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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

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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

Keywords

Trade, Trade dress protection, internet, web site

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

XUAN-THAO N. NGUYEN*

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INTRODUCTION

In the e-commerce world, a company's web site¹ becomes the primary communication center with the customer.² The web site is where the company displays products, presents marketing materials, and provides sales and post-sales support.³ Increasingly, companies are spending valuable resources to build and maintain their web sites.⁴ With the rapid change in web technology, many web sites now feature more than just ordinary text. Color, clipart, graphics, designs, animations, and sounds are now part of the overall appearance of web sites.⁵ Yet copying an image from a web site is just one click away.⁶ What protection is available to the overall appearance of a web site? What protection do consumers of e-commerce expect to receive when they purchase a product from a web site? What if consumers are confused because two sites have the same appearance?

Consider a scenario where two innovative companies of modest size coexist in the network economy almost side-by-side without substantial friction. The first company's domain name is customdisc.com and the second company uses customdiscs.com for its domain name.⁷ It is perfectly legal for both companies to have

1. While there are some differences between the Internet and the World Wide Web, for purposes of this Article, web sites and Internet sites are used interchangeably. *See generally* TIM BERNERS-LEE, *WEAVING THE WEB* 35-48 (1999) (explaining the development of the World Wide Web and its interaction with the Internet).

2. *See* JAKOB NIELSEN, *DESIGNING WEB USABILITY* 14 (2000) (arguing that customer usability is critical for the success of a web site because for many consumers, the web site is their only contact with the company).

3. *See id.* (observing that for e-commerce companies the site "is the company. The user interface becomes the marketing materials, store front, store interior, sale staff, and post-sale support all rolled into one.").

4. *See* John Foley, *Online Service Before Datamining*, *INFORMATIONWEEK*, May 3, 1999, available at 1999 WL 2105390, INFWK, File No. 125 (reporting that many businesses now spend millions of dollars on web sites so that they may conduct e-commerce).

5. *See* Bernard J. Hibbitts, *Changing Our Minds: Legal History Meets the World Wide Web*, 17 *LAW & HIST. REV.* 385, 386 (1999) (advocating the use of the web and its multimedia capacity for a transformation of legal history as a discipline).

6. *See* DARRELL SANO, *DESIGNING LARGE-SCALE WEB SITES, A VISUAL DESIGN METHODOLOGY* 77 (1996) (explaining that it only takes seconds to copy images found on the Internet).

7. *Compare* imix.com, Inc., at <http://www.customdisc.com> (last visited Feb. 7, 2000) (a Connecticut company selling custom made compact discs online), *with* Custom CD Corp., at <http://www.customdiscs.com> (last visited Feb. 7, 2000) [hereinafter *Custom Discs*] (a Canadian company selling custom-made compact discs in the United States).

such similar domain names.⁸ Both companies sell make-it-yourself music compact discs⁹ where visitors may create their own music compact discs containing their favorite songs.¹⁰ What if customdisc.com decided to adopt the overall appearance of customdiscs.com's web site? Would there be consumer confusion? Does customdisc.com's conduct result in an unfair competition? What legal rights does customdiscs.com have to protect itself from such unfair competition? Is this another "classic illustration of a new kind of litigation for which nothing in past experience comes even close to preparing trial judges and the advocates appearing before them?"¹¹

This Article analyzes the challenges created by the Internet environment, from the overall look and feel of web sites, to whether trade dress protection should be extended to web sites. An overview of trade dress law in Part I provides an understanding of the current expansion of trade dress protection. Part II discusses challenges to creating and maintaining the distinctive overall look and feel of a web

8. See Sally M. Abel, *Trademark Issues in Cyberspace: The Brave New Frontier*, 451 PLI/Pat. 151, 155-56 (1996) (discussing the problems created by similar domain names). There are numerous similar domain names on the Internet. See, e.g., Imagemaker Technologies, at <http://www.imagemaker.com> (last visited Mar. 28, 2000) (Iowa company marketing design, publications, and applications on the web); Imagemakers, at <http://www.imagemakers.com> (last visited Mar. 28, 2000) (Rhode Island company providing design services for traditional media and the web); The ImageMaker, at <http://www.theimagemaker.com> (last visited Sept. 18, 2000) (Missouri company providing copying, computer services, and web page design).

9. See *supra* note 7 (providing services on web sites where visitors may create custom-made compact discs).

10. See *id.* (allowing customers to select each song they want for their compact discs).

11. See *Niton Corp. v. Radiation Monitoring Devices, Inc.*, 27 F. Supp. 2d 102, 103, 52 U.S.P.Q.2d (BNA) 1380, 1380-81 (D. Mass. 1999) (illustrating the difficulty of arguing and deciding fair trademark issues in the Internet environment). Judge Keeton asked that question in a trademark infringement litigation involving metatags in the following scenario:

Two innovative enterprises of modest size are coexisting almost side-by-side without friction. They are not in direct competition. Each, however, has possibilities for success and expansion. The success of both will, some months or years away, bring them to competing with each other and with larger entities whose operations may, by then, be international or global in scope.

Enter upon this tranquil scene the Internet and its inducements to each of the two modest enterprises to obtain web sites. They do so, and soon begin to worry about each other. As they learn more, one comes into a United States district court with a complaint and prayer for preliminary injunction against the other One soon learns, by chance, that the other's web sites and means of attracting Internet users to them are deceptive and immediately harmful.

Id. Judge Keeton concluded that "court intervention is appropriate but not in a classic form of preliminary injunction . . . my order is more provisional and tentative in nature and is entitled Preliminary Injunction Subject to Modification." *Id.*

site required for trade dress protection. A web site with an overall “look and feel” that overcomes the challenges of the Internet environment must pass the muster of trade dress law such as inherent distinctiveness, secondary meaning, and functionality. The inquiry, however, does not end there; the protectable “look and feel” of a web site is additionally subject to the likelihood of confusion test. Parts III, IV, V and VI discuss the four cornerstones of trade dress law, distinctiveness, secondary meaning, functionality, and likelihood of confusion, respectively, and apply these concepts to web sites and the Internet environment. The Article argues, in Parts IV and VI, that the traditional inquiries of secondary meaning and likelihood of confusion should be modified to be applicable within the Internet context. Part VII analyzes the harms and benefits of extending trade dress protection to web sites. The Article concludes that to encourage competition and protect both consumers and businesses on the Internet, trade dress protection should be extended to web sites with an inherently distinctive and non-functional overall look and feel.

I. OVERVIEW OF TRADE DRESS LAW

Trade dress is broadly defined as the total image and overall appearance of a product or service.¹² Trade dress may include features such as size, shape, color or color combinations, texture, graphics, or even particular sales techniques.¹³ Trade dress has been held to include the appearance of a video game console,¹⁴ the overall look of greeting cards,¹⁵ the layout and appearance of a mail order catalogue,¹⁶ and the overall look of sales brochures and reminder

12. See *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 764 n.1, 23 U.S.P.Q.2d (BNA) 1081, 1082 (1992) (explaining that trade dress is the total image and overall appearance of the product (quoting *Blue Bell Bio-Medical v. Cin-Bad, Inc.*, 864 F.2d 1253, 1256, 9 U.S.P.Q.2d (BNA) 1870, 1872 (5th Cir. 1989))).

13. See *id.* (quoting *John H. Harland Co. v. Clarke Checks, Inc.*, 711 F.2d 966, 980, 219 U.S.P.Q.2d (BNA) 515, 528 (11th Cir. 1983)).

14. See *M. Kramer Mfg. Co. v. Andrews*, 783 F.2d 421, 447-50, 228 U.S.P.Q. (BNA) 705, 725 (4th Cir. 1986) (finding the similar appearance of video poker games to be trade dress infringement).

15. See *Roulo v. Russ Berrie & Co.*, 886 F.2d 931, 937, 12 U.S.P.Q.2d (BNA) 1423, 1430 (7th Cir. 1989) (holding that although particular elements of cards are not protected, the layout and overall design of a greeting card could receive trade dress protection); *Hartford House, Ltd. v. Hallmark Cards, Inc.*, 647 F. Supp. 1533, 1545, 1 U.S.P.Q.2d (BNA) 1030, 1038 (D. Colo. 1986) (granting preliminary injunction to plaintiff because defendant's cards were deceptively and confusingly similar overall), *aff'd*, 846 F.2d 1268, 6 U.S.P.Q.2d (BNA) 2038 (10th Cir. 1988).

16. See *Tools USA & Equip. Co. v. Champ Frame Straightening Equip., Inc.*, 87 F.3d 654, 662, 39 U.S.P.Q.2d (BNA) 1355, 1357 (4th Cir. 1996) (holding that a tool and equipment catalog satisfied the three elements necessary for trade dress protection).

letters sent by auto repair shops to customers.¹⁷ A trade dress is entitled to protection under the Lanham Act¹⁸ if it is inherently distinctive or has acquired secondary meaning.¹⁹

Unlike trademarks,²⁰ trade dress that is either inherently distinctive or has acquired distinctiveness does not enjoy protection under the

17. See *Computer Care v. Service Sys. Enters., Inc.*, 982 F.2d 1063, 1069, 25 U.S.P.Q.2d (BNA) 1020, 1024 (7th Cir. 1992) (upholding the trial court's determination that follow-up letters for car repairs could be classified as inherently distinctive and receive trade dress protection); see also J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 8:4, at 8-11 to 8-14 (4th ed. 1996-1997) (listing examples of trade dress from a cover of a book to performing style of a rock music group).

18. See Lanham Act § 3(a), 15 U.S.C. § 1125(a) (1994 & Supp. IV 1998). The Act provides:

(a)(1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading representation of fact, which—
is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or
in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities,
shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

Id.

19. See *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 769, 23 U.S.P.Q.2d (BNA) 1081, 1084 (1992) (stating that “[t]he general rule regarding distinctiveness is clear: an identifying mark is distinctive and capable of being protected if it *either* (1) is inherently distinctive *or* (2) has acquired distinctiveness through secondary meaning”) (internal citations omitted) (emphasis in original). The Court establishes the legal principle that trade dress can be inherently distinctive and is entitled to protection under Section 43(a) of the Lanham Act without proof of secondary meaning. *Id.* at 776, 23 U.S.P.Q.2d (BNA) at 1086. In a recent decision, *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, the Court explains that there are two different types of trade dress, products packaging and product design. See 529 U.S. 205, 209, 54 U.S.P.Q.2d (BNA) 1065, 1067 (2000). When a trade dress is a product packaging, there is no need to show secondary meaning if the trade dress is inherently distinctive. See *id.* at 1345, 54 U.S.P.Q.2d (BNA) 1069. Product design trade dress, however, must attain secondary meaning, even if it is inherently distinctive. See *id.* The trade dress of the restaurant chain in *Two Pesos* is an inherently distinctive product packaging trade dress, and, thus, it is entitled to the protection under Section 43(a) of the Lanham Act without proof of secondary meaning. The term “trade dress” used in this Article refers to “product packaging” trade dress as explained by the *Wal-Mart* court in affirming its decision in *Two Pesos*. See *id.* (explaining that “trade dress” in *Two Pesos* referred to “product packaging” or something “that is akin to product packaging”). In particular, the look and feel of a web site as referred to in this Article is “product packaging” of goods or services offered at the web site; the web site and its look and feel are not sold as the goods or services.

20. Trademarks are discrete symbols such as words, pictures, or numbers. See generally MCCARTHY, *supra* note 17, § 8:1, at 8-2 to 8-6 (comparing trade dress to trademarks).

Lanham Act unless such trade dress is also non-functional.²¹ Although the trade dress of a product contains both functional and non-functional features, the combination of all the features or the total image of the product is protectable if it is not functional.²²

The owner of a protectable trade dress, i.e., when the trade dress is inherently distinctive or has acquired secondary meaning and is non-functional, can enforce its right against others for trade dress infringement.²³ In order to prevail on a claim of trade dress infringement, the owner of the protectable trade dress must establish that the similarity of the defendant's trade dress, as a whole, is likely to cause consumer confusion as to the source of the product.²⁴

Trade dress has greatly expanded in scope in recent years.²⁵ The Supreme Court's holding in *Two Pesos v. Taco Cabana, Inc.*²⁶ notably

21. See *Disc Golf Ass'n v. Champion Discs, Inc.*, 158 F.3d 1002, 1006, 48 U.S.P.Q.2d (BNA) 1132, 1135 (9th Cir. 1998) (explaining that plaintiff bears the burden of proving that his trade dress is non-functional) (citing *Rachel v. Banana Republic, Inc.*, 831 F.2d 1503, 1506, 4 U.S.P.Q.2d (BNA) 1877, 1879 (9th Cir. 1987); *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 863, 214 U.S.P.Q. (BNA) 1, 9 (1982) (White, J., concurring) (arguing that functional characteristics should not receive trade dress protection). *But see* *Thomas & Betts Corp. v. Panduit Corp.*, 138 F.3d 277, 297, 46 U.S.P.Q.2d (BNA) 1026, 1041 (7th Cir. 1998) (describing functionality as an affirmative defense with the burden on the defendant to prove that a trade dress is not entitled protection because it is functional).

22. Courts examine trade dress "as a whole" to determine its functionality. See *Tools USA & Equip. Co. v. Champ Frame Straightening Equip., Inc.*, 87 F.3d 654, 658, 39 U.S.P.Q.2d (BNA) 1355, 1359 (4th Cir. 1996); *Computer Care v. Service Sys. Enters., Inc.*, 982 F.2d 1063, 1067, 25 U.S.P.Q.2d (BNA) 1020, 1023 (7th Cir. 1992); *Hartford House, Ltd. v. Hallmark Cards, Inc.*, 846 F.2d 1268, 1271, 6 U.S.P.Q.2d (BNA) 2038, 2041 (10th Cir.), *cert denied*, 488 U.S. 908 (1988); *Fuddrucker's, Inc. v. Doc's B.R. Others, Inc.*, 826 F.2d 837, 842, 4 U.S.P.Q.2d (BNA) 1026, 1030 (9th Cir. 1987); *AmBrit, Inc. v. Kraft, Inc.*, 812 F.2d 1531, 1538, 1 U.S.P.Q.2d (BNA) 1161, 1166 (11th Cir. 1986). Functional elements that are separately unprotectable can be protected together as part of a trade dress. See *Fun-Damental Too, Ltd. v. Gemmy Indus. Corp.*, 111 F.3d 993, 1002, 42 U.S.P.Q.2d (BNA) 1348, 1355 (2d Cir. 1997) ("As we have observed, a useful feature of a product may also be source identifying . . . a finding of usefulness is not tantamount to finding of functionality.") (internal citations omitted).

23. See *Two Pesos*, 505 U.S. at 780, 23 U.S.P.Q.2d (BNA) at 1088-89 (Stevens, J., concurring) (noting that the federal courts are in agreement that section 43(a) of the Lanham Act creates a federal cause of action for claims of trademark and trade dress infringement).

24. See *Thomas & Betts*, 138 F.3d at 291, 46 U.S.P.Q.2d (BNA) at 1021 (noting that a plaintiff must demonstrate that an alleged infringing trade dress causes a likelihood of confusion for consumers regarding the source of the products); *AmBrit, Inc. v. Kraft, Inc.*, 812 F.2d 1531, 1538, 1 U.S.P.Q.2d (BNA) 1161, 1164 (11th Cir. 1986) (stating that the test for infringement of trade dress is the "likelihood of confusion"). See generally MCCARTHY, *supra* note 17, §§ 8-1, 8-2 to 8-6 (reasoning that a finding of unfair competition is valid when the defendant's trade dress is likely to create confusion with the plaintiff's trade dress).

25. See, e.g., Tom W. Bell, *Virtual Trade Dress: A Very Real Problem*, 56 MD. L. REV. 384, 391-92 (1997) (outlining and criticizing the expansion of trade dress protection to encompass virtual trade dress).

