

## Douglas A. Miro Partner



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Douglas A. Miro partners with clients to provide practical legal advice to grow, maximize and protect their businesses. He guides clients in all stages of their intellectual property needs from product development to manufacturing, marketing and enforcement. Leading fashion, retail and manufacturing companies regularly call on Doug for strategic advice on the establishment, maintenance and defense of their intellectual property programs.

Armed with deep technical and legal expertise, Doug litigates patent, trademark, unfair competition and trade secret cases in district and appellate courts throughout the country in a wide variety of fields, including fashion and retail, cosmetics, consumer products, mechanical, electrical, healthcare, ceramics, steel making, refractories, medical devices and Internet-related technologies.

Doug also helps clients create intellectual property assets and strategic IP portfolios that deliver lasting business value. He counsels businesses including hospitals and other health care providers on a broad range of intellectual property issues, including establishing intellectual property programs, licensing and technology transfer matters.

Doug was named one of **Super Lawyers' Top 100 Metro lawyers** in 2015, 2016, 2019, 2020-2021 and 2023 in the intellectual property area and has been listed in the main Super Lawyers' list for the past 14 years.

### PUBLISHED ARTICLES

- **NYSBA Bright Ideas Publishes Article - Appeal of the Second Circuit's ML Genius Holdings LLC v. Google LLC Decision May Resolve a Circuit Split on Copyright Act Preemption Tests**
- **NYSBA Bright Ideas Publishes Article - The Metaverse: From Science Fiction to Commercial Reality—Protecting Intellectual Property in the Virtual Landscape**

[view all »](#)

### ARELAW ALERTS

- **ARE Design Patent Alert: En Banc Decision in LXQ Corp. v. GM Global Tech. Brings The Law of Obviousness for Design Patent in Accord with KSR**
- **ARE Copyright Law Alert: Supreme Court Issues Ruling on Recovery of Damages Beyond the Copyright Act's Three-Year Statute of Limitations**

[view all »](#)

### IN THE PRESS

- **IAM Data & Analytics Reports Amster, Rothstein & Ebenstein partners as being among the IAM Patent 1000**
- **Doug Miro and Charley Macedo to Speak at the New York State Bar Association Program on Emerging Trends in Intellectual Property: What IP Practitioners Need to Know About Non-Fungible Tokens**

[view all »](#)

### CERTIFICATION/SPECIALTIES

- Registered to practice before the U.S. Patent and Trademark Office

### BAR ADMISSIONS

- United States Patent and Trademark Office, 1984
- New York State, 1986
- United States District Courts for the Southern and Eastern Districts of New York, 1988
- United States Court of Appeals for the Federal Circuit, 1990

### EDUCATION

- New York State College of Ceramics at Alfred University, B.S., Ceramic Engineering, 1982
- University of New Hampshire School of Law, Formerly Franklin Pierce Law Center, J.D., 1985

### PROFESSIONAL ASSOCIATIONS & MEMBERSHIPS

- American Bar Association
- American Intellectual Property Law Association
- American Ceramic Society and Executive Committee
- New York State Bar Association
- Intellectual Property Section "Co-Chair of Patent Section"

### AWARDS & HONORS

- New York "Super Lawyers" for IP, 2006, 2009-2021 and 2023
- Recognized as one of the Top 100 Super Lawyers in the New York Metro Area 2015, 2016, 2019-2021 and 2023
- Keramos Honor Society, New York State College Of Ceramics at Alfred University 1981

# Felicity Kohn

Partner



New York, NY



fkohn@pryorcashman.com



212.326.0166



Felicity Kohn is a member of Pryor Cashman’s Litigation, Intellectual Property, and Media + Entertainment Groups, where she handles a wide range of intellectual property, First Amendment, and complex commercial matters for clients in the creative, lifestyle, and entertainment industries.

Felicity’s clients rely on her shrewd and tireless advocacy to safeguard their valuable intellectual property assets. She brings extensive experience litigating copyright, trademark, and unfair competition actions, as well as defamation actions, at both the state and federal levels.

Beyond litigation, Felicity assists her clients by conducting pre-publication reviews of manuscripts, articles, podcasts, and films. She also helps her clients grow and facilitate their businesses by drafting and negotiating strategic commercial agreements, including licensing, agency, branding, and partnership deals.

Representative matters by industry include:

## **Fashion, Apparel + Luxury Goods**

- Successfully enforced numerous luxury clients’ copyright and trade dress rights in iconic items of fashion, including Chloé, Alaïa, AZ Factory, and Jimmy Choo.
- DJ Khaled and Asahd Tuck Khaled in a trademark infringement litigation to enforce their rights in the ASAHD and WE THE BEST trademarks, stepping in as new counsel and promptly securing a favorable settlement for our clients.
- Shawn Carter (p/k/a Jay-Z) in a trademark, trade dress, and right of publicity litigation concerning the use of the HOV mark in connection with a tequila presented in packaging confusingly similar to Jay-Z’s ACE OF SPADES Champagne.
- Secured multiple judgments for a multimillion-dollar apparel company in a number of licensee contract disputes.
- An Italian glass manufacturing company in connection with a trademark and design patent litigation.

## **Beauty Products + Cosmetics**

- Defeated a personal jurisdiction motion made by Nestle S.A., resulting in prompt favorable settlement on behalf of People for the Ethical Treatment of Animals (PETA) certified cruelty-free cosmetics company in trademark infringement suit.
- The world’s largest cosmetics company in managing trademark issues for its numerous subsidiaries.

## Music, Film + Entertainment

- Obtained motion to dismiss on behalf of a major streaming network and film producer in a defamation action based upon a docudrama.
- Successfully defended French, Spanish, and Brazilian film producers against a defamation claim, securing a motion to dismiss for lack of personal jurisdiction.
- Successfully defended a major streaming network against a defamation claim based upon a docudrama, obtaining a Report and Recommendation to dismiss on summary judgment, followed by a favorable settlement.
- Successfully defeated a motion to enjoin the publication of a film by a major streaming network and secured transfer of venue.
- Prevailed on a motion to dismiss the majority of claims against a major streaming network and the producers of a documentary, prompting a speedy and favorable resolution of the remaining claim.
- Represented an author, podcast host, and magazine editor connected with various trademark matters and contract reviews.
- Successfully represented a singer in connection with trademark infringement of her name by another singer/songwriter.
- Obtained pre-discovery summary judgment in a breach of contract action regarding a brokerage fee for the sale of a radio station, including damages and recovery of all attorneys' fees, which was affirmed on appeal.

## Art Collectors, Galleries + Auction Houses

- Secured summary judgment victory on behalf of a gallery owner, art dealer, and collector in a litigation related to provenances and improper acquisition of paintings.
- Provided copyright counseling to a large American auction house in connection with its catalogs.

