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Fashion's Function in Intellectual Property Law

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ABSTRACT

Clothing designs can be beautiful. But they are also functional. Fashion's dual nature sits uneasily in intellectual property law, and its treatment by copyright, trademark, and design patent laws has often been perplexing. Much of this difficulty arises from an unclear understanding of the nature of functionality in fashion design. This chapter proposes a robust account of fashion's function. It argues that aspects of garment designs are functional not only when they affect the physical or technological performance of a garment but also when they affect the perception of the wearer's body. Generally, clothes are not designed or chosen simply to look good. They are also characteristically designed or chosen to look good on. This approach clarifies the appropriate treatment of fashion design in intellectual property, and it exposes the conceptual limitations of the U.S. Supreme Court's copyright decision in *Star Athletica, L.L.C. v Varsity Brands, Inc.*

3.1 Introduction

The creative endeavours of fashion designers have long been celebrated by consumers, journalists and even museums. But despite the widespread recognition of fashion design's artistry, it has always had an uncertain status within intellectual property law. However beautiful a garment may be, it is also functional. It serves to clothe the body, to keep it warm and to enable the wearer to perform particular activities while wearing it.

Copyright, trademark and design patent laws in the United States are deeply anxious about protecting functionality. They each use various

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doctrinal devices to block functional content, and they channel that content instead towards the utility patent regime. It should be noted that in Commonwealth common law jurisdictions, the terminology is different. 'Design patents', that protect ornamental designs are known as 'registered designs' or simply 'designs'.[1]

This chapter explains how garments function and how different intellectual property regimes should deal with that functionality. Garments are not simply functional to the extent that they serve the mechanical or technological ends of keeping people properly clothed. They are also functional to the extent that they influence the way the wearer is perceived. When aspects of a design affect the perception of the wearer, for example, by making them look taller, slimmer, broader or curvier, those aspects of the design must be treated as functional.[2]

The US Supreme Court's opinion in *Star Athletica, L.L.C. v Varsity Brands, Inc.*[3] on the copyrightability of cheerleading uniform designs did not recognise this important aspect of the nature of garment design. Because the Supreme Court did not accurately assess the functionality of the cheerleading uniform designs before it, the Court risks conferring a substantial competitive advantage on the designer-plaintiff, one that Congress did not intend to confer[4] and that the designer did not earn. As we explain here, the contested features of these uniform designs – stripes, chevrons, zigzags and colour-blocking – like many features of fashion design, affect the perception of the wearer by drawing attention to certain aspects of the wearer's body over others and by making the wearer seem to be curvier and have a longer torso.

The account of fashion's functionality that we develop here also has important implications for trademark law and design patent law. In this chapter, we explain how trademark and design patent laws can more successfully respond to attempts by claimants to protect functional

[1] Eg Registered Designs Act (Cap 266) (Singapore); Registered Designs Act 1949 (UK); Registered Designs Ordinance (Cap 522) (Hong Kong); Designs Act 2003 (Cth) (Australia); Designs Act 1953 (New Zealand).

[2] For a related analysis of copyrightability of clothing designs, see Giovanna Marchese, 'A Tri-Partite Classification Scheme to Clarify Conceptual Separability in the Context of Clothing Design' (2016) 38 *Cardozo Law Review* 375 (hereafter Marchese, 'Conceptual Separability').

[3] *Star Athletica, LLC v Varsity Brands, Inc*, 580 US 405 (2017).

[4] See Innovative Design Protection Act (IDPA), S Res 3523, 112th Cong (2012) (US); Innovative Design Protection and Piracy Prevention Act (IDPPA), HR Res 2511, 112th Cong (2011) (US).

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aspects of garment design without satisfying utility patent law's more strenuous demands.

Section 3.1 describes our account of fashion's function. We explain how, in addition to technical or mechanical functions, fashion design is also functional when it incorporates features that influence the way the wearer is perceived. Section 3.2 explains how copyright law should treat the functional aspects of fashion design in light of copyright law's functionality screening for useful articles, like garment designs, and the law's originality and merger doctrines. In Section 3.3, we illustrate our approach with a case study of the cheerleading uniforms at issue in *Star Athletica* and demonstrate how the Court went wrong. Sections 3.4 and 3.5, respectively, show how our account of fashion's function should affect trademark and design patent laws.

3.2 How Fashion Design Is Functional

Copyright, trademark and design patent laws each limit protection for functional aspects of designs. They each do so in somewhat different ways, as we address. Yet these three legal regimes are unified in limiting functional matter as a way to ensure that those design aspects are protected through utility patent law, if at all. Because of their functionality screens, copyright, trademark and design patent laws each need to identify the functional aspects of otherwise protectable designs.[5]

The features of product designs fall into three mutually exclusive categories. Features can be (1) purely functional, (2) purely non-functional or (3) hybrid. Consider how these features might appear in different parts of an automobile. The car's spark plugs are rarely seen, and their design may be motivated entirely by utilitarian concerns about size and performance. They would fall into the first category. The sculpture of a leaping jaguar that serves as the car's hood ornament has no functional contribution to the car's operation; it exists merely to look good. It falls into the second, purely non-functional, category. Many other aspects of the car's design are simultaneously functional and serve some additional non-functional purpose. The shape of the car's hood both makes it look attractive and influences its aerodynamics. The car's wheels may be designed to look speedy, but they must also be able to

[5] See also Christopher Buccafusco and Mark A Lemley, 'Functionality Screens' (2017) 103 *Vanderbilt Law Review* 1293 (hereafter Buccafusco and Lemley, 'Functionality Screens').

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support the car's weight. These and other features of the car's design are hybrid.

Knowing what to treat as functional for purposes of garment design requires understanding how clothing can serve utilitarian ends. In some cases this is fairly simple, while in other cases it is more complex. Decisions about the physical or technological performance of a garment should clearly be treated as functional. For example, a designer's choices to use fabric that provides warmth even in the coldest temperature or fabric that wicks sweat away from the wearer's body are functional.[6]

On the other hand, various aspects of garment design could be purely expressive, or aesthetic. A logo for a sports team emblazoned on a t-shirt is one such example. Similarly, a paisley pattern woven into a necktie is probably a purely expressive element of the tie's design. Two-dimensional pictorial or graphic additions to garment designs are the most plausible candidates of designs for purely expressive elements.

Many of a garment's design features will be at least partially functional and fall into the hybrid category. For example, the incorporation and design of pockets on a pair of trousers may be particularly stylish and visually appealing, but they are also useful because the pockets give the wearer a place for his or her wallet and keys. Thus, the design of pockets and other similar features should also be treated as dual-nature components of garment design. The same might be true for the cut of sleeve that provides a certain degree of warmth, modesty or ease of movement while simultaneously being beautiful to perceive. Many of the aspects of the fit and cut of a garment fall into the hybrid category, because although they may look attractive in their own right, they also affect the garment's technical or physical performance as a piece of apparel.

Designs can importantly also function in ways that go beyond standard mechanical or technological utility. In particular, the designs of many garments are intended to and are purchased because they make their wearers look attractive. A designer's choices about hemline, neckline, darting and, sometimes, fabric prints influence people's perceptions of the wearer. A shopper does not simply ask of a garment, 'Does it look good?' In addition, and more importantly, he or she asks, 'Does it look

[6] If a designer wants to obtain legal protection for the use of a new kind of performance-enhancing fabric, they need to apply for a utility patent and prove that her invention is novel and nonobvious. See, eg, US Patent No 3687754, filed April 29, 1969 (Registered on August 29, 1972) (claiming a 'method of manufacturing an elastic nonwoven fabric').

