On a sweltering Saturday afternoon in downtown Los Angeles, crowds stream through the shops that line Santee Alley, a sliver of a street that slices through the heart of the city's bustling fashion district. These aren't the upscale crowds that fill Barneys or Fred Segal across town. They are largely blue-collar workers, many of them Latino immigrants looking for a deal. And deals are all around: a Louis Vuitton bag for $35, a pair of Gucci sunglasses for $5, three Fendi purses for an astonishing $10 — the kind of bargain one might normally call a "steal."

Only in this case, "steal" may be more accurate than most of the shop-

Barbara Kolsun and Michael Heimbold keep 7 For All Mankind's clothes popular by fighting counterfeiters. Will a proposed extension of copyright law help or hurt them?

See FASHION on page 10
Fashion
Continued from page 1—

the imitations of dresses worn by stars at the Academy Awards, which are sold by the thousands the very next day without the designer’s name and which are quite legal under current U.S. law.
“A designer spends blood, sweat and tears, and he never knows what is going to hit,” says Tom Speiss, of counsel with Baker & Hostetler in Los Angeles. “Designers should be rewarded for that effort by maximizing profit.”

In the U.S., there are tough laws protecting trademarked brands but relatively weak laws protecting the copyright of a design itself — something that may change if the Design Piracy Prohibition Act (H.R. 5955), a bill recently introduced to Congress by Rep. Bob Goodlatte, R-Va., is successful.

“Fashion design is a $500 billion American industry,” Goodlatte notes. “In addition to the jobs directly related to the manufacturing of apparel, it creates jobs in many sectors: printing, trucking, distribution, advertising, publicity, merchandising and retail. By protecting a designer’s original work, we are also protecting the many jobs that support that design.”

While counterfeiting is a serious crime in the U.S. — and it has become more so thanks to stricter punishments mandated by this year’s Stop the Manufacturing of Counterfeit Goods Act (H.R. 32) — determining what portion of a piece of apparel is protected (if any) requires extensive analysis.

“The first step is to understand what are the components that are relevant to intellectual property law,” explains Rod Berman, chair of the intellectual property department at Jeffers Mangels Butler & Marmaro in Los Angeles.

Unique brands, such as QuickSilver or St. John Knits, clearly are protected by trademark law. Such protection also applies to distinctive logos such as Nike’s “swoosh” or McDonald’s "Golden Arches.”

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— Congressman Bob Goodlatte, R-Va.

Precisely what “counterfeit” means is open to interpretation. To lawyers such as Himboldt and Barbara Kol

un, general counsel for the clothing firm 7 For All Mankind, it means a knockoff piece of apparel or a luxury product with the trademarked name of a brand — such as the popular 7 jeans, which retail for up to $700 in stores but sell for a modest $50 in Salvation Army, complete with a label that not only flaunts 7's brand and signature pocket stitching but boasts: “This is an original. Beware of imitations!”

An increasing number of voices in the fashion industry and Congress argue that counterfeit should also include design rip-offs, like

COVER STORY

Fashion
Continued from page 10—

ald’s Golden Arches. Further, it is possible for a designer to protect particular fabric designs through current copyright law, but with very few exceptions, "As we sit here today, the style (of a garment) is not covered by copyright," Berman notes. Which means you can walk 10 yards down Santee Alley to another store where an almost identical Louis Vuitton-style bag is being sold for $20 (but without the identifiable LV logo), and that is legal.

It is this precise issue that Goodlatte’s bill is attempting to address extending copyright to the very design of the item and not just its brand. But there have been objections to the bill, too, from several intellectual property specialists who believe added protection is both unnecessary and may actually harm those the law is attempting to protect. "We have a thriving fashion industry; it is growing, it is exciting, it is innovative, with lots of competitors," says Christopher Sprigman, an associate professor at the University of Virginia School of Law, who testified on the matter before Congress. "Contrast that to music or film, where there is (copyright governing) intellectual property, and those industries are static by comparison — they have a few big companies that rule the roost. Fashion is a much more competitive industry. That is what we should want." Sprigman argues that the new law could damage this competition. “Every season, the industry tries to create trends and get people to buy clothes by suggesting they need to participate in the new trend. And the establishment of those new trends is based on copying — not doing so verbatim but taking substantial elements of an attractive design and playing with it.” In an article on the Public Knowledge Web site (publicknowledge.org), Sprigman shows how this works in practice, with photographs of different designers’ versions of a trendy “driving shoe.” All are similar enough to seem like copies; all are protected under the current law. “But the newly proposed rule could land them in trouble,” Sprigman continues. “Which is potentially quite bad. Companies wouldn’t be able to create new trends. And this means people will become less and less likely to buy. So, on the whole, the absence of IP law is good for the fashion industry. They have an innovation dynamic that depends on setting trends, and trends depend on copying. And we have a really good system of nonlaw that protects that.”

Hearings took place July 27 before the House Subcommittee on Courts, the Internet and Intellectual Property. But the bill still must be “marked up” before it goes to the full Judiciary Committee and then brought before the House. And the Senate would have to pass a similar bill, even though no such bill is in the works. If the present bill is not passed in both houses by November, when a new Congress is elected, it will have to be introduced again. “My guess is it will not get passed and there will not be action on it for a very long time,” Heimbold says.

