"In 1986, when I married, the bridal gown du jour was the one worn by Diana, Princess of Wales -- a silk and taffeta confection with bows trimming the neckline and a 25-foot train. Diana, who had married five years earlier and was my age seemed to live a real-life fantasy. I bought a copy of her dress, sans train, for $1,500 at Kleinfeld, the Brooklyn bridal shop. While I took my vows under a chuppah at the Garden City Hotel on Long Island, no St. Paul’s Cathedral, I half hoped the royal lineage of my gown might make my dreams come true."  

I. Introduction

The bridal industry thrives on fairytale-esque sentiments such as Ms. Hayt’s. In an American society where credit card debt mounts and the per capita GDP is only $43,500, the average cost of a wedding soars to $25,000. The piece de resistance, the bride’s gown, is at the heart of the wedding fairy tale, and is often painstakingly chosen in what has been called “the Olympics of shopping.”

Entire wedding budgets are often built around brides’ “dream dresses,” which, on average, claim four

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* Ms. Torelli received her B.S. from Cornell University in 2004, and is expected to receive her J.D. from Albany Law School of Union University in May 2007.
1 Elizabeth Hayt, Great Dress, Dear. Did You Make It Yourself?, N.Y. TIMES, April 23, 2000, at 91.
5 Id. at 17.
to ten percent of the entire budget. Assuming the stated average total wedding cost of $25,000, this equates to a dress budget of between $1,000 and $2,500.

Like most consumer goods industries, the bridal gown industry is stratified: in quality, in originality, and in cost. “Low end” manufacturers like David’s Bridal and Da Vinci manufacture hundreds of relatively inexpensive copies of popular styles available to brides from every walk of life. For the un-initiated into the bridal industry, gowns retailing for less than $800 are considered “relatively inexpensive.” Mid-price range gowns retailing for around $1,000 begin to feature higher quality materials, and represent the lower end of designer originals. A third tier, featuring generally well-made original gowns by designers such as Alvina Valenta, Amsale, Eve of Milady, Oscar de la Renta, and Vera Wang, caters to the most discerning bride, willing to spend upwards of several thousand dollars for a dress she’ll wear for mere hours.

To some extent, the relative price differences between the three tiers are attributable to the quality of workmanship and materials used in creating the dresses. The sometimes-four-figure price gap between some of the more economical bridal styles and original couture bridal fashions,
however, can only be explained by the currency of design: “[b]ridal designers come and go like pop stars. … Most styles are only in production for a short time.”\textsuperscript{13} For this reason, many bridal designers have sought a variety of forms of intellectual property protection in an effort to corner the clearly lucrative market when they hit upon a hugely popular style. In an effort to exclude such copycats as David’s Bridal from the spoils, designers have scrambled to secure protection in the form of copyrights, trade dress claims, and design patents for their time and effort investments in fabric, concept, and technique research.\textsuperscript{14} As will be discussed in the course of this paper, however, protection of gown designs is neither necessary to the market success of bridal gown designers, nor is it appropriate for the subject matter. Part II of this paper provides additional background on the bridal industry. Part III describes various forms of intellectual property protection and discusses their salience to the bridal industry. Finally, Part IV concludes that bridal gown design does not fit into the ambit of any of copyright, trade dress, or design patent protection. As a result, it suggests that before courts allow designers to push the bounds of design protection, inquiry should be made into whether such extension of protection is appropriate. This paper concludes that, because of the looseness of the connection between art and design, and because of the demonstrated market demand for both original designs and copies, such protection is not appropriate and should not be extended to bridal gowns.

\textbf{II. A Picture of the Bridal Industry and Its Pressures}

Beneath the fluff of tulle and lace, the bridal fashion industry is intensely competitive.\textsuperscript{15} Designers vie for the opportunity to sell what will likely be the single most expensive and most

\textsuperscript{13} Denise & Alan Fields, supra note 4, at 90.

\textsuperscript{14} Eric Wilson, O.K., Knockoffs, This Is War, N.Y. TIMES, March 30, 2006 at G1 (discussing the position of the Council of Fashion Designers of America that the high cost of fashion is justified by the time and effort that designers spend researching fabrics, ideas, and techniques, and that, consequently, it is patently unfair for people who copy their designs to profit from their investment.).

\textsuperscript{15} Shelly Hagan describes bridal stores as “brutally competitive” with each other, resorting to plying brides-to-be with champagne to make a sale. SHELLY HAGAN, THE EVERYTHING WEDDING BOOK, 3RD ED. 106 (Adams Media) (2004).
carefully chosen article of clothing that a bride-to-be will ever buy or wear. In an effort to succeed in the industry, bridal manufacturers, designers, shop owners, and personnel cater to the emotion and excitement that brides-to-be bring to their quests for their perfect dress.

Depending on the type of bridal shop or salon that a bride-to-be patronizes, she is likely to have a dramatically different experience. Brides who visit large, relatively low-end stores like David’s Bridal are likely to try on a myriad of different styles of gowns. In each dress, the bride is likely to be photographed by excited mothers, friends, or relatives, so that she can remember each style she tried on, review the gowns at her leisure, and more objectively determine which design elements she finds most flattering, and which gown she ultimately wishes to purchase.

Brides who visit salons proffering higher end original couture designers’ fashions, however, often meet with a much different experience. Salons usually prohibit brides from photographing any of the dresses before purchase, and many guard the identity of the dress’s designer, going to such lengths as removing tags from the dresses before brides try them on. These salon practices, regarded as frustrating and unethical by many brides, and as illegal by the Federal Trade Commission, are part of an effort to pass off lower quality dress copies as the upscale originals, and to prevent originals from price-shopped or reproduced at a lower price.

