
SURFING FOR PROTECTION: WHY WEBSITES SHOULD BE CATEGORICALLY EXCLUDED FROM TRADE DRESS PROTECTION

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I. INTRODUCTION

“Design is a funny word. Some people think design means how it looks. But of course, if you dig deeper, it’s really how it works.” - Steve Jobs²

To say that the Internet is an important part of modern life is uncontroversial. People all over the world use the Internet for everything from banking,³ to entertainment,⁴ social networking,⁵ and to weight loss.⁶ The most popular sites are valued in the billions of dollars,⁷ demonstrating that popular and groundbreaking sites are big business.

As sites become more popular, so too will the attempts by competitors to

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² Gary Wolf, *Steve Jobs: The Next Insanely Great Thing*, WIRED, http://archive.wired.com/wired/archive/4.02/jobs_pr.html (last visited Aug. 30, 2014).

³ See, e.g., MINT.COM, <http://www.mint.com> (last visited Aug. 6, 2014); CHASE, <http://www.chase.com> (last visited Aug. 6, 2014); BANK OF AMERICA, <https://www.bankofamerica.com> (last visited Aug. 6, 2014).

⁴ See, e.g., YOUTUBE, <https://www.youtube.com> (last visited Aug. 6, 2014); HULU, <http://www.hulu.com> (last visited Nov. 8, 2014); NETFLIX, <http://www.netflix.com> (last visited Nov. 8, 2014).

⁵ See, e.g., FACEBOOK, <https://www.facebook.com> (last visited Aug. 6, 2014); TWITTER, <https://twitter.com> (last visited Nov. 8, 2014).

⁶ See, e.g., MYFITNESSPAL, <http://www.myfitnesspal.com> (last visited Aug. 6, 2014); LOSE IT!, <http://loseit.com> (last visited Aug. 6, 2014).

⁷ Brian Womack, *Facebook Market Value Tops \$100 Billion Amid Mobile Push*, BLOOMBERG (Aug. 26, 2013), <http://www.bloomberg.com/news/2013-08-26/facebook-market-value-tops-100-billion-amid-mobile-ad-push.html>.

gain visitors to other similar websites by using the goodwill created by popular sites.⁸ It is crucial for consumers to identify the sources of the online sites they visit. As a result, website owners have explored various legal remedies to protect their websites.⁹ Trademark law is one area that site owners have turned to for protection.

Source identification and the protection of that identification is the goal of United States trademark law.¹⁰ Historically, trademark law applied to symbols, names, logos, or product designs, a concept known as trade dress.¹¹ However, trade dress has expanded to include many objects beyond just product design,¹² encompassing the entire “look and feel” of a product or service.¹³ A number of cases have arisen across the country where website owners assert infringement of their website’s trade dress by competitors.¹⁴

Trade dress law has its limits, however. Emerging technologies are still constrained by the requirements of trademark and trade dress law.¹⁵ Trademarks that perform some function are not protectable,¹⁶ nor are marks that are only descriptive of the product or service without unique source identification.¹⁷ Because trade dress protection of websites is a relatively new legal theory,

⁸ Sebastian Dramburg, *Copying Websites – How Far Can You Legally Go ?*, VENTURE VILLAGE (July 17, 2013), <http://venturevillage.eu/copying-websites>.

⁹ See, e.g., *Sleep Sci. Partners v. Lieberman*, No. 09-04200 CW, 2010 WL 1881770, at *1 (N.D. Cal. May 10, 2010) (plaintiff Sleep Science Partners sought protection of its website’s design and brought suit for “trade dress infringement, copyright infringement, tortious interference with contract, common law misappropriation, unfair competition, civil conspiracy, and unjust enrichment.”); see also, 15 U.S.C. § 1125(a) (2012) (statutory basis for civil liability under the Lanham Act, § 43(a)).

¹⁰ 15 U.S.C. § 1127 (a trademark identifies and distinguishes goods).

¹¹ *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 209-10 (2000).

¹² See, e.g., *Hartford House Ltd. v. Hallmark Cards Inc.*, 647 F. Supp. 1533, 1533 (D. Colo. 1986), aff’d, 846 F.2d 1268 (10th Cir. 1988) (greeting cards); see, e.g., *Time Inc. Magazine Co. v. Globe Comm’ns Corp.*, 712 F. Supp. 1103, 1104 (S.D.N.Y. 1989) (magazine cover); see, e.g., *Health o meter, Inc. v. Terraillon Corp.*, 873 F. Supp. 1160, 1163 (N.D. Ill. 1995) (bathroom weighing scale).

¹³ See *Blue Nile, Inc. v. Ice.com, Inc.*, 478 F. Supp. 2d 1240, 1242 (W.D. Wash. 2007) (arguing that trade dress protection should be expanded to websites).

¹⁴ See, e.g., *id.* (alleging that rival company copied the design of its diamond search webpage); *Salt Optics, Inc. v. Jand, Inc.*, No. SACV 10-0828 DOC, 2010 WL 4961702, at *5 (C.D. Cal. Nov. 19, 2010) (arguing that defendants intentionally adapted the plaintiff’s copyrighted optics website to sell eyewear to the public);

Conference Archives, Inc. v. Sound Images, Inc., CIV. 3:2006-76, 2010 WL 1626072, at *1 (W.D. Pa. Mar. 31, 2010) (alleging that defendant copied code from plaintiff’s website).

¹⁵ See, e.g., Xuan-Thao N. Nguyen, *Should It Be A Free for All? The Challenge of Extending Trade Dress Protection to the Look and Feel of Web Sites in the Evolving Internet*, 49 AM. U. L. REV. 1233, 1234 (2000).

¹⁶ *TraFFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 32 (2001); 15 U.S.C. § 1125(a)(3) (2012).

¹⁷ *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976).

courts have been apprehensive to apply trade dress law to websites.¹⁸ One of the first cases to consider that trade dress protection for a website was possible, *Blue Nile, Inc. v. Ice.com, Inc.*, was not decided until 2007.¹⁹ Consequently, this area remains mostly unexplored by courts.²⁰

Although other cases have arisen since *Blue Nile*, none has proceeded past the trial court level.²¹ Despite the limited decisional law in this area, there are two cases that have become frequently cited in trade dress jurisprudence: *Conference Archives, Inc. v. Sound Images, Inc.* and *Salt Optics, Inc. v. Jand, Inc.*²² *Conference Archives* sets forth a detailed analysis of how to apply trade dress law to websites and finds that such a claim is plausible if pleaded properly.²³ In a similar vein, the *Salt Optics* court suggested that a successful trade dress claim requires a high level of factual support, and then dismissed the plaintiff's trade dress claim for failing to meet that standard.²⁴ The former of these cases, *Conference Archives*, is the subject of this Note.

Focusing on the *Conference Archives* case, this Note will explore trade dress law in the United States and its application to websites. In particular, it analyzes the *Conference Archives* case, which held that trade dress can apply to websites. Part II discusses the different forms of intellectual property protection available in the United States, including utility patents, design patents, copyright, traditional trademarks and trade dress. Part III provides a basic introduction to websites and the principles and concepts that guide website design, creation, and function. Part III also explores how various forms of intellectual property may protect websites. Part IV describes the *Conference Archives* case and evaluates the court's opinion. Part V argues that the court in *Conference Archives* incorrectly held that the functionality doctrine does not bar trade dress protection for websites. Part V also argues that many legal scholars' arguments regarding website trade dress are flawed as well. Part VI explores

¹⁸ See *Blue Nile*, 478 F. Supp. 2d at 1246 (calling trade dress protection of websites a "a novel legal theory").

¹⁹ *Id.* at 1242.

²⁰ See, e.g., Nguyen, *supra* note 15, at 1234; Lisa M. Byerly, *Look and Feel Protection of Web Site User Interfaces: Copyright or Trade Dress?*, 14 SANTA CLARA COMPUTER & HIGH TECH. L.J. 221, 222-24 (1998); Gary Franklin, Esq., Kevin Henry, Esq., *Protecting Your Company's Website: The Application of Intellectual Property to the Digital Marketplace**, 37 VT. B.J. 26 (2011-2012).

²¹ See *Parker Waichman LLP v. Gilman Law LLP*, No. 12-CV-4784 JS AKT, 2013 WL 3863928, at *4, *5 (E.D.N.Y. July 24, 2013); see also *Creative Co-Op, Inc. v. Elizabeth Lucas Co.*, No. CV 11-116-S-REB, 2012 WL 761736, at *2, *3 (D. Idaho Mar. 7, 2012)

²² See *Salt Optics, Inc. v. Jand, Inc.*, No. SACV 10-0828 DOC (RNBx), 2010 WL 4961702 (C.D. Cal. Nov. 19, 2010); see also *Conference Archives, Inc. v. Sound Images, Inc.*, Civ. No. 3:2006-76, 2010 WL 1626072 (W.D. Pa. Mar. 31, 2010).

²³ *Conference Archives*, 2010 WL 1626072, at *16.

²⁴ *Salt Optics*, 2010 WL 4961702, at *5, *7.

how websites may still find strong protection within existing United States intellectual property law.

II. INTELLECTUAL PROPERTY IN THE UNITED STATES

United States law provides many different forms of protection for intellectual property including patents, copyrights, and trademarks.²⁵ To fully comprehend trade dress and the scope of its protections, one must gain a thorough understanding of intellectual property law.²⁶

A. United States Patent Law

1. Utility Patents Basics

Utility patents are awarded to anyone who invents a new and useful process, method, machine, manufacture, or composition of matter.²⁷ The claimed invention must be novel²⁸ and non-obvious,²⁹ and it must comply with the statutory requirements for the patent specification.³⁰

A patent gives the inventor the right to exclude others from making or using the claimed invention for a period of twenty years from the filing date of the application for the patent,³¹ after that time, the patent enters the public domain and the patent owner cannot sue for infringement.³² Patents have been issued for everything from light bulbs,³³ to barcode scanners,³⁴ and to new types of plastic.³⁵

This trade between the inventor, who gains a right to exclude others from making or using his invention for a limited time,³⁶ and the general public, who

²⁵ See 15 U.S.C. § 1052 (2012); 17 U.S.C. § 101 (2012); 35 U.S.C. § 101 (2012).

²⁶ See Franklin & Henry, *supra* note 20.

²⁷ 35 U.S.C. § 101 (2012).

²⁸ See *id.* § 102 (the America Invents Act amended the specific requirements for novelty effective March 16, 2013, but still requires novelty).

²⁹ See *id.* § 103 (the America Invents Act amended the previous Patent Act of 1952 effective March 16, 2013, but still requires non-obviousness).

³⁰ See *id.* § 112 (the America Invents Act amended the previous Patent Act of 1952 effective March 16, 2013, but has similar requisites for the specification).

³¹ *Id.* § 154(a)(2).

³² See *id.* § 154(a)(1). The term can be adjusted, however, under the provisions of 35 U.S.C. § 154(b). *Id.* § 154(b).

³³ US Patent No. 223,898 (filed 1880).

³⁴ US Patent No. 6,119,939 (filed 1998).

³⁵ US Patent No. 8,349,924 (filed 2010).

