A Pattern of Infringement: The Use of Copyrighted Fabrics in Film

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I. INTRODUCTION

In film, every item in a scene is part of the story.[1] From actors to set designs, careful consideration is given to every detail to help convey the desired message or emotion.[2] Production teams pursue a great level of detail, depth, and

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1. ACAD. OF MOTION PICTURE ARTS & SCI., COSTUME DESIGN: DEFINING CHARACTER INSTRUCTIONAL GUIDE, 6 (2014), *available at* https://www.oscars.org/sites/oscars/files/teachersguide-costumedesign-2015.pdf (on file with *The University of the Pacific Law Review*).

2. *Id.*

realism in film, often requiring the use of copyrighted material to achieve this goal.[3] Obvious background copyrighted materials in film include artwork, posters, and billboards.[4] Less obvious background materials may include the architectural aspect of buildings, the design of furniture, and even the clothing of each character.[5]

Character fashion choices in film promote free expression and allow viewers to understand the character's culture and individuality.[6] Filmmakers pay close attention to fabrics used in film productions to ensure that their use incites the desired emotional effect.[7] A genuine threat of infringement exists for textile designers when filmmakers select garments with their fabric designs for use in films.[8]

Textile designers, like artists, spend countless hours creating masterpieces and are shocked when others steal, use, and profit from their designs without permission.[9] Textile designers use unique combinations of shapes and colors to create copyrightable fabric pattern designs.[10] These textile designers face uncertainty in protecting their creations and often struggle to control the rights and uses of their designs.[11] Filmmakers and television producers may be liable for copyright infringement for using another artist's copyrighted design, without permission, to recreate a derivative version of the original in the background of a

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3. *See generally* John M. Garon, *Managing Content in the Frame: Script Clearance, Background Copyrights and Third-Party Ownership Rights*, GCG LAW 4–5 (Feb. 2010), http://www.gcglaw.com/resources/entertainment/filmcontent.html(on file with *The University of the Pacific Law Review*) (describing how copyrighted works are "being used as background or foreground decoration on a feature film or television show.").

4. *Id.*

5. Adam Freeman, *IP Clearance in Motion Pictures, Videos and Other Audio-Visual Works*, MEDIUM (July 31, 2017), https://medium.com/@adamcolefreedman/ip-clearance-in-motion-pictures-videos-and-other-audio-visual-works-87ab5fc6734b (on file with *The University of the Pacific Law Review*).

6. ACAD. OF MOTION PICTURE ARTS & SCI., *supra* note 1.

7. *Id.* at 6–7.

8. *See generally* Tyler McCall, *Copyright, Trademark, Patent: Your Go-To Primer for Fashion Intellectual Property Law*, FASHIONISTA (Dec. 16, 2016), https://fashionista.com/2016/12/fashion-law-patent-copyright-trademark (on file with *The University of the Pacific Law Review*) (describing the copyrightability of fabric).

9. *See generally* Ona Abelis, *Copyrighting Creativity: What Rights Do Artists Really Have?*, BROOKLYN MAG. (Aug. 27, 2015), http://www.bkmag.com/2015/08/27/copyrighting-creativity-what-rights-do-artists-really-have/ (on file with *The University of the Pacific Law Review*) (quoting artist, Regina Elliot, describing struggles young artists often go through in their inability to obtain proper representation to protect their designs "[I] couldn't afford it and was always dependent on who the scheme-y person I was working with and how creatively they tried to abuse my rights.").

10. Amanda Schallert, *Fashion Lawyers Have Seen Textile Copyright Litigation Increase Over the Past Five Years*, EARLY SULLIVAN (June 10, 2016), https://www.earlysullivan.com/fashion-lawyers-have-seen-textile-copyright-litigation-increase-over-the-past-five-years-los-angeles-and-san-francisco-daily-journal (on file with *The University of the Pacific Law Review*).

11. McCall, *supra* note 8; *see* Abelis, *supra* note 9 (explaining position artists are put in when attempting to gain recognition: "The galleries, museums, and buyers have the power and the resources to call the shots and the artists have to quietly sign on the dotted line.").

film.[12] Generally, media production teams must obtain clearance from the owner before using a copyrighted design.[13]

In recent years, clothing retailers faced increased litigation due to copyright infringement suits by textile designers.[14] Between 2009 and 2015, four textile designers filed thousands of copyright infringement suits against a handful of retailers for their use of copyrighted textile patterns.[15] One example is *Unicolors, Inc. v. Urban Outfitters, Inc.*, where a Los Angeles based fabric manufacturer sued a worldwide retail company operating more than 500 stores.[16]

In *Unicolors*, the retailer, Urban Outfitters, designed and sold a dress made of fabric similar to one owned by Unicolors.[17] Both fabric patterns featured "nearly identical" details of "crowded arrangements of splayed floral and feather motifs."[18] The major difference between the two patterns was the color arrangement—the original Unicolors pattern was red, purple, black, and white, while the Urban Outfitters design was blue and yellow.[19]

Two years prior to Urban Outfitters' release of their dress design, Unicolors registered its copyrighted pattern to protect its creation as an investment against competition.[20] Additionally, in the three years surrounding Urban Outfitters' use of fabric similar to the one owned by Unicolors, Unicolors sold over 14,000 yards of their original fabric to various customers within the United States.[21]

Unicolors sought to prove Urban Outfitters infringed on their design because absent copying, it would be impossible for the designs to be so similar.[22] Ultimately, the court held that due to the overwhelming similarities in the patterns and circumstantial inferences of copying the design, Urban Outfitters was liable for willful infringement of Unicolor's fabric pattern.[23]

Generally, the Copyright Act of 1976 ("Copyright Act") protects only original color arrangements, patterns, and novel combinations of various artistic

12. Abelis, *supra* note 9.

13. Freeman, *supra* note 5.

14. Ian P. Murphy, *The Rise of Copyright Infringement Lawsuits—and What Retailers Can Do About it*, RETAIL DIVE (Aug. 26, 2015), https://www.retaildive.com/news/the-rise-of-copyright-infringement-lawsuitsand-what-retailers-can-do-about/404336/ (on file with *The University of the Pacific Law Review*).

15. *Id.*

16. Unicolors, Inc. v. Urban Outfitters, Inc., 853 F.3d 980, 983–84 (9th Cir. 2017).

17. *Id.* at 984.

18. *Id.* at 985–86.

19. *Id.* at 985.

20. *Id.* at 984.

21. *Id.*

22. *Id.* at 985–86.

