

***Highlights of the 2010 Fashion Design Bill***

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The third version of a bill to protect fashion designs in the United State was introduced in the Senate on August 5, 2010 (the “New Bill”). It is now named the “Innovative Design Protection and Piracy Prevention Act,” S. 3728 (Schumer-D NY).

The New Bill was referred to the Senate Committee on the Judiciary, and it will not become law until it has been passed by both houses of Congress and has been signed by the President.

The New Bill is designed to be more generally acceptable than the bills previously introduced in the House and the Senate. It is narrower in its scope and it simplifies the procedures to obtain protection for a design. But it continues to be likely to be controversial.

The New Bill still seeks to protect from unauthorized copying original designs of clothing, handbags, belts and eyeglass frames. However, it has important new limitations:

- **Protected Designs.** Original elements, or the arrangement or placement of any elements, will be protected only if they are the result of the designer’s own creative effort and are “a unique, distinguishable, non-trivial and non-utilitarian variation over prior designs for similar types of articles.”
- **Infringements.** A protected design will not be deemed to have been copied if it is not “substantially identical” to the protected design. This is defined as “an article of apparel which is so similar in appearance as to be likely to be mistaken for the protected design, and contains only those differences in construction or design which are merely trivial.”

It also will not be an infringement to deal in an article embodying a design, including advertising, which was created without knowledge of the copying, either actual or reasonably inferred from the totality of the circumstances.

- Formalities. The New Bill eliminates the requirement that a design be registered to be protected. Now, a design will be protected for 3 years from the date when an existing useful article embodying the design is first made public anywhere.

The owner of a design can get an injunction against infringement, but getting monetary relief still requires the use of a design notice consisting of (a) the words “Protected Design,” the abbreviation “Prot’d Des.,” the letter “D” within a circle, or the symbol “\*D\*”; (b) the year when protection commenced; and (c) the name of the owner, an abbreviation, or a generally accepted alternative designation of the owner.

- Penalty and Damages. The increased amount of the penalty for a false representation of rights in a design continues to be between \$5,000 and \$10,000.
- But the amount of increased damages a court may award for design infringement has reverted to \$50,000 or \$1 per copy (from the prior bill’s limits of \$250,000 or \$5 per copy).
- Home Sewing Exemption. There is a new exemption for home sewing of a single copy of a design for personal or immediate family use. But the publication of instructions or patterns for making copies is not permitted.
- Particularity of Pleading. The New Bill requires that an infringement plaintiff plead, with particularity, facts establishing that (a) the plaintiff’s design is protected; (b) the defendant’s design infringes; and (c) the protected design, or an image of it, was sufficiently available that it can be reasonably inferred that the defendant saw or otherwise had knowledge of it, considering the totality of the circumstances.
- Enforcement. The New Bill only provides a private cause of action. It no longer permits Customs & Border Protection or the U.S. Postal Service to apply seizure or forfeiture remedies.

The more limited scope of the New Bill may make it more acceptable to those who were opposed to the prior bill. But some of those seeking fashion design protection may find these limitations to be so detailed that the New Bill will be of little practical usefulness. Plaintiffs will have so many hurdles to jump, and defendants will have so many loopholes in which to hide, that there are likely to be few successful litigations.

As a technical drafting matter, the New Bill continues to intermingle fashion design protection provisions with the Vessel Hull Design Protection Act which is part of the Copyright Law. Non-specialists may find the resulting draftsmanship difficult to follow. To request a copy of the Vessel Hull Design Protection Act, with the New Bill’s proposed changes highlighted in red, please email [wmb@ccl.com](mailto:wmb@ccl.com).

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