



Volume 6, Number 2  
Spring 2015

Contents

---

**ARTICLES**

The History and Principles of American Copyright Protection for Fashion Design: A Strange Centennial <i>Charles E. Colman</i> .....	225
The History and Principles of American Copyright Protection for Fashion Design: On 'Originality' <i>Charles E. Colman</i> .....	299
Implementing a Franchise Player Designation System in the National Basketball Association <i>Scott Bukstein and Jacob Eisenberg</i> .....	345

**COMMENTARY**

Without Consequence: When Professional Athletes Are Violent off the Field <i>Bethany P. Withers</i> .....	373
--	-----



**Harvard Journal of Sports & Entertainment Law**

Student Journals Office, Harvard Law School

1541 Massachusetts Avenue

Cambridge, MA 02138

(617) 495-3146; jsel@law.harvard.edu

www.harvardjsel.com

U.S. ISSN 2153-1323

The *Harvard Journal of Sports & Entertainment Law* is published semiannually by Harvard Law School students.

**Submissions:** The *Harvard Journal of Sports and Entertainment Law* welcomes articles from professors, practitioners, and students of the sports and entertainment industries, as well as other related disciplines. Submissions should not exceed 25,000 words, including footnotes. All manuscripts should be submitted in English with both text and footnotes typed and double-spaced. Footnotes must conform with *The Bluebook: A Uniform System of Citation* (18th ed.), and authors should be prepared to supply any cited sources upon request. All manuscripts submitted become the property of the JSEL and will not be returned to the author. The JSEL strongly prefers electronic submissions through the ExpressO online submission system at <http://www.law.bepress.com/expresso>. Submissions may also be sent via email to [jselsubmissions@gmail.com](mailto:jselsubmissions@gmail.com) or in hard copy to the address above. In addition to the manuscript, authors must include an abstract of not more than 250 words, as well as a cover letter and resume or CV. Authors also must ensure that their submissions include a direct e-mail address and phone number at which they can be reached throughout the review period.

**Permission to Copy:** The articles in this issue may be reproduced and distributed, in whole or in part, by nonprofit institutions for educational purposes including distribution to students, provided that the copies are distributed at or below cost and identify the author, the *Harvard Journal of Sports & Entertainment Law*, the volume, the number of the first page, and the year of the article's publication.





Volume 6, Number 2

Spring 2015

EDITORIAL BOARD

*Editor in Chief*  
Kim Miner

*Editor in Chief*  
Kyle Schneider

*Executive Editor*  
Daniel Ain

*Executive Editor*  
Willimina Bromer

*Executive Editor*  
Jay Cohen

*Executive Editor*  
Joo-Young Rognlie

*Managing Editor*  
Jonathan Diaz

*Production Chairs*  
Adam Rosenfeld  
Shuangjun Wang

*Submissions Chairs*  
Jeffrey Huberman  
Jeremy Winter

*Highlights Chairs*  
Jason Fixelle  
Megan Michaels

*Online Content Chair*  
Tilak Koilvaram

*Notes Chair*  
Michael Brandon

*Solicitations Chair*  
Michelle Elsner

Elliot Bromagen  
Sophia Jeewon Choi  
Ella Cohen  
Wesley Dietrich  
Martin Erreich  
Laura Escalona  
Timothy Fleming  
Michael Gocksch  
Katherine Hardiman  
Elisa Hevia  
Elizabeth Houghton

*Submissions Committee*  
Keith James  
Rebecca Johnson  
Jose Lamarque  
Cody Lawrence  
Matthew Lee  
Zoya Lozoya  
Douglas Margison  
Michael Mattheiss  
Miranda Means  
Megan Michaels  
Jennifer Mindrum

Christopher Namba  
Hillary Preston  
Nick Purcell  
Harry Rudo  
Jeremy Salinger  
Andrew Santana  
Scott Sherman  
Loren Shokes  
Zachary Sonenshine  
Jonathan Weinberg  
Alex Zuckerman

Timothy Fleming

*Senior Article Editors*  
Marissa Lambert

Sam Stuckey

Ella Cohen  
Martin Erreich  
Jonathan Gartner

*Article Editors*  
Elisa Hevia  
Cody Lawrence  
Douglas Margison

Hillary Preston  
Nick Purcell  
Harry Rudo

Elliot Bromagen  
Sophia Jeewon Choi  
Wesley Dietrich  
Laura Escalona  
Stacie Friedman  
Richard Gadsden  
Michael Gocksch  
Katherine Hardiman  
Elizabeth Houghton  
Tyler Hunt

*Editors*  
Tucker Hunter  
Ryan Issa  
Rebecca Johnson  
Allison Kempf  
Jose Lamarque  
Michael Mattheiss  
Miranda Means  
Jennifer Mindrum  
Christopher Namba  
Cyrus Nasser

Crystal Nwaneri  
Jeremy Salinger  
Andrew Santana  
Scott Sherman  
Loren Shokes  
Olivia Smith  
Zachary Sonenshine  
Saukshmya Trichi  
Stephanie Vara

*Notes Editors*  
Patrick Gutierrez  
Matthew Lee





The History and Principles of American Copyright  
Protection for Fashion Design:  
A Strange Centennial

Charles E. Colman\*

SERIES PREFACE

Between 1914 and 1916, the United States Congress saw the first serious round of lobbying by advocates seeking more robust legal protection of original industrial design and applied art, including fashion design. In the subsequent hundred years, the fashion industry has become a powerful (if fractured) force on the American legislative scene—yet fashion designers and their allies have continually failed to persuade Congress to amend federal statutes to provide greater rights in the appearance of their creations. At the same time, these stakeholders have pressed their cause in the courts, with varying results. This series of articles examines the U.S. federal courts' adjudication of the resulting disputes. In the process, the articles to come will highlight tacit assumptions, unacknowledged inconsistencies, and irreconcilable tensions in the case law. At the same time, this series will seek to shed light on largely unrecognized consistencies, coherent but under-theorized quasi-doctrines, and systematic principles that characterize—and, in many instances, are arguably unique to—U.S. “copyright-for-fashion” jurisprudence.

Before embarking on this journey, it is necessary as an initial matter to dispose of the commonly recited myth that there is “no copyright for fashion” under U.S. law. In fact, certain components of fashion design receive

---

\* Acting Assistant Professor, NYU School of Law. © 2015 Charles E. Colman. I would like to thank Francis Galasi, Rachael Griffith-Pierce, Yin Huang, Guillermo Jimenez, Barbara Kolsun, Angela Lelo, Ariana Lo Giudice, Hannah Mrakovich, Sam Van Eichner, and the editors and staff of the *Harvard Journal of Sports and Entertainment Law* (especially Jeff Huberman, Marissa Lambert, and Sam Stuckey.)

substantial—arguably too much—copyright protection under Title 17 of the U.S. Code, while others receive levels of protection that tend to hover somewhere between “nothing at all” and the full “bundle of rights” associated with contemporary American copyright. (Still other aspects of fashion design effectively receive copyright-like protection through trademark law, the recently reinvigorated vehicle of design-patent law, and/or causes of action under state law—though these sources of rights are generally beyond the scope of this series.) As these articles will show, the current legal landscape is the fractured, but fascinating, outcome of a confluence of historical developments, strategic litigation by stakeholders, innovative and/or counterintuitive application of precedent by federal judges, and other variables.

Of course, this series is by no means the first scholarly examination of fashion design and copyright protection under American law. Indeed, recent years have witnessed a proliferation of commentary by legal academics, practitioners, and others regarding the optimal scope and type of intellectual property protection for fashion design in the United States.<sup>1</sup> Yet much of the existing literature focuses on economic arguments for or against increased protection, other philosophical or policy-based analyses of the wisdom of enhanced rights, or political parsing of the legislative battles that have recurred over the decades. In the process, many have lost sight of the complex and idiosyncratic jurisprudential history, principles, and doctrine of *existing* copyright protection for aspects of fashion design.

The “practical” stakes of having a nuanced understanding of U.S. copyright law’s application to fashion design are hardly trivial. By one measure, “the global apparel market was valued at US\$1.7 trillion in 2012, growing

---

<sup>1</sup> See *discussion* at Eric Wilson, *O.K., Knockoffs, This Is War*, N.Y. TIMES, Mar. 30, 2006, <http://www.nytimes.com/2006/03/30/fashion/thursdaystyles/30copy.html?pagewanted=print&r=0>, [http://perma.cc/6UB4-FART] (“[I]nexpensive copies could be history if the Council of Fashion Designers of America has its way in a new anti-copying campaign in Washington. Designers like Diane Von Furstenberg, Narciso Rodriguez and Zac Posen have been journeying there to lobby for copyright protections like those governing books, music and other creative arts. Mr. Posen was in Washington on Tuesday with Steven Kolb, the executive director of the council, who said a bill could be introduced in Congress as early as today by Representative Bob Goodlatte, a Virginia Republican.”); Eric Wilson, *When Imitation’s Unflattering*, N.Y. TIMES, Mar. 13, 2008, <http://www.nytimes.com/2008/03/13/fashion/13ROW.html> [http://perma.cc/B876-D754] (“Steven Kolb, the executive director of the designers’ council, said his group would continue to push for the legislation but that it would be more difficult.”).



by 5.8% over the year.”<sup>2</sup> While the percentage of this amount consisting of American fashion is open to debate,<sup>3</sup> one can safely say that the economic importance of the industry is significant.<sup>4</sup> Yet non-partisan, sustained engagement with the contours and overarching principles of existing U.S. copyright protection for fashion has been decidedly sparse.<sup>5</sup>

This series of articles will provide an analysis—sometimes granular and doctrinal, sometimes sweeping and theoretical—of the American federal courts’ surprisingly voluminous, sometimes difficult-to-reconcile decisions concerning copyright protection for fashion design. Far from the mythic unanimity imagined by those who would declare that there is simply “no copyright protection for fashion design in the United States,” the case law in fact reflects a range of approaches to determining the rights available

---

<sup>2</sup> Ashma Kunda, “New Apparel Research: Part 1 - A Focus on Geographies,” EUROMONITOR INTERNATIONAL (Mar. 11, 2013), <http://blog.euromonitor.com/2013/03/new-apparel-research-part-1-a-focus-on-geographies.html> (citing Euromonitor International, *Passport Apparel Global* (Feb. 2013), available at <http://www.euromonitor.com/passport-apparel-global/passport-subscription> (subscription required)).

<sup>3</sup> See C. Scott Hemphill & Jeannie Suk, *The Law, Culture, and Economics of Fashion*, 61 STAN. L. REV. 1147, 1147 (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[.]”); but see *Protecting Design*, COUNCIL OF FASHION DESIGNERS OF AMERICA, <http://cfda.com/programs/protecting-intellectual-property> [<http://perma.cc/7XHJ-2Y5N>] (last visited Dec. 30, 2014) (“Accounting for more than four million U.S. workers and \$350 billion in annual retail sales, the U.S. fashion industry represents one of the nation’s largest drivers of economic growth.”).

<sup>4</sup> Far less clear is whether economic vibrancy of the industry would be enhanced or damaged by the codification of additional U.S. intellectual-property protection for fashion design. See discussion at Hemphill & Suk, *supra* note 3, at 1180 (“In an influential article, Kal Raustiala and Chris Sprigman . . . have advanced the counterintuitive argument that in the fashion industry, ‘piracy paradoxically benefits designers.’ Some observers have found their argument persuasive. Here we explain why we disagree with their argument.”) (Internal citations omitted.) Raustiala and Sprigman subsequently co-authored a book making similar arguments. See THE KNOCKOFF ECONOMY: HOW IMITATION SPARKS INNOVATION (2012).

<sup>5</sup> See FASHION LAW: A GUIDE FOR DESIGNERS, FASHION EXECUTIVES, AND ATTORNEYS xv (Kolsun & Jimenez rev. ed. 2014) (“Despite the economic and cultural importance of the fashion sector, the legal profession [has been] slow to develop specific tools and treatises to serve its fashion clientele.”) (alteration in original); Hemphill & Suk, *supra* note 3, at 1147 (noting that annual U.S. retail sales of fashion are “larger than those of books, movies, and music combined”). For critical commentary on the curious disconnect between the cultural importance of fashion and the lack of attention it receives from legal scholars, see Charles E. Colman, *Trademark Law and the Prickly Ambivalence of Post-Parodies*, 163 U. PA. L. REV. ONLINE 11, 27 (2014).

therein, along with often-idiosyncratic doctrinal vehicles for adjudicating claims for the alleged infringement of those rights.

Before proceeding, it is necessary to define the scope of this inquiry into U.S. copyright protection for elements of “fashion design.” The term “fashion” is generally used throughout this series to refer to *the design (i.e., shape, color, material, and overall appearance) of items, not exclusively* utilitarian in nature, that are created primarily to be worn or carried on the human body.<sup>6</sup> Fashion’s distinctive relationship with the body immediately differentiates it<sup>7</sup> from most other material potentially eligible for copyright law—a distinction addressed later in this series. (Indeed, the importance of fashion design’s relationship with the body and the identity of the wearer has been widely studied and hotly debated<sup>8</sup>—albeit largely outside of the legal academy.)

---

<sup>6</sup> This definition is necessarily artificial; it does not accord with either theoretical and practical perspectives. See EUGENIA PAULICELLI, WRITING FASHION IN MODERN ITALY 6 (2014) (“The doublesidedness of fashion is what makes it difficult to find a clearcut definition of the term’s ontological and epistemol[ogical] boundaries. Clothing can be different styles of dress, the empirical, personal and multisensorial realms that define the perception of the wearers, viewers and makers; fashion can be understood beyond clothing as part of wider cultural, economic and political systems including manners, behavior, way of life and taste.”). Certain practices regularly grouped with “fashion,” like the styling of hair, the use of makeup, and the application of tattoos, are largely excluded from this text—owing less to abstract difficulties than to the near-total absence of relevant U.S. legal decisions. I should note that “any definition of ‘design’ is likely to be controversial and partial . . . for reasons intrinsic to the subject: in a nutshell, the boundary between ‘art’ and ‘design’ is always necessarily fluid insofar as all artefacts can be said to have elements of both in them, whether the artefacts in question are conventionally classified as ‘art objects’ or ‘design objects.’” Jerry Palmer, *Introduction to Part I*, JERRY PALMER & MO DODSON, EDs., DESIGN AND AESTHETICS: A READER 3, 3 (Jerry Palmer & Mo Dodson, eds., 1996) (emphasis added).

<sup>7</sup> See ELIZABETH WILSON, ADORNED IN DREAMS: FASHION AND MODERNITY vii (I.B. Tauris 2013) (“Clothes are among the most fraught objects in the material world of things, since they are so closely involved with the human body and the human life cycle. They are objects, but they are also images. They communicate more subtly than most objects and commodities, precisely because of that intimate relationship to our bodies and our selves.”).

<sup>8</sup> See, e.g., Francesca Stavrakopoulou, *Female academics: don’t power dress, forget heels – and no flowing hair allowed*, THE GUARDIAN, Oct. 26, 2014, <http://www.theguardian.com/higher-education-network/blog/2014/oct/26/sp-female-academics-dont-power-dress-forget-heels-and-no-flowing-hair-allowed> [http://perma.cc/8HCP-NDT5] (“The [sartorial conventions of academia suggest] that dressing in a more conventionally feminine way is somehow more frivolous, and can undermine perceptions of a woman’s intellectual and professional skills. Dressing in order to be taken seriously indicates that the spectre of older, more explicit forms of sexism still

More often discussed within IP jurisprudence and scholarship is a different aspect of fashion, the conceptually thorny “art/design” distinction, which has sometimes presented obstacles to the consistent application of certain well-established tenets of American copyright law. Media scholar Jerry Palmer explains the fraught nature of the imagined art-design dichotomy:

It is clear that there is a tension here between the thrust of aesthetic judgment, at least according to traditional theories where it is always conceived as universalizing; and design judgment, which must articulate the functions of artefacts, where such functions are ultimately historically and sociologically determined . . . . [Yet a]ll objects have a function of some sort by virtue of occupying some place in human society . . . and all objects have to be created according to some imaginative process where the creator imagines them in their completed state before the completions occurs in actuality. This points to ambiguities in the definition of the terms ‘design’ and ‘art.’<sup>9</sup>

Some would likely identify, not unreasonably, the puzzles identified by Palmer as central to the fractured landscape of copyright protection for fashion design in the United States.

Some might highlight related structural reasons for fashion design’s idiosyncratic posture in U.S. copyright law, noting that even purely decorative aspects of utilitarian articles were not “supposed” to be covered by copyright protection in the first place. As a strictly historical matter, it is true that the ornamental components of fashion design were initially allocated to the branch of American intellectual property law known as *design-patent law*.

---

hovers over us: a woman who adopts a more feminine style is too preoccupied with pretty things to be a serious academic, because a woman can’t be both attractive and intelligent – if indeed she can be intelligent at all.”); Tracey M. Lewis-Giggetts, *The Campus Style Police: “Your Look is a Bit Wild.”*, CHRONICLE VITAE, Dec. 5, 2014, <https://chroniclevitae.com/news/826-the-campus-style-police-your-look-is-a-bit-wild> [<http://perma.cc/Z5H5-CTPP>] (“assumptions made about a person of color based on superficial and prejudiced views of ‘appropriate’ hair, dress, and clothing—particularly if held by those with administrative and hiring power—can affect critical decisions, including promotions and committee appointments”); Grayson Perry, *The Straight, White, Middle-Class Man Needs to Be Dethroned*, NEW REPUBLIC, Oct. 10, 2014, <http://www.newrepublic.com/article/119799/straight-white-middle-class-default-man-needs-be-dethroned> (“In people’s minds, what do professors look like? What do judges look like? What do leaders look like? The very aesthetic of seriousness has been monopolized by Default Man. Practically every person on the globe who wants to be taken seriously in politics, business, and the media dresses up in some way like a Default Man, in a grey, western, two-piece business suit. Not for nothing is it referred to as ‘power dressing.’”).

<sup>9</sup> Palmer, *supra* note 6, at 3.

It is perhaps instructive that the picture of copyright protection for fashion was relatively uncomplicated until design patents were judicially marginalized in the early years of the Twentieth Century.<sup>10</sup> As design patents lost their viability in federal-court litigation, designers wishing to assert exclusive rights in works of fashion, interior decoration, and other works channeled their efforts into both legislative lobbying and litigation that increasingly drew on alternative types of IP—not only copyright,<sup>11</sup> but trademark (specifically, “trade dress”) law as well.<sup>12</sup> An examination of the developments in these areas of IP law quickly reveals some of the same sociocultural dynamics that led to the multi-decade period of design patents’ near-complete irrelevance in litigation.<sup>13</sup> It seems very probable indeed that these cultural dynamics have played, and continue to play, at least as prominent a role in shaping the contours of copyright protection for fashion design as strictly “doctrinal” concerns.<sup>14</sup>

Still other features of American fashion have arguably contributed to the development of the doctrine in this area, including fashion’s “bad repu-

---

<sup>10</sup> See discussion at Charles E. Colman, *Design and Deviance: Patent as Symbol, Rhetoric as Metric*, 55 JURIMETRICS J. (forthcoming 2015). For an alternative account of this marginalization, see Jason Du Mont, *A Non-Obvious Design: Reexamining the Origins of the Design Patent Standard*, 45 GONZAGA L. REV. 531 (2010).

<sup>11</sup> See David Goldenberg, *The Long and Winding Road: A History of the Fight over Industrial Design Protection in the United States*, 45 J. COPYRIGHT SOC’Y U.S.A. 21, 27 (1997) (noting that “after the adoption of the Copyright Act of 1909, design protection strategy [in Congress] fundamentally shifted,” as “[a]ttempts to amend the design patent statute were abandoned” in favor of legislation that would provide for “a copyright-like, registration only regime (without a search of prior art”).

<sup>12</sup> See Gerard N. Magliocca, *Ornamental Design and Incremental Innovation*, 86 MARQUETTE L. REV. 846, 858 (2003) (“Taking advantage of the dual nature of trade dress, designers often try to obtain protection for their work by claiming that it performs an identifying function for consumers.”) (Internal footnote omitted, due in part to this author’s disagreement with much of Magliocca’s historical and policy analysis.).

<sup>13</sup> See Sarah Burstein, *GUEST POST: “What makes a fashion design ‘obvious?’”* by Sarah Burstein (Associate Professor, U. of Oklahoma College of Law), LAW OF FASHION, Feb. 13, 2013, <http://lawoffashion.com/blog/story/02/13/2013/176> [<http://perma.cc/67YS-Z8MJ>] (noting that after decades of irrelevance, “[d]esign patents are the intellectual-property regime *du jour* for fashion designs”).

<sup>14</sup> See Charles Colman, *A ‘Female Thing’: Fashion, Sexism, and the United States Federal Judiciary*, 4 VESTOJ 53, 53 (2013) (“As ‘fashion’ was, from the creation of the United States until, arguably, the late 1960s, associated primarily with the female sex, while judges during this time period were almost exclusively male, one naturally wonders whether the power dynamics of gender shaped the development of the law pertaining to fashion. There is good reason to believe that this has indeed been the case.”).

tation” as a vehicle for “conspicuous consumption” and class stratification,<sup>15</sup> the oft-recited (but highly questionable<sup>16</sup>) notion that there is “nothing new in fashion,”<sup>17</sup> and the purportedly “ephemeral” popularity of any particular item or style.<sup>18</sup> These issues, each less straightforward than is likely apparent at first glance,<sup>19</sup> share some of the responsibility for the strange doctrinal twists and turns of American copyright for fashion design.

With that said, the primary purpose of this series is not to map the complex array of social, cultural, and cognitive factors that have shaped current intellectual-property doctrine pertaining to fashion design—I have tackled such questions more directly and thoroughly in other scholarship<sup>20</sup>—but rather to examine what that doctrine *is*. The focus of this series is on the principles, past and present, guiding the application of copyright protection to components of fashion design under U.S. law—and how those

---

<sup>15</sup> See Colman, *supra* note 5, at 27 *et seq.* (explaining continuing, though misguided, influence of Thorstein Veblen’s 1899 theory of “conspicuous consumption” in contemporary legal discussion of fashion design).

<sup>16</sup> Cf. CHRISTOPHER BREWARD, *FASHION* 71-83 (2003) (noting three examples of fashion designers whose creations were indisputably novel, whether because of innovative construction, unique perspective, or the “ability to develop a historical quotation into something uncompromisingly contemporary”).

<sup>17</sup> See *discussion* at Hemphill & Suk, *supra* note 3, at 109-115.

<sup>18</sup> For a representative example, see Magliocca, *supra* note 12, at 847-48 (asserting that because “their life span is so short,” the “optimal term” of IP protection for “[ae]sthetic designs and other marginal improvements” is “only a matter of months”).

<sup>19</sup> One common characteristic of much scholarly discourse on intellectual property is that while it purports to engage in objective policy analysis (of the optimal scope and duration of rights, if any, in “aesthetic designs”), it often serves to reify culturally contingent—and often dispositive—value judgments and social norms that operate on the level of what might be called “deep discourse.” See *discussion* at Colman, *supra* note 10. Operative terms, like “originality,” “innovation,” and “authorship” (to name just a few) tend to be inadequately scrutinized for the premises on which they rest. For further discussion, see LAWRENCE ROSEN, *LAW AS CULTURE: AN INVITATION* 7-8 (2006) (“It is no mystery that law is part of culture, but it is not uncommon for those who, by profession or context, are deeply involved in a given legal system to act as if ‘The Law’ is quite separable from other elements of cultural life . . . . But context is crucial: When we hear a court speak of ‘the conscience of the community,’ ‘the reasonable man,’ or ‘the clear meaning of the statute,’ when we . . . listen to counsel debate whether surrogate motherhood or a frozen embryo should be thought of in terms of ‘ownership,’ we know that the meaning of these concepts will come not just from the experience of legal officials or some inner propulsion of the law but from those broader assumptions, reinforced across numerous domains, that characterize the culture of which law is a part.”).

<sup>20</sup> See *generally* Colman, *supra* notes 5, 10, 14.

principles manifest in consistent and inconsistent, defensible and indefensible, ways.

This series of five articles will begin with a broad overview of historical developments in American fashion design and copyright law—and the intersection of the two—taking note of certain foundational aspects of English law in the early 1700s and jumping forward to notable developments, through late 1980s, by which point the basic doctrinal framework of U.S. copyright-for-fashion had coalesced. The second installment in this series, *On ‘Originality,’* will examine ways in which certain core tenets of copyright law, including “originality” and the interrelated notion of the “idea-expression” distinction, have been judicially implemented in cases concerning fashion design. The third installment, *On ‘Separability,’* will scrutinize the theoretical basis for, and “on-the-ground” application of, U.S. law’s asserted distinction between the non-copyrightable “useful articles” of fashion and design elements deemed copyrightable as “physically or conceptually separable” from such articles. The third installment will proceed to identify lines of judicial decisions applying copyright doctrines, in often-unexpected ways, to disputes over the major categories of “separable” design components, including fabric patterns, superimposed images, embroidery, lace, jewelry, and aspects of fanciful costumes. The fourth installment in the series, *On ‘Similarity,’* will parse the often-opaque mechanics of copyright infringement as they have operated in the context of fashion design. Here again, judicial application of supposedly one-size-fits-all standards reveals unexpectedly systematic and nuanced treatment of certain types of fashion works, even as other decisions reflect irreconcilable tensions in the doctrine. The fifth and final series installment, *The Politics of ‘Piracy,’* will resume the historical narrative where the first installment left off, in 1987, with an account of notable lobbying efforts and legislative activity concerning copyright(-like) protection for fashion design over the past thirty years. That final article will identify the key players, recurring rhetorical strategies, and successes and failures of important stakeholders in the debates surrounding American IP legislation tailored to fashion design.

The articles in this series should not be considered a comprehensive survey of—and certainly not the last word on—the subject of U.S. copyright protection for fashion design.<sup>21</sup> This series does not (nor could it)

---

<sup>21</sup> Further, copyright protection plays a major role in fashion outside the realm of “design”: a recent news story provides just one illustrative example. See Doreen Carvajal, *Koons Again Accused of Copyright Infringement*, N.Y. TIMES ARTSBEAT, Dec. 19, 2014, 2:26 P.M., <http://artsbeat.blogs.nytimes.com/2014/12/19/koons-again-accused-of-copyright-infringement/> [<http://perma.cc/F77S-F3ZL>] (“Franck Davidovici, creator of a 1985 ad campaign for the French clothing retailer Naf Naf featur-

address every rule, exception, statutory provision and judicial decision concerning intellectual-property protection for fashion in the U.S.—let alone similar or alternative protection available under the laws of other countries.<sup>22</sup> As noted above, the primary focus here is on overarching themes, consistencies, and inconsistencies within the body of case law that has emerged concerning U.S. copyright protection for fashion design. Though many specific judicial decisions are used in furtherance of this goal, this series is not and should not be considered a treatise or any sort of “reference guide,” in the traditional sense. Indeed, as will quickly become apparent, even as this series attempts to answer certain questions about U.S. copyright protection for fashion design, it will pose many *new* questions that do not lend themselves to easy answers—to the extent there are correct “answers” at all.

## I. INTRODUCTION TO “A STRANGE CENTENNIAL”

Lawyers and non-lawyers alike often parrot the notion that “[U.S.] copyright protection does not cover apparel.”<sup>23</sup> It is true that the United States

---

ing a similar figure and pig, is pressing a legal complaint” against appropriation artist Jeff Koons over two works, both entitled “Fait d’hiver,” in which “mannequins share the same tousled dark hair [in the original ad and the Koons variation], and are sprawled in what appears to be snow, post-avalanche [but] the Koons woman is wearing sunglasses and the pig is wreathed in red flowers alongside some penguins.”).

<sup>22</sup> The laws of other countries, and potentially relevant international treaties and agreements, are mentioned only in passing throughout this series; such discussion will be limited and primarily in the service of illuminating the subject of copyright protection for fashion design in the United States. In general, the existence of such laws and/or agreements does not impact the doctrinal landscape of copyright protection for fashion design until/unless Congress implements changes via statutory amendment, so addressing the latter will generally be sufficient for the purposes of this series. This is so because intellectual property protection, including copyright law, is generally “territorial” in nature. (Even if one owned a valid copyright in a design under French law, that copyright—as opposed, notably, to a French court’s judgment for infringement of that copyright, in certain instances—cannot be directly enforced in the United States.) While the principle of territoriality has recently been tested by both industrial realities (like the ever-more complex global supply chain on which the fashion industry is dependent) and doctrinal developments (like the U.S. federal courts’ heightened sensitivity to issues concerning choice of law, foreign affiliates, etc.), “territoriality” nevertheless remains a fundamental principle of copyright law in the United States.

<sup>23</sup> See, e.g., Kristi Ellis, *Design Piracy Bill Reintroduced in Congress*, WOMEN’S WEAR DAILY, Sep. 10, 2012, available at <http://www.wwd.com/business-news/government-trade/design-piracy-bill-reintroduced-in-senate-6261424> (subscription re-

Code contains a bar on copyright protection for “useful articles”—a category into which many items comprising “fashion,” do indeed fall (and likely the basis for the above-noted tendency to overgeneralize). Importantly, however, this “useful article” bar to copyright protection is *itself* subject to exceptions ranging from the very narrow to the surprisingly broad. The only way to appreciate the contours of copyright protection for fashion design in the United States, whether “on the books” or in practice, is to survey the often-idiosyncratic judicial decisions of the federal courts.<sup>24</sup> Reliance on

---

quired) (“Copyright protection does not cover apparel, because articles of clothing are currently considered ‘useful articles’ as opposed to works of art.”); Marie-Andrée Weiss, *Puss In (Infringed?) Boots*, THE IPKAT (Sep. 17, 2014, 6:54 PM), <http://ipkitten.blogspot.com/2014/09/puss-in-infringed-boots.html> [<http://perma.cc/J8L7-APQL>] (“As a reminder, U.S. copyright law does not allow for the protection of useful items, which has left fashion designers with the options of protecting their work either with a design patent, or by claiming that a particular design is a trade dress, as it has acquired secondary meaning and can thus protected by trademark law.”).

<sup>24</sup> There is a colorable argument that there exists “common-law copyright protection” for (at least unpublished) works of fashion design. See *Capitol Records v. Naxos of America*, 4 N.Y.3d 540, 552-53 (2005) (“To insure that the 1909 Act would not be interpreted to deny any existing common-law protection, Congress explicitly stated that the Act ‘shall [not] be construed to annul or limit the right of the author or proprietor of an unpublished work, at common law or in equity, to prevent the copying, publication, or use of such unpublished work without his consent, and to obtain damages therefor.’”). The contours of this common-law protection remain uncertain, even in far more fleshed-out contexts than that of fashion design. See, e.g., *Flo & Eddie, Inc. v. Sirius XM Radio Inc.*, No. 13 Civ. 5784(CM), 2015 WL 585641, at \*1, \*2 (S.D.N.Y. Feb. 10, 2015) (certifying interlocutory appeal under 28 U.S.C. § 1292(b) based on “substantial ground for difference of opinion” concerning District Court’s earlier ruling “that under New York law the right to publicly perform sound recordings is part of the bundle of rights associated with common law copyrights in those recordings”). Some courts have acknowledged the possibility of the existence of common-law copyright in unpublished works of fashion design. See *Fashion Originators Guild of America v. Federal Trade Commission*, 114 F.2d 80, 83, 84 (“[W]e have been unable to discover any case which squarely presented the situation— that is, in which ‘intellectual property’ not covered by the copyright act then in existence, was challenged because of its ‘publication’— there are plenty of general expressions in the books that the ‘common-law property’ does not survive . . . . We conclude therefore that, regardless of whether the Guild’s designs could be registered or not, ‘publication’ of them was a surrender of all its ‘common-law property’ in them. To embody a design in a dress or a fabric, and offer the dress for general sale was such a ‘publication’; nothing more could be done to bring it into the public demesne. It may be unfortunate— it may indeed be unjust—that the law should not thereafter distinguish between ‘originals’ and copies; but until the Copyright Office can be induced to register such designs as copyrightable under the existing statute, they both fall into the



“rules of thumb,” while potentially risky in any area of law, is especially problematic in the context of American copyright protection for works of fashion design.

As this series will recount, the past century has witnessed repeated bursts of lobbying efforts for legislation creating (more) robust copyright—or copyright-like—protection for works of fashion design. Such efforts gained newfound momentum in the second half of the first decade of the 2000s.<sup>25</sup> While much of this momentum has been lost as of this writing,<sup>26</sup> it remains important to monitor legislative developments in this area. Until a legislative overhaul does occur (which history suggests is a long shot—though not an impossibility, particularly given the long-term trend toward international harmonization of copyright regimes), it remains crucial to understand the scattered and often difficult-to-reconcile decisions of the U.S. federal courts, which—as reflected in the focus of this series—have long provided the bulk of the relevant law in this area.

Before delving into a detailed discussion of the history of American copyright protection for fashion design, it is prudent to pose a fundamental question: what is “copyright,” under U.S. law, more generally? American copyright is a form of quasi-property, authorized by what some call the “Intellectual Property Clause”<sup>27</sup> of the Constitution, located at Article I,

---

public demesne without reserve.”) (citing *Cheney Bros. v. Doris Silk Corp.*, 35 F.2d 279 (2d Cir. 1929)); compare *A. J. Sandy, Inc. v. Junior City, Inc.*, 17 A.D.2d 407, 409 (N.Y. App. Div. 1962) (“The first and second causes of action link inseparably dress design, artwork, photographs and literary material under the broad heading ‘copyrightable materials’. In the absence of copyright to design patent, dress designs clearly are not protected by so-called common law copyright for design copyrights do not exist at common law.”). Non-copyright causes of action might be available to the aggrieved designer in certain instances. See *Quadrille Wallpapers & Fabric, Inc. v. Pucci*, 1:10-CV-1394 (LEK/DRH), 2011 U.S. Dist. LEXIS 95457 (N.D.N.Y. Aug. 24, 2011) (discussing circumstances in which theft of uncopyrightable designs may nevertheless give rise to a non-preempted cause of action). However, the viability and mechanics of such theories are largely beyond the scope of this five-article series.

<sup>25</sup> See Eric Wilson, *O.K., Knockoffs, This Is War*, N.Y. TIMES, Mar. 30, 2006, <http://www.nytimes.com/2006/03/30/fashion/thursdaystyles/30copy.html>.

<sup>26</sup> See Kristi Ellis, *CFDA, AAFA Taking New Tack on Design Piracy*, WOMEN’S WEAR DAILY, Mar. 20, 2012, available at <http://www.wwd.com/business-news/government-trade/cfda-aafa-taking-new-tack-on-design-piracy-5812260> (subscription required) (reporting on fashion-industry trade groups’ decision to put lobbying effort on backburner in favor of devoting resources to alternative approaches to combating unauthorized copying).

<sup>27</sup> The term “intellectual property” was unknown in the eighteenth century. Edward C. Walterscheid, *To Promote the Progress of Science and the Useful Arts: The Background and Origin of the Intellectual Property Clause of the United States Constitution*,

Section 8: “The Congress shall have power to . . . promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries[.]”<sup>28</sup>

As the constitutional language reveals, the Framers generally viewed copyright protection as a “reward to the author or artist serves to induce release to the public of the products of his creative genius”<sup>29</sup>—a rationale that is still invoked, if increasingly scrutinized,<sup>30</sup> today. But even if we assume that copyright is necessary to encourage the production and distribution of certain works, which “products of creative genius” should receive protection—and what should the scope and term of an author’s rights be?

The Constitution refers only to “writings” as being eligible for copyright, but “Congress has always construed this term broadly, and in doing so has been uniformly supported by judicial decision . . . for instance, interpret[ing the language] as authorizing subject-matter so remote from its popular [meaning] as photographs, paintings, statuary, and dramas, even if unwritten.”<sup>31</sup> Such judicial decisions include, for example, the Supreme

---

2 J. INTEL. PROP. L. 1 n.1 (1994). I will nevertheless use the term “Intellectual Property Clause” (or “IP Clause,” for short) to refer to this constitutional provision addressing copyrights and patents.

<sup>28</sup> Taking the words of the IP Clause at contemporary face value would be misleading, for “the colonial usage of the term ‘useful arts’ referred to scientific inventions that were to be protected by patent laws requiring proof of novelty, [while] the word ‘science’ was taken to mean an organized system of knowledge that was the product of authorship and was to be protected by copyright laws.” ALINA NG, COPYRIGHT LAW AND THE PROGRESS OF SCIENCE AND THE USEFUL ARTS 24-25 (2011).

<sup>29</sup> *Eldred v. Ashcroft*, 537 U.S. 186, 227 n.4 (2003) (Stevens J., dissenting) (quoting *Fox Film Corp. v. Doyal*, 286 U.S. 123, 158 (1945)).

<sup>30</sup> See, e.g., Greg Lastowka, *Innovative Copyright*, 109 MICH. L. REV. 1011, 1013 (2011) (“Of course, while the theory provides that IP contributes to innovation and creativity, everyone knows that IP rights are not absolutely necessary to produce art and inventions . . . . [T]he question is really how much of an IP right produces the optimal social benefits.”). This skepticism can be observed even outside the academy. See, e.g., Mike Masnick, *Yet Another Example Of Creativity Exploding Without Copyright Law: Football Plays*, TECHDIRT (Oct. 1, 2010, 8:24 AM), <http://www.techdirt.com/articles/20100926/21424511172/yet-another-example-of-creativity-exploding-without-copyright-law-football-plays.shtml> [https://perma.cc/D2YT-CSRJ].

<sup>31</sup> S. REP. NO. 59-6187, at 4 (1907). The 1907 Senate Report continued: “As thus interpreted, the word ‘writings’ would to-day [*sic*] in popular parlance be more nearly represented by the word ‘works’ . . . including ‘all forms of record in which the thought of an author may be recorded and from which it may be read or reproduced.” But while the term “writings” may be underinclusive of the subject matter eligible for copyright protection, the word “works” is decidedly overinclusive, for reasons explained later in this chapter.

Court's 1884 decision in *Burrow-Giles Lithographic Co. v. Sarony*, declaring appropriate for copyright protection "all forms of writing, printing, engraving, etching, etc., by which the ideas in the mind of the author are given visible expression."<sup>32</sup>

Once the threshold question of eligible subject matter is resolved, one reaches the question of the specific rights held by the copyright owner. The Supreme Court has said, of 17 U.S.C. § 106, the operative provision under contemporary U.S. copyright law, that

[T]he Copyright Act confers a bundle of exclusive rights to the owner of the copyright. Under the Copyright Act, these rights – to publish, copy, and distribute the author's work [among other rights] – vest in the author of an original work from the time of its creation. § 106. In practice, the author commonly sells his rights to publishers who offer royalties in exchange for their services in producing and marketing the author's work.<sup>33</sup>

In contrast to the oft-repeated rationale for creating and awarding copyright protection in the United States—"motivat[ing] the creative activity of authors . . . by the provision of a special reward, and to allow the public access to the products of their genius"<sup>34</sup>—continental European copyright law has been said to rest on "radically different foundations," such as "preserving the dignity and personhood of creators."<sup>35</sup> Whether or not this conventional wisdom is correct,<sup>36</sup> it is helpful to keep such rhetoric—as well as the culturally contingent status of the "fashion designer"—in mind when studying the highly delineated rights in the appearance of fashion designs under U.S. law.

## II. THE HISTORY OF COPYRIGHT PROTECTION (OR LACK THEREOF) FOR FASHION DESIGNS IN THE UNITED STATES

While contemporary copyright protection resembles a private property right,<sup>37</sup> copyright's early life, was, perhaps surprisingly, most closely

<sup>32</sup> 111 U.S. 53, 58 (1884) (rejecting argument that Congress could not constitutionally codify copyright protection for at least some forms of photography).

<sup>33</sup> *Harper & Row, Publs. v. Nation Enters.*, 471 U.S. 539, 546-47 (1985).

<sup>34</sup> *Sony Corp. of America v. Universal City Studios, Inc.*, 464 U.S. 417, 429 (1984).

<sup>35</sup> See Brian Angelo Lee, *Making Sense of "Moral Rights" in Intellectual Property*, 84 *TEMPLE L. REV.* 71, 73 (2011).

<sup>36</sup> *Id.* at 76.

<sup>37</sup> See, e.g., *Sony Corp. of America v. Universal City Studios, Inc.*, 464 U.S. 417, 429 (1984) ("[T]he limited grant [of exclusive rights, in the form of copyright] is a means by which an important public purpose may be achieved. It is intended to

intertwined with royal censorship. The so-called “right of copy,” defined as “the exclusive right to print and sell copies of a book or other literary work,” was initially regulated in the United Kingdom by royal “Letters Patent.”<sup>38</sup> In sixteenth-century England, the right to print and sell a book could only be obtained through a grant, in the form of a “patent,” from the Crown, and was unavailable to those who would challenge royal prerogatives.<sup>39</sup> A 1557 charter, issued by Queen Mary Tudor to a London printers’ guild, granted the “Stationers’ Company” the essentially exclusive right to print approved books, providing the guild with a strong economic incentive to destroy any unapproved books published by would-be competitors.<sup>40</sup> British Parliament wrested power from the Crown in 1641, only to adopt a series of licensing acts that effectively preserved the Company’s monopoly.<sup>41</sup>

In 1695, after a clash between the upper and lower houses of British Parliament, the Licensing Act of 1662 expired without renewal.<sup>42</sup> Little legislative action was taken over the next fifteen years, while “it remained uncertain just how far the common law was adequate to deal with an emerging and increasingly unruly press.”<sup>43</sup> At the same time, “it was becoming evident that the control and censorship of the book trade, if it was required at all, could be effectively addressed as an issue, separately from any need to provide for the property in such books.”<sup>44</sup>

A complex array of factors<sup>45</sup> led to the passage, in 1710, of the so-called “Statute of Anne,” which forever changed the trajectory of “the right of copy” in common-law countries.<sup>46</sup> Whereas the previous legislative regime had arranged for the Stationers’ Company to purchase manuscripts from au-

---

motivate the creative activity of authors and inventors by the provision of a special reward, and to allow the public access to the products of their genius after the limited period of exclusive control has expired.”).

<sup>38</sup> Howard B. Abrams, *The Historic Foundation of American Copyright Law: Exploding the Myth of Common Law Copyright*, 29 WAYNE L. REV. 1119, 1135 (1983).

<sup>39</sup> *Id.*

<sup>40</sup> *Id.* at 1136.

<sup>41</sup> *Id.* at 1137.

<sup>42</sup> RONAN DEAZLEY, *ON THE ORIGIN OF THE RIGHT TO COPY: CHARTING THE MOVEMENT OF COPYRIGHT LAW IN EIGHTEENTH CENTURY BRITAIN (1695-1775)* 1 (2004)

<sup>43</sup> *Id.* at 6.

<sup>44</sup> *Id.* at 29.

<sup>45</sup> *See id.* at 221-22 (examining contradictory accounts of the decisive social, political, and cultural factors driving the enactment of the Statute of Anne, and arguing that a nuanced examination of historical evidence “exposes the fiction of the larger, unified and coherent form” often grafted onto the history of copyright).

<sup>46</sup> Tyler T. Ochoa & Mark Rose, *The Anti-Monopoly Origins of the Patent and Copyright Clause*, 84 J. PAT. & TRADEMARK OFF. SOC’Y 909, 914 (2002).

thors,<sup>47</sup> essentially making the distribution of works contingent on both the acceptability of their content and on authors' transfer of any applicable legal interest apart from the right to receive certain royalties, the Statute of Anne proclaimed that "the Author of any Book . . . shall have the sole Right and Liberty of printing such Book."<sup>48</sup> The Statute went on to provide that regardless of any subsequent purchase of an author's copyright, "after the expiration of the [initial] term of fourteen years, the sole right of printing or disposing of copies shall return to the authors thereof, if they are then living, for another term of fourteen years."<sup>49</sup> The statute did not explicitly address subject matter other than books. The United Kingdom would enact legislation covering certain works of fashion design at a surprisingly early date, in 1787<sup>50</sup>—but this, of course, took place after the American Revolution and did not exert any immediate influence on IP policy in the United States, due in part to the very different cultural politics and economic agendas prevalent in the two countries.<sup>51</sup>

With that said, "the early years of copyright in the United States paralleled the development of copyright in England in [certain] respects," including the passage of "a copyright act modeled after the Statute of Anne."<sup>52</sup> Indeed, shortly after the ratification of the Constitution, the first federal<sup>53</sup> copyright law in the United States was enacted by Congress, titled

<sup>47</sup> Abrams, *supra* note 38, at 1171.

<sup>48</sup> An Act for the Encouragement of Learning, by Vesting the Copies of Printed Books in the Authors or Purchasers of such Copies, During the Times therein mentioned, 1710, 8 Anne, c. 19 (1710).

<sup>49</sup> *Id.*

<sup>50</sup> An Act for the Encouragement of the Arts of designing and printing Linens, Cottons, Calicoes, and Muslins, by vesting the Properties thereof, in the Designers, Printers and Proprietors, for a limited time, 1787, 27 Geo.III, c.38 (1787) (hereinafter "Calico Printers' Act") (conferred exclusive rights lasting two months on those first printing "new and original" patterns on linens, cottons, calicoes and muslins). See Ronan Deazley, *Commentary on the Calico Printers' Act 1787*, in L. BENTLY & M. KRETSCHMER, EDs., PRIMARY SOURCES ON COPYRIGHT (1450-1900) (2008), [http://www.copyrighthistory.org/cam/commentary/uk\\_1787/uk\\_1787\\_com\\_1072007131417.html](http://www.copyrighthistory.org/cam/commentary/uk_1787/uk_1787_com_1072007131417.html) <http://perma.cc/GAX2-U23Y>].

<sup>51</sup> See generally Kate Haulman, *Fashion and the Culture Wars of Revolutionary Philadelphia*, 62 WILLIAM AND MARY QUARTERLY 621 (2005); Ruthann Robson, *Beyond Sumptuary: Constitutionalism, Clothes, and Bodies in Anglo-American Law, 1215-1789*, 2 BR. J. AM. LEG. STUDIES 477, 502-509 (2013); cf. Mary Lynn Stewart, *Copying and Copyrighting Haute Couture: Democratizing Fashion, 1900-1930s*, 28 FRENCH HISTORICAL STUDIES 103 (2005).

<sup>52</sup> PAUL GOLDSTEIN, COPYRIGHT'S HIGHWAY: THE LAW AND LORE OF COPYRIGHT FROM GUTENBERG TO THE CELESTIAL JUKEBOX 51 (1st ed. 1994).

<sup>53</sup> State copyright laws preceded the passage of the federal act in all but one of the original states. *Id.*

(much like its English precursor) as “An Act for the encouragement of learning, by securing the copies of maps, charts, and books, to the authors and proprietors of such copies, during the times therein mentioned.”<sup>54</sup> Like the Statute of Anne, the 1790 Act provided for an initial term of protection of fourteen years for new works, followed by a renewal term of 14 years if the author survived the first term. Among important questions not answered by the text of the U.S. Copyright Act of 1790, however, was whether authors of works other than “maps, charts, and books” enjoyed any enforceable copyright, and if so, under what law(s). The question would not arise in the fashion-design context for many years to come.<sup>55</sup>

To be sure, the U.S. Congress, with occasional nudges—or pushes—from the federal judiciary, has amended the copyright laws many times over the years to bring a variety of new categories of works within the ambit of copyright protection. (Congress has also repeatedly extended the term of protection for such works; for most works, the duration of copyright now stands at the life of the author, plus seventy years.<sup>56</sup>) But despite these expansions, and despite many advocates’ dogged attempts in the legislature and the courts to obtain robust copyright protection for fashion designs, such works are still left substantially—though, as noted above and discussed in depth below, not entirely—unprotected under U.S. copyright law.

The gradual expansion of federal copyright protection, and the current fragmented doctrinal landscape concerning protection for works of fashion design, can be understood through a survey of major legislative and judicial developments. In 1802, decades before the concept of individual “authorship” in fashion had been meaningfully recognized in mainstream American culture,<sup>57</sup> Congress extended copyright’s embrace around “any historical or other print or prints [that the author had] designed and engraved, etched, or worked.”<sup>58</sup> In 1831, Congress further expanded copyright protection

---

<sup>54</sup> Act of May 31, 1790, ch. 15, 1 Stat. 124. The Statute of Anne had begun as follows: “An act for the encouragement of learning, by vesting the copies of printed books in the authors or purchasers of such copies, during the times therein mentioned.” 8 Anne, c. 19 (1710).

<sup>55</sup> The most influential factors contributing to the passage of Britain’s 1787 Calico Printers’ Act, though applicable in some other European countries, were largely inapplicable in the new United States. See *discussion supra* at text accompanying notes 50 and 51; see especially Robson, *supra* note 51, at 502-509 (surveying salient political and economic landscape concerning fashion in the U.S. of the late 1700s).

<sup>56</sup> See generally *Eldred v. Ashcroft*, 537 U.S. 186 (2003).

<sup>57</sup> See *discussion* at BREWARD, *supra* note 16, at 25-47; accord. BLUM, *infra* note 88 (illustrating the evolution of rhetoric concerning designers in *Harper’s Bazaar* between 1867 and 1898).

<sup>58</sup> Act of Apr. 29, 1802, 2 Stat 171.

through the first major overhaul of the copyright laws since the original Copyright Act, in a law titled “[A]ct to amend the several acts respecting copyright, musical compositions, and cuts, in connection with prints and engravings.”<sup>59</sup> While this codification of IP rights for “prints and engravings” took place long after the passage of similarly targeted legislation in the UK,<sup>60</sup> it is emblematic of the first real—albeit embryonic—flourishing of the arts in the U.S.

In 1842, the United States Congress, apparently prompted in part by recent British legislation regularizing intellectual-property protection for works of industrial design<sup>61</sup> codified an entirely new domestic regime for the grant of “design patents.” This new type of IP protection was not heavily

<sup>59</sup> Act of Feb. 3, 1831, 4 Stat. 436.

<sup>60</sup> Engravers’ Copyright Act, 1735, 8 Geo.II, c.13. See discussion at Deasley, *supra* at note 45, text accompanying note 3 (“[In 1735, the British House of Commons had received a petition from a group of artists and engravers complaining that when they had] ‘finish’d a Design, which has taken them up Time, and Pains, and Thought in the Execution, and procured at a considerable Expence Engravings, or any other Sort of Prints from their Designs,’ their original designs were reproduced by ‘Copyers’ who were ‘no better than the Lowest of Robbers.’”) (quoting *The Case of Designers, Engravers, Etchers, &c., Stated in a Letter to a Member of Parliament*, Lincoln’s Inn Library, M.P.102, Fol.125 (1735)).

<sup>61</sup> See “Report from the Select Committee on Copyright of Designs; together with the Minutes of Evidence Taken Before Them,” in HOUSE OF COMMONS PAPERS, REPORTS FROM COMMITTEES, Vol. VI, Session Jan. 16-Aug. 11, 1840 442 (1840) (discussing design laws passed to date: 27th Geo. III, c. 38 [Designing and Printing of Linens, etc. Act 1787 c. 38]; 29th Geo. III, c. 19 [Designing and Printing of Linens, etc. Act 1789 c. 19]; 34th Geo. III, c. 23 [Linens, etc. Act 1794 c. 23]; 2d Vict. c. 13 [Copyright of Designs Act 1839 c. 13]; 2d Vict. c. 17 [Copyright of Designs Act 1839 c. 17]). See also U.K. Intellectual Property Office, “History of designs,” <http://www.ipo.gov.uk/types/design/d-about/d-what/d-history.htm> (last visited Feb. 27, 2013) (“The first Act dealing with copyright in industrial designs was the Designing & Printing of Linen Act in 1787. This gave a very limited copyright protection to those who engaged in the ‘arts of designing and printing linens, cottons, calicos and muslin’. It gave proprietors the sole right of printing and reprinting for 2 months from the date of first publication, provided the name of the proprietor was marked on each piece. In 1794 the period of protection was extended to 3 months. From 1839 a series of laws were passed, gradually extending the boundaries of design protection. The Copyright and Design Act 1839 considerably increased the protection given to fabrics by extending the law to fabrics composed of wool, silk or hair and to mixed fabrics. The same Act extended protection far beyond the textile trade and gave us the foundations of modern design law. It gave protection to every new or original design including textiles. It also allowed protection for the ornamentation and for the shape and configuration of any article of manufacture.”).

used during its first two decades.<sup>62</sup> However, one of the first recorded judicial opinions concerning design-patent law—an 1847 district-court decision finding that a defendant had infringed a patentee’s rights in the appearance of fashionable silk buttons<sup>63</sup>—arguably suggests that design patents could have provided a potential remedy that countless future fashion designers would claim to be necessary—had the doctrine in that new area of intellectual-property protection law not strayed so dramatically off-course.<sup>64</sup>

Throughout the mid-Nineteenth Century, Congress made a series of largely administrative amendments to both the patent and copyright laws. While some of these statutory revisions tinkered with the design-patent laws, the relevant legislative activity does not evince a clear policy imperative: the statutory language specifically mentioning “new and original design[s] for the printing of woolen, silk, cotton or other fabrics,” for example, was removed in 1861—without any immediately apparent objective or effect<sup>65</sup>—only to be reinstated in 1870.<sup>66</sup>

Meanwhile, Congress was busy making substantive revisions to the copyright laws; in 1870, the copyright statutes were amended to provide, for the first time, exclusive rights to authors of “paintings, drawings, chromolithographs, statues and statuaries, and ‘models or designs intended to be perfected as works of fine art.’”<sup>67</sup> Again, there was no mention of fashion, and (as discussed below), it seems beyond reasonable dispute that industrial design and applied art—to use contemporary terminology—were assumed to be outside the purview of the statutory language.

---

<sup>62</sup> See WILLIAM LEONARD SYMONS, *THE LAW OF PATENTS FOR DESIGNS* 5 (1914).

<sup>63</sup> *Booth v. Garrelly*, 3 F. Cas. 883, 884 (C.C.S.D.N.Y. 1847).

<sup>64</sup> For a culturally grounded “critical history” of design patents’ decline as a viable form of IP protection for fashion design, see generally Colman, *supra* note 10. For a primarily doctrinal account of the decline, arguing that an unduly stringent “nonobviousness requirement was . . . forced on design patents through an odd series of administrative, legislative, and judicial mishaps,” see Jason Du Mont, *A Non-Obvious Design: Reexamining the Origins of the Design Patent Standard*, 45 *GONZAGA L. REV.* 531, 535 (2010).

<sup>65</sup> See Du Mont, *supra* note 64, at 547 n.99.

<sup>66</sup> See *id.* at 564 n.198.

<sup>67</sup> Act of July 8, 1870, §§ 85-111, 41st Cong., 2d Sess., 16 Stat. 198 (describing protectable subject matter as any “map, chart, musical composition, print, cut, engraving, or photograph, or chromo, or of the description of any painting, drawing, statue, statuary, or model or design intended to be perfected and executed as a work of the fine arts”). See GOLDSTEIN, *supra* note 52, at 56 (arguing that 1870 Act’s “extension of copyright to prohibit unauthorized new uses of literary works reflected a sensitivity to the burgeoning variety of American culture”).



Among its other changes, the 1870 Act centralized responsibility for the administration of copyright matters in the Library of Congress, which soon resulted in a dramatic increase in the number of works received by the executive branch.<sup>68</sup> Indeed, the Librarian of Congress suddenly found himself overwhelmed with submissions, many of which consisted solely of commercial labels for industrial goods. In his 1872 annual report, the Librarian—perhaps motivated more by practical considerations than by legal analysis—asserted that without pictorial embellishment, such labels were not “writings of authors” within the meaning of the Constitution.<sup>69</sup> “Mere printed labels,” the Librarian insisted, should instead be protected by the Patent Office, as “trademarks” or “designs for labels.”<sup>70</sup> Congress promptly obliged, passing an 1874 amendment purporting to limit copyright for writings and engravings to “pictorial illustrations or works connected with the fine arts, and no[t] prints or labels designed to be used for any other articles of manufacture.”<sup>71</sup> The Library of Congress’s marginalization of “industrial” and “commercial” goods (and related paraphernalia) can also be observed some thirty years later, in another annual report stating that industrial articles “are nowhere found thus designated [as protectable in

<sup>68</sup> WILLIAM F. PATRY, *COPYRIGHT LAW AND PRACTICE* 43-44 (ed. 2000) (hereinafter “PATRY, *COPYRIGHT LAW AND PRACTICE*”).

<sup>69</sup> *Id.* at 46 (quoting 1872 Annual Report of the Librarian of Congress at 4-5).

<sup>70</sup> *Id.*

<sup>71</sup> Act of June 18, 1874, 43d Cong., 1st Sess., 18 Stat. 78 (hereinafter “1874 Act”). See *discussion* at *Higgins v. Keuffel*, 11 S. Ct. 731, 733 (1891) (“The act of June 18, 1874, (18 St. c. 301, p. 78,) changes the previous law in some respects. It allows, in place of the statement of entry in the office of the librarian, the simple use of the word ‘copyright,’ with the addition of the year it was entered, and the name of the party by whom it was taken out. It also declares that the words ‘engraving,’ ‘cut,’ and ‘print,’ shall be applied only to pictorial illustrations or works connected with the fine arts; and also that no prints or labels designed to be used for any other articles of manufacture shall be entered under the copyright law, but may be registered in the patent-office[.]”). This provision remained in effect, in substance if not always in identical language, until 1939, when Congress amended the Copyright Act to include “[p]rints and pictorial illustrations including prints or labels used for articles of merchandise.” See *discussion* at *Forstmann Woolen Co. v. J. W. Mays, Inc.*, 89 F.Supp. 964, 971 (E.D.N.Y. 1950) (“since *Higgins v. Keuffel*, the Copyright Act has been amended so as to include § 5, subdivision (K), prints and pictorial illustrations including prints or labels used for articles of merchandise’ by the amendment of 1939 to the copyright statute, Act of July 31, 1939, c. 396, 53 Stat. 1142, 17 U.S.C.A. § 5(K).”); accord. *Mazer v. Stein*, 347 U.S. 201, 209 n.14 (1954). The intervening period witnessed a strange quirk of IP history: a period during which the Patent Office took over registration responsibilities for labels of manufacture, but issued *copyrights* for such works. See PATRY, *COPYRIGHT LAW AND PRACTICE*, at 47.

the Copyright Act], while they would seem to be included in the provisions of section 4929 of the patent law.”<sup>72</sup>

Yet in certain respects, the federal courts of the *fin de siècle* took a decidedly liberal approach to copyrightability. In *Burrow-Giles Lithographic Co. v. Sarony*, for example, the U.S. Supreme Court was confronted with an appeal posing the question of whether it was proper, under the Constitution’s Intellectual Property Clause, for Congress to allow for the grant of copyright in works of photography.<sup>73</sup> The Court’s 1884 decision answered in the affirmative, explaining that “[b]y writings in [the Constitution’s operative language] is meant the literary productions of those authors, and Congress very properly has declared these to include all forms of writing, printing, engraving, etching, etc., by which the ideas in the mind of the author are given visible expression.”<sup>74</sup>

However, late Nineteenth-Century federal courts did not take the same creator-friendly approach reflected in *Sarony* to the copyrightability of what might be described (again, using contemporary terminology) as “applied art.” While the *Sarony* Court had stated that copyright was “the exclusive right secured to the author . . . of a writing or drawing which may be multiplied by the arts of printing in any of its branches,”<sup>75</sup> *fabric* prints would not be judicially adopted into these privileged categories for another ninety years.<sup>76</sup> Further, in striking contrast to the Court’s generous approach to a variety of borderline works in the copyright arena between the 1880s and the 1910s,<sup>77</sup> the federal courts of the time period took a decidedly skeptical, narrow, and/or dismissive view of purportedly exclusive rights—whether claimed via utility or design patent law—of the components forming the very heart of the craft of fashion design.<sup>78</sup>

The very same year the *Sarony* Court opted for an expansive construction of the copyright law, for instance, the Court in *Smith v. Nichols* invalidated as insufficiently novel to warrant patent protection a new textile of

---

<sup>72</sup> 1902-1903 Annual Report of the Register of Copyrights at 445.

<sup>73</sup> *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53 (1884). The Court continued: “The only reason why photographs were not included in the extended list in the act of 1802 is probably that they did not exist[.]”

<sup>74</sup> *Id.* at 58.

<sup>75</sup> *Id.* at 56.

<sup>76</sup> See *discussion at Folio Impressions, Inc. v. Byer California*, 937 F.2d 759, 762-63 (2d Cir. 1991).

<sup>77</sup> See GOLDSTEIN, *supra* note 52, at 243 (providing citations to four majority decisions authored by (Chief) Justice Holmes issued between 1903 and 1917, each expanding the scope of copyrightable subject matter).

<sup>78</sup> See *discussion at Colman*, *supra* note 10.

“corded fabric.”<sup>79</sup> At a time when the critical rhetoric and negative social connotations concerning fashion design were on the rise in mainstream American culture,<sup>80</sup> the Court decided that there existed a dispositive distinction between a patentable *improvement* and an unpatentable *adaptation*—specifically, of “form, proportions, or degree.”<sup>81</sup> (Such modifications naturally comprise some of the most important means of innovation for the typical fashion designer.<sup>82</sup>)

Despite discouraging decisions like *Nichols*, patent law—and specifically, design-patent law, appeared, for at least a couple decades more, to be the most promising (and perhaps *only* conceivable) avenue for asserting exclusive rights in the appearance of fashion articles. Indeed, some case law of the time period appears to indicate that copyright protection for textile prints was widely assumed to be a non-starter.

---

<sup>79</sup> 88 U.S. 112, 115 (1874) (describing purported invention at issue as a textile “in which the cords are elastic and held between the upper and under weft threads, and separated from each other by the interweaving of the upper and under weft threads with the warp threads in the spaces between the cords”).