23. *Id.* at 987–88.

elements.[24] The Copyright Act also provides that the "fair use" of any copyrighted material is not infringement.[25] The Copyright Act further provides four factors for courts to consider when analyzing whether use is fair.[26] However, courts have applied the factors inconsistently causing mixed results across jurisdictions.[27]

To provide a guide for compliance with copyright law and to protect textile designers, the Copyright Act should be amended to include an additional factor inspired by the Second and Ninth Circuit's fair use analysis of copyrighted materials.[28] By analogizing standards from cases involving fabric patterns and background art used in film, this Comment will set forth a standard for those in the entertainment industry to determine what constitutes infringement regarding fabric patterns used in film.[29]

Part II of this Comment will provide a brief explanation of copyright law and its relation to textile designers.[30] Part III will discuss copyrighting fabric pattern designs.[31] Part IV will describe the Useful Article Doctrine and determine whether integration of fabric designs into useful articles results in a loss of copyright protection.[32] Part V will discuss the Fair Use Doctrine's application to copyrighted fabric through case analysis.[33] Part VI will then discuss and suggest a standard that can be implemented to provide a guide for those in the film industry when using copyrighted materials in productions to potentially avoid infringement litigation.[34]

II. COPYRIGHT LAW

The Copyright Act protects "original works of authorship fixed in any tangible medium of expression."[35] Copyright law provides definitive protection

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24. 17 U.S.C.A. § 102(a) (West, Westlaw through Pub. L. No. 116-29); Oliver Herzfeld, *Protecting Fashion Designs*, FORBES (Jan. 3, 2013, 9:14 AM), https://www.forbes.com/sites/oliverherzfeld/2013/01/03/protecting-fashion-designs/#1b80a04db317 (on file with *The University of the Pacific Law Review*).

25. 17 U.S.C.A. § 107 (West, Westlaw through Pub. L. No. 116-29).

26. *Id.* at § 107(1)–(4).

27. NIMIA, *Copyright Infringement in Videos*, 8, 15, *available at* https://nimia.com/wp-content/uploads/2013/10/Copyright-Infringement-in-Videos.pdf (on file with *The University of the Pacific Law Review*); Laurie Tomassian, *Transforming the Fair Use Landscape by Defining the Transformative Factor*, 90 S. CAL. L. REV. 1329, 1335 (2017).

28. *See infra* Part VI (suggesting additional factor to be included in Copyright Act).

29. *Infra* Part IV.

30. *Infra* Part II.

31. *Infra* Part III; Section III.A.

32. *Infra* Part IV.

33. *Infra* Part V.

34. *Infra* Part IV.

35. 17 U.S.C.A. § 102(a) (West, Westlaw through Pub. L. No. 116-29).

for textile designers for their original prints, patterns, and color arrangements.[36] Intellectual property law, more generally, provides protection for the creation of intangible property.[37] While specific protections are available through patent and trademark law, copyright law provides the best protection because all original works are automatically copyrighted upon creation or fixation in a physical medium.[38]

Copyright protection affords creators exclusive rights to reproduce, publicly display, prepare derivative versions, and distribute copies made of their own copyrighted works.[39] Owning a copyright offers a right to inhibit others from exploiting copyrighted designs.[40] Artists even retain copyright protection after the sale of items integrating their copyrighted designs within them.[41] This provides certainty in copyright protection which allows textile designers to prevent knock-off recreations of their own designs.[42]

Copyright protection is not available, however, for thoughts or ideas.[43] If an individual hears of or is told of an idea that is not fixed in a tangible expression, they are free to use it.[44] Additionally, and as related to fabric designs, one cannot hold a copyright over the idea of a particular pattern or design.[45] This means that no single textile designer can monopolize the ownership of a particular shape or color, but can protect their tangible expression that integrates such shapes or colors into a unique design.[46]

Registration is not required to own a copyright.[47] Protection is afforded whether or not designs are ever published or registered.[48] However, copyright registration is much easier than the formal requirements of patent and trademark protection: individuals register online, complete an application, provide a copy of

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36. Herzfeld, *supra* note 24.

37. McCall, *supra* note 8.

38. Abelis, *supra* note 9.

39. 17 U.S.C.A. § 106A (West, Westlaw through Pub. L. No. 116-29).

40. Anne Kearns, *Copyright in the Fashion Business? It All Depends . . .*, ANNE KEARNS LAW (Feb. 20, 2018), https://www.annekearnslaw.com/single-post/2018/02/13/Copyrights-in-the-Fashion-Business-It-All-Depends (on file with *The University of the Pacific Law Review*).

41. Abelis, *supra* note 9.

42. David E. Shipley, *All for COPYRIGHT Stand Up and Holler! Three Cheers for Star Athletica and the U.S. Supreme Court's Perceived and Imagined Separately Test*, U. GA. SCHOOL OF LAW 152 (Univ. Ga. Sch. of L., Res. Paper No. 2017-25, 2018).

43. Kearns, *supra* note 40.

44. *Id.*

45. Emily F. Evitt, *Copyright Protection of Fabric Designs*, MS&K'S FASHION INDUSTRY BLOG (Nov. 5, 2012), *available at* https://s3.amazonaws.com/documents.lexology.com/281322ca-b4e5-4e14-8d09-358df8ea391b.pdf (on file with *The University of the Pacific Law Review*).

46. *Id.*

47. Kearns, *supra* note 40.

48. *Id.*

the work to be registered, and pay a filing fee.[49]

Artists, or copyright holders, automatically receive protection when they create their designs, but they may face difficulties proving ownership in litigation because filing a federal suit for infringement requires copyright registration.[50] While not technically required to obtain copyright protection, registration is necessary for those intending to enforce copyright ownership as registration provides notice of ownership to others.[51]

The Supreme Court recently decided a case resolving the jurisdictional split as to whether applying for protection alone could satisfy the registration requirement.[52] The Court held that while certain circumstances may allow for filing infringement suits prior to registration, copyright owners must eventually obtain registration over their copyrights to maintain their suits.[53]

With the exponential growth in the number lawsuits pertaining to textile infringement, this development by the Supreme Court affects the use of fabric patterns in film because registration may take months to complete which could stall production or interfere with film schedules.[54] Regardless, the registration requirement must be met prior to filing any infringement suit.[55]

III. IS FABRIC COPYRIGHTABLE?

Determining what features in the fashion industry are copyrightable can be confusing.[56] A necessary distinction exists between "fabric design" and "dress design."[57] "Fabric design" refers to patterns printed on fabric.[58] These designs often include artistic and unique elements, which—like any other artistic creation—maintain copyright protection.[59] "Dress design" refers to the style, cut,

49. Abelis, *supra* note 9.

50. *Id.*

51. *See* Kearns, *supra* note 40 (describing marks used to provide notice of copyright rights as "© [year] by [name of owner]" as well as use of "'Copyright' or 'Copr.' in place of the ©").

52. Fourth Estate Public Benefit Corp. v. Wall-Street.com, L.L.C., 139 S. Ct. 881, 886 (2019).

53. *Id.* at 888.

54. *See* Amanda Schallert, *Fashion Lawyers Have Seen Textile Copyright Litigation Increase Over the Past Five Years*, EARLY SULLIVAN (June 10, 2016), https://www.earlysullivan.com/fashion-lawyers-have-seen-textile-copyright-litigation-increase-over-the-past-five-years-los-angeles-and-san-francisco-daily-journal (on file with *The University of the Pacific Law Review*) (explaining the fact that of the 2,500 copyright infringement cases filed between 2011 and 2015 in the Central District of California, 417 were filed by textile manufacturers); *see generally Fourth Estate*, 139 S. Ct. at 892 (discussing increased wait times for copyright registration process).

