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# Designing Justice

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*A critical analysis of intellectual  
property rights within the fashion  
industry*

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## ABSTRACT

Designers are those individuals within our society with a desire and drive to create. In general designers can be found in all facets of industry and good designers (and ultimately good designs) are the very backbone upon a successful business is built. Designers are required to marry practical knowledge with artistic ability and we are reliant on their skills and to turn abstract ideas into formal designs for everything from the groceries we purchase, the cars we drive and of course, the clothes we wear<sup>1</sup>.

Whilst there is no definitive delineation of what a fashion design is, generally fashion designs relate to the creation of designs that focus on clothing, apparel and accessories. The style and functionality of the end products rest firmly within particular time frames, economic and socio-cultural environments within which particular designers find themselves. Accordingly the fashion design industry is never one that stagnates but rather is one that is constantly evolving<sup>2</sup>.

In South Africa, the fashion industry is blossoming. As an emerging economy, it is important to create opportunities and not barriers for entry into particular sectors for emerging entrepreneurs. The entire fabric of the fashion industry has certainly changed over time and these changes have brought an increased focus on issues of copying and counterfeiting. It is the contention of some in the industry that there is a need for stricter protection of the actual design in and of itself. Using intellectual property rights as a means of protecting fashion designs is very fitting as every new design begins with an idea, which then evolves, through a process of creative engagement and application of skill and labour to become the final original end product.

Designers seeking to protect their designs would need to consider the provisions of the Copyright Act<sup>3</sup>, the Designs Act<sup>4</sup> and the Trade Marks Act<sup>5</sup>. These Acts may in some instances provide a

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<sup>1</sup>Apparel Search „Designer Definition for the Clothing, Textile and Fashion Industry“ available at [http://www.apparelsearch.com/definitions/fashion/designer\\_definition.htm](http://www.apparelsearch.com/definitions/fashion/designer_definition.htm), accessed on 19 February 2016.

<sup>2</sup>ShirtsGoneWild „Definition of Fashion Design“ available at <http://definitionoffashiondesign.blogspot.co.za/>, accessed on 19 February 2016.

<sup>3</sup>The Copyright Act 98 of 1978.

<sup>4</sup>The Designs Act 195 of 1993.

<sup>5</sup>The Trade Marks Act 194 of 1993.

means for protect the actual design incidentally, i.e. by protecting the designer's rights in relation to reputation and goodwill associated with the goods whilst in others may afford protection to the design itself. The focus of this research will be a discussion of the legal mechanisms available to fashion designers in South Africa for the protection of their designs using their intellectual property rights and an assessment of whether the fashion industry is in need a stronger intellectual property regime than the current one.

# 1. AN INTRODUCTION TO THE FASHION INDUSTRY

## 1.1 *The Research Problem and Background*

There are different sectors that constitute the fashion industry, namely; the creators of the garments and the advertisers of the product, the marketers of the garments, those involved in selling the products<sup>6</sup>, and finally the producers of goods that are necessary make the apparel. However, it must be noted that this dissertation is limited to a discussion regarding the creators of garments and the protection sought over such designs.

An introduction into the fashion industry began in 17<sup>th</sup> century in the city of Paris, which is considered to be one of the world's fashion capitals. The first well-known designer to lay the foundation, on which the fashion industry is built, is Charles Frederick Worth and the fashion industry continues in this vein to this day<sup>7</sup>.

The driving force behind the fashion industry is said to be creativity or innovation, but where exactly does the creativity and innovation come from? In a perfect world fashion designers are the creative engines to the industry, with a seemingly never ending supply of fresh ideas and designs. However, this cannot be said to be the case. In reality inspiration to create comes from an existing source as one cannot create out of nothing<sup>8</sup>. Street fashion gives inspiration to designers and then undergoes transformation and interpretation into a collection<sup>9</sup>. That being said, the fact of the matter is that fashion designs are afforded limited protection under the intellectual property regime and many scholars call for stronger protection of this art, while others believe that the limited protection over this industry has done it justice. Therefore, it is clear this "beautiful" industry is at war. While many well-established fashion designers have

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<sup>6</sup> Janis Adams „What is the fashion industry?“ available at <http://www.wisegeek.org/what-is-the-fashion-industry.htm>, accessed on 9 March 2015.

<sup>7</sup> Where well known designers are the fuel to the fashion industry and less well known designers struggle to catch up.

<sup>8</sup> A Balasescu „After Authors: Sign(ify)ing Fashion from Paris to Tehran“ (2005) 10 *J of Mater. Cult* 289-310.

<sup>9</sup> EgreisGjergjani „How do Fashion Trends Start?“ *Stiletto Me Up* 8 March 2013, available at <http://stilettoeup.xyz/how-do-fashion-trends-start/> accessed on 20 March 2015.

called for sui generis protection for designs, others have begged the question, “Why should we extend regulation to protect every aspect of a design, when the industry has managed to survive as it stands?”

The fashion industry is a phenomenal one and it can be considered as one of the fastest growing industries that contribute to the growth of our economy<sup>10</sup>. The fashion industry stretches far and wide across the globe and can be equated to a culture that is practiced by every individual, be it from a fashionable perspective to an individual who mindlessly wanders the streets. Every day, we as individuals wake up and make a conscious and at times unconscious decision about what we wear. While some take it more serious than others, the point of departure is that this industry affects all. It is submitted that individuals unconsciously leave trends everywhere they go as evidenced by the evolution of modern fashion and this could be the inspiration needed for a designer that is looking for a new perspective.

South Africa’s second largest tax revenue source in the year 2014 was the Clothing, Textiles, Footwear and Leather (CTFL) industry. This industry also accounted for 14% of manufacturing employment<sup>11</sup>. Further, the industry creates approximately 60 000 to 80 000 jobs and injects about 8% into the country’s gross domestic product (GDP)<sup>12</sup>.

Over the past five years the fashion industry has evolved and has grown to new heights and as a result has made some significant contributions to the GDP of South Africa<sup>13</sup>. In 2004 the total contribution made to the GDP, by the textile industry amounted to R85billion out of a total GDP figure of R1.492 trillion<sup>14</sup>. In 2015 the fashion industry’s contribution is forecasted to increase to R122 billion<sup>15</sup>. Looking at the period 2010-2015 the textile industry has grown from 1.5 percent to 4 percent<sup>16</sup>. This is a clear indication of steadfast growth within the fashion industry.

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<sup>10</sup>R Hicks „The South African textile and clothing industry-an overview“ available at <http://www.businesspartners.co.za/knowledge-hub/manufacturing-fund/posts/south-african-textile-clothing-industry-overview-3252/>, accessed on 10 March 2015.

<sup>11</sup>Ibid.

<sup>12</sup> Ibid.

<sup>13</sup> Ibid.

<sup>14</sup> Ibid.

<sup>15</sup> Ibid.

<sup>16</sup> Ibid.

Further the fashion industry has significantly contributed towards employment within South Africa. The fashion industry has offered a lot of young people jobs and was able to absorb them into the industry and train them in respect to their various roles.

## **1.2 Aims and Purpose of this Research**

An aspect of the fashion industry that this dissertation concerns itself with is the creative process of a physical design. Stronger protection is sought over the creative work birthed through the process of conceiving, collecting and assembling ideas. When considering the effect of how a creative industry, such as the fashion industry, would be affected if protection over a design was afforded, attention must be drawn to a system where this position already exists. Within the European system the entire aspect of a design is protected, irrespective of whether such design is “intended to be multiplied by an industrial process or not”. The effectiveness of this system is evaluated to consider whether South Africa can follow suit in this regard.

South Africa’s intellectual property framework is a niche area of law with a number of different intellectual property principles governing it and there are various pieces of legislation that have been adopted to protect creativity in different respects. Creations that derive from the fashion industry can be said to generate certain intellectual property rights, subject to the aspect of separability<sup>17</sup>. Intellectual property is a unique area of law and for the purpose of this dissertation it will suffice to limit it to the concerning features of three important pieces of legislation within a South African legal context. Firstly, the Copyright Act 98 of 1978, the Designs Act 195 of 1993 and the Trade Marks Act 194 of 1993.

Firstly, looking at the Copyright Act, protection will be afforded upon meeting the requirements of the three elements, namely, the work must be in a material form, the work must be original and the work must be eligible for copyright protection in terms of s2(3) of the Copyright Act<sup>18</sup>. Secondly, the Designs Act extends protection to all registered designs, regardless of

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<sup>17</sup>*Carol Barnhart Inc v Economy Cover Corporation* 773 F.2d 411 (2d Cir. 1985) where the court laid down “the separability test which allows for the copyright of pictorial, graphic or sculptural features of a design, provided that those features are physically or conceptually separable from the useful features of the product. However, it must be stressed that this test would only apply to the non-functional aspect of the garment and the functional part still remains unprotected.”

<sup>18</sup>The Copyright Act 98 of 1978.



whether the design was registered before or after the introduction of this Act<sup>19</sup>. The Designs Act also makes a distinction between aesthetic and functional designs<sup>20</sup>. Aesthetic designs are concerned with appreciating the beauty of a piece of artwork, while functional designs are concerned with a design that is practical as opposed to decorative, i.e. it has a utilitarian purpose<sup>21</sup>. Therefore with respect to an aesthetic design, a design has to be both new and original<sup>22</sup> and with regards to a functional design, it has to be new and not commonplace in the scope of art being questioned<sup>23</sup>.

Lastly, the Trade Marks Act affords protection to trade marks within South Africa and while trademark protection does not afford protection to the outward appearance of a design, the effect of trade mark rights would be the same if the fashion design's outward appearance were protected. The effect of trade mark rights prohibits the continued trading of the same of similar goods and services under a same or similar trade mark.

However, in the absence of stringent protection over a fashion design in its entirety, the wealth of literature surrounding the topic of the fashion industry has given rise to an area of extensive debate. While some scholars recognise and understand that it is not a practical idea to extend the intellectual property regime to now include protection over a fashion design itself, other scholars maintain conflicting views. The other side of the scholars stress the dire need to extend protection to include every detail of the fashion design, arguing that there is no way new designers can build a name for themselves in an industry which grants little or no protection over their designs. In a South African context the fashion industry has proved to be successful and this is evident by the contribution made to the economy. Therefore, should the law be altered to reflect otherwise?

The purpose of this dissertation will be to critically examine the current intellectual property laws within a South African context and determine whether the unregulated aspect<sup>24</sup> should remain unaltered or should South Africa proceed with stringent fashion design rights, especially when the industry, left as is, has proved to be a prosperous one.

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<sup>19</sup> The Designs Act 195 of 1993 section 2.

<sup>20</sup> The Designs Act 195 of 1993 ss1 (1).

<sup>21</sup> Ibid.

<sup>22</sup> The Designs Act 195 of 1993 ss14(1)(a).

<sup>23</sup> The Designs Act 195 of 1993 ss14(1)(b).

<sup>24</sup> The fashion design itself.

### ***1.3 Research Objectives***

The objective of the research is to assess the current legislative mechanism within the intellectual property regime and evaluate the limitations of the law in this respect. After an evaluation has been conducted, recommendations are put forth as to how the industry should proceed with protection over a creative design.

This dissertation provides a background to the fashion industry and the limitations that are associated with the law, particularly in this regard. This dissertation also includes a review of arguments for and against the extension of intellectual property rights protection over a creative design, with a view of providing the industry with an appropriate model for industry in an accommodating manner.

### ***1.4 Relevance of this Research***

This research is relevant as it adds to the existing body of knowledge by providing insight into three traditional methods of intellectual property protection and the limitations within the system. The research focuses on the limited of intellectual property protection within the fashion industry and the ability of the industry to flourish nonetheless. The literature review is a clear indication of the conflict within the industry and at the same time it clearly recognises that copying and creativity can exist in harmony within the fashion industry. In the end this latter proposition is what is advocated for in the fashion industry and is recommended that South Africa should proceed in this direction.

### ***1.6 Research Questions***

The following research questions are examined and addressed in this dissertation:

1. What is the scope of the protection afforded by the Copyright Act afforded to fashion designs?
2. What is the reach of protection afforded by the Designs Act over a fashion design?
3. To what extent does the Trade Mark Act provide protection within the fashion industry?
4. Should copying be allowed and if so, to what extent?
5. How effective are international systems where every aspect of a design is protected?

## ***1.7 Methodology***

The type of research conducted will take the form of desktop research. Therefore, this will encompass local and foreign statute, foreign case law, academic journals, as well as web articles. These sources will be examined and critiqued to formulate an opinion as to whether a process of “*designing justice*” by introducing sui generis legislation or amending the traditional intellectual property legislation should take place within South Africa.

The next chapter will unpack the intellectual framework in South Africa that is said to afford limited, yet adequate protection over the fashion industry. Particular attention is paid to the Design Act<sup>25</sup>, the Trade Marks Act<sup>26</sup> and the Copyright Act<sup>27</sup>. A careful consideration will be made into how these pieces of legislation afford protection and instances where they are said to fall short.

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<sup>25</sup>The Designs Act 195 of 1993.

<sup>26</sup>The Trade Marks Act 194 of 1993.

<sup>27</sup>The Copyright Act 98 of 1978.