## Services

- Litigation
- Fashion
- Media + Entertainment
- Copyright
- Trademark

## Education

- New York University School of Law (J.D., *cum laude*, 2012)
  - Notes Editor, Annual Survey of American Law; Robert McKay Scholar
- University of Chicago (M.A., 2008)
- Wesleyan University (B.A., 2002)
  - Phi Beta Kappa

## Recognition

- Named "One to Watch" in Intellectual Property Law (2021-24) and Commercial Litigation (2024) by *Best Lawyers in America*
- Named "Women In The Law: One To Watch" by *Best Lawyers in America* (2021)

## Admissions

- New York
- U.S. District Courts for the Southern and Eastern Districts of New York
- U.S. Court of Appeals for the Eleventh Circuit

## Professional Affiliations

- American Bar Association – Copyright and Related Rights Division, Chair (2023-2024), Vice-Chair (2021-2023); IPL Section Visual Arts and Dramatic Works Committee, Vice-Chair (2020-2021); Copyright Litigation Committee, past Chair (2018-19), past Co-Chair (2017-18); Copyright and Social Media Committee, Fair Use Subcommittee, past Co-Chair (2016-17)

## Publications

March 22, 2024

**Social Media Account Ownership: When a Business Relationship Breaks Down, Who Gets the Accounts?**

*New York Law Journal*

January 10, 2024

**Weigensberg and Kohn Write About Copyright and AI in 2024**

*Law360*

March 17, 2023

**Copyright Office Issues Guidance on Copyrightability of AI-Generated Content**

September 16, 2020

**Harmless Sharing or Copyright Infringement?**

*Published in Women's Wear Daily*

October 20, 2017

**Protecting Branded Apparel IP Assets: Pursuing Counterfeiters and Their Profits**

*Published in IP Watchdog*

## Richard S. Mandaro Partner



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48th Floor  
New York, NY 10174



Richard Mandaro litigates patent, trademark, copyright, trade secret, and unfair competition cases in the leading intellectual property litigation venues, including the Southern District of New York, the Eastern District of Texas, and the Northern and Central Districts of California. In addition to litigation, Rich counsels his clients regarding the development, protection, and commercialization of their intellectual property.

With a background in electrical engineering, Rich has worked on patent cases involving consumer electronics, semiconductors, computer and Internet technologies, camcorders, plasma and LCD televisions, sensors, and telecommunications devices. Rich also litigates trademark and copyright cases, most recently in the Vans, Inc. v. Walmart, Inc. case, Macy's IP Holdings, LLC v. Aroma360, LLC case, and Benefit Cosmetics LLC v. e.l.f. Cosmetics case.

Rich counsels companies in the technology, retail, apparel, cosmetics, toy, and restaurant businesses, among others, on trademark and brand development, protection, enforcement, and anti-counterfeiting. Rich's clients range from large Fortune 500 companies to start-ups. He understands the need to achieve a client's business objectives without litigation whenever possible and has extensive experience resolving matters through negotiation, mediation, alternative dispute resolution, and strategic licensing.

As a litigator, Rich is always aware of the business context and economics of disputes, and clients' expectations for a practical, economic, and strategic approach. With a wealth of experience in both small and large-scale enterprises, Rich is well-positioned to assist clients from diverse business perspectives. When not practicing law, Rich expresses his entrepreneurial passion by running and operating his own successful gourmet hot sauce business.

Rich acts as local counsel in the New York District Courts for out-of-state attorneys who seek insight into local judges and their practices and procedures.

Rich has served on the executive alumni board for his law school and is active in numerous professional associations outside of his law practice.

### PUBLISHED ARTICLES

- **Patent Litigation Alert: Federal Circuit Court Clarifies 'Regular And Established Business' For Venue Purposes in *In re Cray Inc.***
- **Microsoft ruling clarifies guidance on inter partes reviews**  
- *Journal of Intellectual Property Law & Practice* (2015) 10 (12): 891-893. doi: 10.1093/jiplp/jpv177

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### ARELAW ALERTS

- **ARE Trademark Law Alert: In *Booking.com*, the Supreme Court Holds that a "Generic.com" Term can be Eligible for Federal Trademark Protection**
- **Patent Law Alert: Federal Circuit Clarifies "Regular And Established Business" For Venue Purposes in *In re Cray Inc.***

[view all »](#)

### IN THE PRESS

- **Amster, Rothstein & Ebenstein's Richard Mandaro Interviewed by Nate Crespo in "Lawyers in the Making" Podcast**

### BAR ADMISSIONS

- U.S. Supreme Court, 2003
- U.S. Court of Appeals Federal Circuit, 2001
- U.S. District Court Southern District of New York, 2000
- U.S. District Court Northern District of New York, 2000
- U.S. District Court Eastern District of New York, 1996
- New York, 1995

### EDUCATION

- Hofstra University School of Law, Hempstead, New York, 1994, J.D.
- University of Maryland, College Park, Maryland, 1990, B.S., Electrical Engineering

### PROFESSIONAL ASSOCIATIONS & MEMBERSHIPS

- American Bar Association
- IEEE
- Federal Circuit Bar Association
- New York Intellectual Property Law Association

### PROFESSIONAL EXPERIENCE

- Congdon, Flaherty, O'Callaghan et al., Associate, 1994-2000

### AWARDS & HONORS

- Intellectual Property, Super Lawyer, 2013-2024

### REPRESENTATIVE CLIENTS

- Macy's
- Panasonic
- Scotto Brothers/Anthony Scotto
- e.l.f. Cosmetics
- The Madelaine Chocolate Company
- Walmart



# HOW TO PROTECT FASHION THROUGH IP: CONSIDERING AI

JUNE 26, 2024

Douglas A. Miro  
Richard S. Mandaro

**Amster, Rothstein & Ebenstein LLP**

**Amster  
Rothstein &  
Ebenstein** LLP

Nineteen Hundred and Twenty-two  
**NYIPLA** 100 YEARS  
The New York Intellectual Property Law Association  
Fashion Law Committee

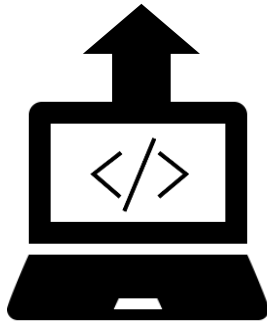


TODAY WE ARE GOING TO  
DISCUSS GENERATIVE AI  
&  
ITS IMPACT ON FASHION





NEW DESIGN



PROMPT



Generative artificial intelligence or “generative AI” is a type of artificial intelligence system capable of *generating text, images, or other media in response to prompts*. Generative AI models learn the patterns and structure of their input training data, and then generate new data that has similar characteristics.





