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Intellectual Property

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INTELLECTUAL PROPERTY PROTECTION FOR FASHION DESIGN: AN OVERVIEW OF EXISTING LAW AND A LOOK TOWARD PROPOSED LEGISLATIVE CHANGES

N. Elizabeth Mills¹

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ABSTRACT

Intellectual property distinguishes a protected work's aesthetic value from its functionality. In so doing, intellectual property law prevents fashion designers from asserting their rights over entire garments. Apparel industry leaders have repeatedly proposed legislation that would overcome this limitation, and the latest in a succession of draft bills is the Design Piracy Prohibition Act. In critiquing the Design Piracy Prohibition Act, this Article surveys fashion designers' existing federal intellectual property rights, particularly trade dress. In the most recent Supreme Court exposition of the elements of a trade dress action, *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, the Court clarifies some elements of the law, but leaves the threshold for establishing secondary meaning unresolved. After *Samara*, federal district courts have applied trade dress protection to fashion designers without compromising policy objectives against broad intellectual property rights. This Article concludes that trade dress, specifically the secondary meaning element of trade dress, is an underdeveloped area of law with potential to satisfy designers' need for stronger intellectual property rights where other legislative attempts have failed.

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INTRODUCTION

<1>Under the rubric of copyright, patent and trademark, no single intellectual property right protects a clothing design's aesthetic and functional aspects.² Rather than acquiring rights to an entire garment, image, or "look," designers must compartmentalize a piece of fashion into its functional³ and aesthetic components,⁴ and then obtain separate protections for each.⁵ However, fashion is not readily susceptible to such compartmentalization. The aesthetic worth of a pair of pants, for example, is inseparable from its utility as clothing.⁶ Accordingly, fashion designers have sought protection via the Design Piracy Prohibition Act (DPPA), which would amend Chapter 13 of the Copyright Act, to include fashion designs among the Copyright Act's protected "useful articles."⁷ Critiquing the need for *sui generis*⁸ legislation, this Article surveys the intellectual property rights currently applicable to fashion and identifies their limitations. The Article then evaluates trade dress as coming the closest to resolving designers' compartmentalization problem,⁹ and concludes that judicial expansion of trade dress would offer moderate security from design piracy, without the adverse economic and policy consequences of expansive *sui generis* legislation.¹⁰

PAST AND PRESENT FASHION DESIGN PROTECTION: COPYRIGHT, DESIGN PATENTS AND TRADEMARKS

<2>Fashion designers typically rely on copyright, design patent and trade dress to protect their nonfunctional works. In detail, the Copyright Act extends intellectual property rights to "works of authorship fixed in any tangible medium of expression."¹¹ The statute expands the U.S. Supreme Court's *Mazer v. Stein* holding,¹² and has been revised to extend protection to certain named industries.¹³ Despite legislative expansion of the Copyright Act to benefit specific industries, copyright fails to overcome the apparel industry's compartmentalization problem, whereby designers must distinguish between the useful and aesthetic aspects of their works and assert separate rights to each.¹⁴

<3>The threshold issue for whether a fashion warrants copyright protection is which elements of the work are copyrightable.¹⁵ As was noted, a copyrightable work must be both original and fixed in tangible form.¹⁶ However, copyright does not extend to

useful design components, even where such components are original and fixed in tangible form. A typical illustration of this limitation is that neither the pocket of a jacket, nor the overall jacket design, is copyrightable. As such, copyright has limited application to fashion designers.

<4>Apart from copyright, design patents also fail to meet fashion designers' need for holistic protection over an entire garment. In general, design patents, which arise under the Patent Act,¹⁷ do not extend to designs "essential to the use" of a protected work;¹⁸ rather, federal protection extends only to works that are primarily ornamental. For example, a work that is primarily ornamental would be the embroidery on a compartment, as opposed to the compartment's overall configuration.¹⁹ Thus, design patents, like copyright, do not protect tailoring because the aesthetic and useful value of tailoring are legally indistinguishable.