## 2. FASHION DESIGN AND COPYRIGHT

South Africa's intellectual property rights protection provides comprehensive cover for creativeness once disseminated to the public<sup>28</sup>. However, when one considers the fashion industry in particular, to purely rely on intellectual property rights protection could prove problematic. This is because despite the fact that protection through multiple forms of intellectual property protection can be granted over certain aspects of fashion design, the majority of the rights of fashion designers fall between the gaps of the intellectual property system<sup>29</sup>. This chapter will consider the Copyright Act 98 of 1978 in order to assess and critique the protection afforded to the fashion industry. Specific sections will be examined from the aforesaid legislative mechanism and an analysis will be done respectively.

Copyright is a form of protection given to authors or creators of original works of authorship including literary, dramatic, musical and other intellectual works<sup>30</sup>. Copyright protection vests in the author automatically upon fulfilling the requirements under the Copyright Act<sup>31</sup>. Copyright protection is also one of the traditional ways in which designers seek protection of their work. Copyright protection is said to be an incentive based system whereby the inventor creates something in which society can draw benefit from and in turn, society rewards the inventor with limited duration monopoly over such invention<sup>32</sup>. Fashion designs are more likely protected under s2 of the Copyright Act<sup>33</sup> as an artistic works. This then means that the author has the exclusive right to do and authorise others to do as the Copyright Act<sup>34</sup> indicates.

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<sup>28</sup> Publication disclosure and dissemination indicate the availability of a work and therefore does not constitute works that fall into the public domain. the public domain refers to works that are not protected by copyright and are not available for use with permission to the general public.

<sup>29</sup>Layne Randolph *Fashion Forward or Fashion Victim: Intellectual Property Protection in the Fashion Industry* (unpublished LLM thesis, Turin University, 2009) 67.

<sup>30</sup>The Copyright Act 98 of 1978.

<sup>31</sup>Ibid 27.

<sup>32</sup>S Yin & F Braun, 'The Devil Wears Trademark: How the Fashion Industry has Expanded Trademark Doctrine to its Detriment' (2014) 127 *Harvard LR* 995-1016.

<sup>33</sup>The Copyright Act 98 of 1978 section 2.

<sup>34</sup>Ibid 27.

## ***2.1 How does copyright arise?***

Copyright arises automatically provided certain requirements are met. These requirements are: that the work needs to be original and embodied in a material form.

### ***2.2.1 Qualified person***

In order for artistic, literary, musical and other intellectual works to be eligible for protection, the author, or the joint author in the case of joint authorship, or any one of the authors of any part of the work must be a qualified person<sup>35</sup>. An author will be a qualified person if the individual is a South African citizen or is domiciled or resident in the Republic<sup>36</sup>. Therefore in order for a fashion design to be an artistic work worthy of protection under the Copyright Act<sup>37</sup>, the fashion designer must be a South African citizen or the work must have been created in South Africa.

### ***2.2.2 Material Form***

The work must be in a material form. It must be stressed that mere ideas are not considered protectable under the Copyright Act<sup>38</sup> and that for protection to be afforded the creative work must be written or recorded for a copyright to subsequently come into existence<sup>39</sup>. For example there cannot be copyright protection in a painting whilst it still remains in the creator's mind; accordingly copyright may only exist when the painting has been actually painted in the form of an artistic work as defined in the Copyright Act<sup>40</sup>. Likewise, there can be no copyright while a design is still in the designer's head, rather copyright may only become applicable where the design is drawn out as an artistic work. Where an idea is reduced to a three-dimensional form (a completed garment) this would constitute material embodiment. In other words the idea needs to be written down in some form or the other. Owen Dean, in his article *Quo Vadis* clarifies the concept of material form further, "A traditional story which has been in existence for several generations is more often than not in a non-material and has been handed down by word of mouth from generation to generation... and for as long as it remains in this inchoate form it

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<sup>35</sup>The Copyright Act 98 of 1978 ss3 (1).

<sup>36</sup>The Copyright Act 98 of 1978 ss3 (1) (a).

<sup>37</sup>*Ibid* 27.

<sup>38</sup>*Ibid* 27.

<sup>39</sup>*Designer Guild Limited v Russell Williams (Textiles) Limited (T/A Washington DC)* [2000] UKHL 58.

<sup>40</sup> *Ibid*.

cannot qualify for copyright since it would have not passed from the realms of ideas into being in a material form<sup>41</sup>.”

### **2.2.3 Original Works**

The work must be original. However, the Copyright Act<sup>42</sup> does not give a precise definition as to what exactly is meant by the term “original”. In the absence of such definition, in *Hauptt/a Soft Copy v Brewers Marketing Intelligence (Pty) Ltd and Others*<sup>43</sup> the court required that in order to have met the originality requirement the author must have created the work” through their own creativity and labour and the following factors will be considered by the courts, namely, the fact that the work is a substantial improvement on what preceded it and that a lot of skill, labour, effort and time were expended in creating the works<sup>44</sup>. Originality does not refer to original thought or the expression of thought, but rather to skill or labour involved in the creative process<sup>45</sup>. Further it is work that can be proven to emanate from the author himself and not merely copied from another piece of work. It must be shown that some labour, skill or judgment has been brought to bear on the work before copyright can be successfully claimed<sup>46</sup>. The amount of labour, skill or judgment required for a work to be considered original is a question of fact and degree in each and every case<sup>47</sup>.

The question of original work is most often the stumbling block in terms of copyright protection for fashion designs. In relation to two dimensional designs, the path is clear and generally one is easily able to ascertain whether a two dimensional fashion design is original. However, three dimensional designs prove to be much more problematic. An example of a two dimensional drawing could be a sketch of a design that is produced by the designer as part of the creative process. It is an idea that is reduced to a material form. This type of two dimensional design would be capable of meeting the copyright requirements of originality (provided sufficient skill

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<sup>41</sup> O Dean „Quo Vadis South African Trademarks?“ (1998) 10 *South African Merc.LJ* 89.

<sup>42</sup>Ibid 27.

<sup>43</sup>*Haupt t/a Soft Copy v Brewers Marketing Intelligence (Pty) Ltd and Others* 2006 (4) SA 458 (SCA).; *Kalamazoo Division (Pty) Ltd v Gay and Others* 1978 (2) SA (C) 184.; *Pan Africa Engineers (Pty) Ltd v Hydro Tube (Pty) Ltd and Another* 1972 SA 470 (W).

<sup>44</sup>Ibid.

<sup>45</sup>Ibid.

<sup>46</sup>Ibid.

<sup>47</sup>Ibid.

and labour had be expended) and material form and as a result, protection over the two dimensional designs should be afforded. However, it must be stressed that when a two dimensional design is created and automatic protection arises, protection of such creative work is limited to the actual expression of that specific drawing itself. In the instance where the drawing is subsequently modified and results in a substantially altered drawing from the original, strictly speaking this “new” drawing warrant separate copyright protection.

The problem arises when the two dimensional designs are then developed into a three dimensional design. A three dimensional design involves creating the actual physical structure which would encapsulate a height, length and a width, thereby transforming a picture, drawing or photograph into a three dimensional physical form. For example, where the fashion design sketches are converted into pieces of actual clothing or apparel. Let us consider the case of a silk shirt made by fictitious designer X and a copycat silk shirt made by fictitious designer Y. Designer X (provided the requirements of s3 of the Copyright Act<sup>48</sup> are met) will satisfy the qualified person requirement. Material embodiment would be *afait accompli*.

It is the proof that the silk shirt is original in and of itself, separate from its drawings that would be the point of contention. One would need to prove that designer X had created the silk shirt through his own creativity, skill and labour and that the work is a substantial improvement on what preceded it, but it is not that simple. Shirts are functional utilitarian items (as are most items of apparel). Utilitarian works are generally not considered creative or artistic and therefore are not deemed to be protected by copyright. Utilitarian works are defined as works that do not have creative or artistic expression as their primary purpose. Instead they are created to perform a practical or useful function<sup>49</sup>. Examples of types of useful works would include clothing, furniture and electrical equipment.

In South Africa reference is made to works that are utilitarian in nature and the making of a copy of a copy under s15 (3A) of the Copyright Act<sup>50</sup>. Section 15 permits reverse engineering in

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<sup>48</sup>Ibid 27.

<sup>49</sup> T Scassa,Originality and Utilitarian Works: The Uneasy Relationship Between Copyright Law and Unfair Competition”(2003-2004) 1 *Univ of Ottawa Law &Technology Journal* 53.

<sup>50</sup>Ibid 27.

instances where the unauthorised copying of a copy is utilitarian in nature and is “made by an industrial process”.

The general rule regarding copying of a copy is that this would inevitably amount to infringement of copyright. However, the exception to such rule is located in s15 (3A) of the Copyright Act<sup>51</sup>. This section states that where a three dimensional version of an artistic work has been made available to the public with the consent of the copyright owner, the copyright in the artistic work will not be infringed by a person who makes a three dimensional copy of the authorised reproduction, provided that the article in question primarily has a utilitarian purpose and is made by an industrial process<sup>52</sup>. The introduction of s15 (3A) of the<sup>53</sup> Copyright Act authorises reverse engineering under given conditions and also serves as an example of an ongoing trend in intellectual property legislation that favors a freedom to copy works which have been permitted to pass into the public domain<sup>54</sup>.

The effect of s15 (3A) extends copyright protection to drawings regardless if such works are artistic or technical nature<sup>55</sup>. Section 15(3A) (a) (ii) confirms the inherent qualification for copyright protection of artistic works whether they are in two or three dimensional forms, as well as works that are created through an industrial process<sup>56</sup>.

In *Bress Designs v G Y Lounge Suite Manufacturers*<sup>57</sup> the court specifically dealt with the concept of reverse engineering, as an exception to copyright infringement, as well as what is meant by an industrial process. The element of industrial process will be later discussed under the Designs Act and consideration will now be made to the concept of reverse engineering as an

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<sup>51</sup>Ibid 27.

<sup>52</sup>The Copyright Act 98 of 1978 ss 15 (3A).

<sup>53</sup>Ibid 27.

<sup>54</sup> Pistorius, Tana, Trendy Sofa-a Useful Object or a Work of Art. The South African Mercantile Law Journal Vol 4 issue 1 1992 pages 91-97.

<sup>55</sup>Ibid.

<sup>56</sup>*Contra* Van der Merwe “Do Designs also Qualify in Substance for Artistic Copyright Protection ?”SALJ 656- 663.

<sup>57</sup>*Bress Designs (Pty) Ltd v G Y Lounge Suite Manufacturers (Pty) Ltd and Another* 1991 (2) SA 445 (W): The Applicant had seen a photograph of an M-shaped sofa with a hard wood frame manufactured in the USA. Consequently, the Applicant had designed an M-shaped sofa with a metal frame. Once the Applicants sofa had been released into the public for sale, the Respondent started manufacturing similar M-shaped sofas. The applicant alleged that this amounted to copyright infringement.



exception to copyright infringement that rests in two dimensional drawings. The concept of reverse engineering means that a design has been analyzed to see how it was made up and to reproduce it in a similar manner. The court held that the Frendi sofa falls short of the requirement of copyright ability as an artistic work because the objective test that was employed in this case indicated that the work, regardless of how appealing it was to the eye, was furniture and was functional in nature , thereby providing a utilitarian purpose, that being to sit on<sup>58</sup>. As a result of its functionality, s15 (3A) of the Copyright Act<sup>59</sup> then applied. This section allowed for copying of a copy provided that the article in question is utilitarian purpose<sup>60</sup>.

Considering the analogy of the silk shirt previously mentioned, if designer X had seen a picture of a silk shirt, had drawn inspiration from that picture and such modifications were manifested in a slight manner. Then consider that designer Y had seen these deigns and had drawn inspirations from designer X’s silk shirts. However, designer Y decided to add a gold trimming to the shirt. Designer Y can reply on s15(3A) of the Copyright Act<sup>61</sup> as an exception to copyright infringement of the silk shirt, where reverse engineering had taken place, as the shirt fulfills a utilitarian purpose and is made by an industrial process. Under such circumstances the copying of the silk shirt would be justified under reverse engineering. Further, it is important to note that one of the primary purposes in inhibiting copyright protection in utilitarian works is to prevent the creation of monopoly creating rights through copyright laws.

Under the Copyright Act<sup>62</sup> there is an absence of emphasis regarding the aesthetic and functional features that may be embodied in a fashion design. However, a designer would be able to protect features that are capable of existing independent form the useful element of such work, where the aesthetic features can be separated from the utilitarian aspect of such design. Furthermore, when it comes to fashion designs, it is extremely difficult to describe them as fulfilling an artistic work that can stand on its own, wholly independent from the aspects of a garment form<sup>63</sup>, unless a

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<sup>58</sup>Ibid.

<sup>59</sup>Ibid 27.

<sup>60</sup>Ibid 27.

<sup>61</sup>Ibid 27.

<sup>62</sup>Ibid 27.