<sup>80</sup> See discussion at Colman, *supra* note 10 (quoting, *inter alia*, Jno. Stainback Wilson, M.D., *Health Department*, *GODEY’S LADY’S BOOK*, Nov. 1861, full text available at <http://www.accessible-archives.com/2011/11/the-dangers-of-bare-arms-in-godeys-ladys-book/#ixzz3NxpGgXtH> (“We have before warned our readers against the ‘most pernicious practice,’ the dire effects of which are so forcibly presented in the above extract; but so prevalent is this evil, and such is the bending power of fashion, that the subject cannot be too often or too strongly urged upon the attention of mothers. The above remarks are as applicable to every part of our [American] country as to the city of Paris, for from Paris we receive our fashions, and with Paris we must suffer the dreadful consequences of following the senseless requisitions of vanity and folly in preference to the plain dictates of reason, physiology, and common sense. Mothers can never expect health for themselves and their children until they make the laws of health their guide, instead of the decrees of fashion; until they study physiology and hygiene more, and French fashion-plates less.”); cf. GOLDSTEIN, *supra* note 52, at 115 (“At the heart of most cases that reach the Supreme Court is a single question and a single answer that can spell success or failure for a party’s claim. The question rarely turns on strict legal theory. Usually it goes to plain, practical circumstances, to the lives sometimes even of Supreme Court Justices.”).

<sup>81</sup> 88 U.S. at 115. See also *id.* at 118-19 (“[A] mere carrying forward or new or more extended application of the original thought, a change only in form, proportions, or degree, the substitution of equivalents, doing substantially the same thing in the same way by substantially the same means with better results, is not such invention as will sustain a patent.”).

<sup>82</sup> See discussion at BREWARD, *supra* note 16, at 25-47.

One of the first published fashion-related copyright decisions emerged from the 1862 case of *Drury v. Ewing*,<sup>83</sup> at a time when it was common practice for American women to purchase patterns in order to recreate popular styles of clothing for themselves and their children.<sup>84</sup> The plaintiff in *Drury* sued over the alleged infringement of a large chart containing patterns and instructions for cutting apparel; the defendant sought to avoid liability by arguing that “the copyright of Mrs. Drury is a nullity as not being a legitimate subject of a copyright within the scope and intention of the act of congress”—specifically, that the plaintiff’s pattern was not a “book” within the meaning of the copyright laws.<sup>85</sup> The presiding court rather casually disposed of the proffered defense.<sup>86</sup>

But *Drury* was no lasting victory for fashion; indeed, the decision was soon thereafter cited for the principle that fashion designs themselves were not eligible for copyright protection. The Supreme Court’s discussion of *Drury* in its 1879 decision in *Baker v. Selden*<sup>87</sup> suggests that fashion’s ineligibility for copyright was self-evident:

---

<sup>83</sup> 7 F. Cas. 1113 (C.C.S.D. Oh. 1862).

<sup>84</sup> See BREWARD, *supra* note 16, at 53-55.

<sup>85</sup> 7 F. Cas. at 1114-15 (“The point made by the defendants’ counsel is, that the chart copyrighted to Mrs. Drury is neither a ‘book,’ nor a ‘chart,’ nor a ‘print,’ within the terms of the act of congress, and therefore not within its protection. Upon this point, no American authorities have been referred to, nor am I aware that it has been decided in this country. In the English courts I know of but one case in which it has been fully considered. This will be presently referred to as having a direct bearing on the question adverted to.”).

<sup>86</sup> *Id.* at 1115-16 (“[In the only published decision on the relevant issue, a British judge is] reported to have said: ‘I do not see at present why a composition printed on a single sheet of paper should not be entitled to the privileges of the statute.’ . . . No case has been referred to, and I am not aware there is any in which the doctrine then settled has been reconsidered or overruled by the English courts. And the construction of the statute of Anne, on the point under consideration, may be regarded as law in England. And I can not perceive on what ground the principle can be impugned as against good sense and reason. I am, therefore, inclined to adopt the liberal construction given by the English courts to their statute, and to hold that Mrs. Drury’s chart is within the protection of our statute.”).

<sup>87</sup> 101 U.S. 99, 104 (1879) (“Now, whilst no one has a right to print or publish [any material part of the plaintiff’s] book, [which] explained and described a peculiar system of book-keeping, and illustrated his method by means of ruled lines and blank columns . . . any person may practise [*sic*] and use the art itself which he has described and illustrated therein.”) *Baker* is often described as the Supreme Court’s first articulation of “a principle fundamental to copyright law: a copyright does not protect an idea, but only the expression of an idea.” *Kregos v. Associated Press*, 3 F.3d 656, 663 (2d Cir. 1993). See further discussion of the so-called “idea-expression distinction” in *Macrodoctrines* (the second installment in this series).

[The appellant relies on *Drury v. Ewing*, in which] a copyright was [successfully] claimed in a chart of patterns for cutting dresses and basques for ladies, and coats, jackets, &c., for boys. It is obvious that such designs could only be printed and published for information, and not for use in themselves. Their practical use could only be exemplified in cloth on the tailor's board and under his shears; in other words, by the application of a mechanical operation to the cutting of cloth in certain patterns and forms. Surely the exclusive right to this practical use was not reserved to the publisher by his copyright of the chart.<sup>88</sup>

One interesting, if roundabout, example of the judicial rejection of the notion that textile patterns might be copyrightable can be found in a New York federal district-court decision in *Rosenbach v. Dreyfuss*,<sup>89</sup> issued just a year after *Baker*. In *Rosenbach*, a defendant faced the charge that he had violated federal law by placing a copyright notice, without having complied with relevant requirements,<sup>90</sup> on “prints of small balloons [and] prints of hanging baskets, [each] with printing for embroidery and cutting lines.”<sup>91</sup>

The defendant in *Rosenbach* argued, cleverly, that a penalty could only be imposed under the relevant statute where the spurious copyright notice had been placed on material that was potentially copyrightable *in the first place*. The court somehow agreed, ruling that in light of the operative statutory language, examined in conjunction with the provision's predecessor and public-policy considerations, “the statute is to be construed as imposing the penalty only in case of copyrightable articles.”<sup>92</sup> The court could not (improbably) find any “apparent object or obvious reason of public policy in imposing a penalty for using this notice on any article not subject to copyright.”<sup>93</sup>

---

<sup>88</sup> *Baker*, 101 U.S. at 107.

<sup>89</sup> 2 F. 217 (C.C.S.D.N.Y. 1880).

<sup>90</sup> Under the copyright law of the Nineteenth Century, failure to comply with certain formalities, including (initially) a deposit of a copy of the work with a federal district court or (later on) deposit of two copies of a work the Library of Congress, resulted in a forfeiture of one's copyright. See GOLDSTEIN, *supra* note 52, at 55, 60. The repercussions for an author's non-compliance would gradually be softened, but—even after 1989 treaty-implementing legislation often described as abolishing the formalities serving as a hindrance to obtaining enforceable copyright protection in eligible works—not completely eliminated, to date. See *id.*

<sup>91</sup> *Rosenbach*, 2 F. at 217-18.

<sup>92</sup> *Id.* at 219.

<sup>93</sup> *Id.* at 220. If the purpose of the false notice provision is to inform the public and competitors of what can and cannot be lawfully copied, then of course the court's statement is true only if everyone knows exactly what material is and is not potentially eligible for copyright protection. This proposition was (and continues to be) doubtful, not only on the basis of common sense, but also in light of the

This meant that the outcome of *Rosenbach* ultimately hinged on a single question: what did the word “print” mean, as used in copyright law? The court answered:

The word ‘print,’ in [the copyright statute] is used in connection with ‘engraving, cut and photograph.’ It means, apparently, a picture, something complete in itself, similar in kind to an engraving, cut or photograph. It clearly does not mean something printed on paper, that is not intended for use as a picture, but is itself to be cut up and embroidered, and thus made into an entirely different article, as a balloon or a hanging basket.<sup>94</sup>

A print, unless “complete in itself”—*i.e.*, where it might be “fine art” rather than what we now call applied art or industrial design—was deemed not to be the sort of material appropriate for copyright protection.<sup>95</sup>

It is important to observe that at the time of the *Baker* Court’s reference to *Drury* and the district court’s opinion in *Rosenbach*, the notion of “authorship” in fashion design was not yet widely recognized in mainstream American culture.<sup>96</sup> Tellingly, America’s leading high-end fashion magazine of the late Nineteenth Century, *Harper’s Bazar*, did not consistently attribute new apparel designs to specific individuals or fashion houses until the 1890s.<sup>97</sup> Further, while individual designers—just a handful of French celebrity couturiers—were sometimes credited for their creation of a new dress “design,” the magazine in the 1870s and 1880s far more often referred to dresses by their salient features or geographical provenance. Until the 1890s, far more common were *Bazar*’s mentions of American retailers—

---

*Rosenbach* court’s own non-committal assertion that “[p]rints’ may or may not be the subject of copyright.” *Id.* at 224.

<sup>94</sup> *Id.* at 221.

<sup>95</sup> Whether summarized accurately or not, *Rosenbach* was later cited in one of the first federal-court decisions tackling the question of fashion design, itself, was copyrightable. See *Kemp & Beatley v. Hirsch*, 34 F.2d 291, 292 n.1 (E.D.N.Y. 1929) (“Under the authority of *Rosenbach v. Dreyfuss* (D.C.) 2 F. 217, it would seem, too, that articles such as dress patterns do not present copyrightable subject-matter”).

<sup>96</sup> See BREWARD, *supra* note 16, at 25-47.

<sup>97</sup> See STELLA BLUM, ED., VICTORIAN FASHIONS AND COSTUMES FROM HARPER’S BAZAR, 1868-1898 (1974) (comparing infrequency of attribution in first half of selected magazine excerpts with final decade). Even then, the attributions rarely accompanied illustrations of any items apart from dresses and, on rare occasions, high-end jewelry. See generally *id.*; see *id.* at 7 (noting that 1868 jewelry designs were “from Messrs. Tiffany & Co. and Browne & Spaulding, New York”). This by no means bespeaks a lack of importance for other types of accessories, however. See, e.g., Susan J. Vincent, *Gloves in the Early Twentieth Century: An Accessory After the Fact*, 25 JOURNAL OF DESIGN HISTORY 190 (2012).

specifically, in the magazine's expressions of gratitude for the "furnishing" of the dress "models" depicted in its pages.<sup>98</sup>

Nor, apparently, was there a significant stigma associated with presenting and purchasing copies of the latest French designs. The caption accompanying a December 1874 cover describes the featured design as a "[Charles Frederick] Worth Basque and Full-Trained Trimmed Skirt," then goes on to thank American retailer Lord & Taylor for their "kindness" in providing the model that had been "*copied* from a stylish toilette made by the celebrated Paris dress-maker, Worth."<sup>99</sup> Over the next two decades, retailers' names—and mentions of "copies"—were eclipsed by mentions of "creations" and "designs" by French and sometimes English individuals who received the increasingly effusive praise of the magazine.<sup>100</sup> By the early 1890s, fashion designs selected for the cover of *Bazaar* were increasingly described as the "exquisite" creations of the "creative brains" of "artists."<sup>101</sup>

Yet this emerging notion of "artistry" did not translate to favorable legislative or judicial treatment of fashion design under United States design-patent or copyright law.<sup>102</sup> Turn-of-the-century courts' skeptical and/or hostile treatment of fashion design in intellectual property disputes<sup>103</sup> stood in stark contrast with its decisions concerning other material whose claim to IP protection was arguably more precarious. In 1903, for example, the Supreme Court took a generous approach to the scope of copyright protection for a heavily commercial work in a case that hinged on the meaning and force of a 1874 congressional amendment purporting to limit copyright for writings and engravings to "pictorial illustrations or works connected with the fine arts, and no[t] prints or labels designed to be used for any other articles of manufacture."<sup>104</sup>

Justice Oliver Wendell Holmes' now-famous majority decision in *Bleistein v. Donaldson Lithographing Co.* dramatically expanded the reach of

<sup>98</sup> See BLUM, *supra* note 94, at 75 (emphasis added). It is possible that the propriety of exalting a self-avowed copy of a Worth design followed from the practical impossibility of obtaining an original—for only the rich and famous could secure an appointment with the increasingly dictatorial couturier.

<sup>99</sup> *Id.* at 75.

<sup>100</sup> See STELLA BLUM, ED., VICTORIAN FASHIONS AND COSTUMES FROM HARPER'S BAZAR, 1868-1898 (1974) (compare infrequency of attribution in first half of selected magazine excerpts with final decade).

<sup>101</sup> See *id.* at 232, 238, 248.

<sup>102</sup> The picture is actually quite complicated, for the newly-dubbed "artists" of fashion were mostly French, and yet the French could not, as a practical matter, take advantage of American IP protection—no matter how they might be considered.

<sup>103</sup> See Colman, *supra* note 10.

<sup>104</sup> 1874 Act.

copyright protection in holding that the operative statutory language did not preclude the availability of copyright protection for illustrated “chromolithographs prepared . . . for advertisements of a circus.”<sup>105</sup> He explained: “Certainly works are not the less connected with the fine arts because their pictorial quality attracts the crowd and therefore gives them a real use — if use means to increase trade and to help to make money.”<sup>106</sup> Holmes went on to write one of the most recognized passages in U.S. copyright law: “It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits.”<sup>107</sup> The Supreme Court thus eviscerated the “fine arts” language of the copyright laws, notably absent from the Copyright Act of 1909, passed just a few years later.<sup>108</sup>

The 1909 Act (still applicable today in disputes over works pre-dating January 1, 1977), contained a long list of categories into which copyrighted works might fall: “(a) Books, including composite and cyclopædic works, directories, gazetteers, and other compilations; (b) Periodicals, including newspapers; (c) Lectures, sermons, addresses, prepared for oral delivery; (d) Dramatic or dramatico-musical compositions; (e) Musical compositions; (f) Maps; (g) Works of art; models or designs for works of art; (h) Reproductions of a work of art; (i) Drawings or plastic works of a scientific or technical character; (j) Photographs; [and] (k) Prints and pictorial illustrations.”<sup>109</sup>)

The Copyright Act of 1909’s broadly worded provision on copyrightable subject matter<sup>110</sup> thus did not explicitly exclude fashion prints from consideration. But the regulations promulgated by the Copyright Office to administer the 1909 Copyright Act were more restrictive, declaring generally that “[p]roductions of the industrial arts utilitarian in purpose and character, are not subject to copyright registration, even if artistically made or ornamented,” and stating more specifically that “[n]o copyright exists in

---

<sup>105</sup> *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 248 (1903).

<sup>106</sup> *Id.* at 251. Justice Holmes continued: “A picture is none the less a picture and none the less a subject of copyright that it is used for an advertisement.” *Id.*

<sup>107</sup> *Id.*

<sup>108</sup> Copyright Act of 1909, Pub. L. No. 60-349, 35 Stat. 1075 (Mar. 4, 1909; repealed Jan. 1, 1978).

<sup>109</sup> *Id.* at § 5.

<sup>110</sup> *See* Copyright Act of 1909, at § 4 (“[T]he works for which copyright may be secured under this Act shall include all the writings of an author.”); § 5 (“[T]he application for registration shall specify to which of the following classes the work in which copyright is claimed belongs [including ‘(g) Works of art; models or designs for works of art’] . . . [but this list shall] not be held to limit the subject-matter of copyright as defined in section four of this Act[.]”).



toys, games, dolls, advertising novelties, instruments or tools of any kind, glassware, embroideries, garments, laces, woven fabrics or any similar articles.”<sup>111</sup>

Yet the Copyright Office softened the above-quoted regulation via a 1917 revision, after which it read: “The protection of productions of the industrial arts utilitarian in purpose and character even if artistically made or ornamented depends upon action under the patent law; but registration in the Copyright Office has been made to protect artistic drawings notwithstanding they may afterwards be utilized for articles of manufacture.”<sup>112</sup> Further complicating the picture, the Office apparently accepted for registration, as early as 1912, “works of art possessing utilitarian aspects”—though the practice, which appears to have been more *ad hoc* than systematic, came to light only decades later.<sup>113</sup> (Such works tended to be at least loosely classifiable as “sculpture”—“statuettes, book ends, clocks, lamps, door knockers, candlesticks, inkstands, chandeliers, piggy banks, sundials, salt and pepper shakers, fish bowls, casseroles, and ash trays”<sup>114</sup>—rather than apparel or “soft” home goods.)

Meanwhile, even as fashion had been mentioned in passing in copyright cases before the 1910s, it seems that no party had been so bold as to claim in court that a *fashion design itself*—as distinguished from a printed work containing images of fashion designs—was entitled to copyright protection. To bring a suit on this basis would require (1) affixing a notice of copyright protection on an article of clothing—a perilous proposition for works not clearly protectable, since use of any “fraudulent notice” was punishable by a fine—and (2) persuading the responsible government agent to accept a “deposit” of a copy (or photograph) of the work.<sup>115</sup> Importantly,

---

<sup>111</sup> Rules and Regulations for the Registration of Claims to Copyright, Copyright Office Bull. No. 15, § 12(g), at 8-9 (1917), *full text of then-applicable regulations available at* ARTHUR WILLIAM WEIL, AMERICAN COPYRIGHT LAW, WITH ESPECIAL REFERENCE TO THE PRESENT UNITED STATES COPYRIGHT ACT, WITH APPENDICES CONTAINING FORMS FROM ADJUDICATED CASES, AND THE COPYRIGHT LAWS OF ENGLAND, CANADA, AUSTRALIA, GERMANY, AND FRANCE 624 (1917) (hereinafter, “WEIL, AMERICAN COPYRIGHT LAW”).

<sup>112</sup> 37 C.F.R. § 201.4(7) (1939).

<sup>113</sup> See *discussion* at Mazer v. Stein, 347 U.S. 201, 212 (1954).

<sup>114</sup> See *id.* at 212; *id.* at 221 (Douglas, J., concurring).

<sup>115</sup> WILLIAM F. PATRY, COPYRIGHT LAW AND PRACTICE 37-38, 46 (1994).

there appears to be no record of a reported judicial decision<sup>116</sup> concerning the governmental refusal to register a work until 1898.<sup>117</sup>

To the extent fashion design was not considered a “fine art,”<sup>118</sup> as was required for copyrightability during the period of many of the decisions discussed,<sup>119</sup> it was—at least in theory—barred from copyright protection as a threshold matter. Only in Justice Holmes’ 1903 majority opinion in *Bleistein* would many (but certainly not all) visual works not qualifying as “fine art” be rescued from their copyright no-man’s land.<sup>120</sup> Even after *Bleistein*, however, litigants would sometimes try to evade liability for copying fashion-related material by invoking either the “common” status of the materials, or the nature of fashion’s output as the mere “productions of the industrial arts,” or both.

---

<sup>116</sup> It is possible that unreported decisions and/or summary orders—and, during an earlier period, casual rejections in district courts of attempted deposits of material deemed non-copyrightable—did not surface during the research conducted for this series of articles.

<sup>117</sup> See *id.* at 52 n. 167 (“In the first decision regarding the Librarian’s refusal to register a work, *United States v. Everson*, 26 Wash. L. Rep. 546 (Sup. Ct. D.C. 1898), the court rejected an effort to compel, by mandamus, registration for a completely blank book. The court indicated at the same time, however, that ‘the act is mandatory. . . . The Librarian has no discretion in relation to the matter of recording.’”).

<sup>118</sup> The uniformly male judges on the Nineteenth-Century federal bench would almost certainly have deemed fashion design not to be a “fine art.” The decision in *Drury v. Ewing* is illustrative. There, the presiding judge included something resembling praise in his opinion finding for the pattern-designer plaintiff: “I can not perceive why her rights as an authoress or inventress should be prejudiced by this form of publication. If the chart, as the court is bound, for reasons before intimated, to presume, is original with her—the product of thought and mental toil—her claim is by no means destitute of merit, and she is justly entitled to all the benefits which the law confers.” 7 F. Cas. at 1116. The judge then stated: “It is clearly no objection to the validity of her copyright, that *her production does not claim a standing as a work of great literary merit*. The statute does not make this a necessary element of a legal copyright; and it is well known there are *works of great practical utility, having no pretension to literary merit*, which are yet within, not only the words, but the scope and design of the statute.” *Id.* (emphasis added). It is worth noting that even this level of highly qualified praise, including the court’s description of the pattern-maker as “an authoress or inventress,” would become increasingly difficult to locate in judicial decisions concerning fashion over the next thirty years. See generally Colman, *supra* note 10.

<sup>119</sup> See discussion at GOLDSTEIN, *supra* note 52. This is all the more expected in light of the then-recent statutory marginalization of “articles of manufacture,” discussed above.

<sup>120</sup> See discussion *supra* at text accompanying notes 105-07.

Such arguments were advanced, for instance, by the defendant in the 1911 case of *National Cloak & Suit Co. v. Kaufman*, which concerned the unauthorized reproduction of a book entitled “New York Fashions, Vol. 14, No. 4.”<sup>121</sup> The work at issue was described by the presiding court as comprising illustrations of “original conceptions and creations relating to wearing apparel, of great interest to a large proportion of the public on account of the originality and exercise of trained aesthetic faculties displayed in said illustrations. . . .”<sup>122</sup> Despite the defendant’s arguments, the court saw “no reason why copyright should be withheld from the complainant’s pictures of ladies showing to advantage wearing apparel of the latest styles and its manufacture,” as *the “complainant {did} not claim to monopolize the manufacture and sale of the wearing apparel depicted by reason of its copyright.”*<sup>123</sup>

In other words, like the Supreme Court in *Baker*, the presiding judge in *Kaufman* appeared to have no doubt about the non-copyrightability of *the fashion designs themselves*: “Of course, the complainant cannot monopolize the right to picture these. ‘Others are free to copy the original. They are not free to copy the copy.’”<sup>124</sup> The *Kaufman* court recited an important distinction that substantially persists today:<sup>125</sup>

The fallacy in [defendant’s] argument that the complainant cannot copyright ‘productions of the industrial arts’ lies in the confusion of the pictures with the things they depict in a particular way; that is, the wearing apparel which appears in the illustration as part of the pictures. As said by Mr. Justice Bradley in *Baker v. Selden, supra*: ‘There is a clear distinction between the book as such and the article which it is intended to illustrate. The object of the one is illustration; of the other it is the use thereof. The former may be secured by copyright, the latter [to the extent protectable at all under federal intellectual property law] by patent.’<sup>126</sup>

Further, the Copyright Office’s regulations contributed to perpetuating a “fine arts” requirement that had an adverse impact on fashion design.

As discussed above, some participants in the fashion industry had, in the latter half of the Nineteenth Century, attempted to assert rights in their creations through the vehicle of design patents.<sup>127</sup> This might have been in

<sup>121</sup> 189 F. 215, 216 (C.C.M.D. Pa. 1911).

<sup>122</sup> *Id.*

<sup>123</sup> *Id.* at 219 (emphasis added).

<sup>124</sup> *Id.* at 218 (citations to earlier cases, none involving apparel, omitted).

<sup>125</sup> See discussion at *On ‘Originality’* (second article in this five-article series).

<sup>126</sup> *Kaufman*, 189 F. at 219.

<sup>127</sup> To be sure, apparel companies relied on *utility* patents at the same time, though such efforts also often failed to prevent perceived “piracy.” See, e.g., *Rheubottom v. Loomer*, 26 F. 698, 699 (C.C.D. Conn. 1886) (dismissing infringement

part because of the assumption, reflected in judicial decisions of the period, that fashion-related materials simply were not the proper subject matter of copyright protection. In the 1889 case of *Untermeyer v. Freund*, for example, a New York federal district judge had explained: “The policy which protects a design [under the “design” branch of patent law] is akin to that which protects the works of an artist, a sculptor or a photographer by copyright.”<sup>128</sup> (The court ruled that the defendant had infringed the plaintiff’s design patent in decorative watch cases.)<sup>129</sup>

But while design patentees in the jewelry and accessory realms had enjoyed occasional success in the courts,<sup>130</sup> patentees of textile (and textile-related) designs and numerous other decorative components of fashion found that design patents provided a gradually more perilous avenue of potential recourse.<sup>131</sup> With increasing frequency, the federal courts—especially in the influential Second Circuit, whose word on design patents was akin to gospel after the Supreme Court stopped granted *certiorari* in design-patent cases after the 1890s—tended to rejected potential liability for the copying of patented fashion designs.<sup>132</sup>

---

suit based on evidence that method of improving hoop skirts had been used by third parties several years before plaintiff obtained a utility patent in same).

<sup>128</sup> 37 F. 342, 344 (C.C.S.D.N.Y. 1889).

<sup>129</sup> *Id.* at 345.

<sup>130</sup> *See, e.g.*, *Dreyfus v. Schneider*, 25 F. 481, 481 (C.C.S.D.N.Y. 1885) (ruling for patentee of design consisting of “a ring made of chenille, or other analogous fabric, suspended from a tuft, and a ball suspended in like manner in the center of the ring; the thickness of the ring increasing from the bottom of the tuft to a point diametrically opposite”).

<sup>131</sup> *But see* *Untermeyer v. Freund*, 37 F. 342, 344, 345 (C.C.S.D.N.Y. 1889) (decision for plaintiff/patentee in watch-case design patent lawsuit, in which the court states that “if [a design] proves to be pleasing, attractive, and popular, if it creates a demand for the goods of its originator, even though it be simple, and does not show a wide departure from other designs, its use will be protected” and considers it “impossible to read the literature upon this subject without being convinced that the courts, though applying the same rules, have looked with greater leniency upon design patents than patents for other inventions.”).

<sup>132</sup> *See, e.g.*, *Post v. T.C. Richards Hardware Co.*, 26 F. 618, 619 (C.C.D. Conn. 1886) (“It is not clear that the substitution of any metallic loop for a silk or woolen loop is a ‘design’ of the character which the statute contemplates; but, without deciding that question, it is clear that if such a change can properly be called a design, it is not a patentable design. The mere substitution of one material for another, in the construction of or for the purposes of an ornament, the ornament to be of any approved form, cannot properly be patentable. There is nothing which the law deems ‘new’ in a mere change of that sort.”).

While the full range of reasons for this doctrinal development is open to debate,<sup>133</sup> it is clear that many designers had lost their taste for design patents by the first decade of the Twentieth Century.<sup>134</sup> Oft-cited disadvantages of this form of IP protection included the cost and trouble of procuring a design patent, the relatively short duration of any protection ultimately obtained,<sup>135</sup> and the uncertainty about whether such patents could actually be enforced in court, notwithstanding the imprimatur of the Patent Office.<sup>136</sup>

---

<sup>133</sup> In *Patents and Perverts* (work-in-progress), I argue that complex social dynamics surrounding gender and sexuality were partially responsible for this doctrinal marginalization of design patents. This is not to deny, however, that some judges had “legitimate” jurisprudential objections to the claims asserted by design patentees. See, e.g., *Jennings v. Dolan*, 24 F. 697, 698 (C.C.S.D.N.Y. 1885) (opining that “[t]here are so many of these things [lace designs with fringe] that the differences are necessarily small, and small differences make different designs” and declaring that in the court’s view, “as fringed fabrics the designs as to the fringes appear to be different”). Regardless of the presiding judges’ motivations, however, design patentees were vulnerable to both the district and appellate courts’ tendency to take rather casual judicial notice of the novelty—or lack of novelty—of the subject matter of their patents, even after the U.S. Supreme Court’s decision in *New York Belting and Packing Co. v. New Jersey Car Spring and Rubber Co.*, 137 U.S. 445, 450 (1890) (“Whether or not the design is new is a question of fact, which, whatever our impressions may be, we do not think it proper to determine by taking judicial notice of the various designs which may have come under our observation.”). This, of course, made such protection less appealing.

<sup>134</sup> Some designers continued to rely on design patent protection, and still make frequent use of it today. See discussion at *The Politics of ‘Piracy’* (fifth installment in five-article series). See, e.g., *Kraus*, 34 F. 39 (ruling that defendant’s product infringed plaintiff’s design patent in particular type of corset). Note, however, that the plaintiff in *Kraus* appears to have only barely made out his case. See *id.* (“Most of the special features of this design are to be found, separately, in prior things, but they are nowhere combined so as to make such an effect as a whole; and that is what is to be looked at.”).

<sup>135</sup> See, e.g., *Kraus v. Fitzpatrick*, 34 F. 39, 39 (C.C.S.D.N.Y. 1888) (“This suit is brought upon design patent No. 13,620, dated February 13, 1883, and granted to Frank Welton, assignor to the orators, to run seven years, for a corset.”).

<sup>136</sup> See, e.g., *Streat v. White*, 35 F. 426, 427 (C.C.S.D.N.Y. 1888) (dismissing infringement suit based on design patent granted for print simulation of seersucker fabric, as he had merely “imitate[ed] an old woven fabric,” precluding a finding of novelty required for a valid patent); accord. *Streat v. Simpson*, 53 F. 358, 359 (C.C.S.D.N.Y. 1891) (“[T]he defendants’ pattern is not more like the plaintiff’s than like the photograph of seersucker, which all would have a right to work into any pattern not a copy of a patented one.”).

As a result, even as the opening years of the new century witnessed significant strides in “American design,”<sup>137</sup> there appeared to be no realistic, viable option for most fashion designers to take legal action against the purveyors of rising numbers of “knockoffs.”<sup>138</sup> (As the Register of Copyrights later observed: “That [design] patents have proved inadequate as a practical form of protection for designs is something on which most people will agree.”<sup>139</sup>) This “failure of the patent law as a method to combat [‘design piracy’] led to a variety of alternative efforts to protect original designs.”<sup>140</sup>

One such effort was the concerted lobbying of Congress, beginning in the 1910s, by designers seeking the codification of a more viable form of IP protection.<sup>141</sup> As David Goldenberg has recounted, advocates of design protection made their first serious attempt to persuade lawmakers to establish “a copyright-like, registration only regime (without a search of prior art)” between 1914 and 1916:

The first hearings were held in 1914, with longer hearings held on substantially the same bill in 1916. These bills are collectively referred to as the Oldfield Bills. The bills provided for the registration with the United States Patent Office of “any design, new and original, as embodied in or applied to any manufactured product of an art or trade . . . . The bill was drafted by the Design Registration League, an organized group of companies which believed that they “were unable to obtain satisfactory protection for their original design work” under the then present statutes.<sup>142</sup>

---

<sup>137</sup> See, e.g., WILLIAM LEACH, *LAND OF DESIRE* 166 (1993) (recounting, *inter alia*, *Women’s Wear Daily* editor and American Museum of Natural History curator Morris D’Camp Crawford’s influential “Designed in America” campaign, carried out in the years immediately following World War I).

<sup>138</sup> See Maurice A. Weikart, *Design Piracy*, 19 *IND. L.J.* 235, 239 (1944) (describing the growth and impact of design piracy).

U.S. Library of Congress, Draft of Second Supplementary Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law, Chapter VII, at 4 (1975) (hereinafter “Register of Copyrights, 1975 Draft of Second Supplementary Report”).

<sup>139</sup> *Id.*

<sup>140</sup> *Id.*

<sup>141</sup> H.R. Rep. No. 11321, 63d Cong., 2nd Sess. (1914). See Weikart, *supra* note 139, at 236 (“The 1914 attempt to get legislative relief represented the first stirring of the movement to secure complete design protection covering [fashion] designs beyond the copyright and design patent law [and was] introduced just about the time when the ready-made apparel industry of the United States was beginning its development into the million-dollar proportions it possesses today”).

<sup>142</sup> Goldenberg, *supra* note 11, at 27-28 (internal citations omitted).

As Goldenberg explains, the designers' rhetoric ranged from rights-based arguments to economic rationales; they also argued "that protection would create [a more robust] American design industry, and that lack of protection would further the then current practice of importing all quality designs and designers from abroad."<sup>143</sup> The fashion industry, specifically, "raised the question of originality in its fundamental sense, with one speaker stating: 'We cannot help copying [but that is perhaps beside the point, as] infringement depends on how you define a new style.'"<sup>144</sup> Despite several efforts to rework the bills to address the vehement objections of opponents, and the House Committee's general support of the legislation, the bills resulted in no new laws.<sup>145</sup>

(It is probably safe to say that these advocates of more robust copyright protection for fashion designs did not anticipate how long and fruitless their struggle would be. Between 1914 and 1976, roughly seventy fashion-specific design protection bills were introduced in Congress, none of which became law;<sup>146</sup> from 1976 to 2012, additional bills on the subject were introduced, but none made it through the House and the Senate.<sup>147</sup>)

Designers' lack of success in the legislative realm appears to have fueled newly aggressive efforts to seek protection in the courts, through litigation premised on various legal theories. One strategy was to invoke the tort of "unfair competition," a common-law cause of action protecting against certain types of misrepresentation and other misconduct.<sup>148</sup> This approach sometimes proved effective, as in the 1918 New York appellate court deci-

<sup>143</sup> *Id.* at 28 (internal citations omitted).

<sup>144</sup> *Id.* at 29-30 (internal citations omitted).

<sup>145</sup> *Id.* at 31.

<sup>146</sup> See *Esquire, Inc. v. Ringer*, 591 F.2d 796, 800 n.12 (D.C. Cir. 1978).

<sup>147</sup> See generally Goldenberg, *supra* note 11.

<sup>148</sup> See *Notes: Self-Protection of Design Creation in the Millinery Industry*, 49 YALE L.J. 1290, 1292 (1940) (hereinafter "*The Millinery Industry*") ("In the absence of legislation, the courts have permitted appropriation of another's design so long as the copyist could not be accused of such unfair competition[.]'). While the student author of the cited piece surely cannot be considered an authority on the fashion industry, it is notable that he felt comfortable adding this commentary to his summary of the law: "Since manufacturers rarely insert trade names in their hats, there is scant chance for their product to become known in the public mind and, therefore, no basis for a claim of 'palming-off.' It is difficult to imagine protection for the style creator from the law of unfair competition." *Id.* at note 15. In fact, manufacturers had begun to insert brand-identifying labels onto their products by the 1930s, and unfair competition—broader than a tort of mere 'palming off'—had sometimes been, and would continue to be, at least in certain circumstances, a viable cause of action for fashion designers confronted with objectionable business activities. See *discussion* at *Lewis v. Vendome Bags*, 108 F.2d 16 (2d Cir. 1939).

sion in *Montegut v. Hickson, Inc.*<sup>149</sup> In *Montegut*, the New York outpost of a French company enjoying “the most exclusive clientele [and] an international and enviable reputation for the creation of exclusive models and styles” of dress prevailed, on an unfair competition theory, against a competitor that had used a mole to purchase gowns that were subsequently stripped of their labels and sold to defendant’s customers.

The difficulties with unfair competition as a reliable tool for designers was apparent from the opinion of the dissenting judge in *Montegut*, who noted that “[t]he question of patent or copyright [was] not involved in this case, as the plaintiffs’ models [were] neither copy-righted nor patented.”<sup>150</sup> Indeed, even the majority opinion “agree[d] that the defendant has a legal right to copy and to sell as its own creations the exclusive models designed by the plaintiffs if the models or an inspection of the models are procured by fair means,” but found the defendant’s conduct actionable because it had “obtain[ed] plaintiffs’ trade by resort[ing] to fraud and deception[.]”<sup>151</sup> Thus, it seemed that the savvy knockoff artist could avoid liability for unfair competition simply by, for example, standing outside a store and sketching the designs presented in the window, for later reproduction.

By the 1920s, some designers had grown bolder in their attempted use of copyright protection to stop unauthorized copies of their creations.<sup>152</sup> One New York federal district-court decision, *Kemp & Beatley, Inc. v. Hirsch*, analyzed the issue of copyright protection for fashion design in a way that the plaintiff had likely hoped to avoid—and which would be cited repeatedly in the years to come.<sup>153</sup> In *Kemp*, a plaintiff sued for copyright infringe-

---

Regardless, the Note author’s apparent perception that most women’s high-fashion hats remained “unbranded” as late as 1940 is worthy of mention.

<sup>149</sup> 164 N.Y.S. 858, 860 (N.Y. App. Div. 1918).

<sup>150</sup> *Id.* at 98, 861 (Davis, J., dissenting).

<sup>151</sup> *Id.* at 97, 860.

<sup>152</sup> See *Kemp & Beatley, Inc. v. Hirsch*, 34 F.2d 291 (S.D.N.Y. 1929). Fashion designers had already begun to look to copyright law for more limited objectives, with mixed results. See *Royal Sales Co. v. Gaynor*, 164 F. 207, 208-09 (C.C.S.D.N.Y. 1908) (“I think the monogram [graphic design at issue in this case] is not a subject within the copyright law. If it were, any one could get, by means of a copyright, what would be substantially a patent for a design for a longer term and upon payment of less fees than [federal law] prescribes in the case of design patents.”).

<sup>153</sup> Note: *Protecting the Artistic Aspects of Articles of Utility: Copyright or Design Patent?*, 66 HARV. L. REV. 877, 880 (1953) (“The value of the *Kemp* holding as precedent [would seem] to have been reduced in 1948 when the Copyright Office finally eliminated the ‘fine arts’ restriction and adopted the position that works of ‘artistic craftsmanship’ may be protected as ‘works of art’ regardless of their practical use. Yet a recent textile design case in continuing to cite *Kemp* as authority indicates that



ment over the copying of dress designs contained in a copyright application that it had successfully submitted for registration under the category of “Work of Art (Painting, Drawing or Sculpture), or for Model or Design for a Work of Art.”<sup>154</sup> The presiding judge was immediately skeptical:

The question [presented in this case] is whether a design for dress goods stamped on paper, or on the goods themselves, is a proper subject for copyright protection. One is aided towards reaching a conclusion by inquiry as to what monopoly right the plaintiff really sought to obtain. It would seem that the aim of the plaintiff was to secure a monopoly right of the manufacture and sale of dress patterns which embodied the designs sought to be copyrighted.<sup>155</sup>

The court proceeded to engage in statutory construction of the copyright laws’ language concerning “works of art,” finding that the relevant provision contemplated only “paintings, drawing, and sculptures,” and models for those specific types of media.<sup>156</sup> The plaintiff here, however, had (at least, in the court’s view) conceded “that its design [was not] for a painting, drawing, or sculpture.”<sup>157</sup>

The *Kemp* court then put the nail in the coffin of the designer plaintiff’s case through reliance on a regulation promulgated by the Librarian of Congress, stating: “The protection of productions of the industrial arts utilitarian in purpose and character, even if artistically made or ornamented depends upon action under the patent law.”<sup>158</sup> Works of this sort, which

---

the change in the regulations has not had a significant impact on the established judicial position.”) (citations omitted).

<sup>154</sup> *Kemp & Beatley*, 34 F.2d at 291-92.

<sup>155</sup> *Id.*

<sup>156</sup> *See id.* at 292 (“Is the copyright statute intended to afford such protection? The form of application requires an applicant to state whether that which is sought to be copyrighted is a work of art, or a model or design for a work of art. The plaintiff answered that inquiry by stating that its matter constituted a design for a work of art. What does the phrase ‘work of art’ mean, as used in the application? The application itself indicated with convincing clearness exactly what is meant, for after ‘Work of Art’ the words ‘Painting, Drawing, or Sculpture’ are used in parenthesis, and that language is followed immediately by the following: ‘Or for Model or Design for a Work of Art.’ Does it not follow, therefore, that the design for a work of art contemplated by this application is a design for a ‘painting, drawing, or sculpture?’”).

<sup>157</sup> *Id.* (“But there is no contention by the plaintiff that its design is for a painting, drawing, or sculpture; on the contrary, its design is for a pattern, the best edition of which was the pattern stamped on dress goods.”).

<sup>158</sup> *Id.* (quoting Rule 12(g) of “Rules and Regulations for the Registration of Claims to Copyright”).

included “[t]oys, games, dolls, advertising novelties, instruments or tools of any kind, glassware, embroideries, garments, laces, woven fabrics, or similar articles,” were deemed outside the bounds of copyright by the government entity with the primary responsibility for administering copyright—confirming the court’s original intuition.<sup>159</sup>

At roughly the same time as the *Kemp* litigation, patterned-silk designer Cheney Bros., tried its hand at anti-knockoff litigation, taking an alternative approach that sought to navigate the obstacles of both traditional unfair competition law and formal copyright protection.<sup>160</sup> Cheney Bros.’ legal theory was premised on the Supreme Court’s 1918 ruling in *International News Service v. Associated Press*, which had addressed the practice of a defendant (“INS”) taking news released by the Associated Press (“AP”), rewording it somewhat, and selling it to consumers—before the AP’s coverage even reached many of those consumers.<sup>161</sup> The twist in *INS* was that the defendant could not be held liable for copyright infringement, as it had made use only of unprotectable “facts”<sup>162</sup> contained within the AP’s coverage, and had used only material that the AP made available to the consuming public—seemingly avoiding the pitfalls of both copyright infringement and unfair competition law.<sup>163</sup> Nevertheless, the *INS* Court used its then-

---

<sup>159</sup> The court added a footnote with some decidedly unhelpful advice: “Parenthetically it may be observed that, if the plaintiff’s designs were novel and the result of invention, complete protection could have been had by the plaintiff by obtaining design letters patent. Revised Statutes, Secs. 4929 and 4933 (35 USCA § 73), were particularly enacted to provide such protection.” *Id.* at n.2.

<sup>160</sup> It is worth noting that the plaintiff in *Kemp* had also invoked the tort of unfair competition, but was rebuffed by the court due to a lack of diversity of citizenship between the parties. *Id.* at n.3. Whether this bespeaks a growing skepticism of the federal courts’ authority in the realm of “federal common law”—addressed by Judge Learned Hand in the Cheney Bros. case, is open to question (but certainly possible).

<sup>161</sup> 248 U.S. 215, 232 (1918).

<sup>162</sup> See *Int’l News Serv. v. AP*, 248 U.S. 215, 246 (1918) (Holmes, J., concurring) (“When an uncopyrighted combination of words is published there is no general right to forbid other people repeating them – in other words there is no property in the combination or in the thoughts or facts that the words express. Property, a creation of law, does not arise from value, although exchangeable – a matter of fact. Many exchangeable values may be destroyed intentionally without compensation.”).

<sup>163</sup> *Id.* at 241 (“It is [argued by defendant] that the elements of unfair competition are lacking because there is no attempt by defendant to palm off its goods as those of the complainant, characteristic of the most familiar, if not the most typical, cases of unfair competition.”).

existing “federal common-law” powers<sup>164</sup> to rule that because “both parties are seeking to make profits at the same time and in the same field . . . as between them, [the AP’s news] must be regarded as *quasi* property, irrespective of the rights of either [party] as against the public.”<sup>165</sup>

The general rationale for the Court’s 1918 *INS v. AP* ruling<sup>166</sup>—that regardless of what copyright law might have to say on the matter, a company should not be permitted to free-ride on “the cost of enterprise, organization, skill, labor, and money” of a competitor by selling a knockoff version of the original product—arguably fit like a glove (so to speak) in the context of fashion piracy—or so argued Cheney Bros. in the late 1920s.<sup>167</sup> Like many designers, Cheney Bros. created and released many new patterns each season, only a fraction of which became popular with the public—and each only for a short time, perhaps nine months at most.<sup>168</sup> Defendant Doris Silk had developed a business model whereby it waited to see which of Cheney’s (and presumably others companies’) patterns struck the public’s fancy, and

---

<sup>164</sup> The Supreme Court’s *INS* ruling pre-dated by two decades the Court’s decision in *Erie Railroad Co. v. Tompkins*, 304 U.S. 64 (1938), which established definitively that a federal court sitting in diversity and presiding over a common-law “unfair competition” case—as distinguished from, for example, present-day litigation for unfair competition brought under the federal Lanham Act of 1946—is bound by relevant state law. See *Fashion Originators’ Guild of America v. FTC*, 312 U.S. 457, 468 (1941) (“[W]hether or not given conduct is tortious is a question of state law, under our decision in *Erie R. Co. v. Tompkins* . . .”). However, even where state law might purport to render actionable various types of “misappropriation,” such causes of action will often be held preempted by the U.S. Copyright Act. See *Laws v. Sony Music Ent.*, 448 F.3d 1134, 1137-38 (9th Cir. 2006) (“We have adopted a two-part test to determine whether a state law claim is preempted by the Act. We must first determine whether the ‘subject matter’ of the state law claim falls within the subject matter of copyright as described in 17 U.S.C. §§ 102 and 103. Second, assuming that it does, we must determine whether the rights asserted under state law are equivalent to the rights contained in 17 U.S.C. § 106, which articulates the exclusive rights of copyright holders.”) (Internal citations and footnotes omitted.) One curiosity of contemporary IP law is that, through the power of *stare decisis*, the *INS v. AP* “hot news” doctrine has managed to survive the demise of “federal common law” and still exists, in emaciated form, today. See, e.g., *NBA v. Motorola*, 105 F.3d 841, 843 (2d Cir. 1997).

<sup>165</sup> *Id.* at 236 (emphasis in original).

<sup>166</sup> Though this terminology was not used in the 1918 Supreme Court decision, the doctrine is now known as “hot news misappropriation.” See, e.g., *NBA*, 105 F.3d at 843.

<sup>167</sup> *Cheney Bros. v. Doris Silk Corp.*, 35 F.2d 279, 280 (2d Cir. 1929) (citing *Int’l News Service v. Associated Press*, 248 U.S. 215 (1918)).

<sup>168</sup> *Id.* See also Weikart, *supra* note 139, at 239 (discussing the “wait-and-see” approach).

copied only those, undercutting the price of the original manufacturer. Cheney Bros. sought recourse through an *INS v. AP* “misappropriation” theory—and lost.<sup>169</sup>

The preeminent Judge Learned Hand, writing for a unanimous Second Circuit panel in 1929, expressed sympathy for designers whose “ingenuity and expense” had gone into the copied designs; he even opined that “it would seem as though the plaintiff had suffered a grievance for which there should be a remedy.”<sup>170</sup> But Judge Hand nevertheless wrote that the plaintiff had no cause of action against copyists under federal law in the absence of patent protection (which he acknowledged would be impractical and burdensome to obtain, given the rapidity of the fashion cycle and most fashion articles’ lack of the requisite novelty) or copyright protection (which Judge Hand wrote was “impossible to [obtain for fashion designs] under the Copyright Act . . . , or at least so the authorities of the Copyright Office hold.”)<sup>171</sup>

At the plaintiff’s urging, Judge Hand’s decision reflected on unfair competition cases like *Montegut v. Hickson, Inc.*, but he found that they merely created an exception to the rule that, absent patent or copyright protection, “a man’s property is limited to the chattels which embody his invention [and others] may imitate [such property] at their pleasure.”<sup>172</sup> Patent and copyright protection were both creatures of statute, upon which Congress had “imposed . . . conditions . . . upon the creation of the right,” and Judge Hand would not use the judiciary’s “limited power to amend the law” to circumvent these statutory limitations.<sup>173</sup> Judge Hand further explained: “To exclude others from the enjoyment of a chattel is one thing; to prevent any imitation of it, to set up a monopoly in the plan of its structure, gives the author a power which the Constitution allows only Congress to create.”<sup>174</sup> In short, the plaintiff was out of luck.

---

<sup>169</sup> Cheney Bros., 35 F.2d 279 (2d Cir. 1929).

<sup>170</sup> *Id.* at 281.

<sup>171</sup> *Id.* at 279. The accuracy of the latter statement was and is open to question, as explained below.

<sup>172</sup> *Id.* at 280.

<sup>173</sup> As the silk patterns in question were copied *after* sale, Judge Hand did not address Section 2 of the 1909 Copyright Act, which provided that “nothing in this Act shall be construed to annul or limit the right of the author or proprietor of an unpublished work, at common law or in equity, to prevent the copying, publication, or use of such unpublished work without his consent, and to obtain damages therefor.” Rights existing only in *unpublished* works are discussed in *On ‘Similarity’* (fourth installment in this series).

<sup>174</sup> Judge Hand did not expressly accuse the U.S. Supreme Court of overreaching in creating a federal “misappropriation” cause of action for “hot news” in *INS v.*

Thus, whereas the Supreme Court in *INS v. AP* had been persuaded to make new law to right the wrong before it,<sup>175</sup> Judge Hand felt constrained from doing so. In his view, this was a matter for the legislature, and “Congress might see its way to create some sort of temporary right, or it might not.”<sup>176</sup> Either way, the legislature’s “decision would certainly be preceded by some examination of the result upon the other interests affected.”<sup>177</sup> (As noted below, the relevant legislative activity in the late 1920s and early 1930s was indeed among the most contentious, and the most promising, for designers.)

Technically, the *Cheney Bros.* court’s proclamations about the non-copyrightability of fashion designs were *dicta*, for the plaintiff had brought no copyright claim. Further, the Copyright Act of 1909’s provision on copyrightable subject matter was broadly worded<sup>178</sup> and did not explicitly exclude fashion prints from consideration. But again, the regulations promulgated by the Copyright Office to administer the 1909 Copyright Act were more restrictive, stating in part that “[n]o copyright exists in toys, games, dolls, advertising novelties, instruments or tools of any kind, glassware, embroideries, garments, laces, woven fabrics or any similar article.”<sup>179</sup>

---

A.P., 248 U.S. 215, but it seemed clear that he disapproved of the Court’s doctrinal innovation. Judge Hand thus unequivocally limited the reach of that case to “news and perhaps market quotations.” *Cheney Bros.*, 35 F.2d at 281. Again, while the “hot news” doctrine managed to survive the demise of “federal common law” in *Erie R.R. Co. v. Tompkins*, 304 U.S. 64 (1938), it survives only in emaciated form today. See *On ‘Similarity’* (fourth installment in this series).

<sup>175</sup> *INS*, 248 U.S. at 236 (“The rule that a court of equity concerns itself only in the protection of property rights treats any civil right of a pecuniary nature as a property right (In re Sawyer, 124 U.S. 200, 210; In re Debs, 158 U.S. 564, 593); and the right to acquire property by honest labor or the conduct of a lawful business is as much entitled to protection as the right to guard property already acquired.”).

<sup>176</sup> *Cheney Bros.*, 35 F.2d at 281.

<sup>177</sup> *Id.*

<sup>178</sup> See U.S. Copyright Act of 1909, § 4 (“the works for which copyright may be secured under this Act shall include all the writings of an author”); § 5 (“the application for registration shall specify to which of the following classes the work in which copyright is claimed belongs [including ‘(g) Works of art; models or designs for works of art’] . . . [but this list shall] not be held to limit the subject-matter of copyright as defined in section four of this Act”).

<sup>179</sup> Rules and Regulations for the Registration of Claims to Copyright § 12(g), Copyright Office Bull. No. 15, § 12(g), at 8-9 (1917), *full text of then-applicable regulations available at* WEIL, *AMERICAN COPYRIGHT LAW*, at 624. However, the reader should also recall that that the Copyright Office had made a somewhat liberal amendment to this regulation, in 1917, to provide that “[t]he protection of productions of the industrial arts utilitarian in purpose and character even if artistically made or ornamented depends upon action under the patent law; but registration in

It is far from clear that the Copyright Office had the power to narrow the category of copyrightable “artistic works” in this manner.<sup>180</sup> But *Cheney Bros.* was not an administrative law case,<sup>181</sup> and the broad strokes of the Second Circuit’s decision seemed clear: fashion had no place in copyright law. *Cheney Bros.* further established, or at least distilled, many of the major points in the “copyright-for-fashion” debate that still apply today.<sup>182</sup> (It is important to note that despite *Cheney Bros.*, the courts—especially the New York state court—continued to adjudicate unfair competition cases involving fashion copyists for decades,<sup>183</sup> and still do so today,<sup>184</sup> though such cases are now often dismissed on federal preemption grounds.<sup>185</sup>)

The outcome of the *Cheney Bros.* case likely created additional momentum for lobbying by designers seeking meaningful copyright protection in their creations, who did manage to get a design-protection bill passed by the House of Representatives in 1930.<sup>186</sup> Yet as their lobbying efforts contin-

---

the Copyright Office has been made to protect artistic drawings notwithstanding they may afterwards be utilized for articles of manufacture.” 37 C.F.R. § 201.4(7) (1939).

<sup>180</sup> One leading commentator wrote in 1917 that the Copyright Office’s narrow view of copyrightable artistic works “appears to take an unduly restricted view of the Act and appears unsupported either by statute or decision.” WEIL, *AMERICAN COPYRIGHT LAW*, at 214.

<sup>181</sup> Eleven years later, Judge Hand wrote for a Second Circuit panel that *did* preside over an administrative law case involving fashion copyists—but the proceeding, *Fashion Originators Guild v. FTC*, 114 F.2d 80 (2d Cir. 1940), concerned an agency other than the Copyright Office: the Federal Trade Commission. In any event, Judge Hand adhered to his previous position that “until the copyright law is changed, *or until the Copyright Office can be induced to register such designs as copyrightable under the existing statute*, [‘published’ fashion designs] fall into the public demesne without reserve.” *Id.* at 84 (citing *Cheney Bros.*, 35 F.2d 279) (emphasis added).

<sup>182</sup> See generally L.J. Jackson, *Some Designers Say Their Work Deserves Copyright Protection; Others Say It Would Harm the Industry*, ABA JOURNAL, (July 2011), [http://www.abajournal.com/magazine/article/the\\_genuine\\_article/](http://www.abajournal.com/magazine/article/the_genuine_article/).

<sup>183</sup> See, e.g., *Dior v. Milton*, 155 N.Y.S.2d 443 (N.Y. Sup. Ct. 1956); *Richard J. Cole, Inc. v. Manhattan Modes Co.*, 157 N.Y.S.2d 259 (N.Y. App. Div. 1956).

<sup>184</sup> See, e.g., *Spicy Clothing Co. v. Say What Inc.*, No. 103456/08, 2008 NY slip op 31192U; 2008 N.Y. Misc. LEXIS 8065 (N.Y. Sup. Ct. Apr. 24, 2008).

<sup>185</sup> See *The Politics of ‘Piracy’* (fifth installment in this series).

<sup>186</sup> See Goldenberg, *supra* note 11, at 37 (discussing, *inter alia*, 1930 “Vestal bill” that was passed by a majority in the House of Representatives, but not the Senate, and noting that it “was at this time that the interests of the silk manufacturers [like *Cheney Bros.*] became dominant in the design debate”).

ued throughout the decade,<sup>187</sup> and the aid of administrative agencies was sought in vain,<sup>188</sup> even as copyright infringement lawsuits continued to be brought by designers without success,<sup>189</sup> key players in the U.S. fashion industry opted to develop their own techniques for dealing with what was increasingly being described—not just by the designer community, but by a growing segment of the general public—as “design piracy.”<sup>190</sup>

The most visible industry self-help effort was the creation of the so-called “Fashion Originators Guild of America,” which a 1936 *TIME* magazine article explained was “founded three years ago [in 1933] to stamp out style piracy and [is] the principal prop of highgrade dressmaking.”<sup>191</sup> FOGA’s members implemented an extralegal system intended to make it financially impractical for retailers to sell or otherwise deal in “pirated” copies of popular women’s dress designs.<sup>192</sup> The perceived root of the problem, as later paraphrased by the Supreme Court, was that “[a]fter [original]

<sup>187</sup> See *The Millinery Industry*, 49 *YALE L.J.* 1290, 1292 (1940) (citing Hearings Before Senate Committee on Patents on H. R. 11852 71st Cong., 3d Sess., 117 (1931)).

<sup>188</sup> See *Jack Adelman, Inc. v. Sonners & Gordon, Inc.*, 112 F. Supp. 187, 189 (S.D.N.Y. 1934) (“In August, 1933, in response to a written inquiry from a designer of dresses, the Register of Patents replied as follows: ‘There are no provisions in the Copyright Law for protecting fashions for dresses. The right to make and sell an artistically designed garment may under proper circumstances be obtained by a design patent issued from the Patent Office but not by copyright.’”); See, e.g., *Nat Lewis Purses, Inc. v. Carole Bags, Inc.*, 83 F.2d 475, 476 (2d Cir. 1936) (“[T]he piracy of designs, especially in wearing apparel, has been often denounced as a serious evil and perhaps it is; perhaps new designs ought to be entitled to a limited copyright. Efforts have been made to induce Congress to change the law so as to give some such protection, without success so far.”).

<sup>189</sup> *Adelman*, 112 F. Supp. at 189-90 (“A dress is not copyrightable [even though a] picture of a dress is . . . . To give an author or designer an exclusive right to manufacture the art described in the certificate of copyright registration, when no official examination of its novelty has every been made, would unjustly create a monopoly and moreover would usurp the functions of letters-patent.”). See also *id.* at 188 (“The dress itself could hardly be classed as work of art and filed in the Register’s office.”).

<sup>190</sup> While Judge Hand had not employed the term “piracy” in the 1929 *Cheney Bros.* decision, the word appeared throughout his 1940 opinion in *Fashion Originators Guild v. FTC*, 114 F.2d 80 (2d Cir. 1940); the term also appears in secondary sources of the time. See generally *The Millinery Industry*, 49 *YALE L.J.* 1290 (1940).

<sup>191</sup> *Business & Finance: Dress War*, *TIME*, Mar. 23, 1936, at 88.

<sup>192</sup> As discussed in detail in *The Millinery Industry*, 49 *YALE L.J.* 1290 (1940), a similar system was devised by a guild of women’s hat designers and manufacturers. This initiative, like FOGA’s, provoked action by the FTC, in *In re Millinery Quality Guild, Inc.*, 24 F.T.C. 1136 (1937). The trajectory and outcome were essentially the same for both organizations. See *id.*; *Millinery Creators’ Guild, Inc. v. FTC*, 109

designs enter the channels of trade, other manufacturers systematically make and sell copies of them, the copies usually selling at prices lower than the garments copied.”<sup>193</sup>

While FOGA’s system was not foolproof,<sup>194</sup> it appears to have been reasonably effective during its brief existence, as the system drew (unsuccessful) legal challenges by private parties,<sup>195</sup> and then a (successful) challenge by the Federal Trade Commission, which initiated antitrust proceedings against FOGA in the late 1930s based on the Clayton, Sherman, and FTC Acts.<sup>196</sup> The FTC ruled against FOGA on a largely stipulated record; the Guild then appealed to the Second Circuit<sup>197</sup> and ultimately to the Supreme Court, which agreed, for reasons explained below, that FOGA’s practices constituted an unlawful restraint of trade.<sup>198</sup>

At the center of the challenged system, the Supreme Court explained, was a boycott by “one hundred and seventy-six manufacturers of women’s garments who are members of the Guild [and notably] occupy a commanding position in their line of business” of any entity found to deal in or sell knockoff fashion items.<sup>199</sup> Knockoff determinations were made based on a private system, intended to serve as substitute for absent IP protection under federal law. Bypassing the U.S. Copyright and Patent Offices, “[t]he Guild maintain[ed] a Design Registration Bureau for garments, and the Textile Federation maintain[ed] a similar Bureau for textiles.”<sup>200</sup> Registered designs, instead of a copyright notice or a patent number, carried a special FOGA label, two examples of which are pictured in *Figure 1*, below.

---

F.2d 175 (2d Cir. 1940); *Millinery Creators’ Guild, Inc. v. FTC*, 312 U.S. 469, 471 (1941) (“present[ing] virtually the same issues as” the *FOGA* dispute).

<sup>193</sup> *Fashion Originators’ Guild of America v. FTC*, 312 U.S. 457, 461 (1941).

<sup>194</sup> *Id.* at 466 (“[I]t [is not] determinative in considering the policy of the Sherman Act that petitioners may not yet have achieved a complete monopoly [as it is] the object of the Federal Trade Commission Act to reach [attempted monopolies and other undesirable restraints of trade] not merely in their fruition but also in their incipency combinations which could lead to these and other trade restraints and practices deemed undesirable.”).

<sup>195</sup> *See Filene’s Sons Co. v. Fashion Originators’ Guild of America, Inc.*, 90 F.2d 556, 559 (1st Cir. 1937). This dispute is covered in the *TIME* article cited *supra* at note 184. *See also* *Wolfenstein v. Fashion Originators’ Guild of America, Inc.*, 280 N.Y.S. 361 (N.Y. App. Div. 1935).

<sup>196</sup> *In re Fashion Originators’ Guild of America, Inc.*, 28 F.T.C. 430 (Feb. 8, 1939).

<sup>197</sup> *Fashion Originators’ Guild of America v. FTC*, 114 F.2d 80 (2d Cir. 1940).

<sup>198</sup> *Fashion Originators’ Guild of America v. FTC*, 312 U.S. 457 (1941).

<sup>199</sup> *Id.* at 462-63.

<sup>200</sup> *Id.* at 462.





FIGURE 1: Sample labels indicating authorized, FOGA-registered fashion designs.

“red-carding” (*i.e.*, blacklisting) process, which entailed “employ[ing] ‘shoppers’ to visit the stores of both cooperating and non-cooperating retailers, ‘for the purpose of examining their stocks, to determine and report as to whether they contain . . . copies of registered designs . . .’” Offenders were brought before “[a]n elaborate system of trial and appellate tribunals [operated by FOGA] for the determination of whether a given garment is in fact a copy of a Guild member’s design.”<sup>201</sup>

Further—and significantly, from the Supreme Court’s perspective—FOGA’s anti-piracy initiative was not limited to its red-carding. As the Court recounted, FOGA not only prescribed rules directly targeting “competition by so-called style copyists, [but also] prohibit[ed] its members from participating in retail advertising; regulate[d] the discount they may allow; prohibit[ed] their selling at retail; cooperate[d] with local guilds in regulating days upon which special sales shall be held; prohibit[ed] its members from selling women’s garments to persons who conduct businesses in residences, residential quarters, hotels or apartment houses; and denie[d] the benefits of membership to retailers who participate with dress manufacturers in promoting fashion shows unless the merchandise used is actually purchased and delivered.”<sup>202</sup>

The Supreme Court, in a ruling consistent with the weight of then-applicable precedent,<sup>203</sup> found FOGA’s practices to be unlawful under the

<sup>201</sup> *Id.* at 463.

<sup>202</sup> *Id.* at 462-63; *see also id.* at 465-66 (“the combination is in reality an extra-governmental agency, which prescribes rules for the regulation and restraint of interstate commerce, and provides extra-judicial tribunals for determination and punishment of violations, and thus ‘trenches upon the power of the national legislature and violates the statute’”) (quoting *Addyston Pipe & Steel Co. v. United States*, 175 U.S. 211, 242 (1899)).