<5>Apart from the Copyright Act and the Patent Act, the Lanham Act, which governs federal trademark rights, offers fashion designers comparatively more protection in the form of trade dress.²⁰ Trade dress refers to the "total image, design, and appearance of a product," including "size, shape, color, color combinations, texture or graphics."²¹ The Lanham Act authorizes claims for trade dress infringement, false designation of origin, false advertising and dilution,²² with remedies of damages, preliminary injunctions, attorneys' fees and corrective advertising costs.²³

<6>Requisite to an infringement action, the claimant must establish the following: (1) the trade dress's non-functionality²⁴ and "source-identifying role," either through inherent distinctiveness or secondary meaning;²⁵ and (2) a likelihood of consumers confusing the defendant's product or service with the claimant's.²⁶ In general, courts deny trade dress for designs that resemble mechanisms, as opposed to ornaments, because mechanistic designs do not meet the non-functionality requirement of trade dress protection.²⁷ Whereas the requirement of consumer confusion reflects the Lanham Act's origin in consumer advocacy,²⁸ the non-functionality requirement lacks a clear policy basis and has been subject to debate.²⁹

<7>Apart from non-functionality, trade dress protection hinges on the designer's use of the trade dress. Specifically, trade dress claims require a showing of inherent distinctiveness or secondary meaning derived from mark use.³⁰ A designer may

not establish secondary meaning instantaneously, or even after a single runway show, but must instead cultivate the trade dress until consumers come to associate it with the designer. This rule is inconsistent with the industry practice of abandoning new designs well before they become ubiquitous.³¹ Absent instant trade dress protection, designers face uncertainty over whether a work may warrant protection.³²

<8>Revisiting the undeveloped state of trade dress law, the Supreme Court in *Wal-Mart Stores, Inc. v. Samara Bros., Inc.* observed that courts should “classify ambiguous trade dress as product design.”³³ To protect such a trade dress, claimants must establish its secondary meaning, not mere inherent distinctiveness. Although the *Samara* Court held that an unregistered color lacked inherent distinctiveness sufficient to support a trade dress infringement action, the Court ruled that even colors *may* warrant trade dress protection if they have acquired secondary meaning.³⁴ While the *Samara* opinion advises courts against broadly extending trade dress protection, the holding does not preclude applying trade dress protection to fashion design.³⁵ Because the Supreme Court has not addressed how trade dress applies to fashion design since *Samara*,³⁶ other federal courts have extended trade dress protections on a case-by-case basis, leaving inconsistent case law ripe for legislative intervention.

PROPOSED LEGISLATION'S SOLUTION TO THE SHORTCOMINGS IN DESIGN PROTECTION

<9>Due to competitor opposition and ideological arguments against *sui generis* legislation, the fashion design industry has sought such legislative intervention with limited success.³⁷ Congress has addressed design protection bills in each convening session from the 96th session to the 102nd, and again in the second session of the 109th Congress.³⁸ The Fashion Design Piracy Prohibition Act (DPPA)³⁹ would allow three years of copyright protection to fashion designers' useful articles.⁴⁰ The DPPA would protect clothing, handbags, and eyewear against both primary and secondary infringement, and offer damages of \$250,000 per violation or five dollars per counterfeited article, whichever is greater.⁴¹

<10>The DPPA has assumed many forms throughout the years, but first arose in the 1930s.⁴² Critics attributed the DPPA predecessors' failure to overly broad language, disproportionate benefit to elite designers, and the risk of making fashion

inaccessible to middle and lower-income consumers. Despite this history of failure, proponents tout the current DPPA as a breakthrough in helping prevent design piracy, and granting U.S. designers protections on par with those of Europe.⁴³ Proponents argue that existing intellectual property rights fall short of those afforded other industries, and the United States risks a loss of fashion design talent to markets with more expansive intellectual property rights.

<11> Designers' aim for legislative subsidies in the Copyright Act also has historical precedent among other industries. Semiconductor mask works gained protection under the Semiconductor Chip Protection Act of 1984,⁴⁴ and boat hull designs also received specifically tailored safeguards as "useful article[s]" under the Vessel Hull Design Protection Act.⁴⁵ Both acts' legislative histories suggest Congress contemplated including additional industries in the *sui generis* amendments to Title 17.⁴⁶ However, unlike these other two industries, fashion has not established its works constitute "useful article[s]," and Congress likely will not amend the Copyright Act to limit an already prospering industry's exposure to competition.

