

UNPICKING THE THREADS

The legal ins and outs of embroidered and woven textiles

Textile companies or designers may be surprised to learn that, if you apply a three-dimensional element to your fabric, such as an embroidered or woven element, you could lose the benefit of copyright protection altogether.

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“...The nature of the fashion industry and its products as disclosed in the evidence can also be borne in mind. The evidence indicates that copying and adapting the designs of other designers is the accepted modus operandi of designers, including reputable designers, within the industry; and that it is through this process that fashion products are created.”

Comments made by **JUSTICE KENNY** in the Federal Court case of *Review 2 Pty Ltd v Redberry Enterprise Pty Ltd* (2008)

This quote was taken from a decision by Justice Kenny in a 1998 court case between the Review fashion label and another clothing company called Redberry Enterprise Pty Ltd.

The case relates to an alleged copy of a Review-branded dress. In the world of fashion, the increasing popularity of offshore manufacturing and the ease of reproduction means that the copying of garments and textiles is becoming common practice.

If you have an intricate design embroidered or woven into a textile, surely you must be protected under copyright law, right?

Wrong.

There is a growing trend within the fashion industry for designers to incorporate three-dimensional elements into their designs. Take for example, Australian fashion label Sass & Bide and UK-based designers Mary Katrantzou and Peter Pilotto, who are increasingly adding three-dimensional elements of embroidery and woven elements into their designs. As designs are becoming more and more accessible to anyone in the world and knock-offs are becoming increasingly common, the loss of copyright protection is a live issue in the textile industry.

So, let's workshop this. If your textile design is made up of woven or embroidered elements or the design is impressed on the fabric, there is a risk that you can lose your copyright protection in the fabric design.

Once this happens, your fabric will only be protected if you have registered it as a design.

But there's a catch. Design registration needs to be done right at the outset, before you have released the design to the public. The design needs to be new and distinctive, a requirement under a piece of legislation called the Designs Act 2003 (Cth).

The key message in this article therefore is that designers and textile brands need to be proactive rather than reactive in protecting their designs.

Otherwise, it may be too late. Once copyright in a design is in the marketplace, you cannot register it retrospectively. Let's take a closer look at the issues.

HOW IS COPYRIGHT LOST?

In order to break it down, consider the following two case studies that illustrate when copyright will subsist and when it will be lost in the context of textiles and fabrics.

CASE STUDY 1:

A FLAT TEXTILE PRINT

Imagine that you have hand printed a two-dimensional design onto a textile that you produce. It turns out to be popular and sells well.

In this example, if someone else was to copy the design and use it on their own textiles (or even just reproduce a very similar pattern or design), you may, on the face of it, have a case for copyright infringement. Certain factors will need to be met, including that:

- you own the copyright in that design to start with (this may not be the case, for example if a freelancer drew it and didn't assign copyright to you);
- the copied design is a '*substantial reproduction*' of your design; and
- the other design was in fact copied (in other words, it needs to be shown that there was a link between your original design and the copied one. If they did not have access to your work in the first place they could argue that they independently created the design, which is a defence in its own right. Remember, copyright law is there to prevent copying).



THE PRINTED PATTERNS ON THESE INK AND SPINDLE TEXTILES ARE PROTECTED BY COPYRIGHT LAW.

PHOTO CREDIT: SEAN FENNESSY (WWW.SEANFENNESSY.COM.AU).



THE PATTERN ON THIS 'DESIGUAL' SKIRT IS PROTECTED UNDER COPYRIGHT LAW AS AN ARTISTIC WORK BECAUSE IT IS A FLAT, TWO-DIMENSIONAL PRINT.

PHOTO CREDIT: JOANNE YOUNG.



THE INK SPLATTER DESIGN ON THIS 'POLLI' TOP IS LIKEWISE PROTECTED BY COPYRIGHT.

PHOTO CREDIT: JOANNE YOUNG.

CASE STUDY 2:

EMBELLISHED & TEXTURED TEXTILES

As established in case study 1, with a flat print such as a screen-printed image on a singlet, you may be able to do something about copycats. In that case, copyright law may come to the rescue.

Sometimes however you may introduce woven or embroidered elements into the fabric that end up being inseparable and part of the design itself.

This is where things can get a bit complicated as it can change the way the design is protected under the law.

