Copyright Protection of Fabric Designs
November 5, 2012
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Prints were prominent at London’s fashion week (Sept. 14-18, 2012), leaving aside the artistic merits, this was a wise choice from a copyright perspective. In the United States, there is no copyright protection for garment designs, but there is protection for the prints and fabric designs on garments. Here are some basic principles for those aiming to protect their ideas and avoid infringement of fabric designs:

Copyright protects expression, not ideas. That means nobody can have a monopoly on the idea of a floral print, or the idea of a fall sweater with leaves and squirrels, but you can protect the expression of a particular floral print or sweater design – to take examples from a recent Ninth Circuit case (L.A. Printex Indus., Inc. v. Aeropostale, Inc., 676 F.3d 841 (2012)) and the leading Second Circuit case (Knitwaves, Inc. v. Lollytogs Ltd. (Inc.), 71 F.3d 996 (1995)). You can also protect the combination of several non-protectable elements, in which case your copyright protects the manner in which you combined those elements. For example, a basic red circle, blue square, or yellow triangle, on its own, would be unlikely to qualify for copyright protection, but a particular combination of these elements as a geometric fabric print could likely be protected.

The test for copyright infringement is whether two works are “substantially similar.” The Second Circuit uses the “ordinary observer” test, which considers whether an ordinary observer (or sometimes a “discerning ordinary observer”) would conclude that the “total concept and feel” of the works at issue are substantially similar. In making this comparison, courts do not exclude those non-protectable elements. So, for example, in Knitwaves, the court found the two sweaters were substantially similar because both used the fall symbols of a leaf and a squirrel against a background of fall colors (though nobody can have a monopoly on a leaf, a squirrel, or fall colors). While Ninth Circuit courts typically apply a different test for substantial similarity – the extrinsic/intrinsic test, where the court first analyzes “objective details in appearance, including but not limited to, the subject matter, shapes, colors materials, and arrangement of the representations,” and then the trier of fact makes a subjective overall comparison (676 F.3d at 849) – the Ninth Circuit recently found the Second Circuit’s “ordinary observer” test persuasive “in the context of fabric designs….” L.A. Printex, 676 F.3d at 850.

The scope of protection depends on how many ways there are to express a particular idea. If there are many different ways to express an idea, the copyright holder will receive “broad” protection. So, for example, in L.A. Printex, plaintiff had broad copyright protection because “there are gazillions of ways to combine petals, buds, stems, leaves, and colors in floral designs on fabric, in contrast to the limited number of ways to, for example, paint a red bouncy ball on black canvas….” 676 F.3d at 850-51 (internal citations omitted). By contrast, a realistic-looking leopard print would receive only “thin” copyright protection because there are a limited number of ways to realistically depict leopard skin. Where copyright protection is “thin,” the test for infringement is the higher standard of “virtual identity,” rather than substantial similarity.

Courts look at similarities in color arrangement. Similarities in color scheme can also prove that defendant copied plaintiff’s work. For example, in L.A. Printex, the court pointed to the fact that both Plaintiff’s fabric design and Defendant’s design had a white/berry color arrangement, even though Plaintiff’s copyright registration was only for the floral design, and not the color scheme.
It is not good enough to make a few changes or to not copy the entire design. A defendant cannot avoid liability by only copying part of a plaintiff’s work; the standard is whether the defendant copied a substantial portion. Thus, the defendant in L.A. Printex could still be liable for copyright infringement even though it only copied plaintiff’s floral print, and not the fabric’s background pattern. Similarly, making a few small changes is insufficient. So, in Knitwaves, defendant could not avoid liability by using two types of leaves, rather than four, and adding acorns.

Registration with the Copyright Office is recommended. Copyright protection automatically occurs at the point a fabric design is “fixed in any tangible medium of expression”; so registration with the Copyright Office is not required. However, registration puts would-be infringers on notice, and is a prerequisite to filing a lawsuit. Also, prompt copyright registration (within three months of first publication or one month of learning of infringement) is necessary to recover attorneys’ fees and statutory damages.

MSK can register the copyright in your fabric design and can also assist you with conducting a search of existing copyright registrations in the U.S. Copyright Office.

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