

# Trade Dress Protection for Websites: Is It a Viable Solution

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**Abstract:** Each and every website has a distinct and unique appearance, style, pattern, etc. of its own. These distinct elements help the people who access such websites to build a connection with the owner of the product as it gives an immediate impression and makes it recognizable and easy to use. “Look and Feel” of a website refers to “the user interface, generally manifested by the display screens that a computer program generates and the keystroke combinations that are used for particular program functions.”<sup>1</sup> Presently the website developers protect their website source code by means of copyright but it has been argued that the ‘look and feel’ aspect of a website is not copyrightable and the same falls outside the realm of copyright.

**Keywords:** Website, Trade Dress Protection;

## 1. Introduction

It is herein that the alternative of trade dress protection emerges as an alternative, because trade dress claim are evaluated based upon an overall appearance rather than on individual components and seems more appropriate because just like trade dress, the “look and feel” of a website concentrates on the overall appearance of the product i.e. website in the present case. The present work aims to understand and analyse both the modes of protection available to website developers, copyright and trade dress and analyse which of the source would be better suited keeping in mind the needs of website developers and in the light of case laws.

## 2. Copyright protection for websites

There are a number of components involved in a website when the aspect of its protection is brought into light. There may be the text which is displayed on the page as well as the software code which controls the way in which the content on the website will be displayed. In a web page, the design of the content is controlled by a special code known as the Cascading Style Sheet (CSS). There are two important requirements (established under copyright law) which must be fulfilled for a copyright to subsist. Firstly, the work has to be original and secondly, it should be capable of fixation. Hence, if a work is an independent creation of the author and some minimal level of creativity has gone in the making of that work, then it qualifies the threshold requirement of originality and becomes an original work.<sup>1</sup> Hence, a website will be considered original (for the purpose of copyright protection) if and when the visual arrangement of the website is an original one.

As far as the requisite of fixation is concerned, the courts have held that information embedded in computer read-only memory (ROM) is regarded as fixed in a tangible medium.<sup>2</sup> In the same manner, the data stored on the hard disk of a computer can be regarded as being fixed. Applying the same analogy to websites, wherein the page files that generate instructions for the user interface are stored on the hard disk of a computer and thus satisfy the requirement of fixation.

Even though it may seem that the criteria of fixation and originality could be satisfied by websites, there might arise a number of issues when copyright protection is to be extended to websites. In one scenario, the display may consist of functional or utilitarian features, which may render copyright protection unavailable or websites. In one such case (although not dealing specifically with websites) *Apple Computer, Inc. v. Microsoft Corp.*<sup>3</sup>, a U.S. Court held that the “look and feel” of the website was not copyrightable. In this case, Apple sued Microsoft and HP for infringing the copyright in the graphical user interface on its Macintosh computer. The GUI interface consisted of icons, pull-down menus, overlapping windows, etc. The Court did not follow the criteria of considering the entire look and feel of an interface to assess copyright protection. It stated that each of the features of the website were functional and utilitarian in nature and therefore non protectable under copyright law.

Another hindrance which might be faced while extending copyright protection to websites is that the command structure (the commands that constitute amount to the input in websites) might come within the purview of “methods of operation”. Article 9 of the TRIPS Agreement expressly stated that “Copyright protection

<sup>1</sup> *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991)

<sup>2</sup> *Apple Computer, Inc. v. Franklin Computer Corp.*, 714 F.2d 1240, 1243 (3d Cir. 1983)

<sup>3</sup> 35 F.3d 1435 (9th Cir. 1994)

shall extend to expressions and not to ideas, procedures, “methods of operation” or mathematical concepts as such.” In the case of *Lotus Development Corp. v. Borland International, Inc.*<sup>4</sup>, the United States Supreme Court was challenged with this issue. The First Circuit Court of Appeals had found that the menu structure of the spreadsheet program, “Lotus 1-2-3”, was a method of operation and thus could not be protected by copyright. The First Circuit based the same on the explicit language of Section 102(b) of the U.S. Copyright Act, which excuses methods of operation from copyrightable subject matter. The Supreme Court affirmed the judgment pronounced by the First Circuit.

