

112TH CONGRESS  
2D SESSION

# S. 3523

To amend title 17, United States Code, to extend protection to fashion design, and for other purposes.

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## IN THE SENATE OF THE UNITED STATES

SEPTEMBER 10, 2012

Mr. SCHUMER (for himself, Mr. HATCH, Mrs. GILLIBRAND, Mr. WHITEHOUSE, Mr. GRAHAM, Mr. BLUMENTHAL, Mr. KOHL, Mr. CARDIN, Ms. SNOWE, and Mrs. BOXER) introduced the following bill; which was read twice and referred to the Committee on the Judiciary

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## A BILL

To amend title 17, United States Code, to extend protection to fashion design, and for other purposes.

1 *Be it enacted by the Senate and House of Representa-*  
2 *tives of the United States of America in Congress assembled,*

3 **SECTION 1. SHORT TITLE.**

4 This Act may be cited as the “Innovative Design Pro-  
5 tection Act of 2012”.

6 **SEC. 2. AMENDMENTS TO TITLE 17, UNITED STATES CODE.**

7 (a) **DESIGNS PROTECTED.**—Section 1301 of title 17,  
8 United States Code, is amended—

1           (1) in subsection (a), by adding at the end the  
2 following:

3           “(4) FASHION DESIGN.—A fashion design is  
4 subject to protection under this chapter.”;

5           (2) in subsection (b)—

6           (A) in paragraph (2), by inserting “, or an  
7 article of apparel,” after “plug or mold”; and

8           (B) by adding at the end the following:

9           “(8) A ‘fashion design’—

10           “(A) is the appearance as a whole of an  
11 article of apparel, including its ornamentation;  
12 and

13           “(B) includes original elements of the arti-  
14 cle of apparel or the original arrangement or  
15 placement of original or non-original elements  
16 as incorporated in the overall appearance of the  
17 article of apparel that—

18           “(i) are the result of a designer’s own  
19 creative endeavor; and

20           “(ii) provide a unique, distinguishable,  
21 non-trivial and non-utilitarian variation  
22 over prior designs for similar types of arti-  
23 cles.

1           “(9) The term ‘design’ includes fashion design,  
2           except to the extent expressly limited to the design  
3           of a vessel.

4           “(10) The term ‘apparel’ means—

5                   “(A) an article of men’s, women’s, or chil-  
6                   dren’s clothing, including undergarments, outer-  
7                   wear, gloves, footwear, and headgear;

8                   “(B) handbags, purses, wallets, tote bags,  
9                   and belts; and

10                   “(C) eyeglass frames.

11           “(11) In the case of a fashion design, the term  
12           ‘substantially identical’ means an article of apparel  
13           which is so similar in appearance as to be likely to  
14           be mistaken for the protected design, and contains  
15           only those differences in construction or design  
16           which are merely trivial.”; and

17           (3) by adding at the end the following:

18           “(c) RULE OF CONSTRUCTION.—In the case of a  
19           fashion design under this chapter, those differences or  
20           variations which are considered non-trivial for the pur-  
21           poses of establishing that a design is subject to protection  
22           under subsection (b)(8) shall be considered non-trivial for  
23           the purposes of establishing that a defendant’s design is  
24           not substantially identical under subsection (b)(11) and  
25           section 1309(e).”.

1 (b) DESIGNS NOT SUBJECT TO PROTECTION.—Sec-  
2 tion 1302(5) of title 17, United States Code, is amend-  
3 ed—

4 (1) by striking “(5)” and inserting “(5)(A) in  
5 the case of a design of a vessel hull,”;

6 (2) by striking the period and inserting “; or”;  
7 and

8 (3) by adding at the end the following:

9 “(B) in the case of a fashion design, em-  
10 bodied in a useful article that was made public  
11 by the designer or owner in the United States  
12 or a foreign country before the date of enact-  
13 ment of this chapter or more than 3 years be-  
14 fore the date upon which protection of the de-  
15 sign is asserted under this chapter.”.

16 (c) REVISIONS, ADAPTATIONS, AND REARRANGE-  
17 MENTS.—Section 1303 of title 17, United States Code, is  
18 amended by adding at the end the following: “The pres-  
19 ence or absence of a particular color or colors or of a pic-  
20 torial or graphic work imprinted on fabric shall not be con-  
21 sidered in determining the protection of a fashion design  
22 under section 1301 or 1302 or in determining infringe-  
23 ment under section 1309.”.

24 (d) TERM OF PROTECTION.—Section 1305(a) of title  
25 17, United States Code, is amended to read as follows:

1       “(a) IN GENERAL.—Subject to subsection (b), the  
2 protection provided under this chapter—

3               “(1) for a design of a vessel hull, shall continue  
4 for a term of 10 years beginning on the date of the  
5 commencement of protection under section 1304;  
6 and

7               “(2) for a fashion design, shall continue for a  
8 term of 3 years beginning on the date of the com-  
9 mencement of protection under section 1304.”.