Designers are also working to prevent copies of their styles from appearing at lower prices: one designer of original bridal fashions includes a hang tag on her dresses warning purchasers and

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16 The average cost of a bridal gown in most stores is about $1,025. Denise & Alan Fields, supra note 4, at 18.
17 According to Denise & Alan Fields, 40% of brides purchase their gowns at bridal shops, 30% at David’s Bridal, 12% from department stores, 10% have their gowns made, 2% wear family heirloom gowns, 2% rent dresses, and 3% buy through a discount online service or mail order. supra note 4, at 18.
19 Denise & Alan Fields, supra note 4, at 48-49.
20 See, FEDERAL TRADE COMMISSION BUREAU OF CONSUMER PROTECTION OFFICE OF CONSUMER & BUSINESS EDUCATION, Wedding Gown Labels: Unveiling the Requirements 1-2 (1999), http://www.ftc.gov/bcp/conline/pubs/buspubs/wedgown.pdf (requiring bridal gowns to bear sewn-in labels identifying "any one business in the distribution channel, the fiber content of the gown, the gown’s country of origin, and care instructions).
21 Denise & Alan Fields, supra note 4, at 48-49 (discussing such bridal industry practices, and reasons brides should avoid purchasing a dress with removed tags, including price gouging, fabric fraud, and sweatshop labor).
retailers that the dress design is copyrighted, and that the company is prepared to sue unauthorized reproducers to protect its interests.\textsuperscript{22} It remains to be seen whether or not the dress is actually protectable under copyright law,\textsuperscript{23} but the scare tactic is nonetheless useful.

Designers are fighting against unauthorized style reproductions on two fronts. Less economically important is the business done by individual seamstresses producing single custom copies of original works. The more significant front is the commercial mass-reproduction front. In this scenario, manufacturers wait for designers to release new gown styles, predict which styles will become popular, develop a copy of the style, and begin mass producing the copy. Often, sales volume of the copies may eclipse the designer originals. Allen B. Schwartz, known as “the uncontested champion of red-carpet knockoffs,”\textsuperscript{24} is known for copying the fashions of designers such as Dior, Versace, Michael Kors, and Vera Wang, and mass producing his interpretations of the original designs that are “subtly altered to the tastes, and the measure, of a mainstream consumer.”\textsuperscript{25}

In 1999, Schwartz sold 80,000 copies of the dress that Carolyn Bessette Kennedy wore to her 1996 wedding.\textsuperscript{26} The original was designed for Kennedy by her close personal friend, designer Narciso Rodriguez, who achieved instant fame for his work.\textsuperscript{27} Rodriguez went on to win many awards for his designs, including 1997 Best New Designer at the VH1 Fashion Awards and 1997 Hispanic Designer of the Year, the 1998 CFDA (Council of Fashion Designers of America) Perry Ellis Award, and 2002

\begin{itemize}
\item \textsuperscript{23} \textit{See infra} § III.A.
\item \textsuperscript{24} Ruth La Ferla, \textit{Night of a Thousand Knockoffs}, \textit{N.Y. Times}, March 9, 2006 at G11.
\item \textsuperscript{25} \textit{Id.} As Susan Hosen, Director of Sales for Allen B. Schwartz designs notes, “[n]ot everyone is a size 2, so we might raise a neckline or change the fit by adding zippers, bust darts and little nip and tucks here and there.” \textit{Id.}
\item \textsuperscript{26} Elizabeth Hayt, \textit{supra} note 1.
\item \textsuperscript{27} Carolyn Bessette Kennedy’s dress has been said to have brought Rodriguez “front and center stage in the design world.” \textit{Fashion Designer Narciso Rodriguez}, \textit{PR News Now: News at the Speed of Now}, \url{http://www.prnewsonline.com/PR%20News%20Releases/Lifestyle/Fashion/Fashion%20Designer%20Narciso%20Rodriguez} (May 11, 2005). Rodriguez’s design, melding “dress elegance, classiness, and sexiness into one knockout package” has also been described as “the buzz around the world … a whole new concept, never heard of before,” and “made Narciso’s a household name.” \textit{Id.}
\end{itemize}
and 2003 Womenswear Designer of the Year honors, while Schwartz enjoys the profits.

The high fashion industry, from which bridal designers draw much of their inspiration, is somewhat split on the need for protection from “piracy” of original fashion designs. Blatant copycats like Schwartz maintain that “[t]here is no such thing as an original design. All these designers are getting their inspiration from things that were done before … a spaghetti strap is a spaghetti strap, and a cowl neck is a cowl neck.” Others, including Rodriguez, joined in his sentiment by designers Diane von Furstenburg and Zac Posen, and Stan Herman, President of the CFDA, feel differently. As Valerie Salembier, publisher of Harper’s Bazaar, succinctly characterizes it, such copying is “stealing at the expense of creativity.” As an example, one of Rodriguez’s dresses which retailed for $1,500 was recently copied and sold at Macy’s for $199.

The fashion industry, which can be described as “only casually regulated by copyright law,” thus features a dichotomy of opinions as to the practice of design copying. While designers generally favor the institution of reliable protection for their work, others in the industry feel that added protection is either unnecessary or impractical. Lesley Jane Seymour, Editor in Chief of Marie Claire magazine, claims that “shoppers understand -- and generally approve [of] -- how fashion offers them expensive runway originals alongside lower-price versions of the same styles.” She also notes that “[i]f you go into any department store, you can take the elevator to one floor and see the designer look and then take the elevator to the next floor and see the interpreted look. The two