26. 505 U.S. 763, 23 U.S.P.Q.2d (BNA) 1081 (1992).

expanded trade dress by harmonizing doctrinal conflicts among the circuits,²⁷ holding that a trade dress, unregistered or registered with the U.S. Trademark Office, is protected under the Lanham Act if it is inherently distinctive.²⁸ Additional proof of acquired secondary meaning of a trade dress is not required.²⁹

The *Two Pesos* Court affirmed the Fifth Circuit's decision that the trade dress of a chain of fast food restaurants in Texas is inherently distinctive.³⁰ The trade dress in *Two Pesos* is defined with precision by the plaintiff as a:

festive eating atmosphere having interior dining and patio areas decorated with artifacts, bright colors, paintings and murals. The patio includes interior and exterior areas with the interior patio capable of being sealed off from the outside patio by overhead garage doors. The stepped exterior of the building is a festive and vivid color scheme using top border paint and neon stripes. Bright awnings and umbrellas continue the theme.³¹

The *Two Pesos* trade dress description considered by the Supreme Court essentially focused on the look and feel of the restaurant generated by its décor. The Court recognized that the look and feel of the restaurant is sufficiently distinctive to serve as a source

27. The circuit courts maintained conflicting interpretations of trade dress under the Lanham Act until *Two Pesos*. The Fifth Circuit in *Two Pesos* followed precedent set out in *Chevron Chem. Co. v. Voluntary Purchasing Groups, Inc.*, 659 F.2d 695, 702, 212 U.S.P.Q. (BNA) 904, 911 (5th Cir. 1981) (holding that trade dress is entitled to protection if it is sufficiently distinctive to identify its source). The *Chevron* court required only trade dress that is not inherently distinctive to show proof of acquired secondary meaning. See *id.* The Seventh and Ninth Circuits followed the Fifth Circuit's *Chevron* standard. See *Fuddrucker's, Inc. v. Doc's B.R. Others, Inc.*, 826 F.2d 837, 843, 4 U.S.P.Q.2d (BNA) 1026, 1031 (9th Cir. 1987) (reasoning that proof of secondary meaning is superfluous if a trade dress is inherently distinctive); *AmBrit, Inc. v. Kraft, Inc.*, 812 F.2d 1531, 1536, 1 U.S.P.Q.2d (BNA) 1161, 1164 (7th Cir. 1986) (explaining that a trade dress must be identifiable separately from the product and identify the source of the product to warrant protection). The Fifth Circuit's approach conflicted with the Second Circuit. See *Vibrant Sales, Inc. v. New Body Boutique, Inc.*, 652 F.2d 299, 304, 211 U.S.P.Q. (BNA) 297, 300 (2d Cir. 1981) (ruling that protection under the Lanham Act extends to unregistered marks or designs only where secondary meaning is established); see also Jenny Johnson, Note, *Two Pesos, Inc. v. Taco Cabana, Inc.: The Supreme Court's Expansion of Trade Dress Protection Under Section 43(A) of the Lanham Act*, 24 LOY. U. CHI. L.J. 285 (1993) (describing the divergent interpretations of trade dress under the Lanham Act).

28. 505 U.S. at 775, 23 U.S.P.Q.2d (BNA) at 1086 (noting that the trade dress of the restaurant is unregistered).

29. See *id.* (explaining that the Lanham Act does not call for secondary meaning when the mark is inherently distinctive).

30. The Fifth Circuit affirmed the jury finding that the defendant infringed on plaintiff's trade dress and stated that defendants were "brazenly copy[ing] plaintiff Taco Cabana's successful trade dress and proceeded to expand in a manner that foreclosed several lucrative markets within Taco Cabana's natural zone of expansion." *Two Pesos*, 505 U.S. at 766-67 n.5, 23 U.S.P.Q.2d (BNA) at 1083 (recounting the prior history).

31. See *Two Pesos*, 505 U.S. at 765, 23 U.S.P.Q.2d (BNA) at 1082.

identifier.³²

Within the spirit of the *Two Pesos*' "look and feel" concept of trade dress, this Article considers the overall look and feel of web sites generated by the color, graphics, animations, designs, layout, text, or combination of web sites' features. It may be necessary on occasion to identify discrete elements or features of the overall look and feel of a web site.³³ Trade dress analysis, however, requires courts to focus on the overall appearance of the individual features that comprise the "total look and feel" of one web site.³⁴

By applying trade dress law, the following sections will examine whether the trade dress of a web site should be protected. Inherent distinctiveness, secondary meaning, functionality, and likelihood of confusion will be discussed in-depth within the context of "total look and feel" of a web site. Because trade dress of web sites exists in cyberspace, attention to the Internet environment and its challenges to trade dress protection are appropriate.³⁵

32. See *id.* at 771, 23 U.S.P.Q.2d (BNA) at 1085 (stating that a trade dress owner should be able to use his or her trade dress to seek wider identification among customers).

33. See *Landscape Forms, Inc. v. Columbia Cascade Co.*, 113 F.3d 373, 381, 42 U.S.P.Q.2d (BNA) 1641, 1647 (2d Cir. 1997) (explaining that examination of the elements of trade dress may aid in determining the overall look and feel). The court stated:

[F]ocus on the overall look of a product does not permit a plaintiff to dispense with an articulation of the specific elements which comprise its distinct dress. Without such a precise expression of the character and scope of the claimed trade dress, litigation will be difficult . . . Courts will also be unable to . . . shape narrowly-tailored relief if they do not know what distinctive combination of ingredients deserves protection.

Id. Sometimes mere words are not adequate to describe the trade dress of a product and courts attach photos of the trade dress in the injunction order. See, e.g., *Imagineering, Inc. v. Van Klassens, Inc.*, 851 F. Supp. 532, 542, 31 U.S.P.Q.2d (BNA) 1119, 1127 (S.D.N.Y. 1994) (explaining that photographs are an appropriate alternative when words cannot provide an adequate description), *mot. denied*, 155 F.R.D. 68 (S.D.N.Y. 1994), *aff'd in part and rev'd in part, vacated in part, remanded*, 53 F.3d 1260, 34 U.S.P.Q.2d (BNA) 1526 (Fed. Cir. 1995).

34. See *Computer Care v. Service Sys. Enters., Inc.*, 982 F.2d 1063, 1069, 25 U.S.P.Q.2d (BNA) 1020, 1026 (7th Cir. 1992) (providing an example of how courts look at specific elements, but make decisions based on the overall look and feel of the trade dress); see also *Taco Cabana Int'l, Inc. v. Two Pesos, Inc.*, 932 F.2d 1113, 1120, 19 U.S.P.Q.2d (BNA) 1253, 1256 (5th Cir. 1991) (explaining that trade dress is the total image and overall appearance of a product), *aff'd*, 505 U.S. 763, 23 U.S.P.Q.2d (BNA) 1081 (1992).

35. See Lisa M. Byerly, Comment, *Look and Feel Protection of Web Site User Interfaces: Copyright or Trade Dress?*, 14 SANTA CLARA COMPUTER & HIGH TECH L.J. 221, 225 n.10 (1998) ("Cyberspace, in its present condition, has a lot in common with the 19th Century West. It is vast, unmapped, culturally and legally ambiguous, verbally terse, hard to get around in, and up for grabs." (quoting John P. Barlow, *Crime and Puzzlement: In Advance of the Law on the Electronic Frontier*, WHOLE EARTH REV., Sept. 22, 1990, at 44)).

II. THE CHALLENGES OF THE INTERNET ENVIRONMENT ON LOOK AND FEEL OF INTERNET SITES

The Internet is a global network of computers adhering to common communication standards.³⁶ The Internet was originally created by the U.S. Government and was adopted by academics and researchers.³⁷ The most visible and widely used component of the Internet is the World Wide Web.³⁸ There are more than one hundred million web users, and commerce on the web is in the hundreds of billions of dollars.³⁹ The World Wide Web was created through the use of hypertext or “computer-based documents in which readers move from one place in a document to another or between documents” located on different host computers.⁴⁰

A user gains access to the Web through an Internet service provider,⁴¹ such as Microsoft Network (MSN), America Online (AOL), or MindSpring.⁴² The user visits a particular Internet site

36. See generally Vinton G. Cerf, *A Brief History of the Internet and Related Networks*, at <http://www.isoc.org/internet/history/cerf.html> (last visited Feb. 9, 2000) (describing the design and operation of the Internet).

37. See *id.*; see also Michael A. Stoker, Comment, *Framed Web Pages: Framing the Derivative Works Doctrine on the World Wide Web*, 67 U. CIN. L. REV. 1301 (1999) (providing a brief history of the Internet).

38. See generally MARGARET LEVINE YOUNG, THE COMPLETE REFERENCE INTERNET MILLENNIUM EDITION 390 (2000); M. Louise Turilli & Joseph Kerschenbaum, *Securities on the Internet: Changes in Laws Required to Increase Online Offerings*, 70-DEC NYSTBJ 22 (1998); Ruth Okediji, *Givers, Takers, and Other Kinds of Users: A Fair Use Doctrine for Cyberspace*, 53 FLA. L. REV. 107, 182 n.169 (2001).

39. See CommerceNet, *Internet Population*, at <http://www.commerce.net/research/stats/> (last visited Feb. 9, 2000) (providing charts for past and projected Internet use). As of June 1998, there are 68 million web users over the age of 16 in North America. See *id.* The projected number for the year 2000 is 120 million web users over the age of 16 in North America. See *id.* Online transactions in the United States totaled \$9 billion for 1997. See Goldman Sachs, *B2B: 2B or Not 2B*, at <http://www.gs.com/hightech/research/b2b> (last visited Oct. 1, 2000) (reporting and analyzing business-to-business companies, technologies, investment in the global e-commerce market). In 1999, business-to-business e-commerce was \$114 billion. The projected estimate for online business-to-business transaction for 2004 is \$1.5 trillion. See *id.*

40. See Katherine E. Gasperek, Comment, *Applying the Fair Use Defense in Traditional Trademark Infringement and Dilution Cases to Internet Meta Tagging or Linking Cases*, 7 GEO. MASON L. REV. 787, 790 (1999) (providing a basic explanation of how the web functions (quoting BILL EAGER ET AL., SPECIAL EDITION USING THE WORLD WIDE WEB 527 (2d ed. 1996))).

41. An Internet Service Provider is the party that provides users with connectivity to the Internet. See BERNERS-LEE, *supra* note 1, at 214 (explaining the definition and function of Internet Service Providers).

42. See YOUNG, *supra* note 38, at 11-12; see also *United States v. Microsoft Corp.*, 84 F. Supp. 2d 9, 13-14 (1999) (“There are two types of IAPs (Internet Service Providers). Online services (“OLSs”) such as America Online (“AOL”), Prodigy, and the Microsoft Network (“MSN”) offer, in addition to Internet access, various services and an array of proprietary content. Internet service providers such as Mindspring and Netcom, on the other hand, offer few services apart from Internet access and relatively little of their own content.”).

using its Uniform Resource Locator or URL address.⁴³ A web site begins with a home page and usually has internal pages that are linked to each other and the homepage.⁴⁴ The user's browser,⁴⁵ such as Microsoft Explorer or Netscape Navigator, displays the content of the user's desired web site received from the service provider.⁴⁶

With the use of hypertext, utilizing text, graphics, illustrations, sounds, and video, the World Wide Web has recently enjoyed escalated growth and popularity.⁴⁷ Currently, there are about one billion web pages on the World Wide Web.⁴⁸ A web site can display worldwide any type of trademarks, such as words, designs, symbols, "logos, characters, sounds, recognizable voices, colors" or combinations thereof.⁴⁹ Animation is one of the features on the Internet.⁵⁰ Internet users can visit a web site and download an animated logo with their web browser and then copy that logo to wherever the user would like.⁵¹ This existing technology, along with

43. See Nielsen, *supra* note 2, at 246-49 (noting that Internet users often overlook the URL portion of a web address even though it is an important functioning element of an address).

44. See NIELSEN, *supra* note 2, at 178 (discussing the differences between the home page and interior pages); see generally JEFF GREENBERG & J.R. LAKELAND, BUILDING PROFESSIONAL WEB SITES WITH THE RIGHT TOOLS 145-46 (1999).

45. See *id.* A browser is described as "an application allowing access to web sites. It navigates to a URL address, deciphers an HTTP header, and uses the graphical services of the computer on which it is running to draw underline text, create margins, to subscript all for the purpose of displaying the content instead of tags." *Id.*

46. See YOUNG, *supra* note 38, at 397-400 (discussing web browsers and their functions); see also Microsoft, 84 F. Supp. 2d at 14 ("Web browser is a type of Web client that enables a user to select, retrieve, and perceive resources on the Web. In particular, Web browsers provide a way for a user to view hypertext documents and follow the hyperlinks that connect them, typically by moving the cursor over a link and depressing the mouse button.").

47. See JOHN DECEMBER & NEIL RANDALL, THE WORLD WIDE WEB UNLEASHED 5 (2d ed., 1995) (explaining that the World Wide Web's popularity exists because the web "provides technology needed to offer a navigable, attractive interface for the Internet's vast sea of resources . . ."); Abel, *supra* note 8, at 165 (discussing the opportunities for trademark infringement on the web given "availability of graphics, sound and animation," which can be used "to displace, worldwide, any number of marks").

48. See Inktomi, *Web Surpasses One Billion Documents*, available at <http://www.inktomi.com/new/press/billion.html> (last visited Feb. 10, 2000) (stating that Inktomi Corp. and NEC Research Institute, Inc. compiled a study finding that the web contains "one billion unique pages"). As of September 2000, there were 21,166,912 web sites. See Robert H. Zakon, *Hobbes's Internet Timeline v5.0*, available at <http://www.isoc.org/guest/zakon/Internet/History/HIT.html> (last visited Oct. 20, 2000) (tracking World Wide Web growth from June 1993 to September 2000).

49. Abel, *supra* note 8, at 165.

50. See *id.* at 166-67 (noting the availability of software that allows visitors to download freely an animated corporate logo, thus eliminating controls that a trademark owner would have on subsequent use).

51. See *id.* at 166 (claiming that "visitors to the company's web site can download

yet unknown future technologies, raises a serious question about the control of subsequent use of elements or features of a web site.⁵² To compound the issue, there currently exists no reported case law addressing the look and feel of a web site.⁵³

Most litigation involving web sites has been limited to claims regarding use of domain names⁵⁴ and metatags⁵⁵ brought under the Lanham Act for likelihood of confusion,⁵⁶ and/or dilution.⁵⁷ Among these types of cases, trademark liability involving metatags and web linking are perhaps the most significant because they prominently highlight how traditional trademark law lags behind advances in technology.⁵⁸ Metatags are HTML instructions in web pages that are

the animated logo onto their web browser and take it with them").

52. See *id.* at 167 (highlighting examples of subsequent use of corporate logo on the Internet by disgruntled former employees or unhappy customers).

53. See Ian C. Ballon, *Internet Issues for Travel Industry*, 790 PLI/COMM. 11, 90-92 (1999) (stating that "[t]here are no reported web site trade dress opinions and no recent, authoritative decisions upholding trade dress protection in a user-interface").

54. See, e.g., *Interstellar Starship Servs., Ltd. v. Epix, Inc.*, 184 F.3d 1107, 1112, 51 U.S.P.Q.2d (BNA) 1535, 1538 (9th Cir. 1999) (reversing the District Court's grant of summary judgment for the plaintiff where plaintiff, who used respondent's company name in Internet domain name, sought declaratory judgment), *cert. denied*, 120 S. Ct. 1161 (2000); *Avery Dennison Corp. v. Sumpton*, 189 F.3d 868, 880, 51 U.S.P.Q.2d (BNA) 1801, 1809 (9th Cir. 1999) (addressing appeal of District Court's grant of summary judgment for plaintiff who alleged that respondent's use of particular domain name registrations diluted plaintiff company's trademarks). See generally Jennifer Golinveaux, *What's In a Domain Name: Is "Cybersquatting" Trademark Dilution?*, 33 U.S.F. L. REV. 641 (1999) (discussing the "strengths and weaknesses of traditional trademark infringement trademark and dilution theories as applied to cybersquatting").

55. See *Niton Corp. v. Radiation Monitoring Devices, Inc.*, 27 F. Supp. 2d 102, 104, 52 U.S.P.Q.2d (BNA) 1380, 1381 (D. Mass. 1999) (addressing whether one company's use of "META" descriptions and keywords, "words that identify an Internet site . . . [and] keywords that are listed by the webpage creator when creating the web site," was misleading). See generally Gasperek, *supra* note 40, at 805-16 (discussing trademark cases involving metatags and linkings).

56. See, e.g., *Interstellar Starship Servs., Ltd.*, 184 F.3d at 1110, 51 U.S.P.Q.2d (BNA) at 1537-38 (supporting a District Court's determination that a likelihood of confusion existed when plaintiff company used the domain name "epix.com"); *CCBN.com, Inc. v. c-call.com, Inc.*, 73 F. Supp. 2d 106, 115, 53 U.S.P.Q.2d (BNA) 1132, 1139 (D. Mass. 1999) (finding no likelihood of confusion between *StreetFussion.com* and *StreetEvent.com*).

57. See, e.g., *Sporty's Farm v. Sportman's Market, Inc.*, 202 F.3d 489, 53 U.S.P.Q.2d (BNA) 1570 (2d Cir. 2000) (applying the newly enacted Anti-Cybersquatting Consumer Protection Act to a trademark case that was originally appealed on a dilution claim under the Federal Trademark Dilution Act and holding that the defendant's use of the "Sporty" mark as a domain name was a bad faith violation of the new federal statute); *Avery Dennison Corp.*, 189 F.3d at 881, 51 U.S.P.Q.2d (BNA) at 1802 (reversing summary judgment for the plaintiff in a trademark dilution case involving "Avery Dennison" trademark and defendant's "avery.net" and "dennison.net" because the plaintiff's mark is not famous).