10       (e) NOTICE.—Section 1306 of title 17, United States  
11 Code, is amended by adding at the end the following:

12       “(d) FASHION DESIGN.—

13               “(1) IN GENERAL.—In the case of a fashion de-  
14 sign, the owner of the design shall provide written  
15 notice of the design protection to any person the de-  
16 sign owner has reason to believe has violated or will  
17 violate this chapter.

18               “(2) CONTENTS.—The written notice required  
19 under paragraph (1) shall contain, at a minimum—

20                       “(A) the date on which protection for the  
21 design commenced;

22                       “(B) a description of the protected design  
23 which specifies how the protected design falls  
24 within the meaning of section 1301(b)(8);

1           “(C) a description of the allegedly infring-  
2           ing design which specifies how the allegedly in-  
3           fringing design infringed upon the protected de-  
4           sign as described under section 1309(e); and

5           “(D) the date on which the protected de-  
6           sign or an image thereof was available such  
7           that it could be reasonably inferred from the to-  
8           tality of the surrounding facts and cir-  
9           cumstances that the owner of the allegedly in-  
10          fringing design saw or otherwise had knowledge  
11          of the protected design.

12          “(3) COMMENCEMENT OF ACTION.—An action  
13          for infringement of a fashion design under this chap-  
14          ter shall not commence until the date that is 21  
15          days after the date on which written notice required  
16          under this subsection was provided to the defendant.

17          “(4) LIMITATION ON DAMAGES.—A person al-  
18          leged to be undertaking action leading to infringe-  
19          ment under this chapter shall be held liable only for  
20          damages and profits accrued after the date on which  
21          the action for infringement is commenced against  
22          such person under paragraph (3).”.

23          (f) INFRINGEMENT.—Section 1309 of title 17, United  
24          States Code, is amended—

25                 (1) in subsection (b)—

1 (A) by amending the matter preceding  
2 paragraph (1) to read as follows:

3 “(b) ACTS OF SELLERS, IMPORTERS AND DISTRIBUTU-  
4 TORS.—A retailer, seller, importer or distributor of an in-  
5 fringing article who did not make the article shall be  
6 deemed to have infringed on a design protected under this  
7 chapter only if that person—”; and

8 (B) in paragraph (1), by striking “, or an  
9 importer to import”;

10 (2) in subsection (c)—

11 (A) by inserting “offer for sale” after  
12 “sell,”; and

13 (B) by inserting “either actual or reason-  
14 ably inferred from the totality of the cir-  
15 cumstances,” after “created without knowl-  
16 edge”;

17 (3) by redesignating subsections (e), (f), and  
18 (g) as subsections (f), (g), and (h), respectively;

19 (4) by inserting after subsection (d) the fol-  
20 lowing:

21 “(e) ACTS OF THIRD PARTIES.—Acts that do not  
22 constitute acts of infringement under subsections (a) or  
23 (b) do not otherwise constitute acts of infringement under  
24 this chapter. It shall not be infringement under this sec-  
25 tion to be engaged in—

1           “(1) the provision of a telecommunications serv-  
2           ice, or of an Internet access service or Internet in-  
3           formation location tool (as those terms are defined  
4           in section 231 the Communications Act of 1934 (47  
5           U.S.C. 231)); or

6           “(2) the transmission, storage, retrieval,  
7           hosting, formatting, or translation (or any combina-  
8           tion thereof) of a communication, without selection  
9           or alteration of the content of the communication,  
10          except that deletion of a particular communication  
11          or material made by another person in a manner  
12          consistent with section 230(c) of the Communica-  
13          tions Act of 1934 (47 U.S.C. 230(c)).”;

14          (5) by amending subsection (f), as so redesign-  
15          nated, to read as follows:

16          “(f) INFRINGING ARTICLE DEFINED.—

17                 “(1) IN GENERAL.—As used in this section, an  
18                 ‘infringing article’ is any article the design of which  
19                 has been copied from a design protected under this  
20                 chapter, or from an image thereof, without the con-  
21                 sent of the owner of the protected design. An in-  
22                 fringing article is not an illustration or picture of a  
23                 protected design in an advertisement, book, peri-  
24                 odical, newspaper, photograph, broadcast, motion  
25                 picture, or similar medium.

1           “(2) VESSEL HULL DESIGN.—In the case of a  
2 design of a vessel hull, a design shall not be deemed  
3 to have been copied from a protected design if it is  
4 original and not substantially similar in appearance  
5 to a protected design.