<sup>63</sup>KVTu „Counterfeit Fashion: the interplay between Copyright and Trademark law in original fashion designs and designer knockoffs“ (2010) 18 *Texas Intellectual Property LJ* 419-448.

distinction is made regarding the two dimensional and three dimensional aspects of the design. Unlike fabric design or patterns that have pictorial depictions that exist apart from the fabric itself, fashion designs are not so easily separated from their utilitarian nature<sup>64</sup>. The doctrine of separability refers to the features of the design that can be identified separately from, and are capable of existing independently of the utilitarian aspects of the article<sup>65</sup> or where a design can be conceptually separated from the object in which it is embodied<sup>66</sup>. The difficulty lies in proving such separability exists, thereby eliminating the avenue of copyright protection for fashion designs. Therefore the design protection sought by fashion designers cannot be located in the Copyright Act<sup>67</sup> as the requirements prove to be limited to the two dimensional aspect of a fashion design.

Once again bearing in mind the silk shirt analogy, where the extent of drawing inspiration is considered, the question raised is could designer Y, in the event of copyright infringement raise the defense of fair-use? Before the principle of fair use is dealt with, one is to consider the issue of infringement. Infringement under the Copyright Act<sup>68</sup> includes reproducing the work concerned in any manner or form, and as s1 (2A) of the Copyright Act<sup>69</sup> makes it clear that the doing of any act in relation to any work shall, unless the context indicates otherwise, be construed as a reference to the doing of that act in relation to any substantial part of the work, it is clear that reproduction of a substantial part of a work will constitute copyright infringement<sup>70</sup>.

### ***2.3 The principle of fair-use***

The principle of fair-use can be found in within South Africa's Copyright Act<sup>71</sup> as general exceptions to copyright infringement (s12-19). When an individual makes unauthorised use of another creator's work, it may in certain circumstances be termed fair use. The general

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<sup>64</sup> Ibid.

<sup>65</sup> S Yin and F Braun "The Devil Wears Trademark", (2012) vol 127, Harvard LR ,issue 3, page 995-1016.

<sup>66</sup> *Carol Barnhart Inc vEconomy Cover Corporation* 773 F.2<sup>nd</sup> 411 (2d Cir 1985).

<sup>67</sup> Ibid 27.

<sup>68</sup> Ibid 27.

<sup>69</sup> Ibid 27.

<sup>70</sup> *Galago Publishers (Pty) Ltd v Erasmus* 1989 1 SA 276 (A).

<sup>71</sup> Ibid 27.

exceptions from protection of artistic works is found in s15 of the Copyright Act<sup>72</sup> and allows for the use of copyrighted material without the permission from the copyright holder<sup>73</sup>.

Section 12 (1) permits the use of unauthorised works-

- a) For the purpose of research or private study by, or the personal or private use of, the person using the work;
- b) For the purpose of criticism or review of that work or of another work; or
- c) For the purpose of reporting current event-
  - (i) In a newspaper, magazine or similar periodical; or
  - (ii) By means of broadcasting or in a cinematograph film<sup>74</sup>.

Section 15 (13) of the Copyright Act<sup>75</sup> specifically applies to artistic works and indicates that s12 (1) grounds of exceptions would apply mutatis mutandis to artistic works<sup>76</sup>. However, it cannot successfully be alleged, in order to avoid copyright liability that the replica of the silk shirt made by designer Y is for purposes such a research, private study or reporting a current event, in its three dimensional form. However, it could be argued that a two dimensional drawing of the silk shirt could somehow amount to criticism of the original design, as drawing may be critiqued, but would fail to be for the purpose of private or personal use or study.

Therefore in order for works to warrant copyright protection it needs to be evidenced of artistry and craftsmanship, said characteristics can be ascribed to designing and creating articles that are both pleasing to the eye and functional, as in the case of designing of clothing. However, as has been shown, in South Africa, a strict interpretation of the Copyright Act<sup>77</sup> disregards mere creativity and affords protection to two dimensional fashion designs alone, thereby rendering three dimension fashion designs unprotected. Therefore it is clear that Copyright Act<sup>78</sup> does in

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<sup>72</sup>Ibid 27.

<sup>73</sup>S Vaidhyathan *Copyright and Copywrongs: The Rise of Intellectual Property and How It Threatens Creativity* (2003 ).

<sup>74</sup>The Copyright Act 98 of 1978 ss12 (1).

<sup>75</sup>Ibid 27.

<sup>76</sup>The Copyright Act 98 of 1978 ss15 (13).

<sup>77</sup>Ibid 27.

<sup>78</sup>Ibid 27.

fact protect two dimensional designs and if such protection were to be extended to three dimensional designs a monopoly of rights would be created in the fashion industry.

The next chapter considers specific aspects of the Designs Act<sup>79</sup> in relation to protection afforded to fashion designs. An in-depth analysis will be conducted against this Act to see how far the legislation provides protection over a fashion design in particular.

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<sup>79</sup>The Designs Act 195 of 1993.

### **3. FASHION DESIGNS AND THE DESIGNS ACT**

There is an overwhelming consensus in the fashion industry that fashion designs are utilitarian items<sup>80</sup> that perform a function, i.e. are to be worn as clothes on an individual's back. With this in mind it is questionable as to what extent can a fashion design in a three dimensional form acquire protection as both aesthetic and functions designs under the Designs Act 195 of 1993. The extent of protection afforded by this Act will be explored in this chapter.

#### ***The Designs Act***

It is submitted that despite the promising language of the Designs Act<sup>81</sup>, it provides limited, yet adequate protections to fashion designs. The Designs Act<sup>82</sup> defines a design as an aesthetic or functional design and protection is only afforded once the design meets the requirements under the Act. As a result of distinguishing between the two types of designs, there are consequentially two sets of requirements, depending on the type of design, before protection can be afforded. For an aesthetic design to acquire protection the design in question must be new and original<sup>83</sup> and for a functional design to acquire protection it must be new and not commonplace in the art in question<sup>84</sup>.

#### ***3.1 Designs covered by the Act***

##### ***3.1.1 Aesthetic Designs***

Aesthetic design refers specifically to any design applied to an article, whether for the pattern or the shape of the configuration or the ornament thereof, or any two or more of these purposes, and by whatever means it is applied having features which appeal to and are judged solely by the eye, irrespective of the aesthetic quality thereof<sup>85</sup>.

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<sup>80</sup>Oliver Herzfeld „Protecting Fashion Designs“ Forbes January 3 2013 available at [www.forbes.com/sites/oliverherzfeld/2013/01/03/protecting-fashion-designs/](http://www.forbes.com/sites/oliverherzfeld/2013/01/03/protecting-fashion-designs/) accessed 16 February 2016.

<sup>81</sup>The Designs Act 195 of 1993.

<sup>82</sup>Ibid.

<sup>83</sup> The Designs Act195 of 1993 ss14(1)(a).

<sup>84</sup> The Designs Act195 of 1993 ss14(1)(b).

<sup>85</sup> The Designs Act195 of 1993 section 1.

### **3.1.2 Functional designs**

A functional design means any design applied to an article, whether for the pattern or the shape of the configuration thereof, or for any two or more of these purposes and by whatever means applied, having features which are necessitated by the function which the article is applied, is to perform, and includes an integrated circuit topography, a mask work and a series of masks works<sup>86</sup>.

### **3.2 Requirements for protection**

The Designs Act<sup>87</sup> does not afford protection to designs that that have not been registered under the Act and in order for protection to be granted over a design it has to be registered under this Act<sup>88</sup>. The Designs Act<sup>89</sup> distinguishes between an aesthetic and a functional design<sup>90</sup>; it goes further and provides a separate set of requirements for registering a different type of design<sup>91</sup>.

#### **3.2.1 Aesthetic designs**

In terms of registering an aesthetic design under s14 (1) of the Designs Act<sup>92</sup>, the design must be new and original. An aesthetic design registration affords the right holder no rights in the purely functional features of an article embodying the registered design, or in its method of construction. Section 14(2) of the Deigns Act<sup>93</sup> states that a design will be considered to be new if it is different from or if it does not form part of the state of the art immediately before the date of application for registration thereof or the release date thereof, whichever is earlier<sup>94</sup>. The state of the art is defined as works that are already made available to the public- either a written source or by other means<sup>95</sup>.

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<sup>86</sup>Ibid.

<sup>87</sup>Ibid 81.

<sup>88</sup> The Designs Act 195 of 1993 ss 2 (1).

<sup>89</sup>Ibid 81.

<sup>90</sup> The Designs Act 195 of 1993 section 1.

<sup>91</sup> The Designs Act 195 of 1993 section 14.

<sup>92</sup>Ibid 81.

<sup>93</sup>Ibid 81.

<sup>94</sup>The Designs Act 195 of 1993 ss14 (2).

<sup>95</sup> Ibid.

### 3.2.2. Functional designs

In terms of registering a functional design under s14 (1) of the Designs Act<sup>96</sup>, the design must be new and not common place within the art in question. The requirement of not common place in the art in question implies that a functional design should not be a trivial alteration to an existing design when viewed through the eyes of a person skilled in the field of articles to which the design is applied<sup>97</sup>. If it is important that a functional feature of an article should be protected, it will be necessary to file applications for design protection in both Part A and Part B, namely as both an aesthetic and a functional design. Section 14(2) of the Deigns Act<sup>98</sup> states that a design will be considered to be new if it is different from or if it does not form part of the state of the art immediately before the date of application for registration thereof or the release date thereof, whichever is earlier<sup>99</sup>. The state of the art is defined as works that are already made available to the public- either a written source or by other means<sup>100</sup>.

### 3.3 Case law

Another very important section of the Designs Act is s14 (5)<sup>101</sup> which reads that no feature of an article in so far as it is necessitated solely by the function which the article is to perform shall afford the registered of an aesthetic design any rights in terms of the Act in respect of such feature<sup>102</sup>. This clearly indicates that the features of a design, may not in some cases, be necessitated by the function of a design. In some instances such a design may also have an aesthetic design. In the case of *Klep Valves (Pty) Ltd v Saunders Valves Co Ltd*<sup>103</sup>, the court followed the approach where the appearance of a valve, which was determined by purely functional considerations, was not protectable as an aesthetic design<sup>104</sup>. The court emphasized the fact that many of the features would not be visible in use. However, the court adopted a different approach in the case of *MCG v Chespak*<sup>105</sup>, which dealt with an aesthetic design filed in

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<sup>96</sup>Ibid 81.

<sup>97</sup>South African Institute of Intellectual Property Law „Design“ available at <http://www.saiip.org.za/introip/73-designs> accessed on 16 February 2016.

<sup>98</sup>Ibid 81.

<sup>99</sup>The Designs Act 195 of 1993 ss14 (2).

<sup>100</sup> Ibid.

<sup>101</sup> The Designs Act 195 of 1993ss14 (5).

<sup>102</sup>Dean and Dyer *Introduction to Intellectual Property Law* (Oxford University Press 2014).

<sup>103</sup>*Klep Valves (Pty) Ltd v Saunders Valves Co Ltd* 1987 (2) SA (A).

<sup>104</sup>Dean and Dyer *Introduction to Intellectual Property Law* (Oxford University Press 2014).

<sup>105</sup>*MCG v Chespak* 2011 BIP 284 (GNP).

terms of the Designs Act<sup>106</sup>. The court found that that a design for a bottle carrier included features which were not necessitated solely by a function which the article is to perform, and that such features also had an eye appeal<sup>107</sup>. The aesthetic design for the bottle carrier was therefore held to be valid<sup>108</sup>.

From this judgment we clearly see that a design which is purely functional and is registered as a functional design may also have aesthetic features and as a result the aesthetic design may be registered. Therefore, if a hat had to be considered, it is clear that this is a purely functional design, however, if diamonds and a unique feature had to be attached to it, then this brings alive the aesthetic design that, based on the *MCG v Chespak*<sup>109</sup> judgement, could also be registered. Therefore there is hope for having, for instance, a shoe or handbag that has a purely functional design as well as eye appeal, if such design is created with an aesthetic appeal.

Therefore, in considering whether the silk shirt would be afforded protection under the Designs Act<sup>110</sup>, the requirements for it to be registered as an aesthetic design must be met, namely, new, which means original<sup>111</sup>. When considering the element of new (original), it is evident that this proved to be a stumbling block for protection of a design under the Copyright Act<sup>112</sup> and would inevitably be a further stumbling block under the Designs Act<sup>113</sup>; therefore fashions designs would find it impossible to meet this requirement. Further, when it comes to the fashion industry one would imagine how difficult, if not impossible, it is to meet the requirement of not commonplace in the existing art, especially when copying is said to fuel creativity. In order to meet this statutory requirement, one would have to manufacture a brand new item of clothing; and unless the public demands fingernail-warmers, one would have to imagine the possible difficulties faced<sup>114</sup>.

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<sup>106</sup>Ibid 81.

<sup>107</sup>Dean and Dyer *Introduction to Intellectual Property Law*(Oxford University Press 2014).

<sup>108</sup>Ibid.

<sup>109</sup>*MCG v Chespak* 2011 BIP 284 (GNP).

<sup>110</sup>Ibid 81.

<sup>111</sup>The Designs Act 195 of 1993 ss 14(3).

<sup>112</sup>Ibid 27.

<sup>113</sup>Ibid 81.

