## Contents

Table of Cases	xiii
Foreword and Acknowledgments	xvii
Foreword and received and received	
I Introduction to Eachion Law	3
Chapter 1 · Introduction to Fashion Law	3
A. Defining the Scope of Fashion Law	3
1. The Need for Fashion Law	4
2. Defining Fashion Law  Design and Brand Protection	4
a. Fashion Intellectual Property—Design and Brand Protection	7
b. Fashion Business Law	9
c. Fashion Public Law	9
B. Fashion Business 101 for Lawyers	10
1. Knocking Off	10
2. Fashion Design and Product Development	10
3. Sourcing and Manufacturing	12
4. Sales and Marketing	13
5. Key Industry Players and Statistics: Countries, Brands, Retailers	
C. Cases and Materials	15
1. Defining Fashion: Trends, Differentiation and Copying	15
The Law, Culture, and Economics of Fashion	16
2. Sumptuary Law and the Origins of Fashion Law	22
Intellectual Property Law and the Sumptuary Code	24
Notes	26
The Clothworkers of Ipswich Case	26
Notes	27
3. The Iconic Designer as Brand: Publicity, Name, and Likeness Righ	ts 27
Otis F. Wood v. Lucy, Lady Duff-Gordon	27
Notes	28
4. The Perennial Problem: Knocking Off and Design Piracy	30
Cheney Bros. v. Doris Silk Corporation	30
Notes	32
Fashion Originators' Guild of America v. FTC	33
Notes	35
Christian Dior v. Frederick L. Milton et al.	36
Notes	40
The Graffiti Cases	40
Graffiti Artists Fight Copying by Fashion Brands	40
Notes	42
5 Fashion Law Feminism and Gender Bias	42

Towards a Feminist Theory of the Public Domain, or Rejecting the Gendered Scope of United States Copyrightable and Patentable Subject Matter  Notes	43
Fashion, Sexism, and the United States Federal Judiciary	45
Notes	45 50
Chapter 2 · Copyright	51
A. Overview of Copyright in Fashion	51
1. Origins and Purpose of Copyright Law	51
2. Sources of American Copyright Law	52
3. U.S. Copyright Law and Fashion	52
4. Key Concepts in Fashion Copyright	54
a. Originality and the Idea/Expression Dichotomy	54
b. Registration and Statutory Damages	55
c. The Rights of the Copyright Holder	55
<ul><li>d. "Work for hire" Agreements and Transfer of Copyright</li><li>e. First Sale Doctrine</li></ul>	55
B. Fashion Copyright Cases	55
1. Copyright Cases  1. Copyrightable Subject Matter	56
a. Fashion Sketches	56
Jack Adelman, Inc. v. Sonners & Gordon, Inc., et al.	56
Notes	56
b. Fabric Designs, Prints and Patterns	58 59
Peter Pan Fabrics, Inc. v. Brenda Fabrics, Inc.	59 59
Peter Pan Fabrics, Inc. v. Martin Weiner Corp.	60
Notes	61
Eve of Milady v. Impression Bridal	62
Notes	65
2. Copyright and Useful Items: Separability	65
Kieselstein-Cord v. Accessories by Pearl, Inc.	66
Notes	69
Gregory Poe v. Missing Persons, Dale Bozzio, Steven Brooks,	
Capitol Records, Inc., Capitol Industries-EMI Inc. Notes	71
	75
Whimsicality v. Rubie's Costume Co. Notes	76
Masquerade Novelty, Inc. v. Unique Industries, Inc.	79
Notes	80
Chosun International, Inc. v. Chrisha Creations, Ltd.	83
Notes	84 87
Jane Galiano and Gianna, Inc. v. Harrah's Operating Company, Inc.;	07
Harrah's Entertainment, Inc.	88
Notes	93
Jovani Fashion, Ltd. v Fiesta Fashions	94
Notes	96
3. Determining Infringement	96
a. Elements of Infringement: Valid Copyright + Copying + Substantial	
Similarity	97