Input:  
Query Data Set  
Or a "Prompt"

Machine Learning Algorithm  
Training Set

Output:  
Matching Label  
Or a Generated  
Result

Training Set

Item	Data 1	Data 2	Data 3	...	Data N	Tag
1	3	9	a		4	Normal
2	33	8	a		4	Normal
3	5	10	c		5	Normal
...						
M	44	15	e		9	Abnormal

# How is AI Being Used in Fashion?

## AI FASHION WEEK

Maison Meta is the proud founder of the only AI Fashion Week.

A global contest that invites everyone to showcase their AI-powered creations, with the winning collections brought to life in the real world!



MORE INFO

<https://maisonmeta.io/about/>



BoF



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TECHNOLOGY

## Can AI Carry On a Designer's Legacy?

Norma Kamali is teaching an AI system to replicate her design style — “downloading my brain,” she calls it — so when the day comes that she steps back from her company, her creative legacy will carry on.

Marc Bain, Business of Fashion, “Can AI Carry on a Designer's Legacy”,  
<https://www.businessoffashion.com/articles/technology/can-ai-carry-on-a-designers-legacy/> (January 30, 2024)

# How is AI Being Used in Fashion?



- **Design**: AI Design Copilot app to assist designers.
- **Development**: Tailoring AI models specifically for individual brands using their proprietary datasets.
- **Research**: Uncover new ways generative AI can be used to boost profitability and creativity within the fashion industry.
- **Brand Protection**: AI to monitor and enforce copyright and trademark regulations effectively across digital platforms.

1. CAN AI-GENERATED  
DESIGNS BE PROTECTED  
WITH IP LAW?

&

2. WHAT ARE THE RISKS  
OF USING AI-GENERATED  
DESIGNS?





1. CAN AI-GENERATED DESIGNS BE  
PROTECTED WITH IP LAW?





A COMPUTER IS NOT  
AN INVENTOR  
(PATENT) OR AUTHOR  
(COPYRIGHT) UNDER  
U.S. LAW TODAY



That means neither the USPTO nor the Copyright Office will accept applications naming a computer as an inventor or author (N/A to TMs)

USPTO



COPYRIGHT OFFICE



BUT . . . .





Inventorship Guidance for AI-Assisted Inventions, Docket No. PTO-P-2023-0043, 89 FR 10043

(Feb. 13, 2024)

Must have “**significantly contributed**”



“While AI systems and other non-natural persons cannot be listed as inventors on patent applications or patents, the use of an AI system by a natural person(s) does not preclude a natural person(s) from qualifying as an inventor (or joint inventors) if the natural person(s) **significantly contributed** to the claimed invention, as explained in section IV of this notice.”

"[T]he Office will not register works produced by a machine or mere mechanical process that operates randomly or automatically without any *creative input or intervention* from a *human author*."

"The crucial question is “whether the ‘work’ is basically one of human authorship, with the computer [or other device] merely being an assisting instrument, or whether the traditional elements of authorship in the work (literary, artistic, or musical expression or elements of selection, arrangement, etc.) were actually conceived and executed not by man but by a machine.”

## Compendium of the U.S. Copyright Office Practices, Ch. 313.2

Must have “*creative input* or  
*human intervention*”



<https://www.copyright.gov/comp3/chap300/ch300-copyrightable-authorship.pdf>



EXAMPLES OF  
WHERE COPYRIGHT  
LAW HAS DRAWN  
THE LINE





Copyright Review Board Decision On “A  
“A Recent Entrance To Paradise”  
(Feb. 14, 2022)

**Rejected: No human contribution.**

“Thaler must either provide evidence that the Work is the product of human authorship or convince the Office to depart from a century copyright jurisprudence. He has done neither.”

## Copyright Review Board Decision On “Théâtre D’opéra Spatial” (Sept. 5, 2023)

**Rejected: Must disclaim content  
generated by AI.**

“[T]he process of prompting can involve creativity—after all, ‘some prompts may be sufficiently creative to be protected by copyright’ as literary works.”

“To the extent Mr. Allen argues by analogy that his visual edits are ‘transformative,’ and thus, copyrightable, the Board agrees that **human-authored modifications of AI-generated material may protected by copyright.**” (**subject to disclaimer**)