<sup>203</sup> *See* W. Wallace Kirkpatrick, *Commercial Boycotts as Per Se Violations of the Sherman Act*, 10 GEO. WASH. L. REV. 302, 311 (1941) (hereinafter “Kirkpatrick, *Commercial Boycotts*”) (“[R]ecent Supreme Court decisions, although not analyzing the problems presented by a boycott in a very full way and although not deciding whether any boycott is per se a violation of the Sherman Act, do lend considerable

Clayton, Sherman, and FTC Acts.<sup>204</sup> While some have criticized the Supreme Court's reasoning as opaque,<sup>205</sup> the Court minced no words in rejecting FOGA's primary argument that its system was "reasonable and necessary to protect the manufacturer, laborer, retailer and consumer against the devastating evils growing from the pirating of original designs."<sup>206</sup> Justice Black, for a unanimous Court, wrote:

[T]he aim of petitioners' combination was the intentional destruction of one type of manufacture and sale which competed with Guild members. The purpose and object of this combination, its potential power, its tendency to monopoly, the coercion it could and did practice upon a rival method of competition, all brought it within the policy of the prohibition declared by the Sherman and Clayton Acts . . . . [T]he reasonableness of the methods pursued by the combination to accomplish its unlawful object is no more material than would be the reasonableness of the prices fixed by unlawful combination.<sup>207</sup>

In response to the more specific argument that FOGA's system was lawful because it sought only to snuff out tortious conduct, the Court explained:

---

weight to the view that a concerted refusal to deal is illegal regardless of the circumstances."). *But see* Allen C. Horsley, *Comment: Per Se Illegality and Concerted Refusals to Deal*, 13 B.C. IND. COMM. L. REV. 484 (1972) ("The Supreme Court has always treated concerted refusals to deal and group boycotts as being per se illegal."). In any event, antitrust law has evolved considerably since the 1940s—especially beginning in the 1970s. *See* George L. Priesent, *The Abiding Influence of The Antitrust Paradox: An Essay in Honor of Robert H. Bork*, 31 HARV. J. L. & PUB. POL'Y 455, 456 (2008). In light of changes to antitrust law's perceived rationale, executive and judicial policy objectives, and revised doctrine, it would be imprudent to consider the Supreme Court's *FOGA* and *Millinery Creators' Guild* decisions anything other than interesting historical artifacts.

<sup>204</sup> *FOGA*, 312 U.S. at 464 ("[T]he Commission, upon adequate and unchallenged findings, correctly concluded that th[ese] practice[s] constituted an unfair method of competition.").

<sup>205</sup> *See* Kirkpatrick, *Commercial Boycotts*, at 322 ("The Supreme Court decided that the course of conduct in each case was unlawful and, therefore, the Court said, the unreasonableness of the practices followed was immaterial. This can be true, however, only if the case is one where the restraint is unreasonable in and of itself. Unfortunately the Court was not at all clear as to its grounds for holding that the plans were unlawful.").

<sup>206</sup> *Id.* at 467.

<sup>207</sup> *Id.* at 467-68. *Cf.* *Millinery Creators' Guild v. FTC*, 109 F.2d 175, 176 (2d Cir. 1940) ("In certain Cases group action may permissibly have broad objectives, and a trading exchange may fix rules for trading and forbid dealing with non-members, provided again that there is no perceptible effect on legitimate methods of competition.").

[T]he unlawful [conduct of the Guild cannot] be justified upon the argument that systematic copying of dress designs is itself tortious, or should now be declared so by [the Court]. In the first place, whether or not given conduct is tortious is a question of state law, under our decision in *Erie R. Co. v. Tompkins*, 304 U.S. 64 [(1938)]. In the second place, even if copying were an acknowledged tort under the law of every state, that situation would not justify petitioners in combining together to regulate and restrain interstate commerce in violation of federal law. And for these same reasons, the principles declared in *International News Service v. Associated Press*, 248 U.S. 215 [(1918)], cannot serve to legalize petitioners' [activities].<sup>208</sup>

Thus, the Supreme Court brought an end to FOGA's short life,<sup>209</sup> the same fate befell the so-called Millinery Creators' Guild in another short decision authored by Justice Black and issued the same day.<sup>210</sup> Interestingly, in neither opinion did the Supreme Court meaningfully address the subject of intellectual property (or lack thereof) for fashion design. The Second Circuit's decision in the *Millinery Creators' Guild* case, by contrast, had at least dipped a toe in the water of the copyright-for-fashion issue, declaring that "while we maintain the competitive system, a monopoly in an idea, not recognized by positive law, must be jealously scrutinized lest the few are

---

<sup>208</sup> *Id.* at 468.

<sup>209</sup> *But see* *Fabrex Corp. v. Scarves by Vera, Inc.*, 61 Civ. 539, 1961 U.S. Dist. LEXIS 3959, \*8-\*9 (S.D.N.Y. Apr. 14, 1961) ("17. In further defense of its adoption of its accused Butterfly design, Fabrex alleges that it takes every practical precaution to assure itself that the designs and patterns it uses in its printed fabrics are original. One such precaution is taken in the form of submission of finished patterns or designs to the Design Registration Bureau of The Textile Distributors Institute for search, clearance and registration. It is alleged that the function of this Design Registration Bureau is to ascertain whether a submitted design or pattern conflicts with any other pattern or design used by another firm. 18. The Design Registration Bureau appears to be a division of the General Arbitration Council and the National Federation of Textiles. There is, however, no showing that said Bureau has any statutory powers, duties or functions whatsoever. There is no showing that it has been authorized and empowered by the Congress to register designs and determine questions of copyright infringement. Nor is there any showing of how the Bureau could possibly determine such questions in relation to copyrighted designs which have not been registered with the Bureau, as in the case at bar. It is clear that the Bureau cannot stand as a shield between a copyright owner and a copyright infringer and it cannot be permitted to preempt the jurisdiction, powers and functions of this Court.").

<sup>210</sup> *Millinery Creator's Guild v. FTC*, 312 U.S. 469, 472 (1941) ("The respects in which the plan of the Millinery [Creators'] Guild differs from that of the Fashion Originators' Guild are not material[.]").

protected at the expense of the many.”<sup>211</sup> In another passage, even more prescient of the current debate concerning additional IP protection for fashion designs,<sup>212</sup> the Second Circuit reminded the public that what might strike some as “a distasteful ‘evil’” to be eliminated, “the law [might] nevertheless recognize[ ] to be a socially desirable form of competition.”<sup>213</sup>

It is probably safe to say that the issue of “design piracy” took a backseat to other, more pressing national concerns in the troubled years that followed the 1941 Guild decisions.<sup>214</sup> By the late 1940s, however, designers were again quite preoccupied with the problem of copyists. One 1949 judicial opinion attempted to sum up the then-current state of the law on copyright-for-fashion (before a 1954 Supreme Court decision, discussed below, would throw the state of IP protection for industrial design into disarray.)

---

<sup>211</sup> *Millinery Creators' Guild v. FTC*, 109 F.2d 175, 178 (2d Cir. 1940). One wonders if either the Second Circuit or the Supreme Court's rulings in the *FOGA* and *Millinery Creators' Guild* cases might have differed if the entities had set up inspection and boycott systems to “red-card” only *copyright-* or *patent-*infringing vendors. (Of course, if the majority of the knockoffs at issue violated federal copyright or patent law, the Guild would probably never have been created in the first place, as the federal courts would have provided a forum for aggrieved designers to seek recourse.) Because copyright was out of the picture in the fashion design realm, FOGA was forced to argue that the boycotted competitors' conduct ran afoul of state law. As the last-quoted passage of the Supreme Court's opinion indicates, state-law rules (including state IP protection) are subordinate to federal law by virtue of the Constitution's Supremacy Clause. But considering that infringement under the Copyright Act, like Sherman and Clayton Act violations, exists at the federal level, one wonders if the Supreme Court might have condoned a non-governmental, FOGA-like copyright enforcement regime designed primarily as a more economical and effective alternative to the use of the federal courts. *See also* U.S. Copyright Office, *Remedies for Copyright Small Claims*, <http://www.copyright.gov/docs/smallclaims/> (last visited Feb. 1, 2013) (“[W]hile a copyright owner may want to stop an infringement that has caused a relatively small amount of economic damage, that owner may be dissuaded from filing a lawsuit because the prospect of a modest recovery may not justify the potentially large expense of litigation [and, as such,] Congress has asked the Copyright Office to study the challenges of the current system for resolving small copyright claim disputes, as well as possible alternative systems.”).

<sup>212</sup> *See The Politics of 'Piracy'* (fifth article in five-article series).

<sup>213</sup> *Millinery Creators' Guild*, 109 F.2d at 178.

<sup>214</sup> However, lawsuits against copyists did not stop completely, even during the War. *See, e.g., Belding Heminway Co. v. Future Fashions, Inc.*, 143 F.2d 216, 218 (2d Cir. 1944) (vacating district court's preliminary injunction in design-patent case over stylized floral print, and noting “[a]pparently what the makers of women's dresses really need is that copyright protection, which Congress has hitherto denied them.”).

In the case of *Verney Corp. v. Rose Fabric Converters Corp.*,<sup>215</sup> plaintiff designer sued several parties involved in the process of unabashedly replicating plaintiff's "curly chrysanthemum" fabric pattern—for which plaintiff had, it so happened, obtained a registration certificate from the Copyright Office.<sup>216</sup> Registration notwithstanding, the court rejected the idea that the design could give rise to copyright-infringement liability:

While the design may have been properly registered as a print for an article of merchandise, plaintiff, by printing it on the fabric from which the dresses are manufactured, uses the design as a part of the article of merchandise itself. It is obviously not used in connection with a sale or an advertisement of either the fabric or the dresses, but is an attempt by plaintiff to obtain a monopoly of the design in the manufacture of dress fabrics and dresses, to which it is not entitled.<sup>217</sup>

In any event, the court held, "even if there were doubt as to the invalidity of the copyrighted design when so used on fabrics and dresses, which I do not entertain, still plaintiff's copyright on the design has been lost by failure to publish on the fabric and the dresses, in connection with the design, the proper copyright notice."<sup>218</sup> Once again, a fashion designer found himself out of luck. Other intellectual-property enforcement strategies for fashion were attempted, unsuccessfully.<sup>219</sup>

---

<sup>215</sup> 87 F. Supp. 802 (S.D.N.Y. 1949).

<sup>216</sup> *Id.* at 803.

<sup>217</sup> *Id.* at 804. In support of its conclusion, the court cited some of the more significant episodes in the troubled recent history of designers' attempts to obtain copyright protection for their creations: "In *Kemp & Beatley v. Hirsch*, [34 F.2d 291, 292 (E.D.N.Y. 1929)], it was held that dress patterns were not copyrightable under the Act. *Cf. Millinery Creators' Guild v. Federal Trade Commission*, [109 F.2d 175, 177 (2d Cir. 1940)] (affirmed without discussion of the point in [312 U.S. 469 (1941)]), where the court said that 'What passes in the trade for an original design of a hat or a dress cannot be patented or copyrighted.' The lack of statutory copyright protection for dress designers has been repeatedly pointed out by the Court of Appeals in this Circuit. *Nat Lewis Purses v. Carole Bags*, [83 F.2d 475, 476 (2d Cir. 1936)] *White v. Leanore Frocks*, [120 F.2d 113, 114-115 (2d Cir. 1941)]; *Belding Heminway Co. v. Future Fashions*, [143 F.2d 216, 218 (2d Cir. 1944)]." *Id.* at 803-804.

<sup>218</sup> *Id.* at 804.

<sup>219</sup> *See, e.g., Forstmann Woolen Co. v. J. W. Mays, Inc.*, 89 F. Supp. 964, 971 (E.D.N.Y. 1950) ("Nevertheless Exhibits 11 and 12 ['ladies' coats'] do bear such labels [containing notice of copyright]. Some one put them there. I am forced to conclude that they were on the garments when Miss Whiteside and Pfeifer purchased them. Such a use of the registration label was a violation of the copyright registration, if the copyright registration was valid. There is some question about such validity . . . . [T]here certainly is nothing artistic about the way in which the

The picture was about to change, however—not in a way that thoroughly remedied fashion designers’ concerns about “piracy,” but in a way that certainly complicated the legal landscape. In 1954, “[a] radical change in the legal status of original designs in the United States occurred [when] the United States Supreme Court, by a seven-to-two majority in *Mazer v. Stein*, 347 U.S. 201 (1954), upheld the copyrightability of ‘works of art’ that had been incorporated as the designs of useful articles,” notwithstanding their potential eligibility for design patent protection.<sup>220</sup> The complicated doctrinal landscape of copyright-for-fashion that exists today, laid out in the next three articles in this series, can arguably be traced back most directly to the decision in *Mazer v. Stein*—the effects of which the presiding Justices (especially during a court term that featured much higher-profile cases<sup>221</sup>) likely did not foresee.

At issue in the *Mazer* case was a lamp with a statuette base in the form of the human body, pictured in *Figure 2*, below. The sculptural portion of the lamp had been created using the traditional clay-model technique, from which a production mold for casting copies was made.<sup>222</sup> The mass-produced statuettes “were sold throughout the country both as lamp bases and as statuettes.”<sup>223</sup> During the appropriate timeframe, the “statuettes, without any lamp components added, were submitted by the [plaintiff] to the Copyright Office for registration as ‘works of art’ or reproductions thereof under . . . the copyright law, and certificates of registration issued.”<sup>224</sup>

---

plaintiff’s name, nor the legend ‘100% Virgin Wool’, appears on the copyright label. That leaves the representation of the fleurs de lis. Surely and certainly in the form in which the fleurs de lis are shown, no originality is displayed. . . . I must conclude, therefore, that there is no infringement of the copyright registrations, because those registrations are not valid under the copyright statute.”)

<sup>220</sup> *Mazer v. Stein*, 347 U.S. 201, 223 (1954).

<sup>221</sup> *See, e.g., Brown v. Board of Education*, 347 U.S. 483 (1954).

<sup>222</sup> *Mazer*, 347 U.S. at 202.

<sup>223</sup> *Id.* at 203.

<sup>224</sup> *Id.* at 202-203. The Court stated in a footnote that “[e]rrors of classification [in copyright applications] are immaterial.” *Id.* at 203 n.1.



**FIGURE 2:** Decorative lamp base at issue in *Mazer v. Stein*, 347 U.S. 201 (1954).

The defendants in the *Mazer* case, “[w]ithout authorization . . . copied the statuettes, embodied them in lamps and sold them.”<sup>225</sup> The original designer and manufacturer sued for copyright infringement; the defendants argued that the plaintiffs’ “publication [of the object] as a lamp and registration as a statue to gain a monopoly in manufacture that they assert is such a misuse of copyright as to make the registration invalid.”<sup>226</sup> The district court sided with the defendant; the Fourth Circuit reversed. The alleged infringer appealed to the Supreme Court, which granted *certiorari* because of conflicting lower-court decisions on the issue presented.<sup>227</sup>

As Justice Reed, writing for seven Justices, recounted, the Seventh Circuit,<sup>228</sup> among other courts, had rejected the proposition that an artistic object repurposed for a “useful” function was copyrightable, while the

<sup>225</sup> *Id.* at 203.

<sup>226</sup> *Id.* at 206.

<sup>227</sup> *Id.* at 203.

<sup>228</sup> See *Stein v. Expert Lamp Co.*, 188 F.2d 611, 612 (7th Cir. 1951) (“[While] the Copyright Act protects ‘Works of art; models or designs for works of art,’ [it] does not refer to articles of manufacture having a utilitarian purpose. . . . We have examined and considered all the cases cited but are not persuaded that a design of an electric lamp may be protected as a monopoly by means of a copyright registration, registered without an examination [of the sort conducted in the patent context] as to originality, novelty or inventiveness.”).

Fourth<sup>229</sup> and Ninth<sup>230</sup> Circuits, at least, had taken the opposite position. Justice Reed's opinion embarked on an elaborate examination of the legislative and administrative vicissitudes of copyright law over the previous 150 years, and ultimately found that any "[v]erbal distinctions between purely aesthetic articles and useful works of art [had] ended insofar as the statutory copyright language is concerned."<sup>231</sup> Justice Reed concluded (albeit based on seemingly non-dispositive portions of the available legislative history) that "[i]t is clear Congress intended the scope of the copyright statute to include more than the traditional fine arts."<sup>232</sup> Giving considerable deference<sup>233</sup> to the Copyright Office's recently promulgated, more lenient

<sup>229</sup> *Stein v. Mazer*, 204 F.2d 472 (4th Cir. 1953).

<sup>230</sup> *Rosenthal v. Stein*, 205 F.2d 633 (9th Cir. 1953).

<sup>231</sup> *Mazer*, 347 U.S. at 211.

<sup>232</sup> *Id.* at 213.

<sup>233</sup> It was and remains unclear whether this deference was appropriate, though its role in the outcome of *Mazer* has been subsequently acknowledged. See *discussion* at *Eltra Corp. v. Ringer*, 579 F.2d 294, 298-99 (4th Cir. 1978) ("While the principal argument of the appellant is directed to the claim that its work was entitled to registration by the Copyright Office as a 'work of art' under § 5(g), it raises the point that the Register of Copyrights is a legislative office and as such may not exercise any executive powers or authority, in particular any power to issue rules and regulations, though there is specific legislative authorization for such exercise of power. Pursuing this line of reasoning, it argues that the Register can legally exercise no power to deny registration to any 'writing' or design submitted; that his power is very strictly limited to the receipt, deposit and issuance of a registration certificate. It must be conceded that this contention [pertaining to the 1976 Copyright Act] represents in effect a belated challenge to the 1909 revision of the Copyright Act and an attempt to confine the Register to the narrow range of duties exercised by him prior to the 1909 Act. In the roughly three-quarters of a century that the 1909 revision has been in effect, however, its constitutional validity has been generally assumed, including the power of the Register to issue rules and regulations. *Indeed, the leading case of Mazer v. Stein . . . proceeded on the assumption that the Register had such power and the decision in that case relied in its result to a substantial extent on the application of a rule issued by the Register under the authorization given him by the 1909 Act.*") (emphasis added) (citation omitted); *but see* *United States v. Brooks*, 945 F. Supp. 830, 833-34 (E.D. Pa. 1996) ("[T]he government cites to one Fourth Circuit opinion in which the court held that the Copyright Office acts as an executive agency. *Eltra Corp. v. Ringer*, 579 F.2d 294, 301 (4th Cir. 1978). This case is directly contradicted by a Second Circuit case cited by the defendant, in which the court stated that the Copyright Office is a part of the legislative branch. See *Harry Fox Agency, Inc. v. Mills Music, Inc.*, 720 F.2d 733, 736 (2d Cir. 1983), *rev'd on other grounds sub nom.*, *Mills Music v. Snyder*, 469 U.S. 153 (1985)[.] [Footnote 6: The correct characterization of] the Copyright Office was not a decisive issue for either [the Second Circuit or the Supreme Court in *Mills*], though Justice White, in dissent, noted that 'the Copyright Act is unusual



regulations concerning copyrightable subject matter,<sup>234</sup> Justice Reed announced:

The successive acts, the legislative history of the 1909 Act and the practice of the Copyright Office unite to show that ‘works of art’ and ‘reproductions of works of art’ are terms that were intended by Congress to include the authority to copyright these statuettes. Individual perception of the beautiful is too varied a power to permit a narrow or rigid concept of art. *As a standard we can hardly do better than the words of the present {Copyright Office} Regulation . . . naming the things that appertain to the arts {including “works of artistic craftsmanship, in so far as their form but not their mechanical or utilitarian aspects are concerned, such as artistic jewelry, enamels, glassware, and tapestries, as well as all works belonging to the fine arts, such as paintings, drawings and sculpture.” 37 C.F.R. § 202.8 (1949)}* They must be original, that is, the author’s tangible expression of his ideas. [If that condition is met, *such original} expression, whether meticulously delineating the model or mental image or conveying the meaning by modernistic form or color, is copyrightable.*<sup>235</sup>

Although this passage is of major importance for the development of modern copyright law, one need not concern oneself with its exact wording; *Mazer’s* pronouncements about copyright-eligible subject matter have been superseded by the 1976 Copyright Act, as explained below.

---

in that much of it, including the derivative-works exception, was drafted by the Copyright Office, which is itself an arm of Congress.’ *Mills Music*, 469 U.S. at 182 n.6 (1985). [End of footnote.] [In this court’s view, it] is the Copyright Act, not the Administrative Procedure Act, that dictates the policies and procedures of the Copyright Office. The mere fact that the Copyright Office is required to perform ‘administrative functions and duties’ (17 U.S.C. § 701(a)) under the Copyright Act is not enough to make the Copyright Office a component of the executive branch. Acting similarly to an executive agency is not the same as being part of the executive branch. The Copyright Office is a division of the Library of Congress, which is a part of the legislative branch, and thus the Copyright Office is part of the legislative branch.”).

<sup>234</sup> 37 C.F.R. § 202.8 (1949) (“Works of art (Class G) — (a) In General. This class includes works of artistic craftsmanship, in so far as their form but not their mechanical or utilitarian aspects are concerned, such as artistic jewelry, enamels, glassware, and tapestries, as well as all works belonging to the fine arts, such as paintings, drawings and sculpture. . . .”) See *Prestige Floral v. Cal. Artificial Flower Co.*, 201 F. Supp. 287, 291 (S.D.N.Y. 1962) (“[I]n 1949 section 202.8 of the Regulations was changed so as to make registrable the artistic features of jewelry, enamel, glassware, tapestries, and other similar materials. Such registration was to cover only the artistic aspects, as distinguished from ‘the mechanical or utilitarian’ aspects.”).

<sup>235</sup> *Mazer*, 347 U.S. at 213-14 (emphasis added) (citation omitted).

After Justice Reed resolved the question of the statuette's eligibility for protection under the Copyright Act, in isolation, he turned to the defendant's argument that "congressional enactment of the design patent laws should be interpreted as denying protection to artistic articles embodied or reproduced in manufactured articles."<sup>236</sup> In the defendant's view, "overlapping of patent and copyright legislation so as to give an author or inventor a choice between patents and copyrights should not be permitted."<sup>237</sup> Justice Reed acknowledged that some case law did indicate that the award of a *utility* patent for an object precluded copyright protection, but pointed out that, since at least 1910, multiple federal courts had found *design* patents and copyright protection to be perfectly compatible.<sup>238</sup> The Supreme Court gave its imprimatur to the latter class of decisions, holding that "the patentability of the statuettes, fitted as lamps or unfitted, does not bar copyright as works of art [as neither] the Copyright Statute nor any other says that because a thing is patentable it may not be copyrighted."<sup>239</sup> Justice Reed further explained that copyright's limitations, and its distinct objective from that of design patent law, would prevent the adverse effects that the defendant argued would follow from permitting overlapping protection:

The copyright protects originality rather than novelty or invention—conferring only 'the sole right of multiplying copies.' Absent copying there can be no infringement of copyright. [By contrast, 'independent creation' is *not* a defense to the infringement of a patent—a form of property that carries with it a so-called 'right to exclude.'<sup>240</sup>] Thus, respondents may not exclude others from using statuettes of human figures in table lamps; they may only prevent use of copies of their statuettes as such or as incorporated in some other article. [Copyright Office regulations make] clear that artistic articles are protected in 'form but not their mechanical or utilitarian aspects.' . . . *The dichotomy of protection for the aesthetic is*

---

<sup>236</sup> *Id.* at 215-16.

<sup>237</sup> *Id.* at 216.

<sup>238</sup> *Id.* at 215 n.33 (citing *Louis De Jonge & Co. v. Breuker & Kessler Co.*, 182 F. 150, 155 (C.C.S.D. Pa. 1910), *aff'd on other grounds*, 191 F. 35 (3d Cir. 1911), and 235 U.S. 33 (1914)).

<sup>239</sup> *Id.* at 217.

<sup>240</sup> See *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 895 F.2d 1403, 1406 (Fed. Cir. 1990) ("[I]n patent law, the fact of infringement establishes the fact of damage because the patentee's right to exclude has been violated.") (citing 5 D. Chisum, *PATENTS* § 20.03[3] at 20-142 (1986)); *but see* *Apple, Inc. v. Motorola, Inc.*, 869 F. Supp. 2d 901, 909-10 (N.D. Ill. 2012) (Posner, J., sitting by designation) ("A reasonable royalty is a form of damages when awarded in the damages phase of an infringement litigation, though it usually is a form of equitable relief, as we'll see, when it is imposed, in lieu of an injunction, to prevent future harm to the patentee.").

*not beauty and utility but art for the copyright and the invention of original and ornamental design for design patents. We find nothing in the copyright statute to support the argument that the intended use or use in industry of an article eligible for copyright bars or invalidates its registration.*<sup>241</sup>

The *Mazer* decision was unquestionably a major step forward for advocates of IP rights in industrial design, resulting in an overhaul of the Copyright Office's regulations on registrable works<sup>242</sup> and a revolution in the case law on copyright for many aspects of fashion design (among other types of "applied art.")<sup>243</sup> Yet the ruling also raised myriad questions, many eventually answered by courts and policymakers in a less cogent manner than one might have hoped. While this view is not uniformly held, one leading casebook laments that between the pre-*Mazer* period and the present, "the availability of copyright protection for the design of useful objects [like apparel] has evolved from the uncertain to the incoherent."<sup>244</sup>

The current state of affairs, described in a systematic manner in this series, is at least partly the result of zealous litigants pressing copyright

---

<sup>241</sup> *Mazer*, 347 U.S. at 218 (emphasis added) (citations omitted). Compare *Oroamerica, Inc. v. D & W Jewelry Co.*, 10 F. App'x. 516, 517 (9th Cir. 2001) (non-precedential) ("Oroamerica, Inc. alleges that D & W Jewelry, Inc.'s sale of certain jewelry chains infringes upon Oroamerica's copyright in two jewelry chain designs. Oroamerica requested, and the district court denied, a preliminary injunction . . . . We are aware of no authority to support Oroamerica's contention that the district court was not entitled to consider the issuance of a design patent covering D & W Jewelry's gold chain as a relevant factor in evaluating whether to grant preliminary injunctive relief.").

<sup>242</sup> See *Prestige Floral v. Cal. Artificial Flower Co.*, 201 F. Supp. 287, 291 (S.D.N.Y. 1962) ("In August, 1956, the Copyright Office issued regulations which, in greater detail than ever before, explicitly describe what can be registered. These regulations do not talk in terms of 'writings' but do require that any object offered for registration meet at least minimal standards of originality and creativity, as well as fall within one of the classes enumerated in section 5 of the copyright statute." (quoting Subcommittee on Patents, Trademarks, and Copyrights, Senate Committee on the Judiciary, 86th Cong., 1st Sess., *Study No. 3, The Meaning of 'Writings' in the Copyright Clause of the Constitution*, at 100 (Comm. Print 1960) (hereinafter "*Study No. 3*").

<sup>243</sup> See *id.* at 291 ("The courts in recent years, particularly since *Mazer v. Stein*, are beginning to realize the validity of the copyright approach and are gradually overcoming their hesitation to hold, expressly or impliedly, that a three-dimensional object is a 'writing.'") (quoting *Study No. 3*, at 101).

<sup>244</sup> Robert A. Gorman & Jane C. Ginsburg, COPYRIGHT: CASES AND MATERIALS 221 (7th ed. 2006).

claims (some decidedly marginal<sup>245</sup>) in the courts. After all, designers and manufacturers of not only fashion, but other artistic “useful articles,” have tended to favor copyright protection over design patent protection wherever the former is at least conceivably available (and sometimes, even when it seems quite clear that it is not.) As one appellate court later observed, “where copyright is available, it is more popular than the design patent largely because copyrights are far easier and less expensive to obtain than design patents.”<sup>246</sup> But this tells only part of the story: with no examination of “novelty” by a government agency,<sup>247</sup> most formalities once required for copyright protection tempered and/or abolished by the Copyright Act of 1976 and the Berne Convention Implementation Act of 1988,<sup>248</sup> and a far

---

<sup>245</sup> The author takes no view on the propriety of bringing suit cases, only noting that as an objective matter, some of the cases cited herein lay at the very outer edge—some might say the “razor’s edge”—of the law.

<sup>246</sup> *Schnadig Corp. v. Gaines Mfg. Co.*, 620 F.2d 1166, 1168 n.2 (6th Cir. 1980).

<sup>247</sup> See *Original Appalachian Artworks, Inc. v. Toy Loft, Inc.*, 684 F.2d 821, 824 (11th Cir. 1982) (“Although the originality concept defies exact definition, courts generally agree that ‘originality’ for copyright purposes is something less than the novelty or uniqueness necessary for patent protection.”) (citing, *inter alia*, *Durham Industries, Inc. v. Tomy Corp.*, 630 F.2d 905, 910 (2d Cir. 1980)).

<sup>248</sup> See Copyright Act of 1976, 90 Stat. 2541; Berne Convention Implementation Act of 1988, Pub. L. 100-568, 102 Stat. 2853, §§ 7-9 (1988). See also *Original Appalachian Artworks*, 684 F.2d at 826-27, 827 n.7 (“Prior to [January 1, 1978, the effective date of the 1976 Copyright Act,] detachable notices were defective and constituted improper notice under the 1909 copyright law. See 37 C.F.R. § 202.2(b) (9) (1981) (copyright notice on detachable tag does not meet requirements of proper notice for a work published before January 1, 1978). [Footnote omitted.] Under the new Act, however, publication of copies of a work with defective notice does not necessarily impair an author’s copyright protection . . . . The 1976 Copyright Act apparently liberalized certain of the requirements of notice from the 1909 Act by providing that ‘the notice shall be affixed to the copies in such manner and location as to give reasonable notice of the claim of copyright.’”) (citing Latman, *THE COPYRIGHT LAW* 147 (5th ed. 1979)); *Langman Fabrics v. Graff Californiawear, Inc.*, 160 F.3d 106, 114 (2d Cir. 1998) (“The defendants argue that even if Langman Fabrics was the author of the design under the work-for-hire doctrine, it invalidated its copyright when it failed to comply with the requirement in 17 U.S.C. § 401(b)(2) that a copyright notice include the year of first publication. [Footnote 6:] Section 401 does not apply to works first published after [the effective date of the Berne Convention Implementation Act,] March 1, 1989. See *Innovative Networks, Inc. v. Satellite Airlines Ticketing Centers, Inc.*, 871 F. Supp. 709, 720 (S.D.N.Y. 1995). The work in this case was published in 1984 and is therefore subject to section 401.”).

longer term of protection than that accorded to design patents,<sup>249</sup> it is no wonder that the tool of copyright has been ripe for use and abuse—even by those who, like a “pirated” designer trying to make a living, might have only noble intentions.

One should not overstate matters: the *Mazer v. Stein* decision did not revolutionize copyright law for all (or perhaps even most) aspects of fashion design.<sup>250</sup> But the lower federal courts certainly took notice of the Supreme Court’s declarations in the case. As recounted by Judge Clark, dissenting in *Vacheron & Constantin-Le Coultre Watches, Inc. v. Benrus Watch Co.*, “in response to [*Mazer v. Stein*] we have affirmed the copyright of ornamental jewelry, such as pins, bracelets, earrings, and the like, *Boucher v. Du Boyes, Inc.*, [253 F.2d 948 (2d Cir. 1958), *cert. denied*, *Du Boyes, Inc. v. Boucher*, 357 U.S. 936 (1958)]; and the district court has supported the copyright of a necklace, *Trifari, Krussman & Fishel, Inc. v. Charel Co.*, [134 F.Supp. 551 (S.D.N.Y. 1955)].”<sup>251</sup> For example, in one post-*Mazer* copyright infringement dispute over a decorative life-size “Santa Claus bag [designed to be

---

<sup>249</sup> The term of U.S. design-patent protection has never exceeded fifteen years, while the term of U.S. copyright protection for most works has gradually climbed to the life of the author plus seventh years.

<sup>250</sup> See, e.g., *SCOA Industries, Inc. v. Famolare, Inc.*, 192 U.S.P.Q. 216, No. 75 Civ. 3357, 1976 U.S. Dist. LEXIS 16663 (S.D.N.Y. Feb. 13, 1976) (court agreed with Copyright Office “troughs, waves, and lines” on shoe sole did not exist independently as copyrightable work of art).

<sup>251</sup> *Vacheron & Constantin-Le Coultre Watches*, 260 F.2d at 644 (Clark, J., dissenting). Judge Clark, unlike the majority of the presiding panel, would have reached the issue of copyrightability, and would have ruled that the “highly ornamented watches [at issue in the case] were equally entitled to copyright with the ornamental lamp bases in *Mazer v. Stein*.” *Id.* Judge Clark further explained why the validity of the design patent at issue in the suit was too doubtful to justify the majority’s remand for a determination of novelty, and why *copyright* was a preferable source of protection for certain aspects of fashion design—at least, post-*Mazer*:

The prevailing view to date appears to be that we should rest upon infringement of a design patent, a view which presents pitfalls and has limitations, as I shall endeavor to point out. To me the more workable, though possibly more novel, course is that of copyright infringement . . . .

Just as our standard for mechanical patents which combine known elements is high, see, e.g., *Jungersen v. Baden*, [166 F.2d 807 (2d Cir. 1948), *aff’d*, 335 U.S. 560 (1949)], so in terms of the protection afforded, it should be no less high in the case of a design patent. *Knickerbocker Plastic Co. v. Allied Molding Corp.*, 2 Cir., 184 F.2d 652, 654 [(2d Cir. 1950)]. Doubtless it is because of these quite obvious difficulties that, to my knowledge, our court has never sustained a design patent challenged for lack of novelty. If this patent eventually survives, it will indeed mark the case as novel.

stuffed with newspaper and] cut from an appropriate pattern so that it defines the arms, legs and torso of a human form,” the defendant attacked “the validity of plaintiffs’ copyright [on the basis] that plaintiffs’ product is not a work of art at all, but rather a garment.”<sup>252</sup> Though not convinced that the work was, in fact, a garment,<sup>253</sup> the court explained: “[E]ven if plaintiffs’ Santa could be used as a garment, the copyright would not thereby be invalidated. For, in *Mazer v. Stein* . . . the Supreme Court put to rest all previous doubts on the subject by holding that the actual or intended use in industry of an article eligible for copyright does not bar or invalidate its registration[.]”<sup>254</sup>

Further, in the first major cluster of fabric design-related copyright infringement cases that followed *Mazer*, each brought by a company called “Peter Pan Fabrics, Inc.,” original Byzantine-inspired textile patterns were decisively held copyrightable by judges in the Second Circuit, undoubtedly the leading “fashion circuit”—an outcome that surely delighted fashion’s “anti-piracy” advocates. The 1959 disputes in the *Peter Pan Fabrics* cases<sup>255</sup>

---

But for my part I do not see how this patent can possibly prevail against the prior art; there is literally nothing in it which can be considered even new. This, I think, is almost, if not quite, admitted with commendable candor in the opinion herewith, which calls the roll of some of the pertinent prior patents and shows the lack of novelty in the prior art of ‘sticks’ and ‘floaters’ in various combinations for clock or watch dials. The three patents cited in the opinion, those of Gardner, Dupertuis, and Jaeger, are particularly striking and — when seen in illustration more vivid than cold description — really leave nothing more to be imagined. It is urged that the use of jewels to catch the light and sparkle can be relied on as a dependable element of novelty. But this is surely incorrect. For this element appears in previous patents, indeed as early as the Blumstein Design Patent 96,642 of 1935 for a ‘watch dial’ which used only four numerals, instead of twelve, and provided ‘indications’ for the intermediate hours, ‘the indications being provided with baguette precious stones and the numerals being studded with precious stones.’ . . .

On the other hand, the copyright concept affords a different emphasis, one much more directly in point in a case such as this than the patent concept of novelty or new invention . . . .”

*Id.* at 642-44.

<sup>252</sup> *Doran v. Sunset House Distributing Corp.*, 197 F. Supp. 940, 942, 945 (S.D. Cal. 1960), *aff’d*, 304 F.2d 251 (9th Cir. 1962).

<sup>253</sup> *Id.* (“Plaintiffs’ Santa is not a ‘garment’ because it was neither designed nor intended to be worn by anyone as an article of clothing.”).

<sup>254</sup> *Id.*

<sup>255</sup> *See Peter Pan Fabrics, Inc. v. Brenda Fabrics, Inc.*, 169 F. Supp. 142 (S.D.N.Y.1959); *Peter Pan Fabrics, Inc. v. Acadia Company, Inc.*, 173 F.Supp. 292 (S.D.N.Y.1959); *Peter Pan Fabrics, Inc. v. Dixon Textile Corporation*, 280 F.2d

involved virtually identical subject matter and legal issues as the above-mentioned 1949 case of *Verney Corp. v. Rose Fabric Converters Corp.*,<sup>256</sup> yet the later litigation went quite differently. And one need not wonder about *Mazer*'s impact on the outcomes of the later cases, for the presiding judges made plain the influence of the intervening Supreme Court ruling in each of the *Peter Pan Fabrics* opinions.

In the late 1950s, the company Peter Pan Fabrics found that it had a hit on its hands with a textile consisting of "a solid design made up of motifs suggestive of the Near East: arches reminiscent of Arabic architecture, figures much like those in Oriental rugs, tablets covered with palpable imitations of Arabic script and other unidentifiable but similar decorations."<sup>257</sup> The design proved so popular that it inspired a number of knock-offs, over which plaintiff sued in several differently captioned cases. The issue of the pattern's copyrightability was first squarely addressed in Judge Dimock's landmark 1959 opinion in *Peter Pan Fabrics, Inc. v. Brenda Fabrics, Inc.*:<sup>258</sup>

The problem to be decided is whether a design printed upon dress fabric is a proper subject of copyright . . . . In *Mazer v. Stein*, 347 U.S. 201 [(1954)], Mr. Justice Reed said in the opinion of the court:

'It is clear Congress intended the scope of the copyright statute to include more than the traditional fine arts. Herbert Putnam, Esq., then Librarian of Congress and active in the movement to amend the copyright laws, told the joint meeting of the House and Senate Committees:

"The term 'works of art' is deliberately intended as a broader specification than 'works of the fine arts' in the present statute with the idea that there is subject-matter (for instance, of applied design, not yet within the province of design patents), which may properly be entitled to protection under the copyright law."

*In Dr. Putnam's statement before the joint meeting we have an authoritative construction of the term 'works of art' in the Copyright Act as including 'applied design'. No better description of the subject matter of this litigation could be devised.*

---

800 (2d Cir. 1960); *Peter Pan Fabrics, Inc. v. Dixon Textile Corp.*, 188 F. Supp. 235 (S.D.N.Y. 1960). See roundup of aforementioned cases at *Peter Pan Fabrics, Inc. v. Puritan Dress Co.*, 207 F. Supp. 563, 565 (S.D.N.Y. 1962).

<sup>256</sup> 87 F. Supp. 802 (S.D.N.Y. 1949).

<sup>257</sup> *Peter Pan Fabrics*, 169 F. Supp. at 144 (S.D.N.Y. 1959).

<sup>258</sup> *Id.* at 142.

*I therefore find that plaintiffs' design is a proper subject of copyright both as a work of art and as a print.*<sup>259</sup>

History, however, seems to have a better recollection of the related proceeding before Judge Herlands in *Peter Pan Fabrics, Inc. v. Acadia Co.*,<sup>260</sup> whose result in favor of the plaintiff was appealed and affirmed in the oft-cited *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*<sup>261</sup>. In his decision for the plaintiff, Judge Herlands took note of “[t]he well-known history of the struggle between ‘copyists,’ ‘pirates,’ ‘freebooters,’ and the design ‘originators’ in the textile and allied industries.”<sup>262</sup> After Judge Dimock’s decision in *Brenda Fabrics*, it seemed that questioning the pattern’s fundamental copyrightability was off the table. Thus, the defendants shifted their focus to *originality*. Here, again, the copyist lost. As Judge Herlands wrote: “The copyrighted designs are highly intricate and detailed both in over-all pattern and particular features. There is nothing in the record to impeach plaintiffs’ representations that the two designs, Byzantium and Grecian Glory, are ‘original’ expressions of characteristic Byzantine and Greek motifs and artifacts. Where, as here, the designs reflect creative originality and a substantial degree of skill, labor and independent judgment, they are proper subjects for copyright. See *Mazer v. Stein*, [347 U.S. 201, 214, 217-218 (1954).]”<sup>263</sup> It should be noted that the defendants in *Acadia* raised many other defenses to the plaintiff’s copyright infringement claims were raised, none successful.<sup>264</sup>

<sup>259</sup> *Id.* at 143 (emphasis added).

<sup>260</sup> 173 F. Supp. 292 (S.D.N.Y.).

<sup>261</sup> 274 F.2d 487 (2d Cir. 1960) (Hand, J.).

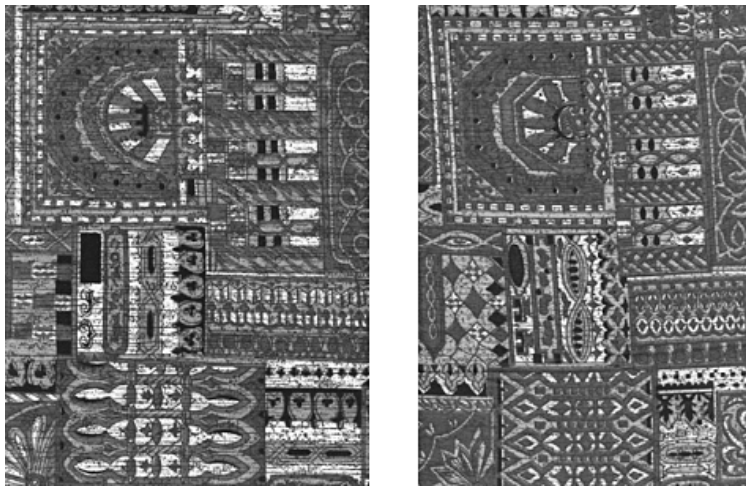
<sup>262</sup> *Acadia*, 173 F. Supp. at 296.

<sup>263</sup> *Id.* at 299. The court added, for good measure: “The ‘originality’ requirement for copyrightability is not onerous.” *Id.* This passage was undoubtedly music to the ears of previously defeated design-patent plaintiffs in fashion houses everywhere.

<sup>264</sup> See *Peter Pan Fabrics, Inc. v. Acadia Co.*, 173 F. Supp. 292, 295-96 (S.D.N.Y. 1959) (“Other infringement actions have been instituted against other defendants by the plaintiffs in this District to protect the copyrighted Byzantium design. In an action against Dixon Textile Corporation (Civil Action 140-109), District Judge Bryan, without opinion, granted plaintiffs’ motion for a preliminary injunction. Subsequently, in an action against Brenda Fabrics, Inc. (Civil Action 140-267), District Judge Dimock also granted plaintiffs preliminary injunctive relief. *Peter Pan Fabrics, Inc. v. Brenda Fabrics, Inc.*, D.C.S.D.N.Y.1959, 169 F.Supp. 142.”) [Nevertheless,] Defendant Weiner [now] argues: (1) that neither plaintiff has the requisite standing to bring a copyright infringement action; (2) that the defendant’s accused design is not an infringing copy of the plaintiffs’ copyrighted design; (3) that the dress made of plaintiffs’ fabrics which defendant allegedly copied bore no copyright notice; (4) that the plaintiffs’ copyright is invalid because the plaintiffs’



The appeal from Judge Herlands' ruling in *Acadia*, contrary to popular belief, did not directly address the question of the fabric pattern's copyrightability. As Judge Hand stated in the resulting opinion in *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, the appeal actually addressed only two questions concerning the fabrics shown in *Figure 3*: "(1) whether the defendant has in fact copied so much of the registered design as to infringe the copyright; and (2) whether the design was dedicated to the public, because it was sold without adequate notice of copyright as required by § 10 of the [Copyright Act]."<sup>265</sup> The Second Circuit panel ruled for the plaintiff on both issues.



**FIGURE 3:** Fabric patterns at issue in *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487 (2d Cir. 1960) (Hand, J.).

And although Judge Hand's decision in *Peter Pan Fabrics* in fact contained no holding on the copyrightability of fabric patterns, it is often remembered that way<sup>266</sup>—which may ultimately have mattered more. Such

---

design was published with insufficient copyright notice; (5) that the wrong defendant has been sued; and (6) that the alleged infringement ceased promptly upon notice given by plaintiffs. [Further,] Defendant *Acadia* argues: (1) that the copyrights should not have been granted to plaintiffs because the designs were lacking in originality; (2) that, if *arguendo* the copyrights are valid, the plaintiffs' failure to provide proper notice of copyright on the ultimate products (i.e., dresses) that embody the plaintiffs' copyrighted fabric designs results in a loss of the copyrights; and (3) that the plaintiffs have failed to establish a proper basis for the issuance of a preliminary injunction.”)

<sup>265</sup> 274 F.2d 487, 489 (2d Cir. 1960) (Hand, J.).

<sup>266</sup> See, e.g., *Primcot Fabrics, Dep't of Prismatic Fabrics, Inc. v. Kleinfab Corp.*, 368 F. Supp. 482, 484 (S.D.N.Y. 1974) (“In *Peter Pan Fabrics, Inc. v. Martin*

details aside, the *Peter Pan Fabrics* cluster of cases made it clear that the Supreme Court's *Mazer* decision (though not actually cited in Judge Hand's opinion) would have the practical effect of immediately bringing most fabric patterns into the copyright fold.

How much further did the Supreme Court's *Mazer* decision (and derivative case law) reach, for the purposes of the copyrightability of "applied art" like fashion design? Quite a bit further. As recounted in 1962 the district-court case of *Prestige Floral v. Cal. Artificial Flower Co.*<sup>267</sup>

In *Mazer v. Stein*, 347 U.S. 201 (1954), the question raised was whether statuettes used as bases for electric lamps were protected by the copyright of the original models. The statuettes were of Balinese dancers. The Supreme Court held that use in industry would not bar or invalidate the copyrights.

One of the studies upon which the Report of the Register of Copyrights, [Copyright Law Revision, House Comm. on the Judiciary, 87th Cong., 1st Sess. (Comm. Print 1961)], was based pointed out the following on *the recent trend in copyrighting three-dimensional objects*:

*"The courts in recent years, particularly since Mazer v. Stein, are beginning to realize the validity of the copyright approach and are gradually overcoming their hesitation to hold, expressly or impliedly, that a three-dimensional object is a 'writing.' Perhaps the Copyright Office anticipated this development by changing its regulation with regard to the definition of the term 'work of art.' Prior to 1949 three-dimensional objects, intended primarily for commercial use, were not ordinarily granted registration. On the contrary, applicants were advised that 'protection of productions of the industrial arts, utilitarian in purpose and character, even if artistically made or ornamented, depends upon action under the patent law.' However, in 1949 section 202.8 of the Regulations was changed so as to make registrable the artistic features of jewelry, enamel, glassware, tapestries, and other similar materials. Such registration was to cover only the artistic aspects, as distinguished from 'the mechanical or utilitarian' aspects. When the validity of this regulation was challenged in Mazer v. Stein, the Register of Copyrights, as amicus curiae, took the position that the new regulation actually reflected the previous practice of the Office. The brief said in this regard — that the Copyright Office has consistently since 1909 — and even before then — registered works like the one in this case following the clearly stated mandate of Congress.*

---

Weiner Corp., 274 F.2d 487 (2d Cir. 1960), the Court of Appeals held that ornamental designs on cloth were the proper subject of copyright under that section.").

<sup>267</sup> 201 F. Supp. 287, 290-91 (S.D.N.Y. 1962) (holding artificial lilac copyrightable, in part because of *Peter Pan Fabrics*).

*'In August, 1956, the Copyright Office issued regulations which, in greater detail than ever before, explicitly describe what can be registered. These regulations do not talk in terms of 'writings' but do require that any object offered for registration meet at least minimal standards of originality and creativity, as well as fall within one of the classes enumerated in section 5 of the copyright statute.'*"<sup>268</sup>

Taking a cue from the Copyright Office's views of, and regulatory response to, *Mazer v. Stein* (discussed in the above-excerpted passage), the lower federal courts pressed on in the general vein of the *Prestige Floral* court, displaying a strong tendency to favor industrial design copyright plaintiffs throughout the 1960s. Indeed, until the late 1970s, one finds a surprisingly small volume of reported decisions in which asserted copyright protection—at least, for works of applied art that were already the subject of copyright registrations—was not upheld in court. Thus, one 1966 case, *Ted Arnold Ltd. v. Silvercraft Co.*,<sup>269</sup> hinged on the copyrightability of “a simulation of an antique telephone [used] as a casing for a pencil sharpener.” Defendant had contended “that this copyrighted article is not a work of art because it is utilitarian” and that “the casing cannot be considered apart from the pencil sharpener.”<sup>270</sup> The court disagreed, relying on *Mazer v. Stein*: “Even without the crank, the telephone casing could still exist independently as a work of art . . . . Defendant is no more persuasive than the *Mazer* defendants in picturing the artistic features as nothing in them-selves and merely necessary parts of the product as a whole. An antique telephone is no more necessary to encase a pencil sharpener than a statuette is to support a lamp.”<sup>271</sup> In a passage whose relevance to fashion can hardly be ignored—and yet, has been, in many ways<sup>272</sup>—the court observed: “Customers are paying fifteen dollars for [the object at issue], not because it sharpens pencils uncommonly well, but because it is also a decorative conversation piece.”<sup>273</sup> Of course, the same is often true of “designer” fashion: a premium can be charged for *aesthetic* reasons. (Just as often, however, consumers are willing to pay a premium for the perceived “exclusivity” associated with particular products or fashion houses.<sup>274</sup>)

<sup>268</sup> *Id.* at 290-91.

<sup>269</sup> 259 F. Supp. 733 (S.D.N.Y. 1966).

<sup>270</sup> *Id.* at 734.

<sup>271</sup> *Id.* at 735.

<sup>272</sup> *But see* National Theme Prods., Inc. v. Jerry B. Beck, Inc., 696 F. Supp. 1348, 1350 (S.D. Cal. 1988) (“The final expression of these costumes is no more determined by their function than the pencil sharpener shaped like a telephone in *Ted Arnold, Ltd. v. Silvercraft Co.*, 259 F. Supp. 733 (S.D.N.Y. 1966).”).

<sup>273</sup> *Ted Arnold, Ltd.*, 259 F. Supp. at 736.

<sup>274</sup> *See generally* Jeremy N. Sheff, *Veblen Brands*, 96 MINN. L. REV. 769 (2012).

It was not until the late 1970s that the federal appellate courts, by and large, resumed the practice of subjecting the claims of textile pattern (or other fashion-related) copyright infringement plaintiffs to close scrutiny. Perhaps one of the first signs of the turning tide is the 1976 decision in *SCOA Industries, Inc. v. Famolare, Inc.*,<sup>275</sup> in which a district-court judge agreed with Copyright Office that sides of shoe soles featuring designs consisting of “troughs, waves, and lines” did not exist independently as work(s) of art. The court justified its ruling thus:

There can be no valid copyright in troughs in the sole or wavy lines on the sides. These have no existence as works of art and if they did have, lack even the minimum originality needed for copyright. . . . A shoe sole is an object whose intrinsic function is utilitarian. There are, of course, works of art which also serve a utilitarian function. The classic example is a statue used as a lamp base. *Mazer v. Stein*, 347 U.S. 201, 100 USPQ 325 (1953). It is clear that a statue can be identified as a work of art independent of its utilitarian aspects. It is concluded, in agreement with the Copyright Office, that the troughs, waves, and lines which appear on the shoe sole cannot be identified and do not exist independently as works of art. This being the case, Famolare has no claim of valid copyright as to the features of the shoe sole which Scoa has allegedly copied.<sup>276</sup>

Some members of the appellate bench appear to have been growing uncomfortable with the “bleed” of industrial design copyright, especially for textile patterns. Perhaps the first major “let’s wait just a minute here” moment at the appellate level occurred in 1977’s *Novelty Textile Mills, Inc. v. Joan Fabrics Corp.*,<sup>277</sup> in which a Second Circuit panel majority—contrary to the ruling of the district court judge—found substantial similarity sufficient to justify the issuance of a preliminary injunction.

Judge Mansfield, concurring and dissenting, was not so sure, writing in a separate opinion: “At a distance of 15 feet or more the similarity between Novelty’s 253, on the one hand, and the two infringing Joan plaids, on the other, was substantial, not solely because of the shading, spacing, composition, and juxtaposition of the diamonds and stripes, but *principally because of the identical color scheme* which lent the same overall effect to the designs . . . . *However, a closer comparison of the fabrics (at a distance of two to five feet) reveals several marked differences*, which were noted by Judge Werker [below] . . . .”<sup>278</sup> Judge Mansfield concluded: “In my view the color scheme should be treated as one of the elements of the copyrighted

<sup>275</sup> 192 U.S.P.Q. 216 (S.D.N.Y. Feb. 13, 1976).

<sup>276</sup> *Id.* at \*5-\*7.

<sup>277</sup> 558 F.2d 1090 (2d Cir. 1977).

<sup>278</sup> *Id.* at 1095.

design and, since we are in as good a position as the district court to resolve the infringement issue, we should hold that Novelty's Style 253 is not infringed by any of the alleged infringing fabrics produced by Joan other than its 'Fleetwood Spice' and 'Sand.'"<sup>279</sup>

During the same fifteen-year "honeymoon" period in the courts for copyright-for-fashion that followed the *Peter Pan Fabrics* cases, there had been much activity in the legislative arena. According to those with influence, it had become clear that a number of difficult issues in copyright law—including the issue of protection for industrial design, post-*Mazer*—could only be satisfactorily resolved only through legislation. For this and other reasons, beginning in the mid-1960s a variety of parties took the first steps toward a major overhaul of the copyright law, the likes of which the U.S. had not seen since the passage of the 1909 Copyright Act. While the eventual result, the Copyright Act of 1976, made many admirable strides forward, the law arguably did little to bring coherency to the thorny area of copyright protection for works of industrial design and applied art. At the very least, it failed to definitively resolve many of the difficult questions raised and left unanswered by the Supreme Court in *Mazer v. Stein*.

It will come as no surprise that when efforts to overhaul the copyright laws finally came to a head in the early 1970s, advocates of robust copyright protection for fashion designs—notwithstanding their recent success in the courts—pressed their cause yet again. Indeed, perhaps because of the positive judicial momentum, these advocates made significant progress toward codification of copyright-for-fashion-design.

One draft section of what eventually became the 1976 Copyright Act, known as the "Design Protection Act of 1975" (a/k/a "Title II")<sup>280</sup> sought to "create a new limited form<sup>281</sup> of copyright protection for 'original' designs which are clearly a part of a useful article, regardless of whether such designs could stand by themselves, separate from the article itself."<sup>282</sup> While Title II was passed in the Senate as part of the "Copyright Revision

---

<sup>279</sup> *Id.*

<sup>280</sup> S. 22, 94th Cong., 2d Sess., "Title II—Protection of Ornamental Designs of Useful Articles."

<sup>281</sup> See 1-2 NIMMER ON COPYRIGHT § 2.08[B][3], \_\_\_ at note 116.1 ("Note that even Title II excluded from the scope of its protection 'three-dimensional features of shape and surface with respect to men's, women's, and children's apparel, including undergarments and outerwear.' § 202(e).")

<sup>282</sup> See *Esquire, Inc. v. Ringer*, 591 F.2d 796, 800-01 (D.C. Cir. 1978) (quoting H.R. Rep. No. 1476, 94th Cong., 2d Sess. 50 (1976), U.S. Code Cong. & Admin. News 1976, at 5659, 5663 (hereinafter "1976 Act House Committee Report")).

Bill,” it was deleted from the final Copyright Act in the House.<sup>283</sup> The House Committee Report explains that the section was removed “in part because the new form of design protection provided by Title II could not truly be considered copyright protection and [was thus not] appropriately within the scope of copyright revision.”<sup>284</sup>

The House Report further stated that the new Copyright Act sought to track the Supreme Court’s *Mazer* decision in distinguishing between “copyrightable works of applied art [versus] uncopyrighted works of industrial design.”<sup>285</sup> The Report deemed “ladies’ dress[es]” as belonging in the second category, absent some copyrightable component that could be identified as “physically or conceptually . . . separable” from the utilitarian aspects of such articles:

The [House] Committee [on the Judiciary] has added language to the definition of “pictorial, graphic, and sculptural works” [in the new Copyright Act] in an effort to make clearer the distinction between works of applied art protectable under the bill and industrial design not subject to copyright protection . . . . In adopting this amendatory language, the Committee is seeking to draw as clear a line as possible between copyrightable works of applied art and uncopyrighted works of industrial design. A two-dimensional painting, drawing, or graphic work is still capable of being identified as such when it is printed on or applied to utilitarian articles such as textile fabrics, wallpaper, containers, and the like. The same is true when a statue or carving is used to embellish an industrial product or, as in the *Mazer* case, is incorporated into a product without losing its ability to exist independently as a work of art. On the other hand, although the shape of an industrial product may be aesthetically satisfying and valuable, the Committee’s intention is not to offer it copyright protection under the bill. *Unless the shape of an automobile, airplane, ladies’ dress, food processor, television set, or any other industrial product contains some element that, physically or conceptually, can be identified as separable from the utilitarian aspects of that article, the design would not be copyrightable under the bill.*<sup>286</sup>

The end result of the legislative process, for purposes of applied art like fashion design, was summarized in the Second Circuit’s later decision in *Brandir Int’l, Inc. v. Cascade Pacific Lumber Co.*<sup>287</sup>

<sup>283</sup> See 1-2 NIMMER ON COPYRIGHT § 2.08[B][3], \_\_\_ at note 116.1 (“This design legislation, passed by the Senate as a part of the Copyright Revision Bill, was deleted from the final Act by the House of Representatives. See Conf. Rep., p. 82.”).

<sup>284</sup> 1976 Act House Committee Report, at 5663.

<sup>285</sup> *Id.* at 5668.

<sup>286</sup> *Id.* at 5667-68 (emphasis added).

<sup>287</sup> 834 F.2d 1142 (2d Cir. 1987).

Against the history of copyright protection well set out in the majority opinion in *Carol Barnhart Inc. v. Economy Cover Corp.*, 773 F.2d 411, 415-18 (2d Cir. 1985), and in Denicola, *Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles*, 67 Minn. L. Rev. 707, 709-17 (1983), Congress adopted the Copyright Act of 1976. The “works of art” classification of the Copyright Act of 1909 was omitted and replaced by reference to “pictorial, graphic, and sculptural works,” 17 U.S.C. § 102(a)(5). According to the House Report, the new category was intended to supply “as clear a line as possible between copyrightable works of applied art and uncopyrighted works of industrial design.” H.R. Rep. No. 1476, at 55. The statutory definition of “pictorial, graphic, and sculptural works” states that “the design of a useful article, as defined in this section, shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.” 17 U.S.C. § 101 . . . .

As courts and commentators [later came] to realize, however, the line Congress attempted to draw between copyrightable art and noncopyrightable design “was neither clear nor new.” Denicola, *supra*, 67 Minn. L. Rev. at 720. One aspect of the distinction that has drawn considerable attention is the reference in the House Report to “physically or conceptually” (emphasis added) separable elements.<sup>288</sup>

Indeed, as the *Brandir* court explains, while Congress (or at least the House Judiciary Committee speaking for the bill) had “attempted to make clearer the distinction between works of applied art protectable under the bill and industrial designs not subject to copyright protection,”<sup>289</sup> the final statutory language ultimately proved inadequate for the resolution of many actual disputes over the copyrightability of utilitarian works.<sup>290</sup>

<sup>288</sup> *Id.* at 1143-44.

<sup>289</sup> H.R. Rep. No. 1476, 94th Cong., 2d Sess. 50 (1976), U.S. Code Cong. & Admin. News 1976, at 5667.

<sup>290</sup> See Michael A. Solomon, *The Copyright of Useful Articles: “Conceptual” Retreat in the Second Circuit*, 52 BROOK. L. REV. 713, 714 n.4 (1986) (“Once protection is granted, the useful article by definition becomes a work of applied art. If protection is denied, it is ‘merely’ an industrial design.”); see also Robert C. Denicola, *Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles*, 67 MINN. L. REV. 707, 721-22 (1983) (at some point “applied art” and “industrial design” meet). The Denicola article later proved influential in shaping the “separability” doctrine that arose from the courts’ application of the statutory “useful article” language. See, e.g., *Brandir Int’l, Inc. v. Cascade Pacific Lumber Co.*, 834 F.2d 1142, 1143-44 (2d Cir. 1987).

Shortly after the 1976 Copyright Act took effect on January 1, 1978,<sup>291</sup> the D.C. Circuit in *Esquire, Inc. v. Ringer* addressed the Copyright Office's broad interpretation of its own regulation on useful articles, which had been applied to deny petitioner a copyright registration in the appearance of its decorative lighting fixture.<sup>292</sup> The regulation in question (no longer in effect in identical form) provided, *inter alia*: "If the sole intrinsic function of an article is its utility, the fact that the article is unique and attractively shaped will not qualify it as a work of art."<sup>293</sup> The applicant for the registration argued that the Registrar had misinterpreted and misapplied its regulation. The District Court had agreed, citing *Bleistein* for the principle that "[t]here cannot be and there should not be any national standard of what constitutes art and the pleasing forms of the Esquire fixtures [which 'serve both to decorate and to illuminate'] are entitled to the same recognition afforded more traditional sculpture."<sup>294</sup>

The D.C. Circuit reversed, siding with the Copyright Office.<sup>295</sup> The appellate court found the Copyright Registrar's interpretation of § 202.10(c), and its application to deny the petitioner his requested copyright registration, to be "reasonable and well-supported," and in harmony with the then-recent 1976 Copyright Act:

The Register's interpretation of § 202.10(c) derives from the principle that industrial designs are not eligible for copyright. Congress has repeatedly rejected proposed legislation that would make copyright protection available for consumer or industrial products. Most recently, Congress deleted a proposed section ["Title II"] from the Copyright Act of 1976 that would have "create(d) a new limited form of copyright protection for 'original' designs which are clearly a part of a useful article, regardless of whether such designs could stand by themselves, separate from the article itself." In rejecting proposed Title II, Congress noted the administration's concern that to make such designs eligible for copyright would be to create a "new monopoly" having obvious and significant anticompetitive effects. The is-

---

<sup>291</sup> For additional information on legislative activity pre-dating the 1976 Copyright Act, see generally Goldenberg, *supra* note 11; Rocky Schmidt, *Designer Law: Fashioning a Remedy for Design Piracy*, 30 UCLA L. REV. 861, 865 n.30 (1983).

<sup>292</sup> 591 F.2d 796 (D.C. Cir. 1978). Note that although this appeal was decided after the 1976 Copyright Act went into effect, it concerned a work pre-dating 1978, which was governed by the 1909 Copyright Act. Further, even as a matter of statutory construction of the 1909 Act, the continuing import of *Esquire* is open to question—as discussed below.