The reason for this is that if the design is woven into, embroidered into or impressed on the fabric then it can be considered to be a '*corresponding design*' as opposed to a feature of pattern or ornamentation applied to the surface of the fabric. Under Australian Copyright laws, where a corresponding design is '*industrially applied*' (i.e. mass produced, this is generally 50 items or more) in that case, copyright protection in the original artistic work is lost.

This is known as the copyright/design overlap.

The overlap works as follows: you lose copyright protection over a corresponding design if it has been mass-produced, or in legal terms, '*industrially applied*'.

What this means is that your copyright may be vulnerable. If you have not registered your design before using it in the marketplace, copyright protection is also lost and you have nothing really to hang your hat on, other than the laws of misleading or deceptive conduct, which are not always applicable.



THE FABRICS PICTURED ABOVE MAY NOT BE PROTECTED BY COPYRIGHT AS THEY FEATURE THREE-DIMENSIONAL ELEMENTS AND DESIGNS THAT HAVE BEEN EMBROIDERED INTO, WOVEN INTO OR IMPRESSED ON THE FABRIC. DESIGN REGISTRATION MAY THEREFORE NEED TO BE SOUGHT, PARTICULARLY IF THE DESIGNS ARE INTENDED TO BE MASS-PRODUCED.

PHOTO CREDIT: JOANNE YOUNG.

AN EXCEPTION TO THE RULE -

'WORKS OF ARTISTIC CRAFTSMANSHIP?'

As with many legal areas, there is an exception to the rule.

A three-dimensional design may still be protected under copyright law if it can be classed as a '*work of artistic craftsmanship*'.

In very basic terms, a textile may be more likely to be considered as a work of artistic craftsmanship if it possesses an overriding artistic quality. While being handmade is not a requirement, this can be a compelling factor. On the other hand, if a design is clearly intended for mass production or has a dominant utilitarian purpose, it is unlikely to fall within the exception.

In a recent case that was decided in the High Court of Australia, the judge said that:

"...determining whether a work is '*a work of artistic craftsmanship*' does not turn on assessing the beauty or aesthetic appeal of work or on assessing any harmony between its visual appeal and its utility. The determination turns on assessing the extent to which the particular work's artistic expression, in its form, is unconstrained by functional considerations."

A work of artistic craftsmanship could therefore be a one-off tapestry, or a unique hand-made textile which was created by someone who possesses the special skills of a craftsperson and invested pride and merit into the textiles they create. However, proving '*artistic craftsmanship*' can be very difficult and there are no guarantees that a court will accept the argument.

For this reason, in a sense, it comes back to one idea: design registration is important to consider in situations where you create fabrics or textiles, in which the pattern or design is embroidered into, woven into or impressed on the fabric, such that it is inextricably linked to or incorporated into the fabric. It's complex but can make all the difference when it comes to protecting yourself should your valuable design be replicated by another company.

DESIGN REGISTRATION

Design registration is highly recommended to protect fabric and textile designs that are intended to be commercialised, particularly where the design or part thereof is woven into, embroidered into or impressed on the fabric.

It protects the overall appearance of a product. This includes its visual shape, configuration, pattern and ornamentation. Examples of designs that can be registered include jewellery, packaging, homewares, garments, helmets, bags, cars, and of course, fabrics and textiles.

A registered design gives the owner the exclusive right to use that design in the marketplace, and making it known that you have a design registration can deter others from copying.

There are however some conditions that must be met in order for a design to be registrable and enforceable in Australia. Let's examine these in more detail.

IT'S ALL IN THE TIMING

The first fundamental rule is that you can only apply to register a design before it has been released into the public domain, for example before the fabric is commercially sold in the marketplace.

This also means that you must not disclose your design to the public (including posting photographs of the product online or in any promotional material) before you apply to register it. Doing so could invalidate your design registration so this rule must not be taken lightly.

IT MUST BE NEW AND DISTINCTIVE

Secondly, the design must be new and distinctive. This means that your design must not look like any other design that already exists in the global marketplace, including existing textile designs, even if you created them.

HOW DO YOU REGISTER A DESIGN?

Design registration is done by filing an application with a government body known as IP Australia. The application also needs to include representations of how the design looks. They can be in the form of diagrams or photos, but they must show a clear and accurate picture of your design including any colour (if applicable).

