

EXPANSION OF TRADEMARK DOCTRINE: AN ATTEMPT TO PROTECT FASHION CLOTHING AND ACCESSORIES

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ABSTRACT

Fashion designers have failed to achieve greater levels of protection for their creations under the copyright and patent laws. The designers eventually turned to courts for enforcement of trademark rights as trademark law emerged to be the strongest tool to safeguard fashion clothing and accessories. This has led to a greater need to expand the contours of Trademark law by the courts so as to also include the protection of quasi-designs. These designs are the shapes or patterns that are used as part of a label or logo. In certain cases, American courts enormously expanded the traditional scope of trademark law by recognising a single colour as trademark. Such decisions have augmented the possibilities of designers getting long-term, permanent rights in quasi-designs that are used as logos. Heavy dependence on trademark protection by the fashion industry has favoured the big brands but not the new and emerging designers. This has distorted innovation as it has induced lessor creativity in designs for fashion.

INTRODUCTION

A fashion company launches a new line in December and after few weeks, counterfeit and knock-off versions appear at retail outlets and stores. It becomes crucial for the company to determine the various alternatives available to prevent loss of revenue to counterfeits and knock-offs. Intellectual property laws form the protective means for the fashion companies or the garment industry to protect its products. Whether it is a newly start-up fashion company or an international brand, the foremost intellectual property preferred by both for launching a clothing line continues to be trademark protection. Trademark protects the name, label, symbol, sign or slogans of the clothing brand. Trademarks are fixed on conspicuous part of the garment. A trademark needs to be registered under the Trademark Act, 1999. Mere registration of domain name is no use of trademark. A trademark search is important to receive registration once a distinctive, unique and a non-descriptive name is selected. Before investing or starting a new clothing line or venture, it is important to file trademark application. If international markets are targeted, then separate trademark applications have to be filed within each of these countries unless a simpler method of registration such as Madrid Protocol is chosen. Copyright also protects the clothing line. The unique and original designs or artistic patterns used on clothing are copyrightable. Any artwork used on dress is copyrightable unless it becomes the means to identify a brand, in which case trademark becomes more significant. Clothing designs are not protected by copyright as they are three-dimensional works. Brand names are most common form of trademarks that is resorted to by the fashion industry. Colour marks and smell marks are also utilised especially in few notable international cases which came forward in recognising author's intellectual property in a colour applied on fashion item or smell of a perfume. The fashion industry sometimes chooses its owner's name as trademark, such as Sabyasachi or Armani, etc. However, the trademark law requires that the customers see and designate the person's name as the authentic source of the origin of the product. This is achieved through massive advertisement campaign and aggressive promotion of the brand name. A designer who is about to launch a brand must be careful while registering a trademark so as to ensure that he owns all the rights in the mark exclusively. An employer who invests in the designer's name as a brand would certainly covet signing contract with the designer to sacrifice some of his intellectual property rights in favour of the employer.

TRADEMARKS FOR GARMENT AND APPARELS

Copyright protection is not available for a garment design but only for two-dimensional sketch or drawings of the garment or floral prints or designer patterns on it. Garment is a fashion article with a useful function and useful articles are not given copyright protection. Only such attributes or features of the garment that are not useful and can be segregated from useful ones, are capable of copyright protection. This is a Hercules task and a great thing to pull off to actually separate a garment's useful and non-useful components physically before a court of law. Even conceptually, it is difficult to do so. In a copyright battle against a knock-off designer, it is imperative to prove before the court that the artistic elements on a garment can be separated from the garment itself. In the alternative, if it is possible, the fashion designer can also prove that the garment or clothing is not functional. However, courts do not give protection to garments but to the sketches or drawings of it. Copyright protection is given to designer patterns or prints on the garment which qualify as artistic works. Garments or apparels do not qualify for patent protection either. Only a very newly innovative wearable technology may get patent. A garment is non-patentable for reasons of anticipation by prior art. In United States, a design patent may be given for appearance of a garment, sunglasses, handbags or fabrics. Patent protection is not a pragmatic option for fashion designer anyway. Acquiring a patent consumes massive time. It is not conducive for a fashion designer to wait that much. Utility patent may also be a good option, if new technology such as a method for dyeing jeans, etc. is invented. Thus, trademarks emerge as the best form of intellectual property protection for a fashion designer for protecting his innovative creations. Trademark protection is very strong and holds massive potential for a brand to grow beyond measure. It is important that the trademark is renewed from time to time. Christian Dior, Louis Vuitton, Fabindia, Sabyasachi, Chanel, etc. are some of the very strong labels and logos that are used as trademarks to designate garments, jewellery and other fashion accessories. In a lawsuit for trademark infringement, millions of dollars are paid as damages especially if it is an action by an international brand. For instance, in 2008, Adidas was awarded 305 million worth damages in a trademark infringement suit against Payless shoes. Adidas had claimed that Payless shoes attempted to sell two and four stripe shoes which closely resembled the three striped shoes of Adidas.¹ If the product's image and overall appearance is distinctive and capable of forming such identity of its source in the minds of the consumers, it can be protected as trade dress. Any type of distinctive packaging of a product or its website or store can be protected as trade dress.