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good on me?' or 'Does it make me look good?'[7] In this way, the garment's design is valued for what it can do when it is being used. Thus, in addition to the mechanical functions of garment designs, another intrinsic – or essential – function garment designs tend to share is that many of their design features are incorporated to affect the perception of the wearer.[8]

Many features of garment design – line, shape, texture, colour and print – exploit features of human visual perception and optical illusions to influence the way in which the wearer's body is perceived.[9] Importantly, these visual effects can be created with both three-dimensional design techniques such as garment shape and cut as well as with two-dimensional design techniques such as patterns, stripes and colour. Thus, the frequent assertion that two-dimensional fabric design is non-functional[10] is in many cases wrong when the design affects how the wearer is perceived. Below, we illustrate a number of these techniques, ranging from camouflage to stripe placement.

As all shoppers know, a certain style or cut of a garment may look good on one person but not on another.[11] And different sorts of designs may affect how people's bodies look. This is not accidental. Design choices create visual effects that can vary the size or shape of the wearer's body or body parts. In this section, we illustrate a number of the most

[7] See, eg, Jintu Fan, 'Perception of Body Appearance and Its Relation to Clothing' in Jintu Fan, Winnie Yu and Lawrance Hunter (eds), *Clothing Appearance and Fit: Science and Technology* (Woodhead, 2004) 1 (hereafter Fan, 'Perception of Body') ('Few people have a perfect body. Most people would like to improve their appearance with appropriate clothing, by camouflaging their less desirable attributes and highlighting the more attractive aspects of their bodies.').

[8] To be sure, there are some instances of haute couture and other fashion designs that are decidedly not about making the wearer look good. In such cases, one can still ask whether particular aspects of such fashion design are incorporated to affect the perception of the wearer. If so, those aspects are just as functional as those that are incorporated to make the wearer look good. Other design aspects of some haute couture and other fashion designs might be purely expressive, with the appearance on the wearer's body being beside the point. Those design aspects are unlikely to be functional in the sense described here.

[9] See Marian L Davis, *Visual Design in Dress* (Prentice Hall, 3rd edn, 1996) 21–23, 33 (hereafter Davis, *Visual Design*); Marilyn Revell Delong, *The Way We Look: Dress and Aesthetics* (Fairchild Books, 2nd edn, 1998) 106–107, 132–133, 166 (hereafter Delong, *The Way We Look*); Marilyn J Horn and Lois M Gurel, *The Second Skin* (Houghton Mifflin, 3rd edn, 1981) 314
(hereafter Horn and Gurel, *The Second Skin*).

[10] Eg, *Galiano v Harrah's Operating Co*, 416 F 3d 411, 419 (5th Cir. 2005).

[11] See, eg, Kat Collings, 'The Complete Guide to Dressing for Your Body Type', *Who What Wear* (April 27, 2017), <http://www.whowhatwear.com/how-to-dress-for-body-type-pear-apple-hourglass>.

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prominent design techniques. Our goal here is not to catalogue garment design techniques exhaustively but rather, by choosing common examples, to illustrate the nature of design functionality.

It is common knowledge that the placement of horizontal lines on a garment can make the wearer look shorter and broader, while vertical lines have the opposite effect of lengthening and slimming the wearer's body.[12] Garment design can visually minimise the size of body parts judged to be too large by either appearing to subdivide those body parts or by counterbalancing them to increase the size of surrounding parts.[13] For example, a V-shaped neckline can make the neck look longer and narrower while also making shoulder width narrower.[14] A bodice can be smocked, pleated, draped or gathered at the bust to make the bust appear larger.[15] Similarly, as one design textbook indicates, 'a line continuing around the body, diagonal stripes that are not too dominant, or a reflecting surface smoothly contouring the body call our attention to the rounded contours'.[16]

Designers can also affect the perception of the shape of body parts through design choices. Importantly for our purposes, the combination of colours, shapes and lines can have enormous influence on how the wearer's body is perceived. This is known as colour-blocking, and it was recently made famous by Stella McCartney's line of dresses, garment designs employing a colour-blocked hourglass appearance that made wearers' bodies look both curvier and slimmer. Two examples of these dresses, as worn by actress Kate Winslet, are shown in Figure 3.1. The black colour along the sides, which changes in width at various points, produces a particularly striking hourglass shape.[17] And, in the dress on the right, the brighter colour on the top of the dress produces a larger and more defined bust.[18]

[12] See Davis, '*Visual Design*', above n 9, 36–41; Fan, 'Perception of Body', above n 7, 11; Jintu Fan, 'Psychological Comfort of Fabrics and Garments' in Jintu Fan and Lawrance Hunter (eds), *Engineering Apparel Fabrics and Garments* (Woodhead, 2009) 251 , 257 tbl 9.1 (hereafter Fan, 'Psychological Comforts').

[13] See Fan, 'Perception of Body', above n 7, 11.

[14] Davis, *Visual Design*, above n 9, 339.

[15] Ibid 340.

[16] Delong, *The Way We Look*, above n 9, 117.

[17] Saliha Ağaç and Menekşe Sakarya, 'Optical Illusions and Effects on Clothing Design' (2015) 3 *International Journal of Science, Culture and Sports* 137 , 154–155 (hereafter Ağaç and Sakarya, 'Optical Illusions').

[18] Ibid. For a related discussion of this dress design and the implications for the copyrightability of fashion designs, see Marchese, 'Conceptual Separability', above n 2, 406–407.

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Figure 3.1 Stella McCartney colour-blocked dresses.[19]
(a) © ABACA/Press Association Images (b) © Action Press / Rex Features

Optical illusions can also be deployed in garment design to influence perceptions of the wearer's body.[20] Consider the Müller-Lyer illusion, as shown in Figure 3.2, which causes a line to look longer if it is bracketed on each end by arrow tails and shorter if it is bracketed on each end by arrow heads.[21] This illusion can be incorporated into garment designs to lengthen or contract the body of the wearer through placement of arrow tails or heads, respectively, as shown in Figure 3.3.[22]

These design techniques are not used just because they look attractive on their own. They are used to make the wearer look more attractive. They are part of what make designs inherently *work* as fashion designs. By manipulating features of human vision, these design techniques alter

[19] Fiona Raisbeck, 'Kate Winslet Wows in Another Body-Con Stella McCartney Dress', *Marie Claire* (November 21, 2011) <http://www.marieclaire.co.uk/news/fashion/532781/kate-winslet-wows-in-another-body-con-stella-mccartney-dress.html#index=1>.
[20] See generally Davis, '*Visual Design*', above n 9, 40–50; Ağaç and Sakarya, 'Optical Illusions', above n 17, 137 (cataloguing various illusions to be used).
[21] Fan, 'Psychological Comforts', above n 12, 257.
[22] Davis, '*Visual Design*', above n 9, 40; Fan, 'Psychological Comforts', above n 12, 257.

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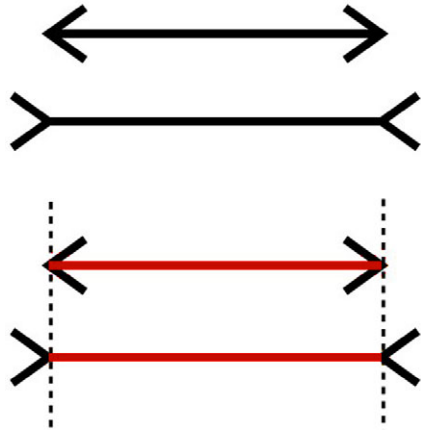


Figure 3.2 Müller-Lyer illusion.[23]
© PsyPhi > SciFi

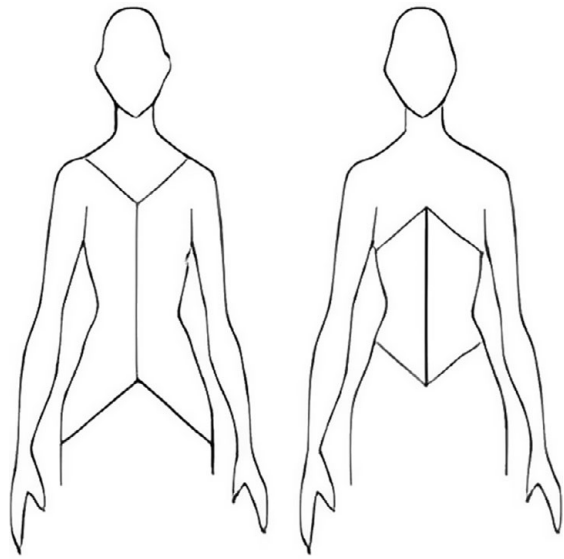


Figure 3.3 The Müller-Lyer illusion applied to garment design.[24]
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[23] Patric Nordbeck, 'An Ecological Note on the Müller-Lyer Illusion', *PsyPhi > SciFi* (February 22, 2015) <http://pnpsyphi.blogspot.co.uk/2015/02/an-ecological-note-on-muller-lyer.html>.
[24] Ağaç and Sakarya, 'Optical Illusions', above n 17, 143 fig 1e.