55. *See id.* at 888 (2019) (holding "the copyright owner must eventually pursue registration in order to maintain a suit for infringement.").

56. Kearns, *supra* note 40.

57. Carl Mazurek, *Fashion Copyright and the Muddle of the Useful Articles Doctrine*, N.Y.U. J. INTELL. PROP. & ENT. L. BLOG (Oct. 26, 2015), https://blog.jipel.law.nyu.edu/2015/10/fashion-copyright-and-the-muddle-of-the-useful-articles-doctrine/ (on file with *The University of the Pacific Law Review*).

58. *Id.*

59. *Id.*

or shape of clothing.[60] Dress design represents the utility and functional aspect of clothing.[61]

The distinction between dress design and fabric design provides a significant defining line related to the available copyright protections for fashion designers.[62] Recognizing the similarities between uniquely-dyed fabrics and artistic creations on canvas, the Copyright Office provides textile designers protections for their fabric designs.[63] Textile designers take unique shapes and colors which may not be eligible for protection alone and arrange them in ways that create novel combinations of designs.[64]

The artistic features of fabric designs are copyrightable, so long as they are separable from their utility or functionality.[65] Only the separable elements of the fabric prints are copyrightable.[66] For example, envision a piece of fabric as a two-ply square, then separate the top layer from the bottom.[67] This separation leaves two identifiable elements: the unique print on the top layer and the actual, tangible piece of fabric.[68] The fabric, which serves an entirely functional purpose, is not copyrightable, but the artistic and separable element of the fabric pattern is.[69]

The jurisdictional inconsistencies between the Second and Ninth Circuits' analysis of copyright protection over fabric design needs resolution.[70] Courts in the Second Circuit traditionally focus on the "ordinary observer" test to determine whether designs are "substantially similar."[71] Ninth Circuit courts use an extrinsic and intrinsic analysis of the copyrighted designs to determine whether they are "substantially similar."[72]

The Second Circuit decided *Knitwaves, Inc. v. Lollytogs Ltd.* and analyzed the use of copyrighted appliques on various clothing items.[73] There, New York manufacturer, Knitwaves, sued a competing manufacturer, Lollytogs, after noticing comparable designs on sweaters manufactured by each company.[74] A

60. *Id.*

61. *Id.*

62. *Id.*

63. McCall, *supra* note 8.

64. Schallert, *supra* note 54.

65. *Intellectual Property Alert: Will Fashion Designers Finally Be Clothed in "Copyright" Protection?*, VORYS (Sept. 13, 2012), https://www.vorys.com/publications-656.html (on file with *The University of the Pacific Law Review*).

66. McCall, *supra* note 8.

67. *See* Star Athletica, L.L.C. v. Varsity Brands, Inc., 137 S. Ct. 1002, 1004 (2017) (discussing conceptual separation); *see also* Shipley, *supra* note 42 at 157–58 (explaining different separability tests established by courts in copyright infringement cases).

68. McCall, *supra* note 8.

69. *Id.*

70. *See* Evitt, supra note 45 (discussing jurisdictional inconsistencies).

71. *Id.*

72. *Id.*

73. Knitwaves, Inc. v. Lollytogs Ltd. (Inc.), 71 F.3d 996, 999 (2d Cir. 1995).

74. *Id.*

design executive at Lollytogs had brought in a Knitwaves sweater and had instructed his team to create the "same feel" as those from Knitwaves.[75] Lollytogs created its sweater design using no other inspiration aside from the original design of the Knitwaves sweater.[76]

After showing proof of a valid copyright, a plaintiff alleging copyright infringement must prove "(1) the defendant has actually copied the plaintiff's work; *and* (2) the copying is illegal because substantial similarity exists between the defendant's work and the protectable element of the plaintiff's."[77] Knitwaves and Lollytogs agreed the designs were copied, but disagreed as to whether the designs were substantially similar.[78] The court stated the test for determining whether designs are substantially similar is that of the "ordinary observer," where the court analyzes "whether an average lay observer would recognize the alleged copy as having been appropriated from the copyrighted work."[79]

The court, in viewing the totality of the designs, held that "[a]n observer viewing the sweaters side by side cannot help but perceive them as coming from one creative source."[80] Despite the minor changes Lollytogs attempted to create in their new sweater design, such as the number of appliques used and additional pattern designed, "the differences pale[d] in comparison to the overwhelming impression of similarity" to the Knitwaves sweater.[81] Reasoning the designs were substantially similar, the court held Lollytogs liable for copyright infringement of the Knitwaves sweaters.[82]

The Ninth Circuit, in *L.A. Printex Industries, Inc. v. Aeropostale, Inc.*, extended its own "substantially similar" analysis by including extrinsic and intrinsic tests.[83] There, a fabric printing company sued a retailer after noticing clothing bearing similar designs to copyrighted patterns available for sale in their stores.[84] To prove the defendants copied the design, the court required proof of plaintiff's valid copyright, defendant's access to plaintiff's design, and substantial similarity between designs.[85] While failing to make an ultimate

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75. *Id.* at 1000.

76. *Id.*

77. *Id.* at 1002; *see also* Feist Publ'ns, Inc. v. Rural Tel. Serv. Co. Inc., 499 U.S. 340, 361 (1991) (discussing requirements for federal copyright suit as "To establish copyright infringement, a plaintiff must prove two elements: (1) ownership of a valid copyright, and (2) copying of constituent elements of the work that are original.").

78. *Knitwaves*, 71 F.3d at 1002.

79. *Id.* (internal quotation marks omitted).

80. *Id.* at 1004.

81. *Id.* at 1004–05.

82. *Id.* at 1005.

83. L.A. Printex Industries, Inc. v. Aeropostale, Inc., 676 F.3d 841, 848 (9th Cir. 2012).

84. *Id.* at 845.

85. *Id.* at 846 (9th Cir. 2012); *see also* Feist Publ'ns, Inc. v. Rural Tel. Serv. Co. Inc., 499 U.S. 340, 361

determination on the facts, the court clarified its own "substantially similar" analysis.[86]

In determining whether separate designs are "substantially similar" the court explained that it applies a two-part, extrinsic and intrinsic, test:

> The extrinsic test is an objective comparison of specific expressive elements; it focuses on the articulable similarities between the two works. The intrinsic test is a subjective comparison that focuses on whether the ordinary, reasonable audience would find the works substantially similar in the total concept and feel of the works.[87]

In its extrinsic test, the court relied on the *Knitwaves* "ordinary observer test" to compare the similarity of designs.[88] While the court found many objective similarities in color arrangement and overall pattern, it ultimately found genuine disputes regarding material facts of substantial similarity because a jury could find similarities or differences in design and process.[89] Additionally, in its intrinsic analysis, the court looked more subjectively at the ordinary observer to determine if the designs were substantially similar.[90]

Though the court did not decide on either the extrinsic or intrinsic evaluation of the substantially similar analysis, the court held the "subjective evaluation of the expressive similarities in two fabric designs…is best suited for the trier of fact."[91] *L.A. Printex* provides a distinction in the substantially similar analysis where "[t]he extrinsic test considers the objective similarities in two works and leaves the subjective analysis of such similarities to the intrinsic test."[92]

The distinction between dress design and fabric design provides textile designers with copyright protection over the separable portions of fabric patterns like other forms of art.[93] As fabric is copyrightable, if a textile designer sees their design used in film without their permission, they may file a copyright infringement claim.[94] Courts should reconcile the inconsistent application of the "substantially similar" analysis to provide for uniformity on the federal level.[95]

(discussing valid copyright requirement for federal copyright suit).

