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FASHION HAS NO FUNCTION: DIMINISHING THE FUNCTIONALITY BAR TO TRADEMARK PROTECTION IN THE FASHION INDUSTRY

Seth DiAsio*

The hardest thing in fashion is not to be known for a logo, but to be known for a silhouette.

– Giambattista Valli

I. INTRODUCTION

The fashion industry exerts influence on nearly every person, and contributes more dollars to the U.S. economy than books, movies, and music combined, but it is relegated to the sidelines and scoffed at as the pursuit of vanity.¹ In New York City alone, the fashion industry consists of over 800 companies that employ nearly 200,000 people and generate over \$800 million in tax revenues.² On a global scale, the fashion industry is a \$1.5 trillion business with millions of employees.³ Because the fashion industry affects the lives of almost everyone, there should be more trademark protection for designers and brands that contribute original creations to the market.

The primary source of trademark law in the United States, The Lanham Act, outlines the requirements for trademark registration and protection.⁴ Marks⁵ which are distinctive, or that have acquired secondary meaning,⁶ can be

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1. See C. Scott Hemphill & Jeannie Suk, *The Law, Culture, and Economics of Fashion*, 61 STAN. L. REV. 1147, 1148 (2009) (“Fashion is one of the world’s most important creative industries. It is the major output of a global business with annual U.S. sales of more than \$200 billion—larger than those of books, movies, and music combined. Everyone wears clothing and inevitably participates in fashion to some degree.”); Imran Amed, *Let’s Show the World that Fashion is Serious Business*, BUSINESS OF FASHION (April 9, 2013), <http://www.businessoffashion.com/articles/editors-letter/lets-show-the-world-that-fashion-is-serious-business> (“Unfortunately, fashion is portrayed in much of the mainstream media as a superficial industry composed of champagne-swilling flakes who have nothing better to do than to gossip and snicker.”); see also Eveline Van Keymeulen & Louise Nash, *Fashionably Late*, INTELLECTUAL PROPERTY MAGAZINE (Jan. 2012), at 53 (noting the revenue of fashion versus other industries).

2. See Press Release, Council of Fashion Designers of America (CFDA), Innovative Design Protection Act Reintroduced (Sept. 12, 2012), <http://cfda.com/the-latest/innovative-design-protection-act-reintroduced>.

3. See, e.g., Amed, *supra* note 1 (emphasizing fashion’s importance by its impact on the global economy); Van Keymeulen & Nash, *supra* note 1 (highlighting the fashion industry’s share of the global gross domestic product).

4. See Lanham Act § 1, 15 U.S.C. § 1051 (2018) (requirements for registration).

5. A mark, or trademark, is defined as any word, name, symbol, or device, or any combination thereof that is used to identify goods and indicate the source of the goods, even if that source is unknown. Lanham Act § 45.

6. “Secondary meaning” refers to marks that have acquired distinctiveness through extended use so that the mark identifies the source of the goods to the consumer. U.S. TRADEMARK REGISTRATIONS: PRINCIPAL

registered on the Principal Register of the United States Patents and Trademarks Office (USPTO).⁷ Registered marks receive strong federal protection; however, those protections are unavailable to marks that are barred by the Act, but would otherwise meet the qualifications of registration.⁸ One of the strongest bars to registration is the functionality bar, which prevents registration of a functional mark regardless of whether it has a secondary meaning.⁹ Although the bar can affect many industries, the fashion industry is particularly vulnerable and accurately illustrates the negative impact of the imposed limitations.

The functionality bar directly prevents most fashion clothing and accessories from receiving trademark protection simply because the items in question serve a functional purpose. Fashion clothing and accessories that are not merely basic apparel, however, are only technically, or “de facto,” functional.¹⁰ Previous trends dictated that both luxury brands and middle tier brands eliminate overt logos (the easiest way to tap into trademark protection), and use functional aspects like buckles, clasps, colors, and silhouettes as indicia instead.¹¹ Recently, however, brands have adopted a logo-mania approach to enhance their protection.¹² Because the law does not allow functional features to be trademarked, another company can create a nearly identical item of lesser quality without any legal ramifications so long as they do not represent it as coming from the original source.¹³ For example, the fast-fashion brand NastyGal produced a small “WANT Quilt for Stamina” belt bag for fall 2018 and priced it at thirty-six U.S. dollars.¹⁴ NastyGal’s bag was clearly designed to replicate Gucci’s fall 2018 “GG Marmont Matelassé” design, which was priced more than thirty times higher than NastyGal’s version.¹⁵ NastyGal’s bag is

REGISTER VS. SUPPLEMENTAL REGISTER,

<http://www.inta.org/TrademarkBasics/FactSheets/Pages/PrincipalvsSupplementalRegister.aspx> (last visited Nov. 1, 2018).

7. The Principal Register contains marks which meet the requirements of registration and are afforded full protection according to the Lanham Act, and provides the most protection for those marks. *Id.*

8. *See infra* Part II (discussing benefits of federal protection and limitations set by the Lanham Act); *see also* Lanham Act § 2(e) (bars to registration).

9. *See* Lanham Act § 2(e)(5) (providing functionality as a bar to registration); § 14(3) (functionality as a cause for cancellation of a mark); § 33(b)(8) (functionality as a defense to incontestability of a registered mark); *see also* § 2(f) (strict bar to registration).

10. *See infra* Part I.B (describing and discussing the changing role of de facto and de jure functionality in trademark decisions).

11. *See* Note, *The Devil Wears Trademark: How the Fashion Industry has Expanded Trademark Doctrine to its Detriment*, 127 HARV. L. REV. 995, 996 (2014) (discussing the backlash to Louis Vuitton’s over-use of logos, and the company’s subsequent introduction of a fashion show without any visible logos).

12. *See* Jackie Mallon, *Logo Up, There’s Mileage in the Monogram*, FASHION UNITED (Oct. 25, 2018), <https://fashionunited.uk/news/fashion/logo-up-there-s-mileage-in-the-monogram/2018-102539629> (noting that brands emphasize logos because of the protection they afford, and crediting that protection with trendsetting status).

13. 19 C.F.R. § 133.21 (2018) (outlining the definition of counterfeit goods, and remedies available for infringing marks).

14. *See* NastyGal, <https://www.nastygal.com/want-quilt-for-stamina-velvet-belt-bag/AGG82548.html> (last visited Nov. 1, 2018); *see also* TFL, *15 of Nasty Gal’s Most Blatant Knockoffs (and Infringements)*, THE FASHION LAW (April 20, 2017), <http://www.thefashionlaw.com/home/13-of-nasty-gals-most-blatant-knockoffs> (noting Nasty Gal’s reputation for stealing ideas).