It is recommended that you engage a lawyer or a Patent attorney or Trade Mark attorney to register your design, as the design registration process is quite technical and all the formalities need to be complied with.

HOW CAN YOU ENFORCE YOUR AGAINST A COPYCAT?

Once you get a registered design for your fabric or textile, this alone will not give you legally enforceable rights.

To obtain an enforceable right, further examination must be sought and the design must be certified.

Upon request, IP Australia will examine the registered design to determine whether it satisfies the requirements of being 'new and distinctive', among other necessary criteria. If these requirements are met, the design will be certified and legally enforceable during infringement proceedings.

In this sense, registration can be likened to a 'shield' whereas certification can be likened to a 'sword'.

WHAT RIGHTS DO YOU HAVE ONCE YOUR DESIGN IS REGISTERED?

Once your design is registered (which generally takes approximately six months after you lodge your application), you have ownership over your design and gain exclusive rights to:

- use your design;
- apply the design to a product;
- sell, use or import a product that embodies that design; and
- authorise other people to use your design.

Design registration lasts for five years and you can renew your registration for a further five years.

This can be contrasted to copyright which lasts for the life of the author plus 70 years (for artistic works). This used to be 50 years but that law has changed.

TEXTILE FABRIC DESIGNS IN AUSTRALIA

Interestingly, textile designers are catching on. This can be seen on the designs register.

As at 1 July 2014 there were over 1,500 design applications / registrations for textiles and fabrics alone in Australia.

Shown below are some examples:



Designed and owned by Australian designer Ken Done.



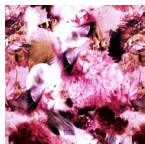
Designed by Jenny Kee and owned by C S Brooks Canada Inc.



Designed by Christel Koch and owned by Zapf Creations AG.



Designed by Ella Leach and owned by Kas Australia Pty Limited.



Designed by Carmen Dugan and Llian Hayter and owned by Australian Fashion Labels Pty Ltd.

FINAL COMMENT

Intellectual property law is complex and if this area of law has you a little baffled, rest assured you are not alone.

The copyright/design overlap is a vexing area that can be challenging not only for textile companies but at times even for their lawyers. If anything, perhaps the best advice is the old adage that to be forewarned is to be forearmed. If a particular fabric or textile design is important to you and you forecast it will be a success in the commercial marketplace, it is important to seek or at least explore the idea of design registration from the outset. There are many businesses that have not done this and have been left to rely on other areas of the law such as misleading or deceptive conduct or passing off to enforce their rights.

CONCLUSION

If your mind is now spinning, you may be asking a fair question: What can I take away from all this?

Effectively, if your design is only going to be printed as a flat, two-dimensional print, then it will most likely be protected under copyright law as an artistic work, so long as certain threshold requirements are met, for example, that the print, pattern or graphic is original, in the sense that it is has not been copied from someone else.

If however the design of a textile is embodied into the fabric for example, by being embroidered or woven into it, so that the design or pattern are inseparable from the fabric itself and mass-produced, design registration will be relevant.

TAKE-AWAY TIPS

- Flat printed two-dimensional patterns on textile or fabric, are generally protected as artistic works under the Copyright Act 1968 (Cth).
- If the designs or graphics have been embodied into the fabric, that is, they have been embroidered into, woven into or impressed on the material the copyright/design overlap rules may apply and copyright may be lost.
- If the design or pattern is stitched on the fabric and not actually part of it, the situation may be less clear. A surface design is generally less likely to be considered as a corresponding design but legal advice should always be sought.
- Designs forming part of textiles or fabrics, including carpets, knits, weaves and tapestries could be embodied in such articles by being woven into, impressed on or worked into the product and could thus amount to corresponding designs which need to be registered to be protected.
- You should consider design registration at the outset if it is your intention to commercialise the product. Do not wait until it is being sold in the marketplace as this will be too late.
- An exception is if you can show that your fabric or textile design can truly be classed as 'a work of artistic craftsmanship' however there are no real black and white rules as to what this means so it is to that extent still risky to rely on.
- If you lose copyright protection and have not registered the design, it may be difficult to stop copycats, however you may still be able to rely on the laws of misleading or deceptive conduct or passing off. This will be the subject of a future article in its own right.

ABOUT THE WRITER



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