OBTAINING FASHION DESIGN PROTECTION THROUGH TRADE DRESS

<12> Among the existing intellectual property rights, trade dress is perceived as the most appropriate for encompassing an entire fashion design.⁴⁷ Trade dress offers practical advantages to designers because it extends to both registered and unregistered works and has no originality or fixation requirement.⁴⁸ In recent years, trade dress has shown promise for fashion designers seeking to protect the nonfunctional aspects of their works. In the representative case *Cosmos Jewelry Ltd. v. Po Sun Hon Co.*, a California district court upheld the claimant jewelry designer's trade dress right against a defendant jewelry designer.⁴⁹ In 2009, the Ninth Circuit Court of Appeals affirmed the district court's ruling.⁵⁰

<13> The *Cosmos* defendant had used the claimant's sand-blasted gold plumeria pattern on pendants, necklaces, bracelets, rings, and earrings.⁵¹ As a threshold matter, the court determined that the jewelry design "depict[ing] the plumeria flower in yellow gold in a specific size and shape with a sand-blasted matte finish on the petals and high-polished shiny edges" was nonfunctional.⁵² Accordingly, the court distinguished the flower-patterned jewelry's aesthetic value from its function as jewelry.⁵³ After the court concluded that the pattern was within the scope of trade dress protection, the

dispositive factor in the ruling was whether the claimant's trade dress had acquired secondary meaning.⁵⁴

<14>The Court relied on four factors for secondary meaning: (1) whether consumers "associate" the trade dress with the claimant designer; (2) the "degree and manner" of the claimant's advertising; (3) the "length and manner" of the claimant's trade dress use; and (4) the exclusivity of this use.⁵⁵ Under this analysis, and after a finding of likelihood of consumer confusion over the origin of the defendant's infringing dress, the district court awarded damages, attorney's fees, and an injunction against the defendant's production of competing jewelry.⁵⁶

<15>Although the claimant had also raised a claim for copyright infringement, the court denied this claim on grounds that the plumeria pattern was ubiquitous in nature and, therefore, did not meet the originality requirement of copyright protection.⁵⁷ Thus, trade dress protection may prove viable for fashion designers whose works fail to meet the originality requirement of copyright protection.⁵⁸ As evinced by *Cosmos*, trade dress provides enough flexibility for designers to obtain protection over entire fashions, so long as they consist of designs that have secondary meaning.

<16>In addition, as *Cosmos* indicates, courts remain receptive to trade dress as protection for fashion designs.⁵⁹ Nevertheless, *Cosmos* upholds trade dress rights that are less expansive than those of the DPPA. For example, existing trade dress law does not grant designers any proprietary interest in a derivative work they have not created, whereas the DPPA would protect against both primary and secondary infringement.⁶⁰ One additional caveat to leaving fashion design protection to the courts is the probability of circuit splits contributing to forum shopping.⁶¹

<17>If history is any indication of the outcome of the DPPA debate, fashion designers' only recourse lies in appealing to the courts for innovative applications of existing protections.⁶² An alternative of allowing a designer to control an entire garment or "look," as the DPPA proposes, would limit not only competition among designers, but also purchasing power and choice among consumers. Despite the *Cosmos* holding's potential to expand trade dress protection, the opinion also has notable limitations. Specifically, *Cosmos* has yet to be followed, pertains to jewelry rather than textiles, and does not address whether the trade dress at issue has the secondary meaning *Samara* requires. Nevertheless, *Cosmos* reignites trade dress as a potential solution to the inadequacies of intellectual property

protection for fashion designers.

<18> Thus, to raise a trade dress claim, fashion designers must establish a trade dress's distinctiveness in one of two ways: inherent distinctiveness or secondary meaning. The *Samara* and *Cosmos* Courts both evaluate the strength of a product design's secondary meaning, and much of the continued debate surrounding trade dress centers on establishing distinctiveness. Fashion designers who establish this element obtain protection more consistent with the demands of the industry.