Trade dress is not functional. It can be inherently distinctive or may acquire distinctiveness through secondary meaning. Burberry's use of plaid pattern in different colours on handbags and garments is an example of trade dress. In any case, a fashion designer and the industry has largely resorted to trademark protection owing to lack of protection from patent and copyright laws especially in case of garments. Copyright cannot protect functional articles of fashion thereby disqualifying bags, footwear, sunglasses, trousers and T-shirts from protection barring the artistic or graphical works used upon them. Several jurisdictions recognise the doctrine of conceptual separability as in United States to protect non-functional or non-useful elements of a dress alone as long as it is capable of being separated from the useful elements. Patents cannot protect fashion for procedural and structural reasons especially in case of short-lived fashion trends. Thus, fashion industry has come up in such a way that it relies heavily on trademarks to protect its products. However, copyright and patent as intellectual property right are quintessentially incentive-based. They are intended to protect the creator of the work. But trademarks are to designate a product's source or origin. A trademark is a permanent form of protection and easily enforceable in a court in terms of costs and time involved. Sometimes, a registered trademark may be embedded in a fashion design as well in an event of counterfeiting. In *Louis Vuitton Malletier v Dooney and Bourke Inc.*, the U.S. District Court gave protection to the Louis Vuitton "LV" label. Louis Vuitton designs versatile handbags of supreme quality. It uses a Toile monogram consisting of interweaved "LV" initials set against one of the three motifs.ⁱⁱ This design is registered as trademark by the company with United States Patents and Trademark Office (USPTO). Subsequently in October 2002, Louis Vuitton updated this Toile monogram of "LV" Initials in nearly eighty-three colours using the black or white background.ⁱⁱⁱ Louis Vuitton later sold 70000 handbags and accessories using the new design pattern. In July 2003, Dooney & Bourke, an American firm engaged into the business of selling handbags used its initials "DB" in a similar pattern for its line of "It-bag" handbags. The firm used interwoven "DB" initials using different colours on a variety of diversely coloured backgrounds. Louis Vuitton sued Dooney & Bourke for trademark infringement and dilution and unfair competition. This was a case where the company could not rely upon trade dress protection. A design was incorporated into a trademark. It was expected that the court might extend the trademark protection in such a way that it will also protect the design. Louis Vuitton lost the case. The court did not question the validity of the Louis Vuitton trademark. The court did not expand the trademark protection and instead focused on the issue of 'likelihood of

confusion'. This is one of the American cases where an attempt was made to protect a design as a logo.

SINGLE COLOUR MARKS

Christian Louboutin, a French fashion designer, is enormously famous for its red coloured outsoles in its high heels internationally. In 1992, the company acquired 'Red Sole Mark' for its lacquered red stilettos from USPTO. Subsequently, another American company YSL made similar shoes with coloured outsoles. The company used all sorts of colours such as green, blue, purple, matte red with unique shades.^{iv} In a trademark infringement suit by Louboutin against YSL, the District court did not consider the Louboutin's signature red sole mark worthy of protection. The court felt that colour has uniquely artistic and expressive purposes in fashion industry, which is highly reliant on colours. Thus, trademarking a single colour would mean restriction on the artistic freedom of the industry. This would, instead, contribute to the promotion of unfair competition. However, when the matter went into appeal to the court of Second Circuit, the court recognised the trademark rights of Louboutin in single red colour. The court reasoned that the red sole mark of Christian Louboutin had acquired secondary meaning. The only condition attached was that the red sole must contrast the remainder of the shoe for the mark to be valid. The second circuit took its stance that YSL use of monochrome design, without any contrast between the red outsole and upper part of the shoe was different and did not infringe Louboutin's red sole mark. These cases highlight the attempt to protect designs under the trademark law as copyright law cannot do it owing to the doctrine of conceptual separability. Designers in such lawsuits try to protect their creations using labels instead of designs. Counterfeiting would become difficult if clothes are uniquely designed or tailored. As fashion cycle moves faster many designs are launched that lasts only up to a few seasons. These are short-term and trademark is considered highly inappropriate to protect these replaceable creations. The trademark owners do not contribute to the society's creative pool. There is a tendency to copy the most popular and easily recognisable brands on unconventional places and items such as bags, etc. Trademark protection also acts to the detriment of new and emerging fashion designers. Trademarks have well-known and strong reputation in case of big famous brands. These brand owners are likely to augment their utilisation of trademark on its

