BROTHERS IN LAW

By Thomas and Charles Danziger

What fools we were! We had read about the runway show Gagosian Gallery held during New York's fall Fashion Week, which featured $4,000 jeans made by Levi Strauss & Co**.** and decorated with Damien Hirst**'s** famous skull pattern in Swarovski crystals. We had seen the Richard Prince exhibition at the Guggenheim Museum, where guests were given an opportunity to preorder hand-embroidered Louis Vuitton bags designed by the artist and Marc Jacobs. But we hadn't yet realized how interwoven the worlds of art and fashion have become.

It took our client Mitch, an art dealer from L.A., to show us the light. Mitch had decided to jump on the fashion-meets-art bandwagon and used his gallery to exhibit apparel designed by well-known artists—think ugly sweaters at Old Master prices. To our amazement, the costly clothes were flying out of the gallery, but Mitch had a problem: A competitor was stealing his artists' designs and manufacturing cheap knock-offs. What was our advice?

The Copyright Act of 1976 protects "pictorial, graphic and sculptural works," which include "two-dimensional and three-dimensional works of fine, graphic and applied art." It does little, however, to protect items with intrinsic utilitarian functions, such as clothing. The design of a so-called useful article is copyrightable only to the degree that its aesthetic aspects are separable from its utilitarian ones. So an original artistic design that is printed on clothing—say, Andy Warhol's *Mao* on a T-shirt or a Chuck Close self-portrait on a dress—is protectable but not the "useful" parts of the clothing, such as the design of the sleeve or the neckline. The problem is that when it comes to fashion, decorative and utilitarian features can be hard to separate, leading to distinctions that are often arbitrary.

Consider the 1980 Second Circuit case *Kieselstein-Cord v. Accessories by Pearl, Inc.* The designer Barry Kieselstein-Cord had sold belt buckles that he described as both jewelry and sculpture and that were eventually accepted into the permanent collection of the Metropolitan Museum of Art, in New York. Kieselstein-Cord sued Accessories by Pear**l** when the New York belt manufacturer began selling

copies of his buckles, some of which it even referred to as "Barry Kieselstein Knockoffs." For its part, Accessories by Pearl argued that the buckles weren't copyrightable because they were merely "useful articles," with no pictorial, graphic or sculptural features that could be identified separately from, or exist independently of, the buckles' utilitarian aspects. The court disagreed and allowed the beltbuckle designs to be copyrighted. It reasoned that the decorative or aesthetically pleasing aspect was primary and the utilitarian function secondary.

"So what are the chances of copyrighting this work?" Mitch asked, hauling out a three-piece ensemble composed of a coat cut in the shape of the old Soviet Union, a mask dripping with rubies and diamonds that resembled ketchup and mayonnaise, and slippers that looked like the paws of a Siberian tiger. The work, created by a rising Russian contemporary-art star, was titled *Russian Dressing*—and Charles looked sensational wearing it.

The leading cases in this area suggested that the coat would not be copyrightable because it would be considered a useful article. In the 1989 Second Circuit case *Whimsicality, Inc. v. Rubie's Costume Co.*, costume designer Whimsicality asserted that a competitor, Rubie's, was making cheap copies of designs, such as the Pumpkin, Bee, Penguin and Spider, for which Whimsicality had already registered the copyright. The plaintiff insisted in its copyright application that the outfits were actually "soft sculpture," thereby meriting protection. But the court determined that the outfits were clothing, not sculpture, and thus not copyrightable, holding that "the word sculpture implies a relatively firm form representing a particular concept. The costumes in question have no such form."

"Since when is a judge qualified to decide what constitutes art?" Mitch asked. Since never, we replied, referring him to our article "But Is It Art?" [see Brothers in Law, *Art+Auction*, May 2006], which describes judicial determinations of essentially artistic matters.

In contrast to the coat, Mitch's mask was copyrightable, we believed, because the United States Copyright Office had determined in 1991 that masks are nonutilitarian. The slippers might also be protectable, since a 1985 federal case, *Animal Fair v. Amfesco Industries*, had granted copyright protection to a particular novelty slipper resembling bears' claws. The court reasoned that certain aspects of the slippers, such as the "impractical width and shape" of the sole, the particular combination of colors and the slippers' profile and toes "are all sculptural features which comprise the artistic design and which are wholly unrelated to function." In this decision, the court drew a distinction between design features and utilitarian aspects that—as with Hirst's jeans or Prince's handbags—seems murky at best.

We thought that a number of other pieces in Mitch's exhibition were also protectable, starting with one of his artists' handbags. It was painted with interesting variations on the logo of Mitch's art gallery, reminiscent of

Takashi Murakami's use of a signature design element in his best-selling handbag line for Louis Vuitton in 2002. We were confident that copying the bag without permission would violate Mitch's right of "trade dress," a branch of trademark law that aims to prevent consumer confusion about the source or manufacturer of a product. "Trade dress can protect the shape or design of clothing," observes intellectual-property-law expert Alexandre Montagu, "but only if the shape or design of the product has become sufficiently distinctive to indicate source. For example, Chanel's interlocking-C design may be protectable under a theory of trade dress because consumers would likely associate those Cs with Chanel."

Furthermore, knowing that Mitch's exhibition was traveling to venues in France and the U.K., we reassured him that those countries actually afford fashion designers far greater protection than the U.S. does. British law protects registered and unregistered industrial designs for 10 to 15 years. Similarly, French copyright law applies to original fashion designs from the moment the work is created.

"So why isn't anyone trying to change the law here in the U.S. to protect fashion designs?" Mitch demanded.

Actually, someone is. In 2006, Representative Bob Goodlatte of Virginia introduced a bill in Congress to allow fashion designers to secure short-term copyrights for fashion works. The Design Piracy Prohibition Act, as it is called, would modify the Copyright Act to protect clothing designs and accessories for three years, after which they may be freely copied. The bill has been referred to a House subcommittee but has not yet been voted on by the full House of Representatives.

By the end of our meeting, Mitch still couldn't understand why U.S. law fails to treat fashion as true art, deserving of the same protection. After all, he declared, major museums have entire departments—and hugely popular exhibitions—devoted to fashion. Wasn't it arbitrary to view fashion as "useful articles" rather than as art, especially since the two have now become so intertwined?

We agreed—and now have a $10,000 sweater from Mitch's gallery to prove it.

"*The Material World" originally appeared in the April 2008 issue of* Art+Auction.