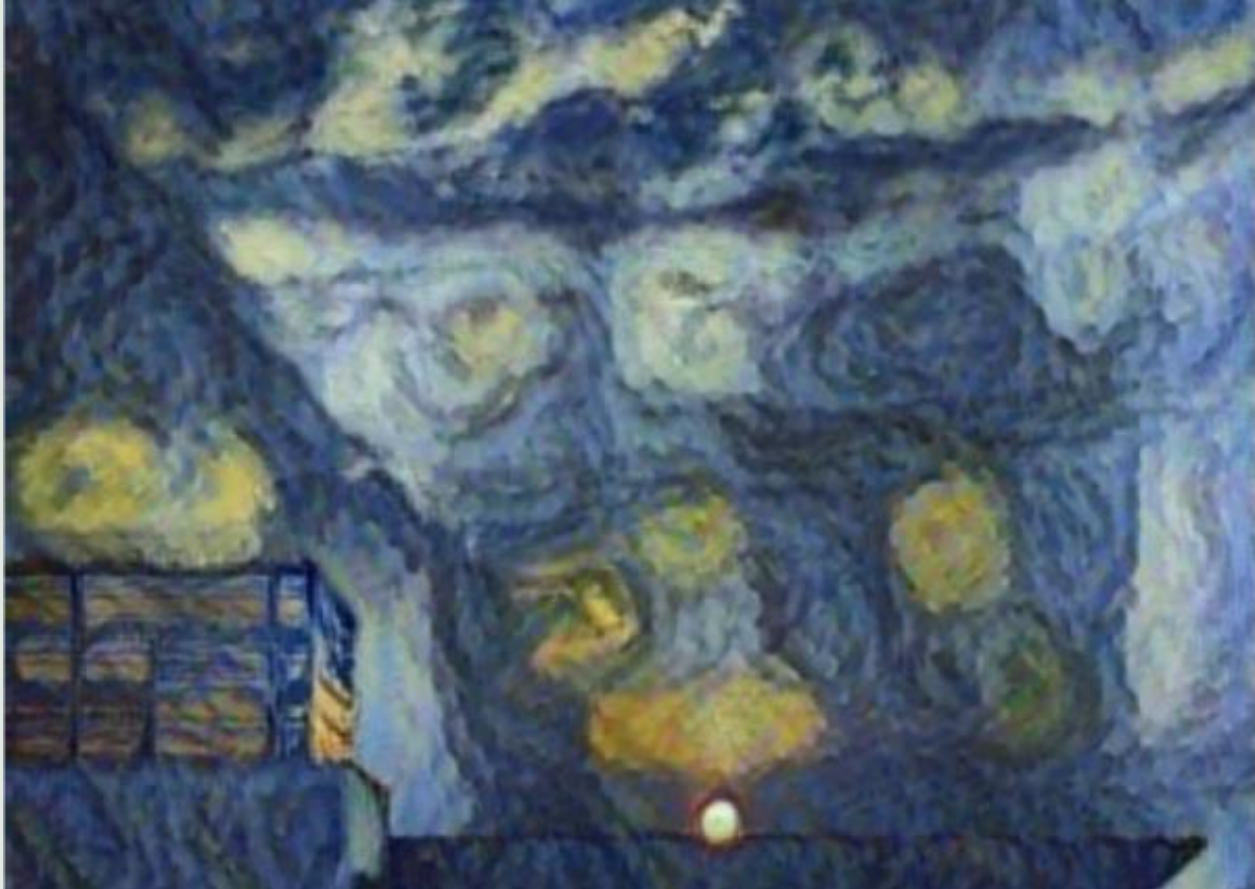


## Copyright Review Board Decision On “Suryast” (Dec. 11, 2023)

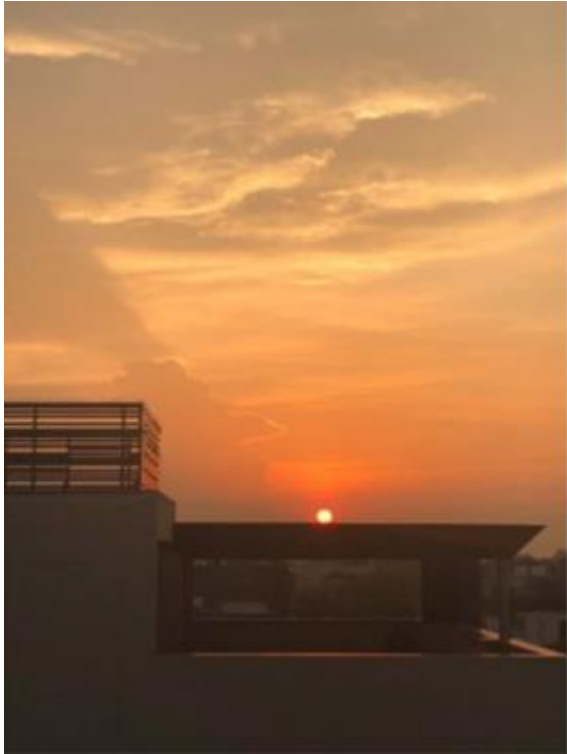
**Rejected: lacked requisite human authorship**

“The Board is not convinced by Mr. Sahni’s description of RAGHAV as ‘an assistive tool’ that works similarly to ‘a camera, digital tablet, or a photo-editing software program.’”

“Here, RAGHAV’s interpretation of Mr. Sahni’s photograph in the style of another painting is a function of how the model works and the images on which it was trained on—not specific contributions or instructions received from Mr. Sahni.”



# SURYAST



+



=



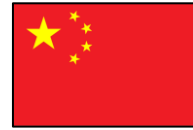
# Global Perspectives – Can a person claim authorship for an AI-Generated work?



UK: **Yes.** For “computer-generated” works, “the author shall be taken to be the person by whom the arrangements necessary for the creation of the work are undertaken.” Copyright Designs and Patent Act 1988, Sec. 9(3).



Czech Republic: **No.** Caselaw suggests that AI-Generated works are not generated by natural persons and therefore fail to satisfy authorship problem. *S.S. v. Taubel Legal*, No. 10 C 13/2023-16 (Prague Mun. Ct. Oct. 11, 2023)



China: **Maybe.** While AI cannot be an “author”, a natural person can be an author of an AI generated work by selecting and finetuning prompts and parameters, as well as refining a final output. *See Li v. Liu*, 0491 No. 11279, Beijing Internet Court (Nov. 27, 2023)



(Figure 3)

Original Output



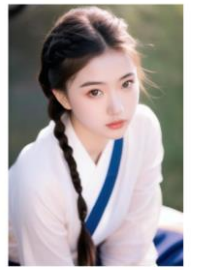
(Figure 4)

Modified Weights



(Figure 5)