<sup>293</sup> 37 C.F.R. § 202.10(c) (1976).

<sup>294</sup> *Esquire, Inc. v. Ringer*, 414 F. Supp. 939, 941 (D.D.C. 1976).

<sup>295</sup> *Esquire*, 591 F.2d at 800.



sues raised by Title II were left for further consideration in “more complete hearings” to follow the enactment of the 1976 Act.<sup>296</sup>

The *Esquire* court found especially persuasive a portion of the Registrar’s brief arguing that (1) “consumer preference sometimes demands uniformity of shape for certain utilitarian articles [and] to give one manufacturer the monopoly on such a shape would also be anticompe[ti]titive;” and (2) “insofar as geometric shapes are concerned, there are only a limited amount of basic shapes, such as circles, squares, rectangles and ellipses [and] it would be unfair to grant a monopoly on the use of any particular such shape, no matter how aesthetically well it was integrated into a utilitarian article.”<sup>297</sup> (These public policy-based arguments are still made in substantially similar form today, not only in the continuing debate about copyright—or copyright-like—protection for apparel, but also in the increasingly important arena of “trade dress” lawsuits premised on the configuration and/or appearance of fashion goods.<sup>298</sup>)

Yet *Esquire* would not be the last word on the subject of copyright protection for works of applied art and industrial design. Just two years later, advocates of copyright protection for such works achieved a major victory in the case of *Kieselstein-Cord, Inc. v. Accessories by Pearl, Inc.*<sup>299</sup> At issue in this Second Circuit appeal were belt buckles comprising “solid sculptured designs . . . with rounded corners, a sculpted surface, a rectangular cut-out at one end for the belt attachment [and] several surface levels.”<sup>300</sup> (Photos of the two buckles at issue are shown in *Figure 4*, below.) The presiding panel split two to one, ruling in favor of the buckles’ copyrightability.

---

<sup>296</sup> *Id.* at 800-01 (citations omitted).

<sup>297</sup> *Id.* at 801 n.15.

<sup>298</sup> See discussion at *The Politics of ‘Piracy’* (fifth installment in this series).

<sup>299</sup> 632 F.2d 989 (2d Cir. 1980).

<sup>300</sup> *Id.* at 990.

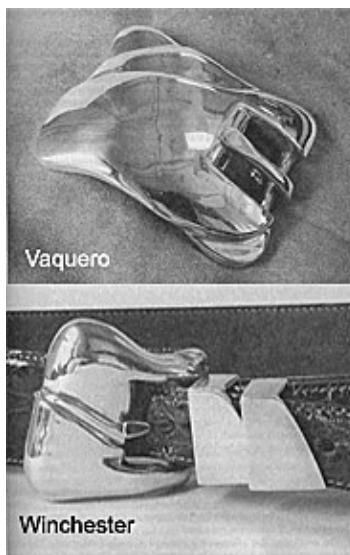


FIGURE 4: Belt buckles at issue in *Kieselstein-Cord v. Accessories by Pearl*, 632 F.2d 989 (2d Cir. 1980).

The *Kieselstein-Cord* majority began its opinion by asserting that the dispute lay “on a razor’s edge of copyright law.”<sup>301</sup> This description may have been a self-fulfilling prophecy, for the panel proceeded to engage in an in-depth analysis of the notion of copyright protection for “conceptually separable” components of industrial design and applied art in a dispute that involved only *physically* separable belt buckles—objects rather analogous to the sculptural lamp base deemed copyrightable by the Supreme Court, some thirty-six years earlier, in *Mazer v. Stein*.<sup>302</sup> The panel, apparently not tempted by the low-hanging fruit of “physical separability,” wrote: “We see in appellant’s belt buckles conceptually separable sculptural elements, as apparently have the buckles’ wearers who have used them as ornamentation for parts of the body other than the waist. The primary ornamental aspect of the Vaquero and Winchester buckles is conceptually separable from their subsidiary utilitarian function.”<sup>303</sup> The key to copyrightability, in other words, lay in the buckle’s independent appeal as a work of art. The buckle was thus similar to one of the few categories of fashion-related goods well-established as copyright-eligible: “Pieces of applied art, these buckles may

<sup>301</sup> *Id.*

<sup>302</sup> See 17 U.S.C. § 101 (1976) (addressing copyrightability of separable components of “useful articles”).

<sup>303</sup> *Kieselstein-Cord*, 632 F.2d at 993.

be considered jewelry, the form of which is subject to copyright protection.”<sup>304</sup>

The well-known District Court Judge Jack Weinstein, sitting on the presiding panel by designation, objected in his dissenting opinion that while the works at issue were “admirable aesthetically pleasing examples of modern design, [they were] indubitably belt buckles and nothing else; their innovations of form are inseparable from the important function they serve—helping to keep the tops of trousers at waist level.”<sup>305</sup> In his view, no copyright protection was available here precisely *because* of the designer’s “success in completely integrating the artistic designs and the functional aspects of the buckles.”<sup>306</sup> He reminded the majority that just two years earlier, the D.C. Circuit in *Esquire v. Ringer* (a case whose majority opinion was barely addressed by the *Kieselstein-Cord* majority) had, in Judge Weinstein’s words, “denied copyright protection to the overall shape of a lighting fixture because of its integration of the functional aspects of the entire lighting assembly.”<sup>307</sup> Weinstein then quoted what he considered the most relevant passage from *Esquire*, the D.C. Circuit panel’s declaration that the “overall design or configuration of a utilitarian object, even if it is determined by aesthetic as well as functional considerations, is not eligible for copyright.”<sup>308</sup>

The Second Circuit’s *Kieselstein-Cord* ruling—at least, in modified form—ultimately won out over the D.C. Circuit’s view expressed in *Esquire*.<sup>309</sup> In one of the first fashion-related cases to be decided after *Kieselstein-Cord*, *Transworld Mfg. Corp. v. Al Nyman & Sons, Inc.*,<sup>310</sup> a district court cited the 1980 Second Circuit decision in support of its holding that there was a possibility of “separability” sufficient to support the copyrightability of eyeglass display cases, and thus denied the defendant’s motion for summary judgment on that basis. Advocates of copyright-for-fashion—perhaps seeking to capitalize on the momentum of victories like those in *Kieselstein-Cord* and *Transworld Mfg.*, perhaps still bitter over fashion’s treatment in the

---

<sup>304</sup> *Id.*

<sup>305</sup> *Id.* at 994 (Weinstein, J., dissenting).

<sup>306</sup> *Id.*

<sup>307</sup> *Id.* at 995.

<sup>308</sup> *Id.* (citing *Esquire v. Ringer*, 591 F.2d 796, 804 (D.C. Cir. 1978)).

<sup>309</sup> See *Pivot Point Int’l v. Charlene Prods.*, 372 F.3d 913, 922 n.8 (7th Cir. 2004) (“[Despite the skepticism of some] that the statutory language encompassed both physical and conceptual separability, circuits have been almost unanimous in interpreting the language of § 101 to include both types of separability. . . . Only one appellate court [the D.C. Circuit in *Esquire, Inc. v. Ringer*, discussed above] has rejected the idea of conceptual separability.”).

<sup>310</sup> 95 F.R.D. 95 (D. Del. 1982).

days leading up to the passage of the 1976 Copyright Act—launched another round of lobbying efforts in 1983, pushing a bill similar to the fallen “Title II”/“The Design Protection Act of 1975.”<sup>311</sup> These efforts, like those that came before it, proved unsuccessful.

Meanwhile, many (including the Copyright Office<sup>312</sup> and some judges) were questioning the precise meaning—including, most importantly, the limiting principles—of the *Kieselstein-Cord* decision. In 1985, a different Second Circuit panel revisited *Kieselstein-Cord* and tried to answer such questions, in a rather far-fetched dispute about the copyrightability of “four human torso forms . . . each of which is life-size, without neck, arms, or a back, and made of expandable white styrene.”<sup>313</sup> (Photos of two such forms are shown in *Figure 5*, below.) The panel majority in *Carol Barnhart Inc. v. Economy Cover Corp.*, gently backpedaled on the *Kieselstein-Cord* decision, but notably declined to overrule it. Instead, the *Carol Barnhart* panel majority held that torso forms at issue were not entitled to the same copyright protection that the *Kieselstein-Cord* belt buckles had received, because unlike the decorative components in the earlier case, which “were not in any respect required by their utilitarian functions,” the features claimed to be aesthetic or artistic in the [torso] forms were “inextricably intertwined with the utilitarian feature, the display of clothes.”<sup>314</sup> (Judge Newman, dissenting, would have applied a different test—whether the disputed “design creates in the mind of the ordinary observer two different concepts that are not inevitably entertained simultaneously”<sup>315</sup>—and would have reached the opposite result.<sup>316</sup>)

---

<sup>311</sup> See H.R. 2985, 97th Cong. 1st Sess. (1983), reprinted in 2 COPYRIGHT L. REP. (CCH) 20,228 (1983).

<sup>312</sup> See U.S. Copyright Office, Compendium II of Copyright Office Practices § 505.03 (1984) (recognizing that a “carving on the back of a chair, or pictorial matter engraved on a glass vase, could be considered for [copyright] registration” on the basis of separability).

<sup>313</sup> 773 F.2d 411, 412 (2d Cir. 1985).

<sup>314</sup> *Id.* at 419.

<sup>315</sup> *Id.* at 422.

<sup>316</sup> *Id.* at 424 (“The initial concept in the observer’s mind, I believe, would be of an art object, an entirely understandable mental impression based on previous viewing of unclad torsos displayed as artistic sculptures. Even after learning that these two forms are used to display clothing in retail stores, the only reasonable conclusion that an ordinary viewer would reach is that the forms have both a utilitarian function and an entirely separate function of serving as a work of art. I am confident that the ordinary observer could reasonably conclude only that these two forms are not simply mannequins that happen to have sufficient aesthetic appeal to qualify as works of art, but that the conception in the mind is that of a work of art in addition

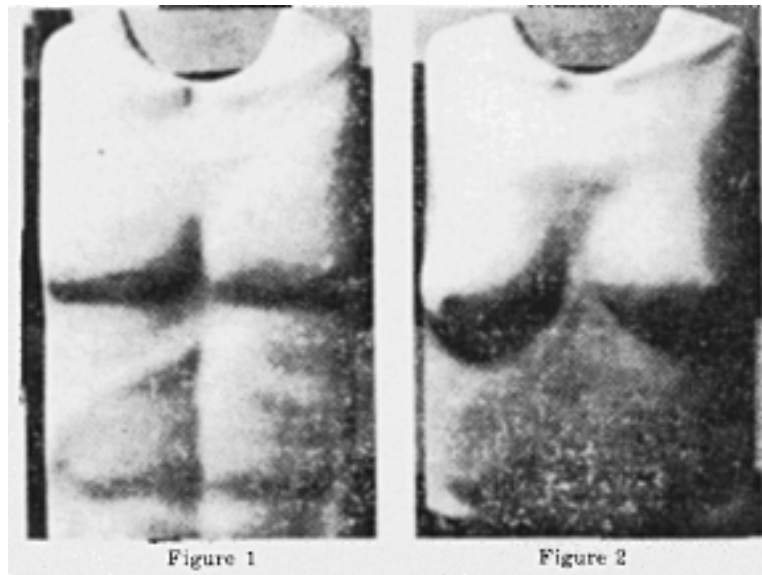


FIGURE 5: Torso forms at issue in *Carol Barnhart Inc. v. Economy Cover Corp.*, 773 F.2d 411 (2d Cir. 1985).

Two years later, in *Brandir Int'l, Inc. v. Cascade Pacific Lumber Co.*,<sup>317</sup> a different Second Circuit panel set out to bring clarity to the parameters of copyright law's "conceptual separability" doctrine. The *Brandir* appeal turned, in part, on the alleged copyrightability of an aesthetically unusual "bicycle rack made of bent tubing that is said to have originated from a wire sculpture."<sup>318</sup> The panel's majority opinion began with the observation that "[i]n passing the Copyright Act of 1976 Congress attempted to distinguish between protectable 'works of applied art' and 'industrial designs not subject to copyright protection,'"<sup>319</sup> but conceded that the courts had experienced "difficulty framing tests by which the fine line establishing what is and what is not copyrightable can be drawn."<sup>320</sup>

The *Brandir* majority reviewed the *Kieselstein-Cord* and *Carol Barnhart* decisions and concluded that "conceptual separability [was] alive and well, at least in this circuit"; the difficulty lay in "determining exactly what it is

---

to and capable of being entertained separately from the concept of a mannequin, if the latter concept is entertained at all.").

<sup>317</sup> 834 F.2d 1142 (2d Cir. 1987).

<sup>318</sup> *Id.*

<sup>319</sup> *Id.* (citing H.R. Rep. No. 1476, 94th Cong., 2d Sess. 54, reprinted in 1976 U.S. Code Cong. & Admin. News 5659, 5667).

<sup>320</sup> *Id.*

and how it is to be applied.”<sup>321</sup> The majority surveyed various proposals for the exact parameters of the doctrine,<sup>322</sup> and found most appealing the commentary of Professor Robert C. Denicola, who had written in a 1983 article that “although the Copyright Act of 1976 was an effort “to draw as clear a line as possible,” in truth ‘there is no line, but merely a spectrum of forms and shapes responsive in varying degrees to utilitarian concerns.’”<sup>323</sup> In the following passage, the panel alternately quoted and paraphrased Denicola’s proposal:

“Copyrightability [of artistic elements of ‘useful articles’] should turn on the relationship between the proffered work and the process of industrial design.” [Robert C. Denicola, *Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles*, 67 MINN. L. REV. 707, 741 (1983).] [Denicola] suggests that “the dominant characteristic of industrial design is the influence of nonaesthetic, utilitarian concerns” and hence concludes that copyrightability “ultimately should depend on the extent to which the work reflects artistic expression uninhibited by functional considerations.” [Footnote omitted.] *Id.* To state the Denicola test in the language of conceptual separability, *if design elements reflect a merger of aesthetic and functional considerations, the artistic aspects of a work cannot be said to be conceptually separable from the utilitarian elements. Conversely, where design elements can be identified as reflecting the designer’s artistic judgment exercised independently of functional influences, conceptual separability exists.*<sup>324</sup>

The panel majority then formally adopted the Denicola approach to conceptual separability, explaining that it represented the best available test because (1) it could be reconciled with the court’s precedent, (2) it would alleviate discrimination against non-representational art, and (3) it would “not be too difficult to administer in practice.”<sup>325</sup> When applied to the bicycle rack at issue in *Brandir*, the test yielded a finding of non-copyrightability, as “the form of the rack is influenced in significant measure by utilitarian concerns and thus any aesthetic elements cannot be said to be conceptually separable from the utilitarian elements.”<sup>326</sup> In the majority’s view, “while the rack may have been derived in part from one or more

---

<sup>321</sup> *Id.* at 1144.

<sup>322</sup> *Id.* A more comprehensive exploration of these various proposals can be found in Judge Newman’s *Carol Barnhart* dissent. *See discussion* at 773 F.2d at 419 *et seq.*

<sup>323</sup> *Id.* at 1145 (quoting Robert C. Denicola, *Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles*, 67 MINN. L. REV. 707, 741 (1983)).

<sup>324</sup> *Id.* (emphasis added).

<sup>325</sup> *Id.*

<sup>326</sup> *Id.* at 1147.

‘works of art,’ it is in its final form essentially a product of industrial design,” which “the designer ha[d] clearly adapted . . . to accommodate and further a utilitarian purpose.”<sup>327</sup>

Judge Winter, dissenting in relevant part,<sup>328</sup> received no support from the other members of the panel for his view—informed largely by Judge Newman’s dissenting opinion in *Carol Barnhart*—that “the relevant question [should be] whether the design of a useful article, however intertwined with the article’s utilitarian aspects, causes an ordinary reasonable observer to perceive an aesthetic concept not related to the article’s use,” and that “[t]he answer to this question is clear in the instant case because any reasonable observer would easily view the Ribbon Rack as an ornamental sculpture.”<sup>329</sup> In Judge Winter’s view, the majority’s “adaptation of Professor Denicola’s test diminishes the statutory concept of ‘conceptual separability’ to the vanishing point” and the majority’s “focus on the process or sequence followed by the particular designer makes copyright protection depend upon largely fortuitous circumstances concerning the creation of the design in issue.”<sup>330</sup> (Subsequent decisions on conceptual separability suggest that Judge Winter’s critiques were not entirely unfounded.<sup>331</sup>)

To be sure, the *Brandir* decision did not bring an end to the conceptual difficulties or the debate surrounding the separability tests.<sup>332</sup> But with the trio of *Kieselstein-Cord*, *Carol Barnhart*, and (most importantly) *Brandir* on the books, the predominant analytical framework of copyright protection for articles of industrial design and applied art—and thus, *the general parameters that would henceforth govern the copyrightability of most works of fashion design*—had been established, at least in the most crucial “fashion

---

<sup>327</sup> *Id.*

<sup>328</sup> Judge Winter concurred with the panel majority’s discussion and disposition of the plaintiff’s trademark and unfair competition claims, which are not relevant for present purposes. *Id.* at 1152.

<sup>329</sup> *Id.* at 1151-52.

<sup>330</sup> *Id.* at 1151.

<sup>331</sup> See discussion at *On ‘Originality’* (second installment in this series).

<sup>332</sup> See discussion at *Pivot Point Int’l v. Charlene Prods.* 372 F.3d 913, 921 (7th Cir. 2004) (“Although the Congressional goal was evident, application of [the 1976 Copyright Act’s ‘separability’] language has presented the courts with significant difficulty. Indeed, one scholar has noted: ‘Of the many fine lines that run through the Copyright Act, none is more troublesome than the line between protectible pictorial, graphic and sculptural works and unprotectible utilitarian elements of industrial design.’ PAUL GOLDSTEIN, 1 COPYRIGHT § 2.5.3, at 2:56 (2d ed. 2004).”).

circuit.”<sup>333</sup> Of course, myriad questions about the doctrine’s application to specific types of works would have to be resolved through case-by-case adjudication (even as lobbying efforts continued in the legislative realm.<sup>334</sup>) That application of the conceptual separability doctrine in apparel and accessories-related disputes forms part, though certainly not all, of the broader contemporary doctrinal landscape of copyright protection for fashion design under U.S. law, addressed in great detail later in this article series.

---

<sup>333</sup> *But see* *Jovani Fashion, Ltd. v. Cinderella Divine, Inc.*, 808 F. Supp. 2d 542, 548 (S.D.N.Y. 2010) (Koeltl, J.) (“None of the Second Circuit cases has purported to establish an exclusive test for determining conceptual separability. Indeed, the most recent entry in the field, *Chosun*, appears to endorse both the ‘separate concept’ test and the ‘judgment exercised independently of functional influences’ test. *See Chosun [Int’l, Inc. v. Chrisha Creations, Ltd.]*, 413 F.3d 324, 329 (2d Cir. 2005)]. It is therefore unclear what test should be applied in a case such as this, involving design elements on dresses.”) Whether or not Judge Koeltl’s statement of the law *circa* 2010 was correct, the *Brandir* test continues to provide the foundation for conceptual separability analysis in the Second Circuit (and in several other jurisdictions), even if the test has been tweaked and appears to have lost its teeth, as discussed in *Macrodoctrines* (second installment in five-article series).

<sup>334</sup> *See, e.g.*, Lee B. Burgunder, *Product Design Protection After Bonito Boats: Where It Belongs and How It Should Get There*, 28 AM. BUS. L.J. 1, 3 (1990) (“Currently, Congress is debating a bill that would establish a separate system of protection for product designs. [H.R. 902, 101st Cong., 1st Sess. (1989).]”).





## The History and Principles of American Copyright Protection for Fashion Design: On ‘Originality’

Charles E. Colman

### I. INTRODUCTION TO ON ‘ORIGINALITY’

As discussed in the previous installment of this five-part series, *A Strange Centennial*, lawyers and non-lawyers alike have often parroted the refrain that U.S. copyright does not apply to articles of fashion design. The American legal system’s actual treatment of fashion articles is far more nuanced. If pressed for an accurate generalization, one might reasonably state that certain components of fashion design are copyright-eligible, but even those elements tend to receive less consistent and robust protection than that accorded to most other types of “artistic” or “expressive” works under the law.

The main objective of *A Strange Centennial* was to shed light on the evolution of popular and judicial thinking about the *conceivability* of copyright protection under U.S. law as an appropriate vehicle for asserting exclusive rights over works of fashion design. An examination of the resulting doctrinal and rhetorical innovations in fashion-related copyright litigation from the late Nineteenth Century to the late Twentieth Century revealed that, after an initial period of “inconceivability,” lasting from the inception of American copyright until the early 1900s,<sup>1</sup> designers pressed increasingly “colorable” claims of copyright infringement concerning their creations.

---

<sup>1</sup> As discussed in *A Strange Centennial*, when designers brought fashion-related IP lawsuits in the opening years of the twentieth century, the vast majority simply did not question the assumption that copyright was not a conceivable vehicle for asserting exclusive rights. There is a written record of the shifting of this collective assumption in the form of previously mentioned judicial decisions from the 1920s, when American plaintiffs first began to bring claims against “design pirates” grounded in copyright law. Charles E. Colman, *The History and Principles of American*

For a roughly thirty-year period beginning in the 1920s, copyright protection hovered somewhere between being *conceivable* as appropriate for copyright protection and actually *eligible* for it. The Supreme Court's 1954 decision in *Mazer v. Stein*, holding the decorative base of a lamp to be "separable" as a work of art, and thus eligible for copyright protection, resolved the threshold question of "eligibility," writ large, for certain components of applied art.<sup>2</sup> From that point on, courts were tasked with separating the eligible from the ineligible. One might conceptualize this shift as a change in the judicial understanding of the appropriate inquiry from (1) whether copyright protection was conceivable for works fashion design *as a category of creative output* to (2) *whether certain sub-categories of fashion-related works* were eligible for copyright protection under U.S. law. After an initial "honeymoon" period in which courts applied the Supreme Court's *Mazer* holding to bring several components of fashion design—most notably, fabric patterns and works of jewelry—into the copyright fold, federal courts in the 1970s began to question anew the copyrightability of fashion articles. However, different federal judges went about this in very different ways.

This second installment, *On 'Originality,'* surveys a number of notable fashion design-related judicial decisions from the 1970s to present, in order to parse their treatment of two core principles of copyright law: the "originality" requirement and the "idea-expression" distinction. As we will see, the forty-year period under discussion has been characterized by a smattering of judicial decisions applying these doctrines in ways that have stretched, shoehorned, and transformed copyright protection for works of fashion design in idiosyncratic and sometimes incoherent ways.

While the doctrines mentioned above certainly have important roles to play in U.S. copyright jurisprudence, they have arguably been deployed by courts in fashion-design disputes with the aim and/or result of achieving, often *sub silentio*, the same disfavored treatment of fashion design reflected in the history laid out in *A Strange Centennial*. Indeed, one might best think of these principles as tools used for the judicial implementation of various intuitions arising from the social, cultural, and ontological complexities of fashion design.<sup>3</sup> To the extent that one can generalize the manner in which these factors have influenced judicial treatment of fashion design in U.S. copyright law, one might posit the following:

---

*Copyright Protection for Fashion Design: A Strange Centennial*, 6 HARV. J. SPORTS & ENT. L. 224 (2015).

<sup>2</sup> 347 U.S. 201, 214 (1954).

<sup>3</sup> See discussion at *A Strange Centennial*; see also Charles E. Colman, *Design and Deviance: Patent as Symbol, Rhetoric as Metric*, 55 JURIMETRICS J. (forthcoming 2015).

Works of fashion design are presumptively ineligible for copyright protection, except for certain components that have been “grandfathered” in by the case law between roughly 1954 and 1980. However, even works of fashion design that *are* potentially copyright-eligible tend to be “constructively derivative,” and are thus entitled to (a) no protection or (b) less robust protection than that awarded to most other copyright-eligible works.

These deep themes are only occasionally made explicit in the “surface discourse” of judicial decisions.<sup>4</sup> Yet their effect can be observed in the cumulative “on-the-ground” judicial application of major copyright-law principles—not only the “idea-expression” distinction and the “originality” requirement, but also a variety of other doctrines discussed later in this series.

As this installment will show, courts have sometimes invoked the “idea-expression” distinction and/or the “originality” requirement as a way to put a decisive “foot down” on the question of copyrightability for newly contested sub-categories of fashion design;<sup>5</sup> other courts have *effectively* rejected the prospect of copyright protection for contested articles of fashion design by applying the same doctrines not as all-or-nothing threshold bars to protection, but rather as “filtering” or “thinning” tools. In decisions of the latter variety, courts appear to give works of fashion design a “pass” on the question of copyright eligibility, but dramatically narrow (or even eviscerate) that protection by later excluding large portions of works as irrelevant to the question of infringement. Still other courts have applied the “idea-expression” and “originality” doctrines in decidedly mechanical ways that do not reflect the ontological differences between many works of fashion design and more traditional genres of copyrightable works, like books and musical compositions. The current, heterogeneous doctrinal landscape has resulted in large part from the inconsistency and conceptual incompatibility of these divergent approaches to the adjudication of copyright disputes over works of fashion design.<sup>6</sup>

---

<sup>4</sup> See Colman, *Design and Deviance*, *supra* note 3 (arguing that design patents were marginalized in IP jurisprudence due to themes pervading the “deep discourse” of federal courts’ decisions).

<sup>5</sup> See, e.g., *SCOA Industries, Inc. v. Famolare, Inc.*, No. 75 Civ. 3357, 1976 U.S. Dist. LEXIS 16663, \*5-\*6 (S.D.N.Y. Feb. 13, 1976) (ruling that “the wavy lines or ridges on the sides of [shoe] soles and . . . the troughs in the bottom of the soles” did exist independently as copyrightable work(s) of art).

<sup>6</sup> See *Boisson v. Banian, Ltd.*, 273 F.3d 262, 270 (2d Cir. 2001) (“Absent evidence of copying, an author is entitled to copyright protection for an independently produced original work despite its identical nature to a prior work, because it is independent creation, and not novelty that is required.”); compare *Todd v. Montana*

Compounding the problem of this “substantive” doctrinal fracturing is the issue of *procedural* fracturing. When courts treat similar or identical principles as, alternatively, (1) threshold requirements presenting “questions of law,” potentially appropriate for adjudication on a motion to dismiss; (2) “mixed questions of law and fact” dictating the requirements for making out a *prima facie* case on summary judgment; or (3) affirmative defenses, which (by their very nature) place the burden on a defendant to rebut conclusions that would otherwise lead to liability;<sup>7</sup> the natural outcome is a reduction in the cohesiveness, predictability, and efficiency of copyright doctrine concerning works of fashion design.

In recognition of such obstacles to the coherence of the law, this Article identifies instances in copyright litigation where courts have dealt with works of fashion design inconsistently—for example, by applying one doctrine in name, but drawing on the substance of an entirely different doctrine; by (perhaps inadvertently) fusing doctrines structurally designed to serve different functions; and by introducing procedural variables of (often unrecognized) significance. Illuminating the day-to-day workings of these mechanics is a necessary first step toward bringing conceptual uniformity to this little-understood corner of U.S. copyright law.

---

Silversmiths, Inc., 379 F. Supp.2d 1110, 1113 (D. Colo. 2005) (“Plaintiff has not ‘recast and arranged’ the public domain elements of her jewelry in an original way. Instead, she has taken the constituent elements of barbed-wire and arranged them in a way that by all objective measures still matches the elemental arrangement of barbed-wire . . . . [S]he has failed to show what copyrightable feature(s) she has added to her work to separate it from ordinary public domain barbed-wire.”) *with* Herbert Rosenthal Jewelry Corp. v. Honora Jewelry Co., Inc., 509 F.2d 64, 65 (2d Cir. 1974) (“The test of copyright infringement is whether the similarity between the products would lead ‘the average lay observer . . . (to) recognize the alleged copy as having been appropriated from the copyrighted work,’ . . . . Applying this test here, the district court concluded that the average layman would not find sufficient similarity in the parties’ particular expressions of the idea of a jeweled turtle pin to warrant a finding of infringement. We agree.”).

<sup>7</sup> For an example of a passage from a judicial decision that conflates a variety of legal and factual inquiries, to the detriment of clarity and guidance to actual or potential litigants, see *L & L White Metal Casting Corp. v. Joseph*, 387 F.Supp. 1349, 1353 (E.D.N.Y. 1975) (“While copyright protection for originality exists if a new element is introduced which is novel or original as compared to the previously known art or material, the introduction of such a new element to the original article will not suffice for infringement protection if the ordinary lay observer would still regard the two articles as substantially similar.”).

II. EXPLORING JUDICIAL INVOCATION OF THE “IDEA-EXPRESSION DISTINCTION” AND THE “ORIGINALITY REQUIREMENT”  
(INCLUDING THE “THIN COPYRIGHT” DOCTRINE)

A. *The “Idea-Expression Distinction” and Its Variable Application*

Federal courts in the United States regularly recite that a work’s eligibility for copyright protection hinges on its compliance with three basic requirements. The first is that the subject matter for which copyright protection is sought must constitute “copyrightable expression,” as opposed to an “uncopyrightable idea.” The second is that the subject matter in question must qualify as “original.” The third requirement, which will not be discussed here, is that a work be “fixed in a tangible medium” (because most fashion articles are static, tangible objects, there are seldom disputes as to whether works of fashion design satisfy the “fixation” requirement). This section will explore the idiosyncratic doctrinal landscape concerning the first of these tenets, the “idea-expression distinction,” highlighting loci of overlap, tension, and/or unacknowledged consistency with other principles of U.S. copyright law.

American copyright law has long recognized a distinction between “ideas” and “expression.” Both Congress and the courts have repeatedly recited the mantra that copyright protection exists only for particular *expressions* of an idea, and not for *the ideas contained* therein.<sup>8</sup> This tenet, however, is much easier to recite than to apply. As the case law reveals, when confronted with disputes over concrete works, it is often challenging to draw principled distinctions between an “idea” and its “expression.” This difficulty was apparent to Judge Learned Hand some fifty years ago, when he wrote the following in a Second Circuit decision concerning fabric designs:

Obviously, no principle can be stated as to when an imitator has gone beyond copying the “idea,” and has borrowed its “expression.” Decisions must therefore inevitably be ad hoc. In the case of designs, which are addressed to the aesthetic sensibilities of an observer, the test is, if possible, even more intangible.<sup>9</sup>

---

<sup>8</sup> 17 U.S.C. § 102(b) (“In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work”).

<sup>9</sup> *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960).

Judicial techniques for distinguishing copyrightable expression from non-copyrightable ideas have improved only marginally in the decades since Judge Hand made his insightful observation. Courts have struggled, in particular, to apply this doctrine in the context of visual works, including fabric patterns. As will become apparent, the difficulty of distinguishing between the “idea” behind visual material from possible “expressions” of that idea is likely responsible, in part, for designers’ frequent lack of success in obtaining and/or enforcing copyright protection for their creations.

The 1977 district court decision in *Russell v. Trimfit, Inc.*<sup>10</sup> provides an illuminating starting point for a discussion of judicial idiosyncrasies and inconsistencies in this area. The plaintiff in *Russell* claimed to have designed so-called “toe socks” (socks with individual compartments for each toe), alleging that the defendant had infringed its copyright in making competing toe socks. The presiding court could have opted for any number of routes to disposing of the plaintiff’s claim; the most intuitive method would likely have been to rule that plaintiff’s work was a non-copyrightable “useful article,” period.<sup>11</sup> Instead, the court dismissed the case on the ground that plaintiff was claiming copyright protection for an “idea” rather than original “expression”—and thus had no viable cause of action under U.S. copyright law—as opposed to U.S. patent law. The presiding judge wrote: “Plaintiff contends that her copyrights prevent others from engaging in the business of manufacturing toe socks. We think that plaintiff has misconstrued the rights afforded under the Patent and Copyright laws . . . [A] copyright does not confer an exclusive right to the idea disclosed, as does a patent.”<sup>12</sup> The court went on to explain that the broad rights asserted by the plaintiff were incompatible with the fact that “[t]he prerequisites for copyright registration are minimal”—and specifically, that “[u]nlike a patented product, [a] copyrighted work need not be novel, nor rise to the level of an ‘invention’; it need only be original, *i.e.*, created without copying.”<sup>13</sup>

The *Russell* decision thus illustrates, as a preliminary matter, the potential interrelatedness of the “idea-expression” distinction, copyright law’s

---

<sup>10</sup> 428 F. Supp. 91 (E.D. Pa. 1977).

<sup>11</sup> The “useful article” bar to copyrightability, along with its exceptions for “physically or conceptually separable” artistic works, will be explored in depth in the next installment of this series, *On ‘Separability.’* (forthcoming).

<sup>12</sup> *Russell*, 428 F. Supp. at 93.

<sup>13</sup> *Id.* at 93 (“A copyright gives protection from copying only; a person working independently would not infringe a copyright even though his resulting work was substantially identical to a copyrighted work. A patentee, on the other hand, may exclude anyone from the field covered by his patent, even if the latter developed his invention independently.”)

“originality” requirement, and its withholding of protection from “useful articles.” While it would undoubtedly have been useful for the Third Circuit to weigh in on the appropriate treatment of these copyright-law tenets, it affirmed the district court’s decision in a summary manner used for disputes determined to lack “precedential or institutional value.”<sup>14</sup> This lack of sustained engagement by appellate courts appears to be a recurring theme in federal court proceedings over alleged rights in gross concerning the appearance of designed goods.<sup>15</sup>

While the idea-expression distinction has thus been used in lieu of the “useful article” bar to copyright protection, it has also been used in a manner reminiscent of copyright’s “originality” requirement. The latter iteration has appeared in several fashion-related disputes where designed articles bear similar visual motifs. In such cases, the idea-expression doctrine has not infrequently served as an adjunct to the conventional originality analysis; in addition to the usual requirements for originality—that material in question (1) have originated with the author and (2) reflect a “modicum of creativity”—the idea-expression distinction steps in to further demand *differentiation from ubiquitous or naturally existing material*.<sup>16</sup>

American copyright jurisprudence has traditionally claimed not to care whether a work is in fact *new*, but only whether it is the author’s “independent creation” and whether an alleged infringer copied *that particular author’s version* of the material in question.<sup>17</sup> However, fashion-design disputes,

<sup>14</sup> *Russell v. Trimfit, Inc.*, 568 F.2d 770 (3d Cir. 1978) (explaining that the Third Circuit rules state that « [a]n opinion which appears to have value only to the trial court or the parties is ordinarily not published »).

<sup>15</sup> See generally Colman, *Design and Deviance*, *supra* note 3.

<sup>16</sup> *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co., Inc.*, 499 U.S. 340, 346 (1990). This iteration of the idea-expression distinction also overlaps significantly with the copyright-law doctrine of “*scènes à faire*,” discussed in some detail below and in greater detail in *On ‘Similarity,’* (forthcoming). For an example of a relatively recent decision treating as conceivable the copyrightability of applied art, but ultimately rejecting the material in question (a collection of artificial corsages) as insufficiently “creative,” non-“original,” and “idea”-based for copyright protection, see *Gardenia Flowers, Inc. v. Joseph Markovits, Inc.*, 280 F. Supp. 776, 783 (S.D.N.Y. 1968) (“[O]riginality is not proved merely because plaintiff may have had the idea to produce artificial corsages made out of a new plastic material. There can be no copyright on an idea.”) (citing *Baker v. Selden*, 101 U.S. 99 (1879); *Uneda Doll Co. v. P & M Doll Co.*, 353 F.2d 788 (2d Cir. 1965)).

<sup>17</sup> *Id.* at 345 (“Original, as the term is used in copyright, means only that the work was independently created by the author (as opposed to copied from other works), and that it possesses at least some minimal degree of creativity . . . . To be sure, the requisite level of creativity is extremely low; even a slight amount will suffice. The vast majority of works make the grade quite easily, as they possess some

perhaps more than litigation in any other area of copyright law, reflect a tendency by courts to make this standard more stringent.

In such cases, federal judges' implementation of the idea-expression distinction (along with a ratcheted-up originality requirement) has arguably grafted onto copyright law principles arising in *patent law* that serve to preclude the award of exclusive rights in, *inter alia*, material as it can be found in nature, material already existing in the body of invented objects and process (known as the "prior art"), and material whose development would have been "obvious" to those with the relevant knowledge and background.<sup>18</sup>

In such circumstances, a would-be patent owner (or patent-infringement plaintiff) cannot obtain or enforce patent rights over the material in question. This principle is traditionally envisioned as wholly removed from copyright jurisprudence; several fashion design-related cases in the copyright realm, however, suggest otherwise.

The Ninth Circuit's decision in *George S. Chen Corp. v. Cadona Int'l, Inc.*<sup>19</sup> illustrates both (1) the partial importation of patent law's "prior art"

---

creative spark, 'no matter how crude, humble or obvious' it might be . . . . Originality does not signify novelty; a work may be original even though it closely resembles other works so long as the similarity is fortuitous, not the result of copying.") (internal citations omitted).

<sup>18</sup> See *Association for Molecular Pathology v. Myriad Genetics, Inc.*, 133 S.Ct. 2107, 2116 (2013) (under 35 U.S.C. § 101, "[p]roducts of nature are not created, and 'manifestations . . . of nature [are] free to all men and reserved exclusively to none'") (quoting *Diamond v. Chakrabarty*, 447 U.S. 303, 309 (1980)); *SmithKline Beecham Corp. v. Apotex Corp.*, 403 F.3d 1331, 1342 (Fed. Cir. 2005) (under 35 U.S.C. § 102(b), "[a] patent claim is not valid if 'the invention was patented or described in a printed publication . . . more than one year prior to the date of the application for patent in the United States . . . .'"); *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 415-16 (2007) ("For over a half century, the Court has held that a 'patent for a combination which only unites old elements with no change in their respective functions . . . obviously withdraws what already is known into the field of its monopoly and diminishes the resources available to skillful men.' . . . . This is a principal reason for declining to allow patents for what is obvious. The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.") (internal citations omitted). The real-life implementation of these principles remains the subject of substantial uncertainty and controversy; further, their applicability to the subject matter of *design* patents can be idiosyncratic. See *MRC Innovations, Inc. v. Hunter Mfg., LLP*, 747 F.3d 1326, 1331 (Fed. Cir. 2014) (explaining doctrinal framework for evaluating obviousness of designs).

<sup>19</sup> 266 Fed. App'x. 523 (9th Cir. 2008). This decision might be viewed as a recent iteration of what is arguably the archetypal case on these issues, *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 742 (9th Cir. 1971) ("The critical distinction between 'idea' and 'expression' is difficult to draw. As Judge



principle into copyright disputes over certain works of fashion design and (2) the way in which the idea-expression distinction and the originality requirement tend to blur when courts utilize this type of reasoning to dispose of copyright litigation. In *Cadona*, a panel majority affirmed the lower court's grant of summary judgment to a defendant accused of infringing plaintiff's "copyrights on [works consisting of] dolphin, frog, and moon/star wind chime ornaments, and on a stand-alone frog ornament."<sup>20</sup> In reaching this result, the panel did not merely use prior art-like reasoning, but stated explicitly: "GSC contends that its moon/star ornament had 'subtle differences' from the prior art of such ornaments[.]"<sup>21</sup> In the panel majority's view, GSC had failed to identify "what those differences may be," making it "impossible to tell whether the differences, if any, are 'more than a "merely trivial" variation [on the 'prior art'], something recognizably "his own.'" "<sup>22</sup> The majority went on to explain:

As GSC concedes, its dolphin and frog ornaments are "approximately true to life." It failed to identify any elements of the dolphin or frog that it selected that are not commonplace or dictated by the idea of a swimming dolphin or sitting frog sculpture. GSC's concept was to make a "cute"

---

Hand candidly wrote, 'Obviously, no principle can be stated as to when an imitator has gone beyond copying the "idea," and has borrowed its "expression.'" Peter Pan Fabrics, Inc. v. Martin Weiner Corp., 274 F.2d 487, 489 (2d Cir. 1960). *At least in close cases, one may suspect, the classification the court selects may simply state the result reached rather than the reason for it.*' (emphasis added). Most courts have been less "candid" than the *Kalpakian* and *Peter Pan* courts in acknowledging the manipulability of the idea-expression distinction, at least in the context of visual works. *But see* Mannion v. Coors Brewing Co., 377 F. Supp. 2d 444, 456, 458-59 (S.D.N.Y. 2005) ("[T]he argument reveals an analytical difficulty in the case law about which more ought to be said . . . . The idea/expression distinction arose in the context of literary copyright. . . . In the visual arts, the distinction breaks down. For one thing, it is impossible in most cases to speak of the particular 'idea' captured, embodied, or conveyed by a work of art because every observer will have a different interpretation. Furthermore, *it is not clear that there is any real distinction between the idea in a work of art and its expression.* An artist's idea, among other things, is to depict a particular subject in a particular way. As a demonstration, a number of cases from this Circuit have observed that a photographer's 'conception' of his subject is copyrightable. By 'conception,' the courts must mean originality in the rendition, timing, and creation of the subject - for that is what copyright protects in photography. But the word 'conception' is a cousin of 'concept,' and both are akin to 'idea.' In other words, *those elements of a photograph, or indeed, any work of visual art protected by copyright, could just as easily be labeled 'idea' as 'expression.'*") (emphasis added).

<sup>20</sup> *Cadona*. 266 F. App'x at 524.

<sup>21</sup> *Id.* (emphasis added).

<sup>22</sup> *Id.*

dolphin-with an open mouth and an uplifted, twisted tail which made it appear to be swimming — but *these features necessarily follow from the idea of a swimming dolphin*. See *Aliotti v. R. Dakin & Co.*, 831 F.2d 898, 901 (9th Cir. 1987) (noting that a tyrannosaurus is commonly pictured with its mouth open, and that *no reliance may be put upon similarity in expression resulting from the physiognomy of dinosaurs*). There is no indication that the frog is anything but a stereotypical frog, sitting as a frog would sit in nature.<sup>23</sup>

The proposition that the representation of “natural” objects on works of fashion design might preclude copyright protection under the idea-expression distinction has, at times, surfaced in a broader form which has resulted in the defeat of copyright-infringement claims by fashion designers. In *Fashion Victim, Ltd. v. Sunrise Turquoise, Inc.*,<sup>24</sup> for example, the plaintiff had created a series of t-shirts bearing cartoon images of skeletons engaging in various sexual acts. After the plaintiff learned that a third party was selling a line of t-shirts showing skeletons in sexual positions, it filed suit for copyright infringement. The court ruled against the plaintiff-designer, applying an iteration of the idea-expression dichotomy that arguably undermined the plaintiff’s rights in “separable” artistic works:

All of the differences (and they are numerous) between the competing designs negate any infringement, while all of the similarities are the natural result of the limitations of the subject matter—the idea itself. To grant Fashion a preliminary injunction under the circumstances here would impermissibly extend the protection of the law to the nonprotectible idea of depicting skeletons as engaged in sexual activity of various kinds.<sup>25</sup>

The contours of unprotectable “ideas” have proven malleable; not every court wrestling with the question of idea versus expression—even where the depictions in question are of “natural objects”—has ruled against plaintiff-designers. In *Wildlife Express Corp. v. Carol Wright Sales, Inc.*,<sup>26</sup> for example, a designer/retailer brought suit to enforce copyright protection in the design of its duffel bags, which featured a stuffed animal head attached to one end and an animal tail attached to the other.<sup>27</sup> Finding the duffel bags to be protectable expression rather than an unprotectable idea, the court wrote: “In this case, protection is claimed for the animal heads and tails them-

---

<sup>23</sup> *Id.* (emphasis added, some internal citations omitted).

<sup>24</sup> 785 F.Supp. 1302 (N.D. Ill. 1992).

<sup>25</sup> *Id.* at 1307 (emphasis omitted).

<sup>26</sup> 18 F.3d 502 (7th Cir. 1994).

<sup>27</sup> *Id.* at 505-06.

selves, and for the way they are placed on the duffle bags, but not for the general idea of animal heads on duffle bags.”<sup>28</sup>

A different district court was similarly inclined to rule in favor of the plaintiff-designer in *Cynthia Designs, Inc. v. Robert Zentall, Inc.*,<sup>29</sup> granting a preliminary injunction where the defendant had copied the plaintiff’s design for a pendant in the shape of a t-shirt.<sup>30</sup> The court reasoned that “Cynthia has not, in this case, attempted to claim that its copyright extends to all T-shirts, or even to all renditions of T-shirts as articles of jewelry. Cynthia merely claims that its particular expression of the T-shirt as jewelry is protected.”<sup>31</sup>

The ruling in *Cynthia Designs* is arguably difficult to reconcile with the outcome in *Todd v. Montana Silversmiths, Inc.*,<sup>32</sup> where the presiding court rejected the possibility of copyright protection in jewelry designed to resemble barbed wire.<sup>33</sup> In *Todd*, the court found that the existence of barbed wire precluded the plaintiff’s claim to any exclusive rights in the jewelry at issue, reasoning: “Any expression contained in Plaintiff’s work is a necessary concomitant of the idea of barbed-wire jewelry. As such, it may not be copyrighted.”<sup>34</sup> The cases were decided nearly three decades apart, during which time major doctrinal developments occurred.<sup>35</sup> Nevertheless, they highlight the unpredictability of judicial application of the idea-expression distinction in the context of fashion design. Some decisions appear to adhere to a nar-

---

<sup>28</sup> *Id.* at 507.

<sup>29</sup> 416 F. Supp. 510 (S.D.N.Y. 1976).

<sup>30</sup> *Id.* at 511, 514.

<sup>31</sup> *Id.* at 512.

<sup>32</sup> 379 F. Supp. 2d 1110 (D. Colo. 2005).

<sup>33</sup> *Id.* at 1111.

<sup>34</sup> *Id.* at 1114. The court added: “Only by vigorously policing the line between idea and expression can we ensure both that artists receive due reward for their original creations and that proper latitude is granted other artists to make use of ideas that properly belong to us all.” *Id.* (quoting *Satava v. Lowry*, 323 F.3d 805, 813 (9th Cir. 2003)).

<sup>35</sup> Of potential significance is the Supreme Court’s decisive rejection of the “sweat of the brow” doctrine in *Feist Publ’ns. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 352-55, 359-360 (1991), which, if decided twenty years earlier, might have influenced the reasoning of the 1976 decision in *Cynthia Designs*, given the court’s finding, “on inspection of plaintiff’s pendants, that its renditions of a T-shirt as articles of jewelry required the exercise of ‘artistic craftsmanship . . .’”. 416 F. Supp. at 512. Also of potential significance is the three-decade expansion of objects in what might be called the “aesthetic public domain”—material determined not by the rules governing copyright expiration, but by the degree to which visual material is commonplace. *See id.* (“these pendants contain ‘distinguishable variations’ from ordinary T-shirts in the public domain”).

row understanding of the idea-expression distinction, while others sometimes seize on it as a sort of end-run around the low bar of “originality” set by the Supreme Court. In the process, the originality requirement might appear unchanged “on the books,” but can surface in real-life litigation—by means of idea-expression-based reasoning—as an obstacle whose contours are somewhere in the gray area between copyright “originality” and patent “novelty.”

In addition to conflating the idea-expression distinction with copyright law’s “useful article” and “originality” doctrines, some courts have either intentionally or inadvertently introduced the idea-expression distinction into the *infringement*-oriented “substantial similarity” determination (addressed in detail in the fourth installment of this series, *On ‘Similarity.’*) Consider *Maharishi Hardy Blechman Ltd. v. Abercrombie & Fitch Co.*,<sup>36</sup> in which the plaintiff had designed pants bearing dragon figures, and alleged copyright infringement by the defendant which put similar (but not identical) dragon-designs on its own pants.<sup>37</sup> In ruling for the defendant, the court stated that “only the particularized expression of the dragon is protectable, not the idea of the dragon itself or even the idea of putting a dragon on pants.”<sup>38</sup> In addressing the issue of substantial similarity, the court found the defendant’s dragons to be “dissimilar” from plaintiff’s:

[T]he overwhelming impression [when examining both designs] is of dis[ ]similarity, and the Court cannot imagine that the dragon images (as distinguished from the mere idea of putting a dragon on pants) came from the same creative source. The Court’s noted differences are merely illustrative of a factual finding which is difficult to explain beyond saying that the dragons are obviously and substantially dissimilar.<sup>39</sup>

The court’s reference to a “factual finding which is difficult to explain” evokes the oft-recited conventional wisdom in U.S. copyright jurisprudence that the murkiness of the “substantial similarity” inquiry warrants sending such questions to a jury; instead, the court disposed of the case on summary judgment through the idea-expression distinction:

No reasonable factfinder could conclude that the dragons at issue are substantially similar in the relevant respect because virtually all of the similarity is attributable to the fact that the images are all dragons.<sup>40</sup>

<sup>36</sup> 292 F. Supp. 2d 535 (S.D.N.Y. 2003).

<sup>37</sup> *Id.* at 538-39.

<sup>38</sup> *Id.* at 553.

<sup>39</sup> *Id.* at 554 (emphasis omitted).

<sup>40</sup> *Id.* at 553; *cf.* *Angela Adams Licensing, LLC v. Surya Carpet, Inc.*, No. 07-77-P-H, 2008 WL 686868, at \*7-\*8 (D. Me. Mar. 10, 2008) (“In *Concrete [Mach. Co. v.*

What might give pause to the reader—let alone to the plaintiff in the case—is that the court, in one breath, denies the possibility of substantial similarity, only to concede the existence of (at least some) similarity a moment later. As noted in the contrasting district-court decision excerpted in footnote 39 courts often declare that it is disfavored to grant summary judgment based on a lack of substantial similarity where there are admittedly similar elements in the parties' works. To be sure, it might represent good public policy, to dispose of claims like Maharishi's at the summary-judgment stage (or even earlier) on the basis of claims over unprotectable material. (We will return to this discussion in the fourth installment of this series, *On 'Similarity.'*) But to say that Maharishi could not proceed to a jury trial because of the "fact that the images are all dragons"<sup>41</sup> arguably stretches the idea-expression distinction to its breaking point—and raises questions about tacit judicial assumptions in copyright disputes about the value of plaintiffs' creations.<sup>42</sup>

In short, courts presiding over copyright-infringement disputes concerning fashion design<sup>43</sup> have invoked the "idea-expression" distinction in a

---

*Classic Lawn Ornaments, Inc.*, 843 F.2d 600, 606 (1st Cir.1988)], the work at issue was a design for a concrete, life-sized deer, and the First Circuit said that "[t]he idea behind this particular expression can be briefly described as a "realistic-looking concrete deer." *Id.* at 607. The idea and its expression in that case were close to being the same thing; in the words used by the First Circuit, 'as idea and expression merge . . . a copyright holder must then prove substantial similarity to those few aspects of the work that are expression not *required* by the idea.' *Id.* (emphasis in original). . . . However . . . , the Lulu design is closer to an original work embodying only one of an infinite variety of ways of expressing an idea than it is to a concrete, life-sized deer. The shapes in the Lulu design are not geometric shapes; they are irregular shapes . . . . [T]he defendant has not established that the Lulu design 'incorporate[s] unprotected modern ideas.' Substantial similarity is a fact-based question, making summary judgment unpopular in copyright litigation.").

<sup>41</sup> *Maharishi*, 292 F. Supp. 2d at 553.

<sup>42</sup> Federal judges have been under instructions from the U.S. Supreme Court for over a century not to make determinations about the worthiness or value of art in copyright litigation. See *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903) ("It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits."). Yet works of design—and fashion design, in particular—represent an apparent blind spot for the egalitarian aesthetic ethos endorsed in *Bleistein* and many subsequent decisions. See *discussion* at *A Strange Centennial*; accord. Colman, *Design and Deviance*, *supra* note 3 (detailing and hypothesizing sociocultural reasons for design's long-disfavored treatment by the federal courts).

<sup>43</sup> Not all of the dynamics noted here are entirely unique to fashion design. See, e.g., *Satava v. Lowry*, 323 F.3d 805, 810 (9th Cir. 2003) (plaintiff's copyright in

manner resembling the “useful article” bar to copyrightability; as an alternative means of finding a lack of sufficient “originality” for copyright protection, sometimes through a sort-of backdoor introduction of patent-law principles into copyright cases; and even as a dispositive consideration in the “substantial similarity” inquiry. In numerous fashion-related disputes, the idea-expression distinction has shown itself to be an obstacle that can rear its head at virtually any point in a case,<sup>44</sup> for myriad purposes—to the detriment of coherence and predictability in the law governing the copyrightability of fashion design.

### B. *The “Originality” Requirement and the Rise of “Thin Copyright”*

#### 1. Constitutional Source of “Originality” Requirement and General Application

Assuming that subject matter for which copyright protection is sought qualifies as protectable “expression” under the idea-expression distinction, such expression must further be “original” to receive copyright protection. The Supreme Court most recently articulated the originality requirement in its 1991 decision in *Feist Publications, Inc. v. Rural Telephone Service Co.*<sup>45</sup> Because the requirement of originality has no explicit statutory basis, *Feist* (as interpreted by the circuit courts in the intervening quarter-century since it was decided) generally serves as the touchstone for federal courts’ analyses of originality. However, the general and often-abstract dictates of *Feist*, compounded by the difficulty of applying a holding geared toward the specific genre of works in the category of “factual compilations,” have often led courts to apply *Feist* to works of fashion design in idiosyncratic ways—and even to develop alternative frameworks for evaluating originality that are arguably irreconcilable with *Feist*’s decidedly lax requirements.<sup>46</sup>

---

glass jellyfish sculpture held not infringed, as similarities with defendant’s work stemmed from jellyfish physiology). However, it is potentially significant that the observed twists and tears in the application of the idea-expression doctrine stem from cases decided during the period of federal-court backlash to the post-*Mazer* “honeymoon” period of welcoming many aspects of fashion design into the copyright fold. See discussion at *A Strange Centennial*.

<sup>44</sup> See discussion at ‘On Similarity.’

<sup>45</sup> 499 U.S. 340 (1991).

<sup>46</sup> Consider (1) above-cited examples of judicial invocation of the idea-expression distinction for non-traditional purposes, with the apparent effect of raising the originality bar for fashion-design plaintiffs; (2) the discussion in this section of “thin copyright” and its often-accompanying “striking similarity” standard for infringement; and (3) other doctrinal and pseudo-doctrinal techniques for rendering moot

The *Feist* case arose when one telephone company sued another for copying its phone book; the defendant challenged the source phone book's eligibility for copyright protection, as a threshold matter.<sup>47</sup> The Supreme Court granted *certiorari* in the case and used Justice O'Connor's majority opinion as something of a massaged "restatement" of the broad principles governing copyright law's "originality" requirement. First, the *Feist* Court resolved the issue at the root of the Court's 1918 "hot news" decision in *INS v. AP*; contrary to the rationale behind the *INS* Court's ruling—and many decisions of lower courts since then—a creator's time and efforts (or "sweat of the brow," as such labor has sometimes been described) does *not* provide a basis for an award of copyright protection.<sup>48</sup> The proper focus is on the end product, not the process:

The *sine qua non* of copyright is originality. To qualify for copyright protection, a work must be original to the author . . . . Original, as the term is used in copyright, means only that the work was independently created by the author (as opposed to copied from other works), and that it possesses at least some minimal degree of creativity . . . . To be sure, the requisite level of creativity is extremely low; even a slight amount will suffice. The vast majority of works make the grade quite easily, as they possess some creative spark, "no matter how crude, humble or obvious" it might be . . . . Originality does not signify novelty; a work may be original even though it closely resembles other works so long as the similarity is fortuitous, not the result of copying. To illustrate, assume that two poets, each ignorant of the other, compose identical poems. Neither work is novel, yet both are original and, hence, copyrightable.<sup>49</sup>

---

portions of fashion design during the traditional "substantial similarity" portion of the infringement analysis, discussed in the fourth installment of this series, *On 'Similarity.'*

<sup>47</sup> *Feist*, 499 U.S. at 344. There was no dispute about copying, as defendant's phone book contained false directory listings appearing in plaintiff's book, inserted for the specific purpose of detecting copying. *Id.*

<sup>48</sup> *Id.* at 353 ("The 'sweat of the brow' doctrine had numerous flaws, the most glaring being that it extended copyright protection in a compilation beyond selection and arrangement—the compiler's original contributions—to the facts themselves. Under the doctrine, the only defense to infringement was independent creation. A subsequent compiler was 'not entitled to take one word of information previously published,' but rather had to 'independently wor[k] out the matter for himself, so as to arrive at the same result from the same common sources of information.' . . . 'Sweat of the brow' courts thereby eschewed the most fundamental axiom of copyright law—that no one may copyright facts or ideas.") (internal citation omitted).

<sup>49</sup> *Id.* at 345-46.

Perhaps surprisingly, the Court declared that this “floor” for copyright protection was not merely a question of good public policy, but rather, that “[a]s a constitutional matter, copyright protects only those constituent elements of a work that possess more than a *de minimis* quantum of creativity.”<sup>50</sup>

The *Feist* Court recognized that the originality determination presented greater difficulties where a would-be author alleged that its “selection, coordination, or arrangement” of constituent non-original elements (here, the individual phone-book entries) “render[ed] the work as a whole original.”<sup>51</sup> In such scenarios, “originality” does not require “that facts be presented in an innovative or surprising way”; however, “the selection and arrangement of facts cannot be so mechanical or routine as to require no creativity whatsoever.”<sup>52</sup> Though the “standard of originality is low,” it was not satisfied by the phone book at issue: plaintiff Rural’s final product reflected “insufficient creativity to make it original.”<sup>53</sup> While the factual scenario of alphabetical listings in white pages arguably presents little room for judicial infusion of tacit value judgments into adjudication, other contexts—including various genres of visual art, such as copyright-eligible components of fashion design—raise “originality” issues that can be, and have been, much more easily massaged, twisted, and even distorted by the lower courts.

Some of this “massaging” has been driven by the welcome (and overdue) realization by federal judges that “all creative works draw on the common wellspring that is the public domain.”<sup>54</sup> As one Second Circuit panel noted in a 2014 appeal over the originality of an architectural work: “Every work of art will have some standard elements, which taken in isolation are un-copyrightable, but many works will have original elements—or original arrangements of elements. The challenge in adjudicating copyright cases is not to determine whether a work is a creative work, a derivative work, or a compilation, but to determine what in it originated with the author and what did not.”<sup>55</sup> In fact, the courts have managed quite well to determine what originated with whom; the thornier issues have stemmed from the lack of a systematic and uniform approach to determine the doctrinal consequences of those findings.

---

<sup>50</sup> *Id.* at 363.

<sup>51</sup> *Id.* at 358.

<sup>52</sup> *Id.* at 362-63.

<sup>53</sup> *Id.* at 362-63.

<sup>54</sup> *Tufenkian Imp./Exp. Ventures, Inc. v. Einstein Moomjy, Inc.*, 338 F.3d 127, 132 (2d Cir. 2003) (Calabresi, J.).

<sup>55</sup> *Zalewski v. Cicero Builder Dev., Inc.*, 754 F.3d 95, 104 (2d Cir. 2014).



For example, one Second Circuit panel began its 2003 copyright-infringement analysis of textile designs by parroting the Supreme Court's dictate in *Feist* that independent creative endeavors are the touchstone of "originality," but went on to filter out non-original elements when evaluating similarity.<sup>56</sup> (Indeed, that panel provided a list of "non-original" components that encompassed a good deal more than material not originating with an author-plaintiff.<sup>57</sup>) Just two years earlier, however, a different panel of the same appellate court insisted, in a case concerning quilt designs, that such filtering (or "dissection") was incompatible with *Feist*, but employed a bit of semantic maneuvering to achieve the same outcome under the purported rubric of "total concept and feel."<sup>58</sup> Some courts (and/or panels) have

---

<sup>56</sup> *Tufenkian Imp./Exp.*, 338 F.3d at 135 ("The appellant charges that, in comparing the two designs' total concept and feel, the district court improperly factored out public domain elements from the Heriz and the Bromley . . . [H]owever, the court was surely correct to factor such elements out. For copying is not unlawful if what was copied from the allegedly infringed work was not protected, for example, if the copied material had itself been taken from the public domain. This principle applies, moreover, whether the copied, unprotected expression at issue is a selection, coordination, or arrangement of elements, or whether it is the exact design itself.").

<sup>57</sup> *Id.* at 132 ("In this pool are not only elemental 'raw materials,' like colors, letters, descriptive facts, and the catalogue of standard geometric forms, but also earlier works of art that, due to the passage of time or for other reasons, are no longer copyright protected. Thus the public domain includes, for example, both the generic shape of the letter 'L' and all of the elaborately more specific 'L's' from the hundreds of years of font designs that have fallen into the public domain. *See* *Boisson v. Banian, Ltd*, 273 F.3d 262, 269-71 (2d Cir. 2001)] (considering copyright infringement in 'alphabet quilts,' and treating the letters of the alphabet and the spectrum of colors as belonging to the public domain); *cf.* *Streetwise Maps, Inc. v. Vandam, Inc.*, 159 F.3d 739, 747 (2d Cir. 1998) (refusing to grant copyright protection to 'street locations, landmass, bodies of water and landmarks depicted in a map'); *Folio Impressions, Inc. v. Byer Cal.*, 937 F.2d 759, 763-64 (2d Cir. 1991) (holding that the plaintiff's fabric-design copyright did not encompass a background pattern copied without modification from a public domain textile); *Williams v. Crichton*, 84 F.3d 581, 587 (2d Cir. 1996)] (examining substantial similarity between literary works and excluding 'scenes a faire,' *i.e.*, 'sequences of events that "necessarily result from the choice of a setting or situation,"' from the scope of the plaintiff's protectible [*sic*] expression (quoting *Walker v. Time Life Films, Inc.*, 784 F.2d 44, 50 (2d Cir. 1986))).").