In addition to the above obstacles, there is also a general notion that the general arrangement of elements in a given space is generally not covered by the Copyright Act. In *Darden v. Peter*<sup>5</sup>, the website displayed a series of maps that were derived from existing U.S. Census maps. The website owner sought registration for website’s “compilation and arrangement of maps, text, graphics and data,” and later amended the application to “text, maps, and formatting of an Internet web page.” The Copyright Office denied the registration for the arrangement and formatting of a website. The District Court upheld the Copyright Office’s decision. “The examiners noted that in general, formatting of web pages is not copyrightable.” In denying the registration, the Copyright Office explained: “The longstanding practice of the Copyright Office is to deny registration of the arrangement of elements on the basis of physical or directional layout in a given space, whether that space is a sheet of paper or a screen of space meant for information displayed digitally.”<sup>6</sup>

Although it appears that the user interface of the websites cannot be protected within the purview of copyright law, but if such a scenario would arise, the claimant would have to show: (1) that he owns a valid copyright, (2) that the copyright has been registered with the Copyright Office, and (3) that the defendant has copied its protected work, which requires both copying-in-fact and substantially similar copying.<sup>7</sup>

In view of the above discussion, it could be said that a website, would lack originality if it merely organises and presents the data. Secondly, in the light of *Apple* and *Lotus* cases, it can be said that the means for navigating and operating a website would be regarded as “methods

of operation”, which would again render the website ineligible for copyright protection. And lastly, if the website merely consists of functional features, that would again bar the extension of copyright protection to websites. Thus, in our view, it would be correct to conclude that it is highly improbable that a website may be eligible for copyright protection.

### 3. Trade dress protection for websites :

In its modern form, trade dress protection includes “the design and shape of a product and its packaging and even includes the design and shape of the product itself.”<sup>8</sup> Trade dress, one of the less common forms of intellectual property, protects the overall image of a product, store, or potentially a website, which connotes a particular source, from illicit copying.<sup>9</sup> What necessarily entails from above-mentioned definitions is that a trade dress refers to the total look of the product and the same includes various features that contribute to make up that total look, these features can be anything ranging from the shape of the product, the colour or colour combinations of the outer package, or anything that does the function of differentiating and making the look of the product distinct.

Firstly, when an infringement claim for website copying is brought forward, the plaintiff must first bring forward all the elements in a website on the basis which he is contending trade dress protection. Specificity and finality are both critical to the success of a trade dress infringement claim, especially for website copying.<sup>10</sup>

The elements claimed as trade dress in the look and feel of a website is necessary to be mentioned but not wholly sufficient. A prima facie case of a trade dress infringement claim is established pursuant to the Lanham Act<sup>11</sup> where a plaintiff must possess an interest in the trade dress design; additionally, the plaintiff must also show that the alleged trade dress is distinctive and non-functional, and that there is a likelihood of consumer confusion between its alleged trade dress and that of the defendant.<sup>12</sup>

Distinctiveness, the first of three elements and its application to trade dress have been considered by the Supreme Court in the landmark cases *Two Pesos, Inc. v. Taco Cabana Inc.*<sup>13</sup> and *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*<sup>14</sup> *Two pesos* set the basis for the protection of inherent distinctive trade dress, even in the

<sup>4</sup> 516 U.S. 233 (1996)

<sup>5</sup> 402 F. Supp. 2d 638, 642 (E.D.N.C. 2005)

<sup>6</sup> J Scott Anderson, *Painstaking Semantics: selecting Website Trade Dress Elements to Survive a Copyright Preemption Challenge*, 7 J. MARSHALL REV. INTELL. PROP. L. 97, 103 (2007-2008)

<sup>7</sup> Liz Brown, *Bridging the Gap: Improving Intellectual Property Protection for the look and feel of websites*, 3 NYU J. INTELL. PROP. & ENT. L. 310, 323 (2013-2014)