58. See *Niton Corp.*, 27 F. Supp. 2d at 103, 52 U.S.P.Q.2d (BNA) at 1381 ("I conclude that court intervention is appropriate but not in a classic form of preliminary injunction."); Gasperek, *supra* note 40, at 787 (noting that judges struggle to apply traditional and innovative legal theories to Internet disputes).

not visible to users who access a site with a web browser.⁵⁹ To create metatags, the web developer lists index words or keywords when designing the web page⁶⁰ “so that the page will be identified when a user performs a search engine query for a word.”⁶¹ To increase the visibility of a web site, web site developers insert “the same word multiple times in metatags so that a site may appear higher on a search engine list.”⁶² Web site developers also may insert words unrelated to the site to increase the number of times the site is accessed.⁶³ As one of the first jurists who had the opportunity to address whether trademark liability arises from metatag use, Judge Keeton noted that past experience of judges and practitioners does not adequately prepare them to address Internet-related litigation.⁶⁴

Soon judges and advocates will find themselves determining what level of protection, if any, should be provided for the look and feel of a web site. Indeed, practitioners have already raised the question of trade dress protection for web sites.⁶⁵ Some practitioners have taken preemptive measures to protect the look and feel of their client’s web site by including an acknowledgement of rights in and control provision for the look and feel of the web site in contractual agreements involving electronic commerce.⁶⁶

59. See Gasperek, *supra* note 40, at 792 (defining a meta tag as “a hidden HTML that Internet search engines read when indexing a Web site”).

60. See *Niton Corp.*, 27 F. Supp. 2d at 104, 52 U.S.P.Q.2d (BNA) at 1381 (explaining that Internet users type “META” keywords into search engines that will identify metatags in web pages).

61. Ballon, *supra* note 53, at 88.

62. *Id.* (explaining that metatags are used in designing web pages in order to give the page publicity); see also Gasperek, *supra* note 40 (“[The] excessive use of the same words . . . can force some search engines to place the site higher on the list of hits. The practice is called ‘spamdexing.’”).

63. See *Niton Corp.*, 27 F. Supp. 2d at 104, 52 U.S.P.Q.2d (BNA) at 1382 (stating that an employee of Niton Corporation asserted that he found META descriptions on the defendant company’s web site that were the same description used when creating the Niton Corporation’s web site, which resulted in more “hits” to the defendant’s web site than Niton’s when conducting a web search); see also Ballon, *supra* note 53, at 88-89 (discussing three lawsuits where trademarked metatags were used without plaintiff company’s permission); Gasperek, *supra* note 40, at 792-93 (noting that in order for a web site designer to create a site that will return enough “hits” on a search engine, the designer may employ metatag words multiple times).

64. See *Niton Corp.*, 27 F. Supp. 2d at 103, 52 U.S.P.Q.2d (BNA) at 1381 (“This [case] is a classic illustration of a new kind of litigation for which nothing in past experience comes even close to preparing trial judges and the advocates appearing before them.”).

65. See Abel, *supra* note 8, at 171-72 (suggesting trade dress protection for web site interface); see also Ballon, *supra* note 53, at 89-93 (discussing the potential use of trade dress protection for screen displays and web site interfaces).

66. See, e.g., Henry W. Jones, III, *Licensing in Cyberspace*, 534 PLI/PAT. 237, 300 (1998). Exhibit D to the Interactive Marketing Agreement, dated March 10, 1998, between Infonautics Corporation and America Online, Inc., defines AOL Look and Feel as “the distinctive and particular elements of graphics, design, organization,

III. ADDRESSING THE INTERNET CHALLENGES: MAKING LOOK AND FEEL PROTECTABLE

Unlike traditional trade dress, the mental association consumers have between the trade dress of an Internet site and its source can only occur in cyberspace. The dynamics of the Internet environment impose several challenges to an attempt to define the trade dress of an Internet site.⁶⁷ Under trade dress law, a failure to explain which aspects of the look and feel are entitled to protection indicates that the trade dress of the web site has no protectable “style, theme or idea.”⁶⁸ A few commentators have examined the user interface⁶⁹ of a site and have evaluated the various forms of intellectual property protection possible for such a user interface.⁷⁰ This Article, however, considers the overall look and feel of a web site generated by the color, graphics, animations, designs, layout, text, or combination thereof of a web site that affects the experience of visitors at the Internet site.

presentation, layout, user interface, navigation, trade dress, and stylistic convention (including the digital implementations thereof) within the AOL Network and total appearance and impression substantially formed by the combination, coordination and interaction of these elements.” *Id.* Exhibit E for Standard Legal Terms and Condition states that “Infonautics acknowledges and agrees that AOL shall, to the extent permitted by law, own all right, title, and interest in and to the AOL Look and Feel.” *Id.* at 302.

67. See *Landscape Forms, Inc. v. Columbia Cascade Co.*, 113 F.3d 373, 381, 42 U.S.P.Q.2d (BNA) 1641, 1647 (2d Cir. 1997) (“[A] plaintiff’s inability to explain to a court exactly which aspects of its product design(s) merit protection may indicate that its claim is pitched at an improper level of generality, i.e., the claimant seeks protection for an unprotectable style, theme or idea.”).

68. See *id.* (finding the plaintiff had not articulated and supported its claimed trade dress with sufficient particularity).

69. See Byerly, *supra* note 35, at 222 (defining user interface as the “look and feel of the interface . . . generally manifested by the display screens that a computer program generates and the keystroke combinations that are used for particular program functions” (quoting David Bender & Craig Nethercott, *Lotus v. Borland: At the United States Supreme Court*, 430 P.L.I. 7 n.1 (1996))); see also Mark Bergner, Comment, *Changing Views: A Comment on Intellectual Property Protection for the Computer User Interface*, 42 ST. LOUIS U. L.J. 301, 301 n.1 (1998) (“A computer user interface is the means by which a person interacts with the computer.”); Lauren Fisher Kellner, Comment, *Trade Dress Protection for Computer User Interface “Look and Feel,”* 61 U. CHI. L. REV. 1011, 1011 (1994) (discussing that the interface includes audio-visual displays, the keyboard, and the printer, among other elements of the computer).

70. See Byerly, *supra* note 35, at 223 (evaluating whether protection under copyright or trade dress law should be extended to user interface); see also Bergner, *supra* note 69, at 328-42 (examining protection under patent, copyright, trademark law for computer user interface and recommending the creation of a permanent technical advisory committee similar to CONTU and new form of intellectual property protection for user interface); Kellner, *supra* note 69, at 1018-35 (evaluating trade dress protection for user interface look and feel).

A. The Paradox of Being the Coolest Site

The Internet is a dynamic place.⁷¹ New web sites are created every day.⁷² With sufficient knowledge of HTML,⁷³ the coding process that builds web pages, a knowledgeable user can build his or her own web site.⁷⁴ To attract visitors to a site, however, the site must be visually appealing, easy to navigate, compelling to read, and service-oriented.⁷⁵ Unlike readers of print media, web users are surfers with short attention spans.⁷⁶ The content, graphics, text, or data must be regularly updated to stay current with the trend.⁷⁷ To maintain a site and to create and update design templates regularly is a financially costly process.⁷⁸

71. There are 92 million Internet users above the age of 16 in North America as of April 1999 and 36.7 million hosts as of July 1998 on the Internet. See CommerceNet, *Internet Demographics and eCommerce Statistics*, at <http://www.commerce.net/research/stats/stats.html> (last visited July 12, 2000).

72. Within one month, the World Wide Web added 1,343,616 new web sites. See Robert Hobbes Zakon, *Hobbes' Internet Timeline v5.0*, at <http://www.isoc.org/guest/zakon/Internet/History/NIT.html> (presenting figures between August 2000 and September 2000) (last visited Nov. 6, 2000).

73. Hyper Text Marked-Up Language ("HTML") is simply a method of encoding a request to the browser. Marked-up text means putting tags around the portions of text to be formatted or that link the user to another page of text when clicked. See GREENBERG & LAKELAND, *supra* note 44, at 14-16.

74. Small web businesses now have access to resources and products for creating and maintaining do-it-yourself web sites. There are off-the-shelf HTML coding products like Microsoft's Front Page, Visual page by Symantec, and Macromedia's Dreamweaver. There are many "how-to" web sites offering guidance and expert advice on web design, hosting and marketing. See internet.com Corp., WebDeveloper.com, at <http://www.webdeveloper.com> (last modified Sept. 8, 2000); MicroVision Dev., Inc., mvd.com, at <http://www.mvd.com> (last visited Apr. 2, 2000). For graphics, knowledgeable users can design their own clipart by using a digital camera to take photographs and a graphic application such as Adobe Photoshop, CorelXARA, Corel PHOTO-PAINT, and Microsoft Image Composer to manipulate the images, or they can use clipart created by others. See ROGER C. PARKER, *WEB DESIGN & DESKTOP PUBLISHING FOR DUMMIES* 273-88 (1997).

75. See SANO, *supra* note 6, at 22-45, 197 (comparing different types of web sites to illustrate that web sites are not static; they require frequent updating and dedicated attention); see also Colin Mackenzie, *Web Design Tips*, at <http://www.colin.mackenzie.org/webdesign/fresh.html> (last visited Feb. 2, 2000) (stating that dynamic web sites are more likely to get repeat hits).

76. See SANO, *supra* note 6, at 66-69 (discussing the short attention span of web users and its implications to web designers); see also NIELSEN, *supra* note 2, at 380 (believing that Web users are goal-driven: "They have something specific they want to do, and they don't tolerate anything standing between them and their goal. So the guiding principle for web designing must be to get out of the way and make users successful as fast as possible").

77. See SANO, *supra* note 6, at 31 ("Web sites are not static, one-time efforts, but require constant updating and dedicated attention, very much as a magazine staff is required to publish a monthly publication.").

78. The cost of web design and domain name registration can start as low as \$995. See *Too Cool*, at <http://www.toocool.com> (last visited Feb. 9, 2000) (listing the price of a package including web design, domain name registration, e-mail set up, and one month of hosting at a starting price of \$995).

The desire to be one of the most visited sites⁷⁹ may drive the owner of a web site into a zone of no legal protection, particularly trade dress protection. When a site is frequently updated with new visual appearance, fresh data, more graphics, additional design and layout schemes for the site, the overall look and feel of the site most likely changes with each update.⁸⁰ With frequent modifications, both consumers and the owner of the site may not be able to articulate or identify the overall look and feel of the site. Trade dress law, however, does not protect the look and feel of a product or service that does not have continuing commercial impression throughout its use.⁸¹ Further, trade dress rights are based on continuous use of the trade dress in commerce.⁸² Any non-use or discontinuous use of a trade dress may amount to abandonment.⁸³ A web site with an

79. See generally NIELSEN, *supra* note 2, at 380-82 (concluding the four reasons why users return to some web sites and not to other web sites are high quality content, often updated, minimal download time, and ease of use). Nielsen quoted a survey conducted by WebReference.com of 8,600 users who were asked what caused them to return to web sites. See WebReference.com, at <http://www.webreference.com/new/990125.html> (last visited Feb. 9, 2000). The survey results include the four reasons named by Nielsen. See MacKenzie, *supra* note 75 (suggesting that web site owners "[m]ake an effort to keep your web site fresh, especially if you want to get repeat visitors. If a site remains stagnant, people will stop visiting it again and again, but if there is always something new, people will often drop by just to see what's changed If the site looks different every time somebody visits, they'll be more inclined to come back again").

80. See MacKenzie, *supra* note 75 (noting that the look and feel of a web site may be changed through the use of dynamic content). Forms of dynamic content include the following: changing elements of the site, such as random main graphics or logos, using cookies to track previous visits and customize content, and using JavaScript or CGI scripting to create content. See *id.*

81. A change in the trade dress, which alters the overall commercial impression of the trade dress, may cause the owner of the trade dress to lose priority of use dating from the date of first use of the old form of the trade dress. See, e.g., *Super Valu Stores, Inc. v. Exxon Corp.*, 11 U.S.P.Q.2d (BNA) 1539, 1542 (Trademark Trial and App. Bd. Mar. 3, 1989) (holding the new form of the mark did not create the same continuing commercial impression, thus, the applicant was not permitted to tack on its prior use of a tiger design and slogan PUT A TIGER IN YOUR TANK for gasoline products to gain priority of use for TIGER MARK for convenience stores); *Ilco Corp. v. Ideal Security Hardware Corp.*, 527 F.2d 1221, 1224, 188 U.S.P.Q. (BNA) 485, 487 (C.C.P.A. 1976) ("The law permits a user who changes the *form* of its mark to retain the benefit of its use of the earlier form, without abandonment, if the new and old forms create the same, continuing commercial impression.") (emphasis in original).

82. See *Ilco Corp.*, 527 F.2d at 1224, 188 U.S.P.Q. (BNA) at 487 (stating that "[t]he test to be applied here is whether [two marks] . . . create the same, continuing commercial impression"); see also *Allard Enter., Inc. v. Advanced Programming Resources, Inc.*, 146 F.3d 350, 358, 46 U.S.P.Q.2d (BNA) 1865, 1872 (6th Cir. 1998) ("As long as there is a genuine use of the mark in commerce, however, ownership may be established even if the first uses are not extensive and do not result in deep market penetration or widespread recognition.").

83. See 15 U.S.C. § 1127 (1994 & Supp. IV 1998) ("A mark shall be deemed to be 'abandoned' either . . . (1) When its use has been discontinued with intent not to resume such use Nonuse for 3 consecutive years shall be prima facie evidence of

established, recognizable overall look and feel will lose any trade dress right it has gained if the owner decides to give it a new face-lift.⁸⁴

Moreover, a web site that is frequently updated with a new overall look and feel does not allow consumers to associate that overall look and feel with the source. Consequently, no trade dress protection can be extended to the trade dress of the web site under the secondary meaning requirement.⁸⁵

Additionally, the owner of a web site with a new face-lift does not have the right to warehouse its older overall look and feel.⁸⁶ Under trade dress law, warehousing is not permissible.⁸⁷ Continuous activities directed to maintain the web site must be established in order to prevent the dissipation of good will that has been generated in association with the older overall look and feel of a web site.⁸⁸

The focus on preserving the consistent overall look and feel of a web site is important because the analysis of trade dress begins with

abandonment . . . (2) conduct of the owner . . . causes the mark to become the generic name for the goods or services [associated with the mark]."); *see also* Exxon Corp. v. Humble Exploration Co., 695 F.2d 96, 102, 217 U.S.P.Q. (BNA) 1200, 1201 (5th Cir. 1983) (holding limited arranged sales of HUMBLE products as part of a trademark maintenance program did not constitute "use" sufficient to avoid prima facie abandonment under the Lanham Act).

84. *See* Am. Paging, Inc. v. Am. Mobilephone, Inc., 13 U.S.P.Q.2d (BNA) 2036, 2038 (Trademark Trial & App. Bd. Nov. 15, 1989) (deciding that a registrant was not permitted to tack on its prior use of the MOBILPHONE and star and stripe design to achieve priority of use for AMERICAN MOBILPHONE PAGING with identical star and stripe design because the two marks generated different commercial impressions and thus are not legally identical even though "this is a close question, we believe that purchasers would distinguish the two marks and would not consider them to be the same").

85. *See* Am. Mobilephone, Inc. v. Am. Paging, Inc., 17 U.S.P.Q.2d (BNA) 1726, 1727 (Fed. Cir. Nov. 14, 1990) (affirming the Board's decision to cancel petitioner's registration mark), *aff'g* 13 U.S.P.Q.2d (BNA) 2036 (Trademark Trial & App. Bd. Nov. 15, 1989); *Super Valu Stores, Inc.*, 11 U.S.P.Q.2d (BNA) at 1542 (holding that there is enough of a similarity between "TIGER MART" and "TIGER DISCOUNTER" to confuse consumers); *see also* Van Dyne-Crotty, Inc. v. Wear-Guard Corp., 926 F.2d 1156, 1160, 17 U.S.P.Q.2d (BNA) 1866, 1868-69 (Fed. Cir. 1991) (finding that the two marks "CLOTHES THAT WORK" and "CLOTHES THAT WORK FOR THE WORK WE DO" "were not legal equivalents because the purchasers 'would clearly differentiate them'").

86. *See* AmBrit, Inc. v. Kraft, Inc., 812 F.2d 1531, 1550, 1 U.S.P.Q.2d (BNA) 1161, 1171 (11th Cir. 1986) ("Were the rule otherwise, a party cannot hold trademarks that it never intended to use but did not want to allow others to use" and that "Lanham Act does not permit . . . warehousing of trademarks."); *see also* Exxon Corp., 695 F.2d at 102, 217 U.S.P.Q. (BNA) at 1204 (discussing the "difference between intent not to abandon or relinquish and intent to resume use").

87. *See* AmBrit, 812 F.2d at 1550, 1 U.S.P.Q.2d (BNA) at 1171 (stating that Lanham Act prohibits warehousing).

88. *See* Exxon Corp., 695 F.2d at 102 n.4, 217 U.S.P.Q. (BNA) at 1204 (citing Sterling Brewers, Inc. v. Schenley Indus., 441 F.2d 675, 169 U.S.P.Q. (BNA) 590 (C.C.P.A. 1971)) (stating that the *Sterling Brewers* court "decided that the goodwill of a trademark for beer had not dissipated through eight years of nonuse").

the total or overall appearance or image of a product.⁸⁹ The trade dress of a web site should be analyzed in its entirety, not by its individual components, just as the trade dress of other products are analyzed.⁹⁰

One method to ensure trade dress protection of the overall look and feel of a web site, while meeting the need to have the most frequently visited site, is to update the data and content of the site,⁹¹ while not changing the way the data and content are organized within the site.⁹² Each time the web site owner updates data and content, the overall look and feel of the web site must be kept consistent with the previous color schematic, sounds, and design layout of the content and graphics.⁹³ This continuity will ensure that the inherently distinctive overall look and feel of the web site has an opportunity to function as a trade dress by distinguishing its products or services from those of its competitors.⁹⁴ Further, this continuity facilitates connections between the consistent overall look and feel of

89. See *Tools USA & Equip. Co. v. Champ Frame Straightening Equip., Inc.*, 87 F.3d 654, 658, 39 U.S.P.Q.2d (BNA) 1355, 1359 (4th Cir. 1996) ("The trade dress of the [plaintiff's] catalog consists of a number of elements, combined in a particular fashion."); *August Storck K.G. v. Nabisco, Inc.*, 59 F.3d 616, 620, 35 U.S.P.Q.2d (BNA) 1211, 1214 (7th Cir. 1995) ("Doubtless the overall appearance is what matters Dissecting a product or package into components can cause a court to miss an overall similarity.").

