An Uphill Battle Protecting Fashion Designs In Nigeria and Abroad

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Growing frustration in the fashion community regarding weak or non-existent intellectual property laws has finally caught the attention of some nations. Nigeria is one nation that currently is trying to alleviate this frustration by reforming its intellectual property laws. This reform is driven, in part, because, Lagos, Nigeria has quickly risen as a fashion hub, and has been compared with such fashion centers as London, Paris, Milan, and New York. Nigerian designers have recently experienced great global success and visibility. For example, Amaka Osakwe has been pushing the limits of Nigerian fashion and has gained the attention of fashionistas in the United States and abroad. In 2014, she was invited to the White House by Michelle Obama, an admirer of her work, and her “Maki Oh” designs have been worn by Lupita Nyongo and other A-list celebrities. Last year, Ms. Osakwe was named a LVMH Louis Vuitton Moët Hennessy Finalist, placing her among the most notable young fashion designers in the world today. Other talented Nigerian designers include Duro Olowu, Deola Sagoe, Lisa Folawiyo, and Lanre DeSilva-Ajayi. As these designers continue to gain worldwide recognition, they must protect their designs from infringement both within Nigeria and globally.

The first hurdle — protecting their fashion designs in Nigeria — is not a simple task. Copyright protection is typically sought to protect the two-dimensional aspects of clothing design, while design law may protect the three-dimensional design and shape of the piece. However, under both Nigeria’s copyright and design laws, designers have encountered significant difficulty protecting their works. Section 1(3) of Nigeria’s Copyright Act states: “An artistic work shall not be eligible for copyright, if at the time when the work is made, it is intended by the author to be used as a model or pattern to be multiplied by any industrial process.” As a result, protection under the Nigerian Copyright Act is not available where a designer intends to mass produce his or her garments. This creates an inadvertent disincentive for Nigerian designers striving for global success because commercially marketed designs are unprotected under the Copyright Act.

Alternatively, Nigerian designers may seek protection by obtaining a design patent, which permits mass production, but is also difficult to secure. Designers who chose this route are often impeded by the lengthy processing time required to obtain the patent, the fees associated with the application and registration process, and the burden to prove that their designs are entirely “new,” varying significantly from each prior design in every country across the world. Each of these obstacles, particularly the last, may preclude protection under Nigeria’s Patents and Design Act: “Any anticipation of the design anywhere in the world, by any means whatsoever before the date of the application for registration of the relevant priority date destroys novelty.” This high standard for proving novelty is often difficult to meet, especially for designers known for their particular aesthetic, as displayed in their prior works, and because fashion designs are often derivative of prior designs.

Nigerian intellectual property scholars have recognized these dilemmas facing Nigerian fashion designers in light of Nigeria’s ascension in the world fashion marketplace and suggested intellectual property reform to remedy them. In an interview with The Guardian, Professor Adebambo Anthony Adewopo, an intellectual property law scholar at Lagos State University and Senior Advocate of Nigeria stated, “[Nigerian intellectual property] laws have remained largely unsuited to the emergent commercial and technological development” and “[w]hat [Nigeria] need[s] is a holistic reform of IP in substance and in form, including a well-articulated national IP and innovation policy.”

Such reform could result in laws that better protect fashion designs, as exemplified in the laws of some nations in the
European Union. For instance, France’s Copyright Act lists fashion designs as works of art that are afforded full copyright protection, regardless of production intent.\[^6\] If such a law were implemented in Nigeria, it would help propel Nigeria’s growing fashion industry by protecting its designers from infringement.

For example, in 2002, the European Union established a Fashion Design and Unregistered Community Design right. It also empowered fashion designers to litigate infringement claims before the Court of Justice of the European Union (“CJEU”) asserting that “individual in character” designs for meaning designs for which the overall impression is different from that of one or more earlier designs, were copied by someone within the jurisdiction of one of the member states.\[^7\] This standard, upheld by the CJEU in Karen Millen Fashions Ltd. v. Dunnes Stores, et al.,\[^8\] differs from that in Nigeria, which requires not only that the impression of the design be different, but that the design be completely unanticipated elsewhere in the world.