<sup>8</sup> Supra note 1 at 145

<sup>9</sup> Supra note 8 at 331

<sup>10</sup> Id at 332

<sup>11</sup> Lanham Act §43(a), 15 U.S.C. § 1125(a)

<sup>12</sup> 15 U.S.C. §§ 1125(a)(3), (c)(2)(B)

<sup>13</sup> 505 U.S. 763, 768 (1992)

<sup>14</sup> 529 U.S. 205, 210 (2000)

absence of any secondary meaning.<sup>15</sup> In the present case Supreme Court had held that the décor of the restaurant was distinctive in nature and thus eligible for protection as trade dress. In *Wal-Mart*, on the other hand, the Supreme Court, after distinguishing between product design and product packaging, held that product designs can never be inherently distinctive.<sup>16</sup> Product packaging denotes the appearance of the package a product comes in, in addition to the interior design schemes.<sup>17</sup> *Au Contraire*, product design refers to the way a product looks and feels. It is only where a product design has acquired a “secondary meaning”, can the same be considered to be distinctive.<sup>18</sup> Secondary meaning refers to a level of distinctiveness acquired by longstanding use in the market, as opposed to the inherent design of the site.<sup>19</sup> A hindrance in adopting the ‘secondary meaning’ is that it would take longer to be eligible for protection because secondary meaning is more difficult to demonstrate than inherent distinctiveness. In the case of *Coach Leatherware Co. v. Ann Taylor Inc.*<sup>20</sup>, it was held that where the trade dress is descriptive, secondary meaning will be present when a significant number of consumers associate the features claimed as trade dress to a particular source rather than the product itself.<sup>21</sup>

The aspect of functionality in case of websites must also be dealt in detail. A functional website is always a desirable one because it attracts more consumers. There are primarily two kinds of websites, firstly, the ones which merely display, describe and sell the product which the consumer wishes to purchase. The second type of websites are the ones which describe the product which the consumer wishes to purchase such as review sites, search engines or booking sites. In the first category, the website is selling the product in which the consumer is interested, whereas, in the second category, the website is itself the product, which the consumer is interested in accessing. Thus, it would not be correct to accord a single trade dress criteria for the ‘look and feel’ of the website when discussing the functionality aspect of the websites.

In *SG Services, Inc. v. God's Girls*<sup>22</sup>, the plaintiff owned an adult services web site and claimed that the defendant had copied various elements of the plaintiff’s website. Among other claims, SG asserted that had infringed its

trade dress by using (1) the colour pink and (2) certain stock phrases, including “they’re the girl next door” and “so you wanna be a suicide girl?” on its website. The court agreed with the plaintiff that the colour and stock phrases were “merely adornment” and not functional in nature, and hence eligible for trade dress protection.

The final aspect that needs to be shown to establish a claim of trade dress infringement is that of consumer confusion i.e. that there exists a likelihood of confusion between the trade dress of the plaintiff and that of the defendant. In the case of *Merchant & Evans Inc. v. Roosevelt Bldg. Prod. Co.*<sup>23</sup>, it was held that a merchant who seeks action for trade dress infringement has a higher likelihood to prove consumer confusion when the parties use the same means to market their products, i.e. a website.

Thus it is the collective or coupled effect of all the above factors that are taken together while considering a claim of trade dress infringement. The plaintiff who seeks to protect the “combination of elements,” if successful, “[is] capable of acquiring exclusive legal rights as a type of identifying symbol of origin” through trade dress.<sup>24</sup>

Coming to the issue at hand, i.e. trade dress infringement of websites; applying the earlier analogy needed to prove an infringement of trade dress, what needs to be proven is that the trade dress of the website is distinct, non-functional and there exists such a similarity between the website of the plaintiff and that of the defendant which would make it likely for the consumers to get confused between the two. A trade dress claim must be evaluated based upon an overall appearance rather than the individual components. The Second Circuit notes “if the overall dress is arbitrary, fanciful, or suggestive, it is inherently distinctive despite its incorporation of generic or descriptive elements.” Thus, if a website owner has generic elements on the site, this may not be fatal if the overall ‘look and feel’ is inherently distinctive.<sup>25</sup>