³⁶ See § 154(a)(2) (providing the limited timeframe of twenty years from the date of filing the application for the patent).

gains the new technical knowledge disclosed in the patent by the inventor, is at the heart of the United States patent system.³⁷ Because of this goal, utility patents are only given to functional designs that increase the technical knowledge available to the public.³⁸ For example, once Edison's light bulb patent expired, anyone could use the technology that was disclosed in the patent.³⁹ Any patent that seeks only to protect a purely ornamental design is invalid.⁴⁰ Design patents, however, were created to protect ornamental designs that are not eligible for utility patent protection.⁴¹

2. Design Patents and Recent Changes in Their Law

An applicant for a design patent must claim a new and original ornamental design.⁴² For example, the famous Coke bottle design received design patent protection.⁴³ The object itself may provide some utility, but the functional elements must be construed out of the claimed design in order to determine any infringement.⁴⁴ Finding a "visual similarity" between the plaintiff's patented design and the defendant's accused infringing design is a key step in the infringement analysis.⁴⁵ As a result, some consider design patents an alternative way to protect designs that cannot be trademarked.⁴⁶

Recently, *Egyptian Goddess, Inc. v. Swisa, Inc.* changed the standard of proving design patent infringement.⁴⁷ The case involved a dispute over whether

³⁷ See Andrew Beckerman-Rodau, *Patents are Property: A Fundamental But Important Concept*, 4 J. BUS. & TECH. L. 87, 93 (2009) ("Absent the ability to assert patent property rights, fewer inventions will be patented and the public storehouse of knowledge will decrease without the public disclosure from those patents.").

³⁸ *Richardson v. Stanley Works, Inc.*, 597 F.3d 1288, 1293-94 (Fed. Cir. 2010), see 35 U.S.C. 35 U.S.C. § 101 (2012) (requiring a new and useful invention).

³⁹ See § 154(a)(2) (providing that twenty years from the date of filing the application for the patent, it would expire and enter the public domain).

⁴⁰ *Richardson*, 597 F.3d at 1293-94.

⁴¹ *Id.*

⁴² 35 U.S.C. § 171 (2012).

⁴³ See US Patent No. D48,160 (filed 1915).

⁴⁴ See *OddzOn Products, Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1405 (Fed. Cir. 1997) ("Where a design contains both functional and non-functional elements, the scope of the claim must be construed in order to identify the non-functional aspects of the design as shown in the patent.").

⁴⁵ *Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571, 1577 (Fed. Cir. 1995) ("The patented and accused designs are compared for overall visual similarity.").

⁴⁶ Jason J. Du Mont & Mark D. Janis, *The Origins of American Design Patent Protection*, 88 IND. L.J. 837, 844 (2013).

⁴⁷ *Egyptian Goddess, Inc. v. Swisa, Inc.* 543 F.3d 655, 678 (Fed. Cir. 2008) (rejecting the "point of novelty" and "non-trivial advance" tests and adopting the "ordinary observer" test as the sole test for whether a design patent has been infringed).

the defendant had infringed the design of the plaintiff's nail buffer, which was disclosed in a design patent.⁴⁸ The Court of Appeals for the Federal Circuit rejected the old "point of novelty test,"⁴⁹ holding that the "ordinary observer test" is the proper test for design patent infringement.⁵⁰ This test considers an ordinary observer who is familiar with prior art designs and decides whether that observer would be deceived by the accused infringing design.⁵¹ This decision and the move to the ordinary observer test were widely seen as making it easier to prove design patent infringement.⁵²

B. United States Copyright Law Fundamentals

Copyright protects "original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device."⁵³ These works can include literary works, musical works, dramatic works or graphical works.⁵⁴ Like patents, copyrights expire after a certain span of time. Usually, this time period is seventy years after the author's death for works published after January 1, 1978.⁵⁵ Also like patent law, copyright law seeks to give the creator of the copyrighted work rights to his or her work for a set time period, until the work passes to the public domain and becomes freely available.⁵⁶

Courts have held that computerized works stored on the Read Only Memory (ROM) of a computer are protectable by copyright.⁵⁷ Copyright protection does not extend to any process, system, or other similar functional thing that embodies the copyrighted work.⁵⁸ However, courts have held that copyright protection

⁴⁸ *Id.* at 668.

⁴⁹ *See id.* at 670-71 (the "point of novelty test" requires the plaintiff who is alleging infringement to point out the novelty in the design that the defendant allegedly copied).

⁵⁰ *See id.* at 676 (adopting the "ordinary observer" test, in which the ordinary observer is assumed to notice the minor differences between the patented design and the alleged infringing design).

⁵¹ *Id.*

⁵² Gene Quinn, *Google Granted Design Patent on Search Webpage*, IP WATCHDOG (Sept. 9, 2009), <http://www.ipwatchdog.com/2009/09/03/google-granted-design-patent-on-search-webpage/id=5512/>.

⁵³ 17 U.S.C. § 102(a) (2012).

⁵⁴ *Id.*

⁵⁵ *Id.* § 302(a).

⁵⁶ *See id.* § 302(e).

⁵⁷ *Apple Computer, Inc. v. Franklin Computer Corp.*, 714 F.2d 1240, 1249 (3d Cir. 1983).

⁵⁸ § 102(b).

extends to source code for computer programs and operating systems.⁵⁹

C. Trademarks in the United States

1. Traditional Trademarks and Basic Governing Law

The Lanham Act defines a trademark as “any word, name, symbol, or device, or any combination thereof...to identify and distinguish... goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.”⁶⁰ Trademarks have no value of their own; they only represent the goodwill of the business they are associated with and not words or use of words.⁶¹ The marks only give its owner the right to protect the goodwill of the business from others.⁶²

Trademarks generally fall into one of four categories that form a continuum: generic, descriptive, suggestive, and arbitrary/fanciful.⁶³ Each category has different requirements for trademark protection; some marks receive automatic protection, while other marks cannot be protected at all.⁶⁴

Generic marks describe a general class of goods, rather than specific goods.⁶⁵ Examples of generic marks include “car” or “chair.” In the case of “car,” giving Toyota exclusive use over the word would severely harm other carmakers like Ford or General Motors. This is because generic marks fail to function as trademarks as required by law. Under the car example, no consumer exclusively associates the word “car” with Toyota, or any specific carmaker for that matter. In other words, generic marks are not source-identifying, and they do not distinguish the product from other similar products.⁶⁶ Generic marks, therefore, cannot be protected or registered.⁶⁷

Descriptive marks describe something about the good, such as a characteristic or ingredient.⁶⁸ An example of a descriptive mark is “Holiday Inn” or “All

⁵⁹ *Apple Computer*, 714 F.2d at 1249; *see also* discussion *infra* Section III, B, 2.

⁶⁰ 15 U.S.C. 1127 (2012).

⁶¹ *See* *Marshak v. Green*, 746 F.2d 927, 929 (2d Cir. 1984).

⁶² *Prestonettes, Inc., v. Coty*, 264 U.S. 359, 368 (1924).

⁶³ *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976).

⁶⁴ *Compare* “generic marks” in *Delaware & Hudson Canal Co. v. Clark*, 80 U.S. 311, 322-323 (1871) (holding that “Lackawanna coal” was not a phrase that could be trademarked), *with* “suggestive marks” in *Stix Products, Inc. v. United Merchants & Mfrs., Inc.*, 295 F. Supp. 479, 488 (S.D.N.Y. 1968) (granting patent to “CON-TACT” for self-adhesive decorating plastics).

⁶⁵ *See* *Sara Lee Corp. v. Kayser-Roth Corp.*, 81 F.3d 455, 464 (4th Cir. 1996).

⁶⁶ *See* *Retail Servs., Inc. v. Freebies Publ'g*, 364 F.3d 535, 538 (4th Cir. 2004).

⁶⁷ *Id.*

⁶⁸ *Miller Brewing Co. v. G. Heileman Brewing Co., Inc.*, 561 F.2d 75, 79 (7th Cir.

Bran.” “Holiday Inn” is descriptive because the hotel chain is the “inn” where travelers stay while on vacation or “holiday.”⁶⁹ Marks that are “merely descriptive” cannot be registered, because they are not inherently distinctive.⁷⁰ A mark that consumers perceive as coming from one source is distinctive,⁷¹ i.e. the mark “has become distinctive of the applicant’s goods in commerce,” and may be protected or registered.⁷² “Holiday Inn” has acquired distinctiveness, because when an individual states, “I’m staying at the Holiday Inn in Washington, D.C.,” most consumers would recognize this name as the well-known national hotel chain.

Distinctiveness⁷³ for descriptive marks is shown if the mark has a secondary meaning.⁷⁴ Factors that demonstrate secondary meaning and thus source-identification,⁷⁵ include consumer testimony and surveys, how long the trademark has been used, advertising, and sales volume.⁷⁶ While all of these factors are important to a secondary meaning analysis, customer surveys are the most effective at demonstrating source-identification and essential to showing secondary meaning.⁷⁷

Suggestive marks are those that require imagination on the part of the consumer to understand the nature of the goods.⁷⁸ Examples of suggestive marks include “Tide” or “Blu-Ray.”⁷⁹ For example, “Tide” does not immediately conjure up notions of doing laundry, but after thinking and imagining, the term may evoke feelings of freshness and cleanliness that are associated with water

1977).

⁶⁹ Custom Vehicles, Inc. v. Forest River, Inc. 476 F.3d 481, 483 (7th Cir. 2007).

⁷⁰ Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 769 (1992).

⁷¹ RESTATEMENT (THIRD) OF UNFAIR COMPETITION U.S. 763, 7

⁷² 15 U.S.C. § 1052 (2012).

⁷³ Distinctiveness can either be inherent or acquired. See the discussion *infra* at 10 for an explanation of inherent distinctiveness. Acquired distinctiveness, or secondary meaning, is an additional meaning that consumers associate with the good or service, and when that occurs, the mark becomes source-identifying. This is called “secondary,” since this new meaning attaches after the descriptive mark is created. See 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 15:1 (4th ed. 1996).

⁷⁴ RESTATEMENT (THIRD) OF UNFAIR COMPETITION ACQUIRED 7.

⁷⁵ See Coca-Cola Co. v. Koke Co. of Am., 254 U.S. 143, 146 (1920) (describing the acquisition of secondary meaning of Coca-Cola, from the Coca leaf and Cola nut, to the soda).

⁷⁶ Spraying Sys. Co. v. Delavan, Inc., 975 F.2d 387, 393 (7th Cir. 1992).

⁷⁷ See, e.g., J & J Snack Foods, Corp. v. Earthgrains Co., 220 F. Supp. 2d 358, 368 (D.N.J. 2002) (permitting survey evidence in a trademark case), see, e.g., Commerce Nat. Ins. Servs., Inc. v. Commerce Ins. Agency, Inc., 214 F.3d 432, 440 (3d Cir. 2000) (allowing customer satisfaction survey to be used as evidence in trademark litigation).

⁷⁸ Stix Products, Inc. v. United Merchants & Mfrs., Inc., 295 F. Supp. 479, 488 (S.D.N.Y. 1968).