Nigeria is not the only country that could benefit from reforms similar to those highlighted. Australia’s copyright law is similar to Nigeria’s in that a design loses copyright protection if it is applied to more than fifty articles.\[^9\] According to the World Intellectual Property Organization (“WIPO”) on Australian design, “copyright protection is . . . available for works of artistic craftsmanship, such as one-off fashion garments and jewelry. However, if you intend to mass produce or make multiple copies of items, you should rely on design law rather than copyright law.”\[^10\] The organization then states, though, that, “[i]f you have publicly disclosed your designs (e.g., if your designs have appeared in fashion magazines, paraded garments at a fashion show, or sold it as a product) prior to registration you may have lost your ability to protect your design.”\[^11\] Should designers fall into this disclosure trap, perhaps in their haste to debut their new “it” pieces during the long pre-registration period and before the fashion trend expires, they may be without protection.

The United States also has unsuccessfully attempted copyright reform to protect fashion designs, and the debate about the adequacy of its current copyright protections continues.\[^12\] The United States Supreme Court’s holding in Star Athletica, L.L.C. v. Varsity Brands, Inc., (“Star Athletica”), expanded the scope of separability analysis, by affirming the Sixth Circuit decision that the design features incorporated in a useful article, such as the cheerleading costumes in the case, are protected under the Copyright Act when they can be separated from, and are capable of existing independently of, the design’s utilitarian aspects.\[^13\] Following the Star Athletica precedent, the “separability doctrine” has been successfully used to protect fashion designs in the United States.\[^14\] Yet, debate persists about the impact of the decision. Some scholars still advocate the need for copyright reform to clarify the separability doctrine and to ensure consistent protection for fashion designs in the United States.\[^15\] Regarding potential design protection, the United States’ Congress has yet to pass legislation specifically protecting fashion designs, although a few bills have been introduced in recent years.\[^16\]

In addition to the hurdle of gaining protection for designs in Nigeria, Nigerian designers also must determine whether they have recourse under international law to bring actions against infringers in other countries — which options are problematic. The Berne Convention for the Protection of Literary and Artistic Works (the “Convention”) does not recognize fashion designs as copyrightable works. WIPO has not interpreted the Berne Convention as permitting protection for fashion designs per se. Certain protections are afforded to copyrights and designs in other jurisdictions but often the situs of creation is the determining factor for analyzing copyright protection, while the situs of infringement is the determining factor for the laws applied in any potential lawsuit.

Innovation and technology have revolutionized the fashion industry by increasing the speed of reproduction of materials. This also has hastened the pace of infringement worldwide. The need for reform of Nigerian intellectual property laws to protect Nigerian fashion designs is apparent. Intellectual property law reform in Nigeria would not only be beneficial to protecting designers and the industry at large, but also could provide direct economic advantages which would help protect the prosperity of Nigeria’s fashion designers. Legal scholars in Nigeria and other similarly situated countries are recognizing the need for reform and the economic and reputational benefits that such reform could bestow. For now, designers should first determine to what extent their works can be protected in their native countries and worldwide. As a general matter, the issues discussed here highlight the complexities with designing, selling, and marketing clothing in various countries, especially when designs are not well protected. Designers should consult with their legal advisors to understand the intellectual property laws of different countries so they may fashion an informed business strategy for obtaining international success.

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\[^2\] Patents and Designs Act (Chapter 344, Laws of the Federation of Nigeria 1990).

\[^3\] Id. at Section 13(5).

\[^4\] Enyinna S. Nwauche, Prior Use and Registration of Designs in Nigeria, at 827.


\[^6\] French Copyright Act of 1783, Art.112-2


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