<sup>114</sup>Scafidi S „Intellectual Property and Fashion Design“ in PK Yu (ed) *Intellectual Property and Information Wealth: Copyright and Related Rights* (2007) 115, 116.



### ***3.4 Industrial process***

Additionally a sub-requirement for the registration of a fashion design is that such a design must be intended for industrial process. It is common cause that a majority of fashion designs are in fact, by their nature, intended for mass production. Considering the example of the silk shirt again, where designer Y intends that such shirt be multiplied by mass production, protection of such functional item is in fact received under Part B of the Designs Act<sup>115</sup> pertaining to functional designs. However, if one has to consider the meaning industrial process under the Designs Act<sup>116</sup>, it is then realised that attention has to be drawn to case law rather as the Act is silent on its definition.

The Designs Act<sup>117</sup> does not provide a specific definition as to what amounts to an industrial process, however in the case of *Bress Designs v GY Lounge Suites Manufacturer*<sup>118</sup> the court dealt with this concept extensively. The court was faced with the question of whether the lounge suite was made by an industrial process. The counsel for Applicant argued that this term was in fact limited to automatic machinery<sup>119</sup>. However, such an argument was rejected by the court and held that the term was in fact not limited, but rather, the term industry meant of industry<sup>120</sup>. The court went on to state that the manufacturing of a sofa is an industrial process that takes place in the Applicant's factory<sup>121</sup>. Therefore, the sofa falls squarely within the ambit of section 15(3A) and its exemption from copyright protection<sup>122</sup>. From this it is clear that the term industrial process refers to a mass production of a design and not just a single masterpiece.

It must be noted that when reference is made to a design, it is limited specifically to a fashion design and does not refer to a fabric design. Fabric designs refer specifically to the design on the pictorial designs that are embodied on the fabric itself. In some instances creating a fabric design may prove to be an effortless task as compared to creating a design of a dress, shoe or handbag.

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<sup>115</sup>Ibid 81.

<sup>116</sup>Ibid 81.

<sup>117</sup>Ibid 81.

<sup>118</sup>*Bress Designs (Pty) Ltd v G Y Lounge Suite Manufacturers (Pty) Ltd and Another* 1991 (2) SA 445 (W).

<sup>119</sup>Pistorius, Tana, Trendy Sofa-a Useful Object or a Work of Art. The South African Mercantile Law Journal Vol 4 issue 1 1992 pages 91-97.

<sup>120</sup>Ibid.

<sup>121</sup>*Bress Designs (Pty) Ltd v G Y Lounge Suite Manufacturers (Pty) Ltd and Another* 1991 (2) SA 445 (W).

<sup>122</sup>Ibid.

Therefore it is submitted the Designs Act<sup>123</sup> does provide protection to designs that are both aesthetic and functional in nature and fashion designs protection locates itself within the latter type of protection afforded by this Act. While masterpieces are seemingly left outside this scope of protection, the Trade Marks Act<sup>124</sup> may be the avenue for affording protection to a masterpiece.

This chapter analysed one of the three mentioned forms of protection fashion designs may have under the intellectual property regime. Therefore it is submitted that the Designs Act<sup>125</sup> does in fact provide protection to fashion designs that are functional in nature and the protection is limited to this type of fashion designs. In the event where the protection of a fashion design is now extended to include aesthetic designs as well as single designs, then once again this may prove to be an avenue for the creation of monopoly rights within the fashion industry, thereby preventing the wheels of fashion from turning.

Consequently, in an attempt to secure protection over masterpiece design, designers turn to trademark law as an alternate avenue of protecting a single master piece, in a hope that a label will provide protection over such design. The next chapter analyses the ambit of the Trade Marks Act<sup>126</sup> in an attempt to discover whether trademark protection may be another avenue which designers may use to protect the physical features of a single masterpiece of a fashion design.

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<sup>123</sup>Ibid 81.

<sup>124</sup>The Trade Marks Act 194 of 1993.

<sup>125</sup>Ibid 81.

<sup>126</sup>The Trade Marks Act 194 of 1993.

## 4. FASHION DESIGN AND TRADE MARK PROTECTION

The strongest source of intellectual property protection, with regards to the fashion industry, has always been trade mark laws as they identify the products as well as their source,<sup>127</sup> as well as protecting the reputation of the designer. This chapter will seek to analyse the protection afforded to designers under the Trade Marks Act<sup>128</sup> and alternatively the common law remedy of passing off.

At this point in the discussion it is highly relevant that it is emphasized that those seeking to protect the fashion design per se would not be able to rely on the protections offered by the Trade Marks Act<sup>129</sup>. This is because one would only be able to protect the trade mark or sign associated with the design and not the actual design itself. Rather, it is the trade mark (acting as the indicator of the original source of the goods and services associate thereto) that is protected by the Trade Marks Act<sup>130</sup> and concomitantly serves to protect the goodwill attached to the said trade mark as well<sup>131</sup>.

The Trade Marks Act<sup>132</sup> defines a trade mark as other than a certification of a trade mark or a collective trade mark, means a mark used or proposed to be used by a person in relation to goods or services for the purpose of distinguishing the goods or services in relation to which the mark is used or proposed to be used from the same kind of goods or services connected in the course of trade with any other person<sup>133</sup>.

In the instance where interested parties are seeking to protected their trade mark from prejudice and more especially to protect the apparel linked thereto from any conduct that would (a) have a negative impact on the proprietor’s ability to trade and/or (b) constitute any prohibited conduct as described in the trades marks act, those parties would have to institute infringement proceedings against the alleged infringer as set out in Part VII of the Trade Marks Act<sup>134</sup>. If

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<sup>127</sup>Layne Randolph *Fashion Forward or Fashion Victim: Intellectual Property Protection in the Fashion Industry* (unpublished LLM thesis, Turin University, 2009) 67.

<sup>128</sup>The Trade Marks Act 194 of 1993.

<sup>129</sup> Ibid.

<sup>130</sup> Ibid 128.

<sup>131</sup>Webster GC& Page NS: *South African Law of Trademarks, Unlawful Competition, Company Names and Trading Styles* 4ed (South Africa: Lexis Nexis 1997) Par 3.16.

<sup>132</sup>Ibid 128.

<sup>133</sup>The Trade Marks Act 194 of 1993 section 2 (definition section).

<sup>134</sup>Ibid 128.

successful in their suit, their effect of their civil litigation would not only be the protection of the trade mark, but also of the associated goods or services.

If one has to consider the example where designer X selling his silk shirts under the trade mark „Parbhoo S“ and discovers that designer Y is selling silk shirts under a similar name „Parbhoo Z“. Designer X may institute proceedings to prevent designer Y from trading under a similar trade mark. The crux of this issue is that both trade marks bare striking similarity, and it is under these circumstances that designer X may institute proceedings to prevent the continued trading of his goods. It is important to note that the while the use of the trade mark does not protect the silk shirt design, trade mark protection still has the same effect of protecting a design, and that is to stop the continued trading of the same or similar item under a similar trademark.

#### ***4.1 Infringement of a trade mark***

Part VII and more particularly s34 of the Trade Marks Act<sup>135</sup> deals with three types of common statutory trade mark infringements.

##### ***4.1.1 Section 34 (1) (a)***

Under s34 (1) (a) of the Trade Marks Act<sup>136</sup> the rights acquired by registration of a trade mark shall be infringed by the unauthorised use in the course of trade in relation to goods or services in respect of which the trade mark is registered, of an identical mark or of a mark so nearly resembling it as to be likely to deceive or cause confusion<sup>137</sup>. In order to invoke protection under this section the infringement must relate to the use of identical or closely resembling trade marks and such trade marks must be used in relation to identical goods or services<sup>138</sup>. An example of this type of infringement would be the clothing stores Forever 21 and Forever 22. Here Forever 21 can sue owners of Forever 22 in terms of s34 (1) (a) of the Trade Marks Act<sup>139</sup>. The allegedly infringing use involves the use of the mark (Forever 22) that is almost identical or very closely resembling Forever 21’s mark and Forever 22 is now being used to promote the same goods and services as Forever 21 i.e. clothing.

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<sup>135</sup>Ibid 128.

<sup>136</sup>Ibid 128.

<sup>137</sup>The Trade Marks Act 194 of 1993 ss34 (1) (a).

<sup>138</sup>Dean and Dyer *Introduction to Intellectual Property Law* (Oxford University Press 2014).

<sup>139</sup>Ibid 128.

In order for Forever 21 to have a successful claim against Forever 22, the owners of Forever 21 would have to prove: the unauthorised use of the Forever 21's trade mark, that was used in the course of trade, that the offending trade mark is identical or closely resembling to the registered trade mark, in the connection with the same goods or services as covered by the registered trade mark and such use of the offending trade mark is likely to deceive or cause confusion.

#### **4.1.2 Section 34 (1) (b)**

Under s34 (1) (b) of the Trade Marks Act<sup>140</sup> the rights acquired by registration of a trade mark shall be infringed by the unauthorised use of a mark which is identical or similar to the trade mark registered, in the course of trade in relation to goods or services which are similar to the goods or services in respect of which the trade mark is registered, that in such use there exists the likelihood of deception or confusion<sup>141</sup>. To invoke protection under this section the infringement must relate to the use of identical or similar marks and used in relation to similar goods or services<sup>142</sup>. An example of this type of infringement would be BMW and BEEMW. The alleged infringing use involves the use of the mark (BEEMW) that is similar to the BMW mark and BEEMW is being used to promote similar services as BMW. BMW's principal business involves the manufacturing and sale of cars under the name BMW. BEEMW principle business is the manufacture of car products and car cleaning products, therefore, similar services or goods.

In order for Microsoft to have a successful claim against BEEMW, the owners of BMW would have to prove there is an unauthorised use of the trade mark (BEEMW), that was used in the course of trade, that the offending trade mark (BEEMW) is identical or similar to the registered trade mark (BMW), in connection with similar goods or services as those covered by the registered trade mark and such use of the offending trade mark is likely to deceive or cause confusion.

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<sup>140</sup>Ibid 128.

<sup>141</sup>The Trade Marks Act 1994 of 1993 ss34 (1) (b).

<sup>142</sup>Dean and Dyer *Introduction to Intellectual Property Law* (Oxford University Press 2014).

### 4.1.3 Section 34 (1) (c)

This section offers protection against the dilution or tarnishment of a trade mark. Under s34 (1)(c) of the Trade Marks Act<sup>143</sup> the rights acquired by the registration of a trade mark shall be infringed by the unauthorised use in the course of trade in relation to any goods or services of a mark which is identical or similar to a trade mark registered, if such trade mark is well known in the Republic and the use of the said trade mark would be likely to take advantage of, or detrimental to, the distinctive character or the repute of the registered trade mark, notwithstanding the absence of confusion or deception<sup>144</sup>. To invoke protection under this section, the infringement must relate to the use of identical or similar marks that is used in relation to any goods or services<sup>145</sup>. The use of the mark does not have to be identical or similar or closely resembling the registered mark. An example of this type of infringement can be seen between PEOPLE'S MAGAZINE and BLACK PEOPLE'S. PEOPLE'S MAGAZINE will be able to sue BLACK PEOPLE'S under this section because the allegedly infringing use involves the use of a mark (PEOPLE'S) that is identical to the PEOPLE'S MAGAZINE trade mark, and it is irrelevant that the that the is being used to promote different goods or services. PEOPLE'S MAGAZINE'S principle business involves the sale of an international news magazine. BLACK PEOPLE'S principal business is a book store and coffee shop.

In order for PEOPLE'S MAGAZINE to have a successful claim against the owner of BLACK PEOPLE'S, PEOPLE'S MAGAZINE would have to prove that the unauthorised use of the trade mark (PEOPLE'S) , is used in the course of trade, where the trade mark (BLACK PEOPLE'S) is identical or similar to the registered trade mark (PEOPLE'S MAGAZINE). Further, that BLACL PEOPLE'S is used in connection with the goods or services where the registered trade mark is well known and such use is likely to take unfair advantage of, or be detrimental to, the distinctive character or the repute of the registered trade mark.

What must be stressed under this section is that the owners of the registered trade mark need not have to prove confusion of the trade marks, but rather what needs to be established is an association that impairs the distinctiveness of the mark. Under this section the consumer does

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<sup>143</sup>Ibid 128.

<sup>144</sup>The Trade Marks Act 194 of 1993 ss34 (1) (c).

<sup>145</sup>Dean and Dyer *Introduction to Intellectual Property Law* (Oxford University Press 2014).

not confuse the products, but the offending mark erodes the selling power and reputation of the registered trade mark.

It must be noted that statutory protection is not the only available remedy for fashion designs and there is a common law remedy that avails itself in the event of infringement under the given circumstances discussed below.

#### ***4.2 Passing off***

Rabie JA in the case of *Capital Estates & General Agencies (Pty) Ltd v Holding Inns Inc.*<sup>146</sup> defined passing off as the wrong known as passing off consists in a representation by one person that his business is that of another, or that it is associated with that of another, and, in order to determine whether a representation amounts to passing off, one inquires whether there is a reasonable likelihood that members of the public may be confused into believing that the business of the one is, or is connected with, that of another. Passing off is not a statutory remedy, but rather it is a common law remedy<sup>147</sup>.