CONCLUSION

<19> Trade dress offers a potential alternative to *sui generis* legislation for fashion designers seeking intellectual property rights tailored to the industry. The best approach for apparel designers seeking to protect their work from piracy is a combination of existing intellectual property protections, with emphasis on trade dress. Congress's historical reluctance to extend *sui generis* protection to designers affirms their need to leverage the existing intellectual property framework, despite its potential insufficiency.

PRACTICE POINTERS

- File for trade dress registration with the United States Patent and Trademark Office. Registration is an advantage in infringement disputes, although it is not a requirement of protection under the Lanham Act.
- Invest in advertising that associates the design with the designer. Specifically, establish consumer familiarity with a design before seeking trade dress protection. Target consumers must recognize the fashion design as the work of the designer, because trade dress protection for non-packaging designs requires secondary meaning in the eyes of consumers.
- Ensure the fashion design is available and visible to the public for the duration of trade dress protection. Modifying a trade dress or withdrawing it from the market may forfeit protection.
- Differentiate the functional elements of a fashion design from its nonfunctional elements; only nonfunctional elements which are solely eligible for trade dress protection.

Footnotes

1. N. Elizabeth Mills, University of Washington School of Law, J.D./M.B.A. program Class of 2010. Thank you to University of Washington School of Law Professor Jane K. Winn and Fashion Institute of Technology Professor Guillermo Jimenez. Thank you also to Alexander Casey and Heather T. Rankie, student editors, for their direction.
2. 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, 309 (2007) (“For decades, designers have sought shelter for their work in nearly all areas of intellectual property law, including design patent, trademark, trade dress, and copyright. However, none of these fields of law has provided complete protection for fashion designs.”).
3. Discussion of the Patent Act’s application to fashion is beyond the scope of this Article, because the patentable components of fashion design (i.e., zippers, buttons, etc.) are minimal. 35 U.S.C. § 101 *et seq.* (2006).
4. See *Carol Barnhart Inc. v. Econ. Cover Corp.*, 773 F.2d 411, 420 (2d Cir. 1985) (Newman, J., dissenting) (copyright infringement case defining “separability” of aesthetic and functional elements of a mannequin design, and asserting copyright protection does not extend to functional elements).
5. See *Antioch Co. v. W. Trimming Corp.*, 347 F.3d 150, 156-61 (6th Cir. 2003) (affirming rule that Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a) (2006), generally limits trade dress protections to nonfunctional components of a design, such that the plaintiff’s album’s book spine did not warrant trade dress protection); see also *Publ’ns Int’l, Ltd. v. Landoll, Inc.*, 164 F.3d 337 (7th Cir. 1998) (holding trade dress protection not available to overall functional design); *Brandir Int’l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1145 (2d Cir. 1987) (“[I]f design elements reflect a merger of aesthetic and functional considerations, the artistic aspects of a work cannot be said to be conceptually

separable from the utilitarian elements. Conversely, where design elements can be identified as reflecting the designer's artistic judgment exercised independently of functional influences, conceptual separability exists.”).

6. Marshall, *supra* note 2, at 311 (“Designers looking to protect the overall appearance of a garment have run up against obstacles in every area of intellectual property law.”).
7. Design Piracy Prohibition Act, H.R. 2033, 110th Cong. (2007).
8. In this context, *sui generis* denotes legislation enacted specifically for a defined class (i.e., fashion designers). BLACK'S LAW DICTIONARY 1475 (8th ed. 2004).
9. Cosmos Jewelry Ltd. v. Po Sun Hon Co., 470 F. Supp. 2d 1072, 1085-88 (C.D. Cal. 2006) (extending trade dress protection to include ornate jewelry design, despite the Supreme Court’s dicta in *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 211 (2000) and *Qualitex Co. v. Jacobson Prods. Co., Inc.*, 514 U.S. 159, 165 (1995) (cautioning against broad trade dress protections)), *aff’d*, No. 07-55333, 2009 WL 766517 (9th Cir. Mar. 24, 2009).
10. Kal Raustiala & Christopher Sprigman, *How Copyright Law Could Kill the Fashion Industry*, THE NEW REPUBLIC, Aug. 14, 2007, available at <http://www.law.ucla.edu/home/News/Detail.aspx?recordid=1188>.
11. Copyright Act, 17 U.S.C. § 102(a) (2006).
12. *Mazer v. Stein*, 347 U.S. 201, 217 (1954) (holding statuettes as copyrightable).
13. *See, e.g.*, 17 U.S.C.A. § 1301(a)(2) (West 2008).
14. *Mazer*, 347 U.S. at 212 n.23 (“Productions of the industrial arts utilitarian in purpose and character are not subject to copyright registration, even if artistically made or ornamented.”) (internal citation omitted).
15. 17 U.S.C. § 102(a).
16. *Id.*

