

FEATHERS, HATS AND COPYCATS

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Legal Briefings - By **Emma Iles** and **Alicia Simonds**

Australian fashion designers have their feathers ruffled over claims of copyright infringement.

Following on from Fashion Week in New York, London and Paris, Melbourne's own Spring Fashion Week has just come to a close. But it's not all beautiful people, glamour and champagne. A storm has been brewing among the fashion community that has recently seen one milliner strip her social media pages of images of her work in reaction to perceived copying of her designs and in an attempt to safeguard those designs from perceived copycats.¹ This is a significant step at a time when Melbourne is gearing up for the Spring Racing Carnival where headwear is a de-rigueur for any female race-goers. And it's not the first time this year that both independent designers and fashion labels have clashed over believed imitations, with Australian clothing brands Gorman, Cotton On and Triangl also alleging or defending claims of copyright infringement.²

In a world of colour, there are grey areas when it comes to legal protection for fashion designs. Below is a brief summary of the role intellectual property rights play in the protection of such designs.

HOW CAN FASHION DESIGNS BE PROTECTED UNDER AUSTRALIAN LAW?

The recently reported copying allegations revolve around jewellery, print, fabric and, of course, millinery designs. The main sources of protection available to such fashion designs are copyright, designs and consumer law.

Copyright protection

Copyright protection attaches to original, relevant subject matter automatically when it is created and, for artistic works, endures for the life of the author plus 70 years. Sounds simple enough. But what is relevant subject matter?

Copyright law can protect original fashion designs if they fall within a recognised category of 'artistic work'. These categories include, relevantly, paintings, drawings, engravings (including prints) and 'works of artistic craftsmanship'. To the extent that a fashion design is originally recorded or exists in final form as a drawing, painting or engraving, it can be protected by copyright.

The fashion designs could also be works of artistic craftsmanship. These are works with artistic quality created by someone with specialised skills and knowledge and with artistry. A fashion design could accordingly be subject to multiple, overlapping copyrights. For example, the drawing of a fascinator can be a copyright work and a separate copyright can exist in the 3D form of that fascinator as a work of artistic craftsmanship.

If copyright exists in a fashion design then the designs' creator can prevent others from replicating the original design in its entirety. Copyright will also prevent the reproduction of something less than the whole of the original design if what is taken is qualitatively and quantitatively a substantial part of the original. It is where a design seeks to reference another without directly reproducing it that it can become grey as to whether a substantial reproduction has occurred.

Designs protection

The fashion designs could separately be protected by designs law with the exception that dual protection for certain artistic works will be prevented.

Designs law can protect a fashion design that is new and distinctive. In contrast to copyright law, designs must be registered to be protected and once registered, will be protected for a maximum of 10 years. A design registration is intended to protect the overall visual appearance of a product, which includes shape, configuration, pattern and ornamentation. The registration requirement and short seasonal life-span of designs are reasons why designers in the field of ever-changing fashion may choose not to register their designs. This can have adverse implications for the ability to protect a design as discussed below.

Like copyright, a designs registration allows the owner not only to prevent exact replicas but also products embodying a design that is substantially similar in overall impression to the registered design. The extent of similarity necessary for infringement is another grey area in the law and in the case of registered designs, relates to how distinctive the registered design is from the prior art (i.e. what has come before). As a general rule, the greater the leap from the prior art to the design, the greater the protection given to the registered design and the more likely it is that a product referencing the registered design will infringe.

The overlap between copyright and designs

A fashion design, such as a fascinator, may qualify to be considered as a copyright work (by virtue of being an artistic work) and the corresponding design, a registrable design. The law provides for this overlap by preventing the enforcement of copyright in certain situations. Full copyright protection will however be maintained for fashion designs consisting of 2D patterns or ornamentation that can be applied to the surface of articles, for example fabric designs.

Copyright cannot be enforced against the embodiment of a corresponding design in a product where:

1. The visual features of shape and configuration of an artistic work are registered as a 3D design (i.e. the fashion design can only be protected under designs law); or
2. The visual features of shape and configuration of an artistic work are not registered as a 3D design but the design has been 'industrially applied' (i.e. commercially manufactured) and the resulting products offered for sale or otherwise made available to the public. A design will be considered to have been industrially applied if 50 or more copies have been produced but, to add a little more grey, something less than 50 may also suffice depending on the circumstances.

Importantly, the second exception listed above does not apply to unregistered designs that are works of artistic craftsmanship. These works will be protected by copyright regardless of whether or not they have been industrially applied. Additionally, custom-made or limited edition designs that often occur in the millinery industry will likely retain copyright protection because they won't be considered to have been industrially applied.

The copyright/design overlap provisions will however be an issue for designers whose work is not registered as a design, is not considered a work of artistic craftsmanship and where the design has been applied to a significant number of articles that are available to the public for sale. In this situation, copyright is unlikely to be enforceable against the embodiment of a fashion design in a product, leaving the unregistered design without the protection of either copyright or designs law.

But rather than fall entirely through the cracks, consumer law may assist the owners of such designs. Consumer law acts to prevent conduct that is misleading or deceptive, and prevents false representations that goods have sponsorship, approval or affiliations with the other goods that they don't actually have. So if a label or brand is well-known for a particular design that's been copied by someone else and a reasonable consumer would think that the 'copied' product is somehow associated with the original label, then this may constitute misleading and deceptive conduct or a false representation.

BACK TO THE MILLINERS

Shifting focus back to the milliners who have been the subject of recent media attention, what steps can they take to protect their designs?

Ultimately the most appropriate means of protection for and enforcement of rights in a fashion design will depend on the individual circumstances. It is therefore important that designers seek legal advice regarding the nature of their business and what policies can be employed to maximise their ability to deploy IP rights to their advantage in the future. For example, advice regarding whether the type of works they produce can be protected by copyright as works of artistic craftsmanship or whether design registrations should be considered. Regardless, it will be important for designers to keep good records regarding the steps involved in creation of their work. This will help in establishing ownership and subsistence of intellectual property rights.

Finally, although enforcement of legal rights can be expensive, that cost should be carefully weighed against the costs to a designers' business when they react to the threat of copying by removing images of their work from their websites and social media, foregoing the associated marketing benefits and reputational growth. With the benefit of legal advice, many disputes of this nature can be resolved quickly and commercially through correspondence, without the need to go to court. Further, when IP and consumer rights are enforced against one offender this sends a strong message to other potential copycats, providing ongoing, positive effects beyond the current dispute.

ENDNOTES

1. SMH, 21 September 2016: [Spring racing fashion 2016: Milliners feud with rivals over copycat claims](#).
2. News.com, 18 May 2016: [Cotton On sued over 'knock-off' shirts](#); Business Insider, 25 June 2016: [An insanely popular Victoria's Secret swimsuit looks almost identical to one designed by a smaller company](#); SMH, 4 August 2016: [Gorman accused of ripping off indie artists' work](#).

KEY CONTACTS

If you have any questions, or would like to know how this might affect your business, phone, or email these key contacts.



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