#### ***4.3 Trade mark infringement case law***

It is important to consider case law to understand the extent to which protection is received. In the case of *Adidas AG v Pepkor Retail Limited*<sup>148</sup>, which involved trade mark infringement and passing off of the respondent's registered trade mark viz. the three parallel stripes, in relation to sporting footwear. Pepkor's use of two and four parallel stripes amounted to an infringement of s34 (1) (a) of the Trade Marks Act<sup>149</sup> and it also amounted to passing off the goods as if they were that of Adidas. The court found that this amounted to the utilisation of a registered trade mark and not decoration or embellishment as argued by the respondent<sup>150</sup>. Further, considering that the appellant's trade mark was so well-known the likelihood of confusion or deception for the ordinary consumer is increased. Protection in this case relates solely to the use of the stripes

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<sup>146</sup>Webster GC& Page NS: *South African Law of Trademarks, Unlawful Competition, Company Names and Trading Styles* 4ed (South Africa : Lexis Nexis 1997) Par 15.5 ;*Capital Estates & General Agencies (Pty) Ltd v Holding Inns Inc* 1977 2SA 916 (A) 929C.

<sup>147</sup> Ibid.

<sup>148</sup>*Adidas AG and Another v Pepkor Retail Ltd* 2011 (14605/2009) ZAWCHC 444; [2012] 1 All SA 636 (WCC).

<sup>149</sup>Ibid 128.

<sup>150</sup> Ibid.

that ultimately constituted a trade mark. Although the effect of this decision does not provide protection to the overall design of the Adidas shoe, it does provide trademark protection, which is an alternative to protecting the overall design where the same resulting protection may be achieved. The trade mark proprietor may use their trade mark rights to prevent the continued sale of the alleged similar designs and this would have the same effect if the overall design was protected. Under the circumstance of this case Adidas was able to prevent the continued sale of Pepkor's goods.

Further, in the case of *Foschini Retail Group (Pty) Ltd v Coetzee*<sup>151</sup>, where the trade mark „DUE SOUTH“ was used by both parties to the matter, but were not used in a similar trade of goods and services, which is requirement for a successful infringement case as stated above<sup>152</sup>. The matter was brought under s34 (1) (b) of the Trade Marks Act<sup>153</sup>. The court had found that both parties' goods and services had nothing in common<sup>154</sup>. The court found that educational services and provision of training could not be deemed as trading in a similar trade. The court stressed on the issue of similarity, and held that even though the trade marks itself were similar, proprietor of the trade marks were not dealing in the same or similar trade<sup>155</sup>. The case turned on the issue of the same or similar trade.

Moreover, a very important case for our South African courts that dealt with the issue of dilution is *Laugh It Off Promotions CC V South African Breweries International (Finance)*<sup>156</sup>. This case dealt with the dilution of the trade mark “Black Label” where such label was parodied in the form of t-shirts, with associated terms which included “Black Labour” and “White Guilt”<sup>157</sup>. In dealing with the issue of detriment, Moseneke JA held that proof of a mere unsavory association was insufficient: the plaintiff in a dilution matter had to establish a likelihood of substantial economic detriment...The probability of material detriment to the mark envisaged in the section must be restricted to economic and trade harm<sup>158</sup>. The effect of this decision is that once works enters the public, such works must be open to critique and commentary, regardless of whether it

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<sup>151</sup>*Foschini Retail Group (Pty) Ltd v Coetzee* 2013 JDR 0001 GNP.

<sup>152</sup> Ibid.

<sup>153</sup> Ibid 117.

<sup>154</sup>*Foschini Retail Group (Pty) Ltd v Coetzee* 2013 JDR 0001 GNP.

<sup>155</sup> Ibid.

<sup>156</sup>*Laugh It Off Promotions CC v South African Breweries International (Finance) B.V. t/a as Sabmark International and the Freedom of Expression Institute* 2005 8 BCLR 743 (CC).

<sup>157</sup> Ibid.

<sup>158</sup> Ibid.



is distasteful or not. Infringement would rise to the surface where such works suffers economic or trade harms. Once again the design of the t-shirts are not protected, but rather the continued sale of clothing that erodes the selling power or reputation of the trade mark will be discontinued when the actual trade mark suffers economic harm, thereby providing an alternative to protection of the outward appearance of a design, but nevertheless achieving the same end result, that is to prohibit the continued sale of similar designs.

Furthermore, case law on an international level in the fashion industry signals that while there is a steadfast attempt to protect one's physical designs, the law proves to be inadequate in this regard. At the forefront of international lawsuits surrounding the issue of trade mark protection, is the case of *Christian Louboutin v Yves Saint Laurent*- also known as the battle of the Red-Sole Shoe<sup>159</sup>. The French designer Christian Louboutin (Applicant) designed the globally renowned red-sole shoe and obtained a trade mark over such a design (a lacquered red sole on footwear<sup>160</sup>), in 2008. Subsequently, in 2011, Christian filed a lawsuit against Yves Saint Laurent (Defendant), arguing that he had infringed upon his trade mark, as the Defendant had a red-sole design in his 2011 collection.

The Defendant argued that a single colour within the fashion industry cannot be protected, especially because the colour red had severe ramifications within the fashion industry. The New York district court judge held that to grant the Applicant a monopoly over the colour will impermissibly hinder competition among other participants and this trade mark protection would give the Applicant too broad a protection, especially when colour provides an aesthetic function in the fashion industry, thereby ruling in the Defendant's favour, on condition that the whole shoe is red. Further, the court ruled out the argument of likelihood of confusion on the basis that the mark violated the aesthetic functionality doctrine. The Second Circuit court reaffirmed the First Circuit Court decision that the Applicant will continue to have the exclusive right to use the colour red on the outer sole of the shoe, but other designers cannot be denied from designing shoes that are totally red, including the soles.

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<sup>159</sup>K Grochala „Intellectual Property Law: Failing the fashion industry and Why the “Innovative Design Protection Act” Should be passed“ (2014) *Student Scholarship Paper* 133.

<sup>160</sup>*Christian Louboutin SA. v Yves Saint Laurent Am. Holding, Inc.* No. 11-3303 (2d Cir. 2013).

This judgment's application of rule, that colour cannot serve as a trade mark, despite precedent's indication otherwise, was formed on the basis that this would create a war within the fashion industry. This judgment was at odds with both the law and precedents, as precedents set have previously awarded colour as a trade mark. The Second Circuit Court was incorrect in reversing the district court's finding and ultimately concluded that there was no likelihood of confusion in instances where the upper-half of the shoe matched the sole, but rather only in instances where the upper-half differed in colour. Therefore, the Applicant's claim should have been entirely successful as colour does in fact serve as a trade mark.

This decision has severe implications for the fashion industry. Firstly, the decision of the court that the trade mark does not apply to shoes that have matching uppers permits other designers to subsequently profit from the expense of Applicant's well-established trade mark, without the fear of incurring liability, thereby reaping off the reputation of a well-known trade mark. Therefore we are unsure what will happen in a situation where another designer seeks to employ a matte red to the sole of a shoe as the trademark registered refers to red without a particular specification of a particular shade or is the trademark limited to high heels, in the instance where another designer employs red to pumps. The decision has positive implications for both sides for both sides, where the Applicant retained the right to use the red sole trade mark; provided the upper part of the shoe contrasted in colour and Defendant was found not to have infringed the Applicant's trademark.

In the case of *Gucci Am Inc. v Guess? Inc.*<sup>161</sup> which was a three-year matter involving alleged passing off, trade mark infringement, dilution and counterfeiting. The initial involved several alleged infringements of Gucci's designs by Guess?, namely its Green-Red-Green (GRG) stripe design, stylized G design mark and its diamond motif. The court found that Guess's Quattro G pattern infringed Gucci's diamond motif despite the fact that it was unregistered. The basis of the court's decision laid in principle of likelihood of confusion, particularly when considered against a two tone canvas background.

Despite the fact that Gucci did not put forth actual evidence before the court, the basis for its finding laid solely in Guess's intentional copying of Gucci's diamond motif. The likelihood of

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<sup>161</sup>*Gucci America, Inc. v. Guess?, Inc.* 2012 WL 1847646, No. 09 Civ. 4373(SAS) (May 21, 2012).

confusion only existed when the G's were against the canvas two-tone background and infringements were as a result limited to this aspect<sup>162</sup>. Next the court considered the GRG stripe, and concluded that Guess's conduct was so egregious that the court found that there was no need to dwell on whether there was a likelihood of confusion.

The court had found with regard to Gucci's dilution claim, that in both instances Guess's Quattro G and striped GRG created a likelihood of dilution. The trade mark use by Guess was purely to impair the goodwill of Gucci and therefore, infringement is specifically limited to instances where Guess's Quattro was used against the brown canvas background and the striped GRG design to the use of green-red-green combination only<sup>163</sup>. With regard to the alleged counterfeiting, the court stressed that this is limited to instances where the entire product has been copied stitch for stitch<sup>164</sup>. What this case symbolizes for the fashion industry is that in the case of an alleged counterfeiting, a successful case will have to rest upon the exact replica of the design in question<sup>165</sup>. The position is the same in a South African context where Gucci would have a merited claim for passing off under common law, evidenced by Guess's attempt to pass off a well-known Gucci's design as if the product is that of or associated with the Gucci brand. Further, Gucci would have had another merited claim under either s34 (1) (a) of the Trade Marks Act<sup>166</sup>, where infringement, by use of the similar marks, took place within the same class of goods.

Next is the case of *Louis Vuitton v Dooney and Bourke*<sup>167</sup>, also known as the battle of the handbags, which also involved alleged trade mark infringement by Dooney and Bourke of Louis Vuitton's multi-colour line of the entwined initials, „LV“. Dooney and Bourke designed a bag with the „D&B“ initials entwined. The court held that this did not amount to passing off and subsequently, there was no trade mark infringement. An important argument made in this case, on the basis of an expert report, was that for at least some consumers the awareness of the alleged copy made the Louis Vuitton bag more desirable. Because mental association of the

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<sup>162</sup>Whitney Devin Cooke „Gucci Am., Inc. v. Guess? Inc.“, available at [http://www.finnegan.com/files/upload/Newsletters/Incontestable/2012/Summer/Incontestable\\_Summer12\\_4.html](http://www.finnegan.com/files/upload/Newsletters/Incontestable/2012/Summer/Incontestable_Summer12_4.html), accessed 10 June 2015.

<sup>163</sup> Ibid.

<sup>164</sup> Ibid.

<sup>165</sup> Ibid.

<sup>166</sup> Ibid 128.

<sup>167</sup> *Louis Vuitton Malletier v. Dooney & Bourke Inc* 454 F.3d 108 (2d.Cir. 2006).

marks is not sufficient and because Vuitton has not showed actual evidence of dilution, the preliminary injunction was rightly denied. This case suggests that designers are able to utilize the same idea and design of another designer without being liable for trade mark infringement so long as the marks themselves are distinctive. Thus, the case suggests the designers do not warrant protection over a specific type of design<sup>168</sup>. However, in a South African context the requirements for passing off are somewhat similar as discussed in the above case. The requirements for proving passing off is infringement of a distinctive mark or infringement of the right to attract customers-therefore reputation of the mark and deception must be proved<sup>169</sup>.

It is evident from the above case law analysis, that trade mark protection may offer the strongest type of protection within the fashion industry; however, in this regard the actual design remains unprotected. Despite this, trade mark protection offers an alternative to protection of the outward appearance of the design, where the effect would be the same if the design was protected. That is that the trade mark rights may be used to prevent the continued trading of goods or services trading under the same or similar trade mark.

An important case that illustrates the case of passing off is the case of *Brian Boswell Circus v Boswell- Wilkie Circus*<sup>170</sup>, where the court dealt with the issue of passing off by establishing a two stage test. The test is then whether in all circumstances the resemblance is such that there is a reasonable likelihood that ordinary members of the public may be confused or deceived into believing that the business of the alleged wrongdoer is that of the aggrieved party or is connected therewith<sup>171</sup>.

Therefore, it is submitted that designers are afforded the ability to secure protection for a design under the guise of seeking to protect their trade marks<sup>172</sup>. This route has proven to more than fairly successful as illustrated in the case law discussed above.

The next chapter goes on to the crux of this dissertation, that is, to what extent copying should be permitted within the industry. Further, does the industry stand to benefit from the ability to freely

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<sup>168</sup>MichealRisch,,Cases of interest „available at <http://www.casesofinterest.com/tiki/Louis+Vuitton+Malletier+v.+Dooney+and+Bourke>, accessed on 11 June 2015.

<sup>169</sup> P A Ramsden *A Guide To Intellectual Property Law* Juta Publishers (2012).

<sup>170</sup>*Brian Boswell Circus v Boswell-Wilkie Circus* 1985(4)SA 466 (A).

<sup>171</sup> Ibid.

<sup>172</sup> S Yin and F Braun „The Devil Wears Trademark“(2012) 127, Harvard LR, 3, 995-1016.

draw inspiration from the existing state of art? Arguments are considered from both sides of the industry, those that argue for better protection and those who argue that the industry is in no need of fixing as it has proved to be prosperous as it stands. The arguments for and against copying are considered in the chapter to follow as well as the consequential effects of permitting copying and what sui generis legislation entails.