17. 35 U.S.C §§ 171-73 (2006).
18. *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1123 (Fed. Cir. 1993); *see also* *Power Controls Corp. v. Hybrinetics, Inc.*, 806 F.2d 234, 238 (Fed. Cir. 1986).
19. *Power Controls*, 806 F.2d at 238.
20. 15 U.S.C. § 1125(a) (2006).
21. *Cosmos Jewelry Ltd. v. Po Sun Hon Co.*, 470 F. Supp. 2d 1072, 1085 (C.D. Cal. 2006) (citing *Clicks Billiards, Inc. v. Sixshooters, Inc.*, 251 F.3d 1252, 1257 (9th Cir. 2001), *aff'd*, *Cosmos Jewelry Ltd. v. Po Sun Hon Co.*, No. 07-55333, 2009 WL 766517 (9th Cir. Mar 24, 2009)).
22. 15 U.S.C. § 1125.
23. *See generally* J. THOMAS MCCARTHY, 1 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 8 (4th ed.1996).
24. *See* Glenn Mitchell & Rose Auslander, *Trade Dress Protection: Will a Statutorily Unified Standard Result in a Functionally Superior Solution?*, 88 TRADEMARK REP. 472, 499 (1998) (noting that the circuits do not agree on which party has the burden of proof for a functionality issue); *see also* Mitchell M. Wong, Note, *The Aesthetic Functionality Doctrine and the Law of Trade-Dress Protection*, 83 CORNELL L. REV. 1116, 1142 (1998) (discussing the "competition" theory of functionality).
25. A work acquires secondary meaning when "in the minds of the public, the primary significance of a product feature . . . is to identify the source of the product rather than the product itself." *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 163 (1995) (citing *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 851, n.11 (1982)).
26. *Cosmos Jewelry*, 470 F. Supp. 2d at 1085. Also, non-functionality refers to that aspect of the trade dress that does not contribute to its purpose, utility, or value. *Clicks Billiards, Inc. v. Sixshooters, Inc.*, 251 F.3d 1252, 1257 (9th Cir. 2001) (citing *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165 (1995) (explaining that "[a] product feature is functional and cannot serve as a trademark if the product feature is essential to the use or purpose of the article or if it affects the cost or quality of the

article, that is, if exclusive use of the feature would put competitors at a significant, non-reputation-related disadvantage.”)).

27. *Compare* Eppendorf-Netheler-Hinz GMBH v. Ritter GMBH, 289 F.3d 351, 358 (5th Cir. 2002) (denying trade dress protection to a pipette tip, whose design was functional and essential to the product’s intended use), *and* Tie Tech, Inc. v. Kinedyne Corp., 296 F.3d 778, 786-87 (9th Cir. 2002) (affirming the denial of trade dress protection for the overall design of a mechanism used to sever wheel chair restraints), *and* Ashley Furniture Indus., Inc. v. SanGiacomo N.A. Ltd., 187 F.3d 363 (4th Cir. 1999) (denying trade dress protection to an ornate silverware design, under the aesthetic functionality doctrine), *and* Bonazoli v. R.S.V.P. Int’l, Inc., 353 F. Supp. 2d 218, 227 (D.R.I. 2005) (denying a trade dress protection for ornate measuring spoons on similar grounds), *with* Hartford House, Ltd., v. Hallmark Cards, Inc., 846 F.2d 1268, 1272 (10th Cir. 1988) (citing *Fuddruckers Inc. v. Doc’s B.R. Others, Inc.*, 826 F.2d 837, 842 (9th Cir. 1987) (recognizing that an overall design may warrant trade dress protection, even if the design includes functional components)), *and* *Cosmos Jewelry Ltd. v. Po Sun Hon Co.*, 470 F. Supp. 2d 1072, 1085 (C.D. Cal. 2006), *aff’d* *Cosmos Jewelry Ltd. v. Po Sun Hon Co.*, No. 07-55333, 2009 WL 766517 (9th Cir. Mar 24, 2009) (granting trade dress protection to ornate jewelry design).
28. *See* *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 28-29 (2003) (observing that § 1125(a) of the Lanham Act is intended to prevent consumer confusion, not reward creativity).
29. *See* Judith Beth Prowda, *The Trouble with Trade Dress Protection of Product Design*, 61 ALB. L. REV. 1309, 1354 (1998) (“It is manifest that courts that have addressed the issue of whether nonfunctional features can serve as trade dress have reached very different conclusions as to the relevant legal standard for such a determination.”).
30. *See* McCARTHY, *supra* note 24, at § 8:13.
31. *Dep’t of Parks & Recs. for the State of Cal. v. Bazaar Del Mundo, Inc.*, 448 F.3d 1118, 1125 (9th Cir. 2006) (stating that “the common law . . .