90. See *Tools USA*, 87 F.3d at 658, 39 U.S.P.Q.2d (BNA) at 1359 (analyzing the trade dress of a catalog in its entirety); see also *Stuart Hall Co. v. Amped Corp.*, 51 F.3d 780, 786, 34 U.S.P.Q.2d (BNA) 1428, 1430-31 (8th Cir. 1995) (noting that the combination of elements, such as shape and design, can create a product that will be perceived by consumers as unique); *AmBrit*, 812 F.2d at 1535-37, 1 U.S.P.Q.2d (BNA) at 1163-65 (affirming the trade dress for Klondike ice cream bar wrapper). Due to its many distinctive features, including "its square size, bright coloring, pebbled texture, polar bear and sunburst images, and distinctive style of printing [the wrapper] is 'a complex composite of size, color, texture and graphics . . . [creating] a distinctive visual impression'". *Id.* (citing *Isaly Co. v. Kraft, Inc.*, 619 F. Supp. 983, 226 U.S.P.Q. (BNA) 801 (S.D.N.Y. 1985) (order at 11-12)).

91. See generally NIELSEN, *supra* note 2, at 380-83 (keeping content regularly updated is one of the main reasons for web site popularity); MacKenzie, *supra* note 75 (recommending keeping a site's content fresh by using dynamic content such as "JavaScript or CGI scripting to create content, using cookies to track previous visits and customize content").

92. See Nielsen, *supra* note 2, at 81 (suggesting the use of Cascading Styling Sheet). One of "the main benefits of style sheet is to ensure visual continuity as the user navigates your site. Legacy publications have long known the value of basing print products on a single typeface: No matter where you turn in a magazine or a newspaper, the text and basic layout will look the same. Web sites will gain brand cohesiveness when all the pages on a site link to the same style sheet." NIELSEN, *supra* note 2, at 81.

93. See *AmBrit*, 812 F.2d at 1536, 1 U.S.P.Q.2d (BNA) at 1165 (noting that the trade dress of any product must be sufficiently unique in order to provide consumers with the ability to identify the product from the trade dress).

94. See *id.* ("Manifestly, if [a] trade dress is not sufficiently distinctive to allow consumers to identify the product from the trade dress, then the dress does not inherently serve as an indication of origin . . .").

the web site and the existence of a single source in the mind of visitors who frequent the site.⁹⁵

B. All Computers, Their Screens, and Modem Speed Are Not Created Equal

Another challenge to the overall look and feel of a web site is the unintended alteration of the trade dress displayed on computers. A web site with pages uniquely displayed, as intended, on the monitor of one computer may have a different result on another computer.⁹⁶ This may affect the overall look and feel of the web site and subsequently the experience of consumers visiting the site. The visitors, depending on the size and resolution of their computer screens, may not experience the same look and feel of the site as intended by the web site designer.⁹⁷

Computers do not all have the same screens, and thus their ability to generate clear and highly defined graphics vary.⁹⁸ These differences may affect the overall look and feel of a web site and the experience of visitors to that web site.⁹⁹ Visitors who gain access to a web site with a screen that can display colorful and clear graphics will experience the overall look and feel of the site differently from visitors who visit the same web site via a computer with a less powerful screen that produces grainy graphics.

Also, the connection to a particular web site is not the same for all

95. See *id.* (discussing the importance of the function of a secondary meaning trade dress because "the consuming public has come to associate that trade dress with the product's producer Secondary meaning is the connection in the consumer's mind between the mark and the product's producer, whether that producer is known or unknown").

96. See LYNDIA WEINMAN & BRUCE HEAVIN, *COLORING WEB GRAPHICS 2: THE DEFINITIVE RESOURCE FOR COLOR ON THE WEB* (1997) (noting that color artwork on the web is very different from traditional medium because there is high variability among computers, operating systems and web browsers); see also Microvision Dev., Inc., *Design Basics*, at <http://www.mvd.com/webguide/style1.shtml> (last visited Feb. 2, 2000) [hereinafter *Design Basics*] (noting different monitors and systems displaying color at different contrasts can cause a web page with a turquoise background and cyan foreground to look great on the web designer's own monitor, but dark and nearly unreadable on other monitors).

97. See *Design Basics*, *supra* note 96 (describing the differing effects that different monitors can have on graphics).

98. See NIELSEN, *supra* note 2, at 28 (providing a graph of distribution of computer screens used to access the Internet between 1997 and 1999).

99. See generally DEKE MCCLELLAND & KATRIN EISMAN, *WEB DESIGN STUDIO SECRETS* 40-70 (1998) (discussing web graphic and color essentials to ensure the web sites download quickly and still look their best on the computer screens of the targeted audience); MARY E.S. MORRIS & RANDY J. HINRICH, *WEB PAGE DESIGN* 2-3 (1996) (advocating for the use of multimedia in web designing); *MacKenzie*, *supra* note 75 (noting "[g]raphics quality can be a key factor in improving the appearance of your web site. One of the reasons that it's so important is that it is fairly subtle . . . one site just looks better than the other, and a lot of people won't recognize why").

visitors, depending on the type of Internet access utilized.¹⁰⁰ Currently, a T1 line connection provides a faster connection to the Internet than a modem.¹⁰¹ Through a T1 connection, a visitor may quickly access a web site and thus experience the overall look and feel of the site differently than a visitor whose access to the web site is slower due to access via a modem.¹⁰²

In the non-virtual world, most, if not all, trade dress remains the same to all consumers regardless of the location of the consumers or distribution point.¹⁰³ One example is the trade dress of the Coca-Cola bottle.¹⁰⁴ In the Internet context, however, the differences among computers, screens, and modem speed may alter the trade dress of a web site.¹⁰⁵ Further, from the network economy perspective, slow response from a web site often means that the site does not provide good service.¹⁰⁶ Slow response times often translate directly into a reduced level of trust, and often result in less web traffic.

C. Not All Users Have the Same Browser

Another unintended alteration of the overall look and feel of a web site is that not all browsers are the same.¹⁰⁷ Some browsers are not capable of running certain applications or playing sound.¹⁰⁸ Many

100. See NIELSEN, *supra* note 2, at 48-49 (providing a graph of distribution of users connecting to the Internet at various speeds and noting that the majority of users gain access to the Internet through modems ranging from 14.4 Kbps to 56 Kbps).

101. See *id.* at 48 ("Many web pages are about 100 kilobytes in size and can be downloaded in half a second only if the user has full use of a T1 line at 1.5 Mbps. This simple calculation shows that anything slower than a T1 will result in usability problems when browsing the Web.").

102. See TSCNet, Inc., *TSCNet Information Center: FAQs*, at <http://www.tscnet.com/faq/internetfaq003.html> (last visited Apr. 17, 2000) (noting the much greater rate of speed T1 lines provide a visitor as compared to a slower modem).

103. See Jason R. Berne, *All Dressed Up and No Place to Go: The Need for Trade Dress Protection of Internet Sites*, 27 AIPLA Q.J. 265, 266 (1999) (noting that in non-virtual context of a restaurant, "even the changeable, unique impression a customer experiences when visiting . . . can be the basis for a valid trade dress protection claim").

104. See *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162, 34 U.S.P.Q.2d (BNA) 1161, 1162 (1995) (noting the Coca-Cola bottle is a registered trademark); *Coca-Cola Co. v. Alma Leo USA, Inc.*, 719 F. Supp. 725, 727-28, 12 U.S.P.Q.2d (BNA) 1487, 1488-89 (N.D. Ill. 1989) (finding the Coca-Cola bottle distinctive and defendant's use of a similar bottle was likely to dilute the reputation of the bottle's distinctiveness).

105. See Berne, *supra* note 103, at 272 (noting that "one Internet Site may present a different experience to a viewer, depending on what type of browser he or she uses").

106. See NIELSEN, *supra* note 2, at 46 (slow response time problem "is determined by the weakest link in the chain from server to browser").

107. See Berne, *supra* note 103, at 272 (noting the effect of different browsers on the appearance of a particular web site).

108. See NIELSEN, *supra* note 2, at 33-42 (noting that most web users are still using old browsers, including Netscape versions 1 or 2); MicroVision Dev., Inc., *Java and*

browsers cannot print framed pages,¹⁰⁹ while other browsers have limited graphic capability.¹¹⁰ In addition, the Netscape browser provides its users with an option to change the color of the browser's background.¹¹¹ The different capabilities of various browsers may affect the graphics, layout, sound, and color scheme that results in an overall look and feel of the web site unintended by the web designer and owner.¹¹² Users with a browser that cannot display graphics or sound, versus users with a browser that can change aspects of the viewing environment, may not experience the same look and feel of a web site.¹¹³

As a result of the differences among computers, screens, modem speed, and browsers, the overall look and feel of a web site may not be consistent to all visitors.¹¹⁴ Under trade dress law this poses a unique problem.¹¹⁵ The inconsistent appearance of a web site reduces its capability of functioning as a source identifier.¹¹⁶ Without the clear identification through the overall look and feel of a web site, visitors exposed to different presentations of the same web site "would have no way of returning to buy products that they have used and liked."¹¹⁷ Visitors may not be able to identify the trade dress of the web site as intended by the web site owner. Thus, the owner of a web site may face a harsh reality that there is no legal protection for

ActiveX, at <http://www.mvd.com/webguide> (last visited Feb. 2, 2000) (noting some Internet visitors using a browser "that is not capable of running Java applets, Java/VB scripts, and/or ActiveX—or even playing sound of any kind").

109. See NIELSEN, *supra* note 2, at 87.

110. See *id.* at 38-47 (noting that since the majority of web users are still using old browsers, it is a good idea for web designers to test their web sites on older browsers); see Mackenzie, *supra* note 75 ("Not all customers have graphical browsers, and in the near future, some may have browsers that haven't even hit the market yet . . . it is almost impossible to test your site on every browser.").

111. See SANO, *supra* note 6, at 62 (noting the many unique attributes of the Netscape browser).

112. See generally Lynch & Horton, *Web Style Guide: Site Design*, at http://info.med.yale.edu/caim/manual/sites/site_elements.html (last modified May 5, 1999) (commenting on the differences in capabilities of different browsers and encouraging site designers not to use large graphics menus due to this disparity).

113. See Lynch & Horton, *Web Style Guide: Multimedia*, at <http://info.med.yale.edu/caim/manual/multimedia/introduction.html> (last modified May 5, 1999) (noting that the ability to download audio files, as well as complex graphics, can vary from browser to browser and may end up costing visitors because they lack the requisite plug-in to fully appreciate the site).

114. See Berne, *supra* note 103, at 272 (noting the constant changing of Internet sites).

115. See *id.* ("One of the major challenges to applying trade dress protection to an Internet site is the inherent variability that exists . . .").

116. See *id.* (noting that variability "can make it difficult to determine what constitutes the product presented to the customer").

117. McCARTHY, *supra* note 17, § 3:2, at 3-3 (discussing four functions a trademark performs in commerce).

the look and feel of her web site.¹¹⁸

To avoid this problem and to facilitate the same look and feel of a web site to most visitors, developers of the web site should pay close attention to the browser problem in order to develop a browser neutral site.¹¹⁹ Although it is not possible to test the look and feel of a site on all browsers, testing the site with an outdated browser is ideal to ensure the site is accessible by customers of most browsers.¹²⁰ With regard to the content to be displayed in the frame window, web designers must check whether the content fits within the parameters of the frame window, even when run on lower resolution computers and smaller screens.¹²¹ In addition, web site developers should use graphics to create a look or a unique theme to a particular site,¹²² but should avoid graphics that require large computer screens or advanced connections.¹²³

D. Defining the Trade Dress of a Web Site in the Land of Links

Defining what constitutes trade dress is crucial to the quest for protection.¹²⁴ Although legal standards analyze trade dress in its entirety, courts nevertheless require the owner of a trade dress to articulate the elements composing the trade dress.¹²⁵

118. See Berne, *supra* note 103, at 274 (noting that currently “new site arrangements and layouts may be inherently distinctive but will never be able to obtain protection”).

119. See generally NIELSEN, *supra* note 2 (discussing browser issues); MacKenzie, *supra* note 75 (discussing browser neutral site and their benefits).

120. See NIELSEN, *supra* note 2, at 36 (suggesting that web designers collect old browsers to test whether their web pages work on older browsers); MacKenzie, *supra* note 75 (recommending web developers follow HTML standards because “it is almost impossible to test your site on every browser . . . and the one person who visits your site with an outdated browser may just be your best client”).

121. See GREENBERG & LAKELAND, *supra* note 44, at 145-46 (noting that “[m]ost browsers support frames, which is the subdividing of a Web page into sections, each section containing a Web page.”).

122. See NIELSEN, *supra* note 2, at 46 (advocating for the use of multiple occurrences of the same small image within a single page). Using this technique “will not only speed up download times but will also tie your entire site together visually.” *Id.* Likewise, reusing larger images such as product photos or a process diagram across pages is a good idea because when a large image is reused, “it should retain its meaning from page to page [and] users will often recognize the image.” *Id.*

123. See *id.* at 27 (noting that most web pages work well on a 17 inch monitor running at a resolution of at least 1024 x 768 pixels, thus, designers must create pages that will work on small screens and at that resolution to avoid cramped layouts that force users to scroll down in order to see the entire page); *Design Basics*, *supra* note 96 (“It is also *very important* to keep the time it takes a visitor to download your images uppermost in your mind when you design a Web site. This is true even if your site is *about* images and Web graphics.”) (emphasis in original).

124. See MCCARTHY, *supra* note 17, at 8-6 (noting “the marketplace exclusively granted by trade dress protection”).

125. See *id.* at 8-9 n.2 (quoting *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 765, 23 U.S.P.Q.2d (BNA) 1081, 1082 (1992)).

In the Internet environment, defining the boundaries of the look and feel of a web site poses several challenges.¹²⁶ Where does a web site begin and where does it end? A web site often has a home page, multiple internal pages, and numerous links to different sites.¹²⁷ Should the trade dress of a web site include just the home page, or should trade dress also extend to the internal pages and linked sites? This Article argues that the trade dress of a web site should be the overall appearance of the home page or possibly the home page and interior pages.¹²⁸ The overall appearance of a home page is significant because it is the place where visitors form the first impression of the web site in their minds.¹²⁹ In contrast, the look and feel of a web site should not include other linked sites because those linked sites are usually for and from different sources.¹³⁰

In the traditional trade dress context, courts look at the design, layout, graphics, background, and text to determine the trade dress of such items as a videogame,¹³¹ a computer-generated car care system,¹³² a line of greeting cards,¹³³ and the cover page of a book¹³⁴ or

126. See Berne, *supra* note 103, at 269-71 (noting many of the difficulties with Internet trade dress protection).

127. See NIELSEN, *supra* note 2, at 53 (structural navigational and associate links allow users to go to new place in the web page, site or the World Wide Web).

128. See *id.* at 166. From a web designer's point of view, the "home page is the flagship of the site and should therefore be designed different from the remaining page . . . should share same style, but there are differences." The home page must answer "Where Am I?" and "What does this site do?" for the consumers. See *id.*

129. The home page is analogous to the cover of a book or magazine. The court held trade dress protection applied to the cover of a book in *Casa Editrice Bonechi S.R.L. v. Irving Weisdorf & Co.*, 37 U.S.P.Q.2d (BNA) 1417, 1427 (S.D.N.Y. Sept. 6, 1995), and a magazine cover design, *Reader's Digest Ass'n v. Conservative Dig.*, 821 F.2d 800, 3 U.S.P.Q.2d (BNA) 1276 (D.C. Cir. 1987).

130. See Berne, *supra* note 103, at 278 (noting that there have been several law suits based on the problem created when the particular "look and feel" of a framed site is actually "that of the framing site").

131. See *M. Kramer Mfg. Co. v. Andrews*, 783 F.2d 421, 442, 228 U.S.P.Q. (BNA) 705, 719 (4th Cir. 1986) (extending trade dress protection to plaintiff's video game console, art work, and mark).