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28 Fashion Designer Narciso Rodriguez, PR NEWS NOW: NEWS AT THE SPEED OF NOW, supra note 27.
29 Cf. Elizabeth Hayt, supra note 1 (quoting Allen B. Schwartz, who claims that “[his] dresses are better than the originals. They’re more forgiving, less risky. They’re a good fit at a good price. Movie stars and suburban housewives buy our clothes. Nobody in the real world wears the real dresses.”).
30 SHARON NAYLOR, 1000 BEST SECRETS FOR YOUR PERFECT WEDDING 96 (Sourcebooks, Inc.) (2004) (noting that “[t]he trend in wedding gowns is now moving outside the traditional lines and laces and formal princess styles to borrow design elements from high fashion. What you’ll see on the runways at bridal fashion shows and in bridal magazine photo spreads looks more like a great line of stylish … dresses than the traditional wedding gowns.”).
31 Eric Wilson, supra note 14 (quoting Narciso Rodriguez).
32 Id. (quoting Allen Schwartz).
33 Id.
34 Id.
35 Ruth La Ferla, supra note 24.
36 Eric Wilson, supra note 14.
don’t compete to each others’ exclusion.” Designer Jeffrey Chow presents a different argument for not attempting to secure copyright protection for dress designs. “How do you copyright fashion design?” he asks, bringing up a valid point. “It’s not like a typeface or a song. There are no boundaries in fashion,” which would enable infringement analyses to be conducted with any predictability. While some may assume that designers espousing Mr. Chow’s viewpoint are merely sour grapes because they have not yet succeeded in creating designs “worthy” of being knocked off to great commercial advantage, Mr. Chow’s $1,000 blush colored satin dress was featured in the November 2004 Marie Claire magazine’s monthly “Splurge v. Steal” section alongside its $245 duplicate by Allen Schwartz.

Still others note that in social circles in which designer originals are the standard, those in the know can tell the difference between originals and copies, allowing originals to retain their hold on the upscale market:

“I had to fix your dress,’ purred Jill Swid, a style editor at Mirabella, in a stunning black Christian Dior gown. ‘I know it’s not Vera [Wang].’

‘How could you tell?’ [Elizabeth] asked glumly[, wearing an Allen Schwartz copy of a Vera Wang gown] …

‘The fit, the fabric and those clips,’ she sniffed. ‘They are definitely not Fred Leighton.’

‘Those clips are very crackerjack,’ added her date, Jim Brodsky, president of Sharp Communications. ‘We figured your dress was from Strawberry.’

That did it. In certain circles where status and style are closely scrutinized, copies still don’t cut it.”

Thus, it is not clearly established that a need truly exists for protection of gown designs to ensure the success of designers. Before resolving the question, however, we will consider whether such protection is even fairly possible.

III. Intellectual Property Protection Options for Gown Designers

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37 Id.
38 Id. (quoting Jeffrey Chow).
39 Id.
40 Elizabeth Hayt, supra note 1.
A. Protection of Gowns under Copyright Law

1. Establishing a cause of action for copyright infringement

A copyright is only useful to a designer to the extent that it is enforceable to protect his interests. In order to establish a cause of action for copyright infringement, a plaintiff designer would have to prove that he owns a valid copyright for the design and that the defendant infringed that copyright by copying without authorization. Valid copyright protection is securable for “original works of authorship fixed in any tangible medium of expression” under the Copyright Act. These “works of authorship” are divided by statute into eight enumerated categories of works, including literary works; musical works; dramatic works; pantomimes and choreographic works; pictorial, graphic, and sculptural works; motion pictures and audiovisual works; sound recordings; and architectural works. In order to obtain copyright protection, a work must fit within one of these categories. Arguably, bridal gowns could best be shoehorned into the “pictorial, graphic, and sculptural works” enumeration by framing the dress as a “wearable sculpture.” This classification is much easier considered than applied, however. The useful articles doctrine, discussed below, provides a potential barrier to protection.

The second prong of a copyright infringement analysis is a determination of whether infringement of a valid copyright has occurred. To show infringement, a plaintiff designer must prove that his or her work was actually copied by proving that the accused copier had access to the original work, “substantial similarity between the works,” and “that this copying constituted an ‘improper’ or ‘unlawful’ appropriation through proof that ‘substantial similarities related to

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43 Id. at § 102(a)(1)-(8).
45 See infra § III.A.2 for a discussion of the useful articles doctrine.
The standard for determining whether substantial similarity exists is whether “the ordinary observer, unless he set out to detect the disparities, would be disposed to overlook them, and regard their aesthetic appeal as the same.” Where designs contain both protectable and unprotectable elements, the fact finder must ignore any similarity (or dissimilarity) in unprotectable elements and “overall impressions” of the work as a whole in determining whether unlawful appropriation of protectable material occurred.

2. Copyrightability of Clothing Designs and the Useful Articles Doctrine

The useful articles doctrine, codified at § 113(b) of the Copyright Act, has been the subject of much litigation, and has frequently denied clothing designers protection for their designs. It includes specific provisions limiting protection for “useful articles,” which, to borrow a definition from the Patent Act, can be described as “article[s] having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information.” Although the legislative history of § 113(b) of the Copyright Act does not articulate a specific justification for the useful articles doctrine, the explicit exclusion of “useful articles” from copyright law and their explicit inclusion in patent law clearly lays out the types of subject matter which are appropriately protectable under copyright law and patent law. In this way, Congress limits individuals’ ability to use copyright law to gain a monopoly on designs that are dictated by the function served by the article. This prevents a manufacturer or designer from using copyright law to unfairly obtain a monopoly on a certain type of product, a grant more appropriately accomplished by a patent. Consequently, the “[t]he Copyright Office has generally refused to register claims to copyright in three-dimensional aspects of clothing

47 Id. at 487 (quoting Laureyssens at 139-40).
49 Laureyssens, 964 F.2d at 141.
50 See, 17 U.S.C. § 113(b) (2000) (“This title does not afford, to the owner of copyright in a work that portrays a useful article as such, any greater or lesser rights with respect to the making, distribution, or display of the useful article so portrayed than those afforded to such works under [federal or state] law.”).
or costume design on the ground that articles of clothing and costumes are useful articles that ordinarily contain no artistic authorship separable from their overall utilitarian shape.”