<sup>58</sup> *Boisson v. Banian, Ltd*, 273 F.3d 262, 272 (2d Cir. 2001); *see, e.g., id.* at 270 ("Absent evidence of copying, an author is entitled to copyright protection for an independently produced original work despite its identical nature to a prior work, because it is independent creation, and not novelty that is required.") (citing, *inter alia*, *Feist*, 499 U.S. at 345). The *Boisson* court continued, however, to explain that "a 'more refined [infringement] analysis' is required where a plaintiff's work is not 'wholly original,' but rather incorporates elements from the public domain." *Id.* at

provided guidance on appropriate categorical treatment of certain types of works; others have claimed to reject that approach (even as they might effectively adopt it in practice.)<sup>59</sup>

In sum, the textual-compilation fact pattern of *Feist*, its awkward applicability to many or even most visual material, its apparent irreconcilability with common judicial intuitions about the merit of particular works, and the Supreme Court's choice not to revisit the contours of the "originality" standard since 1991 have all contributed to a fractured doctrinal landscape in which courts can quite easily, and have not infrequently, invoked "originality"—in one form or another—to hold even potentially copyright-eligible (*i.e.*, non-"useful") components of fashion design not protected in the first instance and/or not *unlawfully* copied by defendants.

---

272. Specifically, "[i]n these instances, '[w]hat must be shown is substantial similarity between those elements, and only those elements, that provide copyrightability to the allegedly infringed compilation.'" *Id.* (internal citations omitted). The *Boisson* court warned against "dissecting" the works at issue "into separate components," noting that "[t]he outcome—affording no copyright protection to an original compilation of unprotectible elements—would be contrary to the Supreme Court's holding in *Feist Publications*." *Id.* However, the court's articulation of the doctrinal significance of the presence of non-original components in a work—that those components might render "the total concept and overall feel created by the two works [not] substantially similar," would appear to be little more than an alternative (and somewhat nonsensical) avenue for finding a lack of originality. *Id.*

<sup>59</sup> See *Intervest Const., Inc. v. Canterbury Estate Homes, Inc.*, 554 F.3d 914, 919 (11th Cir. 2008) (architectural works, as a class, are best treated as "compilations"); cf. *Zalewski*, 754 F.3d at 103-04 ("While we agree with the outcome in *Intervest*, we disagree with its reasoning. 'Creative,' 'derivative,' and 'compiled' may be useful concepts in some cases, but we reject the idea that works always fall neatly into one of these categories. Every kind of work at some level is a compilation, an arrangement of uncopyrightable "common elements." . . . No individual word is copyrightable, but the arrangement of words into a book is. No color is copyrightable, but the arrangement of colors on canvas is. Likewise, doors and walls are not copyrightable, but their arrangement in a building is. Some architectural designs, like that of a single-room log cabin, will consist solely of standard features arranged in standard ways; others, like the Guggenheim, will include standard features, but also present something entirely new. Architecture, in this regard, is like every art form.") (internal citations omitted.). Various Second Circuit decisions suggest that, with regard to certain components of fashion design—and certain other types of works—a genre-based classification for the court's "originality" analysis amounts to something like a *per se* rule. See *infra* Section heading?.

a. *Applying “Originality” Requirement to Presumptively Copyright-Eligible Works of Fashion Design*

In applying *Feist* and its progeny to potentially copyright-eligible works of fashion design, presiding judges must graft doctrine primarily intended for application to textual works onto the seemingly disparate subject matter of “pictorial, graphic, or sculptural works.”<sup>60</sup> Of course, this is also true of litigation concerning painting and sculpture. Yet the additional complications of the art-design distinction (previously discussed), compounded by the purportedly “imitative” nature of Western fashion as a medium,<sup>61</sup> have provided at least a veneer of plausibility to courts’ idiosyncratic evaluation of the “originality” of such works—even those that have surmounted the “useful article” bar to copyrightability. Indeed, judicial decisions treating even standalone works of fashion design as mere “selections, coordinations, or arrangements”—with repercussions ranging from unclear to distinctly unfavorable—are not uncommon.<sup>62</sup> To a much greater degree

<sup>60</sup> See 17 U.S.C. § 102(a)(5) (2012). See Rebecca Tushnet, *Worth a Thousand Words: The Images of Copyright Law*, 125 HARV. L. REV. 683, 684 (2012) (Copyright “starts with the written word as its model, then tries to fit everything else into the literary mode.”) Cf. Charles E. Colman, *Trademark Law and the Prickly Ambivalence of Post-Parodies*, 163 U. PA. L. REV. ONLINE 11, 54 (2014) (“To try to analyze post-parodic works, like those pictured [earlier in the Essay], through trademark law’s one-dimensional parody doctrine is akin to asking whether a personal diary ‘is persuasive,’ to query whether a wholly abstract sculpture ‘supports fiscal reform,’ or to inquire about the ‘credibility’ of a dessert. In each instance, the questioner attempts to make value judgments about objects whose very nature is alien to the analytical framework used.”)

<sup>61</sup> See *H. W. Gossard Co. v. Neatform Co.*, 143 F. Supp. 139, 140 (S.D.N.Y. 1956) (“[I]t has been said that to invent anything in the way of a new dress design, however temporarily attractive such design may be, [is] almost impossible . . .”). For an especially trenchant take on this “conventional wisdom,” see ANNE HOLLANDER, *SEX AND SUITS* 48 (1994) (observing that men have long “been riveted on the feminine scheme of varying the same idea in different ways through time” and that “[t]his has been what is meant by ‘Fashion’ when it is despised as woman’s business”).

<sup>62</sup> See, e.g., *George S. Chen Corp. v. Codona Int’l*, 266 F. App’x 523, 524 (9th Cir. 2008) (unpublished) (“GSC contends that its moon/star ornament had “subtle differences” from the prior art of such ornaments, but nowhere said what those differences may be. It is thus impossible to tell whether the differences, if any, are “more than a ‘merely trivial’ variation, something recognizably ‘his own.’”). For a discussion of reasons for the potential manipulability of the *Feist* standard, see Elizabeth F. Judge & Daniel Gervais, *Of Silos and Constellations: Comparing Notions of Originality in Copyright Law*, 27 CARDOZO ARTS & ENT. L. J. 375, 408, 402-03 (2009) (“While the policy underpinnings of *Feist* seemed fairly clear, its definition

than in most other factual contexts, judicial analysis of the originality of works of fashion design tends to reflect an assumption that the material in dispute is (to coin a term to which we will return later in this Article) *constructively derivative*.<sup>63</sup> With that said, the outcomes of judicial evaluations of “originality” in fashion design have not been uniformly unfavorable; indeed, they have waxed and waned in conjunction with, among other factors, notable judicial decisions, broader cultural trends, and changes in prevailing legal and business practices.<sup>64</sup> It is possible to identify, at least tentatively, points at which the tide has gently shifted, then shifted again, in the federal courts’ originality determinations concerning fashion design. That is the task to which we will now turn our attention.

*b. The “Originality Pendulum”*

For the reasons identified in the previous Section, courts’ rulings on the originality of works of fashion design have been inconsistent; nevertheless, examination of the relevant judicial decisions does reveal general trends. In the sixty-plus years since the Supreme Court’s ruling in *Mazer v. Stein*,<sup>65</sup> judicial treatment of the copyrightability for fashion articles by American federal judges has reflected a gradual oscillation—in something of a *sine* wave—between more stringent and more relaxed approaches to determining the “originality” of fashion-design works. At its lowest ebb, the require-

---

of originality as being the result of a modicum of creativity posed two problems. One is quantitative in nature: what is a modicum? The other is qualitative: how does one decide what is ‘creative’? . . . [The *Feist* standard turns out to be] difficult to operationalize, especially in borderline cases such as factual or collective works.”)

<sup>63</sup> See, e.g., *Yurman Design, Inc. v. PAJ, Inc.*, 262 F.3d 101, 109 (2d Cir. 2001) (“The same principles apply to ‘derivative work[s],’ which are ‘based upon one or more preexisting works.’ 17 U.S.C. § 101. Jewelry designs have been viewed as fitting within this latter category.”); *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 741 (9th Cir. 1971) (“It seems unrealistic to suppose that defendants could have closed their minds to plaintiff’s highly successful jeweled bee pin as they designed their own.”)

<sup>64</sup> See generally Colman, *supra* note 60 (containing brief history of Western fashion design since the 1960s, presented with an eye toward ramifications for trademark law). The term “constructively derivative” does not denote an established doctrine in U.S. copyright law; however, I find it to be a useful concept for capturing judicial reasoning that either inadvertently or deliberately imposes unusually stringent bars to eligibility, perhaps inspired by or simply reminiscent of patent-law principles. See discussion *supra* at text accompanying note 18 (discussing “natural phenomena,” prior-art, and obviousness bars to patentability, and judicial implementation thereof in copyright disputes via the “idea-expression” distinction).

<sup>65</sup> 347 U.S. 201 (1954).

ment of originality has resembled the standard articulated in *Feist*, so that virtually any feature attributable to the judgment of an author-designer would support a finding of originality. At its highest point, multiple federal courts have chafed at the prospect of upholding copyright protection for (even separable components of) many works of fashion design.

The movement of what will be described here as U.S. copyright law's "originality pendulum" suggests a plausible division into four phases<sup>66</sup>: (1) an initial period, beginning with the Supreme Court's 1954 recognition of the potential copyrightability of separable components of useful articles in *Mazer v. Stein*<sup>67</sup> and continuing until the Second Circuit's 1976 decision in *L. Batlin & Son, Inc. v. Snyder*<sup>68</sup>; (2) a second period lasting from *Batlin* until the Supreme Court's 1991 decision in *Feist*<sup>69</sup>; (3) a third period, beginning with *Feist* and continuing until the early 2000s; and (4) the most recent period, starting from roughly the early 2000s and arguably lasting through the present. The current phase does not closely track a single, landmark court ruling; it might reflect, in part, the popular defense strategy of invoking the "idea-expression" distinction *as part of* the "originality" analysis—an analytical approach that first appeared long before the early 2000s, but has been pressed with increased frequency and vigor in recent years.<sup>70</sup>

---

<sup>66</sup> A complex relationship exists between the adjudication of "landmark" cases and sociocultural developments. See generally Colman, *Design and Deviance*, *supra* note 3. However, for present purposes, each period will be demarcated here by precedent rather than through the identification of more diffuse cultural circumstances that likely contributed to the decisions in question. See *discussion at A Strange Centennial*, *supra* note 1 at \_\_\_\_ ("[T]he primary purpose of this series is not to map the complex array of social, cultural, and cognitive factors that have shaped current intellectual-property doctrine pertaining to fashion design—I have tackled such questions more directly and thoroughly in other scholarship—but rather to examine what that doctrine is.") (internal citations omitted.).

<sup>67</sup> *Mazer*, 347 U.S. at 211-13 (1954).

<sup>68</sup> 536 F.2d 486 (2d Cir. 1976).

<sup>69</sup> *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.* 499 U.S. 340 (1991). See Tufenkian Imp./Exp. Ventures, Inc. v. Einstein Moomjy, Inc., 338 F.3d 127, 132 (2d Cir. 2003) (characterizing *Feist* as the most prominent decision in the "rather lenient caselaw on the originality requirement").

<sup>70</sup> See, e.g., *Mannion v. Coors Brewing Co.*, 377 F. Supp.2d 444, 458-59 (S.D.N.Y. 2005) (addressing defendant's argument that plaintiff was entitled to little, if any, copyright protection for his photograph because of the idea-expression distinction, and noting the conceptual difficulty of applying the idea-expression distinction to visual, as opposed to literary, works); *Angela Adams Licensing, LLC v. Surya Carpet, Inc.*, No. 07-77-P-H, 2008 WL 686868, at \*7-\*8 (D. Me. Mar. 10, 2008) (analyzing defendant's argument and proffered case law in support of contention that plaintiff's textile pattern was minimally original and thus merited little, if any, protection).

## i. Cases from 1954 to mid-1976

During the initial period of the originality pendulum's movement, the quantum of originality required of even fashion-design works was generally characterized as "very modest"<sup>71</sup>; nothing more than a "faint trace of originality" would support copyright protection.<sup>72</sup> Perhaps notably, however, this very low bar appears to have been set in 1951, *before* the Supreme Court brought works of applied art into the copyright fold. In that case, *Alfred Bell & Co. v. Catalda Fine Arts*, the Second Circuit found both "original" and copyrightable a series of "mezzotints" that were mere reproductions (albeit laborious, time-consuming reproductions) of paintings in the public domain.<sup>73</sup> The court explained that while "inventive genius" was required to support the validity of a *patent*, mere "originality"—meaning little or nothing more than "owing its origin to the author"—was sufficient to sustain a copyright.<sup>74</sup> The Second Circuit highlighted various decisions invali-

<sup>71</sup> *Peter Pan Fabrics v. Dan River Mills*, 295 F. Supp. 1366, 1368 (S.D.N.Y.), *aff'd*, 415 F.2d 1007 (2d Cir. 1969); *see also* *Thomas Wilson & Co. v. Irving J. Dorfman Co.*, 433 F.2d 409, 411 (2d Cir. 1970) (describing then-prevailing originality standard as "modest at best").

<sup>72</sup> *Dan Kasoff, Inc. v. Novelty Jewelry Co., Inc.*, 309 F.2d 745, 746 (2d Cir. 1962).

<sup>73</sup> *Alfred Bell & Co. v. Catalda Fine Arts*, 191 F.2d 99, 104 (2d Cir. 1951) ("Not only does the [Copyright Act of 1909] include 'Reproductions of a work or art', but- while prohibiting a copyright of 'the original text of any work . . . in the public domain' - it explicitly provides for the copyrighting of 'translations, or other versions of works in the public domain'. The mezzotints were such 'versions.' They 'originated' with those who make them, and- on the trial judge's findings well supported by the evidence- amply met the standards imposed by the Constitution and the statute.") (internal citations omitted.).

<sup>74</sup> *Id.* at 100-02 ("[P]ointing to the Supreme Court's consequent requirement that, to be valid, a patent must disclose a high degree of uniqueness, ingenuity and inventiveness, the defendants assert that the same requirement constitutionally governs copyrights . . . . [However, the 1790] legislators peculiarly familiar with the purpose of the Constitutional grant by statute, imposed far less exacting standards in the case of copyrights. They authorized the copyrighting of a mere map which, patently, calls for no considerable uniqueness. They exacted far more from an inventor. And, while they demanded that an official should be satisfied as to the character of an invention before a patent issued, they made no such demand in respect of a copyright . . . . Accordingly, the Constitution, as so interpreted, recognizes that the standards for patents and copyrights are [fundamentally] different. The defendants' contention apparently results from the ambiguity of the word 'original'. It may mean startling, novel or unusual, a marked departure from the past. Obviously this is not what is meant when one speaks of 'the original package,' or the 'original bill,' or (in connection with the 'best evidence' rule) an 'original' document; none of those things is highly unusual in creativeness. 'Original' in reference to a copyrighted

dating design-patent protection for works of fashion design, which “neatly illustrated” the higher degree of novelty that the *Bell* copyright-infringement plaintiff need not demonstrate; the court then added, for indeterminate reasons, that designs were not copyrightable (a proposition already clear from the case law.)<sup>75</sup>

After the Supreme Court gave its imprimatur to copyright protection for separable components of industrial design in 1954, however, the “originality” requirement, as articulated in *Alfred Bell*, produced a string of cases during a roughly fifteen-year period in which designer-plaintiffs went largely undefeated on the issues of both copyrightability and originality. Published fashion-related decisions from this period mostly address fabric designs and lace, with an occasional opinion concerning jewelry. *Millworth Converting Corp. v. Slifka* is representative of the rulings from this period.<sup>76</sup> There, a plaintiff sought copyright protection for two variations on a fabric pattern designed to imitate the appearance of embroidery. The defendant highlighted that the plaintiff’s pattern was derived from a preexisting embroidered pattern, but the Second Circuit deemed this fact irrelevant to the originality determination, ruling for the plaintiff:

Defendants do not dispute that the ‘Schiffli’ embroidered design was a ‘work of art,’ 17 U.S.C. 5(h), *Mazer v. Stein*, [347 U.S. 201 (1954)]. Their principal argument both in the District Court and here was that, despite

---

work means that the particular work ‘owes its origin’ to the ‘author.’ No large measure of novelty is necessary.” (Internal citations omitted.)

<sup>75</sup> *Id.* at 104. One might argue either that the court felt compelled to reiterate that designs were not copyright notwithstanding the Copyright Office’s 1949 regulation anticipating (and influencing) the Supreme Court’s 1954 ruling in *Mazer v. Stein* by allowing the registration of certain separable artistic components of industrial design—see discussion at *A Strange Centennial*—and/or that the Second Circuit was further cementing a point that its judges apparently felt could not be made emphatically enough. See, e.g., *White v. Leanore Frocks, Inc.*, 120 F.2d 113, 114-15 (2d Cir. 1941) (*per curiam*) (“We were told at the bar that this appeal has been taken to clear up doubts remaining after the decision of the Supreme Court in *Fashion Originator’s Guild v. Federal Trade Commission*, 312 U.S. 457 . . . ; *it is the latest, and presumably the last, effort of dress designers to get some protection against what they call the ‘piracy’ of their designs.* We fear that their hope will prove illusory; there is little chance that valid design patents can be procured in any such number as to answer their demand. What they need is rather a statute which will protect them against the plagiarism of their designs; a more limited protection and for that reason easier to obtain *if the law recognized copyright in the subject matter at all.* Recourse to the courts, as the law now stands, is not likely to help them. Perhaps, *if their grievance is as great as they say*, Congress may yet be moved to help them; but *short of that, no effective remedy seems open.*”) (emphasis added.)

<sup>76</sup> 276 F.2d 443 (2d Cir. 1960).

this, plaintiff's copyright was invalid . . . [because] the embroidered design was in the public domain and, as defendants alleged, plaintiff's reproduction contained no element of originality. We think Judge Dawson correctly held defendants' attack on the validity of the copyrights to be foreclosed by the principle enunciated in *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, which upheld copyrights on mezzotint reproductions of paintings that were in the public domain . . . Here plaintiff offered substantial evidence that its creation of a three-dimensional effect, giving something of the impression of embroidery on a flat fabric, required effort and skill. Although others may have done the same with respect to other 'Schiffliis,' plaintiff's contribution to its reproduction of this design sufficed to meet the modest requirement made of a copyright proprietor 'that his work contains some substantial, not merely trivial, originality.'<sup>77</sup>

Another Second Circuit decision capturing the tenor of this phase in the oscillation of the originality pendulum is *Peter Pan Fabrics, Inc. v. Dixon Textile Corp.*, where the court decisively rejected a non-originality defense for similar reasons:

The plaintiffs had engaged a Parisian designer to design from rough sketches furnished him a design Byzantine in motif. This design plaintiffs registered as a reproduction of a work of art under 17 U.S.C. § 5(h) . . . . The design was printed on goods with the copyright notice repeated on the selvaige every 19 inches, and the goods were sold to dress manufacturers. While the basis of the sketches appears to have been suggested by or perhaps taken faithfully from ancient art forms, their incorporation into a combined design by the Parisian designer is clearly sufficiently original to satisfy the originality requirement of the copyright law. See *Alfred Bell & Co., Ltd. v. Catalda Fine Arts Inc.* Originality, not novelty, is the test. [Citation omitted.] There was no genuine issue as to any facts material to the question of originality.<sup>78</sup>

Similarly, in the 1963 appeal in *H. M. Kolbe Co. v. Armigus Textile Company*, the Second Circuit found originality in a plaintiff's relatively simple textile pattern, notwithstanding its concededly non-original components: "The 'work' or 'reproduction of a work of art' which [plaintiff] sought to copyright was not merely the single rose square from which its textile design was created. It was rather the composite design itself, which depends for its aesthetic effect upon both the rose figure and the manner in which the reproductions of that figure are arranged in relation to each other upon the fabric. We find no error in the determination below that the work, as thus construed, was sufficiently original for copyright protection . . . . [W]e find

---

<sup>77</sup> *Id.* at 444-45 (citing *Chamberlin v. Uris Sales Corp.*, 150 F.2d 512, 513 (2d Cir. 1945)).

<sup>78</sup> 280 F.2d 800, 802 (2d Cir. 1960) (internal citations omitted).



no authority for the proposition that every element of an original work must itself bear the marks of originality.”<sup>79</sup>

After a few years of decisions like *Millworth*, *Dixon*, and *Kolbe*, many defendants in copyright litigation over fashion design no longer found it sufficiently beneficial to raise non-originality arguments, instead advancing defenses based on “technicalities” like the adequacy of plaintiffs’ copyright notices.<sup>80</sup> But defendants were not the only ones who had become acutely aware of the prevailing originality standard’s utter lack of “bite.” Indeed, in the late 1960s, judges manifestly irked by the prospect of copyright liability for the production of “commonplace” works of applied art took the first tentative steps toward a quasi-systematic ratcheting-up of the originality standard through alternative means. In *Thomas Wilson & Co. v. Irving J. Dorfman*,<sup>81</sup> for example, the court gestured to something like to the notion of “constructively derivative” works:

[B]oth pieces of lace look to the lay observer like rather commonplace pieces of lace, with seemingly commonplace floral designs. Neither design looks like the markings left by intensely creative activity. The plaintiff reports an earlier copyright of its own for an essentially similar ‘style.’ The defendant, upon a full trial, may be able to demonstrate, from the floral designs of others as well as its own, wide usage of such basically comparable patterns. The particular floral arrangement in issue seems to fall within an area—assuming, as the parties do, ‘even the modest originality that the copyright laws require’—where more than ‘substantial similarity’ should be necessary for a finding of infringement.<sup>82</sup>

<sup>79</sup> 315 F.2d 70, 72 (2d Cir. 1963).

<sup>80</sup> See, e.g., *American Fabrics Co. v. Lace Art, Inc.*, 291 F. Supp. 589, 590 (S.D.N.Y. 1968) (defendant relied on purported lack of required copyright notice); accord. *Judscott Handprints, Ltd. v. Washington Wall Paper Co., Inc.*, 377 F. Supp. 1372, 1377 (E.D.N.Y. 1974) (“Defendants attack neither the copyrightability of plaintiff’s design nor the legal sufficiency of its 1969 registration. Instead they argue that the copyright, even if initially valid, was somehow forfeited or abandoned in view of the later sale of improperly noticed infringing Imperial fabric. Defendants assert that the Judscott design entered the public domain when Judscott allowed any Imperial fabric to be sold without a designation of Judscott as the proprietor of the copyright.”). But see *Gardenia Flowers, Inc. v. Joseph Markovits, Inc.*, 280 F. Supp. 776, 781, 783 (S.D.N.Y. 1968) (basing judicial finding of non-originality and non-“creativity” primarily on plaintiff’s admission that it had created his artificial corsages based on traditional works, as well as insufficient notice).

<sup>81</sup> 268 F. Supp. 711 (S.D.N.Y. 1967).

<sup>82</sup> *Id.* at 713 (internal citation omitted; emphasis added). For district-court judges dismayed by the apparently “commonplace” nature of the works before them, some approaches to limiting protection were more viable than others—hinging in part on whether a disgruntled plaintiff appealed to the Second Circuit. See *Condotti Inc. v. Slifka*, 223 F. Supp. 412, 415 (S.D.N.Y. 1963) (“This is not a case

By the early 1970s, a growing number of judges, some of whom had always displayed a certain degree of resistance to the idea of according copyright protection to “garish trinket[s],”<sup>83</sup> had begun to express more emphatically their impatience with both esoteric defenses and the seemingly all-embracing *Alfred Bell* originality standard that defendants tried to work around by invoking defenses grounded in “technicalities.”<sup>84</sup> Some judges were quite explicit in their value judgments; outside the factual context of applied

---

where the copyists infringed the plaintiff’s ‘expression’ of its ideas, as in *Peter Pan Fabrics, Inc. v. Acadia Company*, [173 F. Supp. 292 (S.D.N.Y. 1959), *aff’d sub nom* *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487 (2d Cir. 1960)]; *Peter Pan Fabrics, Inc. v. Candy Frocks, Inc.*, 187 F. Supp. 334, 336 (S.D.N.Y. 1960).”); *cf.* *Concord Fabrics, Inc. v. Marcus Bros. Textile Corp.*, 296 F. Supp. 736, 738 (S.D.N.Y. 1969) (“At worst, what defendant has done here is to use an idea of plaintiff’s . . . . That the usurping of an idea as compared to the usurping of the expression of that idea is [not infringement] is clear.”), *rev’d*, 409 F.2d 1315, 1316 (2d Cir. 1969) (“The designs . . . , while having some differences, give the same general impression on both samples. While the trial court placed great emphasis on the minor differences between the two patterns, we feel that the very nature of these differences only tends to emphasize the extent to which the defendant has deliberately copied from the plaintiff. . . . In sum, a comparison of the samples strongly suggests that defendant copied plaintiff’s basic design, making only minor changes in an effort to avoid the appearance of infringement. The ultimate test in a copyright infringement case of this sort is whether an average lay observer would find a substantial similarity in the designs, recognizing the copy as an appropriation of the copyrighted work.”). Thus, the Second Circuit in *Concord Fabrics* did not engage with the District Court’s articulation of the idea-expression bar to copyright-infringement liability—an approach that would grow in popularity in the years to come. *See discussion supra* at text accompanying notes 14-23; *cf.* Charles E. Colman, *The History and Principles of American Copyright Protection for Fashion Design: On ‘Seperability’ and ‘Similarity’*, 7 HARV. J. SPORTS & ENT. L. (forthcoming 2016).

<sup>83</sup> *Dan Kasoff, Inc. v. Novelty Jewelry Co., Inc.*, 309 F.2d 745, 746 (2d Cir. 1962) (per curiam); *see, e.g., id.* (“Although it might be thought that the invocation of the power of government to protect designs against infringement implied some merit other than a faint trace of ‘originality’, it is now settled beyond question that practically anything novel can be copyrighted. ‘No matter how poor artistically the “author’s” addition, it is enough if it be his own’. *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 103 (2d Cir. 1951).”).

<sup>84</sup> *See, e.g., Herbert Rosenthal Jewelry Corp. v. Grossbardt*, 428 F.2d 551 (2d Cir. 1970) (district court did not abuse its discretion in granting preliminary injunction prohibiting the copying of plaintiff’s jewel-encrusted turtle pin, despite purportedly insufficient copyright notice); *cf.* *Herbert Rosenthal Jewelry Corp. v. Honora Jewelry Co.*, 509 F.2d 64, 65 (2d Cir. 1974) (“The test of copyright infringement is whether the similarity between the products would lead ‘the average lay observer . . . [to] recognize the alleged copy as having been appropriated from the copyrighted work,’ . . . . Applying this test here, the district court concluded that the average layman would not find sufficient similarity in the parties’ particular expres-

art—and specifically, fashion design and other “novelties”—one can find few judicial critiques of the “seemingly commonplace” nature of copyright plaintiffs’ works or the supposed lack of “intensely creative activity” required for their creation.<sup>85</sup>

Nevertheless, through the mid-1970s, most federal judges continued to give works of fashion design the benefit of the doubt concerning both originality<sup>86</sup> and copyrightability more generally.<sup>87</sup> This would change with the “one-two punch” of a forceful *en banc* decision issued by the Second Circuit in April 1976 and, just a few months later, Congress’s rejection of the proposed inclusion of a designated category of fashion-related works in the newly-enacted Copyright Act of 1976.<sup>88</sup>

ii. *Cases from mid-1976 to 1991*

In April 1976, the Second Circuit, sitting *en banc*, issued a decision that effectively served to fling the originality pendulum in the opposite direction, toward greater stringency. In *L. Batlin & Son, Inc. v. Snyder*,<sup>89</sup> a majority of the appellate court reversed a panel’s earlier ruling and held that copyright protection was inappropriate for a plastic novelty bank that reflected only trivial variations from a bank in the public domain. The full court’s majority opinion cited the influential *Nimmer on Copyright* treatise for the proposition that “the mere reproduction of a work of art in a different medium should not constitute the required originality for the reason that no one can claim to have independently evolved any particular medium.”<sup>90</sup>

sions of the idea of a jeweled turtle pin to warrant a finding of infringement. We agree.”).

<sup>85</sup> *Thomas Wilson & Co.*, 268 F. Supp. at 713; see also *Thomas Wilson & Co. v. Irving J. Dorfman Co.*, 433 F.2d 409, 411 (2d Cir. 1970) (“While plaintiff’s lace design is not what the phrase ‘work of art’ ordinarily calls to mind, it possesses more than the ‘faint trace’ of originality required.”). Such rhetoric likely reflects, in part, the same anti-fashion/anti-design bias that had contributed to the marginalization of design-patent protection earlier in the century. That inquiry is largely beyond the scope of this article; for a comprehensive discussion of the operative sociocultural and cognitive dynamics, see Colman, *Design and Deviance*, *supra* note 3.

<sup>86</sup> See, e.g., *Primcot Fabrics, Dep’t of Prismatic Fabrics, Inc. v. Kleinfab Corp.*, 368 F. Supp. 482, 484-85 (S.D.N.Y. 1974).

<sup>87</sup> See *Cynthia Designs, Inc. v. Robert Zentall, Inc.*, 416 F. Supp. 510, 511-12 (S.D.N.Y. 1976).

<sup>88</sup> See discussion at *A Strange Centennial* [insert JSEL cite?].

<sup>89</sup> 536 F.2d 486 (2d Cir. 1976) (*en banc*).

<sup>90</sup> *Id.* at 491. Note that this passage from *Nimmer* endorses a normative position (“*should not constitute*”) on originality. For a critique of the federal courts’ frequent and sometimes distortive reliance on copyright treatises—and *Nimmer*, in particular,

Judge Oakes—who had written the dissenting opinion in the panel’s earlier adjudication of *Batlin* but authored the majority decision here—explained that this stemmed from the principle that “one who has slavishly or mechanically copied from others may not claim to be an author.”<sup>91</sup> In a bit of revisionist history, Judge Oakes’ majority opinion declared: “It has been the law of this circuit for at least 30 years that in order to obtain a copyright . . . the work [must] ‘contain some substantial, not merely trivial originality[.]’”<sup>92</sup> (For this proposition, Judge Oakes cited *Chamberlin v. Uris Sales Corp.*,<sup>93</sup> a decision that was indeed three decades old, but had rarely been cited by the court in the interim—and even then, only *in furtherance of finding the requisite “originality” for copyright protection.*<sup>94</sup>)

---

see Ann Bartow, *The Hegemony of the Copyright Treatise*, 73 U. CIN. L. REV. 581, 591 (2004) (“The Copyright Act is a long and dense body of statutory law. Despite its length and complexity and the wide range of issues it addresses, however, the statute does not answer many questions or create much predictability when disputes about copyrights arise. As a result, judges must either read extensive amounts of copyright case law and distill from it nuanced rules and complicated principles, or they can expediently choose to rely on the formulations that are conveniently and accessibly set out in a treatise, and confidently apply them to the often thorny facts of a particular dispute. The considerable number of citations to the Nimmer copyright treatise suggests it is widespread and commonplace for federal judges to depend on the treatise to articulate and support copyright law decisions.”); *see also id.* at 599 (“Judges who engage in wholesale, unquestioning adoption of any single source of pre-synthesized copyright law, failing to draw on competing theories, will perform ostensibly independent analyses in application of law to fact with hidden and unrecognized but potentially tremendous biases. In the absence of countervailing resources of similar stature, the very existence of a hegemonic treatise potentially prevents the evenly matched battles of policy and doctrine necessary for the emergence of just outcomes.”).

<sup>91</sup> *L. Batlin & Son*, 536 F.2d at 490. Significantly, Judge Oakes’ dissenting opinion in the first round of appellate review of *Batlin* is used to (1) call into question the wisdom of *Mazer v. Stein*’s extension of copyright protection to certain components of industrial-design works; (2) advocate for anchoring copyright’s originality requirement in language from the Supreme Court’s nearly century-old photography case of *Burrow-Giles Lithographic Co. v. Saroni*, 111 U.S. 53, 59-60 (1884), which had stressed the importance of “facts of originality, of intellectual production, of thought, and conception on the part of the author”; and (3) *single out “some of our fabric design cases”* as having “gone far in upholding on an ad hoc basis copyrights of design copies on a ‘minimal quantum of originality. . . .’” *L. Batlin & Son, Inc. v. Snyder*, No. 75-7308, 1975 WL 21412, at \*13, \*14 (2d Cir. Oct. 24, 1975) (Oakes, J., dissenting) (emphasis added).

<sup>92</sup> *L. Batlin & Son*, 536 F.2d at 490.

<sup>93</sup> 150 F.2d 512, 513 (2d Cir. 1945).

<sup>94</sup> *See Thomas Wilson & Co. v. Irving J. Dorfman Co.*, 433 F.2d 409, 411 (2d Cir. 1970). *Uris* had received similar treatment in the Southern District. *See, e.g.,*

Judge Meskill, who had switched places with Judge Oakes from the panel to the *en banc* decisions in *Batlin*, demonstrated that the Second Circuit's recent treatment of the originality requirement differed greatly from the majority's characterization of it.<sup>95</sup> The dissent cited several decisions, including many discussed earlier in this Section, for the notion that copyright protection required only "a faint trace of originality,"<sup>96</sup> a "slight addition" to preexisting material,<sup>97</sup> or mere "effort and skill."<sup>98</sup> At the end of the day, however, the majority's opinion, as an *en banc* decision from the leading "copyright circuit" in the fashion capital of the United States, set a new tone for the judicial analysis of originality—especially after the Supreme Court denied *certiorari* in the case.<sup>99</sup>

Notably, the post-*Batlin* decisions holding works of fashion design to a more stringent originality requirement were also acting against the backdrop of the recent legislative debate concerning the 1976 Copyright Act, which had at one point expressly included certain fashion-related items in its list of eligible works, but ultimately dropped that language from the statute.<sup>100</sup> Between the apparent legislative endorsement of the general exclusion of non-separable components of applied art from copyright protection, the saga of the *Batlin* decisions—which had at one point had dwelled on works of fashion design as an important example of works on the margins

---

Concord Fabrics, Inc. v. Generation Mills, Inc., 328 F.Supp. 1030, 1032 (S.D.N.Y. 1971) ("In the well-ploughed field [of the genre of the 'basic fabric design called "Indian Madras Plaid"'] on which the parties are waging this contest, plaintiff appears to have achieved a sufficiently 'distinguishable variation' . . . to meet the modest requirement made of a copyright proprietor 'that his work contains some substantial, not merely trivial, originality.'") (citing, *inter alia*, *Uris*, 150 F.2d at 513). With that said, the *Generation Mills* court did proceed to rule that plaintiff was not ultimately entitled to relief, based on both the both the "independent creation" bar to infringement liability and an infringement analysis that represents an early implementation of "thin copyright." *Id.* at 1033. ("Thin copyright" is discussed *infra* at text accompanying note 111 *et seq.*; "independent creation" will be addressed in a forthcoming installment, *On 'Similarity.'*)

<sup>95</sup> *L. Batlin & Son*, 536 F.2d at 493 (Meskill, J., dissenting).

<sup>96</sup> *Id.* (quoting *Dan Kasoff, Inc. v. Novelty Jewelry Co.*, 309 F.2d 745, 746 (2d Cir.).

<sup>97</sup> *Id.* (quoting *Peter Pan Fabrics, Inc. v. Dan River Mills, Inc.*, 295 F. Supp. 1366, 1368 (S.D.N.Y. 1969)).

<sup>98</sup> *Id.* (citing *Millworth Converting Corp. v. Slifka*, 276 F.2d 443 (2d Cir. 1960)).

<sup>99</sup> *Snyder v. L. Batlin & Son, Inc.*, 429 U.S. 857 (Oct. 04, 1976).

<sup>100</sup> See discussion at *A Strange Centennial*. [Does the discussion in *Centennial* include the original language that was eventually dropped?] The Copyright Act of 1976 was enacted fifteen days after the Second Circuit's *en banc* ruling in *Batlin*. See Pub. L. No. 94-553, 90 Stat. 2541 (Oct. 19, 1976).

of “originality”—and the post-*Batlin* opportunity for the venting of judicial frustration with their earlier obligation to accord copyright protection to so-called “commonplace” and “trivial” works of fashion design, it is unsurprising that judicial invalidation of copyright in various fashion-related works became a frequent occurrence by the late 1970s. Indeed, these decisions often went beyond the issue of (non-)originality, holding that the fashion items in dispute were not copyright-eligible at all.

Illustrative examples of such decisions are excerpted below, in bullet-point form:

- *SCOA Industries, Inc. v. Famolare, Inc.*, No. 75 Civ. 3357, 1976 U.S. Dist. LEXIS 16663, at \*5-\*7 (S.D.N.Y. Feb. 13, 1976) (emphasis added).<sup>101</sup>

Famolare claims copyright protection for the copied features on the ground that they are “works of art.” 17 U.S.C. § 5(g). What is a “work of art” may require a subjective judgment [though some guidance can be derived from Copyright Office regulations.<sup>102</sup>] . . . It is concluded, in agreement with the Copyright Office, that *the troughs, waves, and lines which appear on the shoe sole cannot be identified and do not exist independently as works of art.* This being the case, Famolare has no claim of valid copyright as to the features of the shoe sole which Scoa has allegedly copied.

- *Past Pluto Productions Corp. v. Dana*, 627 F. Supp. 1435, 1441-42 (S.D.N.Y. 1986) (emphasis added).

*There is nothing at all original, or copyrightable, about seven spikes on a liberty crown.* Plaintiff attempts to lay some claim to originality by pointing out that its spikes are uniform in shape and size, unlike the non-uniform spikes of the Statue of Liberty. *This Court declines, however, to find artistic originality in a design feature composed of elemental symmetry* and prompted

---

<sup>101</sup> Note that the *SCOA* decision was issued after the Second Circuit had agreed to rehear the *Batlin* case *en banc*; it may well have been clear to the lower courts that the appellate court planned to ratchet up a lax originality requirement that *Nimmer on Copyright* had identified as responsible for “ludicrous” results. For a discussion of the crucial role of the (decidedly non-neutral) copyright treatise, see Bartow, *supra* note 90.

<sup>102</sup> At this point, the *SCOA* decision states: “Section 202.10, 37 C.F.R. (1975), provides in relevant part:

“(c) If the sole intrinsic function of an article is its utility, the fact that the article is unique and attractively shaped will not qualify it as a work of art. However, if the shape of a utilitarian article incorporates features, such as artistic sculpture, carving, or pictorial representation, which can be identified separately and are capable of existing independently as a work of art, such features will be eligible for registration.”).

most probably by the promise of convenience in manufacture. . . . Past Pluto's argument that its hat is copyrightable is ultimately reduced to the basic contention that the hat's silhouette window design is sufficiently original to afford plaintiff's hat at least some measure of copyright protection. *{T}his Court declines to find that this design or any of the hat's other features amount to substantial non-trivial originality deserving of protection under the federal copyright laws.*

- *John Muller & Co., Inc. v. New York Arrows Soccer Team, Inc.*, 802 F.2d 989 (8th Cir. 1986) (emphasis added).

The district court granted partial summary judgment for defendants, finding that plaintiff's logo for the New York Arrows was not copyrightable . . . . In order to be copyrightable, a work must show certain minimal levels of creativity and originality . . . . If, as here, the creator seeks to register the item as a "work of art" or "pictorial, graphic or sculptural work, *the work must embody some creative authorship in its delineation or form.*" 37 C.F.R. § 202.10(a) (1985); *Gardenia Flowers, Inc. v. Joseph Markovits, Inc.*, 280 F. Supp. 776, 781 (S.D.N.Y. 1968); 1 M. Nimmer, NIMMER ON COPYRIGHT, § 2.08[B][1] (1985). *There is no simple way to draw the line between "some creative authorship" and not enough creative authorship*, and there are no cases involving "works" exactly like this one . . . . The [Copyright] Register's decisions are subject to judicial review, but only on an abuse of discretion standard. 17 U.S.C. § 701 (1982); 5 U.S.C. § 706(2)(A) (1982)[.] We conclude that the district court's opinion [finding no abuse of discretion in the Register's denial] is correct and well-reasoned, and we affirm on the basis of that opinion.<sup>103</sup>

- *Jon Woods Fashions, Inc. v. Curran*, No. 85 Civ. 3203 (MJL), 1988 U.S. Dist. LEXIS 3319, at \*1, \*7-\*8 (S.D.N.Y. Apr. 19, 1988) (emphasis added).<sup>104</sup>

<sup>103</sup> See also *Brandir Int'l v. Cascade Pacific Lumber*, 834 F.2d 1142, 1146 (2d Cir. 1987) (emphasis added) (rejecting copyrightability of artistic bicycle rack due to lack of "conceptual separability," where Copyright Office had denied registration on the grounds (1) that the design at issue contained no physically or conceptually separable components, and, alternatively, (2) that *the design comprised "nothing more than a familiar public domain symbol" and thus lacked the originality required for copyright protection*). *Brandir* is discussed in *A Strange Centennial* and again in the next installment, *On 'Separability'* [forthcoming 2016].

<sup>104</sup> See discussion at *Paul Morelli Design, Inc. v. Tiffany & Co.*, 200 F. Supp. 2d 482, 485-86 (E.D. Pa. 2002) ("We believe [the approach of giving a Copyright Office denial of registration 'some deference'] strikes the proper balance between a *de novo* review which plaintiff seeks and the heightened abuse of discretion [standard] found in some cases. See *John Muller & Co. v. New York Arrows Soccer Team, Inc.*, 802 F.2d 989, 990 (8th Cir. 1986).").

Plaintiff Jon Woods Fashions, Inc. (“Jon Woods”) is a converter of fabrics. Prior to April 25, 1984, Jon Woods produced a fabric design which it called “Awning Grids.” The design consists of striped cloth over which is superimposed a grid of 3/16[-inch] squares. . . . [When plaintiff applied for a copyright registration, the Copyright] Register twice found that [his geometric fabric design] did not meet the minimal level of creative authorship necessary for copyright. He explained to Jon Woods that *familiar symbols are not proper subjects for copyright protection even where they are ‘distinctively arranged or printed.’* . . . Such a determination is clearly within the discretion afforded the Register by prevailing statutes and case law . . . . Because there is thus no issue of fact as to the propriety of the Register’s denial of copyright to Jon Woods, design, the Register’s motion for summary judgment is granted.

iii. *Cases from 1991 to the early 2000s*

As noted above, the Supreme Court’s 1991 decision in *Feist* endorsed a lax approach to the “originality” requirement.<sup>105</sup> And indeed, fashion-related decisions issued in the decade or so after 1991 reflect a swing of the “originality pendulum” back toward (in the words of the *Feist* Court) a “modicum of creativity” approach to originality.<sup>106</sup> Some illustrative decisions are provided in bullet-point form below:

- *Mulberry Thai Silks, Inc. v. K&K Neckwear*, 897 F. Supp. 789, 791-92 (S.D.N.Y. 1995) (emphasis added).

The basis of K & K’s position is the assertion that *Mulberry’s collection simply reflects geometric elements that are common in the trade*. In substance, then, defendant contests the validity of Mulberry’s copyrights.

To be sure, copyright may subsist only in “original works of authorship.” 17 U.S.C. § 102(a). But *Mulberry’s certificates of registration are prima facie evidence of validity and, therefore, of originality. The burden therefore is on the defendant to prove that the plaintiff’s designs were not original. {Citations omitted.} Moreover, “the originality needed to support a copyright merely calls for independent creation, not novelty”* — it requires only that the copyrighted work

<sup>105</sup> See discussion *supra* at text accompanying note 46 *et seq.*

<sup>106</sup> *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 346 (1991). Of course, this did not occur immediately or everywhere. See *Homer Laughlin China Co. v. Oman*, 1991 U.S. Dist. LEXIS 10680, at \*3 (“The Supreme Court in [*Feist*] noted that ‘the *sine qua non* of copyright is originality’ [and] ‘to be sure, the requisite level of creativity is extremely low; even a slight amount will suffice.’ However, in determining creativity, such a decision necessarily requires the exercise of informed discretion, and the Register, in part due to having to make such determinations on a daily basis, is generally recognized to possess considerable expertise over such matters. .”) (internal citations omitted).



not have been copied [*citing Nimmer.*] To quote Judge Hand again, “If by some magic a man who had never known it were to compose Keats’ Ode On a Grecian Urn, he would be an ‘author,’ and, if he copyrighted it, others might not copy that poem, though they might of course copy Keats [because his work is now in the public domain].” *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49, 54 (2d Cir. 1936). . . .

Here the evidence<sup>107</sup> establishes, and *the Court finds, that each of the seven designs copyrighted by Mulberry was an original creation by Mulberry’s in-house design studio. In consequence, Mulberry’s copyrights are valid, and they were infringed by K & K’s designs.*

- *Prince Group v. MTS Prods.*, 967 F. Supp. 121, 125 (S.D.N.Y. 1997) (emphasis added).

Although the Defendants claim that these polka dots are only a slight variation of a commonplace design, they offer no expert evidence to support that claim. There must be more than the Defendants’ meager claim to support the invalidity of the Plaintiff’s copyright. *In Design [v. Lynch Knitting Mills, Inc.]*, 689 F. Supp. 176, 179 (S.D.N.Y.), *aff’d* 863 F.2d 45 (2d Cir. 1988)] (the court determined the contention of the defendant’s expert witness that the argyle pattern in question was a mere variation of a standard argyle pattern was insufficient to show that the plaintiff’s copyright was invalid). The polka dots in this case are more than average circles. First, they are irregularly shaped, and not the perfect circles of a standard polka dot. They are ‘shaded,’ that is, there is a crescent of white around half of the perimeter of each of the dots which is different from the standard uniformly colored polka dot, and they consist of several different colors. Thus, *the shape and the shading of the dots are sufficiently original to meet the threshold of creativity.*

- *C&F Enterprises, Inc. v. Barringtons, Inc.*, Civ. Action No. 96-1108-A, 1997 U.S. Dist. LEXIS 14054, at \*10-\*11 (E.D. Va. May 13, 1997) (emphasis added).

Defendants’ second argument focuses on the creation of the underlying paper artwork for the seven needle-point stockings . . . . Courts have said that in the copyright context the standard for originality of a compilation

---

<sup>107</sup> This “evidence” was not specified in the opinion, nor did the Court expressly rely on the defendant’s failure to rebut the plaintiff’s “presumption of validity” in support of its copyrightability ruling. *See discussion infra.* Indeed, the language employed by the court (“the Court finds, that each of the seven designs copyrighted by Mulberry was an original creation by Mulberry’s in-house design studio [and] [i]n consequence, Mulberry’s copyrights are valid”) suggests that in this case—in stark contrast to many of the other decisions cited in this Article—the court deemed the mere fact of actual authorship (at least, if accompanied by registration) sufficient for a finding of “originality.”

or derivative work is ‘minimal,’ ‘of a low threshold,’ and ‘modest at best.’ This requirement is satisfied if the new material or expression has a ‘faint trace of originality’ and if it provides a ‘distinguishable variation.’ [*M. Kramer Manufacturing Co. v. Andrews*, 783 F.2d 421, 438 (4th Cir. 1986)] (citations omitted). *The court finds that the needlepoint adaptations by Carol Fang, contributing as they did the ‘translation’ into a different medium, satisfy this low standard of originality such that plaintiff’s copyrights in the needlepoint stockings are valid even though plaintiff may not have initially owned copyrights in the underlying artwork for the three works created by Kearney.* [Footnote omitted.] See, e.g., *Millworth Converting Corporation v. Slifka*, 276 F.2d 443, 445 (2d Cir. 1960) (Friendly, J.) (embroidered design that was in the public domain could be photo-graphed and transferred into a printed form on dress fabric and the resulting flat printed design copyrighted in view of the modest requirement made of a copyright proprietor that it possess only some minimal degree of creativity or ‘distinguishable variation’).

*iv. Cases from the early 2000s to present*

In the past decade, *Feist* notwithstanding, dismissals of copyright plaintiffs’ claims based on the purported non-originality of fashion-related works have once again started to appear with some frequency—particularly (though not exclusively) where the Copyright Office has already rebuffed a plaintiff’s efforts to secure a registration:<sup>108</sup>

- *Coach, Inc. v. Peters*, 386 F. Supp. 2d 495, 498-99 (S.D.N.Y. 2005) (emphasis added).

Having determined that the works were essentially arrangements of the letter “C,” defendant [the Register of Copyrights] noted that letters, mere variations of letters, and familiar symbols cannot be copyrighted. A.R. 1, Ex. 1 at 3-4 (citing 37 C.F.R. § 202.1(a) and *Compendium of Copyright Office*

<sup>108</sup> Note that the nature of the originality determination will differ depending on the type of proceeding in which the issue is raised. See *Darden v. Peters*, 488 F.3d 277, 285 (4th Cir. 2007) (“Congress has afforded disappointed copyright applicants two separate methods of seeking redress for the decision of the Copyright Office not to register a copyright claim. First, . . . the applicant may file a review action under the APA against the Register of Copyrights for the sole purpose of having the denial of registration set aside. See 17 U.S.C. §§ 410(a), 701(e) . . . . Second, the claimant may seek judicial review of the rejected registration as part of an infringement action against an alleged infringer under section 411(a) of the Copyright Act.”). Alternatively, the unsuccessful applicant may decide not to challenge the Register’s decision directly, but rather proceed to sue infringers and confront the issue at that point. The way that course of events will play out is arguably less predictable. See *id.* at 286 (“[I]t is not a foregone conclusion that courts owe no deference whatsoever to the Register’s decision [regarding lack of originality] in the context of an infringement action under section 411(a). Indeed, courts are split on this issue.”).

*Practices, Compendium II*, § 503.02(a). [Footnote omitted.] Defendant cited a number of cases which held that simple arrangements of such items are similarly uncopyrightable[.] [Ed. Most of the cited cases post-date *Batlin* but pre-date *Feist*.] [D]efendant concluded not simply that the letter ‘C’ is not copyrightable, but that “the elements embodied in this work, individually, and in their particular combination and arrangement, simply do not contain a sufficient amount of original and creative authorship to be copyrightable.” [Citation omitted.] [P]LAINTIFFS HAVE FAILED TO OVERCOME THE SUBSTANTIAL DEFERENCE THAT THIS COURT MUST AFFORD DEFENDANT’S DECISION DENYING REGISTRATION OF THE WORKS BECAUSE PLAINTIFFS HAVE NOT SHOWN THAT DEFENDANT ACTED ARBITRARILY AND CAPRICIOUSLY.

- ***Royal Printex, Inc. v. Unicolors, Inc.***, No. CV 07-05395-VBK, 2009 U.S. Dist. LEXIS 60375, at \*5-\*6, \*9-\*10 (C.D. Cal. Jul. 8, 2009) (emphasis added).

The design of the flower in . . . the daisy design is of a six-petaled daisy flower, with a center round pistil, a short stem, and a small leaf emanating from that stem. The six petals, the stem, and the small leaf are each shadowed, and the resulting flower in both designs repeats in a manner in which the stems are turned at different angles to each other, and the flowers are relatively equidistant from each other. The background in each of the designs is a generic polka-dot (“polka-dot”) pattern. The predominant part of the overall design of both the daisy design and the flower design consists of the actual flowers depicted in the design, and the placement of the flowers in a repetitive pattern. . . .

[It is true that the] requisite originality for copyright protection can also be found in the combination of unoriginal (and therefore uncopyrightable) elements. *{However, the} daisy design in this case does not possess at least the requisite minimum degree of creativity to qualify as an original design which is copyrightable.* In the daisy design, the actual flowers, and their repetition throughout the design, constitute the predominant design elements. Neither the flowers, nor their repetitive placement, were independently created by Unicolors. *The deletion of the ticking stripe background from the forties flower design, and the insertion of generic polka-dots, does not constitute the requisite originality required for a design to be copyrightable.*

- ***Express, LLC v. Forever 21, Inc.***, No. CV 09-4514 ODW-VBKx, 2010 U.S. Dist. LEXIS 91705, \*17-\*18, \*20, \*21 (C.D. Cal. Sep. 2, 2010) (emphasis added).

At best, [plaintiff’s designer Michael] Tower was able to recall that he “colored-up” [earlier] Plaids with certain colors Express selected for its seasonal clothing line. Tower Deposition at 54-56. However, as Tower testified that he has no recollection of the original plaid designs, let alone knowledge of how they were originally colored, Express cannot produce

any evidence at trial of what color substitutions Tower may have made. Thus, the mere fact that Tower claims he “colored-up” the Plaids does nothing to cure the utter lack of evidence upon which a juror could reasonably conclude that any of the Plaids contains content original to Express. . . . [E]ven if Tower could recall that he made particular color substitutions, *mere changes in color are generally not subject to copyright protection*. 37 C.F.R. § 202.1 ([E]xamples of works not subject to copyright [include] mere variations of . . . color’).<sup>109</sup> *{E}ven if Express’s copyright registration{s} are entitled to presumptive effect, Defendants have rebutted that presumption by producing Tower’s deposition testimony [and] the Court grants summary judgment in favor of each Defendant with respect to Express’s claims for copyright infringement.*<sup>110</sup>

It is difficult to make predictions with any degree of certainty about where the law of “originality” for fashion-related works might be headed in the coming years. However, the question might be largely academic, as it has become common practice for courts to handle what are essentially originality concerns through alternative doctrinal vehicles like the idea-expression distinction (discussed above), various “filtering” techniques applied during the infringement analysis (discussed in a forthcoming installment, *On ‘Similarity’*), and in particular, an essentially formalized filtering technique that has proven influential—even dispositive—in many copyright-infringement disputes over works of fashion design: the notion of “thin copyright,” to which we now turn our attention.

*c. The Provenance and Contours of “Thin Copyright”*

In the context of fashion articles, in particular, a threshold finding of “originality” often represents little more than a tentative conclusion that the article in question has not been wholly *disqualified* from copyright protection. More than in almost any other corner of copyright jurisprudence, such a ruling provides little guidance regarding the *scope* of protection that a work of fashion design will ultimately enjoy. That fate hinges to a substan-

<sup>109</sup> *But see* *Boisson v. Banian Ltd.*, 273 F.3d 262, 271 (2d Cir. 2001) (“Color by itself is not subject to copyright protection. *See* 37 C.F.R. § 202.1(a). Nevertheless, ‘an original combination or arrangement of colors should be regarded as an artistic creation capable of copyright protection.’ [*Nimmer.*] . . . [The case law] teach[es] that even though a particular color is not copyrightable, the author’s choice in incorporating color with other elements may be copyrighted. . . . [This] leads us to conclude it was clear error for the district court to find that plaintiffs’ choice of colors in the ‘School Days’ quilts was an unprotectible element.”).

<sup>110</sup> For further discussion of the “presumption of validity” accorded to a copyright registrant, *see infra*.

tial degree on whether presiding courts invoke the notion of “thin copyright.”

Most IP practitioners, if asked to define the term “thin copyright,” would likely first jump to the notion that copyright protection in the arrangement and compilation of factual material is protected only from exact, or near-exact, copying. This is indeed one iteration of the “thin copyright” principle, which has been refined in the wake of *Feist* for works that do make the grade when it comes to originality, but only by a hair.<sup>111</sup> The terminology used appears to have been inspired by the *Feist* Court’s remark that “facts themselves do not become original through association” and “[t]his inevitably means that the copyright in a factual compilation is *thin*.”<sup>112</sup>

It is important to note, however, that this approach to the adjudication of “composite” works neither originated in *Feist* nor has been limited to the “protection for the expression of facts” context.<sup>113</sup> Indeed, textiles have often been a key site for the application of “thin copyright.” Consider, for example, the Second Circuit’s 2001 decision in the copyright case of *Boisson v. Banian, Ltd.*,<sup>114</sup> which concerned the alleged infringement of quilt designs that contained some elements that were “original” to the author and other elements that were not. The Second Circuit explained:

If a work is not original, then it is unprotectible. Likewise an element within a work may be unprotectible even if other elements, or the work as a whole, warrant protection. Some material is unprotectible because it is in the public domain, which means that it “is free for the taking and cannot be appropriated by a single author even though it is included in a copyrighted work.”<sup>115</sup>

(For this principle, the Second Circuit cited a 1992 software-related copyright decision,<sup>116</sup> which in turn cited various pre-*Feist* decisions applying the doctrine of “*scènes à faire*”<sup>117</sup>—the principle that no single author can claim

---

<sup>111</sup> See *Feist*, 499 U.S. at 350-51 (copyrightability of “the particular selection or arrangement” of facts is limited, and “[i]n no event may copyright extend to the facts themselves”).

<sup>112</sup> *Id.* at 349 (emphasis added).

<sup>113</sup> *Id.* at 348.

<sup>114</sup> 273 F.3d 262, 269-70 (2d Cir. 2001).

<sup>115</sup> *Id.* at 268-69 (quoting *Computer Associates Int’l, Inc. v. Altai, Inc.*, 982 F.2d 693, 710 (2d Cir. 1992)).

<sup>116</sup> See *Computer Associates Int’l, Inc. v. Altai, Inc.*, 982 F.2d 693, 710 (2d Cir. 1992)).

<sup>117</sup> See *id.* (citing, *inter alia*, *Plains Cotton Co-op. Ass’n of Lubbock, Texas v. Goodpasture Computer Service, Inc.*, 807 F.2d 1256, 1262 (5th Cir. 1987)).

exclusive rights over material that is “indispensable, or at least standard, in the treatment of” a subject.<sup>118</sup>)

There appear to be at least three iterations of the “thin copyright” doctrine: (1) the notion articulated by the Supreme Court in *Feist* that one claiming copyright in a collection or arrangement of facts can assert protection only in the manner of expression of those facts; (2) the notion that only “thin copyright” is accorded to visual works incorporating material *not* original to the author; and (3) the notion that “thin copyright” applies even where an entire work *is* original, but contains elements that (though “originating” with the author in the manner described by the *Feist* Court) are common, imitative of nature, a mere “idea,” or required for/typical of the medium in question.

Courts have differed not only in their choices of which version(s) of “thin copyright” to recognize, but also in their application of the doctrine and the consequences of that application. Nearly across the board, however, judicial invocation of “thin copyright” is associated with the substitution of a more demanding infringement inquiry<sup>119</sup> than the conventional “substantial similarity.” Indeed, the doctrine is arguably little more than a “filtering” doctrine<sup>120</sup> in copyright-eligibility’s clothing. In this respect, the notion of “thin copyright” is reminiscent of many cases on the idea-expression distinction reviewed earlier in this Article. (Indeed, the triggers for the

---

<sup>118</sup> *Id.* at 709 (quoting *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972, 979 (2d Cir. 1980)).

<sup>119</sup> See e.g., *Beaudin v. Ben & Jerry’s Homemade, Inc.*, 95 F.3d 1, 2 (2d Cir. 1996) (reasoning that “where the quantum of originality is slight and the resulting copyright is ‘thin,’ infringement will be established only by very close copying because the majority of work is unprotectable”).

<sup>120</sup> The issue of “filtering” is, to be sure, not limited to the “thin copyright” context: courts are in disarray concerning the amount of “dissection” or “extraction” that should occur during this type of infringement analysis, even outside of the fashion-design context. Compare *DiTocco v. Riordan*, 496 F. App’x 126, 128 (2d Cir. 2012) (emphasis added) (“Where, as here, we are comparing subject matter that contains both protectible and unprotectible elements, we apply the ‘more discerning’ ordinary observer test to determine substantial similarity: ‘we must attempt to extract the unprotectible elements from our consideration and ask whether the protectible elements, standing alone, are substantially similar.’”) (emphasis omitted) (internal citations omitted) *with* *Cameron Indus. v. Mother’s Work, Inc.*, 338 F. App’x 69, 70 (2d Cir. 2009) (“We have declined, however, to ‘dissect [designs] into their separate components[ ] and compare only those elements which are in themselves copyrightable,’ noting that taking this approach to its logical conclusion could lead to a decision that ‘there can be no originality in a painting because all colors of paint have been used somewhere in the past.’”) (internal citations omitted).

judicial application of “thin copyright” and the idea-expression distinction overlap substantially.)

On rare occasions, appellate courts have chided district courts for having “applied a test that erroneously mingled the standard for sufficient originality and the test for infringement.”<sup>121</sup> But a review of the case law on “thin copyright,” particularly in the realm of fashion design, shows that such “mingling” is not the exception, but the rule.<sup>122</sup>

The impetus for the recognition of “thin copyright” protection in the fashion-design context can be traced at least as far back as the post-*Mazer v. Stein* wave of 1960s copyright-recognition-for-fashion-design-cases.<sup>123</sup> But “thin copyright” in its current iteration is most directly traced to a Second Circuit decision issued in 1991 (just a few months after the Supreme Court handed down its detailed guidance on copyright law’s “originality” requirement in *Feist*, which, on its own, suggested a possible return to the state of affairs in the 1960s, when any and all fashion seemed copyrightable.)

In that case, *Folio Impressions, Inc. v. Byer California*,<sup>124</sup> a copyright owner had sued over the alleged infringement of, *inter alia*, a design consisting of images of roses “placed in straight lines and turned so that the roses faced in various directions [using a technique] called ‘clip art,’ which consists of a designer cutting out photocopies of the rose, pasting them over the background, and photocopying the result.”<sup>125</sup> On appeal, the Second Circuit noted that “[t]he pattern thereby made was one of only slight original-

<sup>121</sup> *Eden Toys, Inc. v. Florelee Undergarment Co.*, 697 F.2d 27, 34 (2d Cir. 1982); *see, e.g., id.* at 35 (“To the extent that the district court applied the *Peter Pan Fabrics* test for copyright infringement as the test for determining originality, the district court erred as a matter of law.”), *superseded on unrelated grounds* by 15 U.S.C. § 1125(a) (1988). The offending passage in the lower court’s decision can be found at *Eden Toys, Inc. v. Florelee Undergarment Co., Inc.*, 526 F. Supp. 1187, 1192 (S.D.N.Y. 1981) (“[Plaintiff’s] changes, however, would not convey to the ordinary observer aesthetic appeal different from that experienced from prior expressions of Paddington Bear. *See Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960). [Eden] expressed Paddington Bear essentially unchanged from his prior manifestations.”).

<sup>122</sup> *See Concord Fabrics, Inc. v. Generation Mills, Inc.*, 328 F. Supp. 1030, 1032 (S.D.N.Y. 1971) (noting that, in general, “the analysis that supports the validity of the copyright moves, in the end, very close to the argument defeating the charge of infringement”).

<sup>123</sup> *See, e.g., Kepner-Tregoe, Inc. v. Carabio*, No. 8-71025, 1979 WL 1072, at \*9 (E.D. Mich. Apr. 20, 1979) (citing *Thomas Wilson & Co. v. Irving J. Dorfman Co.*, 268 F. Supp 711, 713 (S.D.N.Y. 1967) (noting that the amount of protection enjoyed depends upon the amount of protectible originality in the original work)).