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the way we see things in the world. As two designers explain, 'By using art components in this way, [designers] can alter the frame of reference in which we see the human form, and in so doing, [they] can create illusions or effects that would not be possible in any other way.'[25] In this sense, they are the same as camouflage or high-visibility patterns that serve a particular function. Unlike a painting or a drawing of a cartoon character, they do not exist merely to portray their own appearance or convey information.

As we argue in Section 3.3, the Copyright Act treats as functional aspects of visual design that influence the perception of another object, including the human body. Accordingly, as a matter of copyright statute and policy, the incorporation of design techniques that produce dependent value are unprotectable. Similarly, trademark and design patent laws must grapple with the issue of whether such functional aspects of fashion designs are unprotectable. We now address these laws in turn, beginning with copyright law.

3.3 Fashion's Function in Copyright Law

Congress and the US courts have long expressed concern about the misuse of copyright law to protect functional objects from market competition.[26] The fashion industry, in particular, has proven a consistent source of consternation in this regard.[27] Over a century ago, one court explained that 'a manufacturer of unpatented articles cannot practically monopolise their sale by copyrighting a catalogue containing illustrations of them'.[28] As the *Star Athletica* case decided by the US Supreme Court indicates, many in the fashion industry are still seeking haven for their designs within copyright law. In this section, we review the general structure of the copyright-patent divide in intellectual property law and the doctrinal techniques that copyright law has historically used to screen out functional content. We then set out how copyright law and policy lead to the conclusion that fashion design features that affect the perception of the wearer are not protectable.

[25] Horn and Gural, *The Second Skin*, above n 9, 314.

[26] *Mazer v Stein*, 347 US 201, 217–218 (1954) (*Mazer*); *Baker v Selden*, 101 US 99, 101–106 (1879); Copyright Law Revision, HR Rep No 94-1476, 94th Cong (1976) (US) 54–55.

[27] Eg, *Fashion Originators' Guild*, 312 US 457 (deeming efforts to stop garment design piracy a violation of the Sherman Act, and emphasising that copyright law, as it then existed, did not provide a basis for preventing such piracy).

[28] *National Cloak & Suit Co v Std Mail Order Co*, 191 F 528, 528 (SDNY 1911).

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3.3.1 *The Separate Spheres of Copyright and Patent Laws*

Copyright law and utility patent law address different kinds of creativity. Copyright law protects authors' writings, while patent law protects inventors' discoveries.[29] Put another way, copyright law is the province of expression and aesthetics, while patent law is the province of utility and functionality.[30] Both fields seek to optimise creative production within their spheres, but they both adopt different legal mechanisms to do so.

Patents can confer substantial market power on their owners, enabling them to charge higher prices for access to the protected technology than they otherwise would.[31] These higher prices and diminished market competition are deemed worthwhile, however, because they provide valuable incentives to invest in creating and disseminating new and useful technologies.[32] The world is a better place, so the story goes, when inventors are given incentives to develop and disclose their inventions, even if this comes at the cost of higher prices.[33] But not all 'inventions' are worth this tradeoff. Patent law establishes relatively high standards for obtaining its protection. Inventors who desire patent rights must submit to an expensive patent examination by the Patent and Trademark Office of their inventions' utility, novelty and nonobviousness.[34] Only 75% of utility patents get granted, and the procedure typically costs US$22,000.[35] Moreover, once granted, patent protection lasts only for 20 years from the application date.[36]

Contrast this situation with copyright law. Copyright lasts for much longer than does patent protection. Authors typically receive copyright protection in their works for their entire lives plus an additional 70 years post-mortem.[37] In addition, copyrights are easy to obtain. Under the

[29] Compare Copyright Act 1976, 17 USC § 102 (US) with Patent Act 2012, 35 USC § 101 (US).

[30] Christopher Buccafusco, 'A Theory of Copyright Authorship' (2016) 102 *Virginia Law Review* 1229; Jeanne C Fromer, 'A Psychology of Intellectual Property' (2010) 104 *Northwestern University Law Review* 1441.

[31] Mark A Lemley, 'The Economics of Improvement in Intellectual Property Law' (1997) 75 *Texas Law Review* 989, 996–997.

[32] Ibid 993–996.

[33] Ibid.

[34] Patent Act 2012, 35 USC §§ 101–103, 131 (US).

[35] Jonathan S Masur, 'Costly Screens and Patent Examination' (2010) 2 *Journal Legal Analysis* 687, 695, 700.

[36] Patent Act 2012, 35 USC § 154(a)(2) (US).

[37] Copyright Act 1976, 17 USC § 302(a) (US).

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1976 Act, copyright vests without need for further action at the moment that a work is fixed in a tangible medium of expression – as soon as it is filmed, drawn or written down.[38] In contrast to the Patent and Trademark Office, the Copyright Office plays little to no role in screening out inappropriate claims to protection. Moreover, to be protectable, works do not need to be novel and nonobvious but rather only 'original', that is, independently created and that they exhibit a very modest creative spark.[39] This threshold is much lower than the one imposed by patent law.

In light of the differences between obtaining patents and copyrights, there is a sizeable risk that creators will attempt to use copyright law to obtain 'backdoor patents'.[40] Although virtually all areas of copyright are at risk of improperly protecting functional content, these concerns are heightened for certain two- and three-dimensional works. Copyright law has taken a targeted approach to excluding functional aspects of these 'pictorial, graphic, and sculptural works',[41] which we discuss and for which we offer an analytical framework in Section 3.3.2.

3.3.2 *Screening Functionality in Pictorial, Graphic and Sculptural Works*

To the extent that copyright law protects the aesthetic features of the design, it risks also protecting utilitarian function, the province of patent law. Consistent with this concern, Congress established a general rule against copyright protection for so-called 'useful article[s]', subject to a narrow exception for expressive features of a useful article that are separable from its functional aspects.[42] Specifically, the Copyright Act provides that 'pictorial, graphic, and sculptural works' include 'works of artistic craftsmanship insofar as their form *but not their mechanical or utilitarian aspects are concerned*'.[43] Further, the design of a work that constitutes a 'useful article' is protectable 'only if, and only to the extent

[38] See ibid § 102(a).
[39] Copyright Act 1976, 17 USC § 102(a) (US); *Feist Publications, Inc v Rural Telephone Service Co*, 499 US 340, 345–347 (1991).
[40] *Baker v Selden*, 101 US 99, 102 (1879); Viva R Moffat, 'Mutant Copyrights and Backdoor Patents: The Problem of Overlapping Intellectual Property Protection' (2004) 19 *Berkeley Technology Law Journal* 1473.
[41] Copyright Act 1976, 17 USC § 102(a)(5) (US).
[42] Copyright Act 1976, 17 USC § 101 (US).
[43] Ibid (emphasis added).