⁷⁹ Wal-Mart Stores, Inc. v. Samara Brothers, Inc. 529 U.S. 205, 210 (2000).

and the sea.⁸⁰ Suggestive marks are therefore inherently distinctive,⁸¹ so they may be registered without proving secondary meaning.⁸² As a result, determining whether or not a trademark is descriptive or suggestive is one of the most-contested areas in trademark litigation.⁸³

Arbitrary or fanciful is the final classification of trademark.⁸⁴ Arbitrary marks take a word or symbol and use it in an arbitrary manner with respect to the product, so that it does not describe or suggest the product.⁸⁵ Fanciful marks create a new word or mark to associate with the product or service. Examples of this include “Apple” (applied to computers and other technological products) or “Exxon” (applied to petrochemicals). “Apple” is an arbitrary mark, since the word “apple” existed prior to the mark, but it is now being used to name a technology company in an arbitrary way. “Exxon” is fanciful: the word did not exist before the oil company created the word as its company name.⁸⁶ Like suggestive marks, arbitrary marks are automatically entitled to trademark protection, because they are also inherently distinctive.⁸⁷ Arbitrary or fanciful marks avoid the commonly contested descriptive/suggestive distinction.⁸⁸

These four categories together form a “spectrum” of trademark classifications. The spectrum of trademarks range from generic marks, which provide the least protection, to fanciful marks, which provide the greatest protection.⁸⁹ Marks tending toward the suggestive or arbitrary end of the spectrum are inherently strong and, thus, more likely to survive a challenge in court.⁹⁰ Conversely, protecting a descriptive mark is more difficult because one must show secondary meaning.⁹¹

One common issue that arises in trademark litigation is whether or not color

⁸⁰ *See id.* at 212.

⁸¹ *Star Indus., Inc. v. Bacardi & Co. Ltd.*, 412 F.3d 373, 385 (2d Cir. 2005).

⁸² *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 11 (2d Cir. 1976).

⁸³ *See* B. Brett Heavner and Marcus H.H. Luepke, *Avoiding Trademark Pitfalls in the “Land of the Unlimited Possibilities”*, FINNEGAN (July-Aug. 2008), <http://www.finnegan.com/resources/articles/articlesdetail.aspx?news=72244da2-f0ae-432f-80a8-2f88a8b2bd0c> (determining whether a mark is suggestive or descriptive requires precise evaluation and objective judgment).

⁸⁴ *See, e.g., Abercrombie & Fitch*, 537 F.2d at 9.

⁸⁵ MCCARTHY, *supra* note 73, § 11:4.

⁸⁶ *See* EXXON, Registration No. 922,511.

⁸⁷ *See, e.g., Star Indus., Inc. v. Bacardi & Co. Ltd.*, 412 F.3d 373, 385 (2d Cir. 2005).

⁸⁸ *See, e.g., Abercrombie & Fitch*, 537 F.2d at 11.

⁸⁹ *See* Public Service Co. of New Mexico v. Nexus Energy Software, Inc., 36 F.Supp. 436, 438 (D. Mass. 1999).

⁹⁰ *Nutri/System, Inc. v. Con-Stan Indus., Inc.*, 809 F.2d 601, 605 (9th Cir. 1987).

⁹¹ *Perfect Pearl Co., Inc. v. Majestic Pearl & Stone, Inc.*, 887 F. Supp. 2d 519 (S.D.N.Y. 2012).

can be a trademark. Classifying color somewhere on the trademark spectrum can be difficult.⁹² The Supreme Court tackled this issue in *Qualitex Co. v. Jacobson Products Co., Inc.*⁹³ The plaintiff Qualitex had registered the green-gold color of its dry cleaning pads as a trademark, and the defendant Jacobson began using a similar color in its pads.⁹⁴ Jacobson argued there are special reasons why the law should forbid the use of color alone as a trademark; for instance, if the law were to permit color as a trademark, Jacobson argues that such a result would “produce uncertainty and unresolvable court disputes about what shades of a color a competitor may lawfully use.”⁹⁵

The Court rejected Jacobson’s arguments, finding no reason why color alone could not be protectable as a trademark, so long as that particular color acquired secondary meaning.⁹⁶ A product feature such as color is functional if it is either essential to the product’s use or if it somehow affects the product’s cost or quality.⁹⁷ Colors can meet the requirements of trademarks.⁹⁸ In this case, the dry cleaning pad falls into the arbitrary category. There is no competitive reason why a dry cleaning pad should be green-gold, and the color performs no significant function.⁹⁹

Qualitex illustrates the large range of objects and designs that can be protected by a trademark. If something identifies its source and is not functional, trademark protection is possible.¹⁰⁰ These ideas provide the foundation for a special type of trademark protection: trade dress.

2. Trade Dress: A Special Form of Trademark

Trademark protection can extend not only to words or logos, but to other objects related to a product’s source. Trade dress is a special type of trademark “that originally included only the packaging, or dressing, of a product.”¹⁰¹ However, that definition has expanded over the years to include product design as well.¹⁰² This enlarged definition now encompasses “the total image of a

⁹² *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159, 160-61, 166 (1995).

⁹³ *Id.*

⁹⁴ *Id.* at 161.

⁹⁵ *Id.* at 166-67.

⁹⁶ *Id.* at 163.

⁹⁷ *Inwood Labs, Inc. v. Ives Labs, Inc.*, 456 U.S. 844, 850 n.10 (1982).

⁹⁸ *Qualitex Co.*, 514 U.S. at 166.

⁹⁹ *Id.* at 166 (citing *Qualitex Co. v. Jacobson Products Co., Inc.*, No. CV 90 1183 HLH(JRX), 1991 WL 318798, at *4 (C.D. Cal. Sept. 3, 1991)).

¹⁰⁰ *Inwood Labs*, 456 U.S. at 850-51 nn.10-11.

¹⁰¹ *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 209 (2000) (internal quotations omitted).

¹⁰² *Id.*

product and may include features such as size, shape, color or color combinations, texture, graphics, or even particular sales techniques.”¹⁰³ Under this new definition, trade dress protection has been extended to greeting cards, magazine covers, a bathroom scale, and a variety of other products.¹⁰⁴ However, this expansion led to problems in defining the alleged trade dress.¹⁰⁵

A valid trade dress infringement claim contains three elements: the trade dress is distinctive and identifies its source, there is a likelihood of confusion between the plaintiff’s trade dress and the defendant’s alleged infringing dress, and the trade dress is not functional.¹⁰⁶ Because trade dress protection has the potential to severely limit other businesses in a particular area, courts have required plaintiffs to assert a “concrete expression” of their trade dress.¹⁰⁷ Overly broad trade dress claims can effectively exclude others from using common design elements, and such an exclusion would put competitors at a non-reputation based disadvantage.¹⁰⁸

Like other trademarks, distinctiveness in trade dress may be shown in one of two ways: either the trade dress is inherently distinctive¹⁰⁹ or it has acquired secondary meaning.¹¹⁰ Essentially, a plaintiff must show that his or her trade dress is either arbitrary/fanciful or suggestive in order to show inherent distinctiveness, or that customers have come to associate the descriptive trade dress with that plaintiff, i.e. that the dress has secondary meaning and acquired distinctiveness.¹¹¹

Following from the idea that trade dress must not put the competition at a non-reputation based disadvantage comes the requirement that trade dress cannot protect a functional design.¹¹² Giving one company the exclusive right to a

¹⁰³ John H. Harland Co. v. Clarke Checks, Inc., 711 F.2d 966, 980 (11th Cir. 1983).

¹⁰⁴ Melus, Gregory J., *Trade Dress 2.0: Trademark Protects in Web Design What Copyright Does Not*, AM. INTELLECTUAL PROP. LAW ASS’N. (forthcoming summer 2014) (discussing *Hartford House Ltd. v. Hallmark Cards Inc.*, 647 F. Supp. 1533 (D. Co. 1986) (greeting cards); *Time, Inc. v. Globe Communications Corp.*, 712 F. Supp. 1103 (S.D.N.Y. 1989) (magazine cover); *Health O Meter v. Terrailon Corp.*, 873 F. Supp. 1160 (N.D. Ill. 1995) (bathroom scale)).

¹⁰⁵ *Landscape Forms, Inc. v. Columbia Cascade Co.*, 113 F.3d 373, 381 (2d Cir. 1997); see MCCARTHY, *supra* note 73, § 8:7.25 (“[h]azy and indefinite references to the protectable and allegedly infringed aspect of trade dress in a Web site as its “look and feel” fall far short of the exactitude that is required.”).

¹⁰⁶ *Yurman Design, Inc. v. PAJ, Inc.*, 262 F.3d 101, 115 (2d Cir. 2001); *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 850 n.10 (1982).

¹⁰⁷ *Jeffrey Milstein, Inc. v. Greger, Lawlor, Roth, Inc.*, 58 F.3d 27, 33 (2d Cir. 1995).

¹⁰⁸ *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159, 165 (1995).

¹⁰⁹ *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 766 (1992).

¹¹⁰ *Brunswick Corp. v. Spinit Reel Co.*, 832 F.2d 513, 517 (10th Cir. 1987).

¹¹¹ 15 U.S.C. 1052 (2012).

¹¹² See *id.* § 1125(a)(3) (“the person who asserts trade dress protection has the burden of proving that the matter sought to be protected is not functional”); *Freixenet, S.A. v. Admiral*

functional design is the scope of patent law, not trademarks.¹¹³ Trademarks should only identify the source of the goods or service to the consumer and not preclude competitors the right to use a functional design they would otherwise have the right to use.¹¹⁴

The so-called *Morton-Norwich* factors are useful in determining whether or not the design is functional.¹¹⁵ The factors arose from *In Re Morton-Norwich Products, Inc.*, a case in which the United States Patent and Trademark Office (USPTO) denied registering a trademark for the design of a spray bottle for cleaning products.¹¹⁶ The attorney examining the trademark held that the design of the bottle was functional.¹¹⁷ In reviewing the USPTO's decision, the United States Court of Customs and Patent Appeals considered four factors: the existence of utility patents which disclose the design,¹¹⁸ the existence of advertising touting the design,¹¹⁹ the existence of alternatives,¹²⁰ and the costs of manufacture.¹²¹

The reasoning behind these factors is relatively straightforward. Because utility patents are only awarded for devices or methods that serve a useful purpose,¹²² functionality is inherent to them. Advertisements that tout the design would suggest that the manufacturer of the alleged functional design also considers that design functional.¹²³ A design that severely reduces the number of alternatives or increases costs of manufacture is likely using something that is important to the design of the device, and therefore, the design element is not merely indicative of the designer's goodwill.¹²⁴ Giving a manufacturer an effective monopoly on a design would unfairly disadvantage the trademark owner's competitors. Furthermore, trademarks and trade dress protection can extend indefinitely, so long as they are used in commerce,¹²⁵ whereas patent and copy-

Wine & Liquor Co., 731 F.2d 148, 151 (1984).

¹¹³ *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 34-35 (2001).

¹¹⁴ RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 17 (1995).

¹¹⁵ *In re Morton-Norwich Products, Inc.*, 671 F.2d 1332, 1340-41 (C.C.P.A. 1982).