132. See *Computer Care v. Service Sys. Enters., Inc.*, 982 F.2d 1063, 1069, 25 U.S.P.Q.2d (BNA) 1020, 1024 (7th Cir. 1992) (extending trade dress protection to the car care system embodied in the plaintiff's sales brochure, reminder letters and monthly reports). Even though many of the elements of the sales brochure and monthly reports were generic and descriptive, the court held that the overall combination of the elements was largely arbitrary and therefore inherently distinctive. See *id.*

133. See *Hartford House, Ltd. v. Hallmark Cards, Inc.*, 846 F.2d 1268, 1270, 6 U.S.P.Q.2d (BNA) 2038, 2039 (10th Cir. 1988) (affirming that the arbitrary selection and combination of greeting card features constitute protectable trade dress even though the features are common). Examples of features are: two-fold card, deckle edge, lengthy poetry, and air brush colors. All of these features serve useful purposes in conveying messages and involving certain emotions and feelings. See *id.*

134. See *Casa Editrice Bonechi S.R.L. v. Irving Weisdorf & Co.*, 37 U.S.P.Q.2d (BNA) 1417, 1418 (S.D.N.Y. 1995) (describing the different characteristics of a

magazine.¹³⁵ Similarly, the color scheme, graphics, text, animation, video, sound, design, layout, background, or any combination thereof are relevant in an attempt to define the trade dress of a web site.¹³⁶ Viewing all of the features constituting the look and feel of a web site, the appropriate question for trade dress protection is whether the overall look and feel of a web site is inherently distinctive.¹³⁷

IV. INHERENTLY DISTINCTIVE LOOK AND FEEL WEB SITES?

A trade dress is inherently distinctive if the total appearance and image of a product or service alone can identify the source of the product or service.¹³⁸ For example, the décor of the Taco Cabana, a Mexican restaurant chain, that includes artifacts, bright awnings, umbrellas, neon stripes and murals, when taken as a whole, is inherently distinctive.¹³⁹ Thus, the overall décor of the Taco Cabana restaurant chain is capable of serving as a source identifier.¹⁴⁰ This definition of “inherently distinctive” is a direct importation from the well-known classification of trademark protection in accordance with the marks’ relative distinctiveness.¹⁴¹ The Second Circuit in *Abercrombie & Fitch Co. v. Hunting World, Inc.*,¹⁴² categorized trademarks into the following types: (1) generic, (2) descriptive, (3) suggestive, (4) arbitrary, and (5) fanciful.¹⁴³

Suggestive,¹⁴⁴ arbitrary,¹⁴⁵ or fanciful¹⁴⁶ trade dress are entitled to

guidebook that constitute trade dress).

135. See *Reader's Digest Ass'n v. Conservative Digest*, 821 F.2d 800, 805, 3 U.S.P.Q.2d (BNA) 1276, 1278 (D.C. Cir. 1987) (describing the characteristics of a magazine that constitute a trade dress).

136. See *Ballon*, *supra* note 53, at 89 (noting that “in order to be registered, a mark must be capable of distinguishing the applicant’s goods from those of others”).

137. See *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768, 23 U.S.P.Q.2d (BNA) 1081, 1083-84 (1992) (noting the importance of inherent distinctiveness in a trade dress situation).

138. See *id.* at 768 (contrasting with “generic marks—those that ‘refer to the genus of which the particular product is a species’” (quoting *Park ‘N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 194, 224 U.S.P.Q. (BNA) 327, 329 (1985))).

139. See *id.* at 765, 23 U.S.P.Q.2d (BNA) at 1082 (noting the different characteristics of the restaurant).

140. See *Two Pesos*, 505 U.S. at 768, 23 U.S.P.Q.2d (BNA) at 1086 (noting that the categories identifying a source of a product are inherently distinctive).

141. See *id.* (noting the classic trademark classification formulated by Judge Friendly in *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9, 189 U.S.P.Q. (BNA) 759, 764 (2d Cir. 1976)).

142. 537 F.2d 4, 9, 189 U.S.P.Q. (BNA) 759, 764 (2d Cir. 1976).

143. See *id.* (noting that these categories are “[a]rranged in ascending order which roughly reflects their eligibility to trademark status”).

144. See *Nabisco, Inc. v. Warner-Lambert Co.*, 220 F.3d 43, 45, 55 U.S.P.Q.2d (BNA) 1051, 1053 (2d Cir. 2000) (“[S]uggestive marks are deemed inherently distinctive. Their intrinsic nature serves to identify a particular source of a product, so they will be automatically protected.” (quoting *Lane Capital Mgmt., Inc. v. Lane Capital Mgmt., Inc.*, 192 F.3d 337, 344, 52 U.S.P.Q.2d (BNA) 1094, 1097 (2d Cir.

protection under the Lanham Act because they are sufficiently distinctive themselves to serve as source identifiers.¹⁴⁷ An arbitrary or fanciful mark or trade dress bears no relationship to its product, while a suggestive mark or trade dress suggests a particular characteristic of the product or service, but one from which the consumer must use his or her imagination to conclude its nature.¹⁴⁸

At the other end of the spectrum of the *Abercrombie* classification is generic trade dress. A generic trade dress generally includes features that are widely used in a particular industry and are incapable of serving as source identifiers and, as a result, receives no protection.¹⁴⁹ For example, grape leaf designs for wine are generic because wine bottlers have long used such designs to decorate their labels.¹⁵⁰

Applying trade dress law to the Internet context of a web site that (a) overcomes all the challenges discussed in Section II¹⁵¹ and (b) has unusual, memorable, overall appearance generated by the graphics, color scheme, sounds, video, animation, designs, and/or layout,

1999))) (alterations in original); *Lane Capital Management*, 192 F.3d at 344, 52 U.S.P.Q.2d (BNA) at 1097 ("A mark is suggestive if it merely suggests the features of the product, requiring the purchaser to use imagination, thought, and perception to reach a conclusion as to the nature of the goods.").

145. See *Lane Capital Management*, 192 F.3d at 344, 52 U.S.P.Q.2d (BNA) at 1097 ("An arbitrary mark applies a common word in an unfamiliar way.").

146. See *id.* ("A fanciful mark is not real word at all, but is invented for its use as a mark.").

147. See *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768, 23 U.S.P.Q.2d (BNA) 1081, 1083 (1992) (comparing such marks to generic marks which are not registerable as trademarks and thus not entitled to similar protection under the Lanham Act).

148. See *Pebble Beach Co. v. Tour 18 I, Ltd.*, 155 F.3d 526, 540, 48 U.S.P.Q.2d (BNA) 1065, 1074 (5th Cir. 1998) (analyzing fanciful and arbitrary marks or trade dress in relation to the respective products).

149. See *Ale House Mgmt., Inc. v. Raleigh Ale House, Inc.*, 205 F.3d 137, 142, 54 U.S.P.Q.2d (BNA) 1040, 1044 (4th Cir. 2000) ("Trade dress should be considered generic if [it is] well-known or common, a mere refinement of a commonly-adopted and well-known form of ornamentation, or a common basic shape or design, even if it has not before been refined in precisely the same way.") (internal quotation marks omitted); *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 194, 224 U.S.P.Q. (BNA) 327, 329 (1985) (stating that generic trademarks are common words that refer "to the genus of which the particular product is a species") (citing *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9, 189 U.S.P.Q. (BNA) 759, 764 (2d Cir. 1979)).

150. See *Kendall-Jackson Winery, Ltd. v. E. & J. Gallo Winery*, 150 F.3d 1042, 1049, 47 U.S.P.Q.2d (BNA) 1332, 1336 (9th Cir. 1998) (explaining that because grape leaf designs are so widely used in the wine industry, it has lost the power to distinguish between brands); see also *Fun-Damental Too, Ltd. v. Gemmy Indus. Corp.*, 111 F.3d 993, 1000, 42 U.S.P.Q.2d (BNA) 1348, 1353 (2d Cir. 1997) (noting that "the cosmetics industry's common use of black, rectangular-shaped compacts renders that [trade dress] packaging generic").

151. See *supra* Part II (discussing challenges to maintaining trade dress protection). For simplification purposes, discussion from here forward assumes that the web site is qualified for trade dress consideration and has overcome all the challenges caused by the Internet environment as analyzed in Part II.

would result in a web site capable of serving as a source identifier.¹⁵² The distinctive, overall appearance of the look and feel of the web site should contain fanciful, arbitrary, or suggestive features, not mostly descriptive or generic elements.¹⁵³ The unusual or memorable features of the web site must bear no relationship to the product or service to which the trade dress is used.¹⁵⁴ Creatively designed web sites are more likely to be deemed protectable.¹⁵⁵ For example, a web site that provides wholesale and retail distribution of tropical fruit would have a suggestive look and feel if it displayed a jungle background with animated monkeys swinging at each link.¹⁵⁶

152. See *Fun-Damental Too*, 111 F.3d at 993, 42 U.S.P.Q.2d (BNA) at 1359 (affirming the district court's finding that the trade dress of a toy coin bank in the shape of a toilet was distinctive). A trade dress is inherently distinctive if its "intrinsic nature serves to identify a particular source of a product," although it may not yet have widespread identification among consumers." *Id.* at 1000, 42 U.S.P.Q.2d (BNA) at 1353. "Suggestive, arbitrary and fanciful trade dress are deemed inherently distinctive." *Id.* "A . . . trade dress is descriptive if it 'identifies a characteristic or quality of an article or service, such as its color, odor, function, dimensions or ingredients.'" *Pebble Beach*, 155 F.3d at 539, 48 U.S.P.Q.2d (BNA) at 1073 (citation omitted). "A . . . descriptive trade dress is protectable only when it has 'acquir[ed] a secondary meaning in the minds of the consuming public.'" *Id.* See also *Computer Care v. Service Sys. Enters., Inc.*, 982 F.2d 1063, 1068, 25 U.S.P.Q.2d (BNA) 1020, 1024 (7th Cir. 1992) (finding the overall combination of a car care system, including sales brochure, reminder letters and monthly reports, is largely arbitrary and therefore inherently distinctive); see also RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 13 cmt. d (1995) ("A symbol or graphic design is not inherently distinctive unless the nature of the designation and the manner of its use make it likely that prospective purchasers will perceive the designation as an indication of source Thus, unless the symbol or design is striking, unusual, or otherwise likely to differentiate the products of a particular producer, the designation is not inherently distinctive."). For information relating to unique, attractive and fast loading web pages, see generally DEKE MCCLELLAND & KATRIN EISMANN, *WEB DESIGN STUDIO SECRETS* (1998) (providing advice from experts who developed popular web sites); MARY E. S. MORRIS & RANDY J. HINRICHS, *WEB PAGE DESIGN 2-3* (1996) (advocating the use of multimedia as the user's eyes and ears in web designing).

153. See *Computer Care*, 982 F.2d at 1069, 25 U.S.P.Q.2d (BNA) at 1024 (stating that "[w]here the plaintiff's overall trade dress is distinctive, the fact that it uses descriptive (or generic) elements does not render it nonprotectable") (citing *Two Pesos, Inc. v. Taco Cabana, Inc.*, 932 F.2d 1113, 1120, 19 U.S.P.Q.2d (BNA) 1253, 1257 (5th Cir. 1991)).

154. See *supra* notes 144-46 and accompanying text (describing arbitrary and fanciful trade dress); see also *AmBrit, Inc. v. Kraft, Inc.*, 812 F.2d 1531, 1537, 1 U.S.P.Q.2d (BNA) 1161, 1165 (11th Cir. 1986) (finding that the "overall appearance of the Klondike trade dress and of its constituent elements is arbitrary or suggestive. The trade dress does not describe the ice cream product, rather it suggests to the consumer the coldness of the product").

155. See *Ballon*, *supra* note 53, at 89 (noting that changes in the computer industry occur at a rapid pace, and thus, creatively designed web sites are less likely to become generic).

156. See *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 773, 23 U.S.P.Q.2d (BNA) 1081, 1085 (1992) (applying the Abercrombie trademark classification to trade dress). The trade dress applicable under the Abercrombie classification is "product packaging" trade dress. See *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 210-11, 120 S. Ct. 1339, 1343, 54 U.S.P.Q.2d (BNA) 1065, 1068 (2000); see also *Fun-Damental Too*, 111 F.3d at 1001, 42 U.S.P.Q.2d (BNA) at 1354 (applying the

If the trade dress of a web site is inherently distinctive, the additional requirement of secondary meaning is not required under *Two Pesos* because such a requirement in trade dress cases could have anticompetitive effects, creating particular burdens on startup companies.¹⁵⁷ A secondary meaning requirement would present special difficulties for a young company that seeks to start and expand its business into new markets.¹⁵⁸ Imposing the additional requirement of secondary meaning on inherently distinctive trade dress would permit a competitor, who has not designed a distinctive look and feel for his own web site, to appropriate the distinctive trade dress of the original web site into other markets of electronic commerce on the Internet. Additionally, it would deter the owner of the original web site from expanding and competing in these markets.¹⁵⁹

Furthermore, in the Internet environment, copying clipart, animated features, logos, and images found on other companies' web sites is only one click away.¹⁶⁰ Although a third party's isolated or piecemeal uses of various elements of an inherently distinctive trade dress of a web site "does not detract from the distinctiveness of the overall impression conveyed by the combination of [the] elements" in the web site,¹⁶¹ the ease of copying features of trade dress on the web raises the urgency of extending protection to web sites that have inherently distinctive features.¹⁶²

If a web site is not inherently distinctive, could it ever acquire distinctiveness through use and advertising? Consider a web site

Abercrombie classification to a trade dress packaging case involving a toy coin bank closely resembling the familiar white tank toilet).

157. See *Two Pesos*, 505 U.S. at 775, 23 U.S.P.Q.2d (BNA) at 1086.

158. See *id.*

159. The Court in *Two Pesos* noted that:

adding a secondary meaning requirement could have anticompetitive effects, creating particular burdens on the startup of small companies. It would present special difficulties for a business . . . that seeks to start a new product in a limited area and then expand into new markets. Denying protection for inherently distinctive nonfunctional trade dress until after secondary meaning has been established would allow a competitor, which has not adopted a distinctive trade dress of its own, to appropriate the originator's dress in other markets and to deter the originator's dress from expanding into and competing in these areas.

See *id.*

160. See SANO, *supra* note 6, at 77 (noting that it only takes a few seconds to copy an image); Abel, *supra* note 8, at 166-67 (discussing how companies' animated logos can be downloaded to the web browser and taken to a different site).

161. See *AmBrit, Inc. v. Kraft, Inc.*, 812 F.2d 1531, 1538-39, 1 U.S.P.Q.2d (BNA) 1161, 1166 (11th Cir. 1986).

162. See *Pebble Beach Co. v. Tour 18 I, Ltd.*, 155 F.3d 526, 536, 48 U.S.P.Q.2d (BNA) 1065, 1070 (5th Cir. 1998) (noting that trade dress is protectable if it is inherently distinctive regardless if it is registered or unregistered).

selling music compact discs that has graphics of compact discs on its home page and link buttons in the shape of compact discs at the top of every internal page.¹⁶³ Should the look and feel of a web site such as this receive trade dress protection? Clearly, the trade dress of the web site in this scenario is descriptive because it describes the characteristic of the web site, i.e., selling compact discs. If the owner of such trade dress can prove that through years of exclusive use of the trade dress in commerce and after an extensive advertising campaign to establish in the public's mind that the trade dress identifies source or origin, then trade dress would have acquired distinctiveness.

Trade dress law provides protection to descriptive trade dress that has acquired distinctiveness or secondary meaning.¹⁶⁴ For example, the total appearance of Pebble Beach and Pinehurst's golf holes is descriptive because it (1) is the configuration of commonplace features of a golf hole, and (2) bears a relationship to the product, a golf hole.¹⁶⁵ The burden is on the owner of a descriptive trade dress to establish that the trade dress has attained a secondary meaning.¹⁶⁶ Should the traditional factors for establishing secondary meaning be applied in determining whether a descriptive trade dress of a web site has acquired secondary meaning?

V. THE QUEST FOR SECONDARY MEANING OF THE LOOK AND FEEL OF A WEB SITE

Secondary meaning is a consumer's mental association or recognition between a trade dress and the source of the product or service bearing the trade dress.¹⁶⁷ A descriptive trade dress develops

163. See *Custom Discs*, *supra* note 7 (web site selling compact discs).

164. See Lanham Act § 2, 15 U.S.C. § 1052(e)-(f) (1994 & Supp. IV 1998) (stating that descriptive mark may be registered if it "has become distinctive of the applicant's goods in commerce"); see also *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 769, 23 U.S.P.Q.2d (BNA) 1081, 1083-84 (1992) (describing an acquired distinctiveness as the concept of secondary meaning). "Generic trade dress 'consisting of the shape of a product that conforms to a well-established industry custom' is not protectable." *Nora Beverages, Inc. v. Perrier Group of Am., Inc.*, 164 F.3d 736, 743, 49 U.S.P.Q.2d (BNA) 1385, 1388 (2d Cir. 1998). An example of generic trade dress is the "packaging of lime-flavored soda in green twelve-ounce cans." *Id.*

165. See *Pebble Beach*, 155 F.3d at 540, 48 U.S.P.Q.2d (BNA) at 1074 (identifying the relationship between the characteristics of Pebble Beach and Pinehurst's golf holes and the product, which is a golf hole).

166. See *Fun-Damental Too*, 111 F.3d at 999, 42 U.S.P.Q.2d (BNA) at 1352 (citing *Two Pesos*, 505 U.S. at 769, 23 U.S.P.Q.2d (BNA) at 1084 (listing elements a party must demonstrate to meet this burden of establishing trade dress infringement)).