CONTENTS vii

	Folio Impressions, Inc. v. Byer California; Macy's New York, Inc.; Lida Manufacturing Co.; et al.	97
	Notes	101
	Royal Printex v. Unicolors	101
	Notes	104
	b. Determining Substantial Similarity	105
		105
	Segrets, Inc. v. Gillman Knitwear Co	110
	Notes	111
	L.A. Printex Industries, Inc. v. Aeropostale, Inc.; Ms. Bubbles, Inc.	111
	Notes	110
	c. Litigation: Combined lawsuits for Copyright and Trade Dress	116
	Infringement	
	Knitwaves, Inc. v. Lollytogs, Ltd.	116
	Notes	124
	Yurman Design Inc. v. PAJ, Inc.	125
	Notes	134
	Work for Hire Issues	134
	Langman Fabrics v. Graff Californiawear	135
	Notes	144
5.	Critical Evaluation of U.S. Fashion Copyright Law	145
	The Dubious Legal Rationale for Denying Copyright to Fashion	145
	Notes	150
	The Kirtsaeng v. Wiley "Hint"	150
	What "Design Copyright"?	151
	Notes	153
Chapte	r 3 · Trademark	155
_	he Importance of Trademarks in Fashion	155
B. B:	asic Trademark Concepts	157
1.	Purpose of Trademark Law	157
2.	Common Law Trademark and the Lanham Act	158
3.	Choosing and Registering a Trademark	158
	a. Distinctiveness: Word Marks and Style Names	159
	Abercrombie & Fitch Co. v. Hunting World, Inc.	159
	Notes	165
	b. Distinctiveness: Personal Names as Trademarks	166
	Paolo Gucci v. Gucci Shops, Inc.	166
	Notes	173
	JA Apparel Corp. v. Joseph Abboud	174
	Notes	180
	c. Distinctiveness: Apparel Design as Trade Dress	181
	Wal-Mart Stores, Inc. v. Samara Brothers, Inc.	181
	Notes	185
	d. Distinctiveness: Color Marks and Aesthetic Functionality	186
	Christian Louboutin v. Yves Saint Laurent America	187
		195
4	Notes  Determining Tradement Infringement	195
4.	Determining Trademark Infringement	193
	a. Multi-Factoral Analysis: The Polaroid Factors	
	Lois Sportswear, U.S.A., Inc. v. Levi Strauss & Co.	196
	Notes	205

b. Combined Trademark Infringement and Dilution Actions	207
Louis Vuitton Malletier v. Dooney & Bourke, Inc.	208
c. Irade Dress Infringement	219
Coach Leatherware Co., Inc. v. AnnTaylor, Inc.	219
Notes	227
5. Trademark Dilution and Commercial Parody	227
Louis Vuitton Malletier SA v. Haute Diggity Dog. LLC	228
o. Registration Issues	238
a. Trademark Opposition	239
Levi Strauss & Co. v. Genesco, Inc.	
i. Trademark Searches and Willful Infringement	239
International Star Class Yacht Racing Association v. Tommy	241
Hilfiger, U.S.A., Inc.	242
Notes	242
ii. Priority between Commercial Usage and Registration	245
Zazu Designs v. L'Oreal, S.A.	245
Notes	246
b. Defenses to Trademark Infringement and Dilution Actions	253
adidas-America, Inc. v. Payless Shoesource, Inc.	254
Notes	254
Gucci Am., Inc. v. Guess?, Inc.	270
Notes	271
7. Fashion Trademarks and Internet Domain Name Disputes	287
TCPIP Holding Co., Inc. v. Haar Communications Inc.	287
Notes	287
C. Evaluating Fashion Trademark Law	294
The Devil Wears Trademark: How the Fashion Industry Has	295
Expanded Trademark Doctrine to its Detriment	
Notes	295
The TTAB's Dangerous Dismissal of Doubt	303
Notes	303
/	309
Chapter 4 · Design and Utility Patents	
A. The Role of Patents in Fashion: Pros and Cons	311
B. Design Patents	311
	312
1. Determining Infringement: Defenses of Functionality and Obviousness	313
L.A. Gear, Inc., v. Thom McAn Shoe Company Notes	313
	318
Rockport Co., Inc. v. Deer Stags, Inc. Notes	319
	323
2. ITC Procedures to Block Imports of Infringing Articles	323
Crocs, Inc. v. International Trade Commission Notes	324
C. Utility Patents	330
Utility Patent Protection	331
2. The Scope of Utility Patent Protection	331
Mahs Inc. d/h/a Lancon of C-115 - 1 C - The	331
Mabs, Inc., d/b/a Lancer of California, Snap-Tab Corporation and	
Leslie Riverview Realty Corp. v. Piedmont Shirt Company Notes	331
110163	335