86. *L.A. Printex*, 676 F.3d at 848–852.
87. *Id.* at 848 (citations and internal quotations omitted).
88. *Id.*
89. *Id.* at 850–51.
90. *Id.* at 852.
91. *Id.*
92. *Id.*
93. McCall, *supra* note 8.
94. Abelis, *supra* note 9.
95. Evitt, *supra* note 45; *see infra* Part VI (proposing additional factor to fair use analysis).

IV. IS COPYRIGHT PROTECTION LOST WHEN FABRIC IS INTEGRATED INTO A USEFUL ARTICLE?

Traditionally, the United States has not recognized fashion as a form of art.[96] Described as "easier stated than applied," the Useful Article Doctrine encapsulates a principle at the core of the Copyright Act by refusing to extend protection to primarily utilitarian or functional designs.[97] The Useful Article Doctrine causes confusion in the fashion industry because designers can copyright portions of designs, but a designer cannot copyright the design itself.[98]

While the Copyright Act clearly does not protect useful articles, the lack of uniformity in the application of the doctrine creates overwhelming uncertainty for design manufacturers regarding available protections for their designs.[99] Part A describes the Useful Article Doctrine's limitation on copyright protection.[100] Part B examines the impact of a recent Supreme Court case, *Star Athletica, LLC. v. Varsity Brands, Inc*., on copyright protection within the fashion industry.[101]

A. The Useful Article Doctrine

The Copyright Act defines a useful article as a tangible work "having intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information."[102] The Copyright Act recognizes the limited copyrightability of design components that are independent and separable from their functional or utilitarian aspects.[103] Dress design—like a garment's shape, style, or cut—is a useful article as its function is inseparable from any identifiable artistic element.[104] The shape, cut, or style of a garment has the purely functional value of being worn.[105] These functional designs are not "independent artistic work[s]" that qualify for copyright protection.[106]

Copyright law does not protect items which are functional or utilitarian.[107] In

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96. Mazurek, *supra* note 57 (explaining the difference between the correlation in European fashion to "traditional fine arts" as opposed to fashion in the United States which "has been treated as more akin to products such as lamps or furniture").

97. *Id.*; Norman J. Leonard, *Applying Copyright Law to Useful Articles – A Dispute Over Cheerleading Uniforms May Result In A New, Unified Test*, WARD & SMITH (Oct. 4, 2016), https://wardandsmith.com/articles/applying-copyright-law-to-useful-articles (on file with *The University of the Pacific Law Review*).

98. Kearns, *supra* note 40.

99. Leonard, *supra* note 97.

100. *Infra* Section IV.A.

101. *Infra* Section IV.B.

102. 17 U.S.C.A. § 101 (West, Westlaw through Pub. L. No. 116-29) (defining "useful article").

103. Leonard, *supra* note 97.

104. Kearns, *supra* note 40.

105. *Id.*

106. *Id.*

107. *Id.*

1954, the Supreme Court upheld this principle in *Mazer v. Stein.*[108] In *Mazer*, an artist created original statuette sculptures of dancers and a manufacturer copied the design and incorporated it into a lamp base without the artist's permission.[109] The Copyright Office allowed for protection over the statuette sculptures as works of art "in so far as their form but not their mechanical or utilitarian aspects are concerned. . . ."[110]

The Court further explained that while integrated into a lamp base, the original sculpture did not lose its copyright protection because there was some artistic value in the statuette itself.[111] The Court used the separation between the statuette and the lamp to create a separation test to determine the copyrightability of an item; however, the Court did not discuss how to apply the test.[112] In recognizing copyright protection for artistic objects, the Court held protection is "given only to the expression of the idea—not the idea itself."[113]

To "codify" *Mazer,* the Copyright Act further explains the application of the Useful Article Doctrine as:

> [T]he design of a useful article, as defined in this section, shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that such design incorporates pictoral, graphic, or scriptural features that can be identified separately from and are capable of existing independently from the article.[114]

The added distinction requires a separation from the useful feature of the design.[115] Jurisdictions have struggled to consistently apply the separability analysis when evaluating copyrightability.[116] Courts previously used a physical separation requirement when analyzing the separability test, but soon realized the physical requirement was insufficient to cover all copyright infringement suits.[117]

Though designers use fabric to make clothing, the integration does not destroy copyright protection because designers can satisfy the separability requirement necessary for copyright protection conceptually, meaning no actual separation of the design needs to occur.[118] The design is protected so long as one

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108. Mazer v. Stein, 347 U.S. 201, 218–19 (1954).

109. *Id.* at 202–03.

110. *Id.* at 212.

111. *See id.* at 214–16 (1954) (discussing copyright protections available for a statuette lamp base).

112. Shipley, *supra* note 42, at 155–57 (discussing adaptation of the separability test).

113. *Mazer*, 347 U.S. at 217.

114. Shipley, *supra* note 42, at 155; *see* 17 U.S.C.A. § 101 (West, Westlaw through Pub. L. No. 116-29) (defining "Pictorial, graphic, and sculptural works" as they relate to useful articles).

115. Leonard, *supra* note 97.

116. Patrick K. McClay, *Has Copyright Protection Expanded for Useful Articles?*, BAKER BOTTS (Nov. 2017), http://www.bakerbotts.com/insights/publications/2017/11/ip-report-p-mcclay (on file with *The University of the Pacific Law Review*).

117. Shipley, *supra* note 42.

118. *Intellectual Property Alert, supra* note 65; Star Athletica, L.L.C. v. Varsity Brands, Inc., 137 S. Ct.

can perceive a separation between the fabric design and the utility of whatever garment it is on.[119] Courts began to use adaptations of the separability test to allow for conceptual separation, but the numerous tests resulted in jurisdictional inconsistencies when applied.[120]

B. Star Athletica, LLC. v. Varsity Brands, Inc.

In 2017, the Supreme Court decided a case that significantly impacted copyright protections for textile designers and manufacturers.[121] The Court granted certiorari to resolve the jurisdictional inconsistencies and "widespread disagreement over the proper test for implementing § 101's separate identification and independent-existence requirements."[122] Addressing significant concerns regarding separability and issues related to functionality and utility of garments, the decision in *Star Athletica* provided textile manufactures more opportunity for protection over "graphical or sculptural" elements of their designs.[123]

In *Star Athletica*, a clothing manufacturer, Varsity Brands, sued a competing manufacturer, Star Athletica, for alleged infringement of a copyrighted cheerleading uniform design.[124] The case centered around the consideration of affording copyright protection for the separable features and industrial designs of "the particular combination of chevrons, zigzags and stripes that characterizes Varsity's uniforms."[125] Ultimately, the Court's decision allowed copyright protection for items that are not necessary to the garment's utility.[126]

To resolve disagreements between courts related to separability and functionality in the fashion industry, the Court expanded copyright protection and determined:

> [T]hat a feature incorporated into the design of a useful article is eligible for copyright protection only if the feature (1) can be perceived as a two-

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1002, 1013–14 (2017).