The concept of separability has its origins in the Supreme Court’s decision in Mazer v. Stein, and was subsequently adopted by Congress. It requires the finder of fact to look at an item for which copyright protection is claimed, for instance, a wedding gown, and ask whether “the shape of … [the] dress … contains some element that, physically or conceptually can be identified as separable from the utilitarian aspects of that article.” Under a physical separability analysis, if the pictorial, graphic, or sculptural elements of the dress can be removed from the functional portions of the dress and displayed separately, as a floral handle design might be removed from silver flatware for display, the pictorial, graphic, or sculptural elements may be protectable under copyright law. Conceptual separability, another way of looking at the doctrine, tests whether the artistic elements are “primary,” and the utilitarian function of the article is “secondary,” a hurdle which clothing designs rarely clear. The difficulty is that “the majority of skill in designing clothing lies in determining the correct shape and fit of the clothing,” which “cannot be physically separated from

55 Mazer v. Stein, 347 U.S. 201, 218 (1954) (holding that a sculptured base of a lamp could be the subject of copyright protection because the sculpted base, when separated from the lamp, constituted artistic work).
57 Id.
59 H.R. Rpt. 94-1476 at 55 (reprinted in 1976 U.S.C.C.A.N. at 5668). Congress cited silver flatware featuring a floral design on the handle as an example of physical separability. “The design of the eating utensil part of the flatware, being a useful article that does more than convey its appearance or information, is not protected, but the floral design itself is protected. Therefore, a copyist could produce floral flatware nearly identical to the original without fear of infringement, so long as the handle incorporated a sufficiently different floral design and the flatware was not otherwise protected under design patent or trademark law.” Anne Theodore Briggs, Hung Out to Dry: Clothing Design Protection Pitfalls in United States Law, 24 HASTINGS COMM. & ENT. L.J. 169, 182-183 (2002) (citing H.R. Rpt. 94-1476 at 55 (reprinted in 1976 U.S.C.C.A.N. at 5668)).
60 H.R. Rpt. 94-1476, supra note 59 at 55. The functional portions of the work may never obtain protection under copyright law. Id.
61 Kieselstein-Cord v. Accessories by Pearl, Inc., 632 F.2d 989, 993 (2d Cir. 1980). This is one of a number of definitions of the conceptual separability test. Another, put forth by Judge Newman in his dissent in Carol Barnhart, Inc. v. Economy Cover Corp., inquires into whether “the article [stimulates] in the mind of the [ordinary, reasonable] beholder a concept that is separate from the concept evoked by the utilitarian function.” 773 F.2d 411, 442 (2d Cir. 1985) (Newman, J., dissenting). Yet another was delineated in Brandir International, Inc. v. Cascade Pacific Lumber Co., see infra at note 69.
the clothing itself,” and is “difficult, if not impossible, to separate conceptually.” Still, there have been a few judicial decisions which have found that pictorial, graphic, or sculptural elements in an article of clothing were protectable, including a cable design in a sweater, a geometric design printed onto fabric, a screen printed image on a shirt, and a belt buckle design. Interpreting the useful articles doctrine, the First Circuit has upheld an issued copyright registering a knitwork fabric design with unique color combinations and patterns, and stitching patterns with distinctive “southwestern” and “primitive” motifs. The designs themselves, found to be separable from the sweaters, were found to be protectable.

In *Whimsicality v. Rubie’s Costume Company*, the Second Circuit applied its own conceptual separability test, originally formulated in *Brandir International v. Cascade Pacific Lumber Co.*, to Halloween costumes. This test turns on whether or not the design elements can be said to reflect the designer’s artistic judgment, or whether they merely reflect the functional influences on the object. In *Whimsicality*, the Halloween costumes were not found to be protectable because “the very decorative elements that stand out [in the costumes are] intrinsic to the decorative function of the clothing.” If applied to wedding gowns, this language could be disastrous to a claim for copyright protection. One year later, however, the Third Circuit decided a similar issue differently in *Masquerade Novelty, Inc. v. Unique Industries, Inc.* In that case, animal

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66 *Kieselstein-Cord*, 632 F.2d at 933 (2d Cir., 1980). “Two dimensional design[s] applied to the surface of the clothing may be registered” with the Copyright Office. 56 FR 56350-02, -56351 (Nov. 5, 1991), Copyright Office Notice [Docket No. RM 91-5A] Registrability of Costume Design.
68 Whimsicality v. Rubie’s Costume Co., 891 F.2d 452 (2d Cir. 1989).
69 *Brandir International*, Inc. v. Cascade Pacific Lumber Co., 834 F.2d 1142, 1148 (2d Cir. 1987) (holding that an S-shaped bicycle rack was not copyrightable because the shape was dictated more by the rack’s function than by the designer’s artistic judgment).
70 *Id.* at 1145.
71 *Whimsicality*, 891 F.2d 452 (2d Cir. 1989).
72 *Id.* at 455.
nose masks were held to be copyrightable as soft sculptures because their only utility was to provoke a humorous response in a human, which is a purpose served by many other types of copyrightable works.\textsuperscript{74} This, viewed in combination with the Second Circuit’s post-\textit{Whimsicality} holding in \textit{Knitwaves, Inc. v. Lollytogs, Ltd.}\textsuperscript{75} that although clothes are not copyrightable, designs on sweaters consisting of acorns and leaves are copyrightable because they constitute “writings;”\textsuperscript{76} could be viewed as the weak beginnings of a pro-original designer trend.

