

Overview of Proposed U.S. Fashion Design Legislation

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“INNOVATIVE DESIGNS PROTECTION AND PIRACY PREVENTION ACT”

1. BILL INTRODUCED IN U.S. SENATE AUGUST 5, 2010
S.3728 111TH CONGRESS 2ND SESSION

2. BILL AMENDED IN U.S. SENATE DECEMBER 6, 2010
S.3728 111TH CONGRESS 2ND SESSION

December 6, 2010

INNOVATIVE DESIGNS PROTECTION AND PIRACY PREVENTION ACT

WHAT IS PROTECTABLE?

- **§ 1301. Designs protected**
- “A “fashion design”—
 - (A) is the appearance as a whole of an article of apparel, including its ornamentation; and
 - (B) includes original elements of the article of apparel or the original arrangement or placement of original or non-original elements as incorporated in the overall appearance of the article of apparel that—
 - (i) are the result of a designer’s own creative endeavor; and
 - (ii) provide a unique, distinguishable, non-trivial and non-utilitarian variation over prior designs for similar types of articles.

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WHAT IS FASHION DESIGN?

- (9) The term ‘apparel’ means—
 - (A) an article of men’s, women’s, or children’s clothing, including undergarments, outerwear, gloves, footwear, and headgear;
 - (B) handbags, purses, wallets, tote bags, and belts; and
 - (C) eyeglass frames.
- (Proposed 17 USC §1301(b)(9))

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STATUTORY BARS TO PROTECTION

- **§ 1302. Designs not subject to protection**
- (B) in the case of a fashion design, embodied in a useful article that was made public by the designer or owner in
- the United States or a foreign country before the date of enactment of this chapter or
- more than 3 years before the date upon which protection of the design is asserted under this chapter.
- (Proposed 17 USC § 1302(B))

INNOVATIVE DESIGNS PROTECTION AND PIRACY PREVENTION ACT STATUTORY BARS TO PROTECTION

- **§ 1302. Designs not subject to protection**
- in General
- (1) not original;
- (2) staple or commonplace, such as a standard geometric figure, a familiar symbol, an emblem, or a motif, or another shape, pattern, or configuration which has become standard, common, prevalent, or ordinary;
- (3) different from a design excluded by paragraph (2) only in insignificant details or in elements which are variants commonly used in the relevant trades;
- (4) dictated solely by a utilitarian function of the article that embodies it
- (Proposed 17 USC §1302)

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When Does Protection Start?

- **§ 1304. Commencement of protection**
- the date the design is first made public - when an existing useful article embodying the design is anywhere publicly exhibited, publicly distributed, or offered for sale or sold to the public by **the owner of the design or with the owner's consent.**

- **§ 1305. Term of protection**
- for a fashion design, shall continue for **a term of 3 years beginning on the date first made public**
- (Proposed 17 USC §1305(a)(2))

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WHAT IS FASHION DESIGN?

- **§ 1306. Design notice**
 - **Once the design is made public**
- **(A)** the words “Protected Design”, the abbreviation “Prot'd Des.”, or the letter “D” with a circle, or the symbol “*D*”;
- **(B)** the year of the date on which protection for the design commenced; and
- **(C)** the name of the owner, an abbreviation by which the name can be recognized, or a generally accepted alternative designation of the owner.

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Rights Protected for Fashion Designs

- **§ 1308. Exclusive rights**
- The owner of a design protected under this chapter [[17 U.S.C.A. § 1301 et seq.](#)] has the exclusive right to--
- **(1)** make, have made, or import, for sale or for use in trade, any useful article embodying that design; and
- **(2)** sell or distribute for sale or for use in trade any useful article embodying that design.

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WHAT IS INFRINGEMENT?

- **§ 1309. Infringement**
- 1) IN GENERAL.—As used in this section, an “infringing article” is any article the design of which has been
 - copied from a design protected under this chapter, or from an image thereof,
 - without the consent of the owner of the protected design.
- An infringing article is not an illustration or picture of a protected design in an advertisement, book, periodical, newspaper, photograph, broadcast, motion picture, or similar medium.
- (Proposed 17 USC §1309(1))

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SELLER AND DISTRIBUTORS LIABILITY?