¹¹⁶ *Id.* at 1332; *see TrafFix Devices, Inc.*, 532 U.S. at 29-30 (finding that expired utility patents do not prevent a finding of functionality, but are strong evidence of functionality).

¹¹⁷ *In re Morton-Norwich Prods.*, 671 F.2d at 1334.

¹¹⁸ *Id.* at 1340-41.

¹¹⁹ *Id.* at 1341.

¹²⁰ *Id.*

¹²¹ *Id.*

¹²² *Id.*; *see Disc Golf Ass'n, Inc. v. Champion Discs, Inc.*, 158 F.3d 1002, 1006 (9th Cir. 1998).

¹²³ *Fisher Stoves, Inc. v. All Nighter Stove Works, Inc.*, 626 F.2d 193, 195 (1st Cir. 1980).

¹²⁴ RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 17 (1995).

¹²⁵ *See* 15 U.S.C. § 1058 (2010) (registration renewable every ten years); *see also Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 1530 (Fed. Cir. 1994) (“[T]rademark

right protection expire after a set period of time.¹²⁶ Extending trade dress protection to a functional design would undermine the goals of patent law.

The mere fact that something can be made in alternative ways does not automatically render the contested design non-functional.¹²⁷ Moreover, the existence of only a few workable alternatives strongly implies a functional design.¹²⁸ Such a situation leads to the fourth factor of cost, by requiring a competitor to design a new and potentially less useful design to avoid trade dress infringement even though such a design is not patented.¹²⁹ The Restatement of Unfair Competition has stated the functional doctrine thusly:

[a] design is ‘functional’ . . . if the design affords benefits in the manufacturing, marketing, or use of the goods or services with which the design is used, apart from any benefits attributable to the design’s significance as an indication of source, that are important to effective competition by others and that are not practically available through the use of alternative designs.¹³⁰

One example that illustrates this concept is the case *Brunswick Corp. v. British Seagull Ltd.*, where the plaintiff, a manufacturer of outboard motors, sought to register the color black for outboard motors as its trade dress.¹³¹ The USPTO and the court both found the use of that color was functional, even though it did not make the motor function better.¹³² Rather, the court and the USPTO found the use of the color black was a “competitive need” in the outboard motor industry, because many other outboard motor manufacturers use black for many different reasons. For example, black “goes well” with most boat colors, allowing it to be used on many more boats than a different colored motor would, and it makes the motor look smaller.¹³³

Functional designs have benefits apart from any source identification and these benefits can be in the use of the design. Restricting use of these functional designs reduces the number of alternatives and unfairly inhibits competition.

The seminal case for trade dress is *Two Pesos, Inc. v. Taco Cabana, Inc.* Taco Cabana operated a chain of Mexican restaurants that featured a unique combination of vivid colors, murals, and paintings to create a festive atmos-

protection is potentially perpetual in duration.”).

¹²⁶ See 35 U.S.C. § 154 (2012) (patent term); see also 17 U.S.C. § 304 (2012) (copyright term).

¹²⁷ See *Application of Honeywell, Inc.*, 532 F.2d 180, 182 (C.C.P.A. 1976) (finding that the existence of alternative thermostat designs does not “detract from the functional character” of the design).

¹²⁸ *Id.*

¹²⁹ *Brunswick Corp.*, 35 F.3d at 1531.

¹³⁰ RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 17 (1995).

¹³¹ *Brunswick Corp.*, 35 F.3d at 1529.

¹³² *Id.* at 1531.

¹³³ *Id.*

phere for patrons.¹³⁴ Shortly thereafter, Two Pesos built restaurants with similar designs and colors.¹³⁵ Taco Cabana sued for trade dress infringement, and Two Pesos argued that Taco Cabana had not shown secondary meaning.¹³⁶

The Supreme Court rejected Two Pesos' argument, finding that Taco Cabana's restaurant design was not descriptive but inherently distinctive.¹³⁷ Like suggestive or arbitrary marks, inherently distinctive marks do not require proof of secondary meaning.¹³⁸ Since the district court found that the trade dress was nonfunctional and inherently distinctive,¹³⁹ any further finding of secondary meaning was unnecessary.¹⁴⁰

Two Pesos is important since it provides guidance for product designers who seek protection for the product's design. The designer must create a nonfunctional and inherently distinctive design, i.e. one that is suggestive or arbitrary/fanciful. Once such a design is created, it will no longer be necessary to prove secondary meaning, since adding that further requirement would have anticompetitive effects on the market.¹⁴¹

III. PROTECTING WEBSITE DESIGN WITHIN CURRENT INTELLECTUAL PROPERTY LAW

With the Internet occupying such an important place in modern society, websites and web design are important aspects of how companies, governments, other organizations and individuals present themselves to the public.¹⁴² With the stakes so high, protecting websites within existing intellectual property law presents a unique challenge to site owners and designers.¹⁴³ Before discussing how different forms of intellectual property might apply to websites, gaining a basic understanding of websites and their components is useful.

¹³⁴ *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 764-65 (1992).

¹³⁵ *Id.* at 765.

¹³⁶ *Id.* at 765-66.

¹³⁷ *Id.* at 774.

¹³⁸ *Id.*

¹³⁹ *Id.* at 766.

¹⁴⁰ *Id.* at 776.

¹⁴¹ *Id.* at 775.

¹⁴² Rob Weatherhead, *Say It Quick, Say It Well – The Attention Span of a Modern Internet Consumer*, THE GUARDIAN (Feb. 28, 2014, 12:40 PM), <http://www.theguardian.com/media-network/media-network-blog/2012/mar/19/attention-span-internet-consumer>.

¹⁴³ Michael Rappa, *Intellectual Property*, MANAGING THE DIGITAL ENTERPRISE, <http://digitallenterprise.org/ip/ip.html> (last visited Aug. 11, 2014).

A. Website Basics and Common Web Design Principles

A website is a “group of connected pages on the World Wide Web containing information on a particular subject.”¹⁴⁴ The World Wide Web sends pages in Hypertext Markup Language (HTML) over the Internet, where web browsers, such as Google Chrome or Mozilla Firefox, read and interpret the HTML code to show the site to the user.¹⁴⁵ Encoded within the HTML are common features of websites, such as formatted text, graphics, search bars, hyperlinks and audio.¹⁴⁶ These features and others combine to form what users see after they type the web address into their web browser.¹⁴⁷

Websites, generally speaking, are a form of graphical user interface (GUI).¹⁴⁸ GUIs are a human-computer interface where the human manipulates items on the computer screen with the mouse or keyboard.¹⁴⁹ GUIs and websites “use...typography, symbols, color, and other static and dynamic graphics ... to convey facts, concepts and emotions.”¹⁵⁰ Several design concepts are used by web designers to organize and communicate information to the user.¹⁵¹ These concepts include consistency, screen layout, relationships between items, navigability, simplicity, clarity, distinctiveness, emphasis, readability,¹⁵² and aesthetics.¹⁵³

Consistency requires internal uniformity throughout the website, as well as external uniformity, which requires a web designer to use existing conventions.¹⁵⁴ For example, the design of the mouse cursor has been used for dec-

¹⁴⁴ THEFREEDICTIONARY.COM, <http://www.thefreedictionary.com/website>.

¹⁴⁵ *Basics of Creating a Website*, U. MICH. <http://www.bus.umich.edu/technology/WebServices/BasicsofCreatingaWebSite.pdf> (last visited Apr. 3, 2014).

¹⁴⁶ *HTML <audio> tag*, W3SCHOOLS.COM, http://www.w3schools.com/tags/tag_audio.asp (last visited Aug. 30, 2014).

¹⁴⁷ *Basics of Creating a Website*, *supra* note 145 (last visited Aug. 11, 2014).

¹⁴⁸ Dmitry Fadeyev, *12 Useful Techniques for Good User Interface Design*, SMASHING MAG. (Jan. 19, 2009), <http://uxdesign.smashingmagazine.com/2009/01/19/12-useful-techniques-for-good-user-interface-design-in-web-applications/> (using GUI design with websites).

¹⁴⁹ *GUI Definition*, LINFO, <http://www.linfo.org/gui.html> (last visited April 3, 2014).

¹⁵⁰ Suzanne Martin, *Effective Visual Communication for Graphical User Interfaces*, WORCESTER POLYTECHNIC INST., http://web.cs.wpi.edu/~matt/courses/cs563/talks/smartin/int_design.html (last visited April 3, 2014).

¹⁵¹ *Id.*

¹⁵² *Id.*

¹⁵³ Dmitry Fadeyev, *8 Characteristics of Successful User Interfaces*, USABILITYPOST.COM (April 15, 2009), <http://www.usabilitypost.com/2009/04/15/8-characteristics-of-successful-user-interfaces/>.

¹⁵⁴ Martin, *supra* note 150.

ades, and departing from this convention would likely confuse users.¹⁵⁵

Screen layout principles seek to arrange the components on the screen in a clear and organized way.¹⁵⁶ A disorganized screen layout is ineffective at directing users to important material, and disorganization can confuse and frustrate a user, which can push that user and others away from the site.¹⁵⁷ For example, a layout using a grid or other similarly organized grouping allows a user to quickly read through all options or content before choosing where to go next.

Emphasizing and linking relationships between closely related items while disassociating unrelated items furthers the goal of good organization.¹⁵⁸ Use of objects like a grid are an effective way to convey related information easily to a site's user.¹⁵⁹ Furthermore, such an organization achieves the functional end of directing the user to important areas of the site.¹⁶⁰

Navigability synthesizes these concepts together, seeking to grab the user's focus when he or she initially reaches the site. After the user has arrived, he or she is then navigated to important information on the site, as well as less important areas.¹⁶¹ All these concepts together seek to enhance and facilitate the user's experience on the site and to ensure the user finds the information and content that he or she is seeking within the website.¹⁶²

Underlying all these design elements is the function of the website. Clarity, for example, should communicate function and meaning so as to aid interaction with the website.¹⁶³ A website that has navigability or layout issues is less functional than one where navigation is obvious and intuitive.¹⁶⁴ Moreover, even something seemingly nonfunctional like aesthetics should "reinforce function."¹⁶⁵ The choice of color, an aesthetic choice in most situations, can have strong functional characteristics in a website.¹⁶⁶ A different color could highlight a changed object, denote the currently open tab, mark different lists, allow a user to customize the site to her preferences, or display site feedback clearly and effectively.¹⁶⁷

¹⁵⁵ *Id.*

¹⁵⁶ *Id.*

¹⁵⁷ Nguyen, *supra* note 15.

¹⁵⁸ See Martin, *supra* note 150 (examples under "Relationships").

¹⁵⁹ *Id.*

¹⁶⁰ *Id.*

¹⁶¹ *Id.*

¹⁶² *Id.*

¹⁶³ Fadeyev, *supra* note 153.

¹⁶⁴ *Id.*

¹⁶⁵ *Id.*

¹⁶⁶ Fadeyev, *supra* note 148.