#### 4. Future of trade dress protection for websites

In the case of *Parker Waichman LLP v. Gilman Law LLP*,<sup>26</sup> the District Court of New York wrote that “the application of trade dress law to websites is a somewhat ‘novel’ concept” and an issue of “first impression in this Circuit.” Thus it could be said that getting a trade dress protection for a website although more suited, keeping in mind the fact that the element that is protected relates to the total look and feel of the website i.e. the overall appearance or total impression of the website, but the same is not proving to be more successful due to the lack

<sup>15</sup> Vlotina Liakatou, *Trade Dress Distinctiveness in the US: Wal-Mart, Progeny and Comparison with The European Standards*, EUROPEAN INTELLECTUAL PROPERTY REVIEW, 1 (2010)

<sup>16</sup> Ibid

<sup>17</sup> Supra note 14 at 210

<sup>18</sup> Id at 215

<sup>19</sup> Ibid

<sup>20</sup> 933 F.2d 162, 168 (2nd Cir. 1991)

<sup>21</sup> Supra note 1 at 149

<sup>22</sup> No. CV 06-989 AHM, 2007 WL 2315437 (C.D. Cal. May 9, 2007)

<sup>23</sup> 963 F.2d 628 (3rd Cir. 1992)

<sup>24</sup> Supra note 1 at 153

<sup>25</sup> Supra note 1 at 158

<sup>26</sup> No. 12-CV-4784 JS AKT, 2013 WL 3863928, at \*4 (E.D.N.Y. July 24, 2013)

of prior judgments on it and therefore the scepticism of the judiciary to adjudicate future matter on these lines.

The case of *Blue Nile Inc v. Ice.Com, Inc*<sup>27</sup> is a decision that accepted the possibility of trade dress protection for websites but did not adjudicate in favour of the claim related to such trade dress protection. In this case, Blue Nile alleged that Ice.com had copied the overall look and feel of its diamond search web pages and filed a claim ranging from copyright infringement to trade dress infringement under the Lanham Act. It was alleged by the defendants that the trade dress claims of the plaintiff must be struck off as the same were overlapping with their copyright claims. But the same was rejected by the court concluding that the same are novel and that the trade dress claims could be dismissed only if sufficient remedy was available in Copyright. It was argued by the plaintiff that its trade dress claim relate to defendants' copying of "the overall look and feel" of its diamond search webpages which cannot be remedied by copyright law. After reviewing plaintiff's claims, the court found the contention sufficient to support a claim that "[Blue Nile] is seeking to protect the 'look and feel' of its web site."<sup>28</sup> Dismissing the claim of the plaintiff that the "look and feel" of plaintiff's website is not within the subject matter of copyright, the court based it on the fact that even though the Ninth Circuit has not addressed the issue of whether a website's "look and feel" is protected under § 102<sup>29</sup>, other circuits have held that a work may be unprotected by copyright under § 102(b)<sup>30</sup> and yet be within copyright's subject matter for pre-emption purposes. A very crucial observation was made by the court with regard to trade dress protection for look and feel of website, wherein it was described "[a]s a novel legal theory [sic], there are more articles supporting trade dress protection for the 'look and feel' of websites than there are published cases deciding the merits of this theory."<sup>31</sup> Thus, the court seemed willing to hear the argument that a website owner may in fact be entitled to protection of the "look and feel" under a trade dress theory.<sup>32</sup> Thus although the court denied the motion of the defendant to dismiss plaintiff's cause of action for trade dress infringement under 15 U.S.C. § 1125(a) but at the same time the court did not consider the claim of the plaintiff that "look and feel" of the website is outside the domain of copyright. Thus with regard to the future of trade dress protection for websites this judgment is one that is neither a victory nor less. It certainly puts the issue on a platform where it emerges as an alternative, and a

good one at that, but at the same time not ruling in favour doesn't trigger any positive change in the circumstances and the legal position remains the same i.e. unclear.