<sup>124</sup> 937 F.2d 759 (2d Cir. 1991).

<sup>125</sup> *Id.* at 764.

ity,” and declared that this fact warranted a modification of the usual scope of protection:

[T]here was ample evidence to support the finding that [Plaintiff] copied the background of Pattern # 1365 from a public domain document. [A witness] testified that the studio created “documentary designs” from public domain material, and that she believed the source for the background in # 1365 was a document in her studio’s possession . . . [However,] there is no evidence that [Plaintiff] copied the placement of the roses from any source. Consequently, the district court’s finding that the particular arrangement given the Folio Rose in Pattern # 1365 was not original was clearly erroneous. Although the arrangement may have required little creative input, it was still [Plaintiff]’s original work and, as such, copyrightable. [*Feist.*] It must be kept in mind that the scope of copyright protection for Folio’s fabric design found above is narrow, extending only to the work’s particular expression of an idea, not to the idea itself.<sup>126</sup>

As this excerpt suggests, the *Folio* decision contains the second and third potential “triggers” of application of the “thin copyright” doctrine noted above: (1) the incorporation of material from the public domain (the “background” of the fabric pattern at issue); and (2) the character of plaintiff’s original contribution (the rotating “rose” motif), which arguably touched on *all* of the subcategories of less-than-fully-protected material listed earlier. The *Folio* court, though purporting to find the fabric pattern sufficiently “original” for copyright protection, effectively put the pattern through two rounds of “filtering”—first, excluding the background from the “substantial similarity” analysis, and second, requiring near-exact copying of the original material (the roses):

Although the roses in both designs are placed against the background in a similar straight line pattern, the roses themselves are not substantially similar. As the district court correctly pointed out, each of the roses in Pattern # 1365 is identical, while the roses in the Baroque Rose pattern differ from each other in their details and nuances. The Baroque Roses appear to be in soft focus and the Folio Rose has a sharper, clearer image. Moreover, though playwrights and poets from William Shakespeare to Gertrude Stein have extolled the beauty of this five-petaled flower, by the rose’s very nature one artist’s rendering of it will closely resemble another artist’s work. For these reasons, we believe that “an average lay observer would [not] recognize the alleged copy as having been appropriated from the copyrighted work.”<sup>127</sup>

---

<sup>126</sup> *Id.* at 764-65.

<sup>127</sup> *Id.* at 766 (quoting *Novelty Textile Mills v. Joan Fabrics Corp.*, 558 F.2d 1090, 1093 (2d Cir. 1977) (quoting *Ideal Toy Corp. v. Fab-Lu Ltd.*, 360 F.2d 1021, 1022 (2d Cir. 1966)).



These excerpts from the *Folio* decision show how easily questions of originality, idea-versus-expression, filtering, and substantial similarity can bleed into each other—and, in the context of fashion design, how they often do. Thus, it might come as little surprise that even after two decades of the quasi-formalization of “thin copyright” for visual works of applied art, important doctrinal questions remain unanswered, and/or have been answered differently by different courts and judges.<sup>128</sup>

To the extent that “thin copyright” imports a patent law-like “novelty” bar into copyright law, what—apart from factual material on the record definitely proving that a portion of the plaintiff’s work is not original—suffices for a judicial finding of what might be called “partial non-novelty”? At times, courts have examined formal evidence on industry practice to evaluate non-novelty in aspects of plaintiffs’ works of fashion design;<sup>129</sup> in other disputes, courts have taken something resembling judicial notice in rejecting “familiar” images as properly considered for infringement purposes (sometimes in the form of purported factual determinations made “as a matter of law.”).<sup>130</sup> Reasoning like that found in the final sentence of the second block quote from the *Folio* case—stating, in essence, that material is not “substantially similar” as a matter of law because the material in question is (in the court’s view) commonplace, is replete with problems.

Such problems are only compounded as courts add various criteria to the list of potential triggers for the application of “thin copyright”—many of which overlap and/or form the basis for other copyright-law doctrines: (1) a work’s lack of “novel[ty]” via trade history;<sup>131</sup> (2) a work’s incorporation of material from the (copyright-law) public domain;<sup>132</sup> (3) a work’s depiction

---

<sup>128</sup> See discussion, *infra*.

<sup>129</sup> See, e.g., *Concord Fabrics, Inc. v. Generation Mills, Inc.*, 328 F. Supp. 1030, 1033 (S.D.N.Y. 1971) (“[B]ecause the concept of alternating squares of solids and plaids is shown not to be novel, the court has necessarily mixed into the emulsion of pertinent ideas the burden upon plaintiff in such a case of proving extremely close copying”).

<sup>130</sup> See, e.g., *Samara Bros. v. Wal-Mart Stores, Inc.*, 165 F.3d 120, 132 (2d. Cir. 1998) (“[C]opyright[ed works] depicting familiar objects, such as the hearts, daisies, and strawberries in Samara’s copyrights, are entitled to narrow protection [as against the] virtually identical copying [found here]”) (citing *Folio Impressions*, 937 F.2d at 765), *abrogated on other grounds by Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205 (2000).

<sup>131</sup> *Concord Fabrics*, 328 F. Supp. at 1033.

<sup>132</sup> *Folio Impressions*, 937 F.2d at 765.

of a real-life object existing in nature;<sup>133</sup> (4) a work whose possible range of expression “is constrained by both the subject-matter . . . and the conventions of [commerce]”;<sup>134</sup> and (5) a situation in which anticompetitive market effects might result from judicial recognition of full-fledged copyright protection for a plaintiff’s work.<sup>135</sup>

Adding to the confusion is the reality that many courts have neglected to observe a strict or systematic division between “thin copyright” and the “idea-expression distinction,”<sup>136</sup> the “merger” doctrine,<sup>137</sup> or the doctrine of “*scènes à faire*.”<sup>138</sup> The following passage from a 2012 district-court opinion illustrates the tendency of courts to gloss over such substantive and procedural nuances:<sup>139</sup>

The Copyright Act protects a plaintiff from competing works that are “substantially similar.” *Mattel, Inc. v. MGA Entm’t, Inc.*, 616 F.3d 904, 913-14 (9th Cir. 2010). This standard applies when there is a wide range of expression available. *Id.* at 916. For example, there are countless ways to design a doll. If, however, there is only a narrow range of expression available, then plaintiff’s copyright protection is “thin” and the defendant’s work must be “virtually identical” to infringe. *Id.* at 913.

. . . .  
In addition, because copyright protection does not extend to “standard, stock, or common” elements, those generic elements must be excluded from the comparison. *Satava v. Lowry*, 323 F.3d 805, 810-11 (9th Cir. 2003). For example, a designer cannot claim for itself the right to all brightly colored jelly fish designs because many jelly fish are brightly colored. *Id.*; e.g., *Ets-Hokin v. Skyy Spirits, Inc.*, 225 F.3d 1068 (9th Cir. 2000) (boldly-colored blue glass vodka bottle shaped like a wine bottle has “thin” protection). The rule prevents one artist from claiming too large of a monopoly on unoriginal, common elements that the public should be

<sup>133</sup> *Satava v. Lowry*, 323 F.3d 805, 810-11 (9th Cir. 2003); see also *Celebration Int’l v. Chosun Int’l, Inc.*, 234 F. Supp. 2d 905, 917 (S.D. Ind. 2002) (“On balance, the Court concludes that the tiger [costume found protectable under conceptual separability theory] does have some particularized expression, and will recognize the copyright protection that this creative expression justifies. However, the expressiveness is limited due to the effort to reproduce a real, lifelike tiger. As such, the Celebration tiger will only be afforded limited copyright protection.”).

<sup>134</sup> *Ets-Hokin v. Skyy Spirits, Inc.*, 323 F.3d 763, 766 (9th Cir. 2003).

<sup>135</sup> *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 741-42 (9th Cir. 1971).

<sup>136</sup> See discussion *supra*.

<sup>137</sup> See discussion at *On ‘Similarity.’*

<sup>138</sup> See *id.*

<sup>139</sup> *Brighton Collectibles, Inc. v. RK Texas Leather Mfg.*, No. 10-CV-419-GPC (WVG), 2012 U.S. Dist. LEXIS 177718 (S.D. Cal. Dec. 13, 2012).

allowed to use in fair competition. *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 741-42 (9th Cir. 1971).<sup>140</sup>

It seems largely beyond dispute that, at least in the fashion-design context, judicial formalization and application of the “thin copyright” doctrine—especially as the triggers for the doctrine multiply—have resulted in ratcheting up the threshold of the “originality” test for copyright protection in a manner difficult to reconcile with *Feist*. Perhaps the best way to reconcile these disparate strands of case law is through the same sort of reasoning underlying the canon of statutory construction known as “constitutional avoidance.” Indeed, the Second Circuit arguably opted for such an approach in *Beaudin v. Ben & Jerry’s Homemade, Inc.*<sup>141</sup> There, plaintiff sued over the alleged copyright infringement of “hand-painted artwork on cloth caps, in a design that uses the pattern of the black splotches on a white background seen on Holstein cows.”<sup>142</sup> The Second Circuit panel considered it “doubtful whether taking a pattern that appears in nature and rendering it in a variety of minute variations that inevitably result from hand-painting satisfies even the minimal originality requirement of copyright.”<sup>143</sup> But the panel reasoned that it “need not go so far as to rule that Beaudin has no protectable features in his copyright”<sup>144</sup>—potentially a *constitutional* determination, under *Feist*. Instead, the court affirmed the district court’s dismissal by invoking “thin copyright”:

As the District Court ruled . . . whatever aspects of Beaudin’s expression of his idea merit protection have indisputably not been infringed by Ben & Jerry’s. Where the quantum of originality is slight and the resulting copyright is “thin,” infringement will be established only by very close copying because the majority of the work is unprotectable. See I William F. Patry, *Copyright Law and Practice* 607, n. 369 (1994). Such close copying has not occurred here. Applying the “ordinary observer” test in the “more discerning” manner appropriate to such cases, see *Folio Impressions*, 937 F.2d at 766, we agree with Chief Judge Murtha that a reasonable trier could not find substantial similarity between Beaudin’s and Ben & Jerry’s hats. The white background is a minimal feature of Beaudin’s hat, but is an extensive feature of the Ben & Jerry’s versions of the [H]olstein splotch pattern.<sup>145</sup>

---

<sup>140</sup> *Id.* at \*21-\*22.

<sup>141</sup> 95 F.3d 1 (2d Cir. 1996).

<sup>142</sup> *Id.* at 1.

<sup>143</sup> *Id.* at 2.

<sup>144</sup> *Id.*

<sup>145</sup> *Id.*

The *Beaudin* decision places in high relief the premise that “thin copyright” is, at least in certain circumstances, effectively a vehicle for ratcheting up copyright law’s “originality” requirement in particular cases.<sup>146</sup> Given that “thin copyright” appears to be disproportionately invoked and applied in disputes over works of fashion design, relevant stakeholders should consider the precedent in which this doctrine has been applied, every bit as much “the law” as the difficult-to-reconcile Supreme Court ruling in *Feist*—at least until the Court revisits the issue of “originality” in the context of a visual work of applied art.

*d. Conclusion of Discussion Concerning “Originality” and “Thin Copyright”*

In sum, the threshold requirement of “originality” that potentially copyright-eligible<sup>147</sup> fashion-related works must meet for acts of purported infringement to be potentially actionable has waxed and waned in its stringency since the Supreme Court opened the door to certain components of fashion design in its 1954 decision in *Mazer v. Stein*.<sup>148</sup> It is important to keep track of which way the wind is blowing in this area, as the tenor of the time might be just as decisive a factor in the outcome of a given case as the actual content of a purportedly copyrightable work. Sometimes, the copyright registration alone serves as a “tiebreaker” in difficult cases.<sup>149</sup> On other occasions, courts have disregarded the supposed “presumption of validity” following from a grant of registration based on little more than intuition.<sup>150</sup>

Introducing another variable into the area of copyright-for-fashion-design, many courts have effectively circumvented difficult “originality” de-

<sup>146</sup> See *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 346 (1991) (copyright law’s “originality” requirement stems from the Constitution).

<sup>147</sup> See discussion at *On ‘Separability.’*

<sup>148</sup> See discussion at *A Strange Centennial*.

<sup>149</sup> See, e.g., *Homer Laughlin China Co. v. Oman*, Civ. A. No. 90-3160, 1991 U.S. Dist. LEXIS 10680, at \*3–\*4 (D.D.C. Jul. 30, 1991) (“The Register is entitled to a significant degree of deference and its decision may be overturned only upon an abuse of discretion . . . . This Circuit has concluded that ‘abuse of discretion [is] the appropriate standard to review the [Register’s] denial of a registration. Since the applicant can gain full judicial review of copyrightability in an infringement action, the costs of forcing too fine an analysis and too extensive an explanation of a denial of registration are not worth the benefits - particularly when reviewing a question which has unavoidably subjective aspects such as how much creativity is sufficient to force the Copyright Office to register a proffered work.’”) (internal citations omitted).

<sup>150</sup> See “The Originality Pendulum,” *supra* at Section B.1.b.

terminations by invoking the doctrine of “thin copyright” (or functional equivalents, as in the “motif” line of cases), with the more stringent infringement test this almost invariably entails. “Thin copyright” might provide a means for a court to avoid making tough calls on “originality,” but arguably does so in a manner that is difficult to reconcile with *Feist*. “Thin copyright” is perhaps even less defensible from a pragmatic perspective, as courts applying the doctrine often achieve little more than pushing back the resolution of difficult questions (to the detriment of many litigants) from the threshold copyrightability determination to the infringement stage of dispute resolution.

This doctrinal morass thus represents one of several areas in which the seemingly fundamental question of which fashion articles are entitled to copyright protection might appear to be settled—but, on a practical level, is not. In the end, it may well be that decisive, transparent, and early-stage calls by judges—whatever their outcome—are of greater utility to the fashion industry at large than is the unpredictable and often-unprincipled invocation of conceptually and procedurally confused notions like “thin copyright.” Whether “rules” are preferable to “standards,” or the other way around, this corner of copyright law cannot currently claim a commitment to either approach.

This underscores a central theme running through this series: that fashion’s unique blend of art, commerce, decoration, and utility makes it an awkward conceptual fit for both copyright protection and legislative/judicial application thereof.<sup>151</sup> The awkwardness of that fit has, in turn, yielded

---

<sup>151</sup> While this series focuses exclusively on American law, it is arguably notable that the copyright jurisprudence of other countries frequently reflects similar tensions and inconsistencies in the applied-art context. See *discussion* at PAUL GOLDSTEIN & BERNT HUGENHOLTZ, *INTERNATIONAL COPYRIGHT: PRINCIPLES, LAW, AND PRACTICE* 214 (3d ed. 2013) (tentatively identifying three general approaches to copyright protection for works of applied art, but qualifying description with caveat that these “categories are by no means impermeable and are not always internally consistent,” as “national differences within categories will sometimes be as great as the differences between the categories themselves”). Interestingly, Goldstein and Hugenholtz identify as a central “reason for the proliferation of conflicting approaches” the notion “that applied art and industrial design encompass a continuum from mass novelty items, such as earrings and toys, to works of industrial design, such as chairs and lamps, in which art and function intertwine”). *Id.* at 214. But see Jerry Palmer, *Introduction to Part I*, , *DESIGN AND AESTHETICS: A READER* 3, 10 (Jerry Palmer & Mo Dodson, eds., 1996) (“Where do such ‘functions’ come from? They cannot come from the object itself, since objects readily change function as they move through time and space . . . . Functions are the purposes to which objects are put, but where do the purposes come from? . . . Nothing is more central to the discussion of how objects relate to people than the notion of need.”) The

idiosyncratic and often inconsistent judicial decisions, in which seemingly well-established doctrines of copyright law become little more than *ad hoc* tools for twisting, reshaping, and fusing as necessary to achieve whatever result appears warranted in a given copyright-infringement case over fashion design. Inconsistency is not, of course, unique to this area of the law. But when even ostensibly straightforward principles like “originality” cannot be relied upon with any degree of certainty by so economically significant an industry as fashion, intervention—whether through judicial and/or legislative clarification of the governing law—is warranted.

---

next article in this series, *On ‘Separability,’* will explore in depth American copyright law’s premise that there is a meaningful distinction between presumptively copyrightable “pictorial, graphic, and sculptural” works and presumptively non-copyrightable “useful articles,” and will investigate how judges have drawn mapped distinction onto real-life disputes over works of fashion design. There is ample reason to believe that American intellectual property law has often placed fashion design in a double-bind, treating it as sufficiently “useful” to disqualify much of its output from copyright, but lacking sufficient worth to accord even its artistically “separable” components robust copyright protection or, at certain key points in U.S. history, design-patent protection. See generally Colman, *Design and Deviance*, *supra* note 3 (arguing that “ornamental” design, for reasons having to do with socio-cultural developments in the late Nineteenth Century, acquired stigmas that manifested in design-patent doctrine).



## Implementing a Franchise Player Designation System in the National Basketball Association

Scott Bukstein, University of Central Florida  
Jacob Eisenberg, Emory University

During the most recent Collective Bargaining Agreement (CBA) negotiation process in 2010-11 between National Basketball Association (NBA) team owners and the National Basketball Players Association (NBPA), the owners proposed adding a new element to the then-current free agency rules—a “franchise player designation.”<sup>1</sup> A franchise tag would have allowed each NBA team to designate one player (who would otherwise have been a free agent) as a “franchise player” each season. That player would only be allowed to sign a contract with his incumbent (i.e., prior) team. The primary purposes of a franchise tag system are to reduce the probability of a team losing its best player(s) in free agency as well as increase the likelihood that teams are able to retain their key players for the maximum number of years possible. The ideal outcome is that a player and his prior team agree to a long-term contract extension to avoid application of the franchise player designation altogether.<sup>2</sup>

The NBA owners proposed a variation of the National Football League’s (NFL) franchise tag. Unlike the franchise tag system in the NFL, the model proposed by NBA owners would have required a player’s consent to being “franchise-tagged.”<sup>3</sup> In addition, the “tagged” players would have also received contract sweeteners that “untagged” players would not be eligible to receive (for example, longer contract length, higher overall salary

---

<sup>1</sup> Kurt Helin, *Report: NBA Proposes Franchise Tag, Non-Guaranteed Contracts*, SI.COM, (May 11, 2011) <http://nba.nbcsports.com/tag/franchise-tag>. The terms “franchise player designation” and “franchise tag” are used interchangeably in this article.

<sup>2</sup> See Chad Ford, *Franchise Player Tag in the NBA?* ESPN.COM, (Jan. 21, 2011), [http://espn.go.com/blog/truehoop/post/\\_id/24106/franchise-player-tag](http://espn.go.com/blog/truehoop/post/_id/24106/franchise-player-tag).

<sup>3</sup> Helin, *supra* note 1.

and more guaranteed money).<sup>4</sup> The primary objective of the proposed franchise tag was to improve the ability of teams to keep star players by increasing “the gap between what teams can offer a ‘designated player’ and what non-designated players can get on the open market.”<sup>5</sup> This franchise player designation was one component of a larger overall (and ultimately unsuccessful) league proposal related to player revenue and salary structure, which also sought to reduce player salaries and contract lengths as well as create a hard salary cap.<sup>6</sup> The NBA owners and the NBPA eventually agreed to a new comprehensive CBA in December 2011 after a 161-day lockout that resulted in 16 lost games for each team. However, the owners and players failed to agree on the issue of integrating a franchise tag provision into the current NBA CBA. The NBA and the NBPA each have the ability to opt-out of the current CBA in June 2017.<sup>7</sup> Recent events suggest that the NBPA will do so.

In October 2014, the NBA announced a new nine-year, \$24 billion media rights agreement with Turner Broadcasting and ESPN.<sup>8</sup> Beginning with the 2016-17 NBA season, NBA teams will receive a significant boost in revenue based on this new media rights deal (i.e., from approximately \$30 million per team each year to more than \$75 million per team each year). As a result, NBA players are expected to opt-out of the current CBA in June 2017 and request a larger share of Basketball Related Income.<sup>9</sup> Michele Roberts, the new Executive Director of the NBPA, explained: “The new television and media deals are good news for all of the stakeholders in the NBA . . . Although we have seen strong revenue growth and significant increases in franchise values over the past three years, it is clear that the league is now entering a period of unprecedented revenue growth. Our job will be to ensure that the players receive their fair share of the results of their efforts.”<sup>10</sup> If the players decide to opt-out of the CBA in 2017, it is

---

<sup>4</sup> See *id.*

<sup>5</sup> *Id.*

<sup>6</sup> See Chris Sheridan & Chris Broussard, *Players Unhappy with Owners' New Offer*, ESPN.COM (May 4, 2011), <http://sports.espn.go.com/nba/news/story?id=6476219>.

<sup>7</sup> *2011 Collective Bargaining Agreement*, National Basketball Association, art. XX-XIX § 2 [hereinafter NBA CBA].

<sup>8</sup> See Press Release, *NBA Extends Partnership with Turner Broadcasting, Disney*, NBA.COM (Oct. 6, 2014), available at <http://www.nba.com/2014/news/10/06/nba-media-deal-disney-turner-sports/>.

<sup>9</sup> See NBA CBA art. VII §1 (defining Basketball Related Income).

<sup>10</sup> Jeff Zillgitt, *NBA Will Have More Programming Under New TV Deal*, USA TODAY (Oct. 6, 2014), available at <http://www.usatoday.com/story/sports/nba/2014/10/06/nba-tv-deal-espn-turner/16807359/>.



quite possible that the owners could once again push for implementation of a franchise player designation system.

In 2010, when asked about whether he foresaw the NBA advocating for teams to be able to utilize franchise tags, then-current NBA Commissioner David Stern responded, “I think that the franchise player is an interesting concept; I’m sure it will come up in collective bargaining, but I think players are entitled to get the benefit of what they bargained for . . . and the union bargains for free agency after the players serve out a certain contract length.”<sup>11</sup> Steve Kerr, former General Manager of the Phoenix Suns and current head coach of the Golden State Warriors, commented that “[t]he franchise tag would be a huge hit for the owners; one of the biggest issues they’re trying to accomplish . . . is cutting down the length of guaranteed contracts and getting rid of dead money.”<sup>12</sup> Another NBA General Manager explained, “I think this is one way, along with revenue sharing, that levels the playing field a bit. For some markets, the only way to get superstars is to draft them. If they’re just going to leave after we develop them—that’s a big problem . . . [O]nce that rookie extension is over, the trend seems to be that the best players leave.”<sup>13</sup>

This article proposes that the NBA adopt a franchise player designation system in specifically defined circumstances—for first-round picks who last played under a four-year rookie salary scale contract and for players who last played under a multi-year contract signed in free agency with an average annual salary of at least \$10 million. Part I of this article summarizes the use of franchise and transition player designations in the NFL. Part II of this article explains why the NFL franchise tag model would not be effective in the NBA, and details preliminary issues to consider with respect to developing and implementing a franchise player designation system in the NBA. Part III of this article highlights the NBA’s restricted free agency and qualifying offer rules, and analyzes the core purpose and function of a franchise tag system in relation to these rules. Part IV of this article provides several case studies that demonstrate the viability and sustainability of a franchise tag system, along with possible limitations and challenges of such a system. Part V of this article outlines the proposed new franchise player designation

---

<sup>11</sup> Benjamin Hochman, *NBA Commish David Stern Talks Carmelo Anthony, CBA Talks*, DENVER POST (Oct. 22, 2010), available at <http://blogs.denverpost.com/nuggets/2010/10/22/nba-commish-david-stern-talks-carmelo-anthony-cba-talks>.

<sup>12</sup> Kyle Stack, *A Franchise Tag in the NBA*, SLAM ONLINE MAGAZINE (Sept. 2, 2010) available at <http://www.slamonline.com/online/nba/2010/09/a-franchise-tag-in-the-nba>.

<sup>13</sup> Chad Ford, *Franchise Player Tag in the NBA?*, ESPN.COM (Jan. 21, 2011), available at [http://espn.go.com/blog/truehoop/post/\\_id/24106/franchise-player-tag](http://espn.go.com/blog/truehoop/post/_id/24106/franchise-player-tag).

model and provides several case studies illustrating how the system would operate. The article concludes with a recap of the proposed model as well as a discussion on the likelihood that the NBA and its players will adopt the proposed NBA franchise player designation framework.

#### I. FRANCHISE AND TRANSITION PLAYER DESIGNATIONS IN THE NFL

The NFL's franchise player and transition player designations allow a team to "tag" one player each season who would otherwise be a restricted or unrestricted free agent. This gives the team either exclusive negotiation rights (for franchise players) or the right of first refusal to match an offer sheet that the player signs with another team (for transition players).<sup>14</sup> Franchise tags are a form of ultra-restricted free agency that enable a team to prevent a player who is considered too valuable for the team to risk losing in an open free agent market from signing a contract elsewhere.<sup>15</sup> Each tag is for a one-year contract, which significantly restricts the ability of that player to change teams and sign a long-term contract that could provide greater financial security.<sup>16</sup>

The NFL has had these franchise tag rules in place since 1993.<sup>17</sup> The NFL Players Association (NFLPA) agreed to the designation system simply because no form of free agency existed prior to the first NFL CBA.<sup>18</sup> The rationale behind agreeing to this restriction was that NFL players collectively agreed that one "right of refusal player" per team via the franchise player system was much better than 37 per team (when there was no free

---

<sup>14</sup> See 2011 NFL Collective Bargaining Agreement, National Football League, art. IX § 1–2 [hereinafter NFL CBA] (defining an Unrestricted Free Agent as a player with four or more accrued seasons and is thus completely free to negotiate and sign a player contract with any club without the prior team having any first refusal rights, and defining a restricted free agent as a player with less than four accrued seasons and is thus completely free to negotiate and sign a player contract with any club but with the prior team being able to receive a right of first refusal and/or draft choice compensation by tendering the player a qualifying offer).

<sup>15</sup> See Larry Coon, *For Melo, Free Agency Full of Risks*, ESPN.COM (Feb. 16, 2011), available at [http://sports.espn.go.com/nba/columns/story?columnist=coon\\_larry&page=CarmeloFA-110216](http://sports.espn.go.com/nba/columns/story?columnist=coon_larry&page=CarmeloFA-110216).

<sup>16</sup> See Jason Cole, *Sources: Union to Fight 'Franchise' Rule*, YAHOO! SPORTS, February 3, 2011, <http://sports.yahoo.com/nfl/news?slug=jc-franchisetag020311>.

<sup>17</sup> See Mike Tanier, *Too Deep Zone: The First Franchise Player*, February 19, 2007, <http://www.footballoutsiders.com/walkthrough/2007/too-deep-zone-first-franchise-player>.

<sup>18</sup> See Charles Ochab, *Don't Franchise Me! The NFL's Emerging Dilemma*, ILLINOIS BUS. L. J. (March 12, 2007), available at <http://www.law.uiuc.edu/bljournal/post/2007/03/12/Dont-Franchise-Me!-The-NFLs-Emerging-Dilemma.aspx>.

agency at all), so the players accepted the compromise back in 1993 likely without understanding the long-term ramifications of having this provision in the NFL CBA.<sup>19</sup>

The NFL's designations require that teams make a specific type of one-year tender offer to the player whom they wish to label as a franchise or transition player. The one-year tender offer salary amount is calculated based on either the average value of the top-five or top-ten player salaries at the designated player's relevant position, depending on whether the player is labeled a franchise or transition player.<sup>20</sup> The franchise and transition average values are calculated the same way for every player at the player's position. Thus, there is not an independent calculation of the fair market value for a particular player based on statistics or production—it is assumed to be the average of the annual salaries of the top-five or top-ten highest-paid players at that specific position. A team can only use one of each type of tag per year, and the team may use a franchise tag on the same player for up to three consecutive years.<sup>21</sup>

There are two types of franchise players, which are classified based on the type of required tender that the team offers the player. The first category of franchise player—exclusive franchise tender—is offered the highest-value one-year tender, which is the greater of (a) the average salary of the five largest salaries for players at the franchise player's position (average salary determined for both the five prior seasons and upcoming season), or (b) 120% of the player's prior year salary; the franchise player given this type of designation is prevented from negotiating with any other team.<sup>22</sup>

The second category of franchise player—nonexclusive franchise tender—is offered a lower-value one-year tender, which is typically the average of the five largest prior year salaries for players at the franchise player's position (average based on prior five years of salary data); the franchise player given this type of designation can negotiate with another team with the prior team retaining a right of first refusal and receiving two first-round draft selections if the team does not match an offer sheet, thereby allowing the player to sign with a new team.<sup>23</sup>

If a player is designated as a transition player, he can sign a contract with a new team, but his prior team has the right of first refusal.<sup>24</sup> If another team agrees to a contract with a player whose prior team designated

---

<sup>19</sup> Tanier, *supra* note 17.

<sup>20</sup> See NFL CBA art. X § 2(a), 4(a).

<sup>21</sup> See *id.* at art. X § 2(b).

<sup>22</sup> See *id.* at art. X § 2(a)(ii).

<sup>23</sup> See *id.* at art. X § 2(a)(i).

<sup>24</sup> See *id.* at art. X § 3–4.

him as a transition player, then the player's original team receives two first-round draft picks if it decides not to match the new team's offer.<sup>25</sup>

In the NFL, the time period for teams to designate franchise players begins on the twenty-second day preceding the first day of the new "league year,"<sup>26</sup> which is in the same week after the conclusion of the Super Bowl each February. Even after a team designates a player as a franchise player, the team can negotiate with that player on a multi-year contract. The deadline for agreeing to a multi-year contract is July 22, and if no multi-year deal is agreed upon, the player must sign the one-year designation and cannot negotiate for an extension or new contract again until the conclusion of the team's last regular season game in that upcoming season.<sup>27</sup>

The franchise tag system in the NFL arguably discourages a team from signing a player to a long-term contract, since owners can always fall back on franchising the player the following season.<sup>28</sup> NFL and NBA player agent Mark Bartelstein said, "With the franchise tag in football, the players always prefer to get long-term deals [because] you only have so many years to do this and the security and long-term money is what players prefer."<sup>29</sup> NFL owners will sometimes use the threat of the franchise tag to get a player to agree to a longer-term contract at lower annual salaries than the player might have commanded from a new team on an open market. Some players agree to sign multi-year contracts or extensions with their prior team because of the risk of the franchise tag being applied and the corresponding uncertainty of having only one season of guaranteed salary (combined with the chance of suffering a career-ending injury).<sup>30</sup> For the 2014 NFL season, six players were tagged; two were transition tags while the other four were

---

<sup>25</sup> See *id.* at art. X § 3.

<sup>26</sup> League Year is defined as "the period from March [ ] of one year through and including March [ ] of the following year, or such other one-year period to which the NFL and the NFLPA may agree." See *id.* at art. I.

<sup>27</sup> See NFL CBA art. X § 14–15.

<sup>28</sup> Ochab, *supra* note 18.

<sup>29</sup> Quoted in KEN BERGER, *Should NBA Adopt NFL-Like Player Movement Rules? Good Question*, July 30, 2010, CBSSPORTS.COM, available at <http://www.cbssports.com/nba/story/13683901/should-nba-adopt-nfl-like-player-movement-rules-good-question>. Bartelstein also said that, "Contracts, like anything in life, are a product of the market. So if people want you enough, whether it's a big signing bonus or a long-term contract, that's what you're going to get. That's the way it should work: supply and demand." *Id.*

<sup>30</sup> Cindy Boren, *Everything you need to know about the NFL's franchise tag*, WASHINGTON POST (March 2, 2015), <https://www.washingtonpost.com/news/early-lead/wp/2015/03/02/everything-you-need-to-know-about-the-nfls-franchise-tag/>; Mike Foss, *Why do NFL players hate the franchise tag?* USA TODAY (March 2, 2015), <http://ftw.usatoday.com/2015/03/nfl-franchise-tag-dez-bryant-dallas-cowboys>.

non-exclusive franchise tags.<sup>31</sup> In 2013, eight NFL teams used franchise or transition tags—a considerable drop off from the NFL-record 21 players who received the franchise or transition tag designation in 2012.<sup>32</sup>

The following section explains that, while the NFL franchise player designation system might not be practicable in the NBA, it could provide some insight into how to develop and implement an optimal franchise tag model in the NBA.

## II. THE NBA CANNOT SIMPLY REPLICATE THE NFL FRANCHISE TAG MODEL—INITIAL ISSUES TO CONSIDER WITH RESPECT TO DEVELOPING AND IMPLEMENTING A FRANCHISE PLAYER DESIGNATION SYSTEM IN THE NBA

An identical franchise player designation system to the one used in the NFL would not be effective in the NBA. First, the current NBA free agency rules have successfully kept the majority of star (i.e., “franchise”) players with their prior teams, unless the team is unwilling to pay the player’s fair market value (e.g., the maximum allowed salary).<sup>33</sup> Second, the average salary of the top-five or top-ten players at each position in the NBA can vary depending on the contracts signed each off-season (and which teams had

---

<sup>31</sup> Gregg Rosenthal, *Franchise Tag Tracker*, NFL.COM (March 3, 2014), <http://www.nfl.com/news/story/0ap2000000330283/article/franchise-tag-tracker>.

<sup>32</sup> Brian McIntyre, *Eight players receive the franchise tag in 2013*, YAHOO! SPORTS (March 4, 2013), <http://sports.yahoo.com/blogs/nfl-shutdown-corner/eight-players-receive-franchise-tag-2013-222934634—nfl.html>; NFL.COM, *Teams that have used franchise tags on 2012 free agents*, (March 2, 2012), <http://www.nfl.com/news/story/09000d5d82756d1c/article/teams-that-have-used-franchise-tags-on-2012-free-agents>.

<sup>33</sup> In the summer of 2014, Kevin Love informed the Minnesota Timberwolves that he would turn down a maximum-salary offer from the team to sign with a new team in the following summer. Love had played six seasons with his prior team and requested a trade to a team that he felt would compete for an NBA championship. Love played for a smaller-market team (i.e., Minnesota) before requesting his trade. Love signed rookie scale extensions that kept him under contract for three additional seasons beyond his initial four-year rookie salary scale deal. Because Love was traded prior to his contract’s expiration, his new team obtained his Larry Bird Rights. This allowed the Cavaliers to offer Love his true maximum salary value as opposed to if he signed there as a free agent straight from Minnesota. Had he signed in Cleveland without his Larry Bird Rights, he would have forfeited more than \$20 million cumulatively. Had a franchise designation system been in place, Love’s prior team could have chosen to sign him to a one-year contract, and possibly increased their leverage in trading Love over the course of the next season. Love would not have been allowed to sign a long-term contract that provided financial security with another team until the team’s option in the franchise tender expired.

salary cap room or engaged in a sign-and-trade transaction) and whether extension salaries (i.e., amendments to existing contracts signed prior to the player becoming a free agent) are included in the calculation. In addition, a player's market value is different based on whether he would be an unrestricted or restricted free agent.<sup>34</sup> Third, teams and owners would probably not want to compensate the signing of a transition-tagged player by giving up draft picks if the prior team does not match the offer because there are only 60 total NBA draft selections each year compared to more than 250 total NFL draft selections.

Additionally, there are only 15 available roster spots on each NBA team compared to 53 roster spots in the NFL. Over the previous four NBA seasons (2011-2014), an approximate average of 47 out of 60 drafted players each season made the team's NBA roster at some point during the following season.<sup>35</sup> Adding additional picks to the end of the draft or adding supplemental picks that would push other teams' picks back later in the draft would not be an ideal solution since the quality of players who could make an NBA team typically drops off considerably after two draft rounds. And lastly, NBA players might intentionally play poorly or make comments to the media in an effort to avoid being tagged as a franchise or transition player.

NBA players would likely never agree to a franchise player designation system that closely paralleled the NFL's franchise and transition player designation system. With new NBPA Executive Director Michele Roberts and Chris Paul (a seven-time NBA All-Star) leading the NBPA, there would be

---

<sup>34</sup> By way of example, for the ten highest-paid power forwards, the position in the NBA with the most money allocated to the top ten players at a position, the average salary during the 2009-10 season was \$14,696,993, which would constitute 25.5% of the league's salary cap for each team (with a mandatory 13-man roster) and 21.0% of the league's luxury tax level for the 2009-10 season. This is compared to NFL transition designations with a \$12,444,000 average salary for the top-10 highest paid quarterbacks, and a \$8,370,000 average salary for the top-10 highest paid cornerbacks, which equates to 9.7% and 6.5%, respectively, of the league's \$128 million salary cap in 2009 for each team (with 22 starters and a 53-person roster). See HOOPDATA - NBA CAP SPACE AND SALARIES INFO, <http://hoopdata.com/salaries/index.aspx> (last visited Mar. 27, 2015).

<sup>35</sup> Data is from BASKETBALL-REFERENCE.COM, <http://www.basketball-reference.com/players>, for each individual player selected in the NBA draft between the years 2011-2014. There were 54 total players selected over that span who failed to suit up for the team that drafted them in the following NBA season. Some of these players, such as Jonas Valanciunas (the fifth overall pick in 2011) actually elected to extend playing professionally overseas for a variety of reasons before joining the NBA. Many others, such as Marcus Denmon (the 59th pick in 2012) simply never received a contract offer from the team that selected them.

great reluctance and hesitation to agree to an amendment in the NBA CBA in which star players' options in free agency are limited as severely as franchise-tag related player mobility in the NFL.<sup>36</sup> Nonetheless, the NBA CBA already contains several provisions that provide increased leverage for teams who attempt to retain key players. Two examples of NBA CBA provisions that limit player mobility are the NBA's current restricted free agency and qualifying offer rules.

### III. NBA RESTRICTED FREE AGENCY AND QUALIFYING OFFER RULES

One potential argument against allowing teams to use a franchise player designation is that the NBA's current restricted free agency and qualifying offer rules already provide teams with leverage to retain key players and, therefore, the franchise tag model is duplicative and unnecessary.

#### *NBA Restricted Free Agency Rules*

The current NBA CBA rules pertaining to restricted free agency give a player's prior team a significant advantage in being able to retain the player's services under a new contract.<sup>37</sup> The prior team has a right of first refusal to match any offer sheet that the player signs with a new team. Over the past several seasons, the majority of restricted free agents have re-signed with their prior team, or signed an offer sheet with a new team that was subsequently matched by their prior team.<sup>38</sup> Additionally, very few players

---

<sup>36</sup> In a November 2014 interview, Michele Roberts explained, "I contend that there is no reason in the world why the union should embrace salary caps or any effort to place a barrier on the amount of money that marquee players can make." Pablo S. Torre, *NBPA Director: 'Let's Stop Pretending,'* ESPN THE MAGAZINE (Nov. 13, 2014), [http://espn.go.com/nba/story/\\_/id/11868612/nba-owners-expendable-players-union-chief-michele-roberts-says](http://espn.go.com/nba/story/_/id/11868612/nba-owners-expendable-players-union-chief-michele-roberts-says).

<sup>37</sup> Any first round pick who finishes the fourth season of his rookie scale contract (which is for two guaranteed years and two team option years) and any veteran free agent who will have three or fewer years of service entering the off-season will be a restricted free agent if his prior team makes a qualifying offer to the player at any time from the day following the season (e.g., in mid-June after the NBA Finals) through June 30. If such a qualifying offer is made, then, on July 1, the player will become a restricted free agent, subject to a right of first refusal in favor of the prior team. See NBA CBA art. XI § 4.

<sup>38</sup> See NBA.COM, *2015 Free Agent Tracker*, last updated Sept. 17, 2015, <http://www.nba.com/freeagents/2015/>; NBA.COM, *2014 Free Agent Tracker*, last updated Oct. 23, 2014, <http://www.nba.com/freeagents/2014/>; NBA.COM, *2013 Free Agent Tracker*, last updated Oct. 26, 2013, <http://www.nba.com/freeagents/2013/>; NBA.COM, *2012 Free Agent Tracker*, last updated Feb. 21, 2013, <http://www.nba.com/freeagents/2012/>.

have signed a one-year qualifying offer,<sup>39</sup> which would allow the player to become an unrestricted free agent the following off-season. This shows that restricted free agents are more inclined to sign multi-year deals with their prior team, opting for the long-term security of such a contract rather than risk a serious injury that would ruin a chance at a true open market in unrestricted free agency the following summer.

Most restricted free agents re-sign with their prior team if that team is willing to pay fair market value. This is because the prior team has the right of first refusal. Under current CBA rules, prior teams are allowed to re-sign their own free agents for an additional season (e.g., five years with prior team compared to four years with new team) and greater annual increases than a new team can offer (e.g., 7.5% annual salary increases for the prior team compared to 4.5% for the new team).<sup>40</sup>

As explained in a November 2014 article by well-respected NBA columnist and commentator Zach Lowe, “even when teams have a clear edge in the restricted free-agency stalemate, they tend to offer a fair deal in the end. Eric Bledsoe got his five-year, \$70 million deal in August . . . Charlotte and Minnesota probably overpaid Kemba Walker and Ricky Rubio, respectively, given the leverage the teams would have had in restricted free agency.”<sup>41</sup> Another member of the media similarly commented, “teams have all the leverage in the restricted free agency process, but playing for the qualifying offer turns things around to where the players have the advantage. The problem is the amount of risk associated with that decision, but for guys like Bledsoe and Monroe who feel like they deserve contracts at or near the max, they may see it as the only realistic option.”<sup>42</sup>

The franchise player designation system proposed in this article would complement and improve the NBA’s restricted free agency system and also partially replace the NBA’s current qualifying offer system, which is a sel-

---

agents/2012/; NBA.COM, *2011 Free Agent Tracker*, last updated Dec. 29, 2011, <http://www.nba.com/freeagents/2011/>; NBA.COM, *2010 Free Agent Tracker*, last updated Oct. 14, 2010, <http://www.nba.com/freeagents/2010/> [hereinafter, collectively, “NBA Free Agent Trackers”].

<sup>39</sup> See *id.* at art. XI § 1(c) for the definition of Qualifying Offer.

<sup>40</sup> See *id.* at art. XI § 4.

<sup>41</sup> Zach Lowe, *The Contract Shell Game: Klay, Kawhi, and Extensions in the Ever-Changing NBA*, GRANTLAND.COM (Nov. 5, 2014), <http://grantland.com/the-triangle/nba-contract-extensions-klay-thompson-warriors-jazz-spurs/>.

<sup>42</sup> Brett Pollakoff, *NBA GM Says ‘There’s No Reason’ to Trade for Restricted Free Agents Greg Monroe or Eric Bledsoe*, NBC SPORTS PRO BASKETBALL TALK (Aug. 21, 2014, 5:02 PM), <http://probasketballtalk.nbcsports.com/2014/08/21/nba-gm-says-theres-no-reason-to-trade-for-restricted-free-agents-greg-monroe-or-eric-bledsoe/>.



dom used and imbalanced one-year contract model that usually does not produce fair and mutually beneficial results for teams and players.

### *NBA Qualifying Offer Rules*

When a team extends a qualifying offer to a player, that player automatically becomes a restricted free agent.<sup>43</sup> A player who receives a qualifying offer must be given until at least October 1 (i.e., usually a few days before training camp) to accept the offer.<sup>44</sup> If a qualifying offer is neither withdrawn nor accepted and the deadline for accepting it passes, the team's right of first refusal continues, but the player will no longer have the option of signing the one-year qualifying offer and the current team can either offer a minimum salary contract or wait until the player signs an offer sheet with another team and determine whether to match the offer.<sup>45</sup>

Every restricted free agent who has signed a qualifying offer during the past six off-seasons has waited until close to the October 1 deadline to do so.<sup>46</sup> This illustrates that restricted free agents are sometimes reluctantly pushed, because of the current CBA rules, to sign a one-year qualifying offer with their prior team because the 29 other teams do not want to sign a player to an offer sheet when the prior team has a right of first refusal and a three-day matching period. Detroit's Greg Monroe signed a qualifying offer during the 2014 off-season after failing to secure a long-term contract in free agency.<sup>47</sup> Monroe told one of the authors of this article, "It was a stressful

---

<sup>43</sup> See NBA CBA art. XI §1(c) for a description of the qualifying offer process.

<sup>44</sup> The October 1 deadline is ninety days after the date by which the qualifying offer must be made, and just one day before the start of a team's training camp for the upcoming season. Under the existing rules, a qualifying offer may be unilaterally withdrawn by the team at any time through July 23 following its issuance. If the qualifying offer is not withdrawn on or before July 23, it may be withdrawn thereafter but only if the player agrees in writing to the withdrawal. If a qualifying offer is withdrawn, the player immediately becomes an unrestricted free agent. See *id.* at art. XI §4(c)(i).

<sup>45</sup> See *id.* at art. XI §4(c)(ii).

<sup>46</sup> See NBA Free Agent Trackers, *supra* note 38. Each player signed the qualifying offer after not being able to secure a long-term deal with their prior team or a contract with a new team that would be subject to the prior team's right of first refusal.

<sup>47</sup> Kevin Zimmerman, *Greg Monroe signs qualifying offer with Pistons*, SBNATION (September 5, 2104), <http://www.sbnation.com/nba/2014/8/12/5944785/greg-monroe-pistons-qualifying-offer-nba>.

time. It's a weird predicament for the players. There's always some kind of tension when it comes to negotiations."<sup>48</sup>

The current qualifying offer system is not ideal. One criticism is that the free agent market and player salaries in general have outpaced the current qualifying offers tendered to players because the qualifying offers are not always directly tied to a player's actual production,<sup>49</sup> the team's desire to keep the player, fluctuations in Basketball Related Income, and the salary cap or any market equivalents. Thus, the NBA's current qualifying offer system is flawed mainly because it does not adjust in conjunction with the salary cap and, when a player is selected in the draft, does not always indicate his value four years later.<sup>50</sup> Instead, there is a predetermined salary increase over the player's fourth year salary of their rookie scale contract based on when players were selected in the draft, subject to a few limited exceptions that, to date, have not been implicated for an accepted qualifying offer extended to a former first-round draft pick.<sup>51</sup> For first-round picks, qualifying offers range from a 30% increase from the fourth-year salary for the number one overall pick to a 50% increase for the 30th pick.<sup>52</sup> For reference, the 2014-15 qualifying offer amounts range from \$9,846,619 for the 1st pick to \$3,227,558 for the 30th pick.<sup>53</sup>

Over the past six seasons, only seven former first-round draft picks who became restricted free agents following the fourth year of their rookie salary

---

<sup>48</sup> Interview by Jacob Eisenberg with Greg Monroe, Power Forward, Detroit Pistons, *available* at [www.jacobeisenberg.com](http://www.jacobeisenberg.com).

<sup>49</sup> Qualifying offers in the NBA are in part based on player performance. This is a change from the qualifying offer model in past CBAs. For example, if a player picked 10th to 30th in the first-round meets one of the following two "Starter Criteria," then the player's qualifying offer amount will be equal to the qualifying offer for the 9th overall draft pick: (1) started an average of 41 regular season games or played an average of 2,000 regular season minutes during third and fourth seasons combined; or (2) started at least 41 regular season games or played at least 2,000 minutes during fourth season. In addition, if a player picked 1st to 14th in the first-round fails to meet the Starter Criteria, then the player's qualifying offer amount will be equal to the qualifying offer for the 15th overall draft pick. *See* NBA CBA art. XI.

<sup>50</sup> For instance, there have been six different players selected to the All-Star game in the past two years who were drafted outside of the top 15 picks. *See* *NBA & ABA All-Star Game Stats and History*, BASKETBALL-REFERENCE.COM, <http://www.basketball-reference.com/allstar> (last visited Mar. 27, 2015).

<sup>51</sup> Larry Coon, *Scale Salary Amounts for First Round Draft Picks*, CBFAQ.COM, <http://www.cbafaq.com/scale2011.htm>.

<sup>52</sup> *Id.*

<sup>53</sup> *See* NBA CBA Exhibit B.

scale contracts signed qualifying offers with their prior team.<sup>54</sup> The value of qualifying offers, which decrease in total value but increase in the percentage raise as a player gets drafted with a later pick, usually does not accurately reflect a player's value because the salary is predominantly based on when a player was drafted four years earlier. For example, over the past seven seasons, five players (Ben Gordon, Raymond Felton, Spencer Hawes, Nick Young and Greg Monroe) have received one-year qualifying offers that were valued well below what they were subsequently paid the following season.<sup>55</sup> Only Spencer Hawes re-signed with his prior team during the off-season following the qualifying offer year.<sup>56</sup> This is possibly because players eventually develop disappointment or resentment toward their prior teams, who failed to offer what was perceived to be "a fair contract" in the player's eyes when the player was a restricted free agent.

No player drafted in the first round after the 12th pick in a draft since 2000 has signed a qualifying offer.<sup>57</sup> Players who are picked later in the first round decline to sign these qualifying offers because their self-perceived value in comparison to the one-year deal is too imbalanced for consideration. On the other hand, some players drafted later in the first round are not extended qualifying offers by their respective teams because the players did not produce at a level at which their team wanted to keep them around for another season at the slotted qualifying offer amount.

In addition to the seven former first-round draft picks who have signed one-year qualifying offers during the past six NBA seasons, several second-round picks and undrafted players have signed qualifying offers.<sup>58</sup> The req-

---

<sup>54</sup> See NBA Free Agent Trackers, *supra* note 38.

<sup>55</sup> See *Ben Gordon*, BASKETBALL-REFERENCE.COM, <http://www.basketball-reference.com/players/g/gordobe01.html>; *Raymond Felton*, BASKETBALL-REFERENCE.COM, <http://www.basketball-reference.com/players/f/feltora01.html>; *Spencer Hawes*, BASKETBALL-REFERENCE.COM, <http://www.basketball-reference.com/players/h/hawessp01.html>; *Nick Young*, BASKETBALL-REFERENCE.COM, <http://www.basketball-reference.com/players/y/youngni01.html>; *Greg Monroe*, BASKETBALL-REFERENCE.COM, <http://www.basketball-reference.com/players/m/monrogr01.html>. One player, Marco Belinelli, signed a one-year qualifying offer that was well above what he was subsequently paid the following season (i.e., qualifying offer of \$3,777,604 for 2011-12 season vs. \$1,957,000 salary in 2012-13). See *Marco Belinelli*, BASKETBALL-REFERENCE.COM, <http://www.basketball-reference.com/players/b/belinma01.html>.

<sup>56</sup> Chuck Myron, *Players Who've Signed Qualifying Offers*, HOOPSRUMORS.COM (July 7, 2012), <http://www.hoopsumors.com/2012/07/players-whove-signed-qualifying-offers.html>.

<sup>57</sup> See *Id.*

<sup>58</sup> On average, historically more first-round draft picks are still in the NBA after two seasons and thus the focus of a franchise player designation system would be on

quisite qualifying offer for all restricted free agents who are not first-round picks is extremely low. The predetermined qualifying offer for second-round picks and undrafted players is the greater of (a) the applicable minimum league player salary for the relevant season plus \$200,000 or (b) 125% of the player's previous year's salary.<sup>59</sup> Consequently, these stipulated qualifying offers for second-round draft picks and undrafted free agents often-times undervalue a player even more than the rookie salary scale qualifying offers for first-round picks.

Overall, thirty-two restricted free agents over the past five seasons signed offer sheets with a new team that the prior team, who had the right of first refusal, did not match. An additional 10 restricted free agents in the past five seasons have been "signed-and-traded" to a new team in restricted free agency. Over this same period, seven players signed offer sheets with a new team that their prior team matched, thus keeping the player with the prior team.<sup>60</sup> In comparison, 20 unrestricted free agents in the 2014 off-season signed contracts with a starting salary of at least \$4 million with a

---

first-round picks and the unbalanced qualifying offer system for this particular subgroup of players. For reference, according to NBA.com, on average eight former second-round picks out of 30 selections each year were still in the NBA after just two seasons during the 2010-2012 time period, compared to an average of 24 former first-round picks playing through their four-year rookie scale contract over the same three-year period. Some former second-round picks, such as Carl Landry, encounter a situation where their current teams extend a qualifying offer for under \$1 million and the player's options are limited because other teams are reluctant to offer a contract due to the prior team's right of first refusal. Second-round picks and undrafted players are not subject to the first-round rookie scale and can sign contracts at a length between one and four years as rookies.

<sup>59</sup> See NBA CBA art. XI. All terms and conditions in the qualifying offer must be unchanged from those that applied to the last year of the player's prior contract. Note, however, that some foreign-born players drafted in the second-round, such as Manu Ginobili, Andres Nocioni, Luis Scola, David Andersen, and Marc Gasol, have received larger qualifying offers because they signed lucrative rookie deals, which the teams offered to convince the players to give up their high-paying foreign-league contracts to join an NBA team. Also note that qualifying offers in the NBA are now in part based on player performance. This is a change from the qualifying offer model in past CBAs. For example, if a player picked 31st to 60th in the second-round (or an undrafted player) meets one of the "Starter Criteria," then the player's qualifying offer amount will be equal to the qualifying offer for the 21st overall draft pick. *See id.*

<sup>60</sup> Data collected via NBA Free Agent Trackers, *supra* note 38. Each player's free agent contract was researched and subsequently analyzed by the authors of this article to produce the data on restricted free agents.

new team.<sup>61</sup> Players, teams, fans and the league can benefit from franchises keeping their marquee former first-round draft picks and other players who want to stay but end up leaving because of a perceived injustice based on the current restricted free agency and qualifying offer rules. The current system, in which players end up reluctantly signing preset one-year qualifying offers or teams reluctantly extend a qualifying offer to an underperforming player, contradicts this goal.

Even in cases in which teams offer players more money than required in qualifying offers (e.g., David Lee and Nate Robinson with the New York Knicks in 2009) to maintain good relations for future negotiations, the players rarely stay with that team after their one year contracts expire. Lee's agent, Mark Bartelstein, praised the Knicks for giving Lee more money than what his qualifying offer required: "There's never been a player who signed a deal worth more than the qualifying offer on a one-year deal . . . We're very appreciative of that. They did something that's unprecedented . . . they could have taken a much harder stance on this. We'll deal with next summer when we get to it."<sup>62</sup> But, sure enough, neither Lee nor Robinson was on the Knicks roster past the one-year contracts they were given in lieu of a qualifying offer. The Knicks declined to extend Lee on a long-term contract for what he perceived his value to be.<sup>63</sup> They also traded Robinson midway through the following season to a division rival.<sup>64</sup> There appears to be a repeated pattern of irreparable discord when a player does not receive a long-term commitment from a team to which he has added value for multiple seasons.

The following section of this article highlights several case studies that illustrate how a franchise player designation system could supplement the NBA's restricted free agency system and also function as a much more effective alternative to the NBA's current qualifying offer model.

---

<sup>61</sup> See *2014 Free Agent Tracker*, NBA.COM, <http://www.nba.com/freeagents/> (last updated Oct. 23, 2014).

<sup>62</sup> See Marc Stein, *Source: Robinson Also Close to Deal*, ESPN.COM (Sept. 25, 2009, 11:24 AM), <http://sports.espn.go.com/nba/news/story?id=4501088>.

<sup>63</sup> Kelly Dwyer, *The Knicks trade David Lee for three Golden State Warriors*, YAHOO! SPORTS (July 9, 2010), [http://sports.yahoo.com/nba/blog/ball\\_dont\\_lie/post/The-Knicks-trade-David-Lee-for-three-Golden-Stat?urn=nba,254883](http://sports.yahoo.com/nba/blog/ball_dont_lie/post/The-Knicks-trade-David-Lee-for-three-Golden-Stat?urn=nba,254883); Chris Forsberg, *C's Land Robinson, Send House to N.Y.*, ESPN.COM (Feb. 19, 2010), <http://sports.espn.go.com/boston/nba/news/story?id=4924052>.

<sup>64</sup> See Forsberg, *supra* note 63.

IV. FRANCHISE PLAYER DESIGNATION CASE STUDIES—DEMONSTRATING  
THE NEED FOR A FRANCHISE TAG IN THE NBA

*Case Study: The Dwight Howard Trade Market in 2012*

The most obvious case study focusing on the power of leverage in the modern NBA trade market might be with Dwight Howard and the Orlando Magic in 2012. Without Howard opting-in for the final year of his maximum salary contract, Orlando would have likely settled on a less than ideal trade offer from the Brooklyn Nets (thus, adding star power to a big-market team while simultaneously hurting a small-market team). Orlando stood to lose Howard as a free agent the following summer so there was little incentive for a major market team to offer Orlando valuable assets in a trade when they could possibly add Howard as a free agent a few months later.

Howard, however, opted-in to the final year of his contract and the Magic were given more time to figure out what to do concerning Howard's dissatisfaction with the team. When the Magic's relationship with Howard proved unsalvageable the following summer, the team was still able to find a better trade offer because of the leverage gained with Howard's contract on the payroll for a full extra season.

As a result, Orlando stands well prepared for the future with the acquisitions of Nikola Vucevic, a pick that later turned into Elfrid Payton and other serviceable role players in the trade that sent Howard to the Los Angeles Lakers. If Orlando stubbornly committed to keeping Howard regardless of his impending departure—instead of looking to trade him that summer—they would have had an additional season to see if they could entice him into signing a long-term deal but likely would have lost him in unrestricted free agency for nothing, a season delayed. Howard crossed a threshold with the Magic in which he went from being a franchise centerpiece to becoming a major trade asset that could return valuable assets (i.e., players and draft picks). A superstar player, such as Howard, is most valuable on the trade market when he has at least a full year remaining before his current contract is set to expire. It is in the incumbent team's best interest to trade its superstar before some small-market teams—that would ordinarily be interested in acquiring the superstar—determine themselves incapable of convincing the superstar to stay beyond the short term.

*Case Study: The LeBron James 2010 "Decision" Revisited  
with a Franchise Tag Twist*

The Cleveland Cavaliers had the ability to match any offer LeBron James received on the open market in 2006. Knowing this, James extended his contract in Cleveland because the team was guaranteed to retain his rights even if he were to have tested the free agent market. Drafted in 2003, James was almost certainly guaranteed to be under contract with the Cleveland Cavaliers for a minimum of five years. Four of those years were under a rookie contract (with a team option for the third and fourth years of this contract) and, at the very least, a fifth year was guaranteed if Cleveland were to extend a qualifying offer (and also match any offer from another team).<sup>65</sup>

Few teams decline to match a restricted free agent's maximum offer from an opposing team on the open market. As a result, James signed a 3-year, \$60 million deal in 2006 with Cleveland and bypassed the process of signing an offer sheet elsewhere only to be retained by the Cavaliers.<sup>66</sup> When James hit unrestricted free agency in 2010, Cleveland assumed its recent success and location in Ohio (James was born in Akron) would be enough to entice James into signing a second long-term extension.

When James decided to leave for Miami, Cleveland was left with the "consolation opportunity" to trade for Miami's future draft picks in a sign-and-trade (Cleveland received two future first-round picks and two second-round picks.)<sup>67</sup> James blindsided Cleveland in his free agent process. Regardless, he still had enough negotiating power to sign for six-years guaranteed in Miami after Cleveland came to agree to a sign-and-trade. Cleveland, not wanting to lose James for nothing, eventually helped James acquire that extra year in free agency by agreeing to sign-and-trade his contract as a way to salvage what then-current Cavaliers' General Manager Chris Grant called "multiple key assets and additional flexibility as we move forward."<sup>68</sup>

If Cleveland had the opportunity to use a franchise tag on James in 2010, the team could have retained James and found a potential trading partner in the following season if James proved to be disgruntled with the

---

<sup>65</sup> Assoc. Press, *Deal Worth Almost \$13 Million in First Three Years* (July 3, 2003), available at <http://espn.go.com/nba/news/2003/0703/1576436.html>.

<sup>66</sup> Assoc. Press, *LeBron Officially Signs Contract Extension with Cavs* (July 18, 2006), available at <http://sports.espn.go.com/nba/news/story?id=2523410>. The contract included a player-option for a fourth year, and thus lasted until 2010.

<sup>67</sup> See Press Release, Cleveland Cavaliers, *Cavaliers Complete Sign-and-Trade Deal with Miami* (July 10, 2010), available at [http://www.nba.com/cavaliers/news/trade\\_100710.html](http://www.nba.com/cavaliers/news/trade_100710.html).

<sup>68</sup> *Id.*

organization. As Dwight Howard's case study shows, teams gain significant leverage when they own the rights to a player's contract for at least one additional season. If James was sincerely committed to leaving Cleveland, he would have only had to play there for at most one extra season and would have likely been traded to a playoff contender at the trade deadline (for a package of assets that would have dwarfed Cleveland's actual sign-and-trade return).

#### V. THE PROPOSED NBA FRANCHISE PLAYER DESIGNATION MODEL

Based on the above analysis, this article proposes an NBA franchise player designation model. The objective of this proposed model is to increase competitive balance by providing incumbent teams—usually from smaller market cities like Minnesota and Milwaukee—with increased leverage in contract negotiations to retain key (i.e., “star” / “franchise”) players.<sup>69</sup>

The franchise player designation should be considered exclusively for first-round picks who last played under a four-year rookie salary scale contract and for players who are scheduled to earn at least \$10 million in average annual salary during a multi-year contract signed in free agency. The remainder of this section details how the franchise player designation framework would operate in each of these two situations. See Figure 1 for a step-by-step detailed overview of the proposed franchise player designation system.

##### *Franchise Player Designation Framework for Players Finishing Fourth Year of Rookie Salary Scale Contract*

In the case of former first-round draft picks who are finishing their fourth year of a rookie salary scale contract, the franchise tag tender amount will be the greater dollar value of (a) 125% of the player's fourth year rookie scale salary, or (b) 150% of the Early Qualifying Veteran Free Agent (EQVFA) value for that season.<sup>70</sup> The player would also have an option to

---

<sup>69</sup> Unlike the franchise tag model proposed by the NBA in 2010/2011, in which the tendered players would have been required to consent to being tagged, the current proposed franchise player designation model does not require player consent. For a description of this aspect of the 2010/2011 NBA proposal see Rivers McCown, *NBA Lockout: The NBA's Take On Franchise Tags Is Intriguing*, SBINATION, May 12, 2011, <http://houston.sbnation.com/houston-rockets/2011/5/12/2167524/nba-lockout-franchise-tag-non-guaranteed-contracts>.

<sup>70</sup> See NBA CBA art. VII §6.



extend the franchise tag for a second year, in which the player's salary would be 150% of his salary in the first year of the franchise tag.