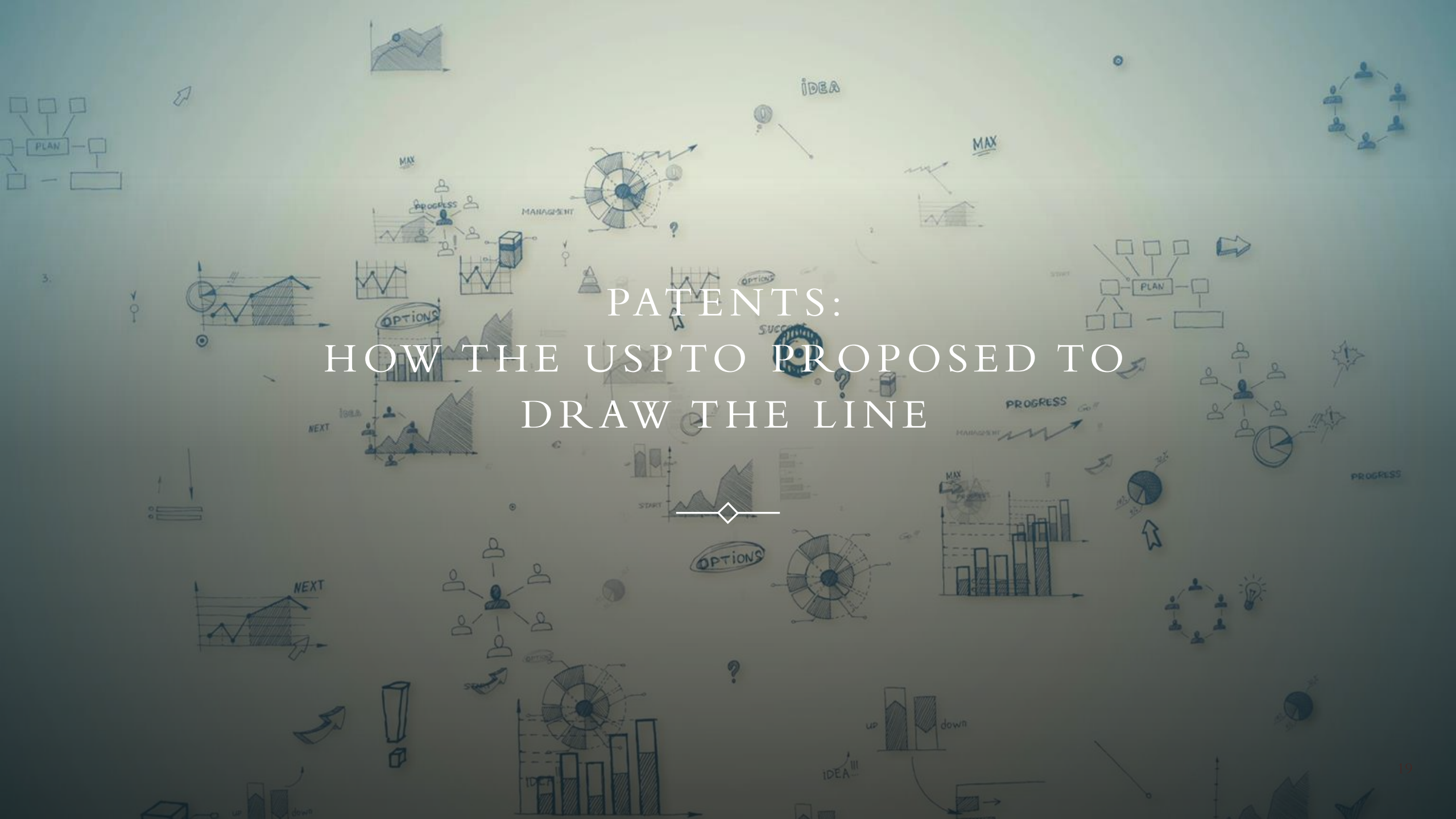
Modified Seed



(Figure 6)

Modified Prompt





PATENTS:  
HOW THE USPTO PROPOSED TO  
DRAW THE LINE

# SIGNIFICANT CONTRIBUTION

When evaluating the contributions made by natural persons in the invention creation process, it is important to keep in mind they **may apply for a patent jointly**, “even though

- (1) they did not physically work together or at the same time,
- (2) each did not make the same type or amount of contribution, or
- (3) each did not make a contribution to the subject matter of every claim of the patent.”



Instead, each inventor must contribute in **some significant manner** to the invention. In making this determination, the courts have looked to several factors, such that each inventor must: ‘

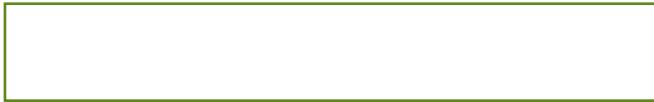
- ‘(1) *contribute in some significant manner* to the conception or reduction to practice of the invention,
- (2) *make a contribution to the claimed invention that is not insignificant* in quality, when that contribution is measured against the dimension of the full invention, and
- (3) do more than merely explain to the real inventors well-known concepts and/or the current state of the art”

(Pannu factors)

# GUIDING PRINCIPLE NO. 1

1. A natural person's use of an AI system in creating an AI-assisted invention does not negate the person's contributions as an inventor. The natural person can be listed as the inventor or joint inventor if the natural person *contributes significantly* to the AI-assisted invention.

**AI + Human = OK!**



## GUIDING PRINCIPLE NO. 2



2. Merely recognizing a problem or having a general goal or research plan to pursue does not rise to the level of conception. A natural person who only presents a problem to an AI system may not be a proper inventor or joint inventor of an invention identified from the output of the AI system. However, a **significant contribution** could be shown by the way the person constructs the prompt in view of a specific problem to elicit a particular solution from the AI system.



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**Problem + No SC = No Good**

# GUIDING PRINCIPLE NO. 3



**RTP (alone) = No Good**

3. Reducing an invention to practice alone is not a significant contribution that rises to the level of inventorship. Therefore, a natural person who merely recognizes and appreciates the output of an AI system as an invention, particularly when the properties and utility of the output are apparent to those of ordinary skill, is not necessarily an inventor. However, a person who takes the output of an AI system and makes a significant contribution to the output to create an invention may be a proper inventor. Alternatively, in certain situations, a person who conducts a successful experiment using the AI system's output could demonstrate that the person provided a significant contribution to the invention even if that person is unable to establish conception until the invention has been reduced to practice.

# GUIDING PRINCIPLE NO. 4

4. A natural person who develops an essential building block from which the claimed invention is derived may be considered to have provided a significant contribution to the conception of the claimed invention even though the person was not present for or a participant in each activity that led to the conception of the claimed invention. In some situations, the natural person(s) who designs, builds, or trains an AI system in view of a specific problem to elicit a particular solution could be an inventor, where the designing, building, or training of the AI system is a significant contribution to the invention created with the AI system.



Provide essential building block = OK!

# GUIDING PRINCIPLE NO. 5



5. Maintaining “intellectual domination” over an AI system does not, on its own, make a person an inventor of any inventions created through the use of the AI system. Therefore, a person simply owning or overseeing an AI system that is used in the creation of an invention, without providing a significant contribution to the conception of the invention, does not make that person an inventor.

Owning or Overseeing an AI system = No Good













RECENT DEVELOPMENT IN  
DESIGN PATENT LAW



Change in Obviousness Standard  
for Design Patents



# *LXQ Corp. v. GM Global Tech.*, 21-2348 (Fed. Cir. 2023)

'625 PATENT CLAIMED DESIGN	LLAN PRIMARY REFERENCE	TUCSON SECONDARY REFERENCE
 <a href="#">Appx0063</a> , FIG. 2	 <a href="#">Appx0450</a> , FIG. 4 (cropped, annotated)	 <a href="#">Appx0464</a> (cropped, rotated)
 <a href="#">Appx0064</a> , FIG. 3	 <a href="#">Appx0449</a> , FIG. 1 (cropped, annotated)	 <a href="#">Appx0462</a> (cropped, flipped)
 <a href="#">Appx0064</a> , FIG. 4	 <a href="#">Appx0451</a> , FIG. 5 (cropped, annotated)	 <a href="#">Appx0462</a> (cropped, flipped)
 <a href="#">Appx0063</a> , FIG. 1	 <a href="#">Appx0452</a> , FIG. 6 (cropped, annotated)	 <a href="#">Appx0453</a> (cropped, flipped)

- Replaces the *Rosen-Durling* test
- Expands Obviousness Inquiry to the four-part *Graham* test (*Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1965))
- May make **design patents more difficult to obtain and easier to challenge**

# How will *LXQ* affect patentability of AI Inventions?



*Graham* four-part obviousness test for utility patents now also applies to design patents:

- (1) considering the scope and content of the prior art with **knowledge of an ordinary designer in the field of design,**
- (2) determining the differences between the prior art designs and the design claim at issue,
- (3) **considering the level of ordinary skill in the pertinent art,** and
- (4) assessing secondary considerations of non-obviousness.

This raises the question, being considered by the USPTO in a **recent Request for Comment:**

**8. How, if at all, does the availability to a POSITA of AI as a tool impact:**

- a. whether something **is well-known or common knowledge in the art?**
- b. how a POSITA would **understand the meaning of claim terms [or design figures]?**

A row of colorful shirts hanging on a rack, with the word 'RISKS' highlighted in red. The shirts are in various colors including blue, pink, and white, and some have a polka-dot pattern. The rack is made of dark metal hangers.