merchandise. This stifles the competition for designers who are new in the market as they now have to struggle harder to establish their brands.

Colours were never recognised as marks traditionally. However, the courts began to recognise colours as trademarks owing to the secondary meaning achieved. Establishing colour as trademark in the court is challenging and monopolising a particular colour can adversely affect the competition. In the fashion industry, every fashion designer chooses to launch a fashion line utilising his own colour scheme. These colours are picked up on the basis of latest trends in the market. Consumer also restrict their demand towards much popular trends in a given season. Trademark protection does not extend to functional features or elements of a product. If colours are allowed to be monopolised by registering them as trademarks, lessor colour would be available for further use. This is also called the colour depletion theory in the United States. However, the way in which colour palette is used in the fashion industry, it draws consumers and augments sales. The courts in United States have reiterated that colour depletion theory does not put a bar on registration of colour marks per se. The defendant who wishes to oppose registration of a colour mark might resort to colour depletion theory or show that colour in a fashion product is serving only a functional purpose. Colour trademarks pressurise the designer of a brand to identity his brand's signature colour and put it to consistent use. So far seasonal creations are concerned, the brand might have to change colour palette with every season. As a consequence, there is dearth of colours remaining to be chosen as signature colour for all seasons by the brand. The signature colour would have to blend with consumer's and designer's choices for seasonal collections. If the designer covets a colour for his brand based on seasonal considerations, none of the colours would be available to add to his brand's distinctiveness. Christian Louboutin's red sole mark may argue on the basis of colour depletion theory. The opposing parties can advance an argument that very less colours are available (except neutral shades or black colour) that contrast with the remaining part of the shoe. It brings them competitive disadvantage. Besides, as new designers enter the market and as other shoe designers opt for colour marks, there will be depletion of colour palette with competition getting more intense. This would deter the new footwear designers to use colours in their shoe designs as lessor colours would now be available for use in the public domain. Colour cycles also limit the number of colours available especially the ones that are trendy in a particular season. Most of the major colours like black, red, white, navy or ivory is beyond trends and are not seasonal colours. These colours are limited in number collapsing the number of choices left

for the competitors. Colours that will only last for a season may not be a good choice for a designer as it will prevent brand building in the long run for the colour's incapacity to tolerate trends. On the contrary, a colour trademark is likely to prevent the competitors from using that colour. Thus, colour depletion theory as advanced in some cases in United States is one of the strong defences from registration of a colour mark. Another argument against colour marks is functionality as it is used traditionally for similar type of fashion products and in the same context and that permitting monopoly in that colour would jeopardise the interests of other competitors. If a colour happens to be a natural choice for any particular product in time with the purpose with which it is launched, then it might not be awarded trademark protection. For instance, jewellery using sea shells is likely to use white or blue colour shades. These are based on themes close to ocean and sea. It would be difficult to register this colour for such jewellery as a trademark. These are based on the ways in which the consumers associate a colour to a fashion accessory. The colour 'red' is often associated with luxury and 'purple' symbolises wealth. If registered as trademarks, the other designers in the market are deprived of the use of these colour giving them competitive advantage. But registration of a trademark ought to give competitive advantage to rightful owner for which he intended to register his mark. On the contrary, the defendants have to prove the existence of an alternative market to defend an action for trademark infringement based on a single colour. If Louboutin red-soled high heels are sold in the market because of the status the brand enjoys, it may not protect its red colour mark unless secondary meaning could be attributed to this mark. Louboutin red soles heels were successful with sales establishing the fact that it may not always be the artistic creativity that drives consumers to buy a product. The red-sole heels had acquired distinctiveness the way the consumers associated with it. Functionality requires a nexus between the meaning attributed to the colour mark by the consumers and the increase in sales of the product using that colour.