15. The price of the Gucci “GG Marmont Matelassé” ranges from \$1,150 to \$1,890. *See* GUCCI, <https://www.gucci.com/us/en/ca/women/womens-handbags/belt-bags-c-women-handbags-belt> (last visited Nov. 1, 2018).

likely legal though because it does not use any registered marks that indicate the source as Gucci. Couture and ultra-luxury creations, especially, are created not as basic apparel, but as status symbols, embellishments, and pieces of art.¹⁶ Dresses that take over 300 hours to create, or handbags that are created by master craftsmen may be de facto functional, but are far from the items that are only used for their functional purposes.¹⁷ Even brands that create fashions for the low end and middle markets strive for trend oriented clothing and accessories, and not merely utilitarian apparel.¹⁸

By diminishing the functionality bar to trademark protection, the USPTO would enable hundreds of brands to protect their innovations, and incentivize continued creation of new and interesting designs that, although technically functional, are indicia of the brand. The current approach to functionality as a bar to protection allows for widespread copying and creates confusion for the consumer in addition to post-sale misperceptions by the public at large.¹⁹ Diminishing the functionality bar would protect both designers and consumers.

This Article explores the current use of trademark protection in the fashion industry and proposes approaching protection from a different perspective. In cases where the proposed mark is only de facto functional and the mark is an indicia of the brand producing the merchandise, the functionality bar should be diminished to allow for protection. This Article considers trademark protection related to fashion brands,²⁰ how a new approach to functionality would diminish its negative impact on the fashion industry, and how that approach benefits individual brands, the entire industry, and consumers.²¹

16. See Virginia Postrel, *Fashion As Art*, WALL STREET JOURNAL (Sept. 11, 2010), <http://www.wsj.com/articles/SB10001424052748703453804575479902076411376> (discussing fashion week's move to Lincoln Center, an Arts arena, and mentioning Andy Warhol's description of Yves Saint Laurent as the best French artist).

17. See Landon Nordeman, *Haute Couture in Paris*, NEW YORK TIMES (Jul. 9, 2015), <http://www.nytimes.com/slideshow/2015/07/09/fashion/20150709COUTURE/s/20150709COUTURE-slide-B4GK.html> (noting the point of couture is either "the dream" or "to perfect" life); see also Leah Chernikoff, *1000 Hours and 50 Feet of Tulle: What It Takes to Make a Dior Couture Gown*, ELLE (Feb. 3, 2017), <https://www.elle.com/fashion/a42672/dior-couture-chiuri-by-the-numbers/> (noting the painstaking processes involved in the creation of couture garments).

18. H&M, a Swedish low-priced, fast-fashion retailer, has collaborated multiple times with well-known designers to produce trendy garments at lower prices. The latest collection is from one of the trendiest brands of the moment, Moschino. See Bianca O'Neill, *Here's Everything You Should (and Shouldn't) Buy From the H&M x Moschino Collab*, FASHION JOURNAL (Oct. 31, 2018), <https://fashionjournal.com.au/fashion/heres-everything-you-should-and-shouldnt-buy-in-the-hm-x-moschino-collab/> (noting Moschino's trend-heavy designs).

19. See Katy Steinmetz, *The Knockoff Economy: How Copying Hurts—and Helps—Fashion*, TIME (Sept. 10, 2012), <http://style.time.com/2012/09/10/the-knockoff-economy-how-copying-hurts-and-helps-fashion/> (discussing in an interview the huge amount of copying that occurs in fashion); *Retro Read: The Knockoff vs. Counterfeit Distinction*, THE FASHION LAW (Dec. 10, 2014), <http://www.thefashionlaw.com/archive/the-knockoff-vs-counterfeit-distinction> (observing that knockoffs are legal as long as they are not direct counterfeits); see also *Hermès Int'l v. Lederer de Paris Fifth Ave., Inc.*, 219 F.3d 104, 108 (2d Cir. 2000) (noting that consumers can be confused post-sale when another consumer purposefully passes off a knockoff).

20. See *infra* Part III.A (discussing the difference in apparel and fashion).

21. The fashion industry is also affected by both copyrights and design patents, those topics deserve their own analyses and proposals, and are beyond the scope of this Article. Copyrights and design patents focus on aspects of protection that do not affect trademark law, or its application by the United States Patents and Trademarks Office (USPTO). Trade dress, although closely tied to trademark law, is also beyond the scope of this Article. Trademarks and trade dress are often confused and the terms are sometimes used

Part II focuses on the history of trademark law and the Lanham Act. The discussion covers the power that authorized Congress to create the USPTO, what the Agency does, and how much power it exerts. Part II also covers what the Lanham Act does and does not do, and what it means in the context of trademark law.

Part III discusses the connection of trademark law to the fashion industry, and functionality's role in barring protection for that industry. As part of the discussion, Part III covers the conceptual separability of "fashion" and "apparel", how copying differs from paying homage, and the nuanced difference between "de facto" functionality and "de jure" functionality.

In Part IV, the discussion turns to a proposal to approach the functionality bar from a different perspective that allows more protection for fashion brands. Ultimately, the proposal would adopt de facto functionality as a way to separate fashion that is protectable from apparel that is not.

II. TRADEMARK LAW AND THE LANHAM ACT

In 1946, Congress passed the Lanham Act under the power granted to it by the Commerce Clause of the United States Constitution, which allows Congress to regulate trade between the states and foreign nations.²² The Act specifies numerous criteria that creators must meet to register their marks on the Principal Register, defenses to infringement claims, and other bars to registration.²³ For example, § 43(a) prevents a person from using words, terms, names, symbols, or devices that will cause confusion about the creator or sponsor of a work.²⁴ The purpose behind these criteria is to eliminate confusion created by similar marks, and prevent others from passing off their work as that of another.²⁵ Registration of a mark creates an indefinite monopoly, and makes a mark incontestable after five years.²⁶

The USPTO dates back to 1802, and was originally under the umbrella of the Department of State, but moved to the Department of Commerce in 1925.²⁷ The USPTO, in its modern form, was created by Congress in 1975.²⁸ The way in which the Agency regulates trademarks is determined by the Administrative

interchangeably, but they are two distinct concepts under the Lanham Act. *See* Lanham Act § 45, 15 U.S.C. § 1127 (2018); *see also* Gibson Guitar Corp. v. Paul Reed Smith Guitars, LP, 423 F.2d 539, 547 (6th Cir. 2005).

22. U.S. CONST. art. I, § 8, cl. 3; Lanham Act §§ 1-45 (2018).

23. Lanham Act §§ 1-45.

24. *Id.* § 43.

25. *See, e.g.*, *Louis Vuitton Malletier v. Burlington Coat Factory Warehouse Corp.*, 426 F.3d 532, 539 (2d Cir. 2005); *Mattel, Inc. v. Mountain Prods.*, 353 F.3d 792, 806 (9th Cir. 2003); *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 898 (9th Cir. 2002).

26. *See* Lanham Act § 15; *see also* *Stormy Clime Ltd. v. ProGroup, Inc.*, 809 F.2d 971, 977-78 (2d Cir. 1987) (noting that trademarks are for an unlimited period of time).