## 2. WHAT ARE THE **RISKS** IN USING AI-GENERATED DESIGNS?



**Risk:** Not Knowing Whether AI Was Used to Make a Design

Example: A Retailer buys a print from a vendor.

The retailer does not know if the print was obtained from a supplier who designed it using generative AI.

**Risk:** Not Knowing if an AI Design Infringes Others' IP Rights

Example: A Retailer asks a supplier to design a shoe.

The supplier designs the shoe using AI.

The retailer does not know what the inspiration of the shoe is, given the size of the AI's training set.

## MITIGATE RISK BY:

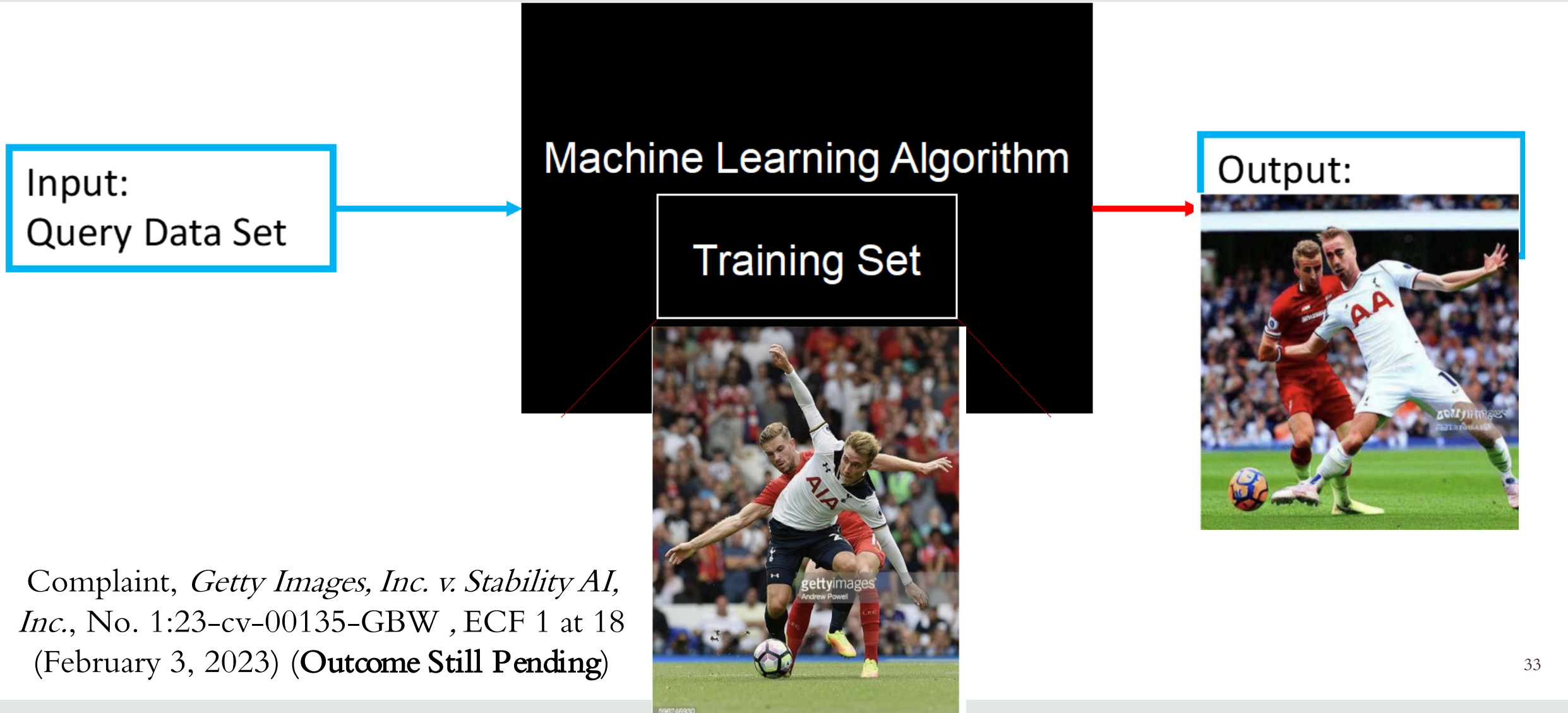


- CONTRACTING TO EXCLUDE AI
- USING INDEMNIFICATION TERMS
- ONLY USING REPUTABLE & KNOWN VENDORS
- (IN HOUSE DESIGNERS) TREATING THE OUTPUT AS THOUGH IT MAY BE COPYRIGHTED