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that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article'.[44] In short, to be protectable, a product design must exhibit expressive 'pictorial, graphic, or sculptural features' (we refer to these as 'expressive' features throughout) that are separable from its 'utilitarian aspects'.[45] If a useful article has no expressive features or if the expressive features are inseparable from its utilitarian aspects, it should not receive copyright protection.

Congress was aware that this rule meant many useful works that are visually appealing would be unprotected by copyright, but it considered this appropriate in light of the risks to competition posed by more expansive copyright protection and the availability of design patents for industrial designs.[46] Congress concluded that leaving some works with expressive features unprotected by copyright was preferable to allowing functional objects to gain lengthy legal protection while avoiding the high inventive threshold and careful examination of the patent system.[47]

When dealing with pictorial, graphic or sculptural works, copyright law distinguishes between those works that constitute 'useful articles' and those that do not. According to the Act, a useful article is 'an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information'.[48] This definition is vitally important to understanding copyright law's treatment of functionality, and it has two essential purposes. First, the definition explains that only those works that have an intrinsic utilitarian function should be treated as useful articles. 'Intrinsic' in this sense means inherent or essential.[49] The Act differentiates between works that essentially have at least one function and those that do not essentially have any function – that is, those that are essentially expressive.

Second, the definition clarifies how to determine whether some characteristic of a work should be treated as functional or expressive. Aspects of a work that 'merely ... portray the appearance of the article or ... convey information' are not functional aspects of the work.[50] They are, instead, expressive features. This distinction is necessary to effectuate the

[44] Ibid.
[45] Ibid.
[46] Copyright Law Revision, HR Rep No 94-1476, 94th Cong (1976) (US) 49–50, 54–55.
[47] Ibid.
[48] Copyright Act 1976, 17 USC § 101 (US).
[49] *Black's Law Dictionary* (9th edn, 2009).
[50] Copyright Act 1976, 17 USC § 101 (US).

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statutory requirement that 'the design of a useful article, as defined in this section, shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article'.[51]

Consider a copyright claim in an original painting. A painting is clearly a 'pictorial, graphic, or sculptural work', so we must then decide whether the painting is a 'useful article'. The answer, in virtually all cases, is that it is not a useful article. Most paintings do not have an intrinsic utilitarian function. Instead, they exist to portray their own appearance. When we think about why most paintings are painted and why they are valued by consumers, we focus on their representational characteristics. Indeed, virtually all of the decisions that an artist makes about the content of a painting are concerned with representational or depictive ends. This is not to say that a painting can have no function. It may successfully cover a hole in the wall, in much the same way that a book can serve as a doorstop. Yet this sort of utilitarian function is one that is shared by all physical objects and is thus not intrinsic, or essential, to a painting or a book in any meaningful way. This sort of non-intrinsic functionality does not magically make paintings or other pictorial, graphic or sculptural works intrinsically utilitarian. Most paintings, then, are by application of the copyright statute, not useful articles.

Now consider the design of a stylish bicycle rack. Although the design may have significant aesthetic features and although it may have won awards for the quality of its design, the bicycle rack has an intrinsic utilitarian function: to hold bicycles securely. The rack was made to hold bicycles, and it is purchased by consumers who want to use it for that purpose. This use is obviously different from typical copyrightable expression, which merely portrays the appearance of an article or conveys information. Similarly, the designs of 'pictorial, graphic, or sculptural' objects like mannequins, floor tiles and, of course, garments, handbags and shoes, are useful articles. They each have an intrinsic function beyond 'portray[ing] the appearance of the article or … convey[ing] information'.[52] They are, as 'useful articles', then subject to a rigorous separability analysis to determine whether they can support a valid copyright.

[51] Ibid.
[52] Copyright Act 1976, 17 USC § 101 (US).

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The copyright statute sets out that 'the design of a useful article ... shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article'.[53] This language indicates that Congress intended to extend copyright protection only to some components of a limited class of useful articles – their separable 'pictorial, graphic, or sculptural' (expressive) features. The first step in a separability analysis, then, must involve determining which components of a work are its expressive features and which are its utilitarian aspects. A court cannot determine whether the former are separable from the latter until it has determined which are which.[54]

Prior to the Supreme Court's *Star Athletica* opinion, this inquiry has been the key component to successful application of the useful articles doctrine in fashion design and elsewhere. In effect, a court is asked to parse the various features of a design and to characterise each of those features. The Copyright Act specifically contemplates that a particular design component can fall into one of the three categories like we described in Section 3.1:

1. only pictorial, graphic, or sculptural (or "expressive");
2. only utilitarian (or functional); or
3. both expressive and utilitarian (ie, hybrid).

The first two categories are straightforward. They encompass design features that are either purely expressive or purely utilitarian, respectively. A cartoon character screen-printed on the front of a T-shirt is likely to be purely expressive, for example, while the shape of an internal part of an automotive engine is purely functional.

The existence and content of the third category may seem less clear, but the statute undoubtedly recognises the existence of hybrid components, and it explains how they should be treated. On its face, the Copyright Act recognises the existence of what we call dual-nature components by acknowledging that there are 'pictorial, graphic, or sculptural features' that cannot 'be identified separately from' the 'utilitarian

[53] Ibid.

[54] As we discuss below, we think the United States Supreme Court erred in its *Star Athletica* decision by failing to categorise the design's features, which led in turn to a flawed outcome in the case. See Section 3.3.

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aspects of the article'.[55] This language indicates that a component of a design, such as the leg of a chair, may be simultaneously expressive and functional. The back of an Eames chair is both a brilliant work of visual design and a terrific example of functional ergonomic engineering.[56]

Indeed, the fundamental justification for the useful articles doctrine has been to exclude from copyright protection aspects of works that exhibit both expression and function.[57] There would be little need for separability analysis if all components of a design could be designated as either expressive or functional, because copyright law could simply indicate that only the expressive features are protectable. Separability analysis exists precisely because design aspects that are expressive can – and, as discussed in Section 3.3.1, in the case of clothing often will – serve utilitarian purposes.

In sum, it is essential to the policies underlying both copyright and patent laws that copyright law distinguish expression from function in determining protectability. Congress sought to do that with the useful articles doctrine by analysing whether a useful article's expressive features are separable from its functional aspects. We now turn to how to think about fashion designs within this context.

3.3.3 *The Functionality of Garment Design Features*

Copyright law's useful articles doctrine is intended to handle cases involving works that incorporate both expression and function. Applying this doctrine to fashion designs has proven challenging to courts, as they try to sort and separate the aspects of garments that are expressive from those that are functional. In this section, we offer a robust approach to understanding the nature of fashion's functionality. Our approach is grounded in the current copyright statute and responds to the Supreme Court's *Star Athletica* decision. Correctly applied, it appropriately limits the scope of copyright protection for garment design to only those features that are purely expressive. According to our

[55] Copyright Act 1976, 17 USC § 101 (US).

[56] John R Berry, *Herman Miller: The Purpose of Design* (Rizzoli, 2004) 85.

[57] Copyright law cannot both protect the expressive features of the uniforms and preserve their functional aspects from protection when they are the same. Cf *Morrissey v Procter & Gamble Co*, 379 F 2d 675, 678–79 (1st Cir. 1967) (holding that copyright does not protect expression whose associated idea can be expressed in very few ways, so that the idea effectively merges with the expression, for the reason that in such cases copyright would then unreasonably protect ideas).

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approach, components of a garment design should be treated as functional not only if they are mechanically or technologically functional but *also if* they are valued for their ability to influence the way that the wearer is perceived. These components are prevalent in fashion design and, even if they are also expressive, must be screened out of any copyright protection granted to an author.