- **(b)** A seller or distributor of an infringing article who did not make or import the article **shall be deemed to have infringed on a design** protected under this chapter **only if that person—**
- **(1)** induced or acted in collusion with a manufacturer to make, or an importer to import such article; or
- **(2)** refused or failed, upon the request of the owner of the design, to make a prompt and full disclosure of that person's source of such article, **and** that person orders or reorders such article after receiving notice by registered or certified mail of the protection subsisting in the design.
- (Proposed 17 USC §1309(b))

INNOVATIVE DESIGNS PROTECTION AND PIRACY PREVENTION ACT NOT AN INFRINGEMENT

- **(c) Acts without knowledge.**--It shall not be infringement under this section to make, have made, import, sell, offer for sale, advertise, or distribute, any article embodying a design which was created without knowledge either actual or reasonably inferred from the totality of the circumstances, that a design was protected under this chapter [17 U.S.C.A. § 1301 et seq.] and was copied from such protected design.
- (Proposed 17 USC §1309(c))

INNOVATIVE DESIGNS PROTECTION AND PIRACY PREVENTION ACT INFRINGEMENT DEFENSE

- (3) FASHION DESIGN. In the case of a fashion design, a design shall not be deemed to have been copied from a protected design if that design
 - (A) is not substantially identical in overall visual appearance to and as to the original elements of a protected design; or
 - (B) is the result of independent creation.
- (Proposed 17 USC §1309(e)(3))

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WHAT IS SUBSTANTIALLY IDENTICAL?

- (10) In the case of a fashion design, the term “**substantially identical**” means 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**.
- (Proposed 17 USC §1301(b)(10))

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EXCEPTION TO INFRINGEMENT

- **§ 1309. Infringement**
- (i) HOME SEWING EXCEPTION.
- (1) IN GENERAL.—It is not an infringement of the exclusive rights of a design owner for a person to produce a single copy of a protected design for personal use or for the use of an immediate family member, if that copy is not offered for sale or use in trade during the period of protection.
- (2) RULE OF CONSTRUCTION.—Nothing in this subsection shall be construed to permit the publication or distribution of instructions or patterns for the copying of a protected design.
- (Proposed 17 USC §1309(i))

INNOVATIVE DESIGNS PROTECTION AND PIRACY PREVENTION ACT ENFORCEMENT

- **§ 1321. Remedy for infringement**
- (a) IN GENERAL.
- (2) FASHION DESIGN. In the case of a fashion design, the owner of a design is entitled to institute an action for any infringement of the design after the design is made public under the terms of section 1310(b) of this chapter.
- (Proposed 17 USC §1321(a)(2))

INNOVATIVE DESIGNS PROTECTION AND PIRACY PREVENTION ACT ENFORCEMENT

- **§ 1321. Remedy for infringement**
- (e) PLEADING REQUIREMENT FOR FASHION DESIGNS.
- (1) IN GENERAL. In the case of a fashion design, a claimant in an action for infringement shall plead with particularity facts establishing that
 - (A) the design of the claimant is protected under this chapter;
 - (B) the design of the defendant infringes upon the protected design as described under section 1309(e); and
 - (C) the protected design or an image thereof was available in such location or locations, in such a manner, and for such duration that it can be reasonably inferred from the totality of the surrounding facts and circumstances that the defendant saw or otherwise had knowledge of the protected design.

INNOVATIVE DESIGNS PROTECTION AND PIRACY PREVENTION ACT REMEDIES

- **§ 1322. Injunctions**
 - TEMPORARY RESTRAINING ORDER
 - PERMANENT INJUNCTION
- **§ 1323. Recovery for infringement**
 - DAMAGES – UP TO \$50,000 PER COPY
 - INFRINGER'S PROFIT - the infringer's sales are reasonably related to the use of the claimant's design
 - Destruction of Infringing Articles, molds, etc.

INNOVATIVE DESIGNS PROTECTION AND PIRACY PREVENTION ACT WHAT ABOUT DESIGN PATENTS?

- **§ 1329. Relation to design patent law**
- The issuance of a design patent under title 35, United States Code, for an original design for an article of manufacture shall terminate any protection of the original design under this chapter.

INNOVATIVE DESIGNS PROTECTION AND PIRACY PREVENTION ACT REGISTRATION REQUIRED?

- NO REGISTRATION FOR A FASHION DESIGN
- NO COPYRIGHT OFFICE REVIEW
- **§ 1310. Application for registration**
- **(a) Time limit for application for registration ****
Registration shall not apply to fashion designs.

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QUESTIONS

THANK YOU

ABOUT THE PRESENTER



- Darrell G. Mottley is President-Elect of the District of Columbia Bar of Washington, D.C. for the 2010-2011 term. He is an intellectual property lawyer focusing on patent and trademark cases, including design law, opinions, licensing and litigation. Darrell is a contributing author of the *Annual Review of Intellectual Property Law Developments: 2006-2008; 2008-2009* and the *Public Contract Law Journal*, both publications of the American Bar Association. He is a Fellow of the American Bar Foundation.
- Darrell earned his law degree, with *honors*, from The George Washington University in 2000; his Masters of Business Administration in 1994, and his B.S. Engineering in 1987 from Virginia Tech, where he was Phi Kappa Phi. He is admitted to practice before the U.S. Patent and Trademark Office and courts in the District of Columbia, Virginia, New Jersey, and the Federal and Fourth Circuits.

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