



The Innovative Design Protection Act: Bound for Success or Doomed to Fail?

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On September 12, 2012, Senator Charles E. Schumer introduced the Innovative Design Protection Act of 2012 (“IDPA”) in the United States Senate. The IDPA seeks to amend the Copyright Act by expanding the scope of copyright protection to include original and unique fashion designs. The IDPA also seeks to curb the manufacture, importation and sale of copies and knock-offs of high-end fashion designs.

Senator Schumer’s bill is actually a modified version of legislation he introduced previously. Other efforts to pass similar legislation in 2007, 2009 and 2011 all failed. The current version of the IDPA has been revised in several significant respects.

I. What is Covered Under the Proposed Legislation

The proposed legislation seeks to protect “fashion designs,” defined as:

- (A) 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.”

Apparel is defined broadly, to include:

- (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.

To be sure, the proposed legislation has been drafted with an extremely broad brush so as to bring a number of items within the scope of the proposed legislation.

II. Key Provisions Included in the IDPA

While the IDPA is proposed as an amendment to the Copyright Act, a number of the provisions represent departures from well-settled practices governing copyright infringement litigation.

Standard for Infringement

The standard for copyright infringement is substantial similarity, meaning that in order for a work to be deemed as infringing on another, it must be substantially similar to the protected work. *Three Boys Music Corp. v. Bolton*, 212 F.3d 477 (9th Cir. 2000) cert denied, 531 U.S. 1126 (2000). The IDPA seeks to modify that standard with regard to fashion designs.

The IDPA provides that the making, importation, offering for sale, sale or distribution for sale or for use in trade, of an infringing article shall be deemed an infringement. An infringing article is any article the design of which has been copied from a design protected by the IDPA without the consent of the owner.

Pretty straightforward so far. But here is where it gets interesting. The IDPA also provides the following exception:

Fashion Designs. 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 the protected design; or
- (B) Is the result of independent creation.

“Substantially identical” is defined by the IDPA 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 that are merely trivial. If an article that is not “substantially identical” will not be infringing, then it stands to reason that if a design is substantially identical to a protected design, it will be deemed an infringement.



The substantially identical standard represents a departure from existing law—not because of the distinction between substantially similar and substantially identical, but in the way “substantial identicality” is measured. Under the IDPA a design will be substantially identical—and thereby infringing—if the article of apparel is so similar in appearance as to be likely to be mistaken for the protected design.

But this raises more questions than answers. From whose vantage point is the likely-to-be-mistaken standard applied? From the vantage point of the average consumer? From the vantage point of the consumer who regularly purchases high-end designer garments? The use of this seemingly objective standard is akin to the likelihood of confusion standard used for trademark infringement and clearly distinguishable from the two-pronged substantially similar standard used in copyright matters, and therefore represents a significant departure from existing copyright law.

Pleading Requirements

The IDPA includes a high pleading requirement for claims for infringement of a fashion design. A claimant suing for infringement must plead with particularity facts that establish:

- (1) the fashion design that serves as the basis for the infringement claim;
- (2) the design of the defendant that the claimant alleges infringes; and
- (3) “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.”

This represents a heightened pleading requirement that a claimant must meet in order to adequately plead a claim for infringement.

III. How Does The Latest Bill Differ From Earlier Versions?

On numerous prior occasions, various forms of the IDPA have been introduced to Congress. So what makes the current legislation different and why might this pass when the prior versions have failed? The IDPA includes two key provisions that were not included in prior versions and

which limit the damages recoverable under the IDPA for an infringement. These additions may prove instrumental in whether or not this legislation passes.

First, the legislation requires that before any infringement complaint is brought, the owner of the protected design must provide the alleged infringer with written notice of the alleged infringement. While the specifics of what must be included in that notice are enumerated in the IDPA, more significantly, the proposed legislation precludes a plaintiff from filing an infringement lawsuit relating to a fashion design until twenty-one days after the aforementioned notice is provided.

The second significant addition to the current version of the IDPA is the measure of damages a claimant can recover following an infringement. The proposed legislation provides that an infringer will only be liable for damages and profits accrued after the date on which the action for infringement is commenced. When read together with the notice requirements, the new legislation provides for the functional equivalent of a safe-harbor, insofar as an alleged infringer may be able to shield itself from a damage award by ceasing to sell all allegedly infringing pieces upon receipt of the required twenty-one day notice.

IV. Conclusion

It is presently unclear whether the IDPA will succeed where its predecessors have failed. A number of the provisions of the proposed legislation represent a significant expansion of copyright protection to items that are not protectable under current law. While other aspects of the IDPA could significantly alter its practical effect, it will be interesting to see how the IDPA is modified, if at all, as it moves its way through the legislative process and whether it garners wide support.



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