requires a mark to have been used in commerce before a protectable ownership interest in the mark arises.”).

32. See generally *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 211 (2000); *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992); *Glow Indus., Inc. v. Lopez*, 273 F. Supp. 2d 1095 (C.D. Cal. 2003) (trademark infringement in the context of fashion design); *Carillon Imps. Ltd. v. Frank Pesce Group, Inc.*, 913 F. Supp. 1559 (S.D. Fla. 1996), *aff'd*, 112 F.3d 1125 (11th Cir. 1997) (holding that trade dress offers protection for vodka bottle design).
33. *Samara*, 529 U.S. at 215-16 (holding that, in an action for infringement of an unregistered trade dress, “a product's design is distinctive, and therefore protectable, only upon a showing of secondary meaning.”); see also 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 (2007).
34. *Samara*, 529 U.S. at 216.
35. See *Gibson Guitar Corp. v. Paul Reed Smith Guitars, LP*, 423 F.3d 539, 547 (6th Cir. 2005) (distinguishing between trademarks and the broader protection available under trade dress); see also *Publ'ns Int'l, Ltd., v. Landoll, Inc.*, 164 F.3d 337, 342 (7th Cir. 1998) (acknowledging that the plaintiff's cookbook could warrant overall trade dress protection, notwithstanding the fact that none of the individual functional components of the cookbook warranted trade dress protection); see also *Coach Leatherware Co., Inc. v. AnnTaylor, Inc.*, 933 F.2d 162, 168 (2d Cir. 1991) (defining trade dress), *abrogated by* *Braun Inc. v. Dynamics Corp. of America*, 975 F.2d 815 (Fed. Cir. 1992)).
36. *Samara*, 529 U.S. at 216.
37. *Design Piracy Prohibition Act: Hearing on H.R. 5055 Before the Subcomm. on Courts, the Internet, and Intellectual Property of the H. Comm. on the Judiciary*, 109th Cong. (2006) (recognizing that design protection bills passed in the House in 1962 and in the Senate in 1963 and 1965 and that “extensive hearings” have been conducted between

1990 and 1992), *available at*
[http://frwebgate.access.gpo.gov/cgi-bin/getdoc.cgi?
dbname=109_house_hearings&docid=f:28908.wais](http://frwebgate.access.gpo.gov/cgi-bin/getdoc.cgi?dbname=109_house_hearings&docid=f:28908.wais).

