

Designers under Review

In two design infringement cases brought by Australian fashion designer, wholesaler and retailer, Review, the Federal Court of Australia was asked to consider if the registration of a design for a dress was infringed and valid.

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Review 2 Pty Ltd (in liquidation) (“Review 2”) and Review Australia Pty Ltd (“Review”) v Redberry Enterprise Pty Ltd (“Redberry”) [2008] FCA 1588 (“Redberry case”)

In the Redberry case, Review 2 and Review claimed that Redberry had infringed a design registration in respect of a “Review” sleeveless, cross-over (or fixed-wrap) dress (“Review Design”) by importing and selling a dress (“Redberry Dress”) alleged to embody a design substantially similar in overall impression to the Review Design.

Redberry challenged the validity of the Review Design principally on the basis that it was not distinctive in the sense that it was substantially similar in overall impression to a design(s) forming part of the prior art published before the application for the Review Design was filed.

Justice Kenny found that the Review Design was different from the designs in the prior art and was valid. Nevertheless, due to differences in the shape of the skirt and the pattern of the respective Review Design and Redberry Dress, Her Honour found that Redberry had not infringed the Review Design. The Judge took into account the designer’s limited freedom to innovate a cross-over or wrap ladies’ dress other than by reference to the shape and configuration of the skirt combined with differences in pattern (including colour).

Review Australia Pty Ltd v New Cover Group Pty Ltd, Maco Collection Pty Ltd and Biguang Pan [2008] FCA 1589 (“New Cover Group case”)

By comparison, in the New Cover Group case, Review succeeded in its claim for infringement of the same Review Design in respect of the manufacture, importation and sale of garments labelled “Spicy Sugar”. In contrast to the Redberry case, Justice Kenny found that whilst the pattern (and colour) of the Spicy Sugar garments differed to the Review Design, they embodied a design substantially similar to the Review Design. Again, the validity of the Review Design was challenged but was upheld.

Judgment was awarded in the sum of \$85,000, of which \$50,000 represented additional damages. In awarding additional damages, Her Honour had regard to the Respondents’ conduct in the proceeding.

Good fashion sense

Significantly, the fact that the Review Design was registered in colour through the use of colour photographs, without a statement of newness and distinctiveness to otherwise define the design, was considered by the Judge as relevant to determining the extent of the monopoly of the registration. In assessing whether a registered design is infringed, the Court may take into account pattern and colour as visual features which form part of the subject matter protected by



registration, unless disclaimed in some way. When seeking registration of a fashion design, very careful consideration should be given as to what are the visual features which are sought to be protected.

The Judge noted in the Redberry case that had infringement been established, the Court would have been entitled to exercise its discretion to refuse to award damages or to reduce the damages that would otherwise be awarded as it was found on the evidence that Redberry was not aware, and could not reasonably have been expected to have been aware, that the Review Design was registered. The *Designs Act* provides that it is *prima facie* evidence that the defendant was aware that the design was registered if the product embodying the registered design to which the infringement proceedings relate, or the packaging of the product, is marked so as to indicate registration of the design. An example would be affixing a garment with a swing tag notifying design registration.

In both the Redberry case and the New Cover Group case, the Judge observed that copying and adapting designs of other designers is commonplace in the fashion industry. Implementing a design registration filing strategy can be a particularly useful way for designers to protect their seasonal fashion wares.

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FURTHER INFORMATION

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