119. *Intellectual Property Alert*, *supra* note 65; *Star Athletica*, 137 S. Ct. at 1032.

120. Shipley, *supra* note 42 (discussing the nine different tests applied for conceptual separability and explaining "[t]he several tests as well as the varied results caused one judge to write that courts 'have twisted themselves in knots trying to create a test to effectively ascertain whether the artistic aspects of a useful article can be identified separately from and exist independently of the article's utilitarian function.' Another court stated that 'the [conceptual separability] analysis often sounds more like metaphysics than law.'").

121. *Star Athletica*, 137 S. Ct. at 1004–05 (2017); *see* Shipley, *supra* note 42 (describing the impact of *Star Athletica*).

122. *Star Athletica*, 137 S. Ct. at 1007.

123. Mazurek, *supra* note 57.

124. *Star Athletica*, 137 S. Ct. at 1007.

125. *Id.* at 1008 (2017); Ronald Mann, *Opinion Analysis: Court Uses Cheerleader Uniform Case to Validate Broad Copyright in Industrial Designs*, SCOTUSBLOG (Mar. 22, 2017, 9:31 PM), http://www.scotusblog.com/2017/03/opinion-analysis-court-uses-cheerleader-uniform-case-validate-broad-copyright-industrial-designs/ (on file with *The University of the Pacific Law Review*).

126. *Star Athletica*, 137 S. Ct. at 1010–12; Mazurek, *supra* note 57.

> or three-dimensional work of art separate from the useful article and (2) would qualify as a protectable pictorial, graphic, or sculptural work—either on its own or fixed in some other tangible medium of expression—if it were imagined separately from the useful article into which it is incorporated.[127]

The Court created a two-part test for analysis of separability as related to fabric design and useful articles.[128] Applying their test to the striped decoration on cheerleading uniforms, the Court noted that Varsity Brands used and applied their copyrighted stripe design on multiple types of clothing and that in doing so, replicated the design and not the uniform itself.[129]

Additionally, the Court explained that regardless of the stripe design use on several different uniforms, the design maintained its protection as a "work of art."[130] Reiterating the distinction between dress design and fabric design, the Court stated that although Star Athletica gained protection of their design, they "have no right to prohibit a person from manufacturing a cheerleading uniform of identical shape, cut, and dimension…."[131] The Court held that the placement or integration of a separable copyrighted work into the useful article—the stripes sewn onto the cheerleading uniform—did not prevent copyright protection.[132]

Star Athletica reconciled jurisdictional inconsistencies in the application of the separability doctrine.[133] When designers integrate uniquely crafted textile designs into clothing, the fabric patterns retain copyright protection because one can perceive a separation between the fabric design and the tangible fabric.[134] In film, costume designers create clothing for characters using various fabric patterns.[135] *Star Athletica* created a recognition of copyright protection for textile designers when films portray their patterns reproduced on useful articles.[136]

V. IS THE USE OF COPYRIGHTED FABRIC ON CLOTHING IN FILM FAIR USE?

The Copyright Act provides various limitations on the exclusive use of copyrighted materials.[137] The Copyright Act states "the fair use of a copyrighted

127. *Star Athletica*, 137 S. Ct. at 1007.

128. *Id.*

129. *Id.* at 1012.

130. *See id.* (providing an example of protecting artwork on a guitar and explaining "[i]f that entire design in imaginatively removed from the guitar's surface . . . the design if a two-dimensional work of art that corresponds to the shape of the useful article to which it is applied.").

131. *Id.* at 1013.

132. *Id.* at 1012.

133. McClay, *supra* note 116.

134. *See Star Athletica*, 137 S. Ct. at 1007–1010 (discussing the test for separation from a useful article).

135. ACAD. OF MOTION PICTURE ARTS & SCI., *supra* note 1, at 7.

136. *See* Shipley, *supra* note 42 (explaining copyright protections afforded to textile designers after *Star Athletica*).

137. 17 U.S.C.A. § 107 (West, Westlaw through Pub. L. No. 116-29) ("Limitations on exclusive use:

work … is not an infringement of copyright."[138] No infringement occurs when the use is fair.[139] The Copyright Act does not define "fair use," but lays out four factors to determine if the use of copyrighted materials is fair.[140]

Additionally, another defense is available to those using copyrighted works—"de minimis" use.[141] If the use is so small, insignificant, or de minimis, a court may allow use without analyzing any fair use factors.[142] Though related to the substantiality factor, courts do not solely determine de minimis use of copyrighted works in film by the length of time used.[143] Some courts focus on whether one could observe or recognize the copyrighted work in the film.[144]

Filmmakers may claim the use of such textile as incidental and fair resulting in no infringement liability, but any significant use requires permission from the owner.[145] The Copyright Act recognizes distinct ownership rights between a copyright and the copyright integrated into an object; thus, clothing made of copyrighted fabric patterns and used on television without the permission of the owner may result in copyright infringement liability.[146]

Subsection A describes the fair use doctrine and the four factors used to analyze the doctrine.[147] Subsection B discusses cases where courts analyzed the use of background art in film, which is analogous to fabric use in film.[148]

Fair Use"); 17 U.S.C.A. § 108 (West, Westlaw through Pub. L. No. 116-29) ("Limitations on exclusive use: Reproduction by libraries and archives"); 17 U.S.C.A. § 109 (West, Westlaw through Pub. L. No. 116-29) ("Limitations on exclusive use: Effect of transfer of particular copy or phonorecord"); 17 U.S.C. § 110 (West, Westlaw through Pub. L. No. 116-29) ("Limitations on exclusive use: Exemption of certain performances and displays"); 17 U.S.C.A. § 111 (West, Westlaw through Pub. L. No. 116-29) ("Limitations on exclusive use: Secondary transmissions of broadcast programming by cable").

138. *See* 17 U.S.C.A. § 107 (West, Westlaw through Pub. L. No. 116-29) (providing examples for certain instances of fair use: "by reproduction in copies or phonorecords or by any other means specified by that section, for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research.").

139. *Id.*

140. *Id.*

141. *See generally* Rich Stim, *Measuring Fair Use: The Four Factors*, STAN. UNIV. LIBR.: COPYRIGHT & FAIR USE, https://fairuse.stanford.edu/overview/fair-use/four-factors/ (on file with *The University of the Pacific Law Review*) (describing the de minimis exception to using copyrighted work).

142. *Id.*

143. *Id.*

144. *Id.*

145. Andrew Hudson, *Copyright & Artwork in Movies*, PHOTOSECRETS (last updated Feb. 4, 2016), https://www.photosecrets.com/copyright-artwork-movies (on file with *The University of the Pacific Law Review*).