## 5. FASHION DESIGN AND COPYING

“Fashion should slip out of your hands. The very idea of protecting the seasonal art is childish. One should not bother to protect that which dies the minute it is born”

- Coco Chanel

From the cradle to the grave man learns by copying, but there comes a point where this copying oversteps the mark<sup>173</sup>. Scholars are at a battle in determining whether copying is beneficial or not to the fashion industry. While copying within the fashion industry is regarded as commonplace by many authors<sup>174</sup>, in terms of intellectual property rights, copying has severe implications, which could possibly startle an industry. One should not be surprised with the scholarly debate surrounding the issue as to whether fashion designs should receive intellectual property protection, especially with the recent case law as well as development within the fashion industry<sup>175</sup>. This chapter will analyse the effects of copying within the industry and determine whether copying can be regarded as commonplace within the fashion industry or not.

Intellectual property law exists simply to prevent verbatim copying and ensures that the authors of creative works are afforded the protection they deserve for their hard work in creating. This underlining principle rests on the notion that freedom to copy would ultimately destroy many creative industries<sup>176</sup>. A further principle on which intellectual property rights exists is that if creative works could be easily copied then the creators of such works would not have the incentive to be innovative and create. However, when one considers the fashion industry, these principles prove to be insufficient in certain respects. Copying and imitation is the fuel which drives the industry, creates trends and kills trends, thereby making the wheel of innovation turn. While some scholars stand firm in their view that copying is beneficial to the industry, others hold views to the contrary.

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<sup>173</sup>*Lorimar Productions Inc v Sterling Clothing Manufacturers (Pty) Ltd; Lormar Productions Inc v Dallas Restaurant* 1981 (3) SA 1129 (T).

<sup>174</sup>K Raustiala&C Sprigman „ThePiracy Paradox: Innovation and Intellectual Property in Fashion Design“ (2006) 92 *Virginia LR* 1687..

<sup>175</sup>Katy Steinmetz „The Knockoff Economy: How Copying Hurts- and Helps- Fashion“ *TIME* 10 September 2012, available at <http://style.time.com/2012/09/10/the-knockoff-economy-how-copying-hurts-and-helps-fashion/>, accessed on 1 July 2015.

<sup>176</sup> *Ibid.*

### ***5.1 Arguments in favor of increased Intellectual Property Protection***

Some scholars argue that “there is a need to have protection for fashion designs... with each new season, designers put their imaginations to work and they put their resources at risk...it takes tens of thousands of dollars to start a business. And every season you go out to create... you are talking of thousands and thousands of dollars. Then if you go put on a show, you can spend anywhere from fifty thousand to a million dollars...”<sup>177</sup>

The argument is heightened by the fact that individuals will be reluctant to create if the creative works would be free to take. Proponents of this view tend to assume that it is self-evident that strong patent and copyright laws are essential to creative juices flowing and more protection is better than less<sup>178</sup>. According to them, the justification for the expansion of intellectual property protection rights is simple; more intellectual property yields more intellectual property protection, which in turn, allegedly, produces more creativity<sup>179</sup>.

#### ***5.1.1 Young designers would be deterred***

One of the scholars in favour of the view that intellectual property rights protection is in fact needed within the fashion industry is Jessica Rosen. She puts forth the argument that the severe effects of the lack of such protection will largely be felt by new designers, who will suffer at the hands of well-established fashion houses<sup>180</sup>. Rosen argues that “new designers are not necessarily more vulnerable to design copying; rather, new designers are helpless because they typically lack other intellectual property protections that well established designers have, such as trade marks<sup>181</sup>.” In the absence of intellectual property protection operating to the advantage of new designers, they fall victim to blatant copying by big fashion houses. As a result of no protection new designers are ultimately left without any sort of recourse. New designers are left

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<sup>177</sup> A Bill To Provide Protection For Fashion Design: hearing before the Subcommittee on Courts, the Internet, and Intellectual Property of the Committee on the Judiciary, House of Representatives, One Hundred Ninth Congress, second session, on H.R. 5055, July 27, 2006, Volume 4.

<sup>178</sup> K Raustiala & C Sprigman „The Piracy Paradox: Innovation and Intellectual Property in Fashion Design“ (2006) 92 *Virginia LR* 1687.

<sup>179</sup> Ibid.

<sup>180</sup> Fashion houses are the generic term given to the big fashion players within the industry. For example, Louis Vuitton and Prada.

<sup>181</sup> Rosen J „The Inability of Intellectual Property to Protect the New Fashion Designer: Why the IDP3PA Should Be Adopted“ (2013) 43 *Golden Gate Univ LR* 372.

with “what-ifs” and perhaps, on a positive note, publicity now that their names and garments have received attention, due to the allegations that someone has copied their design<sup>182</sup>.

Rosen is of the view that without protection being afforded to new designers, there could be startling effects on the fashion industry<sup>183</sup>. It will become difficult, if not impossible for new designers to make a name for themselves if they will continuously be copied and it could also terminate a new designer’s business altogether<sup>184</sup>.

### ***5.1.2 Fashion is a work of art***

Another scholar who is a strong proponent of intellectual property protection for the fashion industry is Miller. Miller argues that fashion designs should actually be afforded intellectual property protection. He believes that creating a fashion design is engineered in the same manner as any other piece of art. Designers draw from a pre-existing vocabulary of colour, style, and pattern and some designers are able to piece these rudiments together in a manner that creates original works of art that is unique in nature<sup>185</sup>. Further, arguments that are advanced by scholars who are proponents of no intellectual property rights within the fashion industry are not valid as; firstly, allowing protection would facilitate a greater divide between social classes<sup>186</sup>. However, this argument is based upon stereotypes and many of the designs that are protected are not every day wear. Secondly, if protection is granted to fashion designs, this would go against the principles of copyright<sup>187</sup>. However, the Copyright Act provides protection for creative works only to a certain extent, and despite what some may argue, physical designs still remain a subject of creative works, yet they fall outside the ambit of protection under this avenue. Thirdly, extending protection would lead to an increase in litigation<sup>188</sup>. However, in reality, there is already an increase in fashion designers bringing lawsuits against copyists.

Therefore, we cannot ignore the experiences of a new designer within the industry and the difficulties faced in an attempt to establish a brand. While it is accepted that starting a career in

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<sup>182</sup> Ibid.

<sup>183</sup> Ibid.

<sup>184</sup> Ibid.

<sup>185</sup> M C Miller „Copyright, The Useful Art of Couture: Expanding Intellectual Property Protection for Fashion Designers” (2015) 55 *Wm and Mary LR*.

<sup>186</sup> Ibid.

<sup>187</sup> Ibid.

<sup>188</sup> Ibid.



fashion is an uphill battle, every designer copies in some form or another as creation comes from something seen somewhere at some point in time. However, it is vital to understand that the future of the fashion industry depends on further creative works and innovation, and that cannot be seen if we continue awarding intellectual property rights to the extent that there is nothing left to create from. There is no future for the fashion industry if every design is protected by intellectual property rights simply because there would be no room for one to take a design and build on it in the process of bringing about the next sizzling trend.

### ***5.1.3 Sui generis legislation***

From the aforementioned arguments, if one were to concede that the notion of copying should be protected against then this would call for the sui generis legislation. Sui generis legislation can be defined as a unique set of legislative measures that exist outside our traditional intellectual property principles. There would be a need for a sui generis legislative mechanism because, as stated in the first four chapters of this dissertation, South Africa's current intellectual property regime is said to be inadequate when determining whether creative works such as fashion designs are included under the umbrella of protection offered.

A sui generis approach should cater specifically to the needs of the fashion industry. Protection should extend to the creative process of creating the design; both the functional and aesthetic aspects of the design, regardless if it's a masterpiece or not and to go a step further, the exclusive rights awarded to the author of the creative work should be limited. An example of this type of legislation would be the Innovative Design Protection Act<sup>189</sup>, which is also known as the "Fashion Bill" in the United States of America. This sui generis legislation affords fashion designs copyright protection for a period of three years, provided that the designs (i) are a result of the designers own endeavors and (ii) provide a unique, distinguishable, non-trivial and non-utilitarian variation over prior designs for similar types of articles<sup>190</sup>. Looking at the uniqueness of the fashion industry, it is evident that trends are created very quickly and are brought to their demise. This then means that the exclusive right should only extend over a design for a

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<sup>189</sup>S.3523 - Innovative Design Protection Act of 2012 112th Congress (2011-2012).

<sup>190</sup>Oliver Herzfeld „Protecting Fashion Designs“ Forbes January 3 2013 available at [www.forbes.com/sites/oliverherzfeld/2013/01/03/protecting-fashion-designs/](http://www.forbes.com/sites/oliverherzfeld/2013/01/03/protecting-fashion-designs/) accessed 16 February 2016.

maximum of three years, so that the wheels of fashion are kept turning and the industry is still able to thrive.

## ***5.2 Arguments against copying***

While the above arguments clearly are of a strong view that an increased level of intellectual property legislation is what the fashion industry needs to take it to greater heights, other scholars share a different view. The latter group of scholars advocates that copying is an essential part of the fashion industry and the success of the industry can be largely owed to this aspect.

In July of 1947, Leon Bendel Schmulen, of Henri Bendel department store-fame, told the New York Times that "...copying is a natural consequence of fashion...by the time a design of ours is copied in a cheaper dress line; it's probably time for it to go..."<sup>191</sup>. Schmulen's bold statement that copying is a natural consequence sums up the argument that copying is definitely needed within the industry.

### ***5.2.1 More protection would stifle creativity***

Further, Raustiala and Sprigman argue that the inability of the law to afford designs the needed protection allows copying to occur more freely and legally<sup>192</sup>. Since the law does not intend to afford protection to creative designs, in the event where copying does take place in the form of either borrowing an idea, adapting the design or even using the overall design in a different light, there is in fact no infringement of any law. Rather, fashion does not only survive despite copying, it thrives due to copying<sup>193</sup>. Raustiala and Sprigman further contend that copying and creativity can exist. Raustiala and Sprigman acknowledge that copying is a wrongful act which society should condemn; the reality is that the fashion industry is built on this practice<sup>194</sup>. Innovation comes from something seen somewhere at some point in time. It is accepted that the innovation requires rules that enable the creator to control who makes copies and that creators need a monopoly over the right to make copies, known as the monopoly theory of innovation.

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<sup>191</sup>Katy Steinmetz „The Knockoff Economy: How Copying Hurts- and Helps- Fashion“ *TIME* 10 September 2012, available at <http://style.time.com/2012/09/10/the-knockoff-economy-how-copying-hurts-and-helps-fashion/>, accessed on 1 July 2015.

<sup>192</sup>K Raustiala & C Sprigman „The Piracy Paradox: Innovation and Intellectual Property in Fashion Design“ (2006) 92 *Virginia LR* 1687.

<sup>193</sup> Ibid.

<sup>194</sup> Ibid.

However, in reality the fashion industry operates to the contrary. The physical design as a creative work should not be subject to any rights rather it should be subject to adaptation and copying so that trends may emerge and trends may die as the cycle of fashion continues.

Raustiala and Sprigman further argue that one should consider the bigger picture in the world of fashion. That is, consumers reap the benefits of copying. Copying has some positive effect, despite the negative effect it might have on the overall industry<sup>195</sup>. It is considered good for the consumer in the sense that copying breeds competition. If the industry is open to copies of products, it means that the consumer will have a variety of products that are similar competing in the market place and if they compete on price, options will be afforded to the consumer that they might not otherwise have.

Kari Heyison puts forth an interesting question: should we continue fighting for intellectual property rights even when it has the strong possibility of hindering creativity and innovation<sup>196</sup>? Heyison argues that protecting fashion designs is more likely than not to have an opposite effect on the industry; it will decrease innovation among designers by forcing them to wait an unwarranted and unprecedented amount of time in order to take advantage of a design<sup>197</sup>. This would ultimately hinder the pace at which the fashion industry should move. Therefore, due to the very nature of the fashion industry it is submitted that the industry should stand absent from intellectual property rights protection. Heyison further argues that the protection afforded under the European system is essentially not an effective one, as the system allows for almost identical designs to be registered and is home to two of the biggest knock-off firms, H&M and Zara<sup>198</sup>. Therefore, even though Europe is home to two of the fashion capitals of the world, Paris and Milan, its legal system which affords fashion designs protection, can be said to be purely paper-based and, in reality, not effective at all.

Further, Heyison argues that there is a grave need for knock-off, or fast fashion within the economy. Thousands of stores acquire profits from knocking-off high end designers and this is

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<sup>195</sup> Ibid.

<sup>196</sup> KHeyison „If It’s Not Ripped, Why Sew It: An Analysis of Why Enhanced Intellectual Property Protection for Fashion Designers is in Poor Taste“ (2012) 28 *Touro LR* 255-283.

<sup>197</sup> Ibid.