It is clear that fashion designs are both 'pictorial, graphic, [or] sculptural works' and 'useful articles', so copyright law's separability criteria apply to them.[58] As noted above, the most important step in this analysis involves the identification and categorisation of the components of a claimed design. A court must determine which components of the design are purely expressive, which are purely functional and which are hybrid – that is, that they simultaneously affect the aesthetics and the utility of the garment.

We think that the Copyright Act treats aspects of garment design that influence the perception of the wearer's body as 'utilitarian features' of a useful article, although they may also be expressive 'pictorial, graphic, or sculptural' aspects of the article. The reason is that the copyright statute defines a useful article as one having 'an intrinsic utilitarian function that is *not merely to portray the appearance of the article or to convey information*'.[59] As discussed in Section 3.3.2, the Act distinguishes between useful article features that 'merely portray the appearance of the article or … convey information' and useful article features that have additional utility. By this distinction, an aspect of a useful article that 'merely … portray[s] [its] appearance … or … convey[s] information' is not considered a utilitarian feature. It is purely an expression of authorship. By contrast, an aspect of a useful article that does not merely portray its appearance or convey information is a utilitarian feature of that article.

In the context of the useful articles doctrine, the Copyright Act establishes a distinction between aspects of designs that are valued inherently for their depictive effect and those whose value is dependent on their effect on other objects. The former it treats as expressive 'pictorial, graphic, or sculptural features', and the latter it treats as 'utilitarian aspects'.[60] Inherently valuable design elements alone may be treated as purely expressive features of a work. Elements that are dependently valuable for their ability to affect the perception of another object

[58] Copyright Act 1976, 17 USC § 101 (US).
[59] Ibid (emphasis added).
[60] Ibid.

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are (at least partly) functional, because they do not exist merely to portray their own appearance or convey information. For garments, this dependent visual utility represents an additional way in which aspects of garment design can be utilitarian. In addition to the mechanical utility related to use, warmth and modesty, garments have additional utility under the copyright statute when they incorporate design features that influence the wearer's appearance.

Consider how different sorts of visual figures might be incorporated into the design of a garment. On the one hand, a drawing of a cartoon character on a T-shirt is inherently valuable. It is produced and consumed for the representation it provides. The drawing of the character plays the same role and has the same effect whether it is on a piece of paper, a digital device screen or a garment. On the other hand are useful article designs that are primarily dependently valuable. They produce value when brought into appropriate relationships with other objects and in terms of their effects on those objects: making them look bigger, smaller, different or better. Camouflage offers an ideal example of designs at this end of the spectrum, of those having dependent value. The design of a camouflage pattern achieves its value when it is placed in an appropriate environment. When it is, the pattern works: it functions to cloak the person or object that it covers.[61] Consider, by comparison, the two camouflage patterns in Figure 3.4. The camouflage pattern on the left was worn by soldiers in the US Army deployed in Afghanistan to cloak them well against their surroundings, whereas the camouflage pattern on the right, worn by North Korean soldiers, does not cloak them, but if anything, makes them easier to see.

When a design element, like an effective camouflage pattern, alters the way another object appears, that is, when it works in relation to some other object, that design element should be treated as utilitarian as a matter of copyright law.[62] That is, the design element is 'not merely . . . portray[ing] the appearance of the article or . . . convey[ing] information'.[63] Only if a design or an aspect of design exists merely to portray its

[61] Isla Forsyth, 'Subversive Patterning: The Surficial Qualities of Camouflage' (2013) 45 *Environment & Planning* 1037.

[62] Cf *Fulmer v United States*, 103 F Supp 1021 (Ct Cl 1952) (finding no copyright infringement when the US government produced camouflage parachutes from the plaintiff's design showing top and side views of a similar parachute because finding otherwise would be akin to conferring unwarranted patent protection), cited in *Mazer*, above n 26.

[63] Copyright Act 1976, 17 USC § 101 (US).

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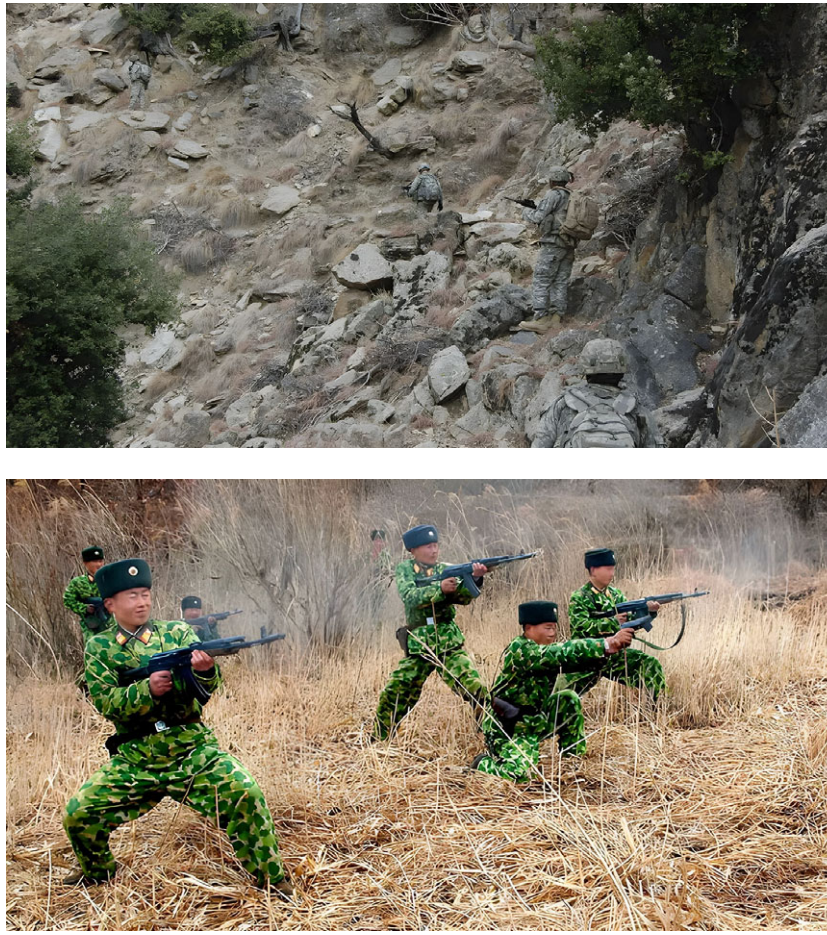


Figure 3.4 Effective and ineffective camouflage.[64]
(a) © SpaceDaily (b) Courtesy of kotaku.com

own appearance should it be treated by copyright law as purely expressive. One such example would be an image of a character, such as Mickey

[64] The figure on the left can be found in Staff Writers, 'Army Selects New Camouflage for Afghanistan',*Spacewar* (February 24, 2010) <http://www.spacewar.com/reports/Army_Selects_New_Camouflage_For_Afghanistan_999.html>, whereas the figure on the right can be found in Brian Ashcraft, 'North Korean Camo Actually Isn't That Awful', *Kotaku* (October 31, 2013) <http://kotaku.com/north-korean-camo-actually-isnt-that-awful-1455805558>.

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Figure 3.5 Pharrell Williams wearing the 'damoflage' print.[65]
Credit: Giovanni Giannoni / WWD / Getty Images

Mouse, printed on a T-shirt. The character exists merely to portray its own appearance. Similarly, Pharrell Williams' so-called 'damoflage' (a pixelated version of Louis Vuitton's damier check print resembling camouflage) – shown in Figure 3.5 – does not serve to camouflage or do anything other than portray its own appearance.

In light of this discussion, we wish to respond to an argument that might be raised to challenge our reading of the Copyright Act: the claim by some courts and scholars that two-dimensional design features are always non-functional, which the Supreme Court recently rejected. It is important to note that expressive techniques that affect the perception of the wearer – and are thus also functional – include both three-dimensional design choices involving the shape and cut of garments as well as two-dimensional design choices involving shapes, colours and patterns. This is essential because some courts and scholars have often

[65] Samantha Tse, 'Pharrell Williams' Louis Vuitton Star-Studded Debut Sparked Joy', *CNN* (June 21, 2023)<https://www.cnn.com/2023/06/21/style/pharrell-williams-louis-vuitton-debut/index.html>.