Thus, colour depletion theory and functionality are strong defences against the validity of a colour mark. However, if the use of colour by the brand has acquired secondary meaning, the courts would strongly favour the colour trademark. It is difficult for a colour to obtain secondary meaning owing to seasonal nature of the fashion industry. The fashion trends and fashion colours also change faster. Generally, designers would not generally confine themselves to the use of a single colour as they are under constant pressure to reinvent new designs for every season. In such a scenario, only when a designer chooses to consistently use a single colour on its product it can acquire secondary meaning after a certain period of time.

In the past, very few colours were available to the consumers. The colour palette is more extensive with more variety of colours to choose from. Colours are not so influential today. The courts would now no longer accept the colour depletion theory.^v In the contemporary times, use of colour marks would not be a problem. Designers can use unexpected colours or take advantage of weak colour memory of consumers. Colour marks is now capable of adding distinctiveness to a design and can prevent others from copying or pirating the design. Colours are changing at a rapid pace. However, if any colour is emulated, which has some connection with a designer's brand, it can act as a strong identifier of the source or origin of the fashion product.

ARE SINGLE COLOUR MARKS REGISTRABLE IN INDIA?

Single colour trademark claim for 'RED SOLE' mark by Christian Louboutin before Indian courts was made for the first time in 2017 when the Delhi High Court confirmed the award of trademark status to well-known mark of red-soled high heels on the grounds of continuous use and global presence.^{vi} Amid the controversy, two another lawsuits were filed later before the Delhi High Court by Christian Louboutin. In *Christian Louboutin v Abubaker*, the court did not favour grant of registration to 'RED SOLE' mark as trademark in India after considering the lack of legislative and judicial interpretations available on the subject.^{vii} However, in July 2018, similar issue was brought before the Delhi High Court in *Christian Louboutin v Ashish Bansal*, where the court favoured the grant of punitive damages.^{viii} These three diverse lawsuits clearly demonstrate the dearth of judicial precedent elaborating upon the registrability of single colour trademarks in India.

Thus, the companies that aggressively innovative should be given the opportunity to preserve their interests even where the laws fail to address the issue of single colour marks. In the United States, a single colour mark can avail trademark registration, if it acquires 'secondary meaning' and is not functional. However, India is yet to form a clear ground on this subject.

CONCLUSION

Louis Vuitton Malletier v Dooney & Bourke, Inc. represents the battle pursued by big brands against fashion piracy in the United States. The request to provide necessary protection to designs was refused in the American fashion industry. Vuitton failed to protect its monogram design under the existing patent, copyright or trade dress laws. And so, it tried to convince the court that the original design was part of the original toile monogram trademark of Louis Vuitton so as to enable the design to get trademark protection. The courts did not extend trademark protection to the design consisting of colours as part of Louis Vuitton's trademark thereby weakening the protection for designs. The Louboutin case continues to be a weak precedent so far as protection of single colour trademark is concerned. Louboutin did not claim trademark in colour 'red' but in 'a lacquered red sole' on high heels. The courts may consider the facts in light of the exact situation when it comes to claims of colour marks vis-à-vis claims of functionality or colour depletion theory. Likelihood of confusion should not be the only determining factor. The court must inquire into the probabilities of protecting a single colour mark which is non-functional and distinctive in fashion.

REFERENCES

ⁱ Adidas-America, Inc. v Payless shoesource, Inc., 546 F. Supp. 2d 1029.

ⁱⁱ Louis Vuitton Malletier v Dooney & Bourke, Inc., 454 F. 3D 108, 112 (2nd Cir. 2006).

ⁱⁱⁱ *Id.*

^{iv} Christian Louboutin SA v Yves Saint Laurent Am. Holding, Inc., 696 F. 3d 206 (2d Cir. 2012).

^v DAP Products v Colour Tile Manufacturing, Inc., 821 F. Supp. 488 (S.D. Ohio 1993).

^{vi} Prashant Reddy, By Invitation: The Delhi High Court Declares Louboutin's Red Sole As a 'Well Known Trademark' SpicyIP (2017), <https://spicyip.com/2017/12/by-invitation-the-delhi-high-court-declares-louboutins-red-sole-as-a-well-known-trademark.html> (last visited Nov 8, 2019). The Delhi High court gave this decision in Christian Louboutin v Pawan Kumar 2018 (73) PTC 403 (Del).

^{vii} Christian Louboutin v Abubaker (2018) 250 DLT 475.

^{viii} Christian Louboutin v Ashish Bansal 2018 SCC online Del 10205.