## 5. Analysis

As we have analysed from the discussion above, we can clearly say that copyright and trade dress are the two primary forms of protecting websites. It is to be clearly understood in the beginning itself that the content contained in the websites is not under consideration in the present research as it would undoubtedly be protected by the law of copyright. What we are concerned with in this research is the appearance, or in other words the 'look and feel' of the website. Thus, by means of this project we seek to analyse whether to protect the commercial expression (which is protectable under copyright law) or the consumer impression (which is protectable under trade dress law).

While assessing copyright protection for websites, initially it could be said that copyright protection can subsist in a website as both the requirements of originality as well as fixation could be fulfilled by it. But, as soon as we go a little bit deeper, we find that copyright is not a suitable option for the protection of websites because of a number of reasons. To begin with, the elements of a website are purely of a utilitarian as well as functional nature and also the command sequence in the website that forms the peculiar display of the website, can be regarded as a 'method of operation' and thus not eligible for copyright protection. Thus even though copyright can protect the source code of underlying program of the website, what it cannot effectively protect, is the overall appearance of the website, its user interface. There could be instances wherein the competitor copies the look and feel of the website, for instance the colour used in the original website or may be the manner in which icons are arranged etc. that make it look like the original and a consumer would get confused between the two and end up being deceived. Here the competitor has not done anything wrong legally as he has not infringed original website's copyright in any particular text but he has copied the essence or appearance that made the website distinct. Thus, a more efficient form of intellectual property protection is desirable for the protection of websites that can protect the look and feel element of websites.

Turning the discussion to the alternative mode of protection available i.e. trade dress, it protects the overall appearance of a product, and can include anything ranging from shape or design of the product to the manner in which it is packaged and also the colour schemes used for packaging; basically anything that makes it distinct so that it sticks in the memory of the consumer and tells him about the source of the product. In the case of websites, it is the combined effect of its various elements, together with its design features, that creates a unique user experience and the same is to be protected. The one reason that trade dress protection

<sup>27</sup> 478 F. Supp. 2d 1240 (W.D. Wash. 2007)

<sup>28</sup> Matthew Formeller, *Trade Dress Protection For Web Sites: Is It Time For The Law To Overtake Theory?*, 18 DEPAUL J. ART TECH. & INTELL. PROP. L. 157, 169

<sup>29</sup> 17 U.S.C. § 102

<sup>30</sup> 17 U.S.C. § 102(b)

<sup>31</sup> *Blue Nile, Inc. v. Ice.com Inc.*, 478 F. Supp. 2d 1240, 1246, n. 8 (W.D. Wash. 2007)

<sup>32</sup> *Supra* note 1 at 157

would be more suited to protecting the “look and feel” of websites is that for proving an infringement claim, the threshold in copyright is much higher and the same is done by substantial similarity test but in trade dress all that needs to be proved is that the trade dress is distinctive, non-functional and there is a likelihood of confusion to the customers. This likelihood of confusion is comparatively easier to establish than courts conducting the substantial similarity test and especially so in the case of websites wherein the comparisons would be made keeping both the original and infringing websites side by side and looking for any similarities on the face of them. Thus in our opinion trade dress protection would be better suited to websites but the issue that arises is that there are no cases that support and grant such protection and even the case of *Blue Nile Inc. v. Ice.Com Inc.*, merely mentioned that such a protection could be granted and would be suitable but the same was not granted. Even then the afore-mentioned case has paved way and hopefully in the future such a protection could be granted for “look and feel” of websites. As far as our country is concerned, Indian law does not have a distinct provision for the trade dress under the existing law unlike the US law wherein it is specifically provided the Lanham Act. Although, the new Trade Marks Act, 1999, includes the concept of trade dress through a constructive and wide reading of Section 2 (zb) of the Indian Trade Mark Act that defines trade mark wherein it takes into its scope the shape of goods, packaging or combination of colours or any combination thereof etc. Even though there have been a couple of cases related to infringement of trade dress in India but there has not been much cases with reference to trade dress protection for websites

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<sup>i</sup> Amber R. Cohen, *A Square Peg Into A Round Hole: Trade Dress Protection Of Websites, The Perspective Of*