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reflexively treated two- dimensional fabric designs as non-functional.[66] Yet both two- and three- dimensional design features will often be utilitarian in nature. As discussed above, camouflage offers an obvious example of a functional two-dimensional pattern. If the developer of a new camouflage pattern desires intellectual property protection, they must look to the patent system, as some camouflage designers (including the US military itself) have done.[67] High-visibility fabrics or patterns are also functional, even though they are two-dimensional. And the techniques discussed above in Section 3.1 use two-dimensional patterns in similar ways, by altering how the viewer sees the clothed person.[68]

As the Supreme Court emphasised in *Star Athletica*, the Copyright Act clearly anticipates that two-dimensional designs can be functional when it refers to 'pictorial, graphic, or sculptural features' that are inseparable from utilitarian aspects of the design.[69] The first two objects in this list, pictorial and graphic features, are, in fact, two-dimensional design techniques. The statutory scheme thus makes clear that two-dimensional works and features, and not only three-dimensional works and features, can be utilitarian.[70] By stating that 'pictorial, graphic, or sculptural work[s]' can be 'useful article[s]', rather than limiting the statutory text to 'sculptural works', it is apparent that Congress recognised that both two- and three-dimensional works can be utilitarian. Similarly, by indicating that 'pictorial, graphic, or sculptural features' might be inseparable from 'utilitarian aspects' of the design, rather than just referring to 'sculptural features', the copyright statute signifies that both two- and three-dimensional features can be utilitarian.

3.4 The Conceptual Shortcomings of *Star Athletica*

The account presented in Section 3.3 best comports with the Copyright Act's useful articles doctrine as Congress drafted it and the policy goals

[66] *Galiano v Harrah's Operating Co*, 416 F 3d 411, 419 (5th Cir. 2005); Melville B Nimmer and David Nimmer, *Nimmer on Copyright* (Matthew Bender Elite Products, rev edn, 2017) § 2.08[B][3]; William F Patry, *Patry on Copyright* (Thomson West, 2017)§ 3:151.

[67] Eg, US Patent No 6,805,957 (issued October 19, 2004) ('Camouflage U.S. Marine Corps Utility Uniform: Pattern, Fabric, and Design'); US Patent No 6,499,141 (issued December 31, 2002) ('Multidimensional Camouflage Outer Wear Garment System').

[68] Cf Marchese, 'Conceptual Separability', above n 2, 408 (applying another framework to make the case that two-dimensional design features that affect the perception of the wearer only when worn are not truly two-dimensional features).

[69] *Star Athletica, LLC v Varsity Brands, Inc*, 580 US 405, 412 (2017) (*Star Athletica*).

[70] Ibid (citing Copyright Act 1976, 17 USC § 101 (US)).

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undergirding it. In 2017, the US Supreme Court had an opportunity to affirm these principles in *Star Athletica, LLC v Varsity Brands, Inc.*[71] Instead, the Court charted an entirely new path through copyright law, upsetting decades of lower court precedents and altering the nature of copyright's functionality screening. Here we attempt to explain what the Court did and how it went so wrong. We also discuss how our account of fashion's function should still matter for copyright validity and infringement even if its role in the useful articles doctrine is now different.

The case centres on the copyrightability of the cheerleading uniform designs shown in Figure 3.6.[72] The Supreme Court held the arrangement of stripes, chevrons, zigzags and colour-blocking in the garment designs to be separable features of useful articles and potentially copyrightable.[73] In light of our analysis above, we think the Supreme Court came to the wrong conclusion, after failing to recognise that the arrangement of stripes, chevrons, zigzags and colour-blocking in the garment designs at issue – like many components of clothing designs – has both expressive and utilitarian aspects.

Varsity submitted the above designs for registration by the Copyright Office, and Varsity sued Star Athletica for producing uniforms displaying similar designs. The district court granted the defendant's summary judgment motion, ruling that the designs were not protectable because they served the function of identifying their wearers as cheerleaders.[74] The Sixth Circuit Court of Appeals reversed.[75] It is worth spending a moment on the Sixth Circuit's opinion because, even though we think it reached the wrong conclusion, it did so via a logical methodology. The appellate court engaged in the correct set of steps, first determining that the uniform designs were useful articles and then identifying their expressive and functional features.[76] It was only in applying this step that we think the court erred. It concluded that the only features of the uniforms that were functional were those that contributed to their mechanical use as garments, such as enabling wearers to jump and flip or cover their bodies.[77] The Sixth Circuit determined that the stripes,

[71] Ibid.
[72] Ibid.
[73] Ibid 409.
[74] Ibid 410; *Varsity Brands, Inc v Star Athletica, LLC*, No 10-2508, 2014 WL 819422, at *9 (WD Tenn, March 1, 2014).
[75] *Varsity Brands, Inc v Star Athletica, LLC*, 799 F 3d 468, 471 (6th Cir. 2015).
[76] Ibid 487–488.
[77] Ibid 490.

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Figure 3.6 Varsity's claimed design.
Courtesy of US Supreme Court opinion and Copyright Office registration image

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chevrons and colour-blocking were purely expressive features and were separable from the rest of the uniforms.[78]

The Sixth Circuit understood the basics of the useful articles doctrine and its separability analysis. Its only problem was its failure to grasp that the plaintiff's designs are not purely expressive. Instead, the stripes, chevrons, zigzags and colour-blocking in the claimed designs serve a hybrid purpose, similar to those documented in Section 3.1. They are simultaneously both expressive and functional, serving to accentuate and elongate the cheerleader's body and make it appear curvier in particular areas.[79] We detail some of these hybrid features in light of the discussion in Section 3.1.

In Design 078, the white patches in the colour-blocked pattern help create the visual effect of curviness by creating an hourglass shape with contrasting colours, as in Stella McCartney's dresses.[80] The V-shaped neckline together with the inverted-V-shaped slit on the skirt elongates the body by exploiting the Müller-Lyer illusion. The V-shaped neckline also serves to point to the bust and elongate the neck. The colour-blocking, using contrasting colours, creates contrast and draws attention to the wearer's body. The repeating stripe pattern at the neckline, bust, waist and skirt hem draws viewers' attention from the top of the wearer's neckline all the way to the bottom of the wearer's skirt to see that part of the wearer's body as unified.[81]

Again, in Design 0815, Varsity employs colour-blocking; this time a darker blue colour along the side of the uniform to make the wearer look both more slender in certain places and curvier in others, just as in the Stella McCartney dresses. In addition, the V-shaped striping on the front centre of the uniform serves to further accentuate the bust. The V-shaped neckline both points to the bust and elongates the neck. Designs 299A and 299B have some of the same features associated with the previous

[78] Ibid 491–493.

[79] For a similar observation about these cheerleading uniform designs, see Marchese, 'Conceptual Separability', above n 2, 412; ibid 379 (stating that the designs 'create a trim silhouette shape of the cheerleader').

[80] Giovanna Marchese likewise emphasises that 'the chevrons and stripes are arranged so that the edge of the chevron's "V" frames the cheerleader's chest' and that 'the panels immediately outside the "V" use colors that sharply contrast the color within the "V," which creates a visual effect in the viewer of an hourglass body shape.' Marchese, 'Conceptual Separability', above n 2, 379.

[81] Delong, *The Way We Look*, above n 9, 229 ('Direction can be aided by repetition of similar parts, often called rhythm. Rhythm is defined as the ordered recurrence of parts that leads the eye.').