Other than for the top two or three draft picks each year (whose fourth year salary greatly exceeds the EQVFA amount), the greater value in the above formula will typically be the 150% of the EQVFA value. The EQVFA value is equal to 104.5% of the average player salary in the NBA; for the 2014-15 season, that amount was \$5,565,000.<sup>71</sup> The EQVFA provision in the proposed franchise tag model protects first-round picks drafted outside of the top two or three overall selections from receiving a franchise tender that would potentially pay them significantly less than a fair market value.

Some of the league's top players have been drafted in the first round but not in the top ten draft picks. For example, Chicago's Jimmy Butler earned \$2,008,748 in the fourth year of his rookie scale contract after being selected 30th overall in the 2011 draft.<sup>72</sup> Butler's qualifying offer for the following season would have been \$3,178,821. Without the EQVFA stipulation in our model, Chicago would have been able to franchise tender Butler to a first-year team option at just \$2,510,935 (equal to 125% of his fourth year salary). Butler's second-year player option at 150% of the first year would be just \$3,766,402. Both of these figures significantly undervalued Butler's potential earnings on the open market.<sup>73</sup> However, with 150% of the NBA's 2014-2015 EQVFA provision, Butler would receive \$8,347,500 in the first year of the franchise tender. If Butler were to exercise his second year player option at 150% of the first year franchise tag salary, he would receive \$12,521,250 in the second year. Both years' salaries, in this model, add up to a two-year contract worth \$20,868,750—a salary that was very close to Butler's estimated free agent value before the start of the 2014-2015 NBA season.

Let's consider another example. For 2014 NBA Finals MVP Kawhi Leonard, who earned \$2,894,059 in the fourth year of his rookie scale contract after being selected 15th overall in 2011,<sup>74</sup> a 125% increase on his rookie scale's fourth year would equate to just \$3,617,572 in the first year of

---

<sup>71</sup> See *id.*

<sup>72</sup> Jimmy Butler, BASKETBALL-REFERENCE.COM, <http://www.basketball-reference.com/players/b/butleji01.html>.

<sup>73</sup> Zach Lowe (Grantland.com) and Amin Elhassan (ESPN.com) estimated Butler would receive approximately \$10 million annually in free agency. See *The Lowe Post Podcast*, GRANTLAND.COM (Oct. 2, 2014), <http://grantland.com/the-triangle/the-low-post-podcast-zach-lowe-and-amin-elhassan-ricky-rubio/>.

<sup>74</sup> Kawhi Leonard, BASKETBALL-REFERENCE.COM, <http://www.basketball-reference.com/players/l/leonaka01.html>.

the proposed franchise player designation model.<sup>75</sup> For the franchise tender's second-year player option, Leonard would receive only \$5,426,358. In a similar situation to Butler's, a two-year deal worth approximately \$9 million total for Leonard grossly undervalues his potential earnings on the free agent market. With the EQVFA provision in the proposed model, Leonard would receive an identical contract to Butler's two-year, \$20,868,750 deal. While this model still underestimates Kawhi Leonard's free agent market value, the incumbent San Antonio Spurs would have to be cautious with using their franchise tender on Leonard as he would easily be able to decline his second-year player option (worth \$12,521,250) and test free agency as an unrestricted free agent at the age of 24 after the 2015-16 NBA season.

*Franchise Player Designation Framework for Free Agents with \$10 Million or Greater Average Annual Salary in Expiring Multi-Year Free Agent Contract*

In the case of players in the final year of a multi-year free agent contract with an annual average salary of at least \$10 million, the franchise tag tender amount will be 125% of the player's salary in the final year of his contract. The player would also have an option to extend the franchise tag for a second year, in which the player's salary would be 125% of his salary in the first year of the franchise tag.

For example, for Kevin Love during the 2015 offseason,<sup>76</sup> the franchise tag amount would be calculated by taking his 2014 season's salary of \$15,719,063<sup>77</sup> and multiplying that salary by 125%, which results in a salary in the franchise tag year of \$19,648,830.<sup>78</sup> Love's salary for season one of the franchise tag would get multiplied by another 125% in the player option season, which would result in a salary of \$24,561,038 if Love exercised

---

<sup>75</sup> The qualifying offer for Leonard for the following season would be \$4,428,608.

<sup>76</sup> Kevin Love has a player option to remain on the Cavs for next season at \$16,744,219. Bob Finnan, *Bob Finnan's NBA notes: Examining Kevin Love's contract options*, THE MORNING JOURNAL (May 2, 2015), <http://www.morningjournal.com/sports/20150502/bob-finnans-nba-notes-examining-kevin-loves-contract-options>. He is expected to decline this player option and become an unrestricted free agent. Yaron Weitzman, *Lebron James, Kevin Love Expected to Opt out of Contracts with Cavaliers*, SBINATION, Jun. 18, 2015, <http://www.sbnation.com/nba/2015/6/18/8810483/lebron-james-kevin-love-expected-to-opt-out-of-current-contracts>.

<sup>77</sup> *NBA Player Salaries – 2014-2015*, ESPN.COM, [http://espn.go.com/nba/salaries/\\_/year/2015/seasontype/4](http://espn.go.com/nba/salaries/_/year/2015/seasontype/4).

<sup>78</sup> The \$19,648,830 franchise tag salary exceeds Love's potential earnings in a max contract elsewhere (\$17,695,200) by \$1,953,629 in the first year.

his player option—approximately \$6 million more than the maximum allowed salary in the second year of a free agent contract offered by another team.

Al Horford's contract situation functions as an excellent additional case study to illustrate how the franchise player designation operates for veteran free agents. In this upcoming NBA season, Horford will be in the final year of a five-year, \$60 million contract he signed with the Atlanta Hawks.<sup>79</sup> Horford's salary in the first year of the franchise tag would be \$15 million (125% of \$12 million). If Horford decided to exercise his player option, his salary in the second year of the franchise tag would be \$18,750,000 (125% of \$15 million).

#### *Other Important Components of the Proposed Franchise Player Designation Model*

*Limit on Number of Tags.* A required provision within this proposed model is that each team can only hold one franchise-tagged player on its roster at any given time. In addition, no player can be tagged multiple times by the same team nor can more than two teams tender the same player in a three-year period.

*Second-round Picks and Undrafted Players.* A second-round draft pick or an undrafted free agent can only qualify for a team's franchise tender after he finishes both his rookie salary scale contract and an additional multi-year contract in free agency. This rewards players drafted in the second round (e.g. Chandler Parsons, Isaiah Thomas) by granting them an opportunity to test their free agent value after they outperform their rookie salary scale and free agent contracts.

*Exercising the Player Option.* The proposed model will also require a player to either exercise or decline his second-year player option during the NBA season (before February's trade deadline) to give his incumbent team a better understanding of the player's intentions. This increases the likelihood that a player will either renegotiate with his incumbent team for a long-term contract or will give his incumbent team enough time (i.e., leverage) to acquire some legitimate talent in a trade. This player option provision also intentionally creates some risk and uncertainty for teams. For example, the player option provision should increase the level of cautiousness of teams before they utilize the franchise tag on a particular player, because even if that tagged player struggles on the court in the franchise tag year, it is the

---

<sup>79</sup> Al Horford, ESPN.COM, [http://espn.go.com/nba/salaries/\\_/year/2015/season-type/4](http://espn.go.com/nba/salaries/_/year/2015/season-type/4).

player (not the team) who has the option to extend the franchise tag contract for the second season.

*Trading a Player Under Rookie-Scale Contract Franchise Tag.* An incumbent team that uses its franchise tender on a player finishing his four-year rookie contract will also be required to extend a no-trade clause to this player in the franchise tender. The result is the player will be on that team for at least the entire initial franchise tag season—unless the player consents to a trade. This rule prevents situations in which up-and-coming players receive franchise tenders yet still face the risk of being traded to a new team during the initial franchise tag year. This gives added negotiating leverage to the players coming off of rookie contracts and prevents teams from using their franchise tender merely as a means of maximizing the trade value of a young player.

*Trading a Player Under Veteran Free Agent Franchise Tag.* If a team trades the tendered player during the first year of the franchise designation, the player would lose his right to sign the second-year player option (at a 125% increase) with his new team.<sup>80</sup> Instead, the acquiring team would reserve the right to subsequently use its own franchise tag on the player acquired in the trade in the following off-season if the acquiring team wanted to ensure the newly acquired player does not leave the team without first playing at least one full season with the team.<sup>81</sup> This gives players more incentive to stay with their current team but also makes player contracts more appealing around the league for future trades. This provision also grants small-market teams additional security and comfort when trying to trade for a star player.<sup>82</sup> Meanwhile, the incumbent team gains more leverage on the trade market as the player instantaneously becomes more attractive around the league without the 125% guaranteed salary increase during the second year player option attached to his contract. Because the rules of the proposed

---

<sup>80</sup> A team is permitted to trade for a franchise tag player only if the team does not currently have a franchise tag player under contract (either in first year of tag or in second year player option).

<sup>81</sup> If the team is unable to enter into a new contract with the acquired player, it is possible that the traded player would play less than a full season with the new team.

<sup>82</sup> The Sacramento Kings, for example, had reported interest in both Rajon Rondo and Kevin Love. However, because both players reportedly expressed disinterest in committing to Sacramento for the long-term, Sacramento was unable to trade for either star, as trading a package of valuable assets in return for star's rental contract proved to be too risky for Sacramento's front office. See Greg Wissinger, *Rajon Rondo Wants to Be Traded, But Not to the Kings*, SBNATION – SACTOWN ROYALTY (Aug. 31, 2014), <http://www.sactownroyalty.com/2014/8/31/6089791/rajon-rondo-trade-demand-rumors-Sacramento-kings>.

model stipulate that a player cannot be tagged by the same team twice or by more than two teams over a three-season period, the player will assuredly avoid a perpetual cycle of short-term contracts. If the incumbent team trades the player during the second year of the franchise designation (player option year), the acquiring team will retain the player's Larry Bird Rights<sup>83</sup> in free agency but will only be allowed to offer the player the maximum contract that he would ordinarily qualify for (based on years of NBA service) in free agency. In addition, if the incumbent team were to trade the player at any point in either year of his franchise tender, the team assuming the player's contract would only have to count the value of the highest paid non-tagged player in the league against that team's salary cap. The remainder of the player's salary would be paid in full to the player without it counting against the acquiring team's salary cap.

*Increasing Salary Cap for Teams Losing Players After Franchise Tag.* Similar to a traded player exception,<sup>84</sup> a "franchise tag exception" could be implemented when a player declines his second-year player option. This would assist the team that loses its key player with increased salary freedom in future trades and free agent acquisitions. For example, assume a player was franchise-tendered and elected to decline his player option for the second season of the tender in favor of a long-term contract elsewhere (e.g., four-year contract for \$97 million).<sup>85</sup> This contract equates to \$24.25 million pro-rated annually over four years. The incumbent team losing a player, with the franchise tag exception, would then divide \$24.25 million by four (the number of years on the player's new contract) and have that amount (approximately \$6.06 million) added to the team's salary cap annually for the duration of the player's first contract with the new team. At the very least, this rule provides the team with some flexibility to work with on the open market (i.e., giving the prior team who lost the player a significant monetary advantage in free agency if they wanted to replace the player with a new quality player).

---

<sup>83</sup> The Larry Bird Exception is also called the "Veteran Free Agent Exception," which allows the incumbent team to offer a higher salary amount and a longer salary length as compared with a new team. See NBA CBA art. VII §6(b).

<sup>84</sup> The traded player exception enables teams that are over the salary cap to complete trades in which the team is permitted to trade for players. See *id.* art. 7 §6(j).

<sup>85</sup> This example closely mirrors Chris Bosh's reported max-contract offer from the Houston Rockets in the summer of 2014. See Zack Cox, *Report: Chris Bosh 'Seriously Considering' Rockets' Four-Year Max Deal*, NESN.COM (Jul. 7, 2014), <http://nesn.com/2014/07/report-chris-bosh-seriously-considering-rockets-four-year-max-deal/>.

*Contract Extensions and Free Agency After Franchise Tag.* In this franchise tender model, a player will become an unrestricted free agent as soon as his franchise tag expires (either through opting-out after season one of the franchise tag, or after expiration of season two if the player exercises his option). If a player exercises his second-year player option, the team will be permitted to offer a contract up to five years in length with 12.5% annual increases that would begin the year following the second-year player option under the franchise player designation framework. The first year of this contract would be permitted to start at 112.5% of the amount of the player's salary in the second year (player option year) of the franchise tag.<sup>86</sup> This is another proposed CBA provision that increases the ability of teams to retain key players, as the 12.5% permitted increase under this provision is greater than the 7.5% annual increases that are otherwise allowed. For example, if a player who is coming off of the second-year player option (with a salary in that year of \$18,750,000 as in the Al Horford example above,) is offered a 5-year contract starting at \$20 million with 12.5% annual increases, the total value of this contract (approximately \$128 million) is approximately \$12 million total (about \$2.4 million per year) more than a 5-year contract starting at \$20 million with 7.5% increases. The \$128 million total contract value is also approximately \$40 million total (average of about \$4.2 million per year) more than the player would be allowed to receive in an offer from a new team in which the contract started at the same \$20 million but could only be for four years with 4.5% increases per year based on current NBA CBA rules.<sup>87</sup>

*Revisiting the LeBron James Case Study Based on the Proposed  
Franchise Tag Model*

If the proposed franchise tag framework had been in place in 2010, the Cavaliers could have kept James for the 2010 season and traded him at the February 2011 deadline if he were clear with his intentions to leave (i.e., decline the franchise tag's second-year player option). James' salary in the final year of his then-expiring free agent contract (\$15,799,912) would have been multiplied by 125%, which results in a salary of \$19,749,890 for year

---

<sup>86</sup> If both the team and player were to agree, the five-year contract could feature a fixed salary across all five years. For example, with Jimmy Butler, instead of five salary increases worth 12.5% annually in a contract starting at \$14,086,406 and reaching \$22,563,698 by the fifth season, the Chicago Bulls and Butler could agree on a five-year contract worth the same total five-year value with a base salary of \$18,076,410 in all five seasons.

<sup>87</sup> See NBA CBA art. XI §4.

one under the proposed franchise player designation model. While a player such as James might be upset with his lack of control in negotiations with a team under the franchise player designation framework, he would take comfort in knowing the incumbent team would be paying him substantially more money in the franchise tag tender year as compared with the maximum amount a new team would be permitted to pay him in the first year of a free agent contract.<sup>88</sup> And, if James decided to exercise his player option for year two under the proposed franchise tag system, his \$19,749,890 salary for season one under the franchise tag model would get multiplied by another 125%, resulting in a second year franchise tag salary of \$24,687,363. The \$24,687,363 salary in the player option year is such a high dollar figure (almost 40% of a team's salary cap for the 2014-15 season) that the incumbent team must feel strongly committed to keeping a player to justify extending a franchise tender.

This near-\$25 million salary figure exceeds what James would have received in a maximum contract (under the current CBA) signed with 4.5% annual increases from a new team by approximately \$4 million, even in the final season of a maximum contract. The \$24,687,363 salary also essentially matches the maximum salary of what James would have received in the final season of a maximum contract (under the current CBA) with 7.5% annual increases signed with the incumbent Cavaliers.<sup>89</sup>

Cleveland, in this model, would have undoubtedly extended a franchise tender in 2010-2011 and would have gained at least one extra year of time to win a championship. If the Cavaliers knew James would leave after the

---

<sup>88</sup> For maximum salary players with 0-6 years of NBA experience, the 125% franchise tag raises the maximum possible salary from \$14,746,000 to \$18,432,500 in the first year's team option (a gain of \$3,686,500). For maximum salary players with 7-9 years of experience, the 125% franchise tag raises the maximum possible salary from \$17,695,200 to \$22,119,000 in the first year's team option (a gain of \$4,423,800). For maximum salary players with 10+ years of experience, the 125% franchise tag raises the maximum possible salary from \$20,644,400 to 25,805,500 in the first year of the franchise tag (a gain of \$5,161,100).

<sup>89</sup> See NBA CBA art. II §7 for reference: James would receive \$25.4 million in his fifth year of a maximum contract with the incumbent Cavaliers after 7.5% annual salary increases. James would receive \$21.1 million in the fourth year of a maximum contract with a new team after 4.5% annual salary increases. As a frame of reference, Deron Williams has been playing several seasons on a maximum contract with 7.5% annual contract increases following his summer of 2012 maximum contract with the incumbent Brooklyn Nets and still will never earn close to \$25 million annually when his contract expires in 2017. Williams will earn 22.3 million in the final year of his deal in 2016-2017 despite signing that contract five years earlier and having years of accumulated 7.5% interest on his maximum salary in every season.

2010-2011 season (i.e., James declines his second-year player option), the Cavaliers could have then shopped James on the trade market at the February trade deadline and acquired the biggest mid-season trade haul in NBA history. After all, if the Cavaliers traded James to one of his preferred destinations, that acquiring team would have all but certainly secured assurance from James that he intended to remain long-term with this new team. Or, in the plausible course of events in which a small-market team with an available franchise tag traded for James, that small-market team would secure James's services for at least one guaranteed additional season. This would provide Cleveland with a virtually endless list of suitors to trade with and, in most cases, ensure that the team with the best trade offer would end up with the superstar.

James' contract with his new team would start at the greater of 30% of the salary cap or 105% of the dollar value of what he was earning in the first (and final) year of the franchise tender.<sup>90</sup> The acquiring team would also acquire James' Larry Bird Rights. In the more likely example in which the Cavaliers gained assurance from James that he planned to stay for his second-year player option (i.e., James signed before the February deadline), Cleveland would gain another full season of guaranteed control on James' contract to build a contender around their superstar. James would become an unrestricted free agent after the player option year and Cleveland would be unable to franchise tender him again. But, under the proposed franchise player designation model, Cleveland could offer James a new five-year free agent contract starting at 112.5% of his salary in the player option year of the franchise tag—this would amount to a starting salary of \$27,773,283—with additional annual increases of 12.5% in subsequent years of this contract.

## VI. CONCLUSION

An effective franchise player designation system should aim to give teams an opportunity to retain a key player, preserve a player's contract rights as an asset in future negotiations (e.g., free agency or trade), and/or to gain more time to evaluate an underperforming player before committing to a multi-year contract. Conversely, an effective franchise player designation system should not be used as a mechanism for teams to keep players on

---

<sup>90</sup> “[F]or any player who has completed at least seven (7) but fewer than ten (10) Years of Service, the greater of (x) thirty percent (30%) of the Salary Cap in effect at the time the Contract is executed, or (y) one hundred five percent (105%) of the Salary for the final Season of the player's prior Contract.” NBA CBA art. II §7(a)(ii).



contracts at salaries below a player's market value. In addition, a sustainable franchise designation system must also provide an NBA player with some leverage and control of his future by providing flexibility with respect to contract length and salary (e.g., one or two year franchise tag contract vs. four or five year free agent contract). Under the franchise player designation system proposed in this article, the team would have leverage in year one (i.e., year in which franchise tag is tendered), but the player would have leverage in year two (i.e., deciding whether to exercise player option). Both the team and player would benefit by the ability to enter into a long-term (e.g., five year) contract following the player option franchise tag year, which would allow a higher starting salary and higher percentage annual salary increases than are otherwise allowed under the CBA.

The proposed franchise tag model would increase the chances that an incumbent team will either agree with the player on a multi-year contract or consider trading the star player before the team's leverage on the trade market dissipates. Either way, teams will gain more clarity on their star player's intentions and will retain control of his contract on the trade market without risking the possibility of losing that player in unrestricted free agency. Meanwhile, players benefit from higher annual wages in this franchise tag model—especially in comparison to the current qualifying offer model.

Would having a franchise player designation system in place increase a player's willingness to sign a one-year deal (or two-year deal if player exercises option) to remain with his current team and explore free agency the following year if he was going to be paid a high salary for that season (or those two seasons)? For reference, if there is not a franchise player designation, players such as Kevin Love will continue to use leverage in either (a) claiming that he would rather play out his contract, as opposed to signing an extension, in order to capitalize on a robust free agent market, or (b) trying to immediately force a trade to another team.<sup>91</sup> Other ancillary factors that would increase a player's willingness to re-sign for one season (or two seasons) with his current team include a player's prior injury history, the team's position with respect to the luxury tax, the team's ownership situation, the team's desire to see how the player performs with a new coach, and a player's desire to test the market the following year after improved production or when the free agent class is not as strong.

In conclusion, although it is uncertain as to whether NBA owners and players will agree to any franchise player designation system in the near future, expect NBA owners to once again propose a franchise tag system

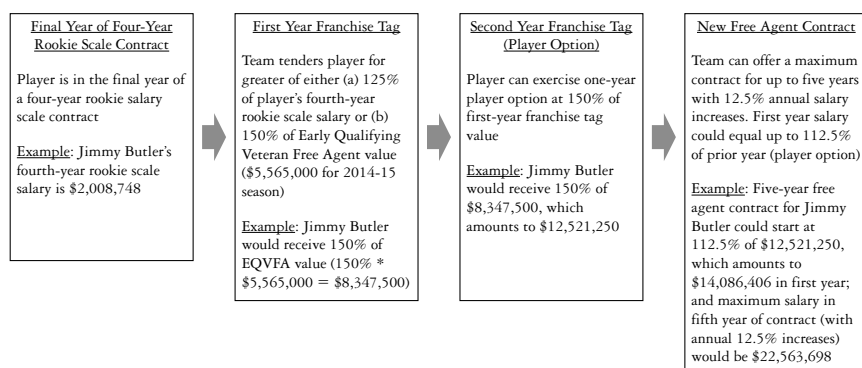
---

<sup>91</sup> See Kyle Stack, *A Franchise Tag in the NBA*, SLAM ONLINE MAGAZINE (Sept. 2, 2010), <http://www.slamonline.com/online/nba/2010/09/a-franchise-tag-in-the-nba>.

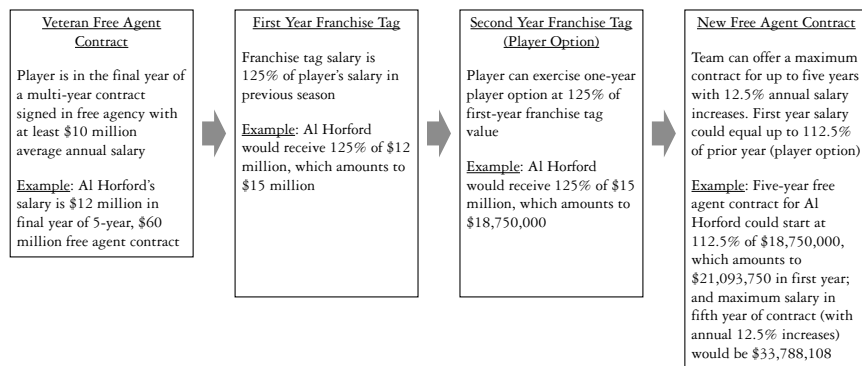
during the next round of collective bargaining—which could take place as early as 2017.

FIGURE 1 – CONCEPTUAL MODEL FOR PROPOSED NBA FRANCHISE  
PLAYER DESIGNATION SYSTEM

*Franchise Player Designation Framework for Players Finishing Fourth Year of  
Rookie Salary Scale Contract*



*Franchise Player Designation Framework for Free Agents with \$10 Million or  
Greater Average Annual Salary in Expiring Multi-Year Free Agent Contract*





## Without Consequence: When Professional Athletes Are Violent Off the Field

Bethany P. Withers\*

### I. INTRODUCTION

In Spring 2010, I wrote an article reviewing the treatment by Major League Baseball (“MLB”), the National Football League (the “NFL”) and the National Basketball Association (the “NBA”) of professional athletes who are accused of domestic violence.<sup>1</sup> At the time, there was very little written on the subject—a number of articles in the late 1990s focusing on the murders of Nicole Brown Simpson and Ron Goldman by famous former running back, O.J. Simpson (and the countless 911 domestic violence calls placed by Nicole Brown Simpson that preceded those deaths) and some pioneering works by author Jeff Benedict.<sup>2</sup>

Just five years later, the story is quite different. The NFL’s treatment of domestic violence was selected as the sports story of 2014 in an annual vote conducted by the Associated Press.<sup>3</sup> For the first time since the late

---

\* Bethany P. Withers is a graduate of Harvard Law School (2010), an attorney at Goodwin Procter LLP and the author of *The Integrity of the Game: Professional Athletes and Domestic Violence*, 1 HARV. J. SPORTS & ENT. L. 146 (2010). Prior to joining Goodwin Procter LLP, Ms. Withers served as the Policy & Programs Manager at the Massachusetts Chapter of the National Organization for Women. She also has experience working and volunteering at domestic violence shelters. The information contained in this article reflects the opinions of the author and is not an official opinion of Goodwin Procter LLP.

<sup>1</sup> *Id.* For purposes of this article, the “leagues” means MLB, the NFL and the NBA, and “professional athletes” means players in the leagues.

<sup>2</sup> Jeff Benedict is now a contributor for *Sports Illustrated*, and a writer for SI.com. His books on professional athletes and violence against women (*Public Heroes, Private Felons: Athletes and Crimes against Women*; *Pros and Cons: The Criminals Who Play in the NFL*; and *Athletes and Acquaintance Rape*) were, and still are, groundbreaking.

<sup>3</sup> Rachel Cohen, *NFL Domestic Violence, LeBron Top Sports Stories of Year*, DAILY HERALD, Dec. 25, 2014, archived at <https://perma.cc/RQ4R-A6WF>.

1990s, the media is publicly recognizing the silent story that has laid dormant, overshadowed by the story of fame, glory, athleticism and America's favorite pastimes.

As in the late 1990s, the recent media attention on professional athletes and acts of off-field violence was precipitated by a widely publicized act of violence. Ray Rice, the esteemed running back for the Baltimore Ravens,<sup>4</sup> was caught on camera punching Janay Rice—his then fiancée and now wife—unconscious in a casino elevator and then, with seeming indifference, dragging her limp body from the elevator. This action resulted in an initial two-game suspension handed down by NFL Commissioner Roger Goodell, but was later increased to an indefinite suspension after the graphic video of the events that took place inside the elevator surfaced.<sup>5</sup> Ray Rice appealed the indefinite suspension and, ultimately, it was overturned by a neutral arbitrator, former U.S. District Judge Barbara S. Jones, who found the penalty “arbitrary” because Ray Rice admitted he struck Janay Rice and never misrepresented the facts to Commissioner Goodell<sup>6</sup>—the increase in the suspension seemed solely linked to the public backlash, largely influenced by the images caught on camera, rather than any new evidence. As Judge Jones wrote, “That the League did not realize the severity of the conduct without a visual record also speaks to their admitted failure in the past to sanction this type of conduct more severely.”<sup>7</sup>

As in many domestic violence cases, Janay Rice has supported her husband throughout the media storm, criminal process and league punishment.<sup>8</sup> It is unfortunate that her personal life has become the fodder for a much-needed debate that should have been happening for some time. The point of the debate should never be the reaction of the survivor. However, it is telling to learn that the Baltimore Ravens suggested that *sbe*, Janay Rice, apologize for her role in the domestic violence incident alongside her hus-

---

<sup>4</sup> Throughout this article, when referencing allegations against players, I refer to the team on which they played at the time of the allegation, even if the player no longer plays for that team.

<sup>5</sup> Ken Belson, *Ray Rice Wins Reinstatement to N.F.L. in Arbitration*, N.Y. TIMES, Nov. 28, 2014, archived at <http://perma.cc/C3HZ-TZ2G>.

<sup>6</sup> *Id.* Despite his reinstatement, Rice has not been picked up by a team for the 2015 season as of the date this article is written.

<sup>7</sup> *Ray Rice Wins Appeal, Eligible to Sign*, ESPN.COM (Dec. 1, 2014), [http://espn.go.com/nfl/story/\\_/id/11949855/ray-rice-baltimore-ravens-wins-appeal-eligible-reinstatement](http://espn.go.com/nfl/story/_/id/11949855/ray-rice-baltimore-ravens-wins-appeal-eligible-reinstatement), archived at <http://perma.cc/DME3-RECL>.

<sup>8</sup> Aaron Wilson, *Janay Rice Says Ravens Suggested She Apologize*, THE BALT. SUN, Dec. 2, 2014, at 5D.

band. The Ravens tweeted (and later deleted): “Janay Rice says she deeply regrets the role that she played the night of the incident”.<sup>9</sup>

Janay Rice has since said that she is glad the incident brought awareness to the issue of domestic violence.<sup>10</sup> The leagues, the public and even Congress are now debating the issue of violence against women.<sup>11</sup> Violence against women is not unique to professional sports, but professional sports provides a unique platform from which we can judge not only the leagues’ reaction to violence against women, but also the consequent response (or lack of response) by the criminal justice system. Some may argue that MLB, the NFL and the NBA should only be concerned with the on-field behavior of their respective athletes, but this is not the stance the leagues have taken. Each of MLB, the NFL and the NBA has consistently doled out punishment for off-field conduct unrelated to the game, such as driving under the influence, using non-performance enhancing drugs like marijuana and even making racist or homophobic statements (which, while repugnant, is not criminal behavior). If the leagues were only to concern themselves with on-field behavior (or off-field behavior that affects the outcome of games, such as use of performance-enhancing drugs), at least it would be a logically consistent policy. Instead, the leagues have been inconsistently punishing players for certain off-field criminal behavior—arguably implicitly condoning the off-field criminal behavior that typically goes unpunished, such as violence against women. As Senator Claire McCaskill (Democrat of Missouri) said in her testimony at a Senate Committee on Commerce, Science and Transportation hearing on the issue of professional sports and violence against women: “With great power and influence comes great responsibility.”<sup>12</sup>

---

<sup>9</sup> *Id.* Others also rushed to a victim-blaming response, such as color commentator Stephen A. Smith, who, in the wake of the Rice controversy, suggested that women should not do things to provoke their spouses or boyfriends to assault them. ESPN suspended Mr. Smith for one week for his comments. Kevin E. Reed, *ESPN Fumbles on Domestic Abuse Issue*, THE COMMERCIAL APPEAL, Sept. 9, 2014, at 7.

<sup>10</sup> Wilson, *supra* note 8.

<sup>11</sup> Domestic violence and sexual assault are also perpetrated against men. The focus on violence against “women”, and reference to victims/survivors using female pronouns, in this article is not meant to diminish the gravity of such offenses when perpetrated against men. However, each reported case of alleged domestic violence or sexual assault by a professional athlete in the NFL, NBA or MLB has been of such athlete committing such violence against a woman. Thus, I refer to violence against women, and use female pronouns, to focus the problem being addressed in this article.

<sup>12</sup> Steve Kraske, *TheChat: Claire McCaskill Goes after Domestic Abuse in Pro Sports*, KANSAS CITY STAR, Dec. 3, 2014, archived at <http://perma.cc/DV9Y-AY7M>.

The leagues seem to understand their responsibility now—or at least that there will be a media backlash if they do not think critically about drafting and, even more importantly, implementing policies that recognize violence against women as a punishable offense by the leagues. The NFL is leading the way, with Commissioner Goodell having hired three female experts in the field to inform NFL policy—Lisa Friel, the former head of the Sex Crimes Prosecution Unit in the New York County District Attorney’s Office, Jane Randel, co-founder of NO MORE, and Rita Smith, the former executive director of the National Coalition Against Domestic Violence.<sup>13</sup> Further, the NFL owners have approved a revised personal conduct policy that, among other things, sets forth a process of review and punishment with respect to allegations of domestic violence and sexual assault (the “Revised NFL Policy”).<sup>14</sup> Commissioner Goodell stated, “Character and values sit[s] above everything else because [the NFL represents] something that means so much to so many people.”<sup>15</sup> Specifically with respect to domestic violence and sexual assault, Commissioner Goodell stated: “Each is a societal problem that is frequently underreported . . . As a league, we must have a continued focus on the needs of victims and families; among other things, we must encourage victims and those who observe such misconduct to come forward, to report offenses, and to seek help.”<sup>16</sup>

Unfortunately, this recent rhetoric does not align with the way the leagues handled domestic violence and sexual assault prior to the media maelstrom—in fact, it is a departure. A review of domestic violence and sexual assault allegedly perpetrated by athletes in MLB, the NFL and the NBA from January 1, 2010 through December 31, 2014 shows that the leagues have not had such a “continued focus” to date. Based on a Westlaw search of newspapers across the United States,<sup>17</sup> there were 64 reported incidents of domestic violence or sexual assault allegedly committed by athletes

---

<sup>13</sup> Will Brinson, *NFL Hiring Female Advisers to Shape Domestic Violence Policies*, CBSSPORTS.COM (Sept. 15, 2014), <http://www.cbssports.com/nfl/eye-on-football/24710845/nfl-hiring-female-advisors-to-shape-domestic-violence-policies>, archived at <http://perma.cc/89M7-XF4K>.

<sup>14</sup> *Owners OK New Conduct Policy*, ESPN.COM (Dec. 11, 2014), [http://espn.go.com/nfl/story/\\_/id/12009596/memo-roger-goodell-nfl-owners-outlines-conduct-policy-changes](http://espn.go.com/nfl/story/_/id/12009596/memo-roger-goodell-nfl-owners-outlines-conduct-policy-changes), archived at <http://perma.cc/4P6W-6EU2>. See NFL Personal Conduct Policy (Dec. 2014), <http://static.nfl.com/static/content/public/photo/2014/12/10/0ap3000000441637.pdf>, archived at <http://perma.cc/Q78G-XX9A> [hereinafter “Revised NFL Policy”].

<sup>15</sup> *Id.*

<sup>16</sup> *Id.*

<sup>17</sup> The Westlaw search captured all articles that included the terms “Major League Baseball,” “National Football League,” “National Basketball Association,”

in MLB, the NFL and the NBA during this five-year period. The results show that only one of the 64 reported allegations resulted in conviction for the alleged crime (though four players pleaded guilty to lesser charges and five pleaded no contest), only seven players were punished by their league, and only two players were punished by their team.<sup>18</sup>

If this statistic is not shocking enough, it is likely that the actual odds of a professional athlete being punished, by the criminal justice system, leagues or teams, for domestic violence or sexual assault are even lower than is evidenced by calculations based on media reports of such incidents. First, many victims of domestic violence and sexual assault do not report to the police. As discussed below, domestic violence and sexual assault have distinct complicating factors, including, for domestic violence, an intimate relationship with the perpetrator and related emotional and economic dependencies, and, for sexual assault, the reality that the victim will likely not be believed and can even be blamed for her own assault.

Second, even when victims have the courage to report to the police, allegations of domestic violence or sexual assault often go unreported by the media until formal charges are pressed. For instance, on January 14, 2015, it was reported that Josh McNary, a linebacker for the Indianapolis Colts, was formally charged with rape, criminal confinement and battery for an incident that took place on December 1, 2014.<sup>19</sup> The original incident and police report were never publicized despite having taken place a month and a half prior to the formal charges—even the Colts indicated that they were unaware of the allegations until the charges were pressed. It is unlikely that

---

“MLB,” “NFL” or “NBA” and “domestic violence,” “sexual assault” or “battery” that were published from January 1, 2010 through March 31, 2015.

<sup>18</sup> The NFL Collective Bargaining Agreement and the NBA Collective Bargaining Agreement expressly indicate that league action supersedes team discipline; thus, players may only be punished by the league *or* by their team so as to avoid a double penalty. See NFL Collective Bargaining Agreement, art. 42, § 3(b) (Aug. 4, 2011), <http://nflcommunications.com/current-cba>, <http://perma.cc/6J3X-CPV3> [hereinafter “NFL CBA”]; NBA Collective Bargaining Agreement, art VI, § 10(a) (Dec. 8, 2011), <http://nbpa.com/cba/2011>, <http://perma.cc/ZGP4-EXX7> [hereinafter “NBA CBA”]. Note, however, that the NBA allows a double penalty where the player’s act or conduct is so egregious as to warrant it, but no such instances were found from 2010-2014. See *id.* The MLB 2007-2011 Basic Agreement does not specifically prohibit a double penalty, but it is a moot point for the purposes of this article; neither MLB nor any of the MLB clubs punished a player for domestic violence or sexual assault from 2010-2014.

<sup>19</sup> See Michael Anthony Adams et al., *Prosecutor Sought No-Contact Orders for Witnesses in McNary Case*, INDIANAPOLIS STAR, Jan. 16, 2015, archived at <http://perma.cc/5UUF-BWVP>.

we would have learned of the allegations if the prosecutor declined to press criminal charges, which, as detailed below, happens more often than not.

The research suggests that professional athletes are rarely formally charged with crimes related to domestic violence or sexual assault, even when there is evidence against them.<sup>20</sup> And in the cases where these professional athletes are indicted, they are almost never convicted. If the leagues continue to shape their collective bargaining agreements and/or personal conduct policies<sup>21</sup> based on the results of the justice system, we cannot solve this problem—professional athletes are not punished as harshly or as consistently as their general public counterparts.<sup>22</sup> We value professional athletes for their aggressiveness and brute strength and, without consequence,

---

<sup>20</sup> For purposes of this article, I have not included domestic violence charges that are dismissed (or conditionally dismissed) in exchange for participation in counseling, treatment, community service or other diversionary programs as “formal charges”.

<sup>21</sup> See Section IV below (League Action) for more on personal conduct policies.

<sup>22</sup> It is generally difficult to generate and compare statistics related to domestic violence and sexual assault arrests, prosecution and convictions, given the level of under-reporting and distinctions in how the statistics are tallied. For instance, in domestic violence cases, it is difficult to draw comparisons regarding rates of formal charges or prosecution, as many published statistics do not expressly state whether dismissal of charges in exchange for participation in a diversionary program is counted as a case that was “prosecuted”. Similarly, statistics regarding “conviction” rates often do not distinguish between cases that go to trial and result in conviction for the charged crime, versus cases in which the defendant pleads down to a lesser charge or pleads no contest. That said, research has shown that the average arrest prosecution rate of domestic violence cases was 63.8% when looking at intimate partner prosecutions between 1973-2006. Andrew R. Klein, *Practical Implications of Current Domestic Violence Research*, Apr. 2008, archived at <https://perma.cc/Y35L-TERQ>. In comparison, the rate of professional athletes formally charged for domestic violence in the past five years is 25% (11 formal charges / 44 arrests—this number of arrests does not include the domestic violence allegation against Robert Sands, which did not result in arrest, or the murder-suicide committed by Javon Belcher). Even if we assume that the 63.8% prosecution statistic includes cases in which charges are dropped in exchange for participation in a diversionary program as cases that were “prosecuted”, the equivalent statistic for professional athletes would be 52.3% (11 formal charges + 12 diversionary program / 44 arrests). In sexual assault cases, statistics show that only 32% of cases are reported to the police and, of those cases, only 6.25% result in felony conviction. *Reporting Rates, RAPE, ABUSE, & INCEST NATIONAL NETWORK*, archived at <https://perma.cc/4DRL-HWVW>. While that statistic is shocking enough (and yet another reason why the leagues should not necessarily use the results of the criminal justice system as a measure for punishment), 0% of professional athletes have been convicted over the past five years for felony sexual assault.



we have created a class of individuals who are above reproach when these characteristics present outside of the game.

In this article, I review my findings based on the above-described search related to incidents of domestic violence and sexual assault allegedly perpetrated by players in MLB, the NFL and the NBA in the years 2010 through 2014<sup>23</sup> and highlight certain allegations, the handling of which should inform our approach to such allegations in the future. Next, I review the league responses to the recent media attention on domestic violence and sexual assault and, in particular, describe and analyze the Revised NFL Policy. Lastly, I consider what steps should be taken to create effective policies in MLB, the NFL and the NBA that account for the realities of domestic violence and sexual assault and ensure that this behavior is no longer left unpunished—even for our most decorated athletes.

## II. A FIVE-YEAR REVIEW: 2010-2014

The five-year search results based on a review of local and national newspapers are illuminating, not so much because of the total number of allegations, but because of the failure of the criminal justice system, the leagues and the teams to properly investigate and address these allegations. Of the 64 total reported allegations of domestic violence and sexual assault by professional athletes from 2010 through 2014, 39 were against NFL players, 16 were against NBA players and 9 were against MLB players.<sup>24</sup> 18 were allegations of sexual assault and 46 were of domestic violence. **Only one of the allegations of domestic violence resulted in conviction (though four players pleaded guilty to lesser charges and three players**

---

<sup>23</sup> The statistics presented in this article do not capture allegations that were made against college athletes (even if such athletes are now members of the leagues) or that were made against retired professional athletes. “Domestic violence” as used herein does not encompass violence against (a) family members other than spouses (e.g., the alleged violence committed by Adrian Petersen against his children) or (b) women who appear to have been unknown to the athlete prior to the incident (e.g., the alleged violence perpetrated by Santonio Holmes and Adam Pacman Jones, each of whom were accused of hitting women in bars who they did not know prior to the alleged incidents). “Sexual assault” as used herein includes any type of sexual contact or behavior that occurs without the consent of the victim, regardless of whether the victim knew the athlete prior to the incident.

<sup>24</sup> Note that, given the number of players in each league, it is logical that the NFL has the highest number of allegations. There are 1,696 players in the NFL (not including the five practice squad players on each team), 750 players in MLB (based on the 25-man roster, and not including the 15 additional players that make up the 40-man roster) and at most 450 players in the NBA.

pleaded no contest),<sup>25</sup> and none of the allegations of sexual assault resulted in conviction (though two players pleaded no contest).<sup>26</sup> Let that sink in for a minute. These numbers reflect a systemic failure, from the leagues to law enforcement to the justice system.

Breaking it down by league, there were four sexual assault allegations<sup>27</sup> and five domestic violence allegations<sup>28</sup> against MLB players from 2010 through 2014. Only two players, Milton Bradley and Evan Reed, were formally charged with a crime. Only Milton Bradley was later convicted.<sup>29</sup> Bradley was sentenced to three years in prison. Prosecutors indicated that he attacked his wife five times in 2011 and 2012, in one incident pushing her against a wall and choking her after she asked him to stop

---

<sup>25</sup> Milton Bradley was convicted of the crime with which he was charged (nine counts of spousal battery). NBA players Greg Oden and Jeff Taylor, and NFL players, A.J. Jefferson and Daryl Washington, pleaded guilty to lesser charges. NBA player Jordan Hill and NFL players Tony McDaniel and Brandon Underwood pleaded no contest. Even though Greg Hardy was originally convicted on domestic violence charges, his appeal was thrown out and thus he is not counted as having been “convicted” for purposes of this article.

<sup>26</sup> Brandon Underwood of the Green Bay Packers pleaded no contest to a lesser charge of prostitution-nonmarital sexual intercourse (originally sexual assault) and Albert Haynesworth of the Washington Redskins pleaded no contest to a lesser charge of simple assault (originally misdemeanor sexual abuse). *NFL Arrests Database*, UTSANDIEGO.COM, available at [www.utsandiego.com/nfl/arrests-database](http://www.utsandiego.com/nfl/arrests-database).

<sup>27</sup> Evan Reed of the Detroit Tigers was accused of third-degree criminal sexual conduct in 2014, Alfredo Simon of the Cincinnati Reds was accused of rape in 2013, Pablo Sandoval of the San Francisco Giants was accused of sexual assault in 2012, and Starlin Castro of the Chicago Cubs was accused of criminal sexual assault in 2011.

<sup>28</sup> The following players were arrested for domestic violence: Everth Cabrera, Francisco Rodriguez, Manny Ramirez, Jeremy Jeffress and Milton Bradley.

<sup>29</sup> The case against Reed is pending; trial is scheduled for July 13, 2015. Holly Fournier, *July Trial Set for Ex-Tiger Evan Reed in Rape Case*, DETROIT NEWS, Mar. 13, 2015, *archived at* <http://perma.cc/7NGV-2DLW>. He is accused of leading an incapacitated woman back to his hotel room and raping her on March 29, 2014. The case was originally dismissed by 36th District Judge Kenneth King, who criticized the alleged victim’s actions (questioning why she did not immediately report to the hotel or the police car that she passed when she left the hotel) and questioned her credibility. Wayne County Circuit Court Judge Michael Callahan heard the prosecutor’s appeal and ruled that Judge King had abused his discretion in dismissing the charges. Holly Fournier, *Sexual Assault Charges Reinstated for Ex-Tiger Reed*, DETROIT NEWS, Nov. 21, 2014, *archived at* <http://perma.cc/6DAD-3ZPT>.

smoking marijuana in front of their children.<sup>30</sup> **Not one of these nine MLB players was punished by his respective team or the league,** though Bradley was released by the Seattle Mariners in 2011 after requesting a leave of absence.<sup>31</sup>

There were two sexual assault allegations<sup>32</sup> and 14 domestic violence allegations<sup>33</sup> against NBA players from 2010 through 2014. **Only three NBA players had formal charges brought against them.**<sup>34</sup> Of these three players, Jordan Hill pleaded no contest, and Greg Oden and Jeff Taylor pleaded guilty to lesser charges—none were convicted of the crime with which they were charged. Only one team, the Boston Celtics, punished its player—Jared Sullinger, who was arrested for assault and battery, intimidation of a witness and malicious destruction of property after allegedly pin-

---

<sup>30</sup> Associated Press, *Former MLB Player Milton Bradley Gets Three Years in Jail for Spousal Abuse*, N.Y. DAILY NEWS, July 3, 2013, archived at <http://perma.cc/5573-GXXA>.

<sup>31</sup> *Id.* 15 of the professional athletes that were accused of sexual assault or domestic violence from 2010-2014 were released by their teams relatively soon after the incidents occurred, or at the end of the then-current season. However, in each case, the team made a point of emphasizing poor athletic performance or remaining silent on the reason for release. Though it seems that the allegations may have at least been a tipping point in deciding to release these players, given that the teams did not expressly make the connection, this article does not consider a player being released by his team during or shortly after the season in which an allegation surfaced as “punishment”. Players are frequently released, so whether or not these allegations factored in the decision to release these players is difficult to discern; besides, the overall message to the public is that the players were released in the ordinary course—not because the teams were taking a stand against violence against women.

<sup>32</sup> Andray Blatche of the Brooklyn Nets and Michael Beasley of the Memphis Grizzlies were each accused of sexual assault in 2013. *In Brief*, CHI. TRIB., July 10, 2013, at 6; Seth Pollack and Kevin Zimmerman, *Michael Beasley Sexual Assault Investigation Resolved by Police*, GRIZZLYBEARBLUES.COM, Sep. 24, 2014, available at <http://www.grizzlybearblues.com/2014/9/24/6839521/michael-beasley-sexual-assault-investigation-resolved-by-police>.

<sup>33</sup> The following players were arrested for domestic violence: Jeff Taylor, Greg Oden, James Johnson, DeAndre Liggins, Jared Sullinger, Terrence Williams, Matt Barnes, Dante Cunningham (on two separate occasions), Ty Lawson, Jordan Hill, Hamed Haddadi, Lance Stephenson and Charlie Villanueva.

<sup>34</sup> Jordan Hill was charged with felony assault in 2012; Greg Oden was charged with felony battery resulting in serious bodily injury, misdemeanor domestic battery and misdemeanor battery resulting in serious bodily injury in 2014; and Jeff Taylor was charged with misdemeanor domestic violence assault and malicious destruction of hotel property in 2014.

ning his girlfriend to a bed and the floor, received a one-game suspension.<sup>35</sup> The charges against Sullinger, like the large majority of other professional athletes who are arrested on domestic violence charges, were ultimately dismissed.<sup>36</sup> The league also punished one player—Jeff Taylor of the Charlotte Hornets received an unprecedented 24-game suspension after he was charged with misdemeanor domestic violence assault and malicious destruction of hotel property.<sup>37</sup> Significantly, Taylor is the only NBA player who was arrested for domestic violence or sexual assault since the recent public focus on the issue—it is unimaginable that NBA Commissioner Adam Silver would have handed down a similar suspension had the Ray Rice incident, and related criticism of Commissioner Goodell's response, not occurred.<sup>38</sup> Commissioner Silver stated, "This suspension is necessary to protect the interests of the NBA and the public's confidence in it. Mr. Taylor's conduct violates applicable law and, in my opinion, does not conform to standards of morality and is prejudicial and detrimental."<sup>39</sup>

Lastly, there were 12 sexual assault allegations and 27 domestic violence allegations<sup>40</sup> against NFL players from 2010 through 2014. Ten of

---

<sup>35</sup> *NBA Report*, HOUSTON CHRON., Nov. 2, 2013, at 2; *In Brief*, THE SPOKESMAN-REVIEW, Sept. 4, 2013, at 2B.

<sup>36</sup> *NBA Report*, *supra* note 35.

<sup>37</sup> *Jeff Taylor Suspended 24 Games*, ESPN.COM (Nov. 20, 2014), [http://espn.go.com/nba/story/\\_/id/11904798/jeff-taylor-charlotte-hornets-suspended-total-24-games-pleading-guilty-domestic-violence-case](http://espn.go.com/nba/story/_/id/11904798/jeff-taylor-charlotte-hornets-suspended-total-24-games-pleading-guilty-domestic-violence-case), archived at <http://perma.cc/573T-ZFKN>.

<sup>38</sup> Though Commissioner Silver only assumed his position effective February 1, 2014, it is necessary to note that Greg Oden, James Johnson and Dante Cunningham were also involved in domestic violence incidents in 2014 – but prior to the release of the video of Ray Rice punching Janay Rice – and were not punished. Oden, like Taylor, was formally charged (in Oden's case, with felony battery resulting in serious bodily injury, misdemeanor domestic batter and misdemeanor battery resulting in serious bodily injury) and later pleaded guilty to a lesser charge, and Commissioner Silver still refrained from handing down a suspension. *Oden Reaches Plea Deal Over Battery Charges*, NAT'L POST, Feb. 4, 2015, at B4.

<sup>39</sup> *Jeff Taylor Suspended 24 Games*, *supra* note 37.

<sup>40</sup> The following players were arrested for domestic violence: Kevin Alexander, Will Smith, Phillip Merling, Leroy Hill (on two separate occasions, in 2010 and 2013), Tony McDaniel, Jermaine Phillips, Erik Walden, Chris Cook, Brandon Underwood, Robert Sands (on two separate occasions, in 2012 and 2013), Bryan Thomas, Chad Johnson, Kelvin Hayden, A.J. Jefferson, Daryl Washington, William Moore, Amari Spivey, Chris Rainey, Jonathan Dwyer, Quincy Enunwa, Ray McDonald, Greg Hardy, Ray Rice and Junior Galette. This statistic also includes the murder-suicide committed by Jovan Belcher in 2012.

the sexual assault allegations were for rape or attempted rape,<sup>41</sup> while the other two allegations related to other sexual acts committed against a woman's consent.<sup>42</sup> Of the ten rape or attempted rape allegations, only four players were formally charged—Brandon Underwood and Perrish Cox were arrested and charged with sexual assault, Jarriel King was arrested and charged with first degree criminal sexual conduct and Josh McNary was arrested and charged with rape, criminal confinement and battery.<sup>43</sup> Of these cases, Brandon Underwood avoided trial by pleading no contest to a prostitution charge and paying a fine of \$379,<sup>44</sup> Perrish Cox and Jarriel King went to trial and both were acquitted, and Josh McNary's case is pending. **The result: 12 sexual assault allegations, and zero convictions (though two players pleaded no contest to lesser charges).** The only league or team punishment related to these allegations was the well-publicized six-game suspension (later reduced to four games) by the NFL of Ben Roethlisberger. Though the prosecutor declined to press charges against Roethlisberger (discussed in more detail below), Commissioner Goodell stated that Roethlisberger's conduct was not "admirable, responsible or consistent with either the values of the league or the expectations of the fans."<sup>45</sup>

---

<sup>41</sup> The following players were accused of rape or attempted rape: Brandon Underwood of the Green Bay Packers, Perrish Cox of the Denver Broncos, Eric Foster of the Indianapolis Colts, Jarriel King of the Seattle Seahawks, Ray McDonald of the San Francisco 49ers (shortly after he was arrested for felony domestic violence in 2014), Sammie Hill of the Tennessee Titans, Josh McNary of the Indianapolis Colts, C.J. Spillman of the Dallas Cowboys (who counts for two of the allegations, having allegedly attempted to rape a woman in 2013 and raped a woman in 2014), and perhaps most infamously, Ben Roethlisberger of the Pittsburgh Steelers.

<sup>42</sup> Julian Edelman of the New England Patriots was arrested for indecent assault and battery after allegedly reaching under a woman's costume at a Halloween party in Boston and grabbing her crotch. *Around the NFL: Patriots' Edelman is Facing Charges*, L.A. TIMES, Nov. 2, 2011, at 3. Albert Haynesworth of the Washington Redskins was arrested for sexual abuse after allegedly touching a waitress' breast at a Washington hotel. *Albert Haynesworth Pleads No Contest*, ESPN.COM (Aug. 22, 2011), [http://espn.go.com/boston/nfl/story/\\_id/6884993/new-england-patriots-albert-haynesworth-pleads-no-contest-assault](http://espn.go.com/boston/nfl/story/_id/6884993/new-england-patriots-albert-haynesworth-pleads-no-contest-assault), archived at <http://perma.cc/D6QA-PEYF>.

<sup>43</sup> Allegations of sexual assault against C.J. Spillman of the Dallas Cowboys, Ray McDonald of the San Francisco 49ers and Sammie Hill of the Tennessee Titans surfaced in 2014. The investigations are pending.

<sup>44</sup> Steve Eder, *N.F.L. Was Family, Until Wives Reported Domestic Violence*, N.Y. TIMES, Nov. 17, 2014, archived at <http://perma.cc/FC74-HQV2>.

<sup>45</sup> *Big Debate over Big Ben in Pittsburgh*, FOXNEWS.COM (May 3, 2010), <http://www.foxnews.com/sports/2010/05/03/big-debate-big-ben-pittsburgh>, archived at <http://perma.cc/Z7XE-YASG>.

Of the 27 domestic violence allegations involving NFL players from 2010 through 2014, only seven allegations resulted in formal charges.<sup>46</sup> Of these seven allegations, four athletes pleaded down to lesser charges or pleaded no contest and three went to trial. Of those three trials, Chris Cook of the Minnesota Vikings was acquitted of felony domestic assault by strangulation after allegedly strangling his girlfriend, Chantel Baker. This, despite evidence that Baker suffered a perforated eardrum, lost hearing in that ear for two weeks, sustained a bloody nose, and had marks on her neck and hemorrhaging in her eyes consistent with strangulation.<sup>47</sup> Greg Hardy was convicted of assault on a female and communicating threats, after allegedly beating, strangling and threatening to kill his ex-girlfriend, though he appealed the conviction to a jury trial and the charges were ultimately thrown out when the victim could not be reached to testify at the jury trial.<sup>48</sup> While Hardy was awaiting the appeal, he was placed on the Commissioner Exempt List and collected his \$13.1 million salary for the 2014 season, as well as an additional \$48,000 from the Carolina Panthers' playoff victory.<sup>49</sup> Jonathan Dwyer's trial began March 4, 2015—he is facing one felony and eight misdemeanor aggravated assault charges for allegedly assaulting his wife during two separate arguments. Investigators indicate that Dwyer broke his wife's nose with a head butt, and the next day punched her.<sup>50</sup> Of

---

<sup>46</sup> As noted above, with domestic violence allegations, formal charges are frequently not pressed in exchange for the accused agreeing to participate in community service, counseling or other diversionary program. In the past five years, ten NFL players did not face formal charges by instead agreeing to participate in such programs.

<sup>47</sup> *Vikings' Chris Cook Acquitted of Assaulting Girlfriend*, USA TODAY, Mar. 16, 2012, archived at <http://perma.cc/N9CG-YDEL>.

<sup>48</sup> See Joseph Person and Jonathan Jones, *Caroline Panthers' DE Greg Hardy's Court Date Pushed Back into 2015*, CHARLOTTE OBSERVER, Nov. 4, 2014, archived at <http://perma.cc/P9BL-LZB3l>; Joseph Person, *NFL Nears End of Greg Hardy Investigation*, CHARLOTTE OBSERVER, Mar. 25, 2015, archived at <http://perma.cc/RXL6-YAG9>. Nicole Holder, Hardy's ex-girlfriend, received a financial settlement from Hardy after his conviction but prior to the appeal date, allegedly in exchange for refusing to cooperate with prosecutors in the appeal. Christine Brennan, *Greg Hardy's Case a Test for NFL's New Approach*, DEMOCRAT & CHRON., Feb. 10, 2015, at D15.

<sup>49</sup> Des Bieler, *Panthers' Playoff Win Put an Extra \$48,000 in Greg Hardy's Pocket*, WASH. POST, Jan. 5, 2015, archived at <http://perma.cc/YU3M-L8CT>.

<sup>50</sup> *Cardinals Jonathan Dwyer Pleads Not Guilty to Hitting Wife*, AZCENTRAL.COM (Oct. 6, 2014), <http://www.azcentral.com/story/sports/nfl/cardinals/2014/10/06/cardinals-jonathan-dwyer-pleads-not-guilty-to-hitting-wife/16825571>, archived at <http://perma.cc/A4S3-N5KM>.

**these 27 allegations, only five resulted in league punishment<sup>51</sup> and one resulted in team punishment.<sup>52</sup>**

Overall, the lasting message from these past five years is that professional athletes rarely face formal charges, and are almost never convicted, for domestic violence or sexual assault. The failure of the justice system has been replicated by the leagues themselves, which have only handed down seven punishments out of the 64 reported domestic violence and sexual assault allegations—six by the NFL, one by the NBA (only after the recent media attention on the issue) and none by MLB. While the leagues have spent countless hours developing stringent standards related to other off-field conduct, such as drug use, driving under the influence and even acceptable apparel, they have neglected to consider the prevalence and complexities of domestic violence and sexual assault and appropriate processes and procedures for addressing them. Professional athletes are admired for their talents on the field, but these talents should not excuse them from being held accountable for violent off-field behavior. The leagues' historical lack of action with respect to domestic violence and sexual assault suggests they tolerate this behavior, and do not see it as harmful to society as the other off-field behavior they consistently condemn. At this point, it is unclear whether the justice system is failing to successfully prosecute athletes because the public (i.e., jurors) has received the message from the leagues that domestic violence and sexual assault are mere distractions, or whether the leagues have failed to take action due to their reliance on flawed law enforcement practices. Either way, someone needs to step up to the plate.

---

<sup>51</sup> The NFL handed down one-game suspensions to Tony McDaniel of the Miami Dolphins in 2010 and Erik Walden of the Green Bay Packers in 2011 and two-game suspensions to Ray Rice of the Baltimore Ravens in 2014 (later increased to an indefinite suspension which was overturned on appeal) and Brandon Underwood of the Green Bay Packers in 2011 (though it was unclear if this punishment was for the domestic violence allegation or the preceding sexual assault allegation against him). Most recently, the NFL suspended Greg Hardy for ten games. In addition, A.J. Jefferson received a four-game suspension in 2013 after being charged with felony domestic violence, but Commissioner Goodell later lifted this suspension. The NFL also claimed it suspended Robert Sands of the Cincinnati Bengals after multiple allegations of domestic violence, but Sands was released by the Bengals for performance reasons, never served the suspension and claims he was unaware of it. Eder, *supra* note 44.

<sup>52</sup> The Minnesota Vikings suspended Chris Cook for two games without pay in 2011 and then removed him from the active roster until his trial was completed and he was ultimately acquitted. *NFL Arrests Database*, *supra* note 26. As noted in note 31, *supra*, this does not account for NFL players that were released by teams the same year during which allegations of domestic violence surfaced, of which there were nine.

### III. FACTORS CONTRIBUTING TO THE LACK OF CONSEQUENCES AND RELATED CASE STUDIES

As Senator Claire McCaskill said, “By and large, professional sports teams have relied on the failure of the criminal justice system to get convictions as their excuse as to why very few players have been held accountable.”<sup>53</sup> So, what is happening with these domestic violence and sexual assault cases? Why are they not being successfully prosecuted? To answer this question, we must consider the societal biases and assumptions that affect our response to allegations of domestic violence and sexual assault and explore how these factors may have played a role in certain case studies—specifically, this section will analyze the domestic violence allegations against Chris Cook and DeAndre Liggins, and the sexual assault allegations against Ben Roethlisberger, Perrish Cox and Jarriel King.

#### *Domestic Violence: Understandably Reluctant Witnesses*

The U.S. Department of Justice reports that nearly one in four American women have experienced domestic violence, and, on average, more than three women are murdered by their intimate partners in the United States every day.<sup>54</sup> Both domestic violence and sexual assault typically take place behind closed doors, without witnesses, which make them difficult crimes to prosecute. The primary evidence is, of course, the victim herself. With domestic violence in particular, a victim may call 911 out of fear, but, once the situation is diffused, may be reluctant to testify against her current or former partner. Many victims of domestic violence are not in a position to leave their partners, due not only to an ongoing emotional connection but also due to economic dependencies and fear of further retaliation, in many cases fear of being murdered (which, as the U.S. Department of Justice statistic illustrates, is not unfounded). Even if an abused woman has the strength to leave her violent partner, going forward with charges against someone you at one time loved or cared for is complicated. When the alleged abuser is a professional athlete, in addition to the above-referenced considerations, many victims fear that their abuser’s career will be put in jeopardy if she reports the abuse or moves forward with charges against him. When these factors do not dissuade the survivor from testifying, professional athletes also have the financial resources to make an offer that the survivor

---

<sup>53</sup> Kraske, *supra* note 12.

<sup>54</sup> U.S. Dept. of Justice Access to Justice Initiative, *Civil Legal Aid Supports Federal Efforts to Help Prevent Domestic Violence*, U.S. DEPT. OF JUSTICE, Apr. 2014, archived at <http://perma.cc/WP7M-5R36>.



cannot turn down in exchange for her silence, especially when the alternative is publicly reliving a terrifying event with no promise of punishment.

Given all of these factors weighing against continuing to cooperate in pressing charges, many women alter their testimony or refuse to show up for court appearances. For instance, in 2011, the girlfriend of Erik Walden of the Green Bay Packers, who was treated at a hospital for injuries to her head and hand after calling the police and alleging Walden pushed her, changed her story claiming that she hit him first.<sup>55</sup> Similarly, Chantel Baker testified that she lied to police because she was angry with Cook—prosecutors contended she backed off her story under coercion and because she was afraid of ruining his career.<sup>56</sup> Victims of abuse allegedly perpetrated by Quincy Enunwa of the New York Jets, Kelvin Hayden of the Atlanta Falcons, James Johnson of the Memphis Grizzlies, Matt Barnes of the Sacramento Kings, Francisco Rodriguez of the Milwaukee Brewers and Manny Ramirez of the Oakland Athletics, also decided not to pursue charges—prosecutors declined to press formal charges in each case.