6           “(3) FASHION DESIGN.—In the case of a fash-  
7 ion design, a design shall not be deemed to have  
8 been copied from a protected design if that design—

9                   “(A) is not substantially identical in overall  
10 visual appearance to and as to the original ele-  
11 ments of a protected design; or

12                   “(B) is the result of independent cre-  
13 ation.”; and

14           (6) by adding at the end the following:

15           “(i) HOME SEWING EXCEPTION.—

16                   “(1) IN GENERAL.—It is not an infringement of  
17 the exclusive rights of a design owner for a person  
18 to produce a single copy of a protected design for  
19 personal use or for the use of an immediate family  
20 member, if that copy is not offered for sale or use  
21 in trade during the period of protection.

22                   “(2) RULE OF CONSTRUCTION.—Nothing in  
23 this subsection shall be construed to permit the pub-  
24 lication or distribution of instructions or patterns for  
25 the copying of a protected design.”.

1 (g) APPLICATION FOR REGISTRATION.—Section  
2 1310(a) of title 17, United States Code, is amended—

3 (1) by striking “Protection under this chapter”  
4 and inserting “In the case of a design of a vessel  
5 hull, protection under this chapter”; and

6 (2) by adding “Registration shall not apply to  
7 fashion designs.” after “first made public.”.

8 (h) REMEDY FOR INFRINGEMENT.—Section 1321 of  
9 title 17, United States Code, is amended—

10 (1) by striking subsection (a) and inserting the  
11 following:

12 “(a) IN GENERAL.—

13 “(1) VESSEL HULL.—In the case of a vessel  
14 hull, the owner of a design is entitled, after issuance  
15 of a certificate of registration of the design under  
16 this chapter, to institute an action for any infringe-  
17 ment of the design.

18 “(2) FASHION DESIGN.—In the case of a fash-  
19 ion design, the owner of a design is entitled to insti-  
20 tute an action for any infringement of the design  
21 after—

22 “(A) the design is made public under the  
23 terms of section 1310(b) of this chapter; and

24 “(B) the 21-day period described in section  
25 1306(d).”; and

1 (2) by adding at the end the following:

2 “(e) PLEADING REQUIREMENT FOR FASHION DE-  
3 SIGNS.—

4 “(1) IN GENERAL.—In the case of a fashion de-  
5 sign, a claimant in an action for infringement shall  
6 plead with particularity facts establishing that—

7 “(A) the design of the claimant is a fash-  
8 ion design within the meaning of section  
9 1301(b)(8) of this title and thus entitled to pro-  
10 tection under this chapter;

11 “(B) the design of the defendant infringes  
12 upon the protected design as described under  
13 section 1309(e); and

14 “(C) the protected design or an image  
15 thereof was available in such location or loca-  
16 tions, in such a manner, and for such duration  
17 that it can be reasonably inferred from the to-  
18 tality of the surrounding facts and cir-  
19 cumstances that the defendant saw or otherwise  
20 had knowledge of the protected design.

21 “(2) CONSIDERATIONS.—In considering wheth-  
22 er a claim for infringement has been adequately  
23 pleaded, the court shall consider the totality of the  
24 circumstances.”.

1 (i) PENALTY FOR FALSE REPRESENTATION.—Sec-  
2 tion 1327 of title 17, United States Code, is amended—

3 (1) by inserting “or for purposes of obtaining  
4 recovery based on a claim of infringement under this  
5 chapter” after “registration of a design under this  
6 chapter”;

7 (2) by striking “\$500” and inserting “5,000”;  
8 and

9 (3) by striking “\$1,000” and inserting  
10 “\$10,000”.

11 (j) NONAPPLICABILITY OF ENFORCEMENT BY  
12 TREASURY AND POSTAL SERVICE.—Section 1328 of title  
13 17, United States Code, is amended—

14 (1) in subsection (a), in the first sentence, by  
15 striking “The Secretary” and inserting “In the case  
16 of designs of vessel hulls protected under this chap-  
17 ter, the Secretary”;

18 (2) in subsection (b), in the first sentence, by  
19 striking “Articles” and inserting “In the case of de-  
20 signs of vessel hulls protected under this chapter, ar-  
21 ticles”; and

22 (3) by adding at the end the following:

23 “(c) NONAPPLICABILITY.—This section shall not  
24 apply to fashion designs protected under this chapter.”.

1 (k) COMMON LAW AND OTHER RIGHTS UNAF-  
2 FECTED.—Section 1330 of title 17, United States Code,  
3 is amended—

4 (1) in paragraph (1), by striking “or” after the  
5 semicolon;

6 (2) in paragraph (2), by striking the period and  
7 inserting “; or”; and

8 (3) by adding at the end the following:

9 “(3) any rights that may exist under provisions  
10 of this title other than this chapter.”.

11 **SEC. 3. EFFECTIVE DATE.**

12 This Act and the amendments made by this Act shall  
13 take effect on the date of enactment of this Act.

○