Trade dress claims, which are based on the total image and packaging of a product, are tough to prove. One important case occurred in 1998 when Samara Bros., a line of children’s clothing, sued Walmart Inc. for selling knock-offs of a one-piece seersucker outfit decorated with appliqués of hearts, flowers, fruits and the like. Samara argued that the appearance of the sequins on its apparel was distinctive because of its application on the appliqués.

See FASHION on page 12

EXPERT TESTIMONY
<< CONTINUED FROM PAGE 10

back to the 19th century, of enacting laws to protect textiles, and of Britain imitating those laws because there was intense competition throughout the Industrial Revolution.

THR, ESQ.: What is the status of attempts to enact similar laws in the U.S.?

Scafeldi: There were attempts back in the early part of the 20th century to get this legislation passed. The problem is, early in this industry the U.S. established itself not as a nation of original designers but as a nation of copiers, so there was a great deal of resistance. What the legal profession has done in the U.S. over the past half-century, in the absence of direct protection for fashion design, is cobble together some protection from other areas of intellectual property. So trademark protection, trade dress protection, trade dress protection for “separable” designs — patterns that may be printed on the surface of a dress, for instance, and that are conceptually separable from the item itself — all those things are in place to protect fashion design, even though we have never been able to protect the core of the design itself.

THR, ESQ.: Where does the bill pending in Congress stand?

Scafeldi: The bill introduced in the House would enact short-term registered protection for fashion designs themselves. If it passes, it would give three years of protection, but only if the designer registers the item through the Copyright Office. What’s interesting is, there have been no manufacturers or retailers who have openly declared themselves against the bill. And I was quite surprised that the members to whom I spoke seemed very interested in the bill and indeed very favorably inclined.

THR, ESQ.: But critics of the bill argue that fashion moves so quickly it can stay ahead of the copyists.

Scafeldi: My view is: Individuals are being harmed, and if an individual designer is being knocked off so rapidly that he or she can’t recover the expenses of creating new designs, that is a huge loss. (Furthermore), three years is a very short and reasonable amount of time.

THR, ESQ.: Do legislators take that seriously, though?

Scafeldi: Fashion design is a disfavored medium for a number of cultural reasons. This goes back to the Enlightenment, when it was seen as a visual medium rather than a verbal one and a craft rather than an art. Things created for utility have been disfavored in the intellectual property system, which in copyright began with the protection of writing only. But fashion, in this cultural moment, has become more recognized as a creative expression. And part of the reason for this new law is that fashion design is now a respected profession.

Fashion

Continued from page 11—

That case went all the way to the U.S. Supreme Court. “And what the Supreme Court said was: As a matter of law, those types of articles are not protected under trade dress unless the owner of the so-called trade dress can prove that the item has a secondary meaning,” Heimbold explains.

But this level of uniqueness goes way beyond that of most apparel. Thus, in effect, the Supreme Court said, in Berman’s words: “Copyright is not available to you fashionable people; it is only available if you have something very distinctive. And in the fashion industry, that is incredibly rare.”

Which may seem surprising given just how much apparel there is. The NPD Group, a private research firm that provides global information to manufacturers and retailers, says that total U.S. apparel sales in 2005 were $181 billion, of which women’s apparel made up $101 billion and men’s apparel $53 billion.

Springman says the worldwide apparel industry sells $1 trillion in goods each year.

Few experts will even hazard a guess as to how much of this business is counterfeit. But all agree it is in the billions. The U.S. Chamber of Commerce estimates that counterfeiting and piracy in all industries cost the U.S. $200 billion-$250 billion annually and estimates losses to the apparel industry at $12 billion a year.

To combat this in the fashion world, most major brand names such as Gucci or Hermes devote a substantial amount of their budgets to fighting counterfeits, just as the major studios fight piracy.

“It is not uncommon to see over 1% of gross revenue going to enforcement,” Heimbold says. He alone files up to 20-30 lawsuits per year on behalf of some of the brands he represents, in different countries around the world.

Nor has the growth of the Internet helped.

“We have automated Internet searches that go after infringers, particularly on places like eBay and Overstock.com,” Heimbold says. “Under the Digital Millennium Copyright Act, they have to provide an efficient mechanism for brand owners to cancel auctions that they have good-faith belief are counterfeit. In over 90% of cases, we never hear from the sponsors of cancelled auctions.”

7) For All Mankind’s Kolsun estimates that she shuts down some 10,000 Internet auctions every month and also uses 10 separate private investigators to look into counterfeiting.

But beyond matters of law, she says, the fashion industry has to deal with the problem of enforcement.

“There’s not enough being done,” she says. “But it’s hard to blame them when they are dealing with drugs and terrorism and things like that.”

Kolsun, Heimbold and their colleagues, along with representatives of the International AntiCounterfeiting Coalition, regularly train customs officers to recognize counterfeit goods when they see them.

“The luxury goods and fashion companies spend a lot of time and effort on the problem,” IACC president Nils Montan says. “Everybody is starting to get organized, and there is going to be more consistent coordinating in the next five to 10 years.”

But will it be enough? Even Montan admits his efforts can seem paltry when compared to the scale of the problem.

“The government is great at passing good laws; I give them an A+ for that. But I give them a B+ or a C- in putting resources behind the problem. Last year, Customs seized $93 million in counterfeit goods out of a total trade worth billions or even trillions. That’s nothing.”