167. See *Two Pesos*, 505 U.S. at 766 n.4, 23 U.S.P.Q.2d (BNA) at 1082 (noting that secondary meaning indicates that a mark or dress has been uniquely associated with a specific source); *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 851 n.11, 214

secondary meaning often through long and extensive use and advertising.¹⁶⁸ In general, secondary meaning can be established through length and manner of use, amount and manner of advertising, volumes of sales, place in the market, consumer testimony, consumer surveys, and proof of intentional copying.¹⁶⁹

Courts often focus on the length and manner of use of the trade dress in connection with the sale of goods in determining secondary meaning.¹⁷⁰ Use of the trade dress must be consistent and continuous to create a distinct commercial impression as an indicator of a source.¹⁷¹ Evidence of five years of exclusive use of the trade dress weighs strongly in favor of secondary meaning.¹⁷² Given the recent growth in the World Wide Web, many web sites are newer than five

U.S.P.Q. (BNA) 1, 4 (1982) ("To establish secondary meaning, a manufacturer must show that, in the minds of the public, the primary significance of a product feature or term is to identify the source of the product rather than the product itself.") (citing *Kellogg Co. v. Nat'l Biscuit Co.*, 305 U.S. 111, 118 (1938)). See generally Ronald J. Horta, Note, *Without Secondary Meaning, Do Product Design Trade Dress Protections Function as Infinite Patents?*, 27 SUFFOLK U. L. REV. 113 (1993) (discussing secondary meaning and the implications of *Two Pesos* in product design trade dress and patents). See also *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 215, 120 S. Ct. 1339, 1345, 54 U.S.P.Q.2d (BNA) 1065, 1069 (2000) (affirming *Two Pesos*'s legal principle that trade dress product packaging can be inherently distinctive and thus, entitled to protection without proof of secondary meaning); *Fun-Damental Too*, 111 F.3d at 1001, 42 U.S.P.Q.2d (BNA) at 1354 (applying *Two Pesos* to trade dress packaging). Even if a trade dress contains some descriptive or generic elements, the trade dress is protectible as long as the overall impression of the combination of all the elements is inherently distinctive. *Id.*

168. See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 13 cmt. e (Tentative Draft No. 2, 1990) ("Secondary meaning is used generally to indicate that a mark or dress 'has come through use to be uniquely associated with a specific source.'").

169. See *Thomas & Betts Corp. v. Panduit Corp.*, 138 F.3d 277, 291, 46 U.S.P.Q.2d (BNA) 1026, 1036 (7th Cir. 1998) (listing the types of evidence for secondary meaning); see also *Pebble Beach*, 155 F.3d at 541, 48 U.S.P.Q.2d (BNA) at 1074 ("While each of these types of evidence alone may not prove secondary meaning, in combination they may indicate that consumers consider the mark or trade dress to be an indicator of source.").

170. See, e.g., *Rock & Roll Hall of Fame & Museum, Inc. v. Gentile Prods.*, 134 F.3d 749, 755, 45 U.S.P.Q.2d (BNA) 1412, 1417 (6th Cir. 1998) (denying protection to museum building design because the plaintiff failed to demonstrate that the design has been consistently in use as a source designator).

171. See *id.* (noting that one of the hallmarks of a trademark is the consistent and repetitive use of a designation as an indicator of the source).

172. See *Thomas & Betts*, 138 F.3d at 295, 46, U.S.P.Q.2d (BNA) at 1040; see also *Tools USA & Equip. Co. v. Champ Frame Straightening Equip., Inc.*, 87 F.3d 654, 659-60, 39 U.S.P.Q.2d (BNA) 1355, 1360 (4th Cir. 1996). The court noted in *Tools USA*:

If a particular product's trade dress has acquired a secondary meaning, then the consuming public associates that product with a certain producer, and, most importantly, is likely to make that same association when the trade dress is used on another producer's product. The public need not be able to identify the name of the manufacturer that produces the product; it is enough if the public perceives that the product emanate from a single source.

See *id.*

years old.¹⁷³ Therefore, at present, the length of use factor may not be feasible.¹⁷⁴ Similarly, obtaining survey evidence of customer recognition of the overall look and feel of a web site that has not been in existence for a long period of time may be impossible.¹⁷⁵

Obviously, long duration of use of the trade dress of a web site enhances the trade dress exposure of the visitors to the web site.¹⁷⁶ Also, if the trade dress of a web site has a unique overall look and feel, the trade dress most likely enjoys higher visibility than a trade dress among several dozen similar trade dresses.¹⁷⁷

In accessing secondary meaning, courts also look at the amount and manner of advertising of the goods in connection with the trade dress.¹⁷⁸ Extensive and consistent advertisement emphasizing the source significance of the designation through prominent use of the trade dress will increase the likelihood that consumers will identify the trade dress and distinguish it from others.¹⁷⁹

In the Internet context, it is not practical to use the overall look and feel of a web site in advertising as would be done by traditional

173. The number of web servers has grown from 2,738 in June 1994 to 6,177,453 web servers in June 1999. See Zakon, *supra* note 72 (listing web site statistics).

174. See *Gimix, Inc. v. JS & A Group, Inc.*, 699 F.2d 901, 907, 217 U.S.P.Q. (BNA) 677, 682-83 (7th Cir. 1983) (noting that the length of use is a factor that can shed light on the ultimate issue of how the public regards the mark in question).

175. Survey evidence has been held as "the most direct and persuasive evidence of secondary meaning [because] the ultimate determination whether a particular mark or dress has acquired secondary meaning remains an empirical question of consumer association." *Sunbeam Prods., Inc. v. West Bend Co.*, 123 F.3d 246, 253-54, 44 U.S.P.Q.2d (BNA) 1161, 1166 (5th Cir. 1997).

176. See *Centaur Communications, Ltd. v. A/S/M Communications, Inc.*, 830 F.2d 1217, 1225, 4 U.S.P.Q.2d (BNA) 1541, 1547 (2d Cir. 1987) (indicating length and exclusivity of the use of a trade dress weigh in favor of a finding of secondary meaning), *overruled on other grounds by* *Paddington Corp. v. Attiki Importers & Distributors, Inc.*, 996 F.2d 577, 27 U.S.P.Q. (BNA) 1189 (2d Cir. 1993); *Pizzeria Uno Corp. v. Temple*, 747 F.2d 1522, 1528 n.3, 224 U.S.P.Q. (BNA) 185, 189 n.3 (4th Cir. 1984) (considering four factors: "(1) long use; (2) advertising; (3) sales volume; and (4) identity of service or origin in the minds of the purchasing public").

177. See, e.g., *EFS Mktg., Inc. v. Russ Berrie & Co.*, 76 F.3d 487, 490-91, 37 U.S.P.Q.2d (BNA) 1646, 1649-50 (2d Cir. 1996) (finding that "troll" doll design cannot possess secondary meaning because more than twenty companies have similar doll designs on the market); *P.F. Cosmetique, S.A. v. Minnetonka, Inc.*, 605 F. Supp. 662, 668, 226 U.S.P.Q. (BNA) 86, 89-90 (S.D.N.Y. 1985) (finding the trade dress for packaging personal care products as weak because its designs and motifs are commonly used by several competitors).

178. See *Pebble Beach Co. v. Tour 18 I, Ltd.*, 155 F.3d 526, 541, 48 U.S.P.Q.2d (BNA) 1065, 1075 (5th Cir. 1998) (analyzing Thomas & Betts's advertising for evidence of secondary meaning (quoting RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 13 cmt. C., at 110; *Thomas & Betts Corp. v. Panduit Corp.*, 138 F.3d 277, 292, 46 U.S.P.Q.2d (BNA) 1026, 1036 (7th Cir. 1998))).

179. See *Pebble Beach*, 155 F.3d at 541, 48 U.S.P.Q.2d (BNA) at 1075 (noting that prominent use of trade dress in advertising can alter the meaning of trade dress for consumers).

advertising when promoting the recognition of a trade dress.¹⁸⁰ The overall look and feel of a web site cannot be fully presented in print media like traditional trade dress such as the dress of the Coca-Cola bottle or can.¹⁸¹ Graphics, animation, voice and interactive features of the trade dress of a web site cannot be easily translated into print. Furthermore, advertising the overall look and feel of a web site in the electronic media, like, television is extremely costly and perhaps may not be feasible.¹⁸²

The purpose of advertising a product is to increase the visibility of the product among consumers. Traditionally, expenditures on advertising are quantified as a monetary sum. In the Internet environment, however, the visibility of a web site is measured by the number of visitors to that site.¹⁸³ Accordingly, in the Internet context, courts should look at the underlying reasons for visibility, i.e., how the web site is organized, whether the overall look and feel affects the number of visitors frequenting the site, and what percentage of expenditures is devoted to maintaining that organization and look.

Sales success of the product bearing the trade dress is one indicator that a trade dress has acquired secondary meaning.¹⁸⁴ Consumers have come to associate the trade dress with a particular source and, therefore, purchase the products or services instead of other available options.¹⁸⁵ In the Internet context, sales success is measured by the

180. Other commentators who focus on trade dress protection for user interfaces provide some discussion on how developers of successful user interfaces for Microsoft Windows, Apple Macintosh and Lotus 1-2-3 established secondary meaning for their user interfaces. See Lauren Fisher Kellner, Comment, *Trade Dress Protection for Computer User Interface "Look and Feel,"* 61 U. CHI. L. REV. 1011, 1022-23 (1994) (explaining that secondary meaning can be established through advertisements featuring photographs of computer screens running the program, significant advertising expenditures, widespread sales, and consumer surveys).

181. See LYNDIA WEINMAN & BRUCE HEAVIN, <COLORING WEB GRAPHICS.2> THE DEFINITIVE GUIDE TO COLOR ON THE WEB 5 (1997) (noting that color artwork on the Web is very different from a traditional medium because there is high variability among computers, operating systems and web browsers).

182. See Stuart Elliott, *Big Plays, Surprise Heroes, Shocking Defeats, and other Super Bowl XXXIV Marketing Memories*, N.Y. TIMES, Feb. 1, 2000, at C10 ("Seventeen of the 36 marketers buying national commercial time during the game for a record average of \$2.2 million for each 30 seconds came from the Internet World."). None of the Internet companies, however, used the overall look and feel of their web sites in the advertisement clips. See *id.*

183. See NIELSEN, *supra* note 2, at 14-15; MacKenzie, *supra* note 75 (outlining tips on how to design a professional web site).

184. See, e.g., *Vaughan Mfg. Co. v. Brikam Int'l, Inc.*, 814 F.2d 346, 348, 1 U.S.P.Q.2d (BNA) 2067, 2069 (7th Cir. 1987) (noting that secondary meaning may be established through longstanding, exclusive, and continuous use, coupled with massive sales and advertising).

185. See, e.g., MCCARTHY, *supra* note 17, § 3:2, at 3-3 ("Without the identification function performed [by a trade dress], buyer would have no way of returning to buy products that they have used and liked.").

number of visitors frequenting a site.¹⁸⁶ For example, the web site Yahoo.com does not sell any product to the average user over the Internet, nor does it sell products bearing the company trade dress, but rather, it provides free content to visitors. It is one of the most successful e-companies and sites on the Internet and the company stock has a market capitalization of about \$93.22 billion dollars.¹⁸⁷ Likewise, Amazon.com is a highly visited site, but it has yet to make a sales profit.¹⁸⁸

Another factor in determining whether a trade dress has attained secondary meaning is the intent of a competitor in copying a trade dress.¹⁸⁹ If the intention is to pawn off the goodwill generated by the owner of the trade dress through years of use and advertising, a reasonable conclusion can be drawn that the trade dress has achieved some recognition in the marketplace.¹⁹⁰

Third party use is another factor for assessing secondary meaning. Numerous third party use of similar trade dress in the same market will dilute any consumer recognition and association of that trade dress with its owner.¹⁹¹ This factor and the intent of competitor to

186. See NIELSEN, *supra* note 2, at 10-11 (noting the competition for users is high because there are about 10 million sites as of January 2000 and this number will increase to 25 million by 2001 and a hundred million by 2002); MacKenzie, *supra* note 75 (providing tips on developing a "top-quality and professional web site" that attracts visitors and promotes repeat visits).

187. See Yahoo, Inc., *Yahoo! Finance*, at <http://finance.yahoo.com/q?s=yahoo&d=t> (last visited Aug. 1, 2000) (stating that Yahoo's market capitalization on March 29, 2000 was \$93.22 billion dollars). Yahoo serves up to 465 million web page views each day. See Matt Richtel, *Yahoo Blames a Hacker Attack for a Lengthy Service Failure*, N.Y. TIMES, Feb. 8, 2000, at C11 (stating that Yahoo's service failure on February 3, 2000, due to a hacker assault that caused approximately \$500,000 in lost advertising and e-commerce revenue was an insignificant loss for the company).

188. See Paul D. Hepig & Nicole Sperling, *Forward the Fantasy World of Jeff Bezos*, RED HERRING, 42-44 (Oct. 30, 2000) (reporting that Amazon.com took \$1.5 billion in losses on \$3.6 billion in revenue). Though, Amazon.com had 3.8 million new customers in the 4th quarter of 1999 and a total of 14 million active customers, it continued to lead other companies as the giant on-line losing company with a major financial loss soaring in the fourth quarter of 1999. See Sual Hanson, *Amazon Loss Soared 543% In 4th Quarter*, N.Y. TIMES, Feb. 3, 2000, at C1 (stating that Amazon.com lost \$323 million in the fourth quarter of 1999 which was 543% more than it lost in the same quarter a year earlier).

189. See *M. Kramer Mfg. Co. v. Andrews*, 783 F.2d 421, 448, 228 U.S.P.Q. (BNA) 705, 724 (4th Cir. 1986) (holding that "evidence of intentional, direct copying establishes a prima facie case of secondary meaning sufficient to shift the burden of persuasion to the defendant on that issue, and, since the defendant has offered no credible evidence rebutting this presumption, the infringement is established").

190. See MCCARTHY, *supra* note 17, at 8-23 to 8-27 (noting although a number of courts held that "intentional copying of trade dress is surrogate evidence of secondary meaning," other courts treat intentional copying as evidence probative of secondary meaning or presumption of secondary meaning).

191. See *generally* *Am. Heritage Life Ins. Co. v. Heritage Life Ins. Co.*, 494 F.2d 3, 12-13, 182 U.S.P.Q. (BNA) 77, 84-86 (5th Cir. 1974) (stating that the lack of exclusivity of use is a factor against secondary meaning).

copy factor, however, may not be useful in the Internet context. On the Internet, clipart, images, or graphics are freely available for users to copy to their web sites.¹⁹² To extend trade dress protection to a web site that contains such free designs may interfere with the right of other users who rely on the free clipart, images, or graphics for their web sites. Further, the owner of such a descriptive look and feel web site is permitted the exclusive right to designs that she originally did not own. To prevent such exclusivity to elements of a descriptive look and feel web site, trade dress protection extends only to the way that the elements are combined, and not the elements themselves.¹⁹³

As demonstrated above, some of the factors should be modified if secondary meaning inquiry is to be applied to web sites with descriptive look and feel. Factors such as sales success should not be measured solely on monetary amount earned, but should also consider the number of visitors to a web site. Because most web sites have not been in use long enough for consumers to associate the descriptive look and feel of a web site with a source, a consumer recognition survey is unobtainable at the present time. Further, advertising expenditure and the manner of advertising factors are not readily obtainable because the means to capture the look and feel of a website for use in advertising are limited. Courts should not accord these factors with the same significance as in traditional dress or trade mark cases.

VI. THE UNIFORMITY SYNDROME AND FUNCTIONALITY

Another challenge to extending trade dress protection to the look and feel of a web site is functionality. The judicially created doctrine of functionality balances the right of the owner of a trade dress with the right of a competitor who needs to use elements of the trade dress for effective competition.¹⁹⁴ The functionality limitation on

192. See SANO, *supra* note 6, at 77 (explaining that many images found on the Internet are available for free); Abel, *supra* note 8, at 166-77 (stating that graphic features and companies' logos can be downloaded and copied); see also MicroVision Dev., Inc., *Home: Free Images*, at <http://www.mvd.com/webguide/links4.shtml> (last visited Mar. 29, 2000) for links to a number of web sites providing free images. See, e.g., Art Holden & Jim Maloney, *Animation Factory*, at <http://www.eclipsed.com> (last visited Mar. 29, 2000); *All Free Clip Art*, at <http://www.allfreeclipart.com> (last visited Nov. 6, 2000); Wanderers Prod. Corp., *Wanderers Com Server System*, at <http://wanderers2.com> (last visited Apr. 21, 2000).

193. See *Computer Care v. Service Sys. Enters., Inc.*, 982 F.2d 1063, 1071, 25 U.S.P.Q.2d (BNA) 1020, 1026 (7th Cir. 1992) (stating that plaintiff seeks to protect the overall format of each of its monthly reports, which defendant copied in its entirety); see also Part VI, *infra*, for a discussion on functionality.