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two designs, plus there is a diagonal striping, which calls attention to the body's rounded contours. Additionally, the chevron at the bottom of the uniform top is cut to display some of the belly and draw attention to it. Design 074 serves to accentuate the curves and elongate the body for many of the reasons discussed with regard to the previous designs. In addition, the colour-blocking serves to highlight the bust by colouring it in white in contrast to the green above it and navy blue below it.

The stripes, chevrons, zigzags and colour-blocking that form the heart of Varsity's uniform designs do not merely portray their own appearance or convey information. They also serve the purpose of influencing the appearance of the uniform's wearer. These features are the reason that the designs succeed as appropriate designs for garments meant to emphasise the fitness, athleticism, and attractiveness of those who don them. It is with these objectives in mind that Varsity here chose to design its uniforms in this fashion, and it is no accident that many cheerleading uniforms share similar design features.[82] Granting copyright protection to these designs would enable Varsity to monopolise functional aspects of garments without satisfying the exacting demands of patent law. Although other designers might be free to produce cheerleading uniforms incorporating features that flatten the bust, widen the waist, and shorten the legs, we suspect that they are unlikely to find a vibrant market for such products. This is not the sort of competitive advantage that copyright law is intended to foster.

Unlike the Sixth Circuit, which misinterpreted what makes a design feature utilitarian or expressive, the Supreme Court thoroughly misunderstood the statute it claimed to be interpreting. Justice Thomas' majority opinion treats the separability criteria as both intellectually simple and doctrinally weak when they are, in fact, neither of these things. He first asks whether the decision maker can 'spot some two- or three-dimensional element that appears to have pictorial, graphic, or sculptural qualities'.[83] He describes this requirement as 'not onerous',[84] as his application of the test to the uniforms proves. According to the majority, an element of a design counts as an expressive feature if it looks like

[82] It is also no accident that Varsity's designs for male cheerleaders often have different design elements from those for female cheerleaders because the physical aspects of male and female bodies that are emphasised differ. '2016 Varsity Spirit Fashion', *Varsity* (2016) 82 <www.varsity.com/publications/Varsity-Spirit-Fashion-2016.html#82>.

[83] *Star Athletica*, above n 69, 414.

[84] Ibid.

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something.[85] As we discuss elsewhere in a commentary on the decision, 'considering that this is the area of copyright law that applies to pictorial, graphic, and sculptural works, it is impossible that the claimed works would not have some such features'.[86]

The Supreme Court next asks whether the identified expressive feature can exist apart from the utilitarian aspects of the article.[87] The Court explains that 'the feature must be able to exist as its own pictorial, graphic, or sculptural work . . . once it is imagined apart from the useful article'.[88] Finally, the Court indicates, 'If the feature is not capable of existing as a pictorial, graphic, or sculptural work once separated from the useful article, then it was not a pictorial, graphic, or sculptural feature of that article, but rather one of its utilitarian aspects.'[89] Although we do not find these statements to be entirely clear, we think that they imply that given 'some [expressive] qualities that were spotted in the first step, the second step of the analysis asks whether they could be fixed in some form other than the useful article itself'.[90] Or as we put it more simply elsewhere: 'In effect, the majority's test for separability amounts to: Could you draw it on a sheet of paper?'[91] 'Here, because the [uniform designs] could have been, and actually were, reproduced on other (presumably non-useful) media[– in drawings –]they were separable."[92]

The Supreme Court utterly fails to understand the statute and its requirement that decision makers identify distinct expressive and functional features of the claimed work. In its interpretation of the 'ordinary, contemporary, common meaning'[93] of the statute, the Court asks whether the spotted expressive features can be 'imagined apart from the useful article'.[94] But this is not how the statute reads.[95] Instead, the statute asks whether the work's expressive features can be separated from

[85] Ibid 417.
[86] Christopher Buccafusco and Jeanne C Fromer, 'Forgetting Functionality' (2017) 166 *University of Pennsylvania Law Review Online* 119, 121 (hereafter Buccafusco and Fromer, 'Forgetting Functionality').
[87] *Star Athletica*, above n 69, 417–418.
[88] Ibid 414.
[89] Ibid 414–415.
[90] Buccafusco and Fromer, 'Forgetting Functionality', above n 86, 122–124.
[91] Ibid 122.
[92] Ibid; see *Star Athletica*, above n 69, 414.
[93] *Star Athletica*, above n 69, 414.
[94] Ibid.
[95] Buccafusco and Fromer, 'Forgetting Functionality', above n 86, 122–124.

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'the utilitarian aspects of the article'.[96] The difference is not trivial. The Court's statutory misreading substantially lowered the bar for claimants: Rather than distinguishing between and separating the uniform design's pictorial, graphic and sculptural features from its utilitarian aspects, the Court only asks whether the pictorial, graphic and sculptural features were distinct and separate from the uniform itself. Varsity could then claim the stripes, chevrons and colour-blocking because, once they were imaginatively removed from the uniform, a uniform could still exist. That is a different exercise from asking whether a design's pictorial, graphic and sculptural features could be separated from the design's utilitarian aspects.[97]

Under the correct formulation of the test, the Court would have had to determine which components of the design it should treat as utilitarian aspects, something it never asked under the test it conceived for itself.

To make matters worse, the Court failed to appreciate how rigorously Congress intended copyright law to treat functionality. The Court seems to have rejected the notion that copyright law should only be used to protect a work's exclusively expressive features. The majority explains that the imaginatively removed feature of the work 'may not be a useful article', but the majority concludes that the feature is still protectable even if 'the imagined remainder [is not] a fully functioning useful article at all, much less an equally useful one'.[98] This reading of the Act flips the statute on its head. Instead of copyright law protecting only solely expressive features of a work and excluding completely functional and dual-nature aspects, the Court's opinion will prevent copyright from attaching only to purely functional features of the work.

Given the Supreme Court's statutory interpretation, it never had to think carefully about the arguments we have raised above. Because the Court lowered the bar for copyright claimants to protect functional aspects of their designs, it did not significantly interrogate whether the features of the uniform designs that influenced perceptions of wearers' bodies were hybrid. The Court further neglected to rely on the part of the copyright statute that explains what makes a feature utilitarian and which we think requires the classification of many fashion features as utilitarian and therefore inseparable and unprotectable.

[96] Copyright Act 1976, 17 USC § 101 (US).
[97] Buccafusco and Fromer, 'Forgetting Functionality', above n 86, 122–124.
[98] *Star Athletica*, above n 69, 420.

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Although this is a shame, it is not a complete catastrophe. The useful articles doctrine is not the only mechanism by which copyright law polices functionality, and we are sanguine that subsequent courts will utilise these tools. For example, for the same reasons as we have articulated as to why these design features are not separable, they likely run afoul of the merger doctrine and ought to be denied protectability on that ground as well. When there are a limited number of ways to express something, the merger doctrine denies copyrightability to that expression, lest it protect the function too.[99] Given the particularities of human vision and human torsos, we suspect that there are only a limited number of ways to express the functions of accentuating the cheerleader's curves, lengthening the cheerleader's torso and so forth. There is thus good basis to deny copyrightability to these features for having merged function and expression.

In addition, when decision makers compare a plaintiff's work with an allegedly infringing work, copyright law demands that they filter out from their analysis aspects of the plaintiff's work that are functional.[100] Accordingly, when decision makers are asked to compare garments like Varsity's to allegedly infringing copies like Star Athletica's, they should be instructed to ignore aspects of the plaintiff's work that contribute to its function, including dual-nature features like the ones discussed above. Doing so will help achieve Congress' goal of limiting copyright protection to functional designs and will minimise costs to consumers and subsequent designers.