ix

Chapter 5 · Comparative Design Piracy Protection: U.S. and E.U.	337
A. Design Piracy Protection: U.S. Legislative Proposals	337
Should the United States Protect Fashion Design?: The Proposed	
Design Piracy Prohibition Act	338
Notes	362
B. European Cases	363
Societe Yves Saint Laurent Couture v. Societe Louis Dreyfus	
Retail Management S.A.	363
Notes	373
Karen Millen Fashions Ltd v. Dunnes Stores, Dunnes Stores	
(Limerick) Ltd	374
Notes	380
C. Critical Evaluation of Global Fashion I.P.	380
The Law, Culture, and Economics of Fashion	381
Intellectual Property Law and the Sumptuary Code (Part II)	388
	396
Notes	
Cook Cook Citing and Crow Market Cooks	399
Chapter 6 · Counterfeiting and Gray Market Goods	399
A. Introduction	400
B. Laws Governing Counterfeiting	400
1. Federal Laws Relating to Counterfeiting	400
15 U.S.C.A. § 1114	401
15 U.S.C.A. § 1116	404
2. Civil Seizure	404
Cartier International B.V. v. Ilan Ben-Menachem, et al.	411
Notes	412
3. Customs Support	412
Gucci America, Inc. v. Duty Free Apparel, Ltd. d/b/a Duty Free	
Apparel, Inc., Joel Soren, Harvest Wrap, Inc., Kurt Davidsen	412
and John Does 2–20	413
Fendi Adele, S.R.L. v. Ashley Reed Trading, Inc.	416
Notes	418
Coach, Inc. v. Fashion Paradise, LLC	418
Notes	422
4. Importation, Smuggling and Trafficking	422
18 U.S.C.A. § 2320	423
18 U.S.C.A. § 1961	424
United States of America v. Siu Yung Chan v. Burberry Limited; Louis	
Vuitton North America, Incorporated; VSE Corporation	424
Notes	432
5. State Laws	433
Cal. Penal Code § 350	434
C. I.P. Enforcement Abroad	434
Protection of Intellectual Property in China (30 Years and More):	
A Personal Reflection	434
D. Ethical Issues — Use of Private Investigators	442
28 No. 9 ACC Docket 86: The Ethics of Using Undercover	
Investigators	442
Rolex Watch, U.S.A., Inc. v. Michel Co.	44
INVESTOR TOURS OF THE PROPERTY	