194. See, e.g., Willajeanne F. McLean, *Opening Another Can of Worms: Protecting Product Configuration as Trade Dress*, 66 U. CIN. L. REV. 119, 124-29 (1997) (explaining

trade dress prevents a perpetual patent grant for a trade dress.¹⁹⁵

A trade dress is functional if the feature or features claimed within the trade dress are as a whole “essential to the use or purpose of the article or if it affects the cost or quality of the article.”¹⁹⁶ This definition of functionality has been a subject of criticism.¹⁹⁷ Accordingly, courts have attempted to redefine functionality.¹⁹⁸ Some courts have determined that a trade dress is functional if it “performs some function other than identifying the source of the goods.”¹⁹⁹ Other courts have defined a trade dress as functional “if exclusive use of the feature would put competitors at a significant non-reputation related disadvantage.”²⁰⁰ In other words, a trade dress is functional if there are no alternatives, or available alternatives are too costly for

that the functionality doctrine aims to limit the protection of elements needed so that others may compete in the market).

195. See *Thomas & Betts Corp. v. Panduit Corp.*, 138 F.3d 277, 288, 46 U.S.P.Q.2d (BNA) 1026, 1033 (7th Cir. 1998) (“The safeguard against an impermissible extension of a patent monopoly by a trademark . . . is the functionality doctrine.”); *Stormy Clime, Ltd. v. ProGroup, Inc.*, 809 F.2d 971, 977-78, 1 U.S.P.Q.2d (BNA) 2026, 2031-32 (2d Cir. 1987) (“To avoid undermining the purpose of the patent laws to place useful innovations in the public domain after expiration of a limited monopoly, courts must be sensitive to whether a grant of trade dress protection would close all avenues to a market that is otherwise open in the absence of a valid patent.”); see also Jay Dratler, Jr., *Trade Dress Protection for Product Configurations: Is There A Conflict With Patent Policy?*, 24 AIPLA Q.J. 427, 506-20 (1996) (discussing the various judicial standards for determining whether a design is functional and therefore not protected as a trade dress); Manotti L. Jenkins, *A Request To The High Court: Don't Let The Patent Laws Be Distracted By A Flashy Trade Dress*, 15 J. MARSHALL J. COMPUTER & INFO. L. 323 (1997) (criticizing the Tenth Circuit's decision in *Vornado Air Circulation Sys., Inc. v. Duracraft Corp.*, 58 F.3d 1498, 1506, 35 U.S.P.Q.2d (BNA) 1332, 1339 (10th Cir. 1995) in which the court held that “[product] configurations can simultaneously be patentably useful, novel, and nonobvious [hence capable of receiving a utility patent] and also nonfunctional, in trade dress parlance” and thus a candidate for trade dress protection).

196. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165, 34 U.S.P.Q.2d (BNA) 1161, 1165 (1995) (quoting *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 850 n.10, 214 U.S.P.Q. (BNA) 1, 4 n.10 (1982)).

197. See, e.g., Mitchell M. Wong, Note, *The Aesthetic Functionality Doctrine and the Law of Trade Dress Protection*, 83 CORNELL L. REV. 1116, 1132-52 (1998) (dividing the *Qualitex* definition of functionality into “identification theory,” which focuses on the “affects the cost or value” portion of the Court's definition and “competition theory,” which focuses on the “essential to the use or purpose” portion of the Court's definition). Under the identification theory, a feature is functional if it imparts any value or utility to the product beyond source identification. See *id.* at 1153. In contrast, a feature is functional under the competition theory if it inhibits competition. See *id.*

198. See *Planet Hollywood, Inc. v. Hollywood Casino Corp.*, 80 F. Supp. 2d 815, 888 (N.D. Ill. 1999) (using a different definition of functionality than was used in *Qualitex*).

199. *Aromatique, Inc. v. Gold Seal, Inc.*, 28 F.3d 863, 873 (8th Cir. 1994).

200. *Qualitex*, 514 U.S. at 165, 34 U.S.P.Q.2d (BNA) at 1165; see also *Home Builders Ass'n of Greater St. Louis v. L&L Exhibition Mgmt., Inc.*, 226 F.3d 944, 948 n.5, 56 U.S.P.Q.2d (BNA) 1197, 1201 (8th Cir. 2000) (noting the *Aromatique* definition for functionality is too restrictive).

competitors to employ in order to compete effectively in the marketplace.²⁰¹

Functionality is divided into two categories: aesthetic functionality and utilitarian functionality.²⁰² To determine whether a feature is aesthetically functional depends on whether the ornamental feature is essential to the commercial success of the product such that protection of the ornamental feature would hinder competition.²⁰³ Judicial interpretations of aesthetic functionality are far from uniform.²⁰⁴ A reason for such disagreement among courts is the duality of ornamentation, "which is functional in the sense of making the product more attractive, and is distinct from identifying the manufacturer or his brand to the consumer."²⁰⁵

Utilitarian functionality focuses on whether the design as a whole is "superior to other designs, not on whether its component features viewed individually each have a function."²⁰⁶ To determine whether competition would be hindered, courts consider whether the design as a whole is "superior or optimal in terms of engineering, economy of manufacture, accommodation of utilitarian function or

201. See, e.g., *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 774-75, 23 U.S.P.Q.2d (BNA) 1081, 1086 (1992) (adopting the Fifth Circuit's functionality definition). A trade is functional "if it is one of a limited number of equally efficient options available to competitors and free competition would be unduly hindered by according" the trade dress protection. *Id.* at 775, 23 U.S.P.Q.2d (BNA) at 1086; see also *Thomas & Betts*, 138 F.3d at 297, 46 U.S.P.Q.2d (BNA) at 1041 (a "feature is functional if it is one that is costly to design around or to do without, rather than one that is costly to have . . . [T]o be functional in the trade dress sense, the feature must be necessary to afford a competitor the means to compete effectively" (quoting *Schwinn Bicycle Co. v. Ross Bicycles, Inc.*, 870 F.2d 1176, 1188-89, 10 U.S.P.Q.2d (BNA) 1001, 1011 (7th Cir. 1989))).

202. See McLean, *supra* note 194, at 120 (arguing that the application of functionality, inherent distinctiveness, secondary meaning and likelihood of confusion from trade dress and trademark law to product configuration cases is problematic).

203. See McLean, *supra* note 194, at 124-28 (explaining that ornamentation of the production which hinders competition is not protected).

204. See Erin M. Harriman, *Aesthetic Functionality: The Disarray Among Modern Courts*, 86 TRADEMARK REP. 276, 283-99 (1996) (analyzing the various interpretations of aesthetic functionality in different circuits).

205. *W.T. Rogers Co. v. Keene*, 778 F.2d 334, 340, 228 U.S.P.Q. (BNA) 145, 147 (7th Cir. 1985); see also McLean, *supra* note 194, at 124-28; Wong, *supra* note 197, at 1152-54 (arguing that the conflict between the identification theory gives rise to the aesthetic functionality problem). The conflict occurs whenever a feature "affects the cost or value" of a product, but is not "essential to [its] use or purpose." See Wong, *supra* note 197, at 1119. Ornamental features fall into the conflict, thereby framing the aesthetic functionality problem. See *id.* at 1153. Wong suggests that a solution to resolve the aesthetic functionality problem is to apply only the identification theory to the evaluation of whether a feature is aesthetically functional. See *id.* at 1162-67.

206. *Pebble Beach Corp. v. Tour 18 I, Ltd.*, 155 F.3d 526, 538, 48 U.S.P.Q.2d (BNA) 1065, 1071 (5th Cir. 1998) (quoting *Vaughan Mfg. Co. v. Brikam Int'l, Inc.*, 814 F.2d 346, 350, 1 U.S.P.Q.2d (BNA) 2067, 2070 (7th Cir. 1987)).

performance.”²⁰⁷ As with aesthetic functionality, utilitarian functionality shares in judicial disagreement.²⁰⁸

Web sites are generally designed with usability as the main goal.²⁰⁹ The look and feel of a web site may be shown by examining the uniformity of web designing.²¹⁰ Web designers are currently using common tools to create web pages. At the present time, the dominant tools to construct programmatic functionality of a web site are Java (Java Script and Java applets) and Visual Basic (VBScript and ActiveX).²¹¹ To create link buttons, banners, image maps, and other graphics, web designers generally use software such as Paint Shop Pro and Image Composer.²¹² To enrich the look and functionality of web pages, web developers use Cascading Style Sheets (“CSS”).²¹³ Not only are designers using the same tools, but they also have developed uniform standards about how certain design elements should be presented.²¹⁴ When developers stray from these standards, the web site is deemed less usable, and usually receives less visitors.²¹⁵

Literature on teaching professional web page design reveals a finite way of efficiently organizing a web page into an industry standard, consisting of columns with structural navigational links along a side column or at the bottom of the page, a title for every page, an advertising page with a banner running on the top portion of the page, an acknowledgement page with a copyright notice, and a home page with contact information.²¹⁶ An exclusive right to this “industry

207. *Id.*

208. See McLean, *supra* note 194, at 124-28 (discussing two tests courts use in assessing utilitarian functionality). If the feature is significantly related to the product’s function, courts may find it is not protectable. In the alternative, courts may assess the design to determine whether a competitor’s manufacturing costs will increase if the competitor is required to design around the feature. See *id.* If so, courts may find the feature to be functional and unprotectable. See *id.*

209. See NIELSEN, *supra* note 2, at 14 (stating that having bad usability equals no customers because the web site is a company’s “primary interface to the customer”).

210. See *id.* at 11-12 (advocating standardization of web site design for high usability).

211. See GREENBERG & LAKELAND, *supra* note 44, at 18-19 (discussing benefits and advantages of using JAVA and VB Script programming languages to construct web sites).

212. See *id.* at 57-73 (providing narrative and screen shots of Paint Shop Pro and Image Composer installation).

213. See *id.* at 20 (using CSS because they can be applied to page elements, or elements on multiple pages on a web site without coding style instructions repetitively); NIELSEN, *supra* note 2, at 81 (stating that CSS promotes the ideal of separation of presentation and content by leaving presentation details to a cascade of site specified style sheets and users’ references).

214. See, e.g., NIELSEN, *supra* note 2, at 82-83 (discussing benefits of standardizing design through style sheets).

215. See *id.* at 11 (stating that user’s expectations about a site come from usability of competitors’ web sites).

216. See *generally id.* at 53-81 (analyzing and discussing links, content design, page

standard” may have anti-competitive effects. Thus, under the functionality doctrine, a web site that has the “industry standard” look and feel is functional and not protected.²¹⁷

The creation of an “industry standard” for web design serves as an obstacle to web site owners’ attempts to establish inherent or acquired distinctiveness for their web sites. On the other hand, the uniformity syndrome in web design supports the argument that trade dress protection should be extended to a look and feel of a web site that does not follow the “industry standard.” Further, even if a web page is organized following the “industry standard” in the layout, the overall look and feel of that web page may not look and feel like other web pages given the fact that multi-media, animated graphics, clipart, and sound files are now widely available on the Internet.²¹⁸

Another consequence of the “industry standard” is that all web pages are designed to be functional.²¹⁹ Web pages provide content to visitors, possibly allowing visitors to transact business after reviewing the content.²²⁰ Categories of content in most web pages are organized like a magazine page.²²¹ Web pages have buttons to serve linking functions.²²² All of these features are indeed functional. A web site that contains mostly links or categories of content is functional and, under trade dress law, the look and feel of this web site would not be protectable.²²³

Whether a trade dress is functional is analyzed by examining if the

design, graphics, etc.); GREENBERG & LAKELAND, *supra* note 44, at 45-47, 243-46 (providing the layout and common elements of advertising pages, copyright pages and home pages).

217. See *Sicilia Di R. Biebow & Co. v. Cox*, 732 F.2d 417, 427 (5th Cir. 1984) (stating that certain designs cannot be protected because they are essential to competition).

218. See *AmBrit, Inc. v. Kraft, Inc.*, 812 F.2d 1531, 1538, 1 U.S.P.Q.2d (BNA) 1161, 1176 (11th Cir. 1986) (holding that defendant was allowed to use the functional element of the trade dress, i.e., a foil wrapper, but not the non-functional elements such as pebbled texture, the color royal blue, the arctic sun, polar bear images, and distinctive style of printing of the packaging of plaintiff’s ice cream bar).

219. See NIELSEN, *supra* note 2, at 11-15 (noting that the main goal of a web site is customer usability).

220. See *id.* at 99-100 (arguing that web site content is the ultimate reason for visits because users immediately look at the page’s main content area to determine what the page is about).

221. See *id.* at 81 (stating that like newspapers and magazines, which use the same basic text and layout throughout the publication, web sites should link to some style sheet for the same brand cohesiveness).

222. See *id.* at 53 (discussing the different forms of links used to connect pages of a web site).

223. See Abel, *supra* note 8, at 172 (suggesting that although Netscape’s browser interface contains a number of functional elements that would not be protectable in and of themselves, it has a unique appearance and thus may be protectable as a whole).

trade dress “as a whole” is functional.²²⁴ Even if individual elements or features of a trade dress are functional, the combination of such elements or features may not be functional.²²⁵ As discussed above, the link buttons and the advertising space for banners are functional features. Nevertheless, these features can be dressed with unusual graphics, animation, color scheme, or a combination thereof to create an overall appearance of a web site that is distinctive and non-functional.²²⁶ Furthermore, the overall look and feel of a web site is non-functional if there are alternatives to “dress” other sites.²²⁷

VII. INFRINGEMENT OF PROTECTABLE LOOK AND FEEL OF A WEB SITE: LIKELIHOOD OF CONFUSION

With a distinctive and non-functional web site, the owner can

224. See *AmBrit, Inc. v. Kraft, Inc.*, 812 F.2d 1531, 1538, 1 U.S.P.Q.2d (BNA) 1161, 1166 (11th Cir. 1986) (affirming the district court’s finding that “the Klondike foil wrapper, with its graphics, is primarily nonfunctional.” Though the wrapper may be functional, but its appearance is not, defendant “is precluded only from using a foil wrapper with an overall appearance that is confusingly similar to the wrapper used in” plaintiff’s ice cream bar); see also *Computer Care v. Service Sys. Enters., Inc.*, 982 F.2d 1063, 1071, 25 U.S.P.Q.2d (BNA) 1020, 1026 (7th Cir. 1992) (stating that it is an error to focus “on individual elements rather than on the overall trade dress” (quoting *Vaughan Mfg., Inc. v. Brikam Int’l, Inc.*, 814 F.2d 346, 350, 1 U.S.P.Q.2d (BNA) 2067, 2070 (7th Cir. 1987))).

225. See *Tools USA & Equip. Co. v. Champ Frame Straightening Equip., Inc.*, 87 F.3d 654, 658, 39 U.S.P.Q.2d (BNA) 1355, 1358 (4th Cir. 1996) (examining “trade dress as a whole to determine its functionality; functional elements that are separately unprotectable can be protected together as part of a trade dress”) (internal quotation omitted); *Hartford House, Ltd. v. Hallmark Cards, Inc.*, 846 F.2d 1268, 1272, 6 U.S.P.Q.2d (BNA) 2038, 2041 (10th Cir.), *cert. denied*, 488 U.S. 908 (1988) (“[A] trade dress may be a composite of several features in a certain arrangement or combination which produces an overall distinctive appearance. In this context, the question is whether the combination of features comprising the trade dress is functional.”); *AmBrit*, 812 F.2d at 1538, 1 U.S.P.Q.2d (BNA) at 1166 (“That individual elements of packaging are functional does not, however, render the package as a whole unprotectable.”).

226. See, e.g., *Fun-Damental Too, Ltd. v. Gemmy Indus. Corp.*, 111 F.3d 993, 1002, 42 U.S.P.Q.2d (BNA) 1348, 1355 (2d Cir. 1997) (explaining that the useful features of a trade dress do not automatically make the entire design functional and unprotectable); *Computer Care*, 982 F.2d at 1071, 25 U.S.P.Q.2d (BNA) at 1026 (explaining that although some elements of plaintiff’s monthly reports, such as the particular combination displayed in columns and inclusion of a car’s make and year are functional, other elements such as the particular combination and arrangement of features in a report are non-functional); *AmBrit*, 812 F.2d at 1538, 1 U.S.P.Q.2d (BNA) at 1166 (stating that the overall appearance of plaintiff’s ice cream bar is “primarily nonfunctional does not mean that [defendant] may not use a foil wrapper in connection with the packaging of its five-ounce ice cream novelties”).

227. See *Fun-Damental Too*, 111 F.3d at 1002, 42 U.S.P.Q.2d (BNA) at 1355 (affirming the district court’s finding on non-functionality of plaintiff’s toilet coin bank trade dress because there were at least two alternative packaging designs to the plaintiffs’ toilet coin bank design and that competition would not be hindered by protection of the plaintiff’s trade dress).

exercise his or her right under the Lanham Act against an infringer who copies the overall look and feel of the web site.²²⁸ In order to prevail on a claim of trade dress infringement, the owner of a distinctive and non-functional trade dress must establish that the similarity of the defendant's trade dress is likely to cause consumer confusion as to the source of the products.²²⁹ Evidence of actual confusion is persuasive proof of likelihood of confusion.²³⁰ Actual confusion is rare and generally is not required.²³¹ Another persuasive evidence of likelihood of confusion is the defendant's intentional copying of the plaintiff's trade dress.²³² Other factors for consideration in determining likelihood of confusion include: (1) the strength of the trade dress; (2) the similarity between plaintiff's

228. See *Computer Care*, 982 F.2d at 1069-71, 25 U.S.P.Q.2d (BNA) at 1024 (noting that when a plaintiff's trade dress is distinctive, the use of "generic" elements does not prevent it from being protected); see also *Fun-Damental Too*, 111 F.3d at 1001, 42 U.S.P.Q.2d (BNA) at 1354 (affirming the district court's finding that "although some of the individual elements of a trade dress are generic or descriptive, the impression given by all of them in combination may be inherently distinctive."); MCCARTHY, *supra* note 17, §§ 8-38 to 8-41 (discussing the concept of "inherent distinction" of a product and the concept's effect on infringement determinations).