27. *See* Virginia Alexandria, *General Information Concerning Patents*, UNITED STATES PATENTS AND TRADEMARK OFFICE (Oct. 2015), <http://www.uspto.gov/patents-getting-started/general-information-concerning-patents#heading-6> (describing the background of the Agency, and its role).

28. *See* An Act to Amend The Trademark Act of 1946 and Title 35 of The United States Code to Change The Name of The Patent Office to the "Patent and Trademark Office", Pub. L. No. 93-596, 88 Stat. 1949 (Jan. 2, 1975) (codified at 35 U.S.C. § 1(a) (2012)).

Procedure Act (APA), and the Lanham Act.²⁹ When there is a conflict, however, or a contest to a ruling by the Agency, the federal courts will review the ruling.³⁰ In a review of the Agency's ruling, the courts consider whether or not the authorizing act specifically mentions the question at issue, and whether the agency's decision is based on an acceptable interpretation of the statute.³¹ When the statute is silent on the issue being decided, the courts defer to the agency's ruling.³²

As stated above, one of the main purposes of trademark law is to benefit the public by protecting them from confusion.³³ After the USPTO makes an initial determination that a mark merits protection, it considers whether the defendant's use of a similar mark might cause consumer confusion.³⁴ Whether a substantial number of consumers might be confused must be decided based on actual market conditions.³⁵ Two products may be easy to tell apart when carefully viewed side-by-side, but those same two products might be confusingly similar to consumers who encounter them in typical purchasing conditions.³⁶ The purpose of the Act is to eliminate this type of "real world" confusion.³⁷ Although some consumers may knowingly purchase copied merchandise, the Act also seeks to eliminate post-sale confusion.³⁸ Post-sale confusion occurs when a consumer purposefully purchases a copied item with the intention of passing it off as the original in order to fool the unknowing public.³⁹

To determine whether there has been confusion, the court considers eight factors: (1) whether the mark is well-known; (2) whether the marks in question are substantially similar; (3) whether the products are sold in similar geographic areas, or in similar store types; (4) whether the plaintiff would likely diversify

29. See Administrative Procedure Act, 5 U.S.C. §§ 500-96 (2018); Lanham Act §§ 1-45.

30. See, e.g., *Dickinson v. Zurko*, 527 U.S. 150, 162 (1999) (discussing the APA's requirement for meaningful federal court review).

31. *Chevron, U.S.A., Inc. v. Natural Res. Def. Council, Inc.*, 467 U.S. 837, 842-43 (1984).

32. See generally *Auer v. Robbins*, 519 U.S. 452 (1997) (reinforcing deference to agency interpretation); *Chevron*, 467 U.S. 837 (when rules are ambiguous, courts must generally accept agency interpretation using a two part test); *Vt. Yankee Nuclear Power Corp. v. Natural Res. Def. Council, Inc.*, 435 U.S. 519 (1978) (courts should not require additional review procedures beyond the APA); *Bowles v. Seminole Rock and Sand*, 325 U.S. 410 (1945) (courts should normally defer to agency interpretations of rules). But see *Talk America v. Michigan Bell Telephone Co.*, 131 S. Ct. 2254 (2011) (Scalia, J., concurring) ("It seems contrary to fundamental principles of separation of powers to permit the person who promulgates a law to interpret it as well.")

33. See *Hermès Int'l v. Lederer de Paris Fifth Ave., Inc.*, 219 F.3d 104, 107-08 (2d Cir. 2000).

34. See *Louis Vuitton Malletier v. Dooney & Bourke, Inc.*, 454 F.3d 108, 115 (2d Cir. 2006); (citing *Gruner + Jahr USA Publ'g v. Meredith Corp.*, 991 F.2d 1072, 1075 (2d Cir. 1993)).

35. See *Louis Vuitton Malletier v. Burlington Coat Factory Warehouse Corp.*, 426 F.3d 532, 534 (2d Cir. 2005) (dismissing the previously used test that compared two goods next to each other).

36. *Id.*

37. See *id.* at 539.

38. See *Counterfeit.com*, THE ECONOMIST (Jul. 30, 2015), <https://www.economist.com/business/2015/07/30/counterfeitcom-makers-expensive-bags-clothes-and-watches-are-fighting-fakery-courts-battle> (noting the complexity of the consumer's role in determining confusion).

39. See *Hermès Int'l v. Lederer de Paris Fifth Ave., Inc.*, 219 F.3d 104, 108 (2d Cir. 2000) (discussing the false prestige that a consumer acquires when purposefully purchasing counterfeit goods); see also *Mastercrafters Clock & Radio Co. v. Vacheron & Constantin-LeCoultre Watches, Inc.*, 221 F.2d 464, 466 (2d Cir. 1955) (noting that some customers purchase cheaper versions to acquire the prestige associated with the original).

and create new products with the mark; (5) whether consumers have experienced actual confusion because of the marks; (6) whether the defendant purposefully tried to benefit from the plaintiff's mark; (7) whether the quality of the defendant's product would diminish the value of the plaintiff's product; and (8) whether the consumer would analyze the product carefully before purchase, or make an impulsive decision.⁴⁰ Courts consider the factors in conjunction to determine the likelihood of confusion.⁴¹ The determination of confusion is also focused on similarity and not identity, and a plaintiff does not have to show that actual confusion has occurred (although it is a factor that is considered).⁴² A plaintiff only has to show that there is a likelihood that confusion could happen.⁴³

The purpose of The Lanham Act, and trademark law as a whole, is to benefit the consumer by avoiding confusion, and to protect the good will that a creator develops in a product through his or her investment.⁴⁴ Although not as significant of a focus, trademark law also provides incentives for creators to make quality goods and continue to innovate.⁴⁵ In that way, trademark law benefits the consumer even when they are not at risk of being deceived.⁴⁶ Although trademark law is designed to protect both consumers and the good will of creators, in the fashion industry trademark protection does not achieve its goal.

III. TRADEMARKS AND THE FASHION INDUSTRY

Trademark is widely considered to be the strongest source of protection for fashion brands, but still lacks the nuance really needed for the industry. One of the biggest hurdles that fashion brands must overcome to gain trademark protection is the functionality bar.⁴⁷ Because most fashion is de facto functional, it loses the opportunity for trademark protection without the use of logos. The idea behind the bar is that functional creations are too valuable not to allow public use and replication; however, the bar does not take into account the difference in fashion and apparel.⁴⁸

40. See generally *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961); *Accord Gucci Am., Inc. v. Guess?, Inc.*, 831 F. Supp. 2d 723, 736 (S.D.N.Y. 2011); *Go SMiLE, Inc. v. Levine*, 769 F. Supp. 2d 630, 637 (S.D.N.Y. 2011); see also *Louis Vuitton Malletier v. Dooney & Bourke*, 454 F.3d 108, 116 (2d Cir. 2006).