<sup>198</sup> Ibid.

what propels the industry forward<sup>199</sup>. Fast fashion also has the effect of propelling the industry by encouraging high-end designers to be more innovative in that,<sup>200</sup> fast fashion comes quick and dies fast, thereby forcing designers to create and turn the wheels of fashion. Therefore Heyison concurs with Sprigman and Raustiala, that if copying designs were to become illegal through enhanced intellectual property protection, the fashion cycle would occur very slowly, if at all<sup>201</sup>. Lastly Heyison argues that in order for a trend to become a trend, multiple actors are involved in this process of conveying on a particular theme and this can only happen when there are limited intellectual property rights within the industry. This allows designers to copy each other, enabling multiple actors to contribute to the emergence of a trend. Without the ability of designers to copy, a trend would never occur, because one designer is not able to single handedly be the creator of a trend<sup>202</sup>.

Another salient point in favor of copying within the industry is stressed by Christian Rogerson, who considers South Africa's position within the international fashion platform. Rogerson looks at South Africa's position pre-1994 and submits that the fashion industry from this era was limited in style, mediocre in quality and was dominated by the white majority rule<sup>203</sup>. This was the position due to Apartheid law, where races were treated differently and some races were more restricted than others. Post 1994 has brought about significant change to the industry, especially in the sense that all races were exposed to an international platform of design from different cultures and traditions. While Intellectual Property laws stayed the same, Apartheid laws changed and this allowed all races the opportunity to have an equal opportunity to part take in the fashion industry. Since the end of Apartheid, South Africa's fashion industry has experienced considerable change- a new design and fashion industry has grown, built upon fresh

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<sup>199</sup> Ibid.

<sup>200</sup> Ibid.

<sup>201</sup> K Raustiala & C Sprigman „The Piracy Paradox: Innovation and Intellectual Property in Fashion Design“ (2006) 92 *Virginia LR* 1687.

<sup>202</sup> K Heyison „If It's Not Ripped, Why Sew It: An Analysis of Why Enhanced Intellectual Property Protection for Fashion Designers is in Poor Taste“ (2012) 28 *Touro LR* 255-283.

<sup>203</sup> CM Rogerson „Developing The Fashion Industry in Africa: The Case of Johannesburg“ (2006) 17 *Urban Forum* 215-240.

national confidence<sup>204</sup> so that South Africans can be leaders and no longer followers of international trends<sup>205</sup>.

Since 1994 a number of fashion designers have emerged in South Africa who are focused on designing clothing for specialized markets by developing indigenous South African brands<sup>206</sup>. These brands include Black Coffee, Loxion Kulca, Stoned Cherrie and Sun Goddess<sup>207</sup>.

### ***5.2.2 Direction for the fashion industry***

Therefore, it is clear how the need for copying triumphs over the minor uphill battles faced by fashion designers, where they struggle to make a name within this tough industry. However as mentioned at the beginning of the chapter, a line must be drawn. Copying in the traditional sense is acceptable, until it becomes unlawful. In determining when copying becomes unlawful the court stated in *Lorimar Productions v Sterling Clothing Manufacturers*<sup>208</sup> that a test needs to be applied in assessing when a certain level of copying becomes unlawful<sup>209</sup>. An objective test based on public policy<sup>210</sup>. This is the general sense of justice of the community, the boni mores, manifested through public opinion<sup>211</sup>.

Further, it must be noted that the copying of a three dimensional design cannot truthfully fall within the realms of the fair-use doctrine, as it would not successfully fall within the four instances where unauthorised use of the work is permitted, as a fashion design is neither for research, private study, personal criticism or reporting a current event.<sup>212</sup> Fashion is built on trends and trends come from copying. Of course, copying of a design verbatim will be largely condemned by the players of the industry and that is not what is suggested here. Rather, the point is then that fashion designs should be left unprotected to an extent for the sole purpose of inspiring a future fashion designer to take that design to the next level.

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<sup>204</sup> Ibid.

<sup>205</sup> Ibid.

<sup>206</sup> Ibid.

<sup>207</sup> Ibid.

<sup>208</sup> *Lorimar Productions Inc v Sterling Clothing Manufacturers (Pty) Ltd; Lorimar Productions Inc v Dallas Restaurant* 1981 (3) SA 1129 (T).

<sup>209</sup> Ibid.

<sup>210</sup> Ibid.

<sup>211</sup> Ibid.

<sup>212</sup> The Copyright Act 98 of 1978 ss12(1).

Overall one is to understand that, while both sides put forth strong arguments, intellectual property rights come at a price. Intellectual property rights protect creativity by limiting competition and less competition means higher prices for creative works such as books, music, art, films and so forth<sup>213</sup>. They require enforcement which is expensive<sup>214</sup>. Intellectual property law can be a powerful tool for well-established businesses to ultimately squash newcomers and new technologies, which could if left alone, give rise to entirely new businesses and cultural products<sup>215</sup>. Copying of a design that results in economic benefits should be permitted to an extent within the industry. Designers should be permitted to build upon ideas of others. The pool of the existing state of art should in fact increase rather than decrease year by year. The route that should be taken is one where copying to an extent is advocated for instead of restricting it altogether.

Now that arguments for and against intellectual property rights protection in the fashion industry have been carefully considered, a way forward needs to be proposed in a South African context. The underlining nature of the fashion industry is such that, irrespective of what is created, it is more often than not, borrowed or referenced from another author's work<sup>216</sup>. The nature of the industry is vital in understanding which argument outweighs the other. The fashion industry is grounded on what is trendy at that very given time in a season. However, in order to know what the trend is, there must be a trend in the first place. In order to start a trend there needs to be more than one player with regards to a particular design, namely, the creator and the copier of the design. As the owner of the Prada trade mark once said, they would be concerned if their designs were not being copied<sup>217</sup>. Thus, the knockoff industry plays a large role within the global economy. Not only does the knockoff industry help create a trend, it helps bring a trend to its end and this is exactly what is needed in order to make the wheel of fashion spin, so that consumers are not forced into wearing the same clothing season after season.

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<sup>213</sup>K Raustiala & C Sprigman „The Piracy Paradox: Innovation and Intellectual Property in Fashion Design“ (2006) 92 *Virginia LR* 1687.

<sup>214</sup> Ibid.

<sup>215</sup> Ibid.

<sup>216</sup> Layne Randolph *Fashion Forward or Fashion Victim: Intellectual Property Protection in the Fashion Industry* (unpublished LLM thesis, Turin University, 2009) 67.

<sup>217</sup> Luisa Zargani ‘Patrizio Bertelli’s Counterfeit Controversy’ available at <http://wwd.com/media-news/fashion-memopad/really-5927610/>, accessed on 10 September 2015.

The effects of extending protection over a design is clearly evident in the chapter to follow and this could cripple the industry altogether. Rather, what South Africa needs is a growing and thriving fashion industry. As it stands, South Africa's fashion industry is on a rise and to now stop the wheels of creativity and extend protection over works already created would ultimately mean that works that already exist cannot be freely built on, modified, reproduced or used for inspiration, without the fear of infringement. The argument is best stated by a South African designer:

"I love creating something new from something old, in a way that people have never imagined it"

Ludlum Ngxokolo

Luduma is one of four designers from the continent selected to showcase his designs at the Constellation Africa show at Pitti Uomo in Florence, which is widely regarded as the most important international menswear event.

## 6. INTERNATIONAL PROTECTION OF FASHION DESIGNS

The aim of this chapter is to review the effectiveness of the regulatory mechanisms in place in the European Union which have a direct impact on the intellectual property protections afforded to fashion designs.

### 6.1 The European System

It is imperative that a system which affords protection over the entire design be considered and as well as whether this system has proven to be an adequate method of protecting the creative art and its effect of the industry as a whole. The European system of regulating the fashion industry is deeply rooted in the aim to protect the seasonal art of fashion in its fashion houses. Under the European Union a design is protected through the Community Design System. According to this system, a design refers to the outward appearance of a product or part of it, resulting in line colour, contours, shape, texture, material and or ornamentation<sup>218</sup>.

Business models within the European fashion industry have intellectual property protection at their core. The industry is powered by quick-paced innovation embodied in the creation of seasonal collections of new fashion designs<sup>219</sup>. Europe remains the center of haute couture<sup>220</sup>. Initially, the European Union (EU) initiated a uniform, EU-wide protection for design rights through the adoption of the EU Design Protection Directives<sup>221</sup>. As a result, this required all those that had signed on as Member States to protect designs by registration<sup>222</sup>. Accordingly, the Directives requires that the design be new and has individual character, for protection to be afforded over the design<sup>223</sup>.

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<sup>218</sup>KHeyison „If It’s Not Ripped, Why Sew It: An Analysis of Why Enhanced Intellectual Property Protection for Fashion Designers is in Poor Taste” (2012) 28 *Touro LR* 255-283.

<sup>219</sup>Francesca Montalvo „Protecting Fashion: A Comparative Analysis of Fashion Design Protection in the U.S. and Europe” *Cardozo Arts & Ent. LJ* 19 Sept 2014, available at [www.cardozoelj.com/2014/09/19/protecting-fashion-a-comparative-analysis-of-fashion-design-copyright-protection-in-the-u-s-and-europe/](http://www.cardozoelj.com/2014/09/19/protecting-fashion-a-comparative-analysis-of-fashion-design-copyright-protection-in-the-u-s-and-europe/) + &cd=1&hl=en&ct=clnk&gl=za, accessed 14 July 2015.

<sup>220</sup> Haute couture is defined as the business of making expensive clothes of original design and high quality.

<sup>221</sup>EU Design Protection Directives (98/71/EU).

<sup>222</sup>Ibid.

<sup>223</sup>EU Design Protection Directives (98/71/EU).



As the law developed in the European Union, fashion products and footwear could be afforded protection through national and community design laws and national copyright laws<sup>224</sup>. The Community design system in the European Union requires registered designs to meet the specifications of novelty and individual<sup>225</sup>. However, the element of novelty requires that no other *identical* design is available to the public at the time of registration or when the article is made public<sup>226</sup>. The Community regulation clarifies that if designs features differ only in immaterial details then those designs shall be deemed identical<sup>227</sup>. The Community design also affords protection to unregistered designs. The same requirements are stated for unregistered as well as registered designs, but the registration procedure and application fee is not applicable to unregistered designs<sup>228</sup>.

Designs are protected whether they are registered for not, in the event where a design is not registered, protection is afforded for a time frame of three years. Where the design is in fact registered, the design will be protected up to a period of twenty-five years. For a design to be registered, the design in question is to be novel and possess individual character. Once a design is registered, it gives the creator of the design the exclusive right to prevent others from utilizing the design in any aspect whatsoever.

The rights conferred to a registered design give the owner exclusive rights over the design in question. However, with regard to unregistered designs, the aforementioned rights are only conferred if design under protection was copied<sup>229</sup>. If the alleged infringement design was the result of independent work without knowledge of the protected design, the original design owner cannot prohibit the distribution and use of the second design<sup>230</sup>. However, it must be noted that

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<sup>224</sup>Francesca Montalvo „Protecting Fashion: A Comparative Analysis of Fashion Design Protection in the U.S. and Europe“ *Cardozo Arts & Ent. LJ* 19 Sept 2014, available at [www.cardozoelj.com/2014/09/19/protecting-fashion-a-comparative-analysis-of-fashion-design-copyright-protection-in-the-u-s-and-europe/](http://www.cardozoelj.com/2014/09/19/protecting-fashion-a-comparative-analysis-of-fashion-design-copyright-protection-in-the-u-s-and-europe/) &cd=1&hl=en&ct=clnk&gl=za, accessed 14 July 2015.

<sup>225</sup>LJ Hedrick „Tearing Fashion Design Protection Apart At the Seams“ (2008) 65 *Wash & Lee LR* 215-272.

<sup>226</sup> *Ibid.*

<sup>227</sup>Council Regulation 6/2002.Article.5.2001.O.J.) (L3) 4 (EC).

<sup>228</sup>The Office for Harmonization in the Internal Market (Trade Marks and Designs), „The Community Design, Frequently Asked Questions on the Community Design“, available at <https://oami.europa.eu/ohimportal/en/faqs-community-design>, accessed 20 May 2015.

<sup>229</sup>LJ Hedrick „Tearing Fashion Design Protection Apart At the Seams“ (2008) 65 *Wash & Lee LR* 215-272.

<sup>230</sup> *Ibid.*

the Community design system makes allowance for fair-use exceptions to infringement for personal, educational and experimental purposes<sup>231</sup>.

Further, those who own unregistered designs have to face many difficulties to prove infringement, as owners of such a design have to prove that their design was eligible for protection, where the owner attempts to assert unregistered Community design protection<sup>232</sup>.

However, examining the practice of registering a copyrightable design in Europe indicates that designs which are identical are able to be registered; therefore one can safely conclude that if the threshold for registering almost identical designs is so low then this clearly indicates the ineffectiveness of the system<sup>233</sup>. It seems that anything short of a replica can be considered to be a new design.

Interestingly, Europe being home to two of the world's fashion capitals namely, Milan and Paris, and having a heavily regulated system in place in an attempt to protect the seasonal art, also happens to be home to the two biggest knock-off firms, namely, H&M and Zara. These two firms made a huge success on home soil before expanding to America<sup>234</sup>.