229. See *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 780, 23 U.S.P.Q.2d (BNA) 1081, 1088 (1992) (Stevens, J., concurring) (providing that "under the Lanham Act § 43(a), the ultimate test is whether the public is likely to be deceived or confused by the similarity of the marks" (quoting *New West Corp. v. NYM Co. of Cal.*, 595 F.2d 1194, 1201, 202 U.S.P.Q. (BNA) 643, 649 (9th Cir. 1979))); *Thomas & Betts Corp. v. Panduit Corp.*, 138 F.3d 277, 291, 46 U.S.P.Q.2d (BNA) 1026, 1036 (7th Cir. 1998) (informing that in order to make a trade dress infringement claim, plaintiff must illustrate that the trade dress is "inherently distinctive" and that similarity of defendant's trade dress will likely cause consumer confusion); *Scott Paper Co. v. Scott's Liquid Gold, Inc.*, 589 F.2d 1225, 1229, 200 U.S.P.Q. (BNA) 421, 425 (3d Cir. 1978) (indicating that the "[l]ikelihood of confusion exists when customers viewing the mark would probably assume that the product or service it represents is associated with the source of a different product or service identified by a similar mark"); see also MCCARTHY, *supra* note 17, at § 8-42 (positing that "[t]he test of unfair competition in the case of a similar use of dress and packaging is whether there is a likelihood of confusion resulting from the total image and impression created by the defendant's product or package on the eye and mind of an ordinary purchaser").

230. See *Fuddrucker's, Inc. v. Doc's B.R. Others, Inc.*, 826 F.2d 837, 845, 4 U.S.P.Q.2d (BNA) 1026, 1032 (9th Cir. 1987) (holding that "[e]vidence of actual confusion is persuasive proof that future confusion is likely"); *AmBrit, Inc. v. Kraft, Inc.*, 812 F.2d 1531, 1543-44, 1 U.S.P.Q.2d (BNA) 1161, 1171-72 (11th Cir. 1986) (finding that four instances of customer confusion established actual confusion).

231. See *Computer Care*, 982 F.2d at 1070, 25 U.S.P.Q.2d (BNA) (noting plaintiff is not required to show actual consumer confusion); *Roulo v. Russ Berrie & Co.*, 886 F.2d 931, 938, 12 U.S.P.Q.2d (BNA) 1423, 1428 (7th Cir. 1989) (affirming jury verdict for plaintiff finding that public was likely to be confused, even "absent the difficult-to-acquire evidence of actual confusion").

232. See *Kendall-Jackson Winery, Ltd. v. E. & J. Gallo Winery*, 150 F.3d 1042, 1048, 47 U.S.P.Q.2d (BNA) 1332, 1339 (9th Cir. 1998) (indicating that evidence of intentional copying of plaintiff's mark should weigh heavily in determining likelihood of confusion); *Schwinn Bicycle Co. v. Ross Bicycles, Inc.*, 870 F.2d 1176, 1183, 10 U.S.P.Q.2d (BNA) 1001, 1007 (7th Cir. 1989) (holding that deliberate copying of trade dress is one factor to consider in determining likelihood of confusion).

trade dress and defendant's trade dress; (3) the similarity of the products or services; (4) marketing channel of the goods or services; (5) consumer survey; and (6) advertising channels.²³³

A finding of likelihood of confusion does not require a positive finding on all or even a majority of the factors.²³⁴ Courts have held trade dress infringement in cases involving the overall festive eating atmosphere of a restaurant,²³⁵ the overall appearance of the wrapper for an ice cream bar,²³⁶ and the overall design of a car service reminder program.²³⁷

In the Internet environment, the analysis of the likelihood of confusion using such a factor as the strength of the trade dress may encounter similar challenges as those discussed in Part IV. For example, if the strength of the trade dress of a web site is weak due to its descriptive look and feel, the owner of the web site must demonstrate that the trade dress has acquired distinctiveness in order for the trade dress to receive protection under Section 43(a) of the Lanham Act.²³⁸ The owner, in its pursuit of proving acquired distinctiveness, will encounter challenges relating to obtaining consumer recognition surveys,²³⁹ sale successes,²⁴⁰ length of use,²⁴¹

233. See *Pebble Beach Corp. v. Tour 18 I, Ltd.*, 155 F.3d 526, 543, 48 U.S.P.Q.2d (BNA) 1065, 1076 (5th Cir. 1998) (providing a list of factors to consider for likelihood of confusion); *AmBrit, Inc. v. Kraft, Inc.*, 812 F.2d 1531, 1538, 1 U.S.P.Q.2d (BNA) 1161, 1166 (11th Cir. 1986) (providing a list of factors to consider for determining likelihood of confusion).

234.

The issue of likelihood of confusion is not determined by merely analyzing whether a majority of the subsidiary factors indicates that such a likelihood exists. Rather, a court must evaluate the weight to be accorded the individual factors and then make its ultimate decision. The appropriate weight to be given to each of these factors varies with the circumstances of the case.

AmBrit, 812 F.2d at 1538, 1 U.S.P.Q.2d (BNA) at 1166; see also *Eclipse Ass'n v. Data Gen. Corp.*, 894 F.2d 1114, 1118, 13 U.S.P.Q.2d (BNA) 1885, 1888 (9th Cir. 1990) (noting that the Ninth Circuit provided for a likelihood of confusion test but the test was not meant to be "hoops" that the district court must jump through in making a determination).

235. See *Taco Cabana, Int'l v. Two Pesos, Inc.*, 932 F.2d 1113, 1123, 19 U.S.P.Q.2d (BNA) 1253, 1260 (5th Cir. 1991), *aff'd*, 505 U.S. 763, 23 U.S.P.Q.2d (BNA) 1081 (1992) (affirming the district court's holding that defendant committed trade dress infringement by imitating plaintiff's Mexican Restaurants).

236. See *AmBrit*, 812 F.2d at 1538-45, 1 U.S.P.Q.2d (BNA) at 1173 (11th Cir. 1986) (affirming district court's holding that defendant's ice cream bar wrapper was an infringing trade dress).

237. See *Computer Care v. Service Sys. Enters., Inc.*, 982 F.2d 1063, 1069-71, 25 U.S.P.Q.2d (BNA) 1020, 1023-26 (7th Cir. 1992) (holding that defendant infringed on plaintiff's computerized follow up of car care repairs).

238. See *supra* notes 167-70 and accompanying text (discussing the burden of proving acquired distinctiveness or secondary meaning for a descriptive look and feel of a web site).

239. See *supra* note 176 and accompanying text (obtaining consumer recognition

advertising expenditure and manner of advertising within the Internet context.²⁴² The growth of the Internet is still a recent phenomenon and many e-companies have not had the opportunity to develop the strength of the trade dress for their web sites. Web site owners may not be able to show that the look and feel of their web sites have been in use over a long period of time in connection with certain on-line goods or services. Additionally, they may not be able to demonstrate substantial sales²⁴³ and advertising.²⁴⁴ Sales success on the Internet is not necessarily quantified in currency, but rather by the frequency of visitors.²⁴⁵ Advertising the look and feel of a web site in the print media, radio, or television is not presently feasible.²⁴⁶ Thus, a consumer recognition survey of the look and feel of a web site, as often conducted in traditional trade dress cases to show the strength of a trade dress, is not fruitful because the majority of the web sites are too new. With regard to the strength of the trade dress factor, this Article asserts that at the present early stage of the Internet and e-commerce, the courts should either exclude it from the inquiry or accord it little importance.

The likelihood of confusion inquiry in the Internet environment should primarily focus on the comparison of the plaintiff's and defendant's web sites, their products or services, and marketing channels. If two web sites with similar domain names have an identical or a very similar look and feel, and sell similar products or services to targeted consumers, it is appropriate for a court to conclude that there is a high likelihood of confusion.

surveys may be impossible at the present time because most web sites have not been in existence for a long period of time).

240. See *supra* notes 186-89 and accompanying text (discussing the visibility of a web site as a measurement of "sale success" because many companies with highly visible web sites are profitable and some companies are operating under business models that offer free content to Internet users).

241. See *supra* notes 171-75 and accompanying text (discussing the difficulty of proving "length of use" of the look and feel of a web site since most web sites are relatively new and are constantly being updated).

242. See *supra* notes 179-83 and accompanying text (discussing the impracticability of capturing the look and feel of a web site for use in advertisements).

243. See *supra* notes 183, 186-88 and accompanying text (discussing the issues of secondary meaning within the context of Internet web sites, issues of visibility and sales success).

244. See *supra* notes 181-82 and accompanying text (highlighting the problems with presenting the overall look and feel of a web site in the print media along with the cost problems of advertising overall look and feel of web sites in electronic media).

245. See *supra* notes 183, 186-87 and accompanying text (presenting the issue of equating sales success to number of site visitors).

246. See *supra* notes 180-82 and accompanying text (demonstrating the problems of web site advertisements).

The intentional copying factor is a relevant factor in the likelihood of confusion inquiry.²⁴⁷ The impact of this factor may be reduced, however, by the innocent infringer argument given that there are many images, animations, and backgrounds freely available for downloading on the Internet.²⁴⁸ Such an argument, however, is not credible because competitors are required to select a trade dress that will avoid a likelihood of consumer confusion.²⁴⁹ If a junior entrant to a particular segment of e-commerce intentionally copied a senior entrant's web site with an inherently distinctive look and feel, the junior entrant has violated the duty to avoid confusion.²⁵⁰

In sum, not all of the factors of the likelihood of confusion inquiry are useful in the Internet context. Instead, the Internet inquiry should be modified, as demonstrated above. Specifically, the strength of the look and feel, advertisement of that look and feel, and the manner of advertising it should be either excluded from the inquiry or accorded little importance. With such modifications, the remaining factors of the likelihood of confusion inquiry are sufficient to determine whether a junior entrant's look and feel of a web site that is identical to the senior entrant's web site is likely to cause confusion among consumers of that particular market.

VIII. THE HARMS AND THE BENEFITS

At first glance, the idea of extending trade dress protection to the overall look and feel of web sites may seem like an endorsement of

247. See *Copy Cop, Inc. v. Task Printing, Inc.*, 908 F. Supp. 37, 46, 38 U.S.P.Q.2d (BNA) 1171, 1177 (D. Mass. 1995) (quoting *Mobil Oil Corp. v. Pegasus Petroleum Corp.*, 818 F.2d 254, 258, 2 U.S.P.Q.2d (BNA) 1677, 1680 (2d Cir. 1987); see also *supra* notes 232-34 and accompanying text (explaining the relationship between intentional copying and likelihood of confusion).

248. See *supra* notes 5, 140, 170 and accompanying text; see also 17 U.S.C. § 405(b) (Supp. 1998) (providing that if an individual proves that he or she was misled by the omission of a copyright notice, that individual incurs no liability for any infringing acts committed before receiving actual notice that registration for the work has been made).

249. See *Badger Meter, Inc. v. Grinnell Corp.*, 13 F.3d 1145, 1155, 29 U.S.P.Q.2d (BNA) 1507, 1514 (7th Cir. 1994) (stating that later entrants have a duty to avoid consumer confusion); *Abbott Labs. v. Nutramax Prods., Inc.*, 844 F. Supp. 443, 445, 30 U.S.P.Q.2d (BNA) 1873, 1874 (N.D. Ill. 1994) (stating that "[a] party who owns a protectable trade dress . . . has the ability to force subsequent entrants into the market to select a trade dress that avoids a likelihood of consumer confusion as to the source or sponsorship of the product."); see also *Sara Lee Corp. v. Am. Leather Prods., Inc.*, No. 97 C 4158, 1998 WL 433764, at *1 (N.D. Ill. July 29, 1998) (finding as the junior entrant into the leather handbag and briefcase market, the defendant "breached its duty to avoid confusion by permitting or directing its suppliers to duplicate the look and feel of COACH handbags and briefcases").

250. See *supra* note 249 and accompanying text (indicating the established duty that junior entrants in the market have to senior entrants).

monopoly.²⁵¹ The e-company with a protectable trade dress can exclude other e-companies from using a similar trade dress on the Internet.²⁵² The exclusivity of the right to use an overall look and feel of a web site may last for as long as the owner uses the same overall look and feel.²⁵³ Practically, this means other e-companies are forbidden to use a similar overall look and feel as long as the protectable trade dress is in use.²⁵⁴ Such an exclusive right to use perhaps is more acute at this early stage of e-commerce. To foster growth in e-commerce, it may not be wise to grant a perpetual and exclusive right to use certain designs, graphics, color schemes, layouts, or composites of those features on the Internet. Also, to open the door for trade dress protection may allow a floodgate of other protections relating to matters on cyberspace.²⁵⁵

The fear of anti-competition, however, is perhaps an exaggeration. The functionality doctrine provides a safeguard to e-companies from the danger of an e-company obtaining a monopoly over useful designs, graphics, color schemes, layouts, sound, and animation features when the alternatives are not available or are too costly to acquire.²⁵⁶ Trade dress law only protects an appearance of a web site

251. See Bell, *supra* note 25, at 428-35 (arguing that a grant of trade dress protection to computer-user interfaces and virtual environments may promote "unjustifiably broad monopolies").

252. See *generally* Allard Enter., Inc. v. Advanced Programming Res., Inc., 146 F.3d 350, 356-59, 46 U.S.P.Q.2d (BNA) 1865, 1870-72 (6th Cir. 1998) (delineating the importance of determining who has priority to a particular trademark in order to prevent others from infringing upon it); *AmBrit, Inc. v. Kraft, Inc.*, 812 F.2d 1531, 1549-51, 1 U.S.P.Q.2d (BNA) 1161, 1176-77 (11th Cir. 1986) (discussing the concept that if an original holder of a trademark does not abandon that trademark then no one else may act in such a way).

253. See *supra* note 252 and accompanying text (indicating that once an entity has priority over a particular trademark ownership, it has exclusive use of such a trademark).

254. See *AmBrit*, 812 F.2d at 1551, 1 U.S.P.Q.2d (BNA) at 1177-78 (discussing what constitutes abandonment of a trademark).

255. Recently, new laws relating to intellectual property have been passed and litigation concerning these new statutes have found their way to courts. See *generally* Digital Millennium Copyright Act, 17 U.S.C. § 1202(b)(3) (1994 & Supp. IV 1998) (stating that no one may knowingly distribute or import materials in which copyright management information has been removed); Anti-Cybersquatting Consumer Protection Act, 15 U.S.C. § 1125(d) (1994 & Supp. IV 1998); *Kelly v. Arriba Soft Corp.*, 77 F. Supp. 2d 1116, 1116, 53 U.S.P.Q.2d (BNA) 1361, 1361 (C.D. Cal. 1999) (providing first impression case where the court held "the use by an Internet 'visual search engine' of others' copyrighted images is a prima facie copyright violation, but it may be justified under the 'fair use' doctrine"); see also Lionel M. Lavenue, *Database Rights and Technical Data Rights: The Expansion of Intellectual Property for the Protection of Databases*, 38 SANTA CLARA L. REV. 1, 59 (1997) (suggesting a new form of intellectual property protection for database—the database right that would require amendment of statutes already enacted).

256. See *Ashley Furniture Indus., Inc. v. SanGiacomo N.A., Ltd.*, 187 F.3d 363, 375, 51 U.S.P.Q.2d (BNA) 1609, 1616-17 (4th Cir. 1999) ("The rule that a product feature is unprotectable if it is functional, however, fully safeguards competitors from the

that is inherently distinctive or has acquired distinctiveness and is non-functional.²⁵⁷ E-companies are free to copy functional features of another e-company's trade dress.²⁵⁸ "The only thing a company cannot do under trade dress law is compete by producing products [or designing a web site] that imitate the nonfunctional, inherently distinctive features of existing products [or web sites] so closely that they are likely to cause consumer confusion."²⁵⁹ Moreover, the rapid change in technology and its applications on the Internet provide many alternatives for e-companies to design the look and feel of their web sites. As there are many alternatives to "dress" a web site, the fear of anti-competition loses its support.²⁶⁰

Denying protection to an inherently distinctive and non-functional overall look and feel of a trade dress, however, is anti-competitive. E-commerce is indeed still in the early stages of development, and it is growing at a fast pace with many uncertainties.²⁶¹ Many e-commerce companies are learning to build their brand recognition in cyberspace.²⁶² It is more pressing at the present time to provide

danger that a producer will, through trade dress law, obtain a monopoly over a useful product feature when the alternatives are limited.").

257. See also *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 769, 23 U.S.P.Q.2d (BNA) 1081, 1083 (1992) (noting that a product that does not inherently identify a particular source is not capable of being protected).

258. See *Ashley Furniture*, 187 F