In the Ninth Circuit, clothing designers have met with mixed results when arguing that their works are best defined as something other than a useful article; that their creation just happens to fit the body. This argument was successful in \textit{Poe v. Missing Persons},\textsuperscript{77} although this is generally an exception to the rule. In \textit{Poe}, a designer created a swimsuit out of clear plastic filled with crushed rock for an art exhibition, and successfully sued for copyright infringement when a member of a rock band subsequently wore the suit on the band’s album cover.\textsuperscript{78} In finding for the designer, Ninth Circuit’s analysis focused on expert testimony, the creator’s intent at the time of creation of the work,\textsuperscript{79} custom and usage in the art trade regarding articles like the one in question, and the marketability of the item as a work of art.\textsuperscript{80}

Six years later, however, the pendulum swung the other way, in the Ninth Circuit’s decision in \textit{Lim v. Green}.\textsuperscript{81} In \textit{Lim}, a designer claimed that the “scarf cap” that he designed for motorcycle riders was a “soft sculpture,” as opposed to a useful article. The Ninth Circuit disagreed, holding

\footnotesize{\textsuperscript{74} \textit{Id.} at 669-71 (noting that “[t]he utilitarian nature of an animal nose mask or a painting of the crucifixion of Jesus Christ inheres solely in its appearance, regardless of the fact that the nose mask’s appearance is intended to evoke mirth and the painting’s appearance a feeling of religious reverence.”).

\textsuperscript{75} \textit{Knitwaves, Inc. v. Lollytogs, Ltd.}, 71 F.3d 996 (2d Cir. 1995), aff’d, 1996 U.S. App. LEXIS 30737 (2d Cir. Nov. 22, 1996).

\textsuperscript{76} \textit{Knitwaves, Inc.}, 71 F.3d at 1002.

\textsuperscript{77} \textit{Poe v. Missing Persons}, 745 F.2d 1238 (9th Cir. 1984).

\textsuperscript{78} \textit{See id.}

\textsuperscript{79} The inquiry into creator’s intent goes to whether the creator intended to create a work of art that just happens to look like clothing, or whether the creator intended to create an article of clothing that just happens to be recognized by some as art. \textit{Id.} at 1243.

\textsuperscript{80} \textit{Id.}

\textsuperscript{81} \textit{Lim v. Green}, 2000 U.S. App. LEXIS 29291 (9th Cir. Nov. 13, 2000).}
that it was a useful article, by virtue of the fact that Lim had designed it with the intent to market the product to Harley Davidson and ultimately cause the cap to be mass-produced. \textsuperscript{82} Thus, the holding in \textit{Lim} effectively limits the Poe exception to the useful article doctrine for artistic clothing designs to exclude works that are mass produced or designed with the intent that they someday could be. Since nearly all bridal gowns are produced for some level of mass distribution, it appears that the argument under Poe that a bridal gown is art which just happens to fit the body will not prove to be a viable source of protection. \textsuperscript{83}

3. Copyrightability of Bridal Gowns (and Elements Thereof) Specifically

The Southern District of New York has seen the majority of litigation over copyright protection of bridal gowns specifically. In the mid 1990’s, Eve of Milady (hereinafter, “Milady”) commenced an action against Impression Bridal, alleging that Impression had infringed several of plaintiff’s lace pattern copyrights. \textsuperscript{84} Eve Muscio, who does business as “Eve of Milady,” designs and sells original bridal gowns incorporating original lace designs. These lace designs were protected by valid United States copyright registrations, and were not licensed to any other company. Milady’s gowns were distributed to a limited number of retailers in a local market, and promoted as “limited edition” dresses to increase appeal to brides. \textsuperscript{85} Milady alleged that for some time, defendant Impression Bridal, a competing gown manufacturer, had been selling copies of Milady gowns. Milady asserted that initially, they did not act, believing Impression’s dresses to be of sufficiently low quality to not pose a market threat, but eventually determined that action was necessary after Impression created and sold copies of all five of Milady’s magazine-advertised gown styles from the

\textsuperscript{82} Id. at *3.
\textsuperscript{83} The only gowns which could still be protectable after Lim, in theory, would be designer one-of-a-kind originals produced for celebrity brides, and never released for public sale.
\textsuperscript{85} Eve of Milady I, 957 F.Supp. at 488.
Fall 1995 line, each of which incorporated a lace design for which Milady held a valid copyright.\textsuperscript{86}

In the first prong of the copyright infringement analysis, the Southern District of New York found that Milady’s lace design copyrights were valid,\textsuperscript{87} noting that “lace designs are a form of fabric designs,” which are protectable in the Second Circuit under \textit{Knitwaves}.\textsuperscript{88}

In the second phase of the analysis, the issue of whether copying actually occurred, Milady was again successful. To show actual copying, Milady was required to show that the dresses were “actually copied by proving ‘access and substantial similarity between the works’” and “that this copying constituted an ‘improper’ or ‘unlawful’ appropriation through proof that ‘substantial similarities related to protectable material.’”\textsuperscript{89} On the issue of access to the designs, the court found that Milady met its burden of showing that Impression had access to Milady’s copyrighted lace designs. Because public display of a product can give rise to an inference of access,\textsuperscript{90} it is enough to show that the defendant merely had an \textit{opportunity} to view the copyrighted work.\textsuperscript{91} Milady was able to show access relatively easily by showing that Impression had the opportunity to view Milady’s advertisements in \textit{Bride’s} magazine, and that it also had the opportunity to purchase one of plaintiff’s dresses to deconstruct and copy it.\textsuperscript{92} It was not necessary for Milady to prove that Impression actually did view the advertisements or purchase a gown.\textsuperscript{93}

As to the question of substantial similarity, the court noted that “[a]lthough the idea of using a lace design is not entitled to copyright protection, a particular expression of the idea of using a lace

\textsuperscript{86} \textit{Id.} (noting that Eve of Milady’s Style 1223 was advertised in the December 1995/January 1996 issue of \textit{Bride’s} magazine, and all five gowns were advertised in the February/March 1996 issue of the same. Between then and spring of 1997, Impression advertised, sold, and filled orders for dresses that were remarkably similar to Milady’s five dresses introduced in the fall of 1995 and the following winter).