¹⁶⁷ *Id.*

For example, the Google search page incorporates many of these elements.¹⁶⁸ The page is simple, and the search bar is in the middle of the page, making it absolutely clear where a user is to type the search query.¹⁶⁹ There is very little else on the page, making the site easy to navigate.¹⁷⁰ When the list of results is displayed, previously visited links are denoted with purple text, and sites that have not been visited are displayed with blue text.¹⁷¹ This use of color helps the user remember what sites have already been visited, so the user does not revisit the same site again while searching. All these design elements reinforce the function of web searching.¹⁷²

Most everything on a website is integrated into the site's function.¹⁷³ This permeates the entirety of the site itself — “correct execution and integration of all facets of the site will outweigh the value of a single component.”¹⁷⁴ Even a beginner's site on web design emphasizes the relationship between form and function from the very beginning: “Rule: Make sure the visual form of a site relates to its function.”¹⁷⁵ It is nearly impossible to separate a website's design from its function.¹⁷⁶

B. Intellectual Property Protection for Websites

1. Patents and Utility Patents Offer Levels of Protection for Websites

a. Utility Patents May Protect Functional Software Methods

A website owner may gain patent protection for the functional aspects of his website, provided these are patentable subject matter,¹⁷⁷ useful,¹⁷⁸ novel,¹⁷⁹ non-obvious¹⁸⁰ and meet the statutory requirements of the patent specification.¹⁸¹

¹⁶⁸ GOOGLE, <http://www.google.com> (last visited April 10, 2014).

¹⁶⁹ *Id.*

¹⁷⁰ *Id.*

¹⁷¹ *Id.*

¹⁷² *Id.*

¹⁷³ THOMAS A. POWELL, WEB DESIGN THE COMPLETE REFERENCE, (Mcgraw-Hill/Osborne, 2d ed. 2002), available at <http://webdesignref.com/chapters/01/ch1-08.htm>.

¹⁷⁴ *Id.*

¹⁷⁵ *Id.*

¹⁷⁶ *See Id.* (“There needs to be a clear and continuous relationship between form and function.”).

¹⁷⁷ 35 U.S.C. §101 (2012).

¹⁷⁸ *Id.*

¹⁷⁹ *Id.* § 102.

¹⁸⁰ *Id.* § 103.

¹⁸¹ *Id.* § 112.

However, such an endeavor leads the site owner into the complex realm of software patents. Methods generally are patentable subject matter,¹⁸² and software is patented as a method of performing some operations on a computer-readable medium.¹⁸³ Software patents are controversial, but they still remain a valid form of intellectual property protection.¹⁸⁴ However, software patents have been increasingly subject to more restrictions on their scope.¹⁸⁵ In *Alice Corp. v. CLS Bank International*, the Supreme Court held that abstract ideas implemented on a computer do not translate into a patentable invention.¹⁸⁶ What exactly this means for software patents as a whole remains to be seen, as now more than ever software patents are subject to restrictions that are not fully defined.¹⁸⁷ This uncertainty presents problems for those seeking to protect their intellectual property.

b. Design Patents are a Potential Alternative

The *Egyptian Goddess* case changed the standard for proving design patent infringement. Some viewed this decision as a victory for design patent owners and a more economical cause of action for website owners.¹⁸⁸ In fact, not long after the *Egyptian Goddess* decision, Google obtained a design patent for its search website.¹⁸⁹

Design patents, which require new and novel designs, could be used to protect the overall look and feel of a website.¹⁹⁰ When courts determine the merits of a design patent infringement claim, they evaluate all aspects of the

¹⁸² *Id.* § 100.

¹⁸³ *See, e.g.*, U.S. Patent No. 5,016,009 (filed Jan. 13, 1989) (Claim 1: “[a] method for converting an input data character stream into a variable length encoded data stream in a data compression system, said data compression system”).

¹⁸⁴ *See, e.g.*, Andrew Nieh, *Software Wars: The Patent Menace*, 55 N.Y.L. SCH. L. REV. 295, 296 (2010).

¹⁸⁵ *See, e.g.*, *Bilski v. Kappos*, 561 U.S. 593, 130 S. Ct. 3218, 3227 (2010) (holding that the claimed subject matter is subject to the Machine or Transformation test, i.e. the subject matter must be tied to a particular machine or transform something); *see also* *Diamond v. Diehr*, 450 U.S. 175, 185 (1981) (“Excluded from such patent protection are laws of nature, natural phenomena, and abstract ideas.”).

¹⁸⁶ *Alice Corp. Pty. Ltd. v. CLS Bank Int’l.*, 134 S. Ct. 2347, No. 13-298, slip op. at 16-17 (U.S. June 19, 2014).

¹⁸⁷ *See Bilski*, 561 U.S. 593, 130 S. Ct. at 3226-27 (2010) (holding that while the machine-or-transformation test is useful, it’s not the sole test for determining patent eligibility); *see also* Jason Rantaten, *Alice v. CLS Bank: Claims Invalid Under Section 101*, PATENTLYO (June 19, 2014), <http://patentlyo.com/patent/2014/06/claims-invalid-section.html> (stating that parts of the ruling are “going to tie folks in knots”).

¹⁸⁸ Quinn, *supra* note 52.

¹⁸⁹ *Id.*; *see also* U.S. Patent No. D599,372 (filed Mar. 17, 2006) (issued Sept. 1, 2009).

¹⁹⁰ 35 U.S.C. § 171 (2012).

claimed design. In other words, the construction of the design patent claim avoids the functionality limits on trademarks and trade dress.¹⁹¹ In fact, some courts have suggested this path for other aspiring trademark owners.¹⁹² With software patents in a state of flux,¹⁹³ design patents for websites are a promising alternative.¹⁹⁴

2. Copyright Protects Purely Artistic Elements

Artistic works like graphics, music, or literary works may be protected by copyright.¹⁹⁵ Some courts view “literary works” to include the source code of computer programs and websites.¹⁹⁶ That protection also extends to all expression embodied in the computer.¹⁹⁷

However, copyright protection of the source code is rather limited.¹⁹⁸ To make a valid copyright infringement claim, plaintiffs must show that they own the copyright and that the copyright work was imitated.¹⁹⁹ While seemingly straightforward for works like books or songs, it can cause problems for computer code.²⁰⁰ To establish the second element of infringement, the plaintiff must show that the defendant copied the work and that copying rendered the works substantially similar.²⁰¹ This second prong is significant for computer code, because two different sets of code can create a program or website that look identical to the original and can perform the same functions.²⁰² In other

¹⁹¹ *OddzOn Products, Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1405 (Fed. Cir. 1997).

¹⁹² *Du Mont & Janis*, *supra* note 46.

¹⁹³ *See Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, No. 13-298, slip op. at 16-17 (U.S. June 19, 2014); *see also Bilski v. Kappos*, 561 U.S. 593, 130 S. Ct. 3218, 3226, (2010) (holding that while the machine-or-transformation test is useful, it is, in itself, not a test for determining patent eligibility); *see also Rantaten*, *supra* note 187 (stating that parts of the ruling are “going to tie folks in knots”).

¹⁹⁴ *Quinn*, *supra* note 52.

¹⁹⁵ 17 U.S.C. § 102(a) (2012).

¹⁹⁶ *Computer Assocs. Int’l, Inc. v. Altai, Inc.*, 982 F.2d 693, 702 (2d Cir. 1992) (“It is now well settled that the literal elements of computer programs, i.e., their source and object codes, are the subject of copyright protection.”).

¹⁹⁷ U.S. Copyright Office, *Circular 61.0812: Copyright Registration for Computer Programs*, LIBRARY OF CONGRESS 1 (Aug. 2012), <http://copyright.gov/circs/circ61.pdf>.

¹⁹⁸ *Id.*

¹⁹⁹ *Feist Publ’ns., Inc. v. Rural Tel. Serv. Co., Inc.*, 499 U.S. 340, 361 (1991).

²⁰⁰ *See id.* at 346, 349 (“The primary objective of copyright is not to reward the labor of authors, but “[t]o promote the Progress of Science and useful Arts.”); *see also* U.S. Copyright Office, *supra* note 197, at 1-2.

²⁰¹ *Feist Publ’ns, Inc.*, 499 U.S. at 361.

²⁰² *See id.* at 345-46 (“Originality does not signify novelty; a work may be original even though it closely resembles other works so long as the similarity is fortuitous, not the result of copying.”).

words, copyright only protects the code, not the end result of the code. Therefore, in order to avoid a copyright infringement claim, a potential infringer would just need to write different source code that produces the same end result. For this reason, some website owners have sought trade dress protection in order to safeguard their sites.

3. Attempts to Apply Trade Dress to Websites

In recent years website owners and legal commentators have attempted to apply the principles of trade dress to websites.²⁰³ Because trade dress was created to protect tangible items, applying this legal theory to abstract objects such as websites is a difficult endeavor.

a. The Blue Nile Case

Because website trade dress is a relatively new legal theory, there is sparse case law to support it.²⁰⁴ *Blue Nile, Inc. v. Ice.com, Inc.* was one of the first cases to allow a website trade dress claim to survive a defendant's motion to dismiss. In that case, the plaintiff, Blue Nile, owned several jewelry websites.²⁰⁵ The defendant, Ice.com, also sold jewelry through its own separate website, which allegedly had a very similar look and feel to Blue Nile's site.²⁰⁶ In its complaint, Blue Nile alleged both copyright infringement²⁰⁷ and trade dress infringement.²⁰⁸ Ice moved to dismiss, and posited a trade dress claim under the Lanham Act.²⁰⁹

When considering the motion to dismiss, the court reasoned that more facts were needed when a "novel legal theory" like this was being put forth by the plaintiff.²¹⁰ The court did not give further guidance as to the factual development necessary to assert a successful trade dress claim,²¹¹ and the case was later

²⁰³ See, e.g., *Blue Nile, Inc. v. Ice.com, Inc.*, 478 F. Supp. 2d 1240, 1242 (W.D. Wash. 2007); see also Gene Quinn, *Google Granted Design Patent on Search Webpage*, IP WATCHDOG (Sept. 9, 2009, 1:54 PM), <http://www.ipwatchdog.com/2009/09/03/google-granted-design-patent-on-search-webpage/id=5512/>.

²⁰⁴ MCCARTHY, *supra* note 73, § 8:7.25.

²⁰⁵ *Blue Nile*, 478 F. Supp. 2d at 1243.

²⁰⁶ *Id.*

²⁰⁷ Complaint at 8-10, *Blue Nile, Inc. v. Ice.com, Inc.*, 2006 WL 2376866 (W.D. Wash. 2007) (No. C-06-1002 RSL).

²⁰⁸ *Id.*

²⁰⁹ *Blue Nile*, 478 F. Supp. 2d at 1243.

²¹⁰ *Id.* at 1246.

²¹¹ *Id.*

settled out of court before any additional facts could be discovered.²¹²

b. Legal Scholars Have Considered the Issue in More Depth

Legal commentators have also studied this issue; in fact, the current literature mostly reflects work from legal scholars rather than decided cases or judicial opinions. However, most articles focus on different issues, e.g. the copyright/trade dress distinction²¹³ or distinctiveness.²¹⁴ Functionality is discussed in passing, if at all.²¹⁵

When scholars discuss functionality, it is cast off as a hurdle to trade dress protection for Web sites in one of two ways.²¹⁶ Either commentators note that there are so many alternatives that giving trade dress protection to only one would not substantially reduce the number of available designs,²¹⁷ or authors rely on cases that advocate for a holistic analysis of the alleged trade dress, rather than the individual parts.²¹⁸ Thus, the court's aim is to foster competition when considering whether functionality is a hurdle to trade dress protection.²¹⁹ These views regarding functionality are misguided, since Web sites are more than just a collection of functional elements, and the number of alternatives is not as large as most commentators seem to believe. When analyzed thoroughly, Web sites fail to meet the nonfunctional requirements of trade dress.