EXAMPLES OF POTENTIALLY  
**INFRINGING USES** OF AI

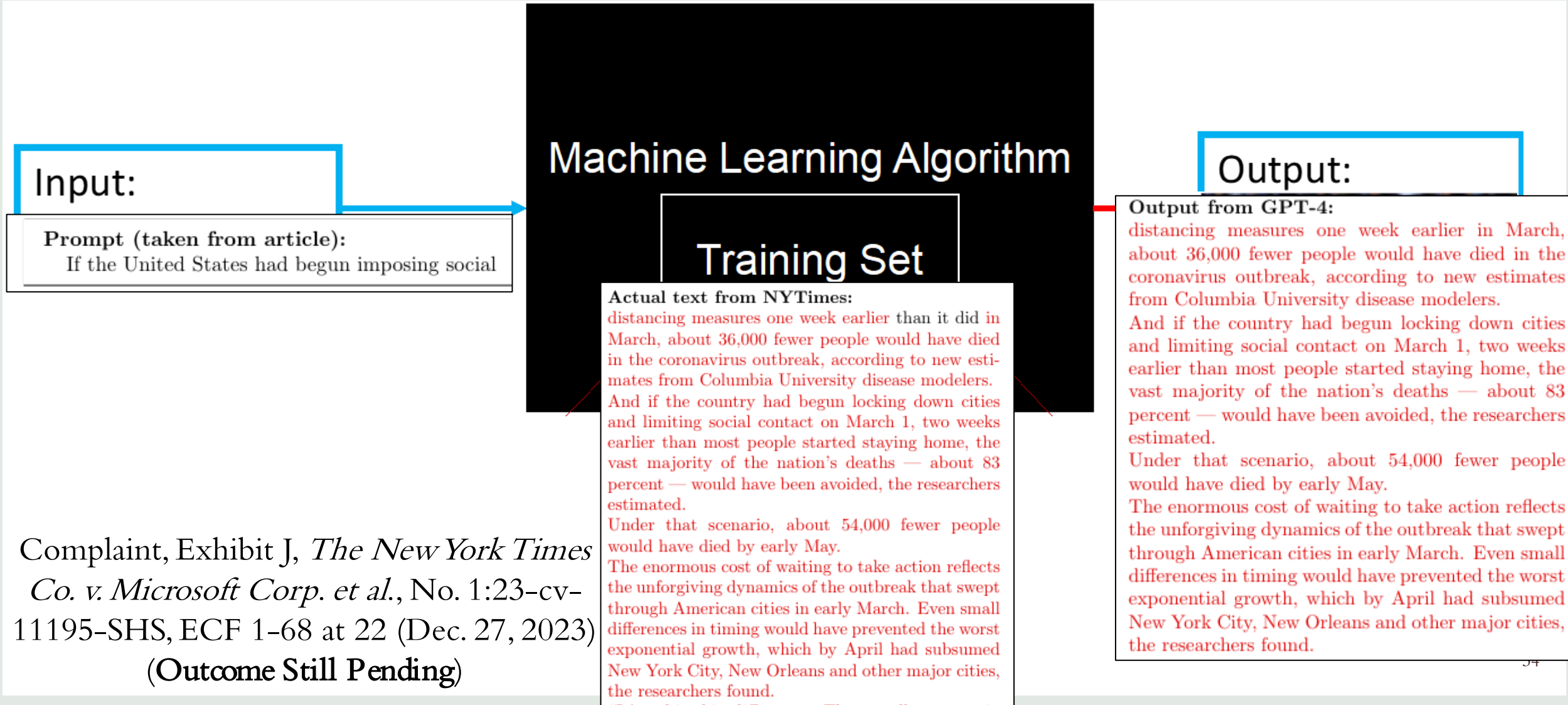


# Getty Images, Inc. v. Stability AI, Inc.



Complaint, *Getty Images, Inc. v. Stability AI, Inc.*, No. 1:23-cv-00135-GBW , ECF 1 at 18 (February 3, 2023) (**Outcome Still Pending**)

# *The New York Times Co. v. Microsoft Corp. et al.,*



Complaint, Exhibit J, *The New York Times Co. v. Microsoft Corp. et al.*, No. 1:23-cv-11195-SHS, ECF 1-68 at 22 (Dec. 27, 2023)  
(Outcome Still Pending)



Someone may argue **fair use as a defense**.

### 17 U.S. Code § 107 - Limitations on exclusive rights: Fair use

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;
- (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.



What About Tomorrow?



# AI Resources:

- Biden's Executive Order on AI: [https://www.whitehouse.gov/briefing-room/presidential-actions/2023/10/30/executive-order-on-the-safe-secure-and-trustworthy-development-and-use-of-artificial-intelligence/?utm\\_campaign=subscriptioncenter&utm\\_content=&utm\\_medium=email&utm\\_name=&utm\\_source=govdelivery&utm\\_term=](https://www.whitehouse.gov/briefing-room/presidential-actions/2023/10/30/executive-order-on-the-safe-secure-and-trustworthy-development-and-use-of-artificial-intelligence/?utm_campaign=subscriptioncenter&utm_content=&utm_medium=email&utm_name=&utm_source=govdelivery&utm_term=)
- USPTO Guiding principles: <https://www.uspto.gov/sites/default/files/documents/inventorship-guidance-for-ai-assisted-inventions.pdf>
- Husch Blackwell, Tracking U.S. State Artificial Intelligence Legislation: <https://www.huschblackwell.com/2024-ai-state-law-tracker>
- Inventorship Guidance for Ai-Assisted Inventions, Docket No. PTO-P-2023-0043, 89 FR 10043 (Feb. 13, 2024), <https://www.govinfo.gov/content/pkg/FR-2024-02-13/pdf/2024-02623.pdf>
- Compendium of the U.S. Copyright Office Practices, Ch. 313.2, <https://www.copyright.gov/comp3/chap300/ch300-copyrightable-authorship.pdf>

## Key Take-Aways



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Copyright protection for AI generated designs may be limited.

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Design patents may be promising but face questions surrounding obviousness.

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Mitigate unknown risks with contractual terms.

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Mitigate unknown risks with substantial human intervention.

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Ongoing changing legal landscape.

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# QUESTIONS



# Disclaimer

The following presentation reflects the opinion of its authors and does not necessarily represent the views of their respective clients, partners, employers, of **Amster, Rothstein & Ebenstein LLP**, or of the **NYIPLA Fashion Law Committee**.

Additionally, the following content is presented solely for the purposes of discussion and illustration and does not comprise, nor is to be considered as legal advice.

**This presentation was prepared with the assistance of AI.**



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# COPYRIGHT AND TRADEMARK PROTECTION OF FASHION DESIGNS

Panelist: Felicity Kohn, Pryor Cashman LLP

Date: *June 26, 2024*



# ■ Protecting Designs in the U.S.



## Three Available Means of Protection

- Copyright
- Trade Dress
- Design Patent

# ■ Copyright



## What is Protected?

- Original works of authorship fixed in a tangible medium of expression  
17 U.S.C. §102(a)
  - Copyright does not protect facts, ideas, systems or methods of operation, although it may protect the way these things are expressed. 17 U.S.C. §102(b)

## How to Obtain a Copyright Registration?

- Complete an application and provide a copy of the “deposit,” *i.e.*, the work.

## How Long is the Protection?

- Depends on several factors, including when it was created, whether it has been published and, if so, the date of first publication.
- As a general rule, for works created after 1/1/1978, copyright protection lasts for the life of the author plus 70 years.
- For a work made for hire, the copyright term is 95 years from first publication or 120 years from year of creation, whichever expires first.

# ■ Challenges for Obtaining Copyright Protection in Fashion Designs



# ■ Challenges for Obtaining Copyright Protection in Fashion Designs



- Under this test, certain aspects of fashion designs may be protectable – such as original prints, patterns, and color arrangements.
- *Star Athletica v. Varsity Brands*, 137 S. Ct. 1002 (2017) addressed the issue of protectability of fashion under the Copyright Act.

# Varsity Brands v. Star Athletica



- At issue were the chevron and zigzag patterns of cheerleading uniforms.

Varsity Brands  
Copyrighted Designs



Star Athletica  
Manufactured Uniforms



## ■ Varsity Brands Cont.



- An aesthetic element of a useful article is copyrightable only if:
  - The element can be perceived as a two- or three-dimensional work of art separate from the useful article; and
  - The element would qualify as a protectable pictorial, graphic or sculptural work, either on its own or fixed in some other medium, if imagined separately from the useful article.
- The chevron and zigzag patterns could be perceived independently of the uniforms as two-dimensional sketches thereby qualifying as a separate copyrightable pictorial work of art



Design 074  
Registration No. VA 1-411-535

## ■ Post *Varsity Brands* Brands



- Some courts have found designs protectable

RASTA IMPOSTA



KANGAROO ITEM 10477



KANGAROO ITEM 10478



*Silvertop Associates Inc. v. Kangaroo Mfg. Inc.*, 931 F.3d 215 (3d Cir. 2019).