146. *See* 17 U.S.C. § 202 (West, Westlaw through Pub. L. No. 116-29) ("Ownership of a copyright, or of any of the exclusive rights under a copyright, is distinct from ownership of any material object in which the work is embodied.").

147. *Infra* Section V.A.

148. *Infra* Section V.B.

A. The Fair Use Doctrine

The fair use doctrine is the most important defense to avoid liability for copyright infringement.[149] Through an application of four statutory factors, the fair use doctrine allows for use of copyrighted material in limited circumstances.[150] The application of such factors often produces inconsistent results.[151] The factors of the fair use doctrine include:

> (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes; (2) the nature of the copyrighted work; (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and (4) the effect of the use upon the potential market for or value of the copyrighted work.[152]

The first factor, "the purpose and character of the use," analyzes the transformative nature of a new design compared to a previously copyrighted design.[153] Courts use the first factor to determine if a new design is original or merely copied from a previously created design.[154] By taking the time to determine why someone used the copyrighted material, courts can evaluate if that use is actually "fair."[155] Merely copying a previously created design can result in infringement liability, but a transformative or novel use of a portion of a copyrighted design might justify application of the fair use defense.[156] Additionally, uses for research, education, or scholarship may be fair because they face commentary and review.[157]

The second factor analyzes the characteristics and attributes of the copyrighted work.[158] In evaluating the nature of the work, the second factor reinforces the importance of copyright law in the United States because it prioritizes the control copyright owners have over the use of their design.[159] For example, use of facts or publicly-beneficial information is fair, whereas use of

149. 17 U.S.C.A. § 107 (West, Westlaw through Pub. L. No. 116-29); Stim, *supra* note 141; Laurie Tomassian, *Transforming the Fair Use Landscape by Defining the Transformative Factor*, 90 S. CAL. L. REV. 1329, 1335 (2017).

150. 17 U.S.C.A. § 107 (West, Westlaw through Pub. L. No. 116-29); Stim, *supra* note 141.

151. *Id.*

152. 17 U.S.C.A. § 107(1)–(4) (West, Westlaw through Pub. L. No. 116-29).

153. 17 U.S.C.A. § 107(1) (West, Westlaw through Pub. L. No. 116-29); *see also* Stim, *supra* note 141.

154. *Id.*

155. *See* Harper & Row, Publishers, Inc. v. Nations Enterprises, 471 U.S. 539, 540 (1985) (describing differences between commercial and nonprofit use of copyrighted materials).

156. Stim, *supra* note 141.

157. *Id.*

158. 17 U.S.C.A. § 107(2) (West, Westlaw through Pub. L. No. 116-29).

159. *Id.*; Stim, *supra* note 141.

another's fictional work is more difficult to characterize as fair.[160] Using unpublished rather than published materials can result in unfair use because original owners control the initial appearance of their design or creation.[161] Inappropriate use destroys a copyright owner's creative control over their design, which often results in a finding of unfair use.[162]

The third factor focuses on the amount and substantiality of portions used from a copyrighted work.[163] Simply put, "[t]he less you take, the more likely that your copying will be excused as a fair use."[164] Although, if someone copies a substantial or essential portion of a copyrighted work, that use is not "fair."[165] However, substantive use of copyrighted material in a parody is less problematic because the creators of the parody need the essential portions to create their own original work.[166]

The fourth factor focuses on the economic effect the use of the copyrighted material has on the market.[167] If the use deprives a copyright owner of potential profits or future economic opportunities, the use is likely unfair.[168] Regardless of any competition with the original copyright owner, depriving the owner of profits will likely result in litigation.[169] Even the adapted use of copyrighted works as inspiration can result in infringement liability because the creation of a different market results in lost profits to the original owner.[170] Additionally, courts treat lost profits or economic impact from parodies differently than mere appropriation, with some courts even allowing use when the parody completely destroys the market or value for the original.[171]

Although applying each of the four factors seems simple, courts struggle to apply the factors uniformly.[172] Courts seem to apply each factor differently or consider particular factors more significantly than others.[173] Additionally, the fair

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160. *See id.* (discussing the application of the "nature of the copyrighted work" factor).

161. *Id.*

162. *See* Harper & Row, Publishers, Inc. v. Nations Enterprises, 471 U.S. 539, 564 (1985) (holding that publishing the content of a copyrighted manuscript without permission from the owner prior to publication "so clearly infringes the copyright holder's interests in confidentiality and creative control [that it] is difficult to characterize it as 'fair'.").

163. 17 U.S.C.A. § 107(3) (West, Westlaw through Pub. L. No. 116-29).

164. Stim, *supra* note 141.

165. *See Harper & Row*, 471 U.S. at 564–65 (explaining that although only 13% of the entire copyrighted work was copied in the infringing book, the court held the portion taken was "essentially the heart of the book.").

166. Stim, *supra* note 141.

167. 17 U.S.C.A. § 107(4) (West, Westlaw through Pub. L. No. 116-29); Stim, *supra* note 141.

168. *Id.*

169. *Id.*

170. *See generally* Rogers v. Koons, 960 F.2d 301 (2d Cir. 1992) (holding the creation and sale of sculptures inspired by a copyrighted photograph infringed on an opportunity for the photographer to profit from the sculpture market of his own original design).

171. Stim, *supra* note 141.

172. *Id.*

173. NIMIA, *supra* note 27, at 7.

use factors provide a general basis for analyzing the use of copyrighted materials, but courts also consider additional factors in their analysis.[174] Alternate considerations include time used, context, and size of the copyrighted material.[175]

The fair use analysis becomes complicated because "each case must be decided on its own facts and tailored to the issues at hand."[176] Copyright law is meant to discourage unlawful use or copying of another's work, but lawmakers can amend the law to resolve disagreements in the fair use factor analysis.[177]

B. Background Art in Film

Film scene complexities require the use of various background items to provide greater visual detail and realism.[178] Similarly to background art, films use clothing to help portray certain qualities, tendencies, or emotions of characters.[179] Whether in the foreground or background of a scene, filmmakers cannot use copyrighted materials without obtaining the express permission from the copyright owner, unless the use is fair.[180] While the fair use factors provide some guidance in analyzing copyright infringement, applying each factor—especially in cases involving the use of copyrighted items in a film's background—causes confusion and complexity within different jurisdictions.[181]

In *Ringgold v. Black Ent. Television, Inc*., the Second Circuit considered an additional factor in the fair use analysis called "observability."[182] In *Ringgold*, an artist brought a copyright infringement suit against a television station, Black Entertainment Television ("BET"), for their use of a poster version of her copyrighted design on a television show.[183] Faith Ringgold, an artist, created a quilted silk-screened print piece entitled "Church Picnic Story Quilt."[184] The High Museum of Art in Atlanta, Georgia actually owned the quilt and Ringgold granted exclusive rights for reproduction of the poster versions for sale in the museum.[185]

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174. *Id.* at 6.

175. *Id.*

176. *Id.*

177. *See* NIMIA, *supra* note 27, at 17 (describing stock agencies use of copyrighted materials in film).

