

# Editors' Note

Our dear CLB readers,

Following our special bonus edition in June (who said 2020 wasn't a great year?), we are delighted to deliver to you our special fashion industry edition, focusing mostly on intellectual property in the fashion world. Now, let me assure you, in Eli's high-school yearbook, when his classmates were asked who among them was most likely to edit a fashion magazine, Eli received every vote available. Described as a pioneer of probably-doesn't-know-how-to-use-a-mirror chic, Eli was nominated by his peers as a likely fashion critic par excellence, in what can now be vindicated as a most prescient prediction. With fashion knowledge acquired from reading legal judgments, Eli has long been able to differentiate blue from such other colours as red, yellow and even orange.

But, fear not, dear CLB readers. You are in safe, begloved hands, with Eli's co-editor. As Karl Lagerfeld probably did not declare on his death bed: "You cannot spell 'Fashion' without Ash."

**Eli:** So Ash, who are you wearing?

**Ashleigh:** Eli. We spoke about this before the red carpet. It's not cool to ask that question anymore. (Zimmerman, though.)

**Eli:** Let us in on the thinking behind this special edition. Why fashion?

**Ashleigh:** Fashion trends invade all industries and professions in one way or another and law is no exception. Aside from the obvious wigs and gowns, well-tailored suits and the highest of heels, fashion law is fundamentally intellectual property law - it's designs, and trade marks, and copyright - and therefore something that is of central interest to our readers. The fashion industry has long driven innovation and technology. It's artwork, and drawings, and photography. It's marketing and advertisements and sponsorship. And so, some of the most interesting intellectual property decisions have been fashion industry decisions. It's an area that IP lawyers are regularly

dealing in. But also, it's October 2020, and we've been wearing the same trackies every day since March - and isn't the world just crying out for a CLB fashion industry special edition?

**Eli:** Completely. So what are we looking at in this edition?

**Ashleigh:** We have **Jennifer Huby** and **Ben Cameron** from HWL Ebsworth discussing the various ways of protecting original fashion with intellectual property. **Rebecca Smith** from G+T discussing trade mark law in the context of online retail following the Pinnacle Runway v Triangl judgment. Two of our favourite Young Lawyers reflect on our favourite fashion judgments: **Amy Campbell** from HWL Ebsworth looks at the Seafolly judgment and **Joel Parsons** from Bird + Bird looks at Elwood v Cotton On. We also have reports on two recent and highly successful CAMLA Young Lawyers events, being the Virtual Speed Mentoring event, by **Jess Millner** (MinterEllison) and the Non-Publication & Suppression Orders 101 webinar, by **Ellen Anderson** (Addisons).

**Eli:** Wonderful. But what if I wanted more?

**Ash:** Well, you're in luck then, Eli. We also have interviews with three of our favourite fashion lawyers. **Philippa Bergin-Fisher**, the General Counsel of Zimmermann, chats with you Eli; **Marina Mitrevski**, the General Counsel of The Iconic chats with **Bella Street**; and **Justin Cudmore** of the Australian Fashion Chamber and Marque chats with Marque's **Emma Johnsen**. Emma also has a piece in this edition on fashion IP in China following the Michael Jordan decision, which you promised her you wouldn't title "EmJ on MJ". **Anita Cade** and **Lachlan Wright** from Ashurst have a piece on copyright and tattoos; and I've written a piece on infringement and knockoffs in the fashion industry.

**Eli:** I've got to say, Ash. We've really, ahem, fashioned an excellent edition in difficult circumstances.

**Ash:** Oh dear. Thanks to all the contributors. We hope you enjoy!

The Gucci jacket, which appears to be very similar, may have infringed Dapper Dan's copyright by reproducing a substantial part of Dapper Dan's jacket. However, if Dapper Dan had been based in Harlin, Queensland instead of Harlem, New York, it is entirely possible that Gucci would not have infringed Dapper Dan's rights. This is because if he had sold many of the jackets, copyright protection in the Drawings for the jacket may have been lost as further explored below. Even if he had registered the jacket as a 'design', due to the time that had passed, he would have been unable to enforce the design.

## 1. Copyright Can Be Lost

A painter can generally rely on copyright to stop a sculptor making a sculpture of one of the painter's paintings (and indeed vice versa).<sup>3</sup> This is because copyright in a two-dimensional artwork (such as a Drawing on paper for the silhouette of a dress) includes the right to control any three-dimensional reproductions of it, say, as an actual dress.

However, copyright will be lost<sup>4</sup> if a fashion designer's Drawing is mass produced<sup>5</sup> in a garment which embodies the shape and configuration (what is referred to as the 'corresponding design') of the

Drawing. If so, third parties are free to copy the original Drawing from the date the product is first offered for sale or hire anywhere in the world.<sup>6</sup> This is the 'copyright/design overlap'.

### 1.1 What is a corresponding design?

A corresponding design is the visual features of shape or configuration which, when embodied in a product, result in a reproduction of the original artistic work. This only applies to 'shape or configuration' and not 'pattern or ornamentation'. For instance, the *'repeating, parallel grooves in the seat of a plastic chair and on its back which produced a noticeable visual effect constituted*

3. Copyright Act 1968 (Cth) s 21(3).

4. Ibid s 77(2)(a).

5. The legal term is 'industrially applied', and, per Regulation 12(1)(a) of the Copyright Regulations 2017 (Cth), will generally be satisfied where 50 or more products have been produced.

6. Copyright Act 1968 (Cth) s 74(1).