IV. THE *CONFERENCE ARCHIVES* CASE AND THE COURT'S OPINION REGARDING WEBSITE TRADE DRESS

Conference Archives, Inc. v. Sound Images, Inc. is one of the first cases to discuss the complex concept of website trade dress protection. The plaintiff, Conference Archives, produced a teleconferencing software that allowed users to stream live video online. The defendant, Sound Images, allegedly violated a

²¹² *Conference Archives, Inc. v. Sound Images, Inc.*, Civ. No. 3:2006-76, 2010 WL 1626072 at *5 (W.D. Pa. Mar. 31, 2010).

²¹³ *See, e.g.*, Byerly, *supra* note 20.

²¹⁴ *See, e.g.*, Nguyen, *supra* note 15.

²¹⁵ *See* Byerly, *supra* note 20; *see also* 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, 163-164 (2007); Rachel Stigler, *Ooey Gui: The Messy Protection of Graphical User Interfaces*, 12 NW. J. TECH. & INTELL. PROP. 215, 42 (2014).

²¹⁶ Byerly, *supra* note 20; *See* *Fuddrucker, Inc. v. Doc GraphicOthers, Inc.*, 826 F.2d 837, 842 (9th Cir. 1987).

²¹⁷ Byerly, *supra* note 20.

²¹⁸ *See* *Fuddrucker, Inc.*, 826 F.2d at 842.

²¹⁹ *See id.* at 842 (citing *Sicilia Di Ri Biebow & Co. v. Cox*, 732 F.2d 417, 429 (5th Cir. 1989) for the proposition that the "ultimate inquiry in functionality analysis is whether protecting a feature will hinder competition.").

non-disclosure agreement it had signed with the plaintiff and recreated Conference Archives' site.²²⁰

Conference Archives moved for summary judgment on the violation of the non-disclosure agreement and violation of intellectual property in its Web site.²²¹ However, the motion contained a “nebulous” discussion of the grounds on which Conference Archives had relied to support its claim.²²² The court then evaluated the various potential theories, eventually discussing trade dress protection for Web sites.²²³ This case was one of the first to analyze what is required, to support a trade dress claim for a Web site, noting three elements of a Web site's “look and feel”: color, orientation and code elements.²²⁴

For the element of color, the court discussed how colors are denoted in Web sites.²²⁵ Web sites use hexadecimal notation to identify over 16,777,216 unique colors.²²⁶ Every color can be made as a mixture of red, green and blue, the primary colors of light and computer displays.²²⁷ A value ranging from zero to 256 is assigned to each color, and these values are interpreted by a computer to obtain the desired color.²²⁸ For example, to give a grayish-blue color, red is given a value of 36, green a value of 104 and blue a value of 160.²²⁹ This three-number coding scheme allows web designers to distinguish colors with a great deal of precision.²³⁰

The court's orientation element considers the placement of the Web site's content within the computer screen.²³¹ The two-dimensional array of pixels that form a computer screen form a coordinate system that allows a Web site designer to place Web site components on the screen.²³² For example, a web designer can place an image or other web object ten pixels from the top of the page and fifty pixels from the left of the page.²³³ Like color, the coordinate system allows a web designer to place objects on the Web site very precisely, down to the specific pixel on the computer screen.²³⁴

²²⁰ Conference Archives, Inc. v. Sound Images, Inc., No. 3:2006-76, 2010 WL 1626072, at *1 (W.D. Pa. Mar. 31, 2010).

²²¹ *Id.* at *2.

²²² *Id.* at *3-4.

²²³ *See id.* at *10, 14-18.

²²⁴ *See id.* at *4-5.

²²⁵ *Id.*

²²⁶ *Id.*

²²⁷ *Id.* at *4.

²²⁸ *Id.*

²²⁹ *Id.*

²³⁰ *Id.* at *5.

²³¹ *Id.*

²³² *Id.*

²³³ *Id.*

²³⁴ *See id.* at *5.

The final element of the court's test was Web site coding.²³⁵ Web sites use HTML "tags" to instruct the computer's web browser what type of object should be displayed on the screen and what features it should have.²³⁶ These objects may include headings, images, paragraphs or links.²³⁷ The court found that "the manner in which the code and tags are arranged directly impact how the page looks and feels."²³⁸

The court then explored just what constitutes the "look and feel" of a website.²³⁹ Look and feel were two different elements of the Web site in the court's opinion. The "look" includes colors, shapes, layouts, typecases, and shapes in the Web site itself,²⁴⁰ while the "feel" includes buttons, boxes, menus, and hyperlinks, which help the user navigate the page.²⁴¹ These create two "critical layers" of a website: the visual design and interface design, which define the look and feel of the site.²⁴²

The court's discussion of functionality focused on color and the existence of alternatives.²⁴³ Specifically, the court noted that "the Supreme Court has held that color is not functional and does not provide a competitive advantage because any color can be used to accomplish a certain functionality."²⁴⁴ The court also concluded that many alternative designs to websites exist, and are not covered by the trade dress claim, and therefore, that the interface should not be considered functional.²⁴⁵

V. CONFERENCE ARCHIVES WAS WRONGLY DECIDED AND LEGAL SCHOLARS HAVE NOT CORRECTLY CONSIDERED WEBSITE FUNCTIONALITY

The court in *Conference Archives* and the legal commentators have not correctly considered functionality in the context of websites. They have misapplied the functional standard, the number of alternatives test, the "as a whole"

²³⁵ *Id.*

²³⁶ Joe Burns, *Web Developer Class: Learn the Basic HTML Tags*, HTMLGOODIES, <http://www.htmlgoodies.com/primers/html/article.php/3478151> (last visited Aug. 25 2014).

²³⁷ *HTML Basic Examples*, W3SCHOOLS.COM, http://www.w3schools.com/html/html_basic.asp (last visited Aug. 10 2014).

²³⁸ *Conference Archives*, 2010 WL 1626072, at *5.

²³⁹ *See id.* at *5-8.

²⁴⁰ *Id.* at *14.

²⁴¹ *Id.*

²⁴² *Id.*

²⁴³ *Id.* at *17.

²⁴⁴ *See id.* (discussing *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159, 165 (1995)).

²⁴⁵ *Id.*

test, and the Supreme Court's ruling in *Two Pesos v. Taco Cabana, Inc.*²⁴⁶ Arguments supporting the nonfunctional nature of websites fail because websites are different than anything before considered for trade dress protection; they are a collection of functional components and joined to make a functional whole.²⁴⁷ They are a visual medium, and users actively interact with that medium when they visit the site. Websites are inherently functional, so trade dress is not a viable form of intellectual property protection for websites.

A. Website Trade Dress When Viewed Through *Two Pesos*

Some have attempted to avoid the functional issues of websites by looking to the *Two Pesos* case, where the Supreme Court found that the design of a restaurant could be protectable trade dress.²⁴⁸ The proponents of this theory argue that the color, orientation and other design elements of a website are analogous to the “vivid color scheme,” “bright awnings,” and “paintings and murals” in *Two Pesos*.²⁴⁹ However, this analogy is faulty; the colors, awnings and artwork in the restaurant at issue in *Two Pesos* are significantly less functional than similar components in a website.

A customer at the *Two Pesos* restaurant can only look at the colors, awnings and artwork; it is a passive experience.²⁵⁰ A user of a website is actively engaged in the website.²⁵¹ Pictures often are clicked to lead to other pages on the site.²⁵² The colors are used to make the site visually pleasing, and more importantly, to direct the user's attention to important parts of the site and to convey the site's information and content to the user actively.²⁵³ Colors of previously visited links change color to help the user remember what links they have already visited.²⁵⁴ These parts of a site are not just “dressing” as their ana-

²⁴⁶ *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 771 (1992); see e.g., MCCARTHY, *supra* note 73, § 8:4 (“To state that something is capable of trade dress protection is hardly the same as concluding that it likely to or has become valid and legally protectable trade dress.”).

²⁴⁷ The court only finds that a trade dress claim for a website is possible, but proving such a claim would be difficult as well. See e.g., MCCARTHY, *supra* note §, 8:4 (“To state that something is capable of trade dress protection is hardly the same as concluding that it likely to or has become valid and legally protectable trade dress.”).

²⁴⁸ *Two Pesos, Inc.*, 505 U.S. at 771.

²⁴⁹ *Id.* at 765-67.

²⁵⁰ *Id.* at 771 (1992).

²⁵¹ See Jakob Nielsen, *Top 10 Mistakes in Web Design*, NN/G NIELSON NORMAN GROUP (Jan. 1, 2011), <http://www.nngroup.com/articles/top-10-mistakes-web-design/> (explaining users preference when visiting websites).

²⁵² See *id.* (explaining why websites like to have their users open new browser windows).

²⁵³ Martin, *supra* note 150.

²⁵⁴ See Nielsen, *supra* note 251 (noting that failure to change the visited link's color is a

logues were in *Two Pesos*; these parts individually perform some function, and they all join together to make the site functional.²⁵⁵

For example, if one of the awnings or pictures in the *Two Pesos* restaurant was missing, customers would still be able to order food and eat. Those dressing elements do not affect the business's function, selling food to its customers. Contrast that situation with a website. If links on a website are broken, the site no longer functions. Users are unable to access parts of the site or the user's browser reports an error and fails to load the site at all. The components and form of a site are so tied to the site's function that very often problems in one portion prevent the entire site from working properly.

B. The Number of Alternative Designs for a Website is Smaller Than Appearances Suggest

Other supporters of website trade dress look to the number of alternatives available to designers. Supporters of this line of reasoning state that because there are many ways to design a website, giving one site rights over its design does not give that particular site an unfair advantage.²⁵⁶ However, this justification for site dress confuses the "number of alternatives" with "number of usable alternatives." In addition, the mere existence of alternatives does not preclude a finding of functionality.²⁵⁷

There are certainly thousands of ways to design a website, but there is a limited realm of usable and effective designs. A good analogy is the number of poker hands (e.g. two-pair, straight, three-of-a-kind) compared to the number of possible hands. The usable site designs are as important to web designers as good hands are to poker players. Giving only one poker player exclusive right to a three-of-a-kind would give that player a large and unfair advantage. Similarly, giving one web designer exclusive use over black letters on a white background would give that designer an unfair advantage. Another designer surely could design a website with yellow letters on a white background, but the tenants of design lead him to avoid such a design, because the user of that site would find the letters very difficult to see and read. There are many possibilities available to a web designer, but the principles of good interface design place strong limitations on those alternatives.²⁵⁸ There are even "industry

common problem in website design).

²⁵⁵ *Two Pesos Inc.*, 505 U.S. at 765.

