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## *Fashion Designs*

### **Bridesmaid Dress Lawsuit Expands Patent Use in Fashion**

Jenny Yoo Collection Inc.—embroiled in lawsuits against bridal wear competitors for selling modifiable dresses—is using design patent protection in a way that’s rare for the fashion industry, intellectual property and fashion law practitioners told Bloomberg Law.

Designer Jenny Yoo is suing three other bridal designers and retailers for selling dresses that can be quickly changed by bridesmaids to suit their personal preferences. The cases show that designers are seeking new ways to protect their designs, according to IP lawyers and scholars who spoke with Bloomberg Law.

Two of the suits were refiled Nov. 21 and 22 following the U.S. Supreme Court’s seminal ruling earlier this year that patent lawsuits must be brought in the state where the defendant is incorporated or has a regular place of business.

U.S. patent law offers 15-years of protection for product designs but, historically, design patents have been much less popular than the more common utility patents, which protect inventions. Design patents, though, have gained prominence since Apple Inc.’s high-profile victory against Samsung Electronics Co.’s copying of iPhone design elements. That long-running case is scheduled for a fourth trial in May 2018 after the Supreme Court overturned Apple’s nearly \$400 million design patent infringement award.

In fashion, design patents haven’t been used much except in the case of accessories—notably footwear and undergarments, Susan Scafidi, a fashion law professor at Fordham University, New York, told Bloomberg Law. Design patents are expensive and time-consuming to secure, and the comparative life cycle of different kinds of fashion products has been influential.

“You don’t empty out your shoe closet or your underwear drawer every season because your underwear has gone out of style,” Scafidi said. “So it makes sense to spend the time and money to get patent protection if you qualify, because you’ll be able to amortize the cost of the patent over a number of years.”

**Functionality Is Hurdle for Trade Dress** Jenny Yoo’s lawsuits also include trade dress claims. Trade dress protection is a kind of trademark protection that applies to product design and packaging—like the iconic hour-glass shape of a Coca-Cola bottle. However, trade dress is going to be a tough argument for the designer to

make, Jason D. Rosenberg of Alston & Bird LLP, Atlanta, told Bloomberg Law.

In the first place, “It’s very difficult to have an element of a design that people come to associate so strongly with you that that design element becomes a protectable trade dress,” Rosenberg said. This case is even harder, because the whole point of the design is that its look can be easily changed. And if the look itself is changeable, it’s difficult to show that the product’s appearance is an iconic indicator of the creator.

Another problem with trade dress protection in fashion is that it can’t apply to a functional feature. For most clothing, that is a fatal flaw because clothing features that aren’t ornamental are usually considered functional.

“Fashion designers in the U.S. have a lot of trouble with functionality,” Rosenberg said. It might be “that what Jenny Yoo has done is they’ve created a really cool design, but it just happens to be functional.”

However, that isn’t a problem for design patents, which can protect features that also have functional aspects.

“Design patent law has been relatively tolerant of claims that cover designs mixing ornamentality and functionality, but trade dress law has been more rigorous in policing functional designs,” Christopher J. Bucafusco, an IP law professor at Yeshiva University’s Cardozo Law School, told Bloomberg Law in an e-mail message.

**Shifts After Patent Venue Ruling** In 2016, Jenny Yoo first sued Watters Designs Inc. d/b/a Watters & Watters of Dallas, Essence of Australia Inc. of Lenexa, Kan., and David’s Bridal Inc. of Conshohocken, Pa., in the U.S. District Court for the Southern District of New York, alleging design patent infringement (U.S. Design Patent No. D744,723). In July 2016, Jenny Yoo settled another case against Faviana International Inc.

Jenny Yoo recently refiled the Watters and Essence of Australia cases in Texas and Kansas (*Jenny Yoo Collection, Inc. v. Watters Designs, Inc.*, N.D. Tex., No. 17-3197, *complaint filed* 11/21/17; *Jenny Yoo Collection, Inc. v. Essence of Australia, Inc.*, D. Kan., No. 17-2666, *complaint filed* 11/22/17). That follows the high court’s May ruling on venue in *TC Heartland LLC v. Kraft Foods Group Brands LLC*. The David’s Bridal case continues in the New York court (*Jenny Yoo Collection, Inc. v. David’s Bridal, Inc.*, S.D.N.Y., No. 16-2205, *complaint filed* 4/8/16).

David’s Bridal, Watters Designs, and Essence of Australia didn’t immediately respond to Bloomberg Law requests for comment.

Barton LLP and Moses Palmer & Howell LLP represented the Jenny Yoo Collection. Eckert, Seaman, Cherin & Mellott LLC and Wood Herron & Evans LLP represented Watters. Lathrop & Gage LLP and Kelley Drye & Warren LLP represented David's Bridal. Fox Rothschild LLP represented Essense of Australia.

By ANANDASHANKAR MAZUMDAR

To contact the reporter on this story: Anandashankar Mazumdar in Washington at amazumdar@bloomberglaw.com

To contact the editor responsible for this story: Mike Wilczek at mwilczek@bloomberglaw.com

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