38. *Id.*
39. Design Piracy Prohibition Act, H.R. 2033, 110th Cong. (2007).
40. *Id.*
41. *Id.*
42. *See, e.g.,* Jack Adelman, Inc. v. Sonners & Gordon, Inc., 112 F. Supp. 187, 190 (S.D.N.Y. 1934) (opining that patent law often “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.”).
43. Diane von Furstenberg, *Von Furstenberg: Fashion Deserves Copyright Protection*, LOS ANGELES TIMES, Aug. 24, 2007, *available at*
<http://www.latimes.com/news/opinion/la-oew-furstenberg24aug24,0,1109807.story>.
44. 17 U.S.C. § 904 (2006).
45. *See* Vessel Hull Design Protection Act of 1998, Pub. L. No. 105-304, 112 Stat. 2860 (1998) (codified as amended at in 17 U.S.C.A. § 1301 (West 2008)).
46. *See id.*
47. *See, e.g.,* Daniel J. Gifford, *The Interplay of Product Definition, Design and Trade Dress*, 75 MINN. L. REV. 769, 781 (1991); *see also*, 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 (1996) (arguing that trademark, and more specifically trade dress, poses an alternative for combating design piracy in the fashion industry); *see also* Dorota Niechwiej Clegg, Note, *Aesthetic Functionality Conundrum and Traderight: A Proposal for a Foster Home to an Orphan of Intellectual Property Laws*, 89 IOWA L. REV. 273, 308-12 (2003) (proposing that the answer to design piracy is found in extending a “traderight” for a limited period of time to creators of a design); *see also* Karina K. Terakura, Comment, *Insufficiency of Trade Dress*

Protection: Lack of Guidance for Trade Dress Infringement Litigation in the Fashion Design Industry, 22 U. HAW. L. REV. 569, 604 (2000).

48. Trademark Amendment Act of 1999, Pub. L. No. 106-43, 113 Stat. 218 (1999) (amending 15 U.S.C. § 1125(a)(3) to permit protection of unregistered trade dress, specifically recognizing “civil action[s] for trade dress infringement under this chapter for trade dress not registered on the principal register . . .”).
49. *Cosmos Jewelry Ltd. v. Po Sun Hon Co.*, 470 F. Supp. 2d 1072, (C.D. Cal. 2006), *aff'd*, *Cosmos Jewelry Ltd. v. Po Sun Hon Co.*, No. 07-55333, 2009 WL 766517 (9th Cir. Mar 24, 2009).
50. *Cosmos Jewelry, Ltd. v. Po Sun Hon Co.*, No. 07-55333, 2009 WL 766517, at *1 (9th Cir. Mar. 24, 2009) (“The district court found Cosmos's trade dress, ‘plumeria flowers in yellow gold in a specific size and shape with a sandblasted matte finish on the petals and high-polished shiny edges,’ to be distinctive. Our precedents allow for the findings the district court made.”).
51. *Cosmos Jewelry Ltd. v. Po Sun Hon Co.*, 470 F. Supp. 2d 1072, 1078 (C.D. Cal. 2006).
52. *Id.* at 1085.
53. *Id.*
54. *Id.* The court lacked discretion to award punitive damages.
55. *Cosmos Jewelry Ltd. v. Po Sun Hon Co.*, 470 F. Supp. 2d 1072, 1086 (C.D. Cal. 2006), *aff'd*, *Cosmos Jewelry Ltd. v. Po Sun Hon Co.*, No. 07-55333, 2009 WL 766517 (9th Cir. Mar 24, 2009) (citing *Clamp Mfg. Co. v. Enco Mfg. Co.*, 870 F.2d 512, 517 (9th Cir. 1989)).
56. *Id.* at 1087-88.
57. *Id.* at 1082.
58. *Id.*
59. *Id.* at 1087-88.
60. Design Piracy Prohibition Act, H.R. 2033, 110th Cong. (2007).
61. See Sarah Cone, Comment, *Designer Discounter*

Infringes Trademark and Goes Unpunished: A Look at Gucci America, Inc. v. Daffy's, Inc. and the Lanham Act, 11 RICH. J.L. & TECH. 8, 26 (2005) (noting that there are "sixty-six jurisdictions capable of making or changing trademark law, not to mention several hundred individual district court judges" capable of creating varied interpretations of the trademark code).

62. See, e.g., *Design Piracy Prohibition Act: Hearing on H.R. 5055 Before the Subcomm. on Courts, the Internet, and Intellectual Property of the H. Comm. on the Judiciary*, 109th Cong. (2006), available at <http://www.copyright.gov/docs/regstat072706.html> - N 2 (statement of the United States Copyright Office suggesting designers first pressured Congress to enact additional copyright protection measures as early as 1914).