²⁵⁶ *See, e.g.,* Byerly, *supra* note 20 at 260; *Conference Archives, Inc. v. Sound Images, Inc.*, Civ. No. 3:2006-76, 2010 WL 1626072 at *17 (W.D. Pa. Mar. 31, 2010).

²⁵⁷ *Application of Honeywell, Inc.*, 532 F.2d 180, 182 (C.C.P.A. 1976).

²⁵⁸ *See* Martin, *supra* note 150 (comparing good designs to faulty ones).

standards” that place further limitations on website design.²⁵⁹

Design principles and industry standards inherently reduce the number of alternatives,²⁶⁰ so the “number of alternatives” argument is a mathematical argument at its core.²⁶¹ If the number of design choices is so limited, then the number of alternative ways the site may be arranged is drastically reduced as well. Poor design harms websites because it leads potential users away from the site.²⁶² Forcing competitors to use other designs would put those competitors at a non-reputation based disadvantage that trademark law seeks to avoid.²⁶³

Moreover, the “as a whole” argument is substantially weakened in view of the proper application of the alternatives argument. This holistic argument, that trade dress must be considered as a whole, cannot be applied to websites. The proper test is not “whether individual elements of the trade dress fall within the definition of functional, but to whether the whole collection of elements taken together are functional.”²⁶⁴ This is a very important distinction, and it is the case with websites. All parts of the website aid the user to interact with the site and direct that user to where he or she wants to go.²⁶⁵ If one concedes that the individual components of a website are “functional,” precepts of website design indicate that the whole of such parts must be “functional” as well.²⁶⁶ Therefore, the holistic argument also fails. Even when considered as a whole, websites are still functional.

²⁵⁹ Nguyen, *supra* note 15; *see* Powell, *supra* note 173, at 19 (“Designers need to respect conventions of navigation choices, navigation placement, colors, and so on.”); *see also* MCCARTHY, *supra* note 73, § 8:4 (“[I]t is probable that few Web sites have an appearance that is so unusual or distinctive that it can constitute what might be called protectable ‘web dress’ or ‘site dress’.”).

²⁶⁰ Nguyen, *supra* note 15; *see also*, Powell *supra* note 173 at 19 (“Designers need to respect conventions of navigation choices, navigation placement, colors, and so on.”); *see also* MCCARTHY, *supra* note 73, § 8:4 (“[I]t is probable that few Web sites have an appearance that is so unusual or distinctive that it can constitute what might be called protectable ‘web dress’ or ‘site dress’.”).

²⁶¹ Nguyen, *supra* note 15; *see* Powell, *supra* note 173, at 19 (“Designers need to respect conventions of navigation choices, navigation placement, colors, and so on.”); *see also* MCCARTHY, *supra* note 73, § 8:4 (“[I]t is probable that few Web sites have an appearance that is so unusual or distinctive that it can constitute what might be called protectable ‘web dress’ or ‘site dress’.”).

²⁶² Nguyen, *supra* note 15.

²⁶³ *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 27-28, 32-33 (2001).

²⁶⁴ *Fuddrucker, Inc. v. Doc’s B.R. Others, Inc.*, 826 F.2d 837, 842 (9th Cir. 1987).

²⁶⁵ *See* Nielsen, *supra* note 251 (noting that failure to change the visited link’s color is a common problem in website design).

²⁶⁶ Martin, *supra* note 15 (explaining how to make the interface of a website more conducive to the internet user).

C. Web Design is Not Arbitrary

Courts have looked to whether the purported design as a whole is arbitrary and nonfunctional, as well as whether the design limits the number of alternative designs when assessing trade dress claims.²⁶⁷ As discussed above, the number of alternatives is not applicable to websites. Design principles severely limit the number of alternatives, and competitors who are excluded from using certain design elements by a trade dress claim are placed at a non-reputation based disadvantage.²⁶⁸

The design of websites is not arbitrary, either. In the process of website creation, web designers constantly make decisions about functionality.²⁶⁹ Throughout this process, they employ key concepts like consistency, navigability, simplicity or clarity, which combine to make the site function.²⁷⁰ Websites are a collection of functional elements, but in combination, the elements form a functional whole that cannot be protected by trade dress.²⁷¹

D. The *Conference Archives* Court's Reasoning Was Flawed

Applying the reasoning of legal commentators and other courts, the court in *Conference Archives* determined whether trade dress law applies to websites. The court's reasoning treated the look and feel of a website separately.²⁷² The "look" was defined as the "graphic treatment or interface elements," while the "feel" was the "dynamic navigation elements, including buttons, boxes, menus and hyperlinks."²⁷³ The court reasoned that these elements together form a protectable trade dress that creates "a graphical user interface that promotes the intuitive use of the web site."²⁷⁴

The court dismissed website functionality by using the number of alternatives argument, the holistic argument, and two other key points. First, the court stated that "a web site may be protectable as trade dress if the site as a whole identifies its owner as the creator or product source."²⁷⁵ Second, "the look and

²⁶⁷ *Clicks Billiards, Inc. v. Sixshooters, Inc.*, 251 F.3d 1252, 1259, 1261 (9th Cir. 2001).

²⁶⁸ *TrafFix Devices*, 532 U.S. at 27-28, 32, 33.

²⁶⁹ See Fadeyev, *supra* note 148.

²⁷⁰ Martin, *supra* note 15.

²⁷¹ *Fuddruckers, Inc. v. Doc's B.R. Others, Inc.*, 826 F.2d 837, 842 (9th Cir. 1987).

²⁷² *Conference Archives, Inc. v. Sound Images, Inc.*, Civ. No. 3:2006-76, 2010 WL 1626072 at *14 (W.D. Pa. Mar. 31, 2010).

²⁷³ *Id.*

²⁷⁴ *Id.* at *15.

²⁷⁵ *Id.* at *17 (internal quotations omitted) (quoting Kurt M. Saunders, *Tradesite Or Web Dress?: Trade Dress Protection For Website Interfaces*, ACAD. OF LEGAL STUD. IN BUS., <http://alsb.roundtablelive.org/Resources/Documents/NP%202001%20Saunders.pdf> (last

feel of a page might be functional if it made viewing the site owner's goods more efficient or facilitated the placing of orders on the owner's site,²⁷⁶ but so long as there are alternatives, the site should not be considered functional.²⁷⁷

The first of these arguments merely recites the "secondary meaning" requirement of descriptive trademarks.²⁷⁸ However, the presence of secondary meaning does not negate the non-functional element of trademark protection, nor does secondary meaning necessarily require that the object possessing that meaning be non-functional.²⁷⁹ The three factors of a trade dress claim must be considered independently; the non-functional element is independent of secondary meaning or source identification.²⁸⁰ An analysis of secondary meaning happens independently of the functionality analysis, and vice versa.²⁸¹

The court's second argument, which alleges that a site can be functional in a limited sense, again relies on the faulty "number of alternatives" argument to avoid a finding of functionality. However, the court's seemingly narrow concession of functionality is in fact a broad admission when viewed through the concepts and established principles of website design.²⁸²

Essentially, the court's argument boils down to efficiency and facilitation.²⁸³ These concepts are at the core of good interface design.²⁸⁴ Objectives like consistency, screen layout, relationships between items, navigability, simplicity, clarity, distinctiveness, emphasis and readability²⁸⁵ each play a role to make a site more efficient and to facilitate the purpose of the site.²⁸⁶ For example, a

visited Aug. 27, 2014).

²⁷⁶ *Conference Archives, Inc.*, 2010 WL 1626072 at *17 (internal quotations omitted).

²⁷⁷ *See id.* (discussing Lisa M. Byerly, *Look And Feel Protection Of Web Site User Interfaces: Copyright Or Trade Dress?*, 14 SANTA CLARA COMPUTER & HIGH TECH. L.J. 221, 260 (1998)).

²⁷⁸ *See id.* (internal quotations omitted) (quoting Kurt M. Saunders, *Tradesite Or Web Dress?: Trade Dress Protection For Website Interfaces*, ACAD. OF LEGAL STUD. IN BUS., <http://alsb.roundtablelive.org/Resources/Documents/NP%202001%20Saunders.pdf> (last visited Aug. 27, 2014)); *see also* 15 U.S.C. § 1052(f) (2012) (secondary meaning).

²⁷⁹ *See Yurman Design, Inc. v. PAJ, Inc.*, 262 F.3d 101, 115–16 (2d Cir. 2001) (quoting *TrafFix Devices, Inc. v. Mtkg. Displays, Inc.*, 532 U.S. 23, 32 (2001) (reciting three elements for a trade dress claim, not three factors)).

²⁸⁰ *Fun-Damental Too v. Gemmy Indus. Corp.*, 111 F.3d 993, 1002 (2d Cir.1997).

²⁸¹ RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 13 (1995) (listing the individual elements of a trade dress claim).

²⁸² *See Conference Archives*, 2010 WL 1626072 at *17 (internal quotations omitted) ("The look and feel of a page might be functional if it made viewing the site owner's goods more efficient or facilitated the placing of orders on the owner's site.").

²⁸³ *Id.* (internal quotations omitted) ("The look and feel of a page might be functional if it made viewing the site owner's goods more efficient or facilitated the placing of orders on the owner's site.").

²⁸⁴ Martin, *supra* note 150.

²⁸⁵ *Id.*

²⁸⁶ *Id.*

proper screen layout combined with simple relationships between items would assist the user in finding the most important links on the site quickly and efficiently. This is an important goal for all websites and web designers. Any site, be it sports, blogs, weather forecasts, streaming video, banking, or anything in between wants to facilitate the user finding its important content efficiently.²⁸⁷

This view is supported by the court's own reference to the Restatement (Third of Unfair Competition).²⁸⁸ The Restatement of Unfair Competition states that a design is functional, if it

[A]ffords benefits in the ... use of the goods or services with which the design is used, apart from any benefits attributable to the design's significance as an indication of source, that are important to effective competition by others and that are not practically available through the use of alternative designs.²⁸⁹

This is the case with websites and web design.²⁹⁰ Giving one site exclusive use of design elements or industry standards is giving the site benefits apart from its indication of source.²⁹¹ Nearly every site uses the same concepts of design to make the site more useable, efficient and functional.²⁹²

The court also discusses color in the context of websites, noting that "color is not functional and does not provide a competitive advantage because any color can be used to accomplish a certain functionality."²⁹³ This argument relies on the *Qualitex* case discussed previously, but it mischaracterizes the Supreme Court's rationale. The *Qualitex* case concerned the coloring of dry cleaning pads. The Court correctly held that they had no "obvious theoretical objection to the use of color alone as a trademark."²⁹⁴ Contrary to the court's statement in *Conference Archives*, in *Qualitex*, the Supreme Court noted that color can only be a trademark when it performs no "significant function."²⁹⁵

The respondent in *Qualitex* argued that "color depletion" was one of the fundamental problems with color trademarks.²⁹⁶ This situation arises when the use of color so severely reduces the number of alternative colors available to

²⁸⁷ Powell, *supra* note 173, at 17-19.

²⁸⁸ *Conference Archives*, 2010 WL 1626072 at *17, n.50.

²⁸⁹ RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 17 (1995).