41. See, e.g., *Starbucks Corp. v. Wolfe's Borough Coffee, Inc.*, 588 F.3d 97, 115 (2d Cir. 2009); see also *Nabisco, Inc. v. Warner-Lambert Co.*, 220 F.3d 43, 46 (2d Cir. 2000).

42. See *Go SMiLE*, 769 F. Supp. 2d at 642.

43. See *id.* at 636.

44. See *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc.*, 696 F.3d 206, 215 (2d Cir. 2012) (quoting *Fabrication Enters., Inc. v. Hygenic Corp.*, 64 F.3d 53, 57 (2d Cir. 1995)).

45. See *The Devil Wears Trademark*, *supra* note 11, at 1000-01 (noting that protection of producers is one of the Lanham Act's main goals). But see *Hammerton, Inc. v. Heisterman*, 2008 U.S. Dist. LEXIS 38036, *19 (D. Utah May 8, 2008) (quoting *TraFFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 35 (2001) ("The Lanham act does not exist to reward manufacturers for their innovation in creating a particular device; that is the purpose of the patent law and its period of exclusivity.")).

46. See *United States v. Torkington*, 812 F.2d 1347, 1353 n.6 (11th Cir. 1987) (discussing the benefits of incentivizing trademark holders to invest in quality by preventing counterfeits).

47. See Lanham Act § 2, 15 U.S.C. § 1052(e)(5) (2015).

48. See Jane C. Ginsburg, Jessica Litman & Mary Kevlin, TRADEMARK AND UNFAIR COMPETITION

A. *Conceptual Separation of Fashion and Apparel*

Although every person participates in the fashion industry in some way, everyone does not participate at the same level, nor do all brands create with the same end goals in mind.⁴⁹ A famous example of universal fashion participation is from a scene in the film *The Devil Wears Prada*.⁵⁰ In the scene, the magazine editrix, Miranda Priestley, condescendingly informs her assistant, Andy Sacs, that she is participating in fashion even when she thinks she is just buying some sweater from a bin.⁵¹ The scene is a precise illustration of near universal participation in fashion regardless of actual willingness to participate.

Besides varying levels of participation, there is also a spectrum of brand purpose. On one end of the spectrum there are brands like Hanes that focus specifically on making clothing or accessories for their functional value.⁵² This Article refers to those strictly functional items simply as apparel. On the other end of the spectrum there are brands like Bottega Veneta or Tom Ford that make clothing and accessories to glorify craftsmanship or to entertain.⁵³ This Article refers to those items created for non-functional reasons more precisely as fashion. Alexander McQueen, for example, was well known for his reactionary collections in which he played with the ideas of pain and pleasure and good versus evil, and he named collections after macabre inspirations like horror stories and pagan rituals.⁵⁴ McQueen created to stoke a reaction, whether it was positive or negative.⁵⁵ The Metropolitan Museum of Art in New York named the retrospective of McQueen's work "Savage Beauty" to emphasize the tension and contradiction that he crafted into his work.⁵⁶

In the same way that designers do not create fashion for function, consumers do not shop for fashion because of its functionality. A handbag can

LAW: CASES AND MATERIALS, 55 (5th ed. 2013) (stating that the separation of what is valuable for protection and what is too valuable to protect is the essence of any intellectual property regime).

49. See, e.g., Nicole Kohler, *Social Media Takeaways from 5 Formidable Fashion Brands*, WOO THEMES: ECOMMERCE INSPIRATION (May 11, 2015), <http://www.woocommerce.com/2015/05/fashion-brands-social-media-tips/> (commenting on Converse's focus on connecting with the personal stories of customers); Burberry, <https://www.burberryplc.com/en/company/strategy.html> (last visited Nov. 1, 2018) (outlining Burberry's core strategies, including "Operational Excellence" and "Inspired People"); Hanes, <http://www.hanes.com/corporate#ourco> (last visited Nov. 1, 2018) (noting the company's dedication to basic apparel).

50. *THE DEVIL WEARS PRADA* (Twentieth Century Fox 2006).

51. *Id.*; See generally Hemphill & Suk, *supra* note 1, at 1148 (denoting the irrelevance of willingness).

52. See Hanes, *supra* note 49.

53. Tomas Maier, the Creative Director of Bottega Veneta, has emphasized his desire to produce clothing and accessories that are examples of craftsmanship and beauty. Tom Ford, the Creative Director and CEO of his eponymous label has said that fashion, especially luxury fashion, is entertainment. See KATE BETTS ET AL., *BOTTEGA VENETA: WHEN YOUR OWN INITIALS ARE ENOUGH* 15 (Tomas Maier ed., 2012); BRIDGET FOLEY, *TOM FORD* 22 (Eva Prinz et al. eds., 2004).

54. See Laird Borrelli-Persson, *From the Archives: 9 Unforgettable Alexander McQueen Shows from the '90s and Beyond*, *VOGUE* (Oct. 3, 2015), <http://www.vogue.com/13356514/alexander-mcqueen-nineties-shows/>.

55. Alexander McQueen once remarked, "I don't want to do a cocktail party, I'd rather people left my shows and vomited. I prefer extreme reactions." ANDREW BOLTON, SUSANNAH FRANKEL & TIM BLANKS, *ALEXANDER MCQUEEN: SAVAGE BEAUTY* 12 (Mark Polizzotti et al. eds., 2011).

56. *Id.*

be more than just a tote for necessities.⁵⁷ A shoe can give insight about a person, and not just protect his or her feet.⁵⁸ Just as fashion is conceptually separable from apparel, functional aspects are separable from the artistic aspects in regards to fashion clothing and accessories by differentiating terminology.⁵⁹ Different terms should be used to distinguish technically functional, but actually artistic, products from purely functional products.

B. De Facto and De Jure Functionality: A Shift in Trademark Terminology

Before 2002, the USPTO differentiated between types of functionality with the terms *de facto* and *de jure*.⁶⁰ *De facto* functionality referred to a design that has a function, like a buckle, but that is irrelevant when the functionality of the product is considered as a whole.⁶¹ *De facto* functionality did not automatically bar registration, which balanced the creator's rights with protection for consumers.⁶² *De jure* functionality—which referred to a design that works better specifically because of its functional shape—did prohibit registration because such products were considered too important to consumers to allow a monopoly.⁶³ Because of three Supreme Court decisions in which the Court did not use the *de facto/de jure* distinction, and the absence of the terms when the Trademark Act of 1946 was amended in 1998, the USPTO no longer makes the distinction between types of functionality when making registration determinations.⁶⁴ The lack of distinction between types of functionality makes it more difficult to overcome the functionality bar to trademark protection.

In 2012, in *In re Becton, Dickinson & Co.*, the Court of Appeals for the Federal Circuit once again referred to those terms, which demonstrated that, although out of favor, the terms are not irrelevant.⁶⁵ In that case, the Court weighed the functional and non-functional features of a mark and emphasized striking a balance between the right to copy and the right to protect a brand's indicia.⁶⁶ Because of how the USPTO and the Court define the terms *de jure* and *de facto*, they are particularly relevant to the determination of functionality for

57. See *Louis Vuitton Malletier v. Dooney & Bourke, Inc.*, 454 F.3d 108, 111 (2d Cir. 2006) (noting that a handbag is also a fashion statement, "or a reflection of its owner's personality").