# Trade Dress



- What is Protected?
  - Products “total image” or “overall appearance”
  - May include features such as size, shape, color or color combinations, texture and graphics





# Standard for Obtaining Trade Dress Protection



- Distinctiveness
  - Inherently distinctive
  - Secondary meaning
    - *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 112 S.Ct. 2753 (1992)
- Not Functional
  - Feature is functional if it "is essential to the use or purpose of the article or [that] affects the cost or quality of the article."
    - *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844 (1982); *TraFFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 28-29, 58 USPQ2d 1001, 1004-05 (2001)

# Product Design



- Shape and Appearance of Product
- Can Never Be Inherently Distinctive
  - Need to show Secondary Meaning
    - *Wal-Mart Stores, Inc. v Samara Bros.*, 529 U.S. 205 1069 (2000)



Samara Brothers



Wal-Mart

# ■ Establishing Secondary Meaning



- Length of exclusivity and manner of use
- Advertising
- Sales
- Unsolicited media attention
- Proof of intentional copying



# ■ Functionality



- *Ezaki Glico Kabushiki Kaisha v. Lotte International America Corp.*, 986 F.3d 250 (3d Cir. 2020)
  - The Pocky cookie trade dress is functional
  - A product is functional “if it works better in this shape”
    - Includes features that make product cheaper or easier to make or use
  - Every feature relates to practical functions of holding, eating, sharing or packing
  - Ads tout the useful features
  - “We will thus affirm. That’s the way the cookie crumbles.”



# Aesthetic Functionality



- A mark is aesthetically functional and therefore ineligible for trademark protection if: (1) the design feature is essential to the purpose of the goods; (2) the design feature affects the cost or quality of the product; and (3) protection of the design feature would significantly hinder competition.
- *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc.*, 696 F.3d 206 (2d Cir. 2012): Court found Louboutin had established secondary meaning in the red sole but limited the trademark to contrasting uses:

## Red Undersole v. Remainder of the Shoe

- *LTTB LLC v. Redbubble, Inc.*, 840 F. App'x 148 (9th Cir. 2021): LETTUCE TURNIP THE BEET is not source-identifying and is aesthetically functional.



# Fabric Design



**Goods and Services** IC 025. US 022 039. G & S: Coats, detachable coat linings, rainwear, ponchos, jackets, gilets, jerseys, jumpers, sweaters, blouses, shirts, polo shirts, t-shirts, singlets, vests, tank tops, waistcoats, suits, dresses, skirts, aprons, trousers, jeans, shorts, ski wear, sports jackets, sports jerseys, sports shirts, sports trousers, sweat pants, sweat shirts, sweat shorts, tracksuits, tennis wear, waterproof clothing, bikinis, sarongs, swimwear, bathrobes, boxer shorts, lingerie, loungewear, nightwear, undergarments, ties, cravats, footwear, shoes, boots, athletic footwear, slippers, ballet slippers, hosiery, socks, leggings, caps, bandanas, hats, head scarves, knitted hats, visors, belts, gloves, mufflers, scarves, shawls, stoles, pashminas, children's and infant's clothing, headwear, footwear; cloth bibs, textile nappies

**Mark Drawing Code** (2) DESIGN ONLY

**Design Search Code** 26.17.01 - Bands, straight; Bars, straight; Lines, straight; Straight line(s), band(s) or bar(s)  
26.17.04 - Bands, vertical; Bars, vertical; Lines, vertical; Vertical line(s), band(s) or bar(s)  
26.17.05 - Bands, horizontal; Bars, horizontal; Horizontal line(s), band(s) or bar(s); Lines, horizontal

**Serial Number** 77209954

**Filing Date** June 19, 2007

**Current Filing Basis** NO FILING BASIS

**Original Filing Basis** NO FILING BASIS

**Owner** (APPLICANT) **BURBERRY** LIMITED CORPORATION UNITED KINGDOM 18-22 HAYMARKET LONDON SW1Y 4DQ UNITED KINGDOM

**Description of Mark** The applicant claims color as a feature of the mark, namely, tan, brown, black, white, red and shades thereof. The mark consists of a repeating plaid pattern.

**Type of Mark** TRADEMARK. SERVICE MARK

**Register** PRINCIPAL

**Live/Dead Indicator** LIVE

# Texture



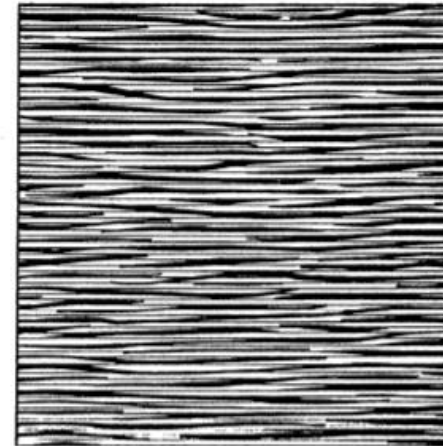
Int. Cl.: 18

Prior U.S. Cl.: 3

Reg. No. 1,931,144

United States Patent and Trademark Office Registered Oct. 31, 1995

TRADEMARK  
PRINCIPAL REGISTER



MALLETIER, LOUIS VUITTON (FRANCE  
CORPORATION)  
54, AVENUE MONTAIGNE  
75008 PARIS, FRANCE

FOR: TRUNKS FOR TRAVELING, SUIT-

KEY CASES, DOCUMENT CASES, BUSINESS  
CARD CASES AND BILLFOLDS, IN CLASS 18  
(U.S. CL. 3).

OWNER OF FRANCE REG. NO. 1-399-708,  
DATED 3-17-1987, EXPIRES 3-17-1997.

THE DRAWING IS LINED FOR THE COLOR

# Recent Infringement Decisions



- *adidas America, Inc. v. Thom Browne, Inc.*, Case No. 23-166, 2024 WL 1953594 (2d Cir. May 3, 2024)





## Recent Infringement Decisions



- *Vans, Inc. v. MSCHF Product Studio, Inc.*, 88 F.4th 125 (2d Cir. 2023)



Vans OLD SKOOL Shoes



MSCHF Wavy Baby Shoe

# Recent Infringement Decisions



- *Hermes International v. Rothschild.*, 678 F.Supp.3d 475 (S.D.N.Y. 2023)



Eight examples of MetaBirkins, the NFTs that Mason Rothschild sold online for \$450 apiece. via Mason Rothschild



Hermès Birkin bags on display during a press preview of the upcoming Luxury Week at Christie's on June 04, 2021 in New York City.

# CONTACT



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**■ Thank You!**