²⁹⁰ See Jessica Goldenberg, *Trade Dress Can be Viable Means of Protecting Websites from Competitor's Look-Alike Sites*, PROSKAUER NEW MEDIA AND TECH. L. BLOG (Nov. 7, 2013), <http://newmedialaw.proskauer.com/2013/11/07/trade-dress-can-be-viable-means-of-protecting-websites-from-competitors-look-alike-sites/> (explaining the recent holding of Louisiana courts position on "trade dress").

²⁹¹ *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165 (1995).

²⁹² Powell, *supra* note 173, at 19.

²⁹³ *Conference Archives*, 2010 WL 1626072 at *17 (discussing *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159, 165 (1995)).

²⁹⁴ *Qualitex Co.*, 514 U.S. at 163.

²⁹⁵ *Id.* at 166.

²⁹⁶ *Id.*

competitors that those competitors cannot find a suitable color to use for their product and are placed at an unfair advantage.²⁹⁷ The Court did not find that situation to have arisen in the context of dry cleaning pads, but noted that if the problem did arise in the future, the “doctrine of functionality normally would seem available to prevent the anticompetitive consequences....”²⁹⁸

This has significant implications for websites, because color is a vital part of site design.²⁹⁹ Colors in websites are used in a functional way; they “are used to convey facts, concepts and emotions.”³⁰⁰ As *Qualitex* contemplates, limiting the types of color available for websites would place others at a severe disadvantage.³⁰¹ Therefore, the *Conference Archives* court erred in its decision that colors should be discarded as nonfunctional.

If websites fail to meet the non-functionality element of trade dress protection, it follows that any pleading or case that advocates for such protection must fail as well.³⁰² Arguments like the “number of alternatives” or the “holistic” argument fail upon application to websites. Colors serve a functional purpose in sites, and granting trade dress to website colors would place competitors at a disadvantage. Trade dress is not a viable form of intellectual property protection for websites.

VI. PROPOSAL

Websites are inherently functional and should be barred from receiving trade dress protection.³⁰³ Viewing the site as a whole or looking to the number of alternatives does not change the fact that websites perform functions that are intimately connected to their design.³⁰⁴ The *Conference Archives* court and others are incorrect for considering the possibility of website trade dress protection. Even without trade dress, site owners still have avenues available to protect their sites. These options include design patents, copyrights, and utility

²⁹⁷ *Id.* at 168 (internal quotations omitted).

²⁹⁸ *Id.* at 169.

²⁹⁹ See Nielsen, *supra* note 251 (noting that failure to change the visited link’s color is a common problem in website design and the color of visited links is important to user navigation); see also Martin, *supra* note 150 (navigability is a design concept).

³⁰⁰ Martin, *supra* note 150.

³⁰¹ *Qualitex Co.*, 514 U.S. at 169.

³⁰² See *Yurman Design, Inc. v. PAJ, Inc.*, 262 F.3d 101, 116-17 (2d Cir.2001) (quoting *TraFFix Devices, Inc. v. Mtkg. Displays, Inc.*, 532 U.S. 23, 32 (2001) (reciting three elements for a trade dress claim, not three factors)).

³⁰³ *Id.* at 116 (quoting *TraFFix Devices, Inc. v. Mtkg. Displays, Inc.*, 532 U.S. 23, 32 (2001) (reciting three elements for a trade dress claim, not three factors)).

³⁰⁴ *Conference Archives, Inc. v. Sound Images, Inc.*, Civ. No. 3:2006-76, 2010 WL 1626072 at *14-21 (W.D. Pa. Mar. 31, 2010) (providing the court’s full discussion of website trade dress).

patents. Together, these three forms of intellectual property form a strong basis of protection for websites.

As previously discussed, design patents are given to novel and functional designs.³⁰⁵ This is important for websites, as any functional aspects are construed out of the design.³⁰⁶ As a result, website owners can receive protection for the design aspects of the site without overreaching into functional protection and undermining the goals of patent law. Design patents remain the most promising alternative to trade dress protection for website design.³⁰⁷

In fact, several popular sites have received design patent to protect their sites. These include Google,³⁰⁸ Facebook,³⁰⁹ Microsoft,³¹⁰ Amazon,³¹¹ and Yahoo!.³¹² These design patents cover the arrangement, spacing, and orientation of the various components of the different sites.³¹³ With the adoption of the “ordinary observer test” for design patents,³¹⁴ proving infringement has become easier.³¹⁵ Design patents provide protection for the aesthetic aspects of the website without the need to argue non-functionality.³¹⁶

Copyright, in contrast with design patents, protects the actual computer code itself. Websites are designed using HTML or XML, and the lines of source code can be copyrighted.³¹⁷ While limited in scope, copyright protects against the outright stealing of source code.

Finally, utility patents are available for novel and nonobvious functions.³¹⁸ These functions must be claimed as a method, while satisfying the Machine or Transformation test, i.e. that the method performs a transformation or is tied to

³⁰⁵ 35 U.S.C. § 171 (2012).

³⁰⁶ See *OddzOn Products, Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1405 (Fed. Cir. 1997) (“Where a design contains both functional and non-functional elements, the scope of the claim must be construed in order to identify the non-functional aspects of the design as shown in the patent.”).

³⁰⁷ *Du Mont & Janis*, *supra* note 46, at 844.

³⁰⁸ U.S. Patent No. D599,372 (filed Mar. 7, 2006) (issued Sept. 9, 2011).

³⁰⁹ U.S. Patent No. D695,304 (filed Dec. 23, 2011) (issued Dec. 10, 2013); U.S. Patent No. D691,622 (filed Oct. 4, 2011) (issued Oct. 15, 2013).

³¹⁰ U.S. Patent No. D664,969 (filed Jan. 21, 2011) (issued Aug. 7, 2012); U.S. Patent No. D665,396 (filed Sept. 14, 2010) (issued Aug. 14, 2012).

³¹¹ U.S. Patent No. D571,819 (filed Mar. 30, 2007).

³¹² U.S. Patent No. D622,280 (filed Jun. 16, 2008) (issued Aug. 24, 2010); U.S. Patent No. D589,970 (filed Mar. 22, 2008) (issued Apr. 7, 2009).

³¹³ MPEP Ch. 1500 § 1502 (9th ed, Mar. 2014).

³¹⁴ *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 670 (Fed. Cir. 2008).

³¹⁵ *Quinn*, *supra* note 52.

³¹⁶ *Id.*

³¹⁷ *Apple Computer, Inc. v. Franklin Computer Corp.*, 714 F.2d 1240, 1249 (3d Cir. 1983).

³¹⁸ 35 U.S.C. § 102 (2012); *id.* § 103.

a particular machine.³¹⁹ While becoming increasingly difficult,³²⁰ different websites such as Facebook,³²¹ Google,³²² and Amazon³²³ have received utility patent protection for novel computerized methods on their websites.³²⁴

Taken as a whole, these three forms of intellectual property protection will protect the source code, aesthetic design, and function of a website. Viewed this way, trade dress protection clearly encroaches upon these areas. While securing these protections might be costly, both in time and money, they still provide a strong defense against potential copiers. Add in the proper forms of trademark protection that the websites may receive, such as for the site name or logo, and it is clear that websites have a broad base of protection for their site designs.

Limiting website intellectual property protection to only these forms also serves the public at large. Trademarks and trade dress protection have no expiration date, so long as the owner of the trademark or trade dress continue to use it in commerce.³²⁵ Copyright,³²⁶ design patents,³²⁷ and utility patents³²⁸ all have defined expiration dates; after those dates the protected property enters the public domain. Internet technology and websites change rapidly. Giving one company or website exclusive use of a non-novel function or design that ordinarily would not be eligible for these forms of protection indefinitely may harm the marketplace of website designs.

The current limited time-duration protection available for websites provides proper protection and incentivizes other companies to create new and innovative designs in order to compete. For every Google, there is a Bing; for every Twitter, there is a Tumblr. The competition between these sites fosters new and exciting developments and creations. Inhibiting that competition by improperly giving indefinite legal protection to website trade dress would damage the innovative culture at the heart of the Internet.

³¹⁹ *Bilski v. Kappos*, 561 U.S. 593, 130 S. Ct. 3218, 3224 (2010).

³²⁰ *CLS Bank Int'l. v. Alice Corp. Pty. Ltd.*, 717 F.3d 1269, 1281 (Fed. Cir. 2013); *see also Bilski v. Kappos*, 561 U.S. 593 (2010) (the Machine or Transformation test is not the sole test for determining patent eligibility, but is a useful test); *see Rantaten, supra* note 187 (stating that parts of the ruling are “going to tie people in knots”).

³²¹ U.S. Patent No. 8,631,084 (filed Mar. 7, 2007) (issued Sept. 1, 2009).

³²² U.S. Patent No. 8,635,518 (filed July 21, 2011) (issued Jan. 24, 2014).

³²³ U.S. Patent No. 5,960,411 (filed Sept. 12, 1997).

³²⁴ 8,631,084, *supra* note 321.

³²⁵ *See* 15 U.S.C. § 1059 (2012) (registration renewable every ten years); *see also Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 1530 (Fed. Cir. 1994) (“[T]rademark protection is potentially perpetual in duration.”).

³²⁶ 17 U.S.C. § 302(a) (2012).

³²⁷ 35 U.S.C. § 173 (2012) (14 years from the date of grant).

³²⁸ *See id.* § 154(a)(2) (twenty years from the date of filing the application for the patent, it would expire and enter the public domain).

VII. CONCLUSION

Courts often struggle to catch up with advances in technology. With the Internet constantly evolving, the courts often try to find novel ways to protect new technologies with outdated laws. This explains the court's willingness to consider extending trade dress law to websites.

Trade dress law is well-settled on the matter of functionality. Functional design cannot receive trade dress protection. Those who have argued for trade dress protection for websites do not fully appreciate the functional elements and design principles that tie those elements together when a website is created. These principles place site functionality at the center of what the designer tries to do while creating the site.

Site design and function are intertwined, and it is impossible to separate the two from each other. The simple truth is that websites are functional. They are an arrangement of functional elements, but they are also a functional whole made up of those elements. As a result, trade dress protection cannot be available for websites. Steve Jobs had it right, especially in regard to websites, when he said that design is how something works, not just what it looks like.³²⁹ Website design is how the website works. All is not lost for websites and web designers, however. If design components of websites are truly functional, then utility patents are still available for innovative functional designs and features.³³⁰ New advancements in design patents offer hope for ornamental design elements.³³¹ And copyright is always available to protect the purely artistic elements and the source code.³³²

Like the Internet and technology, the law must always grow and change to adapt to new problems. The law must also explore all avenues to achieve justice for those that require it. Not all avenues will yield results, however, and this particular avenue should be closed off.

³²⁹ Rob Walker, *The Guts of a New Machine*, N.Y. TIMES ARCHIVES, Nov. 30, 2003, <http://www.nytimes.com/2003/11/30/magazine/the-guts-of-a-new-machine.html>.

³³⁰ § 101.

³³¹ *Id.* § 171.

³³² *Apple Computer, Inc. v. Franklin Computer Corp.*, 714 F.2d 1240, 1249 (3d Cir. 1983).