58. See *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc.*, 696 F.3d 206, 227 (2d Cir. 2012) (agreeing that Louboutin's red soles are so associated with the brand, and that they instantly tells others where the shoe is from). *But see* Amy Odell, *Tom Ford on the Many Different Sides of Tom Ford*, NEW YORK MAGAZINE (Oct. 22, 2009), http://nymag.com/thecut/2009/10/tom_ford_on_the_many_different.html# ("[Shoes] don't really mean anything other than to be able to say, 'Wow, look at my feet. Aren't they pretty?'.")

59. See, e.g., *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989, 993 (2d Cir. 1980) (allowing separability to occur either physically or conceptually). *But see id.* at 994 (Weinstein, J., dissenting) (emphasizing the complete integration of a designer's original work into the functional aspects of a belt buckle).

60. See TMEP § 1202.02(a)(iii)(B) (8th ed. Rev. Oct. 2017).

61. See *In re Becton, Dickinson & Co.*, 675 F.3d 1368, 1373–74 (Fed. Cir. 2012).

62. See *In re Morton-Norwich Prods.*, 671 F.2d 1332, 1337 (C.C.P.A. 1982).

63. See TMEP § 1202.02(a)(iii)(B) (8th ed. Rev. Oct. 2017); *see also In re R.M. Smith, Inc.*, 734 F.2d 1482, 1484 (Fed. Cir. 1984).

64. See *id.*; *see also TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23 (2001); *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205 (2000); *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159 (1995).

65. See *In re Becton*, 675 F.3d at 1373–74.

66. See *id.*

clothing and accessories.⁶⁷ Apparel should generally fall into the de jure functional category, and fashion should generally fall under de facto functionality.⁶⁸ De facto functionality would not guarantee registration, but would allow for a broader approach to the functionality bar.⁶⁹

Moreover, the courts have already started to break away from the traditional scope of trademark law, and allow for marks that are more similar to designs than they are to logos to be protected.⁷⁰ In *Qualitex Co. v. Jacobson Products Co.*, the Supreme Court considered whether color could be a registered mark, and found that the language of the Lanham Act and the basic underlying principles of trademark law include color within the universe of things that can qualify as a trademark.⁷¹ The Supreme Court noted that its findings included no objection under the functionality doctrine, and that the functionality bar is not absolute when color is considered a mark.⁷² The Supreme Court's ruling in *Qualitex* started the trend toward stronger protection.⁷³ Cases that followed in the district courts have debated the merits of stronger protection and the role of so-called aesthetic functionality in the decisionmaking process, but have not expanded the Supreme Court's rulings farther.⁷⁴ The courts' rulings make it clear that terminology plays an increasingly important role in trademark law. The importance of both legal terminology and industry terminology will ultimately become significant to trademark law's relationship with the fashion industry.

C. *The Difference Between Copying and Paying Homage*

Although the two are often conflated in the media, design copying is separate from other more symbiotic design relationships. Inspiration, adaptation, homage, and remixing⁷⁵ are all considered acceptable forms of use and are markedly different than close copies that constitute infringement.⁷⁶ Close copies are far from the references and remixes that comprise current trends as part of the cultural zeitgeist. The proliferation of close copies is not a sign of ingenuity.

67. See TMEP § 1202.02(a)(iii)(B) (8th ed. Rev. Oct. 2017); see also *In re Becton*, 675 F.3d at 1373–74.

68. See, e.g., *In re Becton*, 675 F.3d at 1374 (“De jure functionality means that the product is in its particular shape because it works better in this shape.”).

69. See, e.g., *id.* at 1373–74.

70. See *The Devil Wears Trademark*, *supra* note 11, at 996 (emphasizing the expansion of protection under trademark doctrine, and its potential negative repercussions).

71. See *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 166 (1995).

72. See *id.* at 164–65.

73. See *id.*

74. See, e.g., *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc.*, 696 F.3d 206, 222 (2d Cir. 2012) (noting that an aesthetic functionality analysis is fact-specific but that courts should not jump to conclusions about aesthetic features when making functionality determinations).

75. *Inspiration* refers to creators being influenced by another person, *adaptation* refers to the modification of an existing style to reflect current trends, *homage* refers to designs that are reverential in concept, and *remixing* refers to the blending of other designs to create new ones. Webster's Third New International Dictionary 23, 1082, 1170, 1921 (Philip Gove ed., 3d ed. 1993).

76. See 19 C.F.R. § 133.21 (2015) (“A counterfeit mark is a spurious mark that is identical with, or substantially indistinguishable from, a mark registered on the Principal Register of the U.S. Patent and Trademark Office.”); see also *Hemphill & Suk*, *supra* note 1, at 1153 (emphasizing the distinction between being inspired by a design and copying a design).

Being part of a trend, however, is not necessarily indicative of a close copy.⁷⁷ On-trend designs that suggest historical fashion references, or are inspired by current cultural phenomena, are often incredibly innovative and markedly different than entirely unoriginal creations that are taken directly from another's designs.⁷⁸ Those historical or cultural references are hallmarks of homage and inspiration, and they differentiate those designs from ones that would be considered copies.

Often, though not always, a clue to whether something is a copy, and not just a reference, is the intention of the secondary creator. When a secondary creator purposefully absconds a mark it is clear that the "new" design is meant to be a copy of the original product and create confusion for the customer.⁷⁹ In those cases, copies become complete replacements, and ultimately devalue the original design as well.⁸⁰ Copies not only pose a risk to the design itself, but they can also taint the reputation of the company.⁸¹ Because of close copies, and counterfeits, the fashion industry needs more trademark protection.

IV. DIMINISHING THE FUNCTIONALITY BAR TO TRADEMARK PROTECTION

Distinguishing de facto functionality would diminish the functionality bar to trademark protection for the fashion industry and mitigate the damage caused by limited protection. Although there are alternative view points and proposals, those options lack clarity, an understanding of the fashion industry, and the depth necessary to make an impact.

A. Using De Facto Functionality to Diminish the Bar to Protection

In lieu of Congress amending The Lanham Act or creating *sui generis*⁸² protection, the USPTO can simply approach the functionality bar from a different perspective. If a functional feature on an article of clothing or an accessory indicates the source of that product, the test should consider whether the feature is de jure functional or de facto functional. The entire product, or even the functional aspect, should not be forced under the general umbrella of the term "functional" without a modifier to distinguish it. This is especially true

77. See Hemphill & Suk, *supra* note 1, at 1153.

78. See *id.* (reiterating the distinction between inspired creations and copies and the impact on the fashion industry).