\textsuperscript{87} Although a certificate of copyright registration creates a presumption of copyright validity, the presumption may be rebutted “where other evidence in the record casts doubt upon the question.” \textit{Fonar Corp. v. Domenick}, 105 F.3d 99, 104 (2d Cir. 1997).

\textsuperscript{88} \textit{Eve of Milady I}, 957 F.Supp. at 489. \textit{Knitwaves, Inc. v. Lollytogs, Ltd.} is discussed \textit{infra} at notes 75-76 and accompanying text.

\textsuperscript{89} \textit{Eve of Milady I}, 957 F.Supp. at 487 (quoting \textit{Laureyssens}, 964 F.2d at 139-40).

\textsuperscript{90} \textit{Id.} at 489.

\textsuperscript{91} \textit{Wildlife Express Corp. v. Carol Wright Sales, Inc.}, 18 F.3d 502, 508 (7th Cir. 1994) (emphasis added).

\textsuperscript{92} \textit{Eve of Milady I}, 957 F.Supp. at 489.

\textsuperscript{93} \textit{See Wildlife Express Corp.}, 18 F.3d at 508.
design is copyrightable.” In order to determine “how far an imitator must depart” from the original design, the fact finder must “consider the uses for which the design is intended, especially the scrutiny that observers will give to it as used.” Here, the court noted that “[t]he use of lace designs in a bridal gown will garner careful scrutiny by the bride who purchases and subsequently wears the gown, as well as by those who admire her when she wears the gown.” Under those circumstances, the court held that Impression’s use of the lace was similar enough to Milady’s, in both design of the lace and its placement on the gown, that it was not likely that either a retailer or a bride would be able to find any substantial difference between the dresses based on a magazine advertisement. Therefore, Impression’s use was found to amount to unlawful appropriation of Milady’s lace design. Notably, the court was not impressed with Impression’s argument that Milady’s copyrighted lace designs comprise “an insignificantly small percentage of the entire dress,” as the lace was found to be “a critically important and distinguishing feature of the bridal dress.” Ultimately, the court ordered an injunction against future sales and advertisement, but denied plaintiff’s request for a recall of all dresses that had been ordered.

A few months later, Milady and Impression Bridal were back in court, after Milady asserted that Impression’s “revised” designs pursuant to the injunction still infringed its copyrights. This time, neither the validity of Milady’s copyrights nor Impression’s access to the designs were in question as they had already been established, so the analysis consisted entirely of investigation into the similarity of the two designs. The court conducted three in camera reviews, comparing: Impression’s “revised” lace pattern with Milady’s lace pattern, photos of Impression’s dresses with

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94 *Eve of Milady I*, 957 F.Supp at 489.
95 *Id.* at 489.
96 *Id.* at 490.
97 *Id.*
98 *Id.*
99 *Id.* at 490 n.5.
100 *Eve of Milady I*, 957 F.Supp. at 490.
photos of Milady’s dresses, and Impression’s actual dresses with Milady’s actual dresses.\textsuperscript{102} The court found that Impression had revised its lace patterns such that only one of the five lace patterns was still “substantially similar” to Milady’s, but that

“when viewed on the dresses themselves, the slight discrepancies between the lace patterns are eclipsed by the almost total likeness in the arrangement and placement of the designs on the dresses, which as stated earlier are elements of the plaintiffs’ protectible [sic] work. Even a quick visual inspection of the bridal dresses shows that the arrangement and placement of lace on the arms, neck, shoulders, waist and hem line of defendants’ dresses almost exactly replicates the plaintiffs’ arrangement and placement of their lace designs.”\textsuperscript{103}

The court held that Eve of Milady had sustained its burden for showing substantial similarity, and the injunction re-issued.\textsuperscript{104}

In another copyright infringement action between two lace makers, the Southern District of New York quickly established that the defendant had access to the plaintiff’s copyrighted designs, and focused its fact investigation on whether the two competitors’ lace designs were substantially similar.\textsuperscript{105} The court characterized disparities between the parties’ laces as “immediately obvious,” noting that Imperial’s lace design featured significantly larger holes, making it easier to see through Imperial’s lace pattern, and the presence of a more reticulated liner in Westchester’s design.\textsuperscript{106} Consequently, the court determined that the designs were not substantially similar, hence there was no infringement. In dictum, the court noted that altering the scale of a design does not excuse what would otherwise constitute copyright infringement.\textsuperscript{107}

Taken together, the \textit{Eve of Milady} and \textit{Imperial Lace} cases appear to be promising for gown designers seeking increased protection from copying. To summarize the decisions, it seems that lace designs as well as the placement of lace on the gowns are protectable, but that as between two lace

\begin{flushleft}
\textsuperscript{102} \textit{Id.} at 161.
\textsuperscript{103} \textit{Id.} at 162.
\textsuperscript{104} \textit{Id.}
\textsuperscript{106} \textit{Id.} at *3.
\textsuperscript{107} \textit{Id.} at *3 n.6 (citing L. Batlin & Son, Inc. v. Snyder, 536 F.2d 486, 489 (2d Cir. 1976)).
\end{flushleft}
designs, the differences between them must be significant in order to defeat a claim of copyright infringement. A third *Eve of Milady* case illustrates, however, that perhaps the weak trend described above favoring designers is not bankable, not only because it flies in the face of nearly all incarnations of the physical and conceptual separability tests, but also because the analyses are not possible to conduct with the necessary degree of predictability.