178. *See generally* Garon, *supra* note 3 (describing how copyrighted works are "being used as background or foreground decoration on a feature film or television show.").

179. ACAD. OF MOTION PICTURE ARTS & SCI., *supra* note 1, at 4–7.

180. Garon, *supra* note 3.

181. NIMIA, *supra* note 27, at 15.

182. Ringgold v. Black Ent. Television, Inc., 126 F.3d 70, 75 (2d Cir. 1997).

183. *Id.* at 72–73.

184. *Id.* at 72.

185. *Id.*

Without Ringgold's permission, BET displayed the poster version of the quilt as part of the set decoration in several television episodes of a show they produced.[186] The parties agreed that the total use in "[t]he nine sequences in which a portion of the poster is visible range in duration from 1.86 to 4.16 seconds. The aggregate duration of all nine sequences is 26.75 seconds."[187] The court drew a distinction within the concept of de minimis use and explained that the parties agreed that the feature time of the poster was 26.75 seconds, but that the parties disagreed as to the "observability" of the copyrighted work.[188]

The court reasoned that copyrighted material are used in the background to increase decorative value but are "filmed at such a distance and so out of focus that a typical program viewer would not discern any decorative effect that the work of art contributes to the set."[189] In those instances of small or insignificant use, use of the copyrighted materials is potentially de minimis and may not infringe on a copyright owner's rights.[190] However, the court held that "the painting component of the poster is recognizable as a painting, and with sufficient observable detail for the 'average lay observer,' to discern African–Americans in Ringgold's colorful, virtually two-dimensional style."[191] The court pointed out the lower court's misapplication of the four fair use factor examination, and held the use was unfair after applying the observability test related to an "average lay observer."[192]

In *Sandoval v. New Line Cinema*, the court reinforced the use of its observability and de minimis analysis in *Ringgold*.[193] Photographer Jorge Antonio Sandoval sued film production company, New Line Cinema, after ten of his photographs appeared in a film.[194] In the scene, ten obscure self-portraits of Sandoval appear affixed to a light box.[195] The film features photos in eleven different shots, none of which appear in focus, for a total of 35.6 seconds.[196]

The court stated that "to establish that the infringement of a copyright is de minimis, and therefore not actionable, the alleged infringer must demonstrate that the copying of the protected material is so trivial 'as to fall below the quantitative threshold of substantial similarity, which is always a required element of

186. *Id.*
187. *Id.* at 73.
188. *Id.* at 76.
189. *Id.* at 77.
190. *Id.* at 74–75.
191. *Id.* at 77.
192. *Id.*
193. Sandoval v. New Line Cinema Corp., 147 F.3d 215, 217 (2d Cir. 1998).
194. *Id.* at 216.
195. *Id.*
196. *Id.*

actionable copying.'"[197] The court noted that it applies this concept on a case-by-case basis, and that no "bright-line" rules exist related to what is potentially "substantially similar."[198] Due to the copyrighted materials' lack of clearly recognizable features, the court reasoned the photographs' use fell below the substantially similar threshold requirement.[199] Reasoning that the "average lay observer" would have difficulty identifying the photographs as Sandoval's, the court held the use was de minimis.[200]

With the complexities of film and the use of clothing to convey particular qualities of characters in film, filmmakers and television producers may be liable for copyright infringement for using another's copyrighted textile design in their productions without permission if a viewer recognized it.[201] Because textile designers create their own unique designs affording them copyright protection, any reproduced use of their designs in film without permission results in copyright infringement unless the use is fair or de minimis.[202]

VI. ESTABLISHING A STANDARD

The Copyright Act protects "…original works of authorship fixed in a tangible medium of expression."[203] Additionally, the Copyright Act protects only those elements of an expression that are independent and separable from their functional or utilitarian features.[204] The Copyright Act also prevents any unauthorized use of copyrighted items unless that use is determined fair.[205] Courts have had mixed results applying the fair use analysis to copyright infringement cases, especially as they relate to materials in film backgrounds.[206] Some courts have even created their own factors to analyze these cases, which resulted in uneven application of the fair use defense in copyright infringement cases.[207]

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197. *Id.* at 217.

198. *Id.*

199. *Id.* at 218.

200. *Id.*

201. ACAD. OF MOTION PICTURE ARTS & SCI., *supra* note 1, at 6; Abelis, *supra* note 9.

202. NIMIA, *supra* note 27, at 15; Garon, *supra* note 3.

203. 17 U.S.C.A. § 102(a) (West, Westlaw through Pub. L. No. 116-29).

204. Leonard, *supra* note 97; *see also* Star Athletica, L.L.C. v. Varsity Brands, Inc., 137 S. Ct. 1002, 1007 (2017) (developing the current separability standard: "[A] feature incorporated into the design of a useful article is eligible for copyright protection only if the feature (1) can be perceived as a two- or three-dimensional work of art separate from the useful article and (2) would qualify as a protectable pictorial, graphic, or sculptural work—either on its own or fixed in some other tangible medium of expression—if it were imagined separately from the useful article into which it is incorporated.").

205. *See* 17 U.S.C.A. § 107(3) (West, Westlaw through Pub. L. No. 116-29) (providing limitations of exclusive use of copyrighted materials or works).

206. NIMIA, *supra* note 27, at 15.

207. *See* Knitwaves, Inc. v. Lollytogs Ltd. (Inc.), 71 F.3d 996, 1002 (2d Cir. 1995) (using the ordinary observer test for analyzing substantial similarity); *see also* L.A. Printex Industries, Inc. v. Aeropostale, Inc., 676 F.3d 841, 848 (9th Cir. 2012) (utilizing the extrinsic and intrinsic tests for determining substantial similarity).

In textile design suits, the Second Circuit uses a standard to analyze copyright infringement that asks whether the designs are substantially similar.[208] When analyzing the similarities, the court considers "whether 'an average lay observer would recognize the alleged copy as having been appropriated from the copyrighted work.'"[209] The Ninth Circuit also analyzes textile design copyright infringement cases using the substantial similarity standard, but the court separates its analysis into an extrinsic and intrinsic test.[210] The extrinsic test focuses on an "objective comparison" of the designs used, while the intrinsic test integrates a more subjective approach to determine whether the designs were substantially similar.[211]

Regarding background materials in film, courts also use the "substantially similar" and "average lay observer" tests to evaluate copyright infringement claims.[212] However, the Second Circuit court expanded the substantially similar analysis by considering whether the copyrighted materials in the background are "clearly visible" or identifiable to an ordinary observer.[213] The court pointed out that the application of their "substantially similar" analysis still requires a case-by-case determination.[214]

To provide better guidance for film production teams for use of textile designer's copyrighted prints in film, Congress should amend the Copyright Act to create a fair use factor specifically related to textile designs and film.[215] The new provision uses Second and Ninth Circuit case law to create an additional factor in in the fair use defense for analyzing textile design infringement suits as well as the use of background art in film.[216]

To reconcile jurisdictional inconsistencies in applying the fair use factor analysis to copyright infringement claims, the Copyright Act should be amended as follows:

> In determining whether the use made of a work in any particular case is a fair use the factors to be considered shall include—
>
> (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;

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208. *Knitwaves*, 71 F.3d at 1002.