79. See *Go SMiLE, Inc. v. Levine*, 769 F. Supp. 2d 630, 645 (S.D.N.Y. 2011) (holding that bad faith copying creates a presumption of consumer confusion); *Louis Vuitton Malletier v. Burlington Coat Factory Warehouse Corp.*, 426 F.3d 532, 535–36 (2d Cir. 2005) (holding that Louis Vuitton's mark was infringed based on Burlington's admittance of purposeful copying); see also *Chanel, Inc. v. Italian Activewear of Fla.*, 931 F.2d 1472, 1476 (11th Cir. 1991) (holding that willful blindness to copying is equivalent to bad faith copying).

80. See Seth M. Cooke, *To Catch a Fake: Fashion Industry, Government Confront Market in High-end Counterfeit Goods*, THE POST AND COURIER, June 2, 2006, at D1 (noting the danger to brand reputation that is created by counterfeit goods); see also Hemphill & Suk, *supra* note 1, at 1160 (noting value reduction caused by close copies).

81. Robert Chavez, the President and CEO of Hermès USA, said "Although fakes have created a greater awareness of Hermès in the U.S., the poorer quality can taint the reputation of our company." Cooke, *supra* note 80 (discussing the downsides of design piracy).

82. Latin for "of its own kind," the term *sui generis* is used in intellectual property law to describe new protection that does not fit into traditional law. BLACK'S LAW DICTIONARY 1572 (9th ed. 2009).

if the feature has developed secondary meaning in the marketplace and is an exceptionally strong indicator of the product's origin.⁸³ Some courts have already stretched the definition of what functional means in the context of design, and have held that creative designs that are separable, conceptually and physically, are trademarkable although they exhibit some actual functionality.⁸⁴ It would not overburden the imagination to stretch the concept just a little bit further and distinguish types of functionality. The current test for determining functionality already looks to whether a feature is essential to the use or purpose of the article, and, as noted above, the purpose of fashion is almost never function.⁸⁵ Fashion designs are created to be status symbols, flourishes, and even as pieces of art that are never worn but are nevertheless displayed.⁸⁶ Couture dresses may be de facto functional, but they are not actually functional in their purpose, and should not be considered de jure functional.⁸⁷

For example, suppose that Designer A creates a handbag with a buckle that is shaped in a unique way, but the buckle is not highly ornamental or overly designed.⁸⁸ The buckle is also used as the actual closure of the handbag. Now assume that the handbag becomes wildly popular, and appears on celebrities and in fashion magazines around the world. Under current USPTO regulations, the functionality bar would prevent Designer A from registering his mark, and gaining all the protection that includes.⁸⁹ Designer B would be able to copy the design on his own handbags, and sell them at a lower price to undercut the original creator, Designer A. Other companies may also be able to produce a similar product so quickly that it will be available almost immediately after the original comes to market.⁹⁰ Under the proposed alternative view of functionality, that would not be a problem. The buckle would indicate the source of design, especially if it develops secondary meaning, be considered de facto functional, and as a result it would easily qualify for registration. Approaching the functionality bar to trademark protection by separating de facto and de jure functionality would allow the fashion industry to fight knockoffs and close copies with real legal force, protect innovation, and create an environment that rewards creativity over plagiarism.

83. A mark acquires secondary meaning when the first thing people think of when they see it is the source of the product rather than the actual product. See *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc.*, 696 F.3d 206, 216 (2d Cir. 2012) (quoting *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 851 n.11 (1982)).

84. See, e.g., *Louboutin*, 696 F.3d at 222 (allowing predominantly ornamental features that do not hinder competition to be considered non-functional); *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989 (2d Cir. 1980) (allowing protection for belt buckles that had some artistic qualities).

85. See *Louboutin*, 696 F.3d at 219 (quoting *Inwood Labs.*, 456 U.S. at 851).

86. See Postrel, *supra* note 16 (noting fashion's connection to art through museums, muses, and fashion week's move to an arts venue).

87. See Nordeman, *supra* note 17.

88. This example relates specifically to handbags, but the concept can easily be applied to other accessories, shoes, or fashion clothing.

89. See generally TMEP § 1202.02(a)(iii)(B) (8th ed. Rev. Oct. 2017).

90. Inditex, the parent company of Zara, Pull & Bear, and Massimo Dutti, can make, ship, and sell a new product in days. See Dan Alexander, *Amancio Ortega Briefly Passes Bill Gates to Become World's Richest Man*, FORBES (Oct. 23, 2015), <http://www.forbes.com/sites/danalexander/2015/10/23/amancio-ortega-briefly-passes-bill-gates-to-become-worlds-richest-man/#61166ede5e4b>.

There are many designs that are significant indicators of source that were created through breakthroughs in innovation, and it would not detract from consumers' benefit if the creator were given trademark protection and others were limited in their ability to copy them.⁹¹ Allowing a company like Bottega Veneta to trademark its creative solution to a technical problem would not be unfair to other luxury brands that have access to many other designs without using Bottega Veneta's unique pattern.⁹² If companies like Bottega Veneta are given that protection it may even spur other, more cautious, brands to innovate.⁹³ With the knowledge that protection is available without the use of logos designers would be free to create based solely on art and without the concern of whether their designs would overcome the functionality bar.

Despite the fact that *de facto* functional products are purchased or used without regard to their functionality and that designers create for almost any purpose but function, the United States still bars designers from stronger trademark protection because of the relative functionality of their designs.⁹⁴ The United States' reasoning is based on the principle that if something is functional then it should be accessible to everyone to benefit consumers.⁹⁵ A diminished functionality bar would allow designers to focus on creativity instead of squeezing into the trademark box with a product they already have, something that is usually accomplished by plastering it with logos.⁹⁶ Although overt logos are now *de rigueur*,⁹⁷ designers must focus on incorporating some iteration into their products to garner the most protection without considering future trends or consumers who prefer logo-less products.⁹⁸ Excessive use of logos directs fashion toward a status focused operation and away from the embrace of

91. In 1966 Bottega Veneta purchased sewing machines designed for fabric because sewing machines designed for leather were not available in the Veneto region where the company is located. Bottega Veneta's founders created the *intrecciato* design because their fabric sewing machines were not equipped to sew thick saddle leather like the rest of the luxury design houses used. *Intrecciato* is a tightly woven crosshatched design that is made by layering extremely soft skins on top of each other. The new technique was soft, collapsible, and durable. *Intrecciato* is not yet fully protected by intellectual property law in the United States, although registration of the mark has been published for opposition, the USPTO's decision is still pending after more than eleven years. Bottega Veneta's application for its *intrecciato* mark qualifies that it does not seek a total monopoly on all basket weave patterns. See BETTS ET AL., *supra* note 53, at 7-9 (describing the detailed process through which the signature look is created); See United States Patent and Trademark, Uspto.gov, U.S. Trademark Application Serial No. 77/219,184 (filed June 29, 2007), https://tsdr.uspto.gov/#caseNumber=77219184&caseType=SERIAL_NO&searchType=statusSearch.