Although a few aspects of clothing design have passed copyright muster, including fabric and lace designs, the distinction between protection for embellishments or the fabric itself and protection for clothing incorporating those embellishments and fabric is very muddy. In an off-the-record analysis in *Eve of Milady v. Moonlight Designs, Inc.*, the court went beyond comparing the lace patterns used in designing the parties’ dresses, and compared the actual dresses themselves, including how full the skirts were, the necklines, the shape of the bodices, and the shape and embellishments of the sleeves, including observations that the sleeves of both dresses, “to the extent they can be called sleeves,” are adorned with “petaled [sic] flowers” with “virtually identical ribbed leaves similar to the veining in an insect’s wing.” While one commentator has suggested that such a thorough analysis of the dresses tends to show that dresses are not necessarily too difficult or subjective for judges to evaluate, it arguably also illustrates the many opportunities for judges to reach divergent conclusions. If judges must consider such elements as skirt fullness, neckline shape, and sleeve shape and embellishment, among countless other features with indefinite boundaries in

108 *See infra* notes 55-72 and accompanying text.
111 *Id.* at *13-31.
112 *See*, Anne Theodore Briggs, *supra* note 59, at 191 (claiming that “[t]his analysis tends to rebut the presumption that comparison of clothing designs as a whole is too difficult and subjective for judges to accomplish.”).
113 *See infra* note 38 (quoting designer Jeffrey Chow).
order to determine whether infringement has occurred, it seems unlikely that judges would be able to rule predictably and uniformly on so many subjective elements. Not only are determinations as to similarity of elements like lace design, skirt fullness and neckline subjective, but it would also be a subjective determination as to when small differences in those elements might be “eclipsed by the almost total likeness in the arrangement and placement of the designs on the dresses.”

Without a measure of predictability on these questions, copyright protection is not appropriate to attempt to mete out, not to mention worth very little to designers. Without fair, uniform application of protection, designers could be forced to lay out substantial capital to sue alleged infringers to protect their rights, but would have no way to predict the likelihood of a damages award which would recoup the designer’s litigation costs, and make the suit worth commencing. Such waste would become more of an albatross for the design industry than a boon—and suggests that perhaps the industry would fare better allowing the market, rather than the courts, to assign relative commercial values to original and copied designs.

B. Other Options for Design Protection

Due to the shortcomings of copyright law in protecting gown design, designers have turned to alternate forms of intellectual property protection. The two main alternatives, design patents and trade dress, however, are generally even less useful for designers than copyright protection, which is at best unpredictable and limited in scope.

1. Design Patents

Design patents are a form of intellectual property which combine elements of copyright, trademark, and patent protection for a term of fourteen years for successful applicants. As compared to copyrights, design patent protection demands a stricter threshold combination of originality, novelty, and non-obviousness for the patent to grant, and additionally requires that the

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114 Eve of Milady II, 986 F.Supp. at 162.
115 Anne Theodore Briggs, supra note 59, at 175.
design to be protected be ornamental rather than functional. The litmus test for functionality for design patents is similar to trademark law contexts: “the design of a useful article is deemed to be functional when the appearance of the claimed design is ‘dictated by’ the use or purpose of the article … 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.”

The inclusion of some utilitarian elements in a design will not necessarily result in a denial of protection, but the design as a whole must not be determined to have been dictated by the utilitarian function.

The biggest problem with using this form of protection for bridal gowns by presenting them as ornamental designs is the difficulty clothing designs face in overcoming the non-obviousness standard. As applied to clothing designs, including bridal gowns, the standard against which the design is measured is whether the design would have been obvious to a skilled dressmaker “who has, or is chargeable with, knowledge of the prior art.”

“[M]ore is required for a valid design patent than that the design be new and pleasing enough to catch the trade; it must be the product of ‘invention,’ by which is meant that conception of the design must demand some exceptional talent beyond the skill of the ordinary designer. This standard has been applied so strictly that “even new clothing designs that do not incorporate any known design elements can still fail to qualify for design patent protection. Even many avant garde couture bridal designers would be likely to often fail to clear this hurdle.

Even if a design patent did issue, there are still a number of drawbacks to this form of protection. First, they are difficult to defend: the standard for determining infringement of design patents is whether or not the accused design is so similar to the claimed design that “an ordinary

117 Anne Theodore Briggs, supra note 59, at 176.
118 Id.
119 Id.
120 Id.
122 Id. (citing Nat Lewis Purses, Inc. v. Carole Bags, Inc., 83 F.2d 475 (2d Cir. 1936)).
123 Anne Theodore Briggs, supra note 59, at 177.
observer would be likely to purchase one thinking it was the other,” considering the design in its entirety, and comparing the accused design with the claimed design -- rather than the commercial embodiment of the design in a product. This highly subjective standard is very difficult to enforce. The other substantial drawback to design patent protection is the relative expense of obtaining a design patent as compared to its commercial value. Prosecution of a design patent is likely to be an expensive prospect, between attorneys’ fees and assorted filing, search, examination, and issuance fees assessed by the PTO. This investment is not likely to be recouped in the fashion world, where the average clothing design’s lifespan is only one season, compared to the one to two year pendency of design patent applications. Additionally, in an infringement action, damages will not be awarded for sales by an infringer after a plaintiff has ceased manufacture of the design patent-protected item, regardless of whether the design patent is still in force at the time of the alleged infringement -- so the economic security of design patent protection is limited to the period of time during which the design is simultaneously protected, produced, and sold.

2. Trademark/Trade Dress Protection

Trademark protection, while attractive to designers of more generalized types of clothing,
proves relatively inapplicable to bridal gowns for two reasons. First, trademark protection is formulated to grant protection of indefinite term, so long as the “word, name, symbol, or device, or any combination thereof” is used as a designation of source or origin of the goods so marked.129 In the bridal gown industry, a term of protection of indefinite duration is of little value, since styles come and go so quickly. Second, the mark would have to be used to designate the source or origin of the gown in order to afford the designer protection. In an industry where the designer’s trademark would appear at most on an inner tag not visible while the gown is being worn, it is nearly impossible to secure trademark protection.