209. *Id.*

210. *L.A. Printex*, 676 F.3d at 848.

211. *Id.*

212. Ringgold v. Black Ent. Television, Inc., 126 F.3d 70, 77 (2d Cir. 1997); Sandoval v. New Line Cinema Corp., 147 F.3d 215, 217 (2d Cir. 1998).

213. *Id.* at 218.

214. *Id.* at 217.

215. *See supra* Part VI.

216. *See* Knitwaves, Inc. v. Lollytogs Ltd. (Inc.), 71 F.3d 996, 1002–05 (2d Cir. 1995) (discussing textile design infringement); *see also* L.A. Printex Industries, Inc. v. Aeropostale, Inc., 676 F.3d 841, 845 (9th Cir. 2012) (discussing textile design infringement); *Ringgold,* 126 F.3d at 71–72 (discussing fair use analysis in background art); *Sandoval*, 147 F.3d at 217–18 (discussing fair use analysis in background art).

> (2) the nature of the copyrighted work;
>
> (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole;
>
> (4) the effect of the use upon the potential market for or value of the copyrighted work; and
>
> *(5) as related to the use of pictorial, graphic, and sculptural works in audiovisual works, the observability and recognition of substantially similar use, determined through an objective comparison of each design from the viewpoint of an ordinary observer.*[217]

Two particular states within the Second and Ninth Circuits, California and New York, dominate the fashion and film industries.[218] Consequently, the Second and Ninth Circuits have tailored analyses to address common issues in fashion and film within their jurisdictions.[219] Whether textile designers retain protection over their copyrighted fabric patterns that appear in film, like copyrighted works in stock video backgrounds, has "no direct case precedent."[220]

Creating a fair use factor tailored to audiovisual works would avoid the confusion of a complex fair use analysis by providing clarity in evaluating the use of fabric patterns in film.[221] Additionally, reaffirming protections will provide certainty in ownership and abilities to pursue legal action for textile designers in the event films use their pattern designs without permission.[222]

The inclusion of an additional factor does not, however, resolve the

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217. *See* 17 U.S.C.A. § 107 (West, Westlaw through Pub. L. No. 116-29) (emphasis added to show change made implementing case law analysis from dominating fashion and film industries in the Second and Ninth Circuits); *Knitwaves*, 71 F.3d at 1002; *L.A. Printex*, 676 F.3d at 848; *Sandoval*, 147 F.3d at 217–18.

218. Steve Vondran, *California Fashion Infringement Lawyer – Copyrighted Prints, Florals, Designs, Animal Skins at Issue*, VONDRAN LEGAL (Aug. 18, 2017), http://vondranlegal.com/california-fashion-infringement-lawyer-copyrighted-prints-florals-designs-animal-skins-at-issue (on file with *The University of the Pacific Law Review*); *see generally* Katie Kilkenny, *L.A. Outpacing New York in Film and Digital Media Employment, Study Finds*, THE HOLLYWOOD REPORTER (Sept. 18, 2018, 6:45 AM), https://www.hollywoodreporter.com/news/la-outpacing-new-york-film-digital-media-employment-study-finds-1143546 (on file with *The University of the Pacific Law Review*) (explaining the increase in employment in the entertainment industry in California in comparison to New York); Emily Buder, *California Ranks 1st for Most Film Productions, New York Falls to 6th*, NO FILM SCHOOL (June 16, 2016), https://nofilmschool.com/2016/06/california-ranks-1st-most-film-productions-new-york-6th (on file with *The University of the Pacific Law Review*).

219. See *Knitwaves*, 71 F.3d at 1002 (using the ordinary observer test for analyzing substantial similarity); *see also L.A. Printex.*, 676 F.3d at 841 (utilizing the extrinsic and intrinsic tests for determining substantial similarity).

220. *See generally* NIMIA, *supra* note 27, at 15 (discussing the lack of case precedent regarding copyrighted works used in video backgrounds).

221. *Id.* at 17.

222. *See generally* Abelis, *supra* note 9 (describing the rights of copyright owners when viewing their designs used in film without their permission).

unreliability of application of the fair use defense.[223] The fair use analysis can be impractical because of the open-endedness of its fact-based evaluation.[224] While the application would still require case-by-case analysis, the structure of the analysis would focus on observability, thus integrating considerations from Second and Ninth Circuit case law to narrow a court's focus.[225]

VII. CONCLUSION

Textile designers may pursue infringement action when film production companies select clothing, made from fabric containing their designs, for use in film.[226] With the increase of copyright infringement suits by textile designers, the need for recognized copyright protection in film is apparent.[227] To use, reproduce, or recreate fabric patterns in film, filmmakers must obtain permission from the owner before using the expression unless the use is "fair."[228]

However, various circuit courts have failed to apply the fair use defense uniformly.[229] From the current protections, "the only advice an attorney can give a client regarding copyrighted work in the background of his video is to either (i) get permission and pay licensing fees to the copyright owner, or (ii) avoid using the work altogether."[230] Many in the film industry have decided use of copyrighted materials without permission is not worth the increased risk of litigation given the complexities of applying the de minimis analysis and the uneven, individual application of the fair use defense.[231]

Though complications regarding the use of copyrighted works in film will persist, adding a fifth factor of the fair use defense could resolve inconsistencies in the various circuit court's analysis techniques.[232] Creating an additional fair use factor inspired by analyses in the dominating film and fashion jurisdictions can resolve many misapplication issues by prioritizing the considerations of federal courts when analyzing copyright infringement cases.[233]

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223. Peter Jaszi, *Copyright, Fair Use and Motion Pictures*, UNIVERSITY AM. U. SCH. COMM.S CTR. FOR SOC. MEDIA (2013), *available at* http://archive.cmsimpact.org/sites/default/files/documents/pages/fairuse_motionpictures.pdf/ (on file with *The University of the Pacific Law Review*).

224. *Id.*

225. *Id.*; Knitwaves, Inc. v. Lollytogs Ltd. (Inc.), 71 F.3d 996, 1002 (2d Cir. 1995); L.A. Printex Industries, Inc. v. Aeropostale, Inc., 676 F.3d 841, 845 (9th Cir. 2012); Ringgold v. Black Ent. Television, Inc., 126 F.3d 70, 77 (2d Cir. 1997); Sandoval v. New Line Cinema Corp., 147 F.3d 215, 217 (2d Cir. 1998).

226. *See generally* McCall, *supra* note 8 (describing the ability to copyright fabric).

227. Murphy, *supra* note 14.

228. Freeman, *supra* note 5; *supra* Part VI.

229. *See* NIMIA, *supra* note 27, at 15 (describing stock agencies use of copyrighted materials in film).

230. *Id.* at 18.

231. *See id.* at 15 (describing stock agencies use of copyrighted materials in film).

232. *See* Evitt, *supra* note 45 (discussing inconsistencies between the Second and Ninth Circuits).

233. *Id.*; Vondran, *supra* note 218; Kilkenny, *supra* note 218.