## ***6.2 South Africa v Europe***

Now, considering European law against South African law, there are great differences as well as similarities that exist. Firstly, considering the differences, as mentioned under chapter three, the Designs Act<sup>235</sup> only protects designs that are registered<sup>236</sup>, while unregistered designs do not fall under the scope of protection afforded by the Designs Act<sup>237</sup>. While the European system protects both registered and unregistered designs, as well as affords rights to both a registered and unregistered design (even though enforcing unregistered design rights may be difficult) the avenue does still exist. Secondly, upon meeting the requirements, the Designs Act<sup>238</sup> goes a step

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<sup>231</sup> Design Piracy Bill 111th Congress (2009-2010).

<sup>232</sup> LJ Hedrick „Tearing Fashion Design Protection Apart At the Seams“ (2008) 65 *Wash & Lee LR* 215-272.

<sup>233</sup> KHeyison „If It's Not Ripped, Why Sew It: An Analysis of Why Enhanced Intellectual Property Protection for Fashion Designers is in Poor Taste“ (2012) 28 *Touro LR* 255-283.

<sup>234</sup> Ibid.

<sup>235</sup> Ibid 81.

<sup>236</sup> The Designs Act 195 of 1993 ss2 (1).

<sup>237</sup> Ibid 81.

<sup>238</sup> Ibid 81.

further in that the design must be intended for an industrial process<sup>239</sup>. The European system protects a design regardless of an industrial process. Lastly, there are no rights that are conferred upon an unregistered design, even where such design has been copied.

Furthermore, the European system makes provision for fair use exceptions and while may also be the case under South Africa's Copyright Act<sup>240</sup>, does not apply to three dimensional designs and even if the Copyright Act<sup>241</sup> did protect three dimensional designs, it would remain questionable as to what fair use exception copying of a design would fall under.

### ***6.3 The effectiveness of the European system***

Clearly, from the above-mentioned it is evident that the European system appears to be so heavily regulated that it is almost ineffective, thereby being a disastrous waste of resources, time and money<sup>242</sup>. A system that comprises of a particularly low-standard threshold before protection can in fact be afforded is therefore said to be a facade, fooling many into the idea that these countries, as mentioned above, has all its ducks in a row. Despite the fact that Europe is home to two of the fashion capitals of the world, it is also home to the biggest and most successful knock-off firms. This then begs the question, how successful is the system in place, when the laws behind these fashion capitals seem to be contradictory? It seems as though that these rights are purely paper-based and in reality provide no sense of legal protection over a design.

The European system protects designs through the Community design system. Protection under this system is afforded in two ways. Firstly if the design is registered, the author of the creative work will have exclusive use of the design for a period up to twenty-five years, allowing him to prevent others from the unauthorised use of the design. Secondly, an unregistered design is afforded protection for a period of three years; usually this is the route many emerging designers take. When it comes to infringements of an unregistered design, the onus is on the designer to prove that their work was eligible for protection in the first place.

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<sup>239</sup>The Designs Act 195 of 1993 ss14 (4).

<sup>240</sup>Ibid 27.

<sup>241</sup>Ibid 27.

<sup>242</sup> Ibid.

The greatest difference between the registered design and an unregistered design is the rights conferred to the owner of the design<sup>243</sup>. The author of a registered design is afforded exclusive rights to use the design while the author of the unregistered design is only conferred these exclusive rights if it is shown that their design has been copied<sup>244</sup>. In 2006 the European Union registered 6430 registered designs regarding shoes, clothing and accessories, further, only seven cases regarding community designs went before the Community design courts<sup>245</sup>. The low number of infringement suits in Europe could possibly indicate that fashion designers are content with copying innovative ideas from other designers. Professor Sprigman argues that the fact that there is a widespread copying and minimal litigation in Europe clearly indicates that the design protection system has done nothing to affect the way in which the industry operates<sup>246</sup>. If one were to conclude that the European system of protection is highly effective, this proposition would be negated by the simple fact that Europe is in fact the home ground to two of the largest knock-off companies, namely H&M and Zara.

When considering the requirements under the Community design system, that being the design must not be identical to any other design and it must have individual character in the registration of nearly identical designs, that may differ in colour, colour of accent fabric or the length of the back of a shirt, this indicates that the threshold is extremely low for new, protectable design, therefore protection conferred is meaningless<sup>247</sup>. From this, one could also put forth the argument that an alleged knockoff is not really an infringement of a design, but rather a design that independently qualifies for protection as it fulfills the low-threshold requirements by the Community design system<sup>248</sup>.

#### ***6.4 South Africa's standing***

South Africa's community harks after the celebrity lifestyle...the current generation places more emphasis on pop culture and their primary focus is now to make the effort to know or at least

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<sup>243</sup>LJ Hedrick „Tearing Fashion Design Protection Apart At the Seams“ (2008) 65 *Wash & Lee LR* 215-272.

<sup>244</sup> Ibid.

<sup>245</sup> Ibid.

<sup>246</sup>K Raustiala&C Sprigman „ThePiracy Paradox: Innovation and Intellectual Property in Fashion Design“ (2006) 92 *Virginia LR* 1687.

<sup>247</sup>LJ Hedrick „Tearing Fashion Design Protection Apart At the Seams“ (2008) 65 *Wash & Lee LR* 215-272.

<sup>248</sup> Ibid.

own the latest brands<sup>249</sup>. Therefore, in order to engender a generation, a system is needed that facilitates creativity. If South Africa follows suit with Europe, the impact on South Africa is two-sided. Steps will be taken to have stringent legislation operate over a design. The direct effect of this is then, that the cost of a design will increase the market value. A further result is that certain members of society will not be in a position to afford such designs. This then creates an exclusive brand. On the contrary, this has a positive impact for the designer; he then becomes a well-known designer whose designs are sought after by a South African audience. However, the sad reality is that a small portion, if not nobody, will purchase these designs due to the unreasonable price within a South African economy.

From the above-mentioned, it is evident that South Africa need not follow suit with England and end up with a paper-based, ineffective system. Although the protection of a single physical design may be left unprotected, the industry does not need to extend protection to this aspect of the industry, as there are adequate intellectual property rights that already govern the industry. As mentioned in the previous chapter, copying should be allowed to a certain extent. More intellectual property rights is not what is being advocated for, but rather an industry that allows for a certain degree of copying and where certain aspects of the industry are able to be freely used without the fear of infringement, so that the wheels of fashion may turn and so that South Africa may move forward. Harsher intellectual property rights will only have the effect of lessening the pool of creativity and this is not ideal situation for an emerging economy like South Africa's.

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<sup>249</sup>N Dolby *Constructing Race: Youth, Identity and Popular Culture in South Africa* (2001) 7-16.

## 7. CONCLUSION

### *7.1 Recommendations and final thoughts*

The fashion industry is largely dependent on existing ideas that can be freely incorporated to birth a new design, without the fear of a lawsuit that would follow. The argument then follows, why should steps now be taken to provide a system of intellectual property protection where one size fits all, where intellectual property rights cover every aspect of a design? The fashion industry is uniquely different to other creative industries and acknowledgement of this has to be recognized. South Africa's current legislative mechanism makes the opportunity available for a fashion designer to protect their designs; however the question of the success of protection is not what this dissertation concerns itself with. Rather, the argument is that there is adequate intellectual property protection within the fashion industry and to augment intellectual property rights within the fashion industry will amount to a greater evil than good.

The **first chapter** has laid the foundation to the fashion industry, clearly indicating that this industry has a significant impact on South Africa's gross domestic production. Over the past five years the fashion industry has evolved and has grown to new heights and as a result has made some significant contributions to South Africa's GDP. In 2004 the total contribution made to the GDP, by the textile industry amounted to R85 billion out of a total GDP figure of R1.492 trillion<sup>250</sup>. In 2015 the fashion industry's contribution is forecasted to increase to R122 billion<sup>251</sup>. Looking at the period 2010-2015 the textile industry's growth has grown from 1.5 percent to 4 percent<sup>252</sup>. This is a clear indication of steadfast growth within the fashion industry.

**Chapter two** clearly highlights how the Copyright Act<sup>253</sup> protection only extends to two-dimensional designs. With the Copyright Act<sup>254</sup> the requirements of materiality and originality, are strictly interpreted by the courts. While the Copyright Act<sup>255</sup> does protect a two-dimensional design in a material form, the problem arises when the two-dimensional design is turned into a

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<sup>250</sup>R Hicks „The South African textile and clothing industry-an overview“ available at <http://www.businesspartners.co.za/knowledge-hub/manufacturing-fund/posts/south-african-textile-clothing-industry-overview-3252/>, accessed on 10 March 2015.

<sup>251</sup> Ibid.

<sup>252</sup> Ibid.

<sup>253</sup> Ibid 27.

<sup>254</sup> Ibid 27.

<sup>255</sup> Ibid 27.

three-dimensional design. The Copyright Act<sup>256</sup> does not protect three dimensional designs; the avenue for this type of a design can be found under the Designs Act<sup>257</sup>. While two dimensional designs are afforded protection under the Copyright Act<sup>258</sup>, other designs may find a way around the said protection under the guise of the fair-use principle.

**Chapter three** analyses the Design Act<sup>259</sup>, it sets out the types of designs it affords protection to and the requirements for protection. Importantly, there is no automatic protection afforded over a design unless registered under this Act. An important distinction is made between aesthetic designs and functional designs and as indicated above, fashion designs are in fact functional designs and protection is afforded thereof. The question of protection afforded to a single masterpiece falls outside the scope of the Design Act<sup>260</sup> but could then be located under the Trade Marks Act<sup>261</sup>.

Trade Mark laws is the strongest source of protection for fashion designers and the extent of this argument is encapsulated in **chapter four**. While it is noted that trade mark rights do not afford protection to the outward appearance of the design, it does prove to have the same effect of protecting the outward appearance of a design and this is evident from how trade mark rights operate in the event of infringement. In the event of a successful infringement suit, the trade mark rights operate in manner as to prevent the continued trading under the infringing trade mark, with similar goods or services. The effect is the same where the outward appearance is protected. In an infringement suit prevents the continued sale of the infringing goods or services.

The crux of the argument is then dealt with in **chapter five**, where the scholars argue for and against copying. While some academics recognize and understand that copying and creativity can successfully co-exist, others argue that copying undermines the essence of the fashion industry. Where the argument that copying and creativity cannot be supported, the result is that this then calls for the introduction of sui generis legislation to provide protection to this unique industry. On the converse where the copying and creativity argument is supported, then it

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<sup>256</sup>Ibid 27.

<sup>257</sup>Ibid 81.

<sup>258</sup>Ibid 27.

<sup>259</sup>Ibid 27.

<sup>260</sup>Ibid 81.

<sup>261</sup>Ibid 128.

follows that reality is recognized and it is then accepted that there is no dire need to take such legislative steps. These two arguments have been carefully unpacked in this chapter.

When considering whether South Africa should follow suit with international jurisdictions, the effectiveness of a system is challenged to determine so. It is then realized that a system that extends protection over every aspect of a design is highly ineffective as evidenced by two of the biggest knock off firms that belong to a system governed by the strictest form of intellectual property rights within the fashion industry. The gravity of this problem is considered in **chapter seven**.

The fashion industry as it stands is adequately protected within a South African context. There is no just cause to warrant the extension of stringent intellectual property laws over the fashion industry. South Africa is still an emerging economy and more protection over a design means the pool of ideas to create from will be lessened and this is not an ideal situation for South Africa.

If South Africa has to explore the sui generis route, the effect of this is best said by James Boyle, that our intellectual property policy is going the wrong way; there are two roads which are diverging and we are on the one that doesn't lead to Rome<sup>262</sup>. Our art, our culture and our science depends on the public domain just as much as they depend on intellectual property rights<sup>263</sup>. We can argue that what society is facing at the moment is a „tragedy of the commons“, meaning that unowned or collectively owned resources will be managed poorly; the common pastures will be overgrazed by the village's sheep because no one has an incentive to hold back<sup>264</sup>.

Moreover, allowing creative works to be enclosed, will not just have a severe impact in the South African fashion industry, but also the international fashion industry at large. As previously mentioned in earlier chapters, existing works are needed to create new works. Therefore, implementing sui generis legislation over the fashion industry will be a strenuous, costly, laborious and time-consuming exercise, which the South African legislative sphere does not need. Where this argument is ignored and ineffective legislation is enforced, this would

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<sup>262</sup> Ibid.

<sup>263</sup> Ibid.

<sup>264</sup> Ibid.



ultimately lead to unnecessary matters being disputed in courts, thereby over-flooding the court role.

The argument is then that there to steps should be taken to impose stringent intellectual property rights over the fashion industry as fashion depends on the old to create the new. The industry is already adequately protected, recognizing that the fashion industry is a niche area that was in fact never intended to rest fully within the realms of intellectual property, therefore steps should not be taken to now afford stringent protection over this industry, especially as the industry's stand has proven to be a prosperous one. To ignore this argument will result in severe implications where an attempt to enact stringent legislative protection over this industry will amount to a greater evil than good and this is not the way to proceed.

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