Trade dress protection, which may be afforded to packaging or dressing of a product or its actual design when such is used to designate source or origin of the product, is available under § 2 of the Lanham Act for registered marks130 and under § 43(a) for unregistered marks,131 but again, is of little utility to fashion designers. In order to achieve protection under § 43(a) (as protection under § 2 is unlikely for the reasons discussed above relative to trademark protection), a designer would be required by statute to show that her form of trade dress is nonfunctional, and that the accused infringer’s product is likely to cause confusion.132 Courts have also added the requirement that the trade dress be distinctive.133 Bridal gown designers would be likely to stumble at each of these three hurdles, particularly non-functionality, for many of the same reasons discussed above relative to design patents.

IV. Conclusion

As has been demonstrated, design patent protection and trademark/trade dress protection are ill-suited for the task of protecting the claimed intellectual property of bridal gown designers, and the

133 See Wal-Mart Stores, Inc., 529 U.S. at 210 (noting that “Nothing in § 43(a) explicitly requires a producer to show that its trade dress is distinctive, but courts have universally imposed that requirement, since without distinctiveness the trade dress would not ‘cause confusion… as to the origin, sponsorship, or approval of [the] goods,’ as the section requires.”).
use of copyright protection for the purpose is significantly flawed to the point of causing more waste than it endeavors to prevent. If no currently recognized form of intellectual property protection fits the needs of the industry, the question surfaces: does this mean that innovation is necessary, or that the industry is seeking protections which were not established, and with good reason? Should courts move toward refusing to stretch the definitions of “pictorial, graphic, and sculptural works” to include bridal gowns?

Copyright protection for gowns assumes a connection between fashion and art, the general category of subject matter which it was designed to protect. The concept of fashion as art, however, is not a popular one even within the industry, which defines itself with a note of functionality that art lacks: “The suspicion grows that the … definition of art/fashion is something so avant garde that it is unwearable … Genuine fashion must be functional and, therefore, can only be classified as applied art or craft. If a garment is not wearable, it is not fashion.” Many fashion designers do not view themselves as artists, either – they espouse different inspirations, different purposes. Tom Ford, a designer for Gucci and Yves Saint Laurent has gone so far as to say, “[w]hat I do is not art - it is a commercial creation. I’m the exact opposite of an artist; everything I do is about what is happening at the last possible second. Fashion is perishable.”

Designer Christian LaCroix has also noted a distinct difference between artists and designers: he notes that designers’ “work is only made to be

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136 Anne Theodore Briggs, supra note 59, at 188 (citing Snapshot: Introducing the Dutch Masters; Bored of Versace? Tiring of McQueen? Fear Not, Says Josh Sims--Holland’s New Breed of Conceptual Fashion Designers are Out to Save the Day, Indep. 9 (Jan. 14, 2001) (noting that “Viktor Horsting and Rolf Snoeren of Viktor & Rolf balance out the uneasy art-fashion equation. ‘Some experimental fashion can be really ridiculous, but it’s important for us that our clothes are wearable,’ says Snoeren. ‘We trained as fashion designers, but our work has had the attention of the art world. This isn’t art for the art world. Perhaps it’s art for the fashion world.’”).  Designer Miuccia Prada also notes the divide between art and fashion. While she persistently pushes the bounds of fashion, she also admits to being nervous about pushing too far: “My job is fashion,” she reminds herself. “Any time I feel myself getting too ‘arty,’ I go back to my fashion roots. Of course you see what is happening in art and that influences you. But we have our art foundation. Maybe I’m wrong, but I want to keep them separate.” Menkes, supra note 135 (quoting Miuccia Prada).
137 Jessica Kerwin, Under the Influence: Fashion designers reflect on the stuff that moves them most, W MAGAZINE, 434 (Sept. 2001) (quoting Tom Ford, designer for Gucci and Yves Saint Laurent).
consumed, worn, used. An artist may escape from reality to fantasy. We are not allowed to forget
the body.”138

Thus it seems that copyright is not an appropriate avenue for designers to seek protection of
gown designs. In addition to designers’ own remarks distancing dress designs from the ambit of
appropriate copyrightable subject matter, it has been shown that copyright protection to date of bridal
gowns and similar subject matter has been somewhat contradictory, and wholly unpredictable and
unclear.139 This renders such protection useless for designers, because it is impossible to opine
which way any given case may fall.

Ultimately, a debate of forms of intellectual property protection for bridal gowns appears to
be a fruitless one, because it seems that the answer is for courts to simply step back. Despite the high
cost of bridal gowns and the stakes of what designers see as being up for grabs, intellectual property
protection of bridal gowns does not appear to be the answer. If it cannot be enforced fairly,
uniformly, and predictably, then courts’ refusal to entertain cases claiming such protection will
actually insert a modicum of predictability into the consumer-driven industry. Furthermore, the
competition with “knocked off” copies does not seem to have hurt the higher end designers
tremendously: as Ms. Hayt can attest,140 there will always be a market for the designer originals like
Vera Wang’s. “It’s like when you go to the Shop & Stop, you have the real Raisin Bran[TM] and
then the generic raisin bran. Both have their buyers. Neither one has put the other out of
business.”141

138 Id. (quoting Christian LaCroix).
139 For example, the concept of conceptual separability has been defined and redefined, in Kieselstein-Cord, in Carol
Barnhart, and in Brandir International. See infra § III.B.2 at notes 65, 75 and accompanying text.
140 See infra note 40.
141 Eric Wilson, supra note 14 (analogizing Raisin Bran® breakfast cereal to designers’ original gowns, and generic
raisin bran cereal to competing copies).
Appendix of Dress Photos: Bridal and Bridesmaid Gowns

Maggie Sottero

David’s Bridal

Alfred Angelo

At left: Oleg Cassini for David’s Bridal

At right: Da Vinci Bridal

142 Maggie Sottero, Dress Details - Capri,

143 David’s Bridal, Bridal Gowns T9017,

144 Alfred Angelo, 1963,

145 David’s Bridal, CK166,

146 Da Vinci Bridal, T8147,


