

Protectable Plaids?

by Larry Russ and Nathan Meyer

Plagiarism may be the sincerest form of flattery, but it can get you into trouble. In the clothing industry, copying can lead to all-out war in the courtroom. Still, it's one thing to make a liability claim and quite another to prove it. A ruling last year in a battle between two apparel rivals offers guidance for future claimants.

In *Express LLC v. Forever 21, Inc.* (2010 WL 3489308 (C.D. Cal.)), a Los Angeles federal judge rejected a manufacturer's copyright claims based on the use of purportedly protectable plaid designs on shorts.

Copyright Proof

To prevail in a copyright claim, the plaintiff must prove that the design of the item in question is original. The keys to demonstrating originality are good record keeping and witnesses with good memories.

Express LLC, a nationwide retailer with more than 500 stores, contended that its plaid designs were original, and it presented the court with copyright registrations. However, there was a problem: Many similar plaid designs preexisted the ones at issue.

When Express LLC's designer testified in deposition, he admitted having been "inspired" by the preexisting designs, but his recollection of his particular creative process was hazy, to say the least. He admitted that he'd started out with another design but did not retain it. The designer said he was certain he'd made changes, but he could not recall them in any detail.

Because the record did not contain sufficient evidence of originality, the court granted Forever 21's motion for summary judgment; absent such evidence, even the plaintiff's registered copyright was not enforceable. The court noted that although the registration might be entitled to presumptive effect, the defendants adequately rebutted the presumption by presenting the designer's deposition testimony that he'd relied on preexisting patterns. (See 2010 WL 3489308 at *5 – 7.)

What does this holding mean for future cases? It is bound to increase the burden on copyright trolls (the proliferation of such lawsuits in California's Central District may go a long way to explain the tone of the ruling). Moreover, it emphasizes the need for full disclosure to the copyright office at the time of registration, and full investigation of authorship prior to filing suit. Future plaintiffs must bring more than a copyright registration to the courthouse; they must present proof of originality. And if their works are derivative, they must demonstrate that they contain significant original elements.

Trade Dress Evidence

The *Express* ruling also clarified, for the first time in California law, the showing required to establish protectable "trade dress" in clothing. For one season Express LLC had marketed--in stores and on its website--a jacket festooned with a chest pocket zipper, a passport stamp emblem, graphic numbers and lettering, and satiny accent strips. There was no copyright at issue; instead, the company contended in the same lawsuit that because its jacket constituted protectable trade dress, the defendants should be enjoined from copying it.

But the court rejected this claim as well. In order to achieve protectable trade dress, a garment must have "secondary meaning." In legal terms, there must be a "mental association by a substantial segment of consumers and potential customers" between the item in question and "a single source of the product."

Express LLC urged the court to find liability simply because Forever 21 had copied its jacket. But the court refused to do so, because taking that approach would mean that in future cases virtually every garment Express LLC sells would have secondary meaning. (See 2010 WL 3489308 at *7 – 9.)

To prove that a product deserves trade dress protection, the plaintiff must establish that the design, by itself, identifies the firm that produced it. A classic example is the Coke bottle: Everyone knows which company makes that item.

One effective way to prove secondary meaning is to conduct a market survey and record responses when the public is shown the disputed item. An expert survey, said the court, "typically provides the most persuasive evidence." (See 2010 WL 3489308 at *8.) But in the case of the copied jacket, Express LLC could not demonstrate a connection between the article of clothing and the company that produced it.

The lesson to be learned from this ruling is that trade dress plaintiffs must undertake serious, in-depth investigation before they file a claim--and then consult with experienced counsel to make a realistic assessment of the merits of the case. Otherwise, a company could incur hundreds of thousands of dollars in attorneys fees seeking legal protection that doesn't exist

Larry Russ is the founding partner of Russ August & Kabat in Los Angeles, where he focuses on IP litigation and represents emerging technology companies. Nathan Meyer is an associate at the firm.