Despite the understandable considerations that convince many women not to testify against former or current loved ones, there is other evidence upon which the leagues and law enforcement can rely. For instance, County Attorney Mike Freeman, who prosecuted the case against Cook, indicated jurors could have still believed Baker's initial statements over her retractions.<sup>57</sup> He went forward with the case despite Baker changing her story, stating that his office turned in convictions in other domestic violence cases when alleged victims denied abuse even more vehemently than Baker.<sup>58</sup> In some cases, there are eyewitnesses, and even when there are not eyewitnesses, prosecutors can present evidence consisting of the 911 calls, photographs of the crime scene and victim's injuries, hospital reports and first responder interviews of the victim.<sup>59</sup> In addition, domestic violence is generally a pattern of abusive behavior that is used by one partner to gain or maintain

---

<sup>55</sup> *NFL Packers Expected to Start Walden, Arrest Over Weekend under Review*, THE COMMERCIAL APPEAL, Dec. 1, 2011, at D6.

<sup>56</sup> *Vikings' Chris Cook Acquitted of Assaulting Girlfriend*, *supra* note 47.

<sup>57</sup> *Id.*

<sup>58</sup> *Id.*

<sup>59</sup> The Greg Hardy case is particularly troublesome. The prosecutors dropped his case when it was on appeal, even after Hardy was convicted in a bench trial in which the survivor testified as well as two witnesses—one who was in the apartment at the time of the incident and heard arguing and someone being slammed into a wall and the other who saw the pile of guns on Hardy's futon and took a picture of it. Michael Gordon, Joseph Person & Jonathan Jones, *Panthers Greg Hardy Guilty of Assaulting Female, Communicating Threats*, CHARLOTTE OBSERVER, July 15, 2014, archived at <http://perma.cc/EX8U-XZ6V>.

power and control over another partner; as such, it is not unusual for one to discern this pattern from prior allegations of abuse.

Unfortunately, many prosecutors do not ultimately press formal charges against domestic violence offenders—whether due to the lack of victim cooperation or otherwise. For instance, the charges against DeAndre Liggins of the Oklahoma City Thunder were ultimately dropped, despite his being arrested for two counts of kidnapping, two counts of domestic violence and battery with a dangerous weapon, three counts of domestic abuse in the presence of a minor and one count of violating a protective order.<sup>60</sup> In this case, there was also a witness other than Liggins and his girlfriend who he allegedly attacked. This witness, Marcus Rogers, allegedly taunted and made fun of the victim in a cellphone recording of the attack, but later as the attack ensued stepped in between Liggins and the victim allowing her to run to a neighbor's house.<sup>61</sup> According to the probable cause affidavit, she was thrown out of bed to the ground, punched 11-12 times, stomped on and kicked and then dragged back into the house upon trying to escape twice—all in front of their two-year old son.<sup>62</sup> The doctor who examined her indicated she suffered a shoulder separation, bruising on the back of her head and multiple scrapes.<sup>63</sup> Liggins never faced legal or league punishment—the Thunder released him, but he returned to the NBA after the charges were dropped.

The leagues have followed the prosecutors' lead, rarely doling out punishment despite, in some cases, overwhelming evidence of illegal violent behavior. Instead of focusing on this distortion of justice, the public focus tends to shift to why the victim continues to support, or at least not outwardly accuse, the alleged abuser. Why is the onus on the victim, who has been both physically and emotionally harmed and may remain fearful for her life or wellbeing, to determine whether or not a professional athlete should be punished for a crime evidence suggests was committed? Why can we not prosecute domestic violence committed by professional athletes? Is it the continuing sense that domestic violence is a family matter? Or the stereotype of the victim who deserves the punishment if she refuses to leave? Or is it our tendency to look past all evidence to the contrary to believe that the professional athletes we idolize are incapable of such repulsive conduct?

---

<sup>60</sup> Associated Press, *DeAndre Liggins Signs 10-Day Contract with Miami Heat*, CHARLESTON DAILY MAIL, Feb. 26, 2014, at 4B.

<sup>61</sup> *Id.*

<sup>62</sup> *Id.*

<sup>63</sup> *Id.*

*Sexual Assault: Victim Blaming and Fear of False Accusation*

Misguided focus on the victim and her actions is also apparent in sexual assault cases; in this case the public (and, by extension, law enforcement and the leagues) envision that the victim somehow “asked for it”, by drinking, wearing revealing clothing or consenting to some sexual contact, or that the accusation is false—a cry for attention and, in the case of professional athletes, money. With these often-held stereotypes, the fact is that “reasonable doubt” always already exists with rape accusations in a way that it doesn’t always already exist for accusations of other criminal activity—we are culturally trained to doubt the victim, especially when the alleged rapist does not match our idea of who a rapist is. The combination of public perception of alleged rape victims and, in contrast, professional athletes, makes it next to impossible to prosecute rape in this context.

The fear of false accusation is one of the driving forces behind the public’s immediate inclination to blame the victim and disbelieve her story. It has been reported that “[m]any men in college—athletes, fraternity members, and others—believe they or their friends are at a significant risk of being falsely accused of rape by a woman.”<sup>64</sup> Yet, credible sources report that false rape accusations range between two-percent and eight-percent.<sup>65</sup> In comparison, the approximate false accusation rate for all criminal offenses is two-percent to three-percent. Thus, false rape accusations are, at most, slightly above average, but also quite possibly occurring at exactly the same rate as false accusations of other crimes. Thus, the American public “dramatically overestimates the percentage of sexual assault reports that are false.”<sup>66</sup> Interestingly, commentators have used sexual assault cases involving athletes as an example of such fears:

[W]e have all seen how victims are portrayed in the media accounts of rape accusations made against popular sports and cultural figures. These media accounts show us just how easy it is for us as a society to believe the suspect’s statements (a respected cultural icon) and both discount the victim’s statements and disparage her character. This tendency to overestimate the percentage of false reports can then introduce bias into an investigation and prosecution because it causes us to give less credibility to victims and more credibility to suspects.<sup>67</sup>

---

<sup>64</sup> JACKSON KATZ, *THE MACHO PARADOX* 218 (2006).

<sup>65</sup> See, e.g., *id.* at 219; Kimberly A. Lonsway et al., *False Reports: Moving beyond the Issue to Successfully Investigate and Prosecute Non-Stranger Sexual Assault*, 43-MAR PROSECUTOR 10, 11 (2009).

<sup>66</sup> Lonsway et al., *supra* note 65, at 13.

<sup>67</sup> *Id.*

The FBI statistic that should startle people is that 80%-90% of rapes go unreported.<sup>68</sup> Instead of solely focusing on potential false accusations, we should consider the number of rapists that continue to walk our streets (and play professional sports), either because the victim's accusation is never prosecuted or because the victim never reports in the first place, likely because she is aware that her allegation will result in her disparagement and his continued freedom.

There are significant odds that work against rape victims, especially those who are raped by professional athletes. Remember, of the 18 reported allegations of sexual assault committed by professional athletes in the past five years, only seven arrests were made and no convictions (though two players pleaded no contest to lesser charges). The sexual assault cases involving Ben Roethlisberger, Perrish Cox and Jarriel King illuminate how the above-described biases, victim blaming and pro-athlete sentiment coalesce, despite seemingly convincing evidence of wrongdoing.

While most people remember the headlines regarding an alleged sexual assault committed by Roethlisberger against a Georgia college student, the details of the Roethlisberger case are important—including, for instance, that he has reportedly also been accused of sexual assault on *three* other occasions. He was publicly accused of sexual assault by a woman in Nevada—the prosecutor declined to press charges on her behalf, so she initiated a civil suit.<sup>69</sup> In addition, two other sexual assault accusations surfaced against Roethlisberger that were not as publicized, given the accusers' reluctance to come forward to the police or to initiate a civil suit.<sup>70</sup>

The much publicized Georgia case against Roethlisberger was mishandled at best, and a total failure of the justice system allowing a serial rapist to continue playing professional football at worst. In the case against Roethlisberger, a Georgia college student was at a bar with her sorority sisters, allegedly led down to a bathroom by Roethlisberger's bodyguards

---

<sup>68</sup> Katz, *supra* note 64, at 218.

<sup>69</sup> See generally, Jack McCallum, *The Hangover: Roethlisberger*, SIVVAULT.COM (May 10, 2010), <http://sportsillustrated.cnn.com/vault/article/magazine/MAG1169185/1/index.htm>, archived at <http://perma.cc/L75J-3C8R>.

<sup>70</sup> Jonathan D. Silver, *Lawyer Says Client Made Roethlisberger Allegation*, PITTSBURGH POST-GAZETTE (Apr. 13, 2010), <http://www.post-gazette.com/steelers/2010/04/13/Lawyer-says-client-made-Roethlisberger-allegation/stories/201004130232>, archived at <http://perma.cc/PQ5U-6WFD> (reporting that another alleged sexual assault victim contacted Boston attorney Harry Manion but ultimately decided not to press charges); Timothy Egan, *Nike's Women Problem*, N.Y. TIMES, Apr. 21, 2010, archived at <http://perma.cc/P8ZH-CMAF> (reporting that the 500-plus page investigatory report in the Georgia case revealed another Georgia woman had claimed Roethlisberger accosted her repeatedly on two occasions).

and then raped by Roethlisberger. The alleged victim immediately reported the rape and Sergeant Jerry Blash conducted the initial interviews—he was the only individual to interview Roethlisberger and he was the officer to whom the accuser made her initial report and, as such, would ordinarily be a key witness in her case, as he could attest to her condition and what was said immediately after the alleged assault. Blash had been pictured smiling with the quarterback earlier in the evening and was overheard by multiple witnesses calling the accuser a “drunken bitch” and saying, “This pisses me off, that women can do this,” statements which Blash later admitted making.<sup>71</sup> He also discouraged her from reporting the rape and immediately notified Roethlisberger of the allegation.<sup>72</sup> Further, he coordinated with the off-duty police officer and state trooper that served as Roethlisberger’s bodyguards that night.<sup>73</sup> Blash has since resigned from the Milledgeville police force.<sup>74</sup> The crime scene was never sealed off and, twelve hours after the incident, the club’s janitor swabbed the bathroom with Clorox and Pine-Sol.<sup>75</sup>

Georgia District Attorney Fred Bright was in charge of examining the evidence and concluding whether it was sufficient for the state to press charges against Roethlisberger. In the press conference in which Bright announced his decision not to press charges, he stressed the accuser’s intoxication and her inconsistent statements. Bright mentioned Roethlisberger’s drunken state only once when he said “[b]oth parties had been drinking alcohol.”<sup>76</sup> Bright overlooked the botched investigation and Blash’s biased statements and neglected to recount the accuser’s version of events, as well as her sorority sisters’ eyewitness accounts.

As revealed in the report by the Georgia Bureau of Investigation, which investigated the Georgia allegations along with the Milledgeville police force, the accuser said that one of Roethlisberger’s two bodyguards, later identified as police officer Anthony Barravecchio, escorted her into a hallway and sat her on a stool, at which point Roethlisberger walked down the hallway and exposed himself.<sup>77</sup> It was at this point that she said it wasn’t okay, tried to leave, and went to the first door she saw, which happened to be a bathroom—Roethlisberger followed her into the bathroom, shut the door,

---

<sup>71</sup> McCallum, *supra* note 69.

<sup>72</sup> Christian Boone et al., *QB’s Case in Trouble from the Start*, ATLANTA JOURNAL-CONSTITUTION, Apr. 26, 2010, archived at <http://perma.cc/T6V7-GVCK>.

<sup>73</sup> *Id.*

<sup>74</sup> *Id.*

<sup>75</sup> *Id.*

<sup>76</sup> *Big Debate over Big Ben in Pittsburgh*, *supra* note 45; McCallum, *supra* note 69.

<sup>77</sup> *Accuser: Roethlisberger Exposed Self*, ESPN.COM (Apr. 16, 2010), <http://sports.espn.go.com/nfl/news/story?id=5094224>, archived at <http://perma.cc/8S9X-3HGS>.

and then, allegedly, had sex with her against her will.<sup>78</sup> Her friend, Nicole Biancofiore said that she saw the accuser “dragged by a bodyguard to the back room.”<sup>79</sup> Two other friends said they saw the bodyguard lead the accuser down the hallway and knew she was drunk and were worried about her.<sup>80</sup> Ann Marie Lubatti claims she approached one of Roethlisberger’s two bodyguards and said, “This isn’t right. My friend is back there with Ben. She needs to come back right now.”<sup>81</sup> According to her, the bodyguard, later identified as Pennsylvania state trooper Ed Joyner, would not look her in the eye. Upon questioning, Bright conceded that the accuser’s friends said they spoke to one of the bodyguards in an effort to get their friend from the bathroom and that he would not look at them.<sup>82</sup> Further, he said that the accuser’s friends confronted the manager who “basically said, look, he’s an NFL quarterback with the Steelers – something to that effect – he’s not going to risk his career doing anything foolish.”<sup>83</sup> After the accuser reported the alleged assault to the police, she then went to the hospital and the examination showed lacerations, bruising, and bleeding in her genital area, though the doctor indicated that he could not conclusively say if these resulted from trauma or sexual assault.

Roethlisberger was never prosecuted—a discouraging outcome, given that many rape victims (a) do not immediately report to the police, (b) do not go to the hospital, (c) lack evidence of physical trauma to the genital area (whether conclusive or not) and (d) are not raped in public places with multiple witness accounts as to suspicious behavior of the alleged rapist. This evidence provides valuable insight into the events that occurred that night, and more evidence than many other rape victims have when faced with the decision of whether to report a sexual assault. If this allegation of rape does not lead to prosecution in a court of law, it is not hard to figure out why so few women report rape.

The cases against each of Perrish Cox and Jarriel King were not as publicized as Roethlisberger’s case, though, unlike Roethlisberger, each player was formally charged with sexual assault. Perrish Cox was in his

---

<sup>78</sup> *Id.*

<sup>79</sup> *Id.*

<sup>80</sup> *Id.*

<sup>81</sup> *Id.*

<sup>82</sup> Georgia DA: ‘Don’t Even Have Probable Cause’, STEELCITY INSIDER, Apr. 12, 2010, <http://www.scout.com/nfl/steelers/story/961691-georgia-da-don-t-even-have-probable-cause#/story/961691-georgia-da-don-t-even-have-probable-cause>, archived at <http://perma.cc/3WS4-8JVS> (citing D.A. Fred Bright Transcript plus the Post-Statement Interview).

<sup>83</sup> *Id.*

rookie year with the Denver Broncos when he was accused of sexual assault in 2010. Cox's accuser claimed that she, Cox, his teammate Demaryius Thomas and Cox's girlfriend, Carthy Che, went out together and then returned to Cox's apartment.<sup>84</sup> The alleged victim believed she was drugged, as she remembered little about what happened that evening even though she only had four drinks.<sup>85</sup> Though she was suspicious that something had happened the next morning, she did not file a complaint because she could not remember the details and did not want to make unfounded charges.<sup>86</sup> Instead, she came forward on October 28, 2010 after learning she was pregnant, with the doctors placing the date of conception around the date that she was at Cox's apartment.<sup>87</sup> Both before and after the alleged victim came forward with the accusation, Cox repeatedly denied having sex with the alleged victim,<sup>88</sup> thus restricting him from using the defense most commonly used by men accused of rape—that the sex was consensual. Nonetheless, the DNA sample taken from the fetus matched the sample taken from Cox.<sup>89</sup>

Not only was there DNA evidence, coupled with a history of Cox vehemently denying that he had sex with the woman, there were also witnesses. Thomas testified against Cox and indicated that the alleged victim was passed out at Cox's home, and Cox then brought her into his bedroom and said to Thomas: "I think she's ready."<sup>90</sup> Thomas left the apartment shortly thereafter.<sup>91</sup> While many things were debated during the trial, it was not contested that the alleged victim was passed out, incapacitated—unable to consent.

Without having the typical defense of consensual sex to rely on, the defense attorney, Harvey Steinberg, went to the second best option—painting a picture that the alleged victim was a drunk party girl and arguing that the DNA results were unreliable.<sup>92</sup> Steinberg clinched his case, saying,

---

<sup>84</sup> P. Solomon Banda, *Trial opens for former Broncos CB Perrish Cox*, NFL.COM (Feb. 28, 2012), <http://www.nfl.com/news/story/09000d5d8273ddac/printable/trial-opens-for-former-broncos-cb-perrish-cox>, archived at <http://perma.cc/HCV9-DBLJ>.

<sup>85</sup> Carlos Illescas, *Broncos Ex-Teammate's Testimony Scathing at Perrish Cox Sex-Assault Trial*, THE DENVER POST, Mar. 1, 2012, archived at <http://perma.cc/APM7-HWZM>.

<sup>86</sup> Banda, *supra* note 84.

<sup>87</sup> *Id.*

<sup>88</sup> *Id.*

<sup>89</sup> *Id.*

<sup>90</sup> Illescas, *supra* note 85.

<sup>91</sup> *Id.*

<sup>92</sup> Associated Press, *Perrish Cox Acquitted of Sexual Assault*, ESPN.COM (Mar. 2, 2012) [http://espn.go.com/nfl/story/\\_/id/7638140/ex-denver-broncos-player-perrish-cox-acquitted-sexual-assault](http://espn.go.com/nfl/story/_/id/7638140/ex-denver-broncos-player-perrish-cox-acquitted-sexual-assault), archived at <http://perma.cc/C3YC-CVBJ>.

“Let’s just call this what it is. These were a couple of party girls . . . What did [the alleged victim] herself do?” Prosecutor Bob Chappell countered, “You just heard why, the reason women are reluctant to report rape.”<sup>93</sup> And the jury followed through—they acquitted Cox shortly thereafter.

The case against Jarriel King of the Seattle Seahawks was similar to Cox’s, given the unusual amount of evidence that was present for a rape case. A woman alleged that King and his friend, Arthur Lee Denson-Holmes, drugged her and raped her in a North Charleston, South Carolina apartment despite her cries to stop the sexual assault.<sup>94</sup> In this case, the defense attorneys argued that the sex was consensual and that the woman concocted the accusations in order to get her hands on King’s money.<sup>95</sup> But unlike typical he-said, she-said cases in which, due to the lack of physical evidence, the prosecution relies almost exclusively on the victim’s word alone, there was a text message sent from King’s cellphone at 4:20 a.m. the morning of the incident that said, “Let’s get her sleepy.”<sup>96</sup> King also sent the woman a text to apologize for anything that might have happened to her.<sup>97</sup> In addition, a drug often used in sleeping pills and cold medicine was found in the woman’s system.<sup>98</sup> Despite all of this evidence, a jury acquitted King.<sup>99</sup>

The Roethlisberger, Cox and King cases illustrate the uphill battle women face in pressing sexual assault charges generally, but more specifically, against professional athletes. Typically, prosecutors must rely on the word of the victim, together with accounts of the officers who take the initial report. If they are lucky, the victim may have had the strength to go to the hospital immediately after the attack and have evidence of physical trauma, though most rape kits do not produce such results in adult women. The above-referenced cases had additional evidence including witness testimony, DNA evidence, evidence of the use of sleeping pills and text messages documenting the state of mind of the alleged perpetrator. And yet one case did not even get to court, and the other two resulted in acquittals.

---

<sup>93</sup> Katherine Redmond, *Perrish Cox Verdict the Result of Victim Blame, Sexism and Status*, HUFFINGTON POST (Mar. 7, 2012), [http://www.huffingtonpost.com/katherine-redmond/perrish-cox-trial\\_b\\_1322908.html](http://www.huffingtonpost.com/katherine-redmond/perrish-cox-trial_b_1322908.html), archived at <http://perma.cc/GWX3-MEWG>.

<sup>94</sup> Christina Elmore, *Charleston County Jury: Jarriel King, Friend, Not Guilty of Criminal Sexual Conduct*, THE POST AND COURIER, July 31, 2014, archived at <http://perma.cc/TE7G-U29W>.

<sup>95</sup> *Id.*

<sup>96</sup> *Id.*

<sup>97</sup> *Id.*

<sup>98</sup> *Id.*

<sup>99</sup> *Id.*



It is not surprising that there have been no convictions of professional athletes for sexual assault from 2010-2014, despite 18 allegations, and that prosecutors rarely even press formal charges—their cases are already lost. Instead of focusing on the rates of false accusation, these numbers and stories suggest we should focus on the sexual assaults committed by professional athletes that go unreported given the likely outcome—being vilified in the media as a party girl and liar and having only a slim chance of seeing even an incredibly strong case result in conviction. The arrest affidavit for Cox's accuser stated:

"She said she was worried about filing a police report because she saw how the media tormented the victim in the Kobe Bryant case. She feels that society has the mentality that because of an athlete's social status he wouldn't have to force someone to have sex with him. She said all of the athletes have the money to get big lawyers and they pay their way out of it. She said she doesn't want to be harassed in the media."<sup>100</sup>

#### *Team Complicity with Law Enforcement*

In addition to general victim blaming and stereotypes that exist with respect to victims of domestic violence or sexual assault, forming a strong case against a professional athlete is complicated by the relationship between team security, a player's personal security and law enforcement. In many cases, there is a comradery amongst these individuals, oftentimes due to mutual friends and connections. In many other cases, members of law enforcement supplement their income by actually serving as team security or player personal security while off-duty—thus, making it difficult to discern in what capacity they are acting and creating a conflict of interest. The teams foster this relationship, routinely employing such off-duty officers as uniformed escorts or team security, paying them, providing perks and covering travel costs.<sup>101</sup>

---

<sup>100</sup> A woman alleged that Kobe Bryant, a basketball player for the Los Angeles Lakers, gripped her by the neck, bent her over a chair and raped her on June 30, 2003 in a Colorado hotel room. The case of *People v. Kobe Bean Bryant* was eventually dismissed by prosecutors when the 20-year-old woman declined to testify after evidence of her sexual activity was ruled admissible at trial (information that is typically protected from disclosure under "rape shield" laws). Prior to this ruling, the woman's name and sealed transcripts regarding her sexual history were leaked to the press by court staff. See T.R. Reid, *Rape Case Against Bryant is Dropped*, WASH. POST, Sept. 2, 2004, at A01.

<sup>101</sup> Steve Eder, *Whisked Out of Jail, and Back to the NFL*, N.Y. TIMES, Nov. 16, 2014, archived at <http://perma.cc/2HB6-JLKZ>.

As discussed previously, the fact that Roethlisberger's two bodyguards, Barravecchio and Joyner, were an off-duty police officer and state trooper responsible for leading the alleged victim to the bathroom and then barring her sorority sisters from assisting her indicates some level of complicity—at the very least, they knew they were facilitating some sort of private interaction, likely sexual, between Roethlisberger and a drunk, underage woman whose friends were concerned for her. At the worst . . .

The formal relationship between Roethlisberger's bodyguards and law enforcement (and other bodyguards and team security with law enforcement) underlies and informs the bias that police officers have exhibited in favor of professional athletes accused of domestic violence and sexual assault. Roethlisberger's bodyguards were not the only biased witnesses on hand when, and shortly after, the alleged attack occurred—witnesses claim that Sergeant Jerry Blash demonstrated little patience with the alleged victim, allegedly saying, "You can file a statement but this man has a lot of money and good attorneys."<sup>102</sup> After the accusation was made, Blash warned Roethlisberger and his bodyguards, telling Barravecchio, "We have a problem, this drunken bitch, drunk off her ass, is accusing Ben of rape."<sup>103</sup> He told Joyner, "There is no way it could have happened."<sup>104</sup> Former District Attorney J. Tom Morgan observed, "With that kind of attitude, what victim would want to go through with a prosecution? . . . After the way she was treated, it was going to be hard to move forward with this case."<sup>105</sup>

Ray McDonald's recent run-ins with the police have been no different. The defensive end for the San Francisco 49ers was arrested for felony domestic violence against his then-pregnant fiancée in August 2014, and accused of sexual assault more recently in December 2014.<sup>106</sup> In each case, McDonald reached out to the 49ers organization when police became involved. In fact, Sergeant Sean Pritchard, who provided private security to the 49ers, was already present at the house when the officers arrived on the scene to

---

<sup>102</sup> Boone et al., *supra* note 72.

<sup>103</sup> *Id.*

<sup>104</sup> *Id.*

<sup>105</sup> *Id.*

<sup>106</sup> As of the date this article is written, the sexual assault allegation against McDonald is still pending and no formal charges have been filed. McDonald has vehemently denied the allegations and filed a suit against the accuser for defamation—an unusual tactic with potentially far-reaching consequences, given that her account was given to the police and not to the public. Evan Sernoffsky, *Ex-49er Sues Rape Accuser for Defamation*, S.F. CHRON., Mar. 17, 2015, at C2.

investigate the domestic violence allegations.<sup>107</sup> After this apparent conflict of interest arose, the San Jose Police Department later suspended its officers from working private security for the 49ers but claimed it had no bearing on the investigation; nevertheless, it took a month for the San Jose Police to forward its investigation of McDonald to the District Attorney's office.<sup>108</sup> The 49ers stood behind McDonald, allowing him to play for the entire 2014 season even though he was facing the domestic violence charge; since the sexual assault allegation surfaced, the 49ers released him citing a "pattern of poor decision-making".<sup>109</sup> He still has not been formally punished by the league or a team for these incidents, other than his release from the 49ers which occurred after the completion of the 2014 season—he has since been signed by the Chicago Bears, so he will seemingly not miss a game.<sup>110</sup>

It is not only team and player security and law enforcement that may be biased, but also third parties to whom alleged victims report. In 2010, Eric Foster of the Indianapolis Colts was accused of sexual assault by a 22-year old hotel clerk who claimed Foster confined her in a hotel room and had sex with her against her will, hours before the AFC Championship game.<sup>111</sup> She returned to the hotel lobby to report the incident to a hotel security official, who then promptly called the Colts security liaison but not police.<sup>112</sup> The accuser's attorney claims that both hotel security and the police mishandled the investigation—for instance, the police later failed to take the uniform that she was wearing during the assault as evidence.<sup>113</sup> Though the police filed a probable cause affidavit, the prosecutor declined to file charges.<sup>114</sup>

These issues may arise from the fact that the teams themselves encourage reporting criminal conduct internally, to the teams, instead of the police. Mercedes Sands indicated that the Cincinnati Bengals coach, Marvin Lewis, advised her and her husband, Robert Sands to reach out to the Ben-

---

<sup>107</sup> Tim Keown, *No Charges in Ray McDonald Case*, ESPN.COM (Nov. 10, 2014), [http://espn.go.com/nfl/story/\\_id/11852824/ray-mcdonald-san-francisco-49ers-cleared-domestic-violence-case](http://espn.go.com/nfl/story/_id/11852824/ray-mcdonald-san-francisco-49ers-cleared-domestic-violence-case), archived at <http://perma.cc/FWL9-54RV>.

<sup>108</sup> *Id.*

<sup>109</sup> Christine Brennan, *McDonald Release Handled Correctly*, USA TODAY, Dec. 18, 2014, at 01C.

<sup>110</sup> *Ex-49ers DE Ray McDonald Gets Second Chance with Bears*, FoxSports.com (Mar. 24, 2015), <https://www.foxsports.com/nfl/story/ray-mcdonald-chicago-bears-san-francisco-49ers-032415>, archived at <http://perma.cc/9HYC-SW6D>.

<sup>111</sup> *Colts Tackle Denies Sexual Assault*, THE INDIANAPOLIS STAR, Apr. 21, 2010, at A15.

<sup>112</sup> *Id.*

<sup>113</sup> *Id.*

<sup>114</sup> *Id.*

gals first if there were further problems after a domestic violence incident in 2012.<sup>115</sup> Robert Sands agreed that Lewis encouraged them to keep their problems “in house.”<sup>116</sup> When interviewed about a *New York Times* article that revealed this practice, Lewis stated, “Mercedes doesn’t have a very good memory of things” (despite the fact that Robert corroborated her story), and shrugged off the multiple alleged domestic violence incidents saying, “You had two young kids who didn’t really have a good feel for what life is . . . Their relationship was very tumultuous.”<sup>117</sup> Lewis continued, “Domestic violence is a matter of law. It’s not our deal.”<sup>118</sup> Apparently, Lewis is not aware of the NFL’s personal conduct policy (both the old policy and the newly revised version), which expressly makes it the NFL’s “deal.”

The overlap between local law enforcement and team and player security, and the potential influence that has over third parties, is a systemic problem. In fact, Broward County Sheriff Al Lamberti initiated an internal affairs inquiry into the special treatment of Miami Dolphins player Phillip Merling, after he was charged with aggravated domestic battery on a pregnant woman, Kristen Lennon, in 2010.<sup>119</sup> Lamberti said that “deputies who were caught up in the glamour of a big-time sports franchise could lose sight of their allegiance.”<sup>120</sup> At the time of Merling’s arrest, six deputies from the Broward County Sheriff’s Office were employed by the Dolphins. Similarly, in a 2008 memoir, *Bodyguard to the Packers*, Jerry Parins, a police officer who became the security director for the Green Bay Packers, recounted how his connections to the police force were useful when players were in trouble.<sup>121</sup>

These stories are not fun to recount or acknowledge, but they happened, and we cannot pretend that they didn’t. The general discounting of evidence by the justice system and the leagues and teams is astounding. It is not surprising that, when Manny Ramirez was interviewed as he was re-

---

<sup>115</sup> Eder, *supra* note 44.

<sup>116</sup> *Id.*

<sup>117</sup> Jay Morrison, *Lewis: Abuse Story Not Truthful*, DAYTON DAILY NEWS, Nov. 20, 2014, at C1.

<sup>118</sup> *Id.*

<sup>119</sup> Eder, *supra* note 101. After Merling was taken into custody, Miami Dolphins’ security director, Stuart Weinstein, called the Sheriff’s Office to get information on the allegation and to ask a commander who worked side jobs for the Dolphins to notify him when Merling’s bond was posted. Against policy, Merling was allowed to leave the jail through a rear exit to evade reporters and was also taken to get his belongings, even though a judge had ordered Merling to stay away from Lennon.

<sup>120</sup> *Id.*

<sup>121</sup> *Id.*

leased from jail after an arrest for domestic violence, he told the reporters, “The case is closed.”<sup>122</sup> When the reporters questioned him further, he stated, “I closed it. I closed it because I’m the protagonist.” It would not be surprising if many professional athletes feel that they can close their own cases, given the dearth of league punishment and legal consequence over the past five years. We need to get beyond the stereotypes of false accusation, stop questioning the victims’ actions, acknowledge that these are crimes and not personal or family matters and confront our pro-athlete bias. A shield has been created by the inextricably linked security, police, teams and leagues, creating a class of individuals that are seemingly above reproach.

#### IV. LEAGUE ACTION

Since the Ray Rice video surfaced and Commissioner Goodell’s initial two-game suspension came under scrutiny, MLB, the NBA and the NFL have each dedicated more resources toward better understanding domestic violence and sexual assault and the impact that inaction may have on both the leagues and the players. As set forth below, each of the leagues’ commissioners has a tremendous amount of discretion in punishing players for conduct that is detrimental to the league or impacts the integrity of the game. The question is how consistently this power is used, and the process that is used to determine whether or not certain conduct warrants punishment, especially when reliance on the criminal justice process has been proven ineffective.

The MLB commissioner has the authority to discipline “conduct by Major League Clubs, owners, officers, employees or players that is deemed by the commissioner to not be in the best interest of baseball.”<sup>123</sup> Nonetheless, MLB has been the most reluctant to punish players for domestic violence and sexual assault. In fact, “At no time in the last quarter of a century has there been a commissioner-level sanctioning of any player for domestic violence, and most teams haven’t bothered either.”<sup>124</sup> As stated earlier,

---

<sup>122</sup> *Manny Ramirez Tells Reporters He “Closed” His Domestic Violence Case, Report Says*, CBSNEWS.COM (Sept. 14, 2011), <http://www.cbsnews.com/news/manny-ramirez-tells-reporters-he-closed-his-domestic-violence-case-report-says/>, archived at <http://perma.cc/UXU4-RQAY>.

<sup>123</sup> MAJOR LEAGUE CONST., art. II, § 3 (2005), archived at <http://perma.cc/6DAK-56JL>.

<sup>124</sup> Mike Bates, *MLB’s Record on Domestic Violence Worse than NFL’s*, SBNATION.COM (July 28, 2014) <http://www.sbnation.com/mlb/2014/7/28/5936835/ray-rice-chuck-knoblauch-minnesota-twins-mlb-domestic-abuse-violence>, archived at <http://perma.cc/C9FH-VAB8>.

there were nine allegations of sexual assault and domestic violence against MLB players from 2010 through 2014, and no league or team punishments for such incidents. The problem may be that former Commissioner Bud Selig is apparently unaware that MLB players commit these crimes.<sup>125</sup> In September 2014, Commissioner Selig said, “We haven’t had any cases [of domestic violence] I’m happy to say for a long, long time. I can’t remember when the last time was. . . We deal with situations as they occur.”<sup>126</sup> But does he? He went on to say, “We are a social institution and I’m proud of our record in dealing with a myriad of subjects, and we deal with them, I think, quite effectively.”<sup>127</sup>

If inaction is a response, Commissioner Selig has been quite effective. MLB’s reported allegations are admittedly fewer than those in the NFL and the NBA (which has fewer players), but that does not diminish the fact that MLB players have been involved in similar incidents. The case against Cincinnati Reds pitcher, Alfredo Simon, is particularly troubling. He was accused of anally raping a woman in April 2013—a rape kit revealed anal tears, abrasions and protruding tissue. Despite the fact that the woman went to the hospital and testified before a grand jury, the U.S. Attorney’s Office for the District of Columbia decided not to file charges against Simon without even polling the grand jury.<sup>128</sup> MLB and the Cincinnati Reds similarly took no action—it is unclear who, if anyone, fully investigated these allegations to determine if they were founded. Pete Rose—banished from MLB for gambling—observed, “I picked the wrong vice. I should have picked alcohol. I should have picked drugs or I should have picked beating up my wife or girlfriend because if you do those three, you get a second chance.”<sup>129</sup> Crass, but undeniably accurate.

Currently, MLB does not have a personal conduct policy but its collective bargaining agreement handles domestic violence through a treatment program administered jointly by MLB and the Major League Baseball Play-

---

<sup>125</sup> Rob Manfred succeeded Bud Selig as commissioner as of January 25, 2015.

<sup>126</sup> Craig Calcaterra, *Bud Selig Can’t Remember the Last Domestic Violence Incident in Major Leagues Baseball*, NBCSPORTS.COM (Sept. 12, 2014), <http://hardballtalk.nbc.com/2014/09/12/bud-selig-cant-remember-the-last-domestic-violence-incident-in-major-league-baseball/>, archived at <http://perma.cc/C72U-HDVU>.

<sup>127</sup> *Id.*

<sup>128</sup> Rachel Axon, *Woman Files Lawsuit Saying She Was Raped by Alfredo Simon*, USATODAY, Apr. 25, 2014, archived at <http://perma.cc/Z3DK-TB9G>.

<sup>129</sup> Craig Calcaterra, *Pete Rose: ‘I Should Have Picked Alcohol . . . or I Should Have Picked Beating Up My Wife or Girlfriend’*, NBCSPORTS.COM (Aug. 12, 2013), <http://hardballtalk.nbcsports.com/2013/08/12/pete-rose-i-should-have-picked-alcohol-or-i-should-have-picked-up-beating-up-my-wife-or-girlfriend/>, archived at <http://perma.cc/7PW3-FLUJ>.

ers Association.<sup>130</sup> This should not be downplayed, as treatment is an essential part of any comprehensive domestic violence program, but this internal process does not provide for any punishment that could act as a deterrent, and implicitly seems to suggest that this is a matter to be handled in-house. However, in December 2014, MLB indicated that it will be meeting to discuss parameters of a disciplinary program (likely in response to the negative press the NFL received regarding the Ray Rice incident).<sup>131</sup> Further, MLB is implementing a mandatory domestic violence training for all teams in spring 2015—each team is required to meet with a local domestic violence and sexual assault prevention organization for such training.<sup>132</sup> It is yet to be seen whether MLB will put in place a formal assessment and punishment process making clear that domestic violence and sexual assault are not tolerated in the way that MLB does not tolerate other off-field conduct, such as gambling and driving while intoxicated.

Under the NBA Constitution, Commissioner Silver has the right to impose fines or inflict suspensions on players who, in his opinion, are guilty of conduct that “does not conform to standards of morality or fair play, that does not comply at all times with all federal, state, and local laws, or that is prejudicial or detrimental to the [NBA].”<sup>133</sup> In addition, the NBA Collective Bargaining Agreement indicates that, if the NBA and National Basketball Players Association (“NBPA”) agree there is reasonable cause that a player has engaged in any type of off-court violent conduct, the player will be required to undergo clinical evaluation and counseling.<sup>134</sup> Domestic violence and sexual assault are expressly considered types of “violent conduct”.<sup>135</sup> Mandatory punishment for violent off-court conduct is limited to convictions for felony violent conduct, and the NBA Collective Bargaining Agreement expressly states that a team shall not impose discipline on a player solely on the basis of the fact that the player has been arrested, but

---

<sup>130</sup> Jon Paul Morosi, *MLB, Union to Meet This Month on Domestic Violence Policy*, FOXSPORTS.COM (Jan. 4, 2015), <http://www.foxsports.com/mlb/story/mlb-union-to-meet-this-month-on-domestic-violence-policy-010415>, archived at <http://perma.cc/Y9FA-AXDT>.

<sup>131</sup> *Id.*

<sup>132</sup> Janie McCauley, *A's Begin Baseball's Mandatory Domestic Violence Training*, SALON.COM (Feb. 26, 2015), [http://www.salon.com/2015/02/26/as\\_begin\\_baseballs\\_mandatory\\_domestic\\_violence\\_training/](http://www.salon.com/2015/02/26/as_begin_baseballs_mandatory_domestic_violence_training/), archived at <http://perma.cc/6P2P-BSHN>.

<sup>133</sup> NBA Constitution R. 35(d).

<sup>134</sup> NBA CBA, *supra* note 18, art. VI, § 8.

<sup>135</sup> *Id.*

can do so if the conduct underlying the arrest “has an independent basis for doing so”.<sup>136</sup>

Unlike MLB, the NBA has not suggested that it will reform its policies with respect to violence against women; however, Commissioner Silver exhibited a change in his approach through his punishment of Jeff Taylor. The NBA launched an investigation of Taylor’s case independent of law enforcement and conducted separate interviews of all parties.<sup>137</sup> Commissioner Silver also involved domestic violence experts in the investigation and assessment of the appropriate punishment.<sup>138</sup> In addition to the 24-game suspension, Taylor was sentenced to 80 hours of community service, and Commissioner Silver suggested that he direct his community service toward helping victims of domestic violence.<sup>139</sup> Though Commissioner Silver indicated that he would continue to assess player conduct on a case-by-case basis, with no formal change to the NBA’s policies,<sup>140</sup> each of these actions was a departure from how domestic violence allegations have been handled by the NBA in the past. So much so that the executive director of the NBPA, Michele Roberts, criticized the decision, stating, “We have a scheme of discipline that was the result of collective bargaining between the parties that has been applied consistently over the years. While we appreciate the sensitivity of this societal issue, the Commissioner is not entitled to rewrite the rules or otherwise ignore precedent in disciplinary matters.”<sup>141</sup> Roberts is wrong that Commissioner Silver rewrote the rules, though she is correct that Taylor’s punishment was not consistent with past inaction by the league—but sometimes change is warranted and, here, long overdue. As Commissioner Silver explained, “While the suspension is significantly longer than prior suspensions for incidents of domestic violence by NBA players, it is appropriate in light of Mr. Taylor’s conduct, the need to deter similar conduct going forward, and the evolving social consensus—with which we fully

---

<sup>136</sup> *Id.* at §§ 8 & 15. Conviction of an NBA player, which according to the NBA Constitution includes a plea of guilty, no contest or nolo contendere, for a felony violent crime results in automatic suspension for a minimum of ten games.

<sup>137</sup> Smriti Sinha, *The NBA Just Showed the NFL How to Handle Domestic Violence Cases*, VICE SPORTS (Nov. 26, 2014), <https://sports.vice.com/article/the-nba-just-showed-the-nfl-how-to-handle-domestic-violence-cases>, archived at <https://perma.cc/2U54-4L2C>.

<sup>138</sup> *Id.*

<sup>139</sup> *Id.*

<sup>140</sup> *Jeff Taylor Suspended 24 Games*, *supra* note 37 at 7.

<sup>141</sup> Sam Amick, *NBPA Chief: NBA Tried to ‘Out-Muscle’ NFL with Jeffery Taylor Suspension*, USA TODAY, Nov. 21, 2014, archived at <http://perma.cc/HE9B-EK4A>.



concur—that professional sports leagues like the NBA must respond to such incidents in a more rigorous way.”<sup>142</sup>

Of course, even with murmurings of a revised MLB disciplinary program and Commissioner Silver’s evolving mindset, focus remains on the NFL. Under the Constitution and By-Laws of the NFL, the NFL commissioner may discipline players who are “guilty of conduct detrimental to the welfare” of the NFL.<sup>143</sup> The recent media attention on the NFL distracted the public from the fact that it is the only league to have developed a distinct personal conduct policy, and has been the most consistent in doling out punishments related to off-field violent conduct.<sup>144</sup> However, it can obviously do better.

In the wake of the Ray Rice backlash, Commissioner Goodell made a number of changes, including to personnel, policy and procedure. First, as mentioned above, he hired Lisa Friel, Jane Randel and Rita Smith to advise him—each experts in the fields of domestic violence and/or sexual assault. In addition, Anna Isaacson, currently the NFL’s vice president of community affairs and philanthropy, was tapped to take an expanded role as vice president of social responsibility.<sup>145</sup> It is important for the leagues to not only have input from knowledgeable sources on domestic violence and sexual assault, but also to have female voices present in this predominantly male atmosphere—a different perspective could be refreshing.

Initially, the public and media was skeptical about the female hires, suggesting that they were publicity driven and did not reflect an honest commitment by the NFL to understand and discipline for domestic violence and sexual assault. Lindsay Jones, a journalist who currently works for *USA Today* and has historically covered many stories on professional athletes and violence against women, interviewed Friel and came to the opposite conclusion. Jones thinks that, while part of the hirings were for the sake of public appearance (since the NFL looked like an old boys’ club that did not know how to handle the Rice incident), Friel is not going to be pushed around.

---

<sup>142</sup> *Jeff Taylor Suspended 24 Games*, *supra* note 37 at 7.

<sup>143</sup> Constitution and By-Laws of the National Football League, art. VIII, § 8.13(A) [hereinafter “NFL Constitution”].

<sup>144</sup> In 1997, the NFL adopted the violent crime policy under Commissioner Paul Tagliabue’s leadership, which became the personal conduct policy in 2000, was revised in 2007 and has now evolved into the Revised NFL Policy. In 2000 alone, Corey Dillon, Rod Smith and Dana Stubblefield were fined and Mario Bates, Mustafah Muhammad and Denrad Walker were suspended for one or two games—all for domestic violence incidents. *NFL Players Arrested in 2000*, SAN DIEGO UNION-TRIB., Jan. 22, 2001, at D4.

<sup>145</sup> Brinson, *supra* note 13.

Jones stated, “[Friel] would not do this for a PR move and she won’t be used as a pawn.”

Friel, Randel and Smith will assist with building training curricula and educational programs for NFL personnel and identifying and managing domestic violence and sexual assault resources for NFL personnel and their families.<sup>146</sup> In addition, they have already provided valuable assistance regarding the Revised NFL Policy, which was unanimously approved by the owners in December 2014.<sup>147</sup> The Revised NFL Policy is much more specific with respect to procedures and processes to be used when assessing allegations of violent off-field conduct than its predecessor policy. Friel played a large role in forming the policy with Commissioner Goodell and other advisors. As she revealed in an interview with Jones, much of her focus was on considering the stage at which you take a player off the field and, secondly, the stage at which you impose discipline—after an allegation, arrest, formal charges or conviction?<sup>148</sup> The NFL wants to ensure that it balances due process and the rights of the accused with the interest of the leagues and teams to uphold a certain standard of behavior.<sup>149</sup>

Commissioner Goodell stated that the steps taken to improve the NFL’s prior personal conduct policy come from a clear, simple principle: “Domestic violence and sexual assault are wrong. They are illegal. They have no place in the NFL and are unacceptable in any way, under any circumstances. That has been and remains our policy.”<sup>150</sup> The new policy states that, if the NFL becomes aware of a possible “violation”, it will undertake an investigation, which may be conducted by NFL security, independent parties or a combination of the two.<sup>151</sup> A “violation” occurs if: (a) the player has a “disposition of a criminal proceeding”, which includes “an adjudication of guilt or admission to a criminal violation; a plea to a lesser

---

<sup>146</sup> *Id.*

<sup>147</sup> *Owners OK New Conduct Policy*, *supra* note 14. Neither the Revised NFL Policy nor the earlier version implemented in 2000 was collectively bargained. They were issued pursuant to the commissioner’s authority under the NFL Constitution. NFL Constitution, *supra* note 143. The NFL Players Association filed a grievance challenging the Revised NFL Policy, arguing that it violates the NFL CBA. Michael O’Keeffe, *Union Files Grievance over NFL’s Conduct*, N.Y. DAILY NEWS, Jan. 24, 2015, at 34.

<sup>148</sup> Lindsay H. Jones, *Lisa Friel Addresses Challenges Developing NFL’s New Conduct Policy*, USA TODAY, Oct. 7, 2014, *archived at* <http://perma.cc/5SME-6NZC>.

<sup>149</sup> *Id.*

<sup>150</sup> *NFL Commissioner Addresses Domestic Violence*, CNN.COM (Aug. 28, 2014), <http://www.cnn.com/2014/08/28/sport/nfl-goodell-domestic-violence-memo/index.html>, *archived at* <http://perma.cc/AL9B-RPMG>.

<sup>151</sup> Revised NFL Policy, *supra* note 14.

and included offense; a plea of *nolo contendere* or no contest; or the disposition of the proceeding through a diversionary program, deferred adjudication, disposition of supervision, conditional dismissal or similar arrangements” or (b) if the evidence gathered by the league’s investigation demonstrates that the player engaged in conduct prohibited by the Revised NFL Policy.<sup>152</sup> Players may be placed on paid administrative leave or the Commissioner Exempt List<sup>153</sup> if formally charged with a crime of violence (which may be in the form of an indictment by a grand jury, the filing of charge by a prosecutor or an arraignment in a criminal court), or if an investigation leads the commissioner to believe that there has been a violation of the Revised NFL Policy.<sup>154</sup> Josh McNary is currently on the Commissioner Exempt List, as the NFL conducts its internal investigation regarding his conduct. The commissioner’s discretionary decision to place a player on paid leave “will not reflect a finding of guilt or innocence and will not be guided by the same legal standards and considerations that would apply in a criminal trial.”<sup>155</sup> This leave with pay will last until it is determined whether or not a player has violated the policy.<sup>156</sup>

As such, the much discussed mandatory punishment for violations that involve assault, battery, domestic violence, dating violence, child abuse and other forms of family violence, or sexual assault involving physical force or committed against someone incapable of giving consent, only kick in upon a “disposition of a criminal proceeding” or if the “evidence gathered by the league’s investigation demonstrates” a violation of the policy. A first offense receives a baseline suspension without pay of six games, while a second offense results in permanent banishment, though a player can petition for reinstatement after one year.<sup>157</sup> The commissioner will consider mitigating and aggravating circumstances when determining the extent of the suspension.<sup>158</sup> If a player appeals his punishment, the process will unfold pursuant to Article 46 of the NFL Collective Bargaining Agreement, under which players may appeal disciplinary action *to the commissioner*. However, the commissioner can name a panel that consists of independent experts *to recommend*

---

<sup>152</sup> *Id.*

<sup>153</sup> A player on the Commissioner Exempt List cannot practice or attend games, but may be present at the club, with the club’s permission, for individual workouts, meetings or therapy, and continues to get paid.

<sup>154</sup> Revised NFL Policy, *supra* note 14.

<sup>155</sup> *NFL Owners Endorse New Personal Conduct Policy*, NFL.COM (Dec. 10, 2014), <http://www.nfl.com/news/story/0ap3000000441758/article/nfl-owners-endorse-new-personal-conduct-policy>, archived at <http://perma.cc/3J7X-FCUQ>.

<sup>156</sup> *Id.*

<sup>157</sup> Revised NFL Policy, *supra* note 14.

<sup>158</sup> *Id.*

a decision on the appeal pursuant to the NFL Collective Bargaining Agreement.<sup>159</sup>

Importantly, the Revised NFL Policy also states that NFL teams are obligated to report any matter that comes to their attention that may constitute a violation, and failure to report is grounds for disciplinary action.<sup>160</sup> “This obligation to report is broader than simply reporting an arrest; it requires reporting to the league any incident that comes to the club’s attention which, if the allegations were true, would constitute a violation of the Revised NFL Policy.”<sup>161</sup>

Each of these changes is a step in the right direction, but does the new policy go far enough? What is the real-life impact of these changes? How does it differ from the previous NFL regime, and can we expect real change? While some may view professional sports leagues and violence against women as disparate topics, the overlap between renowned athletes and a profoundly serious societal problem has created an opportunity for widely impactful social change. As Kim Gandy, president and CEO of the National Network to End Domestic Violence stated, “Beyond addressing issues of player discipline, I would hope that they would use the power of the NFL’s brand to begin changing public attitudes about masculinity and violence . . . I think few entities in the country that have the ability—both financially and in terms of impact—to accomplish a thing like that.”<sup>162</sup>

## V. ENSURING CHANGE IN THE NEXT FIVE YEARS

The Revised NFL Policy is a good starting point, especially as compared to MLB’s inaction and the NBA’s less structured approach of dealing with domestic violence and sexual assault allegations on a case-by-case basis under the commissioner’s disciplinary authority (which is, essentially, what each of the leagues has done unsuccessfully and inconsistently in the past). The practical impact of the Revised NFL Policy was already evidenced by the NFL’s ten-game suspension of Greg Hardy. Even though Hardy’s conviction was thrown out, as discussed above, the NFL conducted its own internal investigation of his conduct and concluded that Hardy “violated the [Revised NFL Policy] by using physical force against Nicole Holder in at

---

<sup>159</sup> *Id.*

<sup>160</sup> *Id.*

<sup>161</sup> *Id.*

<sup>162</sup> Erik Brady, *NFL’s Domestic Violence Policy Could Undergo Numerous Changes*, USA TODAY, Oct. 9, 2014, archived at <http://perma.cc/H5R7-KXKL>.

least four instances.”<sup>163</sup> Commissioner Goodell wrote in his decision, “The net effect of these acts was that Ms. Holder was severely traumatized and sustained a range of injuries, including bruises and scratches on her neck, shoulders, upper chest, back, arms and feet.”<sup>164</sup> He continued, “The use of physical force under the circumstances present here, against a woman substantially smaller than [Hardy] and in the presence of powerful, military-style assault weapons, constitutes a significant act of violence in violation of the [Revised NFL Policy].”<sup>165</sup>

That said, there is still room for improvement—certainly within the NBA and MLB, and even within the NFL. With the backdrop of 64 allegations resulting in only one conviction,<sup>166</sup> seven league punishments and two team punishments in the past five years, we should take some time to get this right and consider where even the NFL Revised Policy may continue to fall short. Namely, more attention needs to be given to (a) the punishment that players face who are never formally charged with crimes or convicted, since these players account for the large majority of players who face allegations of domestic violence or sexual assault, (b) the role and duration of paid leave, (c) team accountability and reporting, including with respect to player and team security personnel who moonlight as police officers, and (d) effective efforts to train and educate both the players and the public and to, especially, debunk the myths surrounding domestic violence and sexual assault.

As the statistics from the past five years indicate, professional athletes are rarely formally charged with crimes. Even if initially arrested for domestic violence, those charges are typically dropped altogether or in exchange for counseling, treatment or community service. Conviction is even more rare—actually non-existent with respect to rape allegations against MLB, NFL and NBA players in the past five years. As such, the new structure which introduces mandatory paid leave upon formal charges and mandatory suspension upon conviction would only affect outlier cases.

That said, the new definition of a “violation” of the Revised NFL Policy moves the pendulum in the right direction. A violation includes not only convictions or guilty pleas, but also pleas to a lesser and included offense, pleas of *nolo contendere* or no contest and the disposition of a pro-

---

<sup>163</sup> Dan Hanzus, *Greg Hardy Suspended 10 Games Without Pay*, NFL.COM, Apr. 22, 2015, available at <http://www.nfl.com/news/story/0ap3000000487503/article/greg-hardy-suspended-10-games-without-pay>.

<sup>164</sup> *Id.*

<sup>165</sup> *Id.*

<sup>166</sup> As noted earlier, there were also nine players who plead no contest or guilty to lesser charges.

ceeding through a diversionary program, deferred adjudication, disposition of supervision, conditional dismissal or similar arrangements. In the past five years, there were 22 professional athletes that would have fallen into this category. The large majority of these players were facing domestic violence charges and agreed to participate in counseling, educational programs and/or community service in exchange for dismissal (sometimes conditional dismissal) of such charges. While only nine punishments related to domestic violence or sexual assault were doled out by teams or leagues in the past five years, if the Revised NFL Policy had been in effect in all leagues during this period, this number would have been at least 22.<sup>167</sup>

Commissioner Goodell has recognized that it is not enough to “defer entirely to the decisions of the criminal justice system, which is governed by processes and considerations that are not appropriate to a workplace, especially a workplace as visible and influential as [the NFL’s].”<sup>168</sup> So, what do the leagues do if they do not defer to the decisions of the criminal justice system? The Revised NFL Policy puts in place an investigatory process under which claims will be assessed but ultimately does not answer this question. As USA Today reporter Lindsay Jones considers, “The foundation of the legal system is due process and the leagues need to give all players this right and an unbiased investigation; however, there comes a point in the investigation when you realize a player should not be continuing to play and this is not always after formal charges have been pressed.”

The investigatory procedure outlined in the Revised NFL Policy will aid in the NFL’s private investigations into player conduct. Not only

---

<sup>167</sup> In the NFL, Will Smith of the New Orleans Saints, Leroy Hill of the Seattle Seahawks, Jermaine Phillips of the Tampa Bay Buccaneers, Erik Walden of the Green Bay Packers, Bryan Thomas of the New York Jets, Chad Johnson of the Miami Dolphins, Amari Spivey of the Detroit Lions, Robert Sands of the Cincinnati Bengals, Quincy Enunwa of the New York Jets and Ray Rice of the Baltimore Ravens agreed to such diversion programs in exchange for dismissal of charges; Tony McDaniel of the Miami Dolphins, Brandon Underwood of the Green Bay Packers and Albert Haynesworth of the Washington Redskins pleaded no contest (Brandon Underwood pleaded no contest to two separate incidents that took place on different occasions—one for domestic violence and the other for sexual assault—and thus counts twice under this statistic); and A.J. Jefferson of the Minnesota Vikings and Daryl Washington of the Arizona Cardinals pleaded guilty to lesser charges. In the NBA, Hamed Haddadi of the Memphis Grizzlies agreed to participate in a diversion program, Jordan Hill of the Houston Rockets pleaded no contest and Jeff Taylor and Greg Oden pleaded guilty to lesser charges. In MLB, Jeremy Jeffress of the Kansas City Royals agreed to community service and counseling, while Milton Bradley of the Seattle Mariners was the lone professional athlete to be convicted of the crime with which he was charged.

<sup>168</sup> *Owners OK New Conduct Policy*, *supra* note 14.

should the NFL consider reports and evidence provided to it by law enforcement, but it should conduct comprehensive interviews of the involved parties, as well as teammates and coaches. Both sexual assault and domestic violence are crimes that can sometimes be predicted, as they are typically committed by repeat offenders. As I suggested in my 2010 article, the leagues should consider a three-strikes policy (possibly, a two-strikes policy) under which a player will be suspended if he has multiple allegations of domestic violence or sexual assault reported to the team, league and/or law enforcement, regardless of whether such allegations result in arrest.<sup>169</sup> Even without formal charges, such a pattern of misconduct is problematic and the likelihood that the player is being pre-judged or punished without fault is diminished.

The paid leave policy also needs to be reexamined. While it is undoubtedly trying to strike a middle ground between allowing the player to continue playing until the internal investigation and/or law enforcement proceedings conclude and suspending the player upon the report of an unsupported allegation, an indefinite leave with pay also seems unfair under certain circumstances. In cases where the facts suggest that criminal conduct indeed occurred, I would suggest placing the player on leave *without pay* until the internal NFL investigation concludes, at which point the player should be punished regardless of the stage of the criminal proceeding, which can take far longer than the leagues' assessment of the facts. For instance, while the Indianapolis Colts requested that Josh McNary be added to the Commissioner Exempt List, resulting in his full payment while the sexual assault allegation against him unfolds, the Arizona Cardinals placed Jonathan Dwyer on the reserve/non-football injury list, which gives them the option of not paying Dwyer.<sup>170</sup> In appropriate circumstances, the league should also consider placing players on a similar list that maintains the player's status in the league but does not reward him with ongoing payment. At the very least, there should be a time limitation on how long a player remains in this limbo status, whether paid or unpaid. Whether or not a player is placed on paid leave versus unpaid leave would inevitably come down to the commissioners' discretion, but it is better than having a presumption that runs in the face of the facts presented in certain cases.

---

<sup>169</sup> Withers, *supra* note 1.

<sup>170</sup> Despite the distinction, the Cardinals indicated that they will continue paying Dwyer while he is on the reserve/non-football injury list. Josh Alper, *Cardinals Place Jonathan Dwyer on Non-Football Illness List, Cut Chris Rainey*, NBCSPORTS.COM (Sep. 18, 2014), <http://profootballtalk.nbcsports.com/2014/09/18/cardinals-place-jonathan-dwyer-on-non-football-illness-list-cut-chris-rainey/>, archived at <http://perma.cc/8F82-D2PX>.

Next, as illustrated above, the role of team security and player personal security in internal investigations and law enforcement proceedings needs to be addressed. The pro-player bias that results from the overlap between teams and local law enforcement is tremendously damaging to a survivor's case—it is not irrational to conclude that people invested in the team and its reputation may, at best, be biased in their assessment of the facts and, at worst, cover them up and discourage victims from reporting. As Jones observed from her experience, “There is a sense that the team will cover for the guys.” The mandatory reporting under the Revised NFL Policy, and added pressure from the media, will help keep teams honest, but why don't we go one step further? Should team or player security personnel ever be involved in processing a domestic violence or sexual assault allegation? There is no reason that I can think of where this would be rational or desirable. The leagues should implement a bright line rule that team and player security must recuse itself from any such investigation.

Further, the teams should be prohibited from suggesting that domestic violence is an internal issue that should be referred to the team alone. Domestic violence is a crime that can result in severe injury, including death, and its proper place of referral is law enforcement. Suggesting that players have team resources and support available if players have issues outside of the clubhouse is one thing; using this suggestion as an attempt to divert all criminal conduct to a biased forum that can keep the matter from being released to the public or law enforcement is another. Victims should be encouraged to come forward, not stifled. And any support system that is extended to the families of players should not be retracted if a member of that family determines that she also needs assistance from law enforcement during a domestic dispute.

Lastly, the leagues' efforts to educate and train both their personnel and the public need to be in earnest—not as an effort to placate the recent media attention, such that we will hear no more of this training after a few months have passed. In particular, the content of the training and public education is critical. According to Jones, the initial training that each of the NFL teams attended in 2014 was based on a very basic PowerPoint presentation that outlined the definitions of domestic violence and sexual assault, and what actions could be considered to fall in these categories. This may be where the leagues need to start, since they have not previously confronted these issues head-on. However, in addition to covering basic topics, the leagues have a duty to target and address the public's misconception about, and myths surrounding, domestic violence and sexual assault. The NFL has started to foster this larger public dialog by providing each team with lists of domestic violence and sexual assault groups in its community. However,



only some teams have moved forward with establishing those relationships.<sup>171</sup> For instance, after Ray McDonald was arrested in 2014 for domestic violence, a group of Bay Area domestic violence support groups proactively reached out to the 49ers and offered their services and expertise.<sup>172</sup> Five months later, even after 49ers' fullback Bruce Miller was arrested on March 5, 2015, the 49ers still have yet to respond to this letter.<sup>173</sup>

We must first change our cultural understanding of domestic violence and sexual assault before we can expect justice—changing league policy or law will make no difference if the public (including the very jurors who decide the cases as well as the prosecutors who decide whether to press charges) are still operating under false conceptions of domestic violence and sexual assault. We need to accept that domestic violence victims may amend their stories or decline to take the stand, for the variety of reasons considered in this article. We need to accept that sexual assault victims may have been drinking or willing to consent to certain sexual activities, but that these factors do not mean they were not raped. That incredibly talented players in MLB, the NFL and the NBA may also be beating their girlfriends or raping women. And that none of these factors should keep us from assessing the actual facts and determining whether one of our culturally elite abused his power and deserves to be punished.

## VI. CONCLUSION

The NFL has put a tremendous amount of resources into addressing domestic violence and sexual assault by its players since the Ray Rice incident surfaced, but we still must question if the proposed solutions actually address the problem, and also what the NBA and MLB are doing to address the same violent conduct by players in their leagues. It is not clear that a change in policies and procedures is going to result in real change unless we change the perception that the public and other players and league employees have about domestic violence and sexual assault. Leagues and teams, who likely know their players and their behaviors better than law enforcement, should take action when there is evidence of domestic violence or sexual assault regardless of whether the athlete is prosecuted or convicted through our criminal justice system—a system which rarely punishes profes-

---

<sup>171</sup> The Tennessee Titans, Denver Broncos, Cleveland Browns and Detroit Lions are cited as having developed strong community partnerships. Ann Killion, *49ers Disappointing on Domestic Violence*, S.F. CHRON., Mar. 15, 2015, at A.

<sup>172</sup> *Id.*

<sup>173</sup> *Id.*

sional athletes. Athletes are the culturally elite; they are placed on pedestals, respected, and imitated. While they should be admired for the work they do on the field, we cannot ignore their conduct off the field.