92. See U.S. Trademark Application Serial No. 77/219,184, *supra* note 91.

93. *But see* Wallace Int'l Silversmiths, Inc. v. Godinger Silver Art Co., 916 F.2d 76, 81 (2d Cir. 1990) ("It is a first principle of trademark law that an owner may not use the mark as a means of excluding competitors from a . . . market.").

94. See Van Keymeulen & Nash, *supra* note 1, at 55 (underlining U.S. courts' unwillingness to provide intellectual property protection for fashion).

95. See *In re Becton, Dickinson & Co.*, 675 F.3d 1368, 1374 (Fed. Cir. 2012) (noting that the public interest in a design is sometimes superior to the interest of the producer).

96. Susan Scafidi, the President of The Fashion Law Institute at Fordham University School of Law, said, "You didn't think that all of those repeated logos were just aesthetic choices, did you?" See *The Devil Wears Trademark*, *supra* note 11, at 1002.

97. *De rigueur* means that it is prescribed or required by fashion, etiquette, or custom. WEBSTER'S THIRD NEW INTERNATIONAL DICTIONARY (3d ed. 1993).

98. See *The Devil Wears Trademark*, *supra* note 11, at 996.

diversity and creativity.⁹⁹

A change in policy would not only create incentives at the top end of the market, but also in the mid-range and bottom tiers of the market too. Many big name luxury brands like Gucci, Chanel, Louis Vuitton, Celine, Dior, and Givenchy started as small companies and grew because of innovative design.¹⁰⁰ With new protection available, investment and design would become the main impetus for producers of fashion, and drive them away from the prolific use of logos.¹⁰¹

Not only would this approach be beneficial to the fashion industry, implementation by the USPTO would be simple. Examining attorneys at the USPTO use the Trademark Manual of Examining Procedure (TMEP) as a guide when analyzing trademark applications.¹⁰² The TMEP instructs trademark examiners to consider functionality without a de facto/de jure analysis.¹⁰³ The USPTO can allow examiners the flexibility to grant trademark protection to de facto functional fashion clothing and accessories by removing that section of the TMEP entirely. Although the point could be emphasized by adding guidelines to the TMEP on the use of de facto and de jure functionality, it is unnecessary to allow the protection.

Ultimately, by prohibiting brands from protecting features that are otherwise indicia of origin because those features are also de facto functional, the law promotes rampant copying, and fails to fulfill its purpose.¹⁰⁴ The gap in protection is costly to the U.S. fashion industry, allows foreign brands to benefit from the stronger protections offered by their home countries, is bad for consumers, and in some cases supports criminal activity.¹⁰⁵ Even though there are so many negative consequences to the gaps in protection, there are still people who believe the current protection is already enough or are against increased protection at all.

B. Arguments Against Diminishing the Functionality Bar

Many people in the fashion industry fight for either *sui generis* or stronger

99. See Hemphill & Suk, *supra* note 1, at 1178.

100. During the 1980s and 90s, many small design houses erupted in bursts of creativity that skyrocketed them to global dominance. Karl Lagerfeld at Chanel, Marc Jacobs at Louis Vuitton, Michael Kors at Celine, John Galliano at Dior, Alexander McQueen at Givenchy, and Tom Ford at Gucci are just a handful of examples of this phenomenon. See FOLEY, *supra* note 53, at 26 (“We took what had been a small luxury company and democratized it.”).

101. See Hemphill & Suk, *supra* note 1, at 1153–54 (noting that logo proliferation takes advantage of available legal protections). *But see* Paige Holton, Note, *Intellectual Property Laws for Fashion Designers Need no Embellishments: They are Already InStyle*, 39 J. CORP. L. 415, 427 (2014) (hypothesizing that the greatest boost for creativity is from internal drive rather than external incentives).

102. See TMEP Foreword (8th ed. Rev. Oct. 2017).

103. See TMEP § 1202.02(a)(iii)(B) (8th ed. Rev. Oct. 2017).

104. See *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc.*, 696 F.3d 206 (2d Cir. 2012) (elucidating trademarks purpose of differentiating between items and rewarding the producer).

105. See Press Release, CFDA, *supra* note 2 (emphasizing the cost of copying to U.S. brands); *see also* Van Keymeulen & Nash, *supra* note 1, at 53–54 (Noting Europe’s dominance in the fashion industry); Dana Thomas, *The Fight Against Fakes*, HARPER’S BAZAAR (Jan. 8, 2009), <http://www.harpersbazaar.com/culture/features/a359/the-fight-against-fakes-0109/> (connecting copyists to human trafficking, child labor, gang warfare, money laundering, and terrorism).

protection within the framework that already exists.¹⁰⁶ There are people, however, who believe that the protection already available is strong enough, that there is no need for protection at all, or even that the fashion industry does not want protection.¹⁰⁷ Although some of the arguments appear facially helpful, they lack enough substance to affect the fashion industry in any meaningful way.

In a Note for the University of Iowa's Journal of Corporation Law, Paige Holton argued that the current trademark protection offered is already enough.¹⁰⁸ She discussed the regulations for trademark registration and the accompanying bars to registration, but when she applied the rules to the fashion industry she ignored the functionality bar to registration.¹⁰⁹ She said that the only requirement for registration is for a mark to become distinctive, but neglected to discuss the limitations imposed by the Lanham Act.¹¹⁰ She later argued that trademark protection is easy for fashion brands to obtain, but relied on the logos that limit a companies' options.¹¹¹ As discussed, logo fatigue prevents companies from overuse of logos to achieve protection.¹¹² Diminishing the functionality bar would eliminate the need for designers to focus on logos, and enable registration for distinctive products regardless of functionality.

Alternatively, In *The Piracy Paradox: Innovation and Intellectual Property in Fashion Design*, professors Kal Raustiala and Christopher Sprigman argued that the lack of protection is actually good for the fashion industry.¹¹³ Raustiala and Sprigman posited that fashion copies reduce the original's value, which in turn causes consumers to no longer want the product and move on, which then spurs the designer to create new products and start the cycle over again.¹¹⁴ Raustiala and Sprigman referred to this process as "induced obsolescence," but did not support their hypothesis with any meaningful data.¹¹⁵

Additionally, Raustiala and Sprigman argued that because the fashion industry has been without protection since the fall of the Fashion Originators' Guild that the industry does not want protection.¹¹⁶ That argument is roughly equivalent to arguing that women did not want to vote because they never had the right to vote.¹¹⁷ In the late 19th and early 20th century, there were many

106. Steve Kolb, the President and CEO of the Council of Fashion Designers of America, has committed the organization to fighting for the same intellectual property protection that is enjoyed by other industrialized nations for American designers. See Press Release, CFDA, *supra* note 2.

107. See, e.g., Holton, *supra* note 101 (suggesting that designers use brand image to protect their marks, but ignoring the lack of intellectual property protection available).