E. The Gray Market and the First Sale Doctrine	448
Zino Davidoff SA v. CVS Corporation	448
Notes	454
F. The International Trade Commission as a Venue	455
In the Matter of Certain Handbags, Luggage, Accessories and	433
Packaging Thereof	150
G. Third-Party Liability: Indirect Infringement and Counterfeiting	456
1. Suits Against Landlords/Flea Market Owners	460
	461
Coach, Inc. and Coach Services, Inc. v. Frederick Goodfellow, d/b/a	
the Southwest Flea Market, aka 3rd Street Flea Market Notes	461
	466
Gucci America, Inc. v. Frontline Processing Corp., Woodforest	
National Bank, Durango Merchant Services LLC, d/b/a National	
Bankcard Systems of Durango, "ABC Companies," et al.	466
Notes	474
Tiffany (NJ) Inc. and Tiffany and Company v. eBay Inc.	475
Notes	484
2. Suits against ISPs	485
Louis Vuitton Malletier, S.A. v. Akanoc Solutions, Inc.; Managed	
Solutions Group, Inc.; Steven Chen	485
3. Real Property Law and Anti-Counterfeiting	489
New York Real Property Law § 231	489
1165 Broadway Corp. v. Dayana of N.Y. Sportswear, Inc., et al.	490
Chapter 7 · Fashion Licensing	493
A. Introduction	493
Licensing in the Fashion Industry	493
Calvin Klein Trademark Trust and Calvin Klein, Inc. v. Linda	494
Wachner, Warnaco Group, Inc. et al.	502
Notes	503
Robert Trent Jones II, Inc., and Robert Trent Jones Licensing	508
Group IIC v CESI Inc. Albia Country Street I	
Group, LLC v. GFSI, Inc., d/b/a Gear for Sports, Inc. Notes	509
	513
The Levy Group, Inc. v. L.C. Licensing, Inc. and Liz Claiborne, Inc. Notes	513
	517
1. Disputes over Term and Termination	517
Jones Apparel Group, Inc. v. Polo Ralph Lauren Corp.	517
Notes	520 .
2. Disputes Related to Exclusivity	521
Macy's, Inc. v. J.C. Penney Corporation, Inc.; Macy's, Inc. v. Martha	
Stewart Living Omnimedia, Inc.	521
Notes	535
Chapter 8 · Fashion Business Law: Commercial Operations	537
A. Introduction	537
B. Manufacturing and Commercial Sales	538
1. Chargebacks	538
Chargebacks Crisis: Saks Inc. to Repay \$21.5M to Vendors	538
1 /	200

CONTENTS xi

Atateks Foreign Trade, LTD. v. Private Label Sourcing, LLC and	
Second Skin, LLC	539
Notes	548
C. Customs and Import	548
Pollak Import Export, Corp. v. The United States	548
Notes	553
D. Sweatshop Issues	553
1. Sweatshop Disasters and Their Legal Consequences	554
a. Triangle Shirtwaist Factory Fire (1911)	554
141 Men and Girls Die in Waist Factory Fire	554
Triangle Owners Acquitted by Jury	555
b. Pakistan — Karachi and Lahore Fires (2012)	556
Inspectors Certified Pakistani Factory as Safe Before Disaster	556
c. Bangladesh—The Tazreen Factory Fire (2012)	558
At least 117 killed in fire at Bangladeshi clothing factory	558
d. Bangladesh—Rana Plaza Building Collapse (2013)	559
Major Retailers Rejected Bangladesh Factory Safety Plan	559
As Firms Line Up on Factories, Wal-Mart Plans Solo Effort	560
2. Anti-Sweatshop Litigation	561
Street Beat Sportswear, Inc. v. National Mobilization Against	
Sweatshops et al.	562
Notes	565
Zeng Liu v. Donna Karan, Inc.	566
3. Industry Responses to the Bangladesh Crisis: The Accord on Fire an	
Building Safety in Bangladesh	569
Accord on Fire and Building Safety in Bangladesh	569
E. Employment Issues	573
1. Anti-Discrimination	574
Equal Employment Opportunity Commission, Petitioner v.	371
Abercrombie & Fitch Stores, Inc.	574
Notes	581
2. Non-Compete Provisions in Employment Contracts	581
The Estee Lauder Companies, Inc. v. Shashi Batra	582
Notes	593
	594
3. Class Actions: Wage/Hour and Working Conditions Cases  Ann Otsuka; Janis Keefe; Corinne Phipps; and Renee Davis,	374
individually and on behalf of all others similarly situated v.	E0.4
Polo Ralph Lauren Corporation, et al.	594
Notes	598
F. Advertising	598
Four National Retailers Agree to Pay Penalties Totaling \$1.26	
Million for Allegedly Falsely Labeling Textiles as Made of	500
Bamboo, While They Actually Were Rayon	598
Notes	600
Bill Diodato Photography, LLC v. Kate Spade, LLC	601
Notes	608
Index	611