3.5 Fashion's Function in Trademark Law

Copyright law is not the only field of intellectual property law that is concerned with screening out functional aspects of product design. Both trademark law and design patent law also cast a wary eye toward

[99] Pamela Samuelson, 'Reconceptualizing Copyright's Merger Doctrine' (2016) 63 *Journal of the Copyright Society of the USA* 417. A canonical case on this doctrine holds that when there is 'one form of expression, [or] at best only a limited number [of ways to express an idea], to permit copyrighting would mean that a party or parties, by copyrighting a mere handful of forms, could exhaust all possibilities of future use of the substance'. *Morrissey v Proctor & Gamble Co*, 379 F 2d 675, 678 (1st Cir. 1967). For that reason, the idea is considered to have merged with the expression, rendering the expression as unprotectable by copyright as the idea. Ibid.

[100] Buccafusco and Lemley, 'Functionality Screens', above n 5.

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functionality.[101] Although the doctrines these regimes use to screen functionality differ from those employed by copyright law, their concerns are similar. Accordingly, we analyse how these two fields should respond to the particular issue of fashion design's dependent functionality, considering trademark law in this section and design patent law in Section 3.6.

Unlike copyright law, trademark law is not concerned with encouraging the creation of new aesthetic works. Instead, to promote fair competition and protect consumers, trademark law guards consumers from marketplace confusion by ensuring that certain symbols accurately reflect the source of goods.[102] If a pair of shoes has the distinctive Nike swoosh on it, consumers should be able to trust that the shoes are made by Nike. Trademark law covers more than just words or images that designate source, however. It can also be used to protect features of a product's design or packaging that identify its source.[103] This is known as trade dress.

Trademark law is similar to copyright in at least one important respect: it also needs to be concerned about functionality.[104] Just as features of a pictorial, graphic or sculptural work can have utilitarian features, so too can a product's design or packaging. Moreover, allowing mark owners to protect the functional aspects of their designs can have anticompetitive effects as it does in copyright law.[105] Like copyrights, trademarks do not undergo the substantial ex ante evaluation that patents do to ensure that they are new and nonobvious. In many cases, allowing trademark protection for aspects of garment design that affect the perception of the wearer's body will produce problematic anticompetitive effects.

To ensure that trademark law is not used to provide claimants with an undue competitive advantage, the law excludes functional trademarks

[101] Christopher Buccafusco, Mark A Lemley and Jonathan S Masur, 'Intelligent Design' (2018) 68 *Duke Law Journal* 75.

[102] Mark P McKenna, 'The Normative Foundations of Trademark Law' (2007) 82 *Notre Dame Law Review* 1839, 1841.

[103] *Wal-Mart Stores, Inc v Samara Bros, Inc*, 529 US 205 (2000); *Two Pesos, Inc v Taco Cabana, Inc*, 505 US 763 (1992).

[104] Mark P McKenna, '(Dys)functionality' (2011) 48 *Houston Law Review* 823 (hereafter McKenna, '(Dys)functionality').

[105] Buccafusco and Lemley, 'Functionality Screens', above n 5; McKenna, '(Dys)functionality', above n 104.

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and trade dress from protection.[106] Trademark law enables owners to take advantage of the value of their reputations for producing high-quality products, but it seeks to prevent them from using trademarks to gain advantages unrelated to their reputation.[107] This unfair advantage could result if the mark extended to cover useful product features that competitors were then prevented from producing.[108] It could also occur if the mark extended to product features that consumers desired to purchase irrespective of their source-signifying characteristics.

Features of clothing design that influence the way the wearer's body is perceived, such that they make him or her look thinner, bigger, taller or curvier should be treated as bearing on the functionality inquiry in trade dress law. Such features should be treated as functional to the extent that they confer an unfair competitive advantage. Thus, while Burberry's plaid is purely ornamental, a design that used stripes to make the wearer's legs look longer or one that used a pattern to make the wearer's feet look smaller should be treated as functional and unprotectable.

3.6 Fashion's Function in Design Patent Law

Creators of 'any new, original and ornamental design for an article of manufacture' may obtain a design patent.[109] Design patents provide protection from infringement for 15 years from the date of patent grant.[110] To get a design patent, a design's creator must apply to the Patent and Trademark Office, where the application will be examined for patentability.[111] Design patent law does not treat the 'ornamental[ity]' requirement as an affirmative condition that designs be aesthetically pleasing.[112] Rather, the law has long seen this threshold requirement to mean that designs simply be 'non-functional'.[113] The courts have furthermore not understood this requirement to mean that entire designs are necessarily rendered unprotectable for functionality; after all, the 'article[s] of manufacture' that design patent law anticipates will be

[106] *TrafFix Devices, Inc v Marketing Displays, Inc*, 532 US 23 (2001).
[107] McKenna, '(Dys)functionality', above n 104, 825.
[108] *In re Morton-Norwich Prods., Inc*, 671 F 2d 1332, 1339 (CCPA 1982).
[109] Patent Act 2012, 35 USC § 171 (US).
[110] Ibid §§ 173, 289.
[111] Ibid §§ 111, 112, 171.
[112] *Seiko Epson Corp v Nu-Kote International, Inc*, 190 F 3d 1360, 1368 (Fed. Cir. 1999).
[113] Matthew A Smith, *Design Patents* (2012) 8 (preliminary draft) <http://patentlyo.com/media/docs/2012/12/2012-12-17_design_patents.pdf>.

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protected will typically have conventionally functional uses.[114] Instead, courts understand the ornamentality/non-functionality requirement to signify that a 'design patent only protects the novel, ornamental features of the patented design'.[115]

What 'functional' means in the context of design patent law seems less stringent than in copyright and trademark law. A design feature is functional, and therefore unprotectable, only if the feature is '"dictated by" the use or purpose of the article'.[116] By contrast, as the Federal Circuit has explained, 'when there are several ways to achieve the function of an article of manufacture, the design of the article is more likely to serve a primarily ornamental purpose'.[117]

Design patent law ought to take account of hybrid design features in fashion. That is, the law must sort out how to characterise these features: as ornamental or not ornamental. Design patent law must decide whether these features that function to change the appearance of the wearer rather than merely to look attractive in their own right are well accounted for in the calibrations of design patent law or are better addressed by utility patent law. To the extent that design patent law – or the other non-utility patent IP regimes – ignores fashion's function, it risks imposing substantial limits on competition, stifling innovation and increasing costs to consumers.

3.7 Conclusion

The account of fashion's function that we develop in this chapter clarifies how intellectual property law should treat fashion design. It recognises an important way in which designs are functional – when they affect how wearers' bodies are perceived. This is not simply an issue with fashion design, however. As fashion designer and businesswoman Coco Chanel famously said, 'Fashion is not something that exists in dresses only. Fashion is in the sky, in the street. Fashion has to do with the ideas, the way we live, what is happening.'[118] Looking beyond fashion, many visual media can affect the ways that we perceive objects. Trompe l'oeil

[114] Buccafusco and Lemley, 'Functionality Screens', above n 5.
[115] *OddzOn Prods, Inc v Just Toys, Inc*, 122 F 3d 1396, 1405 (Fed Cir. 1997).
[116] *LA Gear, Inc v Thom McAn Shoe Co*, 988 F 2d 1117, 1123 (Fed Cir. 1993).
[117] Ibid.
[118] Rachel Dixon, 'Coco Before Chanel: "She Was Claiming Freedom Through Her Designs"', *The Guardian* (July 31, 2009), <https://www.theguardian.com/lifeandstyle/2009/jul/31/coco-before-chanel>.

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painting and camouflage techniques have this effect. The same is true of chemical or physical processes for developing pigments, such as Vantablack, a carbon nanotube surface coating that produces the sensation of perfect blackness.[119] Attempts to gain intellectual property protection for any of these techniques, unless through the patent system, should be met with intense scepticism.

[119] Elizabeth Blair, 'Some Artists Are Seeing Red over a New "Black"', *National Public Radio* (March 3, 2016), <http://www.npr.org/sections/thetwo-way/2016/03/03/469082803/some-artists-are-seeing-red-over-a-new-black>.

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