108. See *id.*

109. *Id.* at 421.

110. *Id.* at 422.

111. *Id.* at 421.

112. See generally Hemphill & Suk, *supra* note 1; see also text accompanying note 99.

113. See Kal Raustiala & Christopher Sprigman, *The Piracy Paradox: Innovation and Intellectual Property in Fashion Design*, 92 VA. L. REV. 1687 (2006).

114. See *id.*

115. Compare *id.* (promulgating the concept that copyist inspire creation) with Hemphill & Jeannie Suk, *supra* note 1, at 1181 (arguing that designers would induce obsolescence themselves if it was really beneficial to the industry).

116. See Raustiala & Sprigman, *supra* note 113, at 1715-16.

117. See Lyman Abbott, *Why Women Do Not Wish the Suffrage*, THE ATLANTIC, Sept. 1903, at 289, <https://www.theatlantic.com/magazine/archive/1903/09/why-women-do-not-wish-the-suffrage/306616/>

people, both men and women, who believed that women should not vote and that they did not want to vote.¹¹⁸ History shows that was not the case, and women got the vote in 1919.¹¹⁹ Similarly, the lack of protection available to the fashion industry is not indicative of a disinterest in protection.

Raustiala and Sprigman also ignored the incredible amount of power that the Fashion Originator's Guild wielded before its collapse under pressure from the Federal Trade Commission, and the incredible amount of expense the industry exerted to make it a success in the first place.¹²⁰ While they blindly assumed that the fashion industry sits idly by, designers have actively pursued protection for years.¹²¹ Over 70 bills have been introduced since 1914 to protect designs, and there have been various laws against design piracy since the Middle Ages.¹²² The long history of design piracy laws, attempts to strengthen protection, and the money spent to lobby for protection all contradict Raustiala's and Sprigman's claims about intellectual property protection for the fashion industry.

Contrarily, the author of *The Devil Wears Trademark: How the Fashion Industry Has Expanded Trademark Doctrine to its Detriment* argued that expanding on the system that is already in place is detrimental to the industry, and that what is needed is strong *sui generis* protection.¹²³ She discussed several important cases in trademark protection, such as *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc.* and *Louis Vuitton Malletier v. Dooney & Bourke, Inc.*, and adeptly noted their failings when it comes to providing enough protection for the fashion industry.¹²⁴ She then suggested that Congress introduce *sui generis* legislation to undo the courts' interpretations of current trademark laws; however, her recommendation stopped short of suggesting what those laws would look like or how they would benefit the fashion industry.¹²⁵ Without a clear recommendation of what *sui generis* protection should look like, the suggestion has little impact and encourages no actual benefit for the fashion industry. Diminishing the effects of the functionality bar, however, would have wide-ranging impact on the entire industry.

In practice, challenges to the use of de facto functionality would likely focus on amendments to the TMEP and the USPTO's authority to interpret functionality. Courts, however, give considerable weight to the Agency's

(proposing myriad reasons why women at the turn of the 20th century did not even want to vote).

118. *See id.*

119. U.S. CONST. amend. XIX, § 1.

120. *See Fashion Originators' Guild of Am. v. FTC*, 312 U.S. 457, 462–63 (1941) (listing the elaborate system the Guild used to enforce its regulations).

121. *See The Devil Wears Trademark*, *supra* note 11, at 998–99 (noting the volume of legislation introduced to protect the fashion industry).

122. *See id.* (noting every piece of legislation introduced since 1914 ultimately failed); *see also* Cooke, *supra* note 80.

123. *See The Devil Wears Trademark*, *supra* note 11, at 1011 (“The courts’ piecemeal expansion of trademark doctrine to include protection of design, however, may ultimately hurt the industry”).

124. *See id.* at 1012; *see also* *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc.*, 696 F.3d 206 (2d Cir. 2012); *Louis Vuitton Malletier v. Dooney & Bourke, Inc.*, 454 F.3d 108, 111 (2d Cir. 2006).

125. *See The Devil Wears Trademark*, *supra* note 11, at 1015.

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interpretation of its regulations.¹²⁶ To determine whether the Agency has applied its regulations appropriately courts look at the thoroughness of the Agency's considerations, the soundness of the Agency's reasoning, the consistency of other Agency assertions, and other persuasive factors.¹²⁷ Amending the TMEP to allow for the use of de facto functionality easily falls within the scope of the USPTO's authority.

There are many alternatives for providing the fashion industry with the trademark protection it deserves but pretending that protection is strong enough by limiting brands to the current framework, suggesting that the fashion industry does not want protection at all, or enacting generic *sui generis* legislation are not good options.¹²⁸ Approaching the functionality bar from a new perspective using de facto functionality and de jure functionality is a good place to start.

V. CONCLUSION

The USPTO can allow hundreds of fashion brands to protect innovative designs and creations by diminishing the functionality bar to registration without amending the Lanham Act or creating *sui generis* protection for the fashion industry.

The current approach allows for widespread copying and creates confusion at both the purchasing stage and post-sale stage of consumer interaction with the product. The Lanham Act facially denies protection for functional features; however, approaching the Act from a different perspective would allow the USPTO to offer protection to fashion while still barring protection for apparel. Simply differentiating between types of functionality with the terms de facto and de jure, would enable the USPTO to clarify the limitations on registration caused by functionality while fulfilling the purpose of trademark law to protect the consumer from confusion and protect the good will that a creator develops through his or her investments.

The fashion industry contributes significantly to the U.S. economy, and deserves stronger protection that promotes both domestic and international competition. Although trademarks are considered a strong form of protection, the fashion industry does not receive all of the benefits because of limitations imposed by the USPTO in its interpretation of the Lanham Act. By diminishing the functionality bar to trademark protection, the USPTO would enable fashion brands to register de facto functional marks and receive protection for their brand indicia. This approach directly benefits designers without causing a significant negative impact on others in the market. Ultimately, and perhaps most

126. See *Skidmore v. Swift & Co.*, 323 U.S. 134, 140 (1944).

127. See *id.*

128. Alternatively, it has been suggested that the entirety of § 2 of the Lanham Act is facially unconstitutional on the basis that it discriminates against private speech. Oral Argument at 00:17, In re Tam No. 14-1203 (Fed. Cir. 2015), http://www.cafe.uscourts.gov/oral-argument-recordings?title=in+re+tam&field_case_number_value=2014-1203&field_date_value%5Bvalue%5D%5Bdate%5D=. That case, however, was resolved in *Matal v. Tam*, 137 S. Ct. 1744 (2017). The Supreme Court narrowly decided that only the disparagement clause was unconstitutional on the grounds of free speech. That ruling could signal an openness to eliminating other bars to trademark protection.

importantly, this approach would eliminate significant market confusion and create a pronounced benefit for the consumer. By barring brands from registration for de facto functional indicia, the law quashes creativity, promotes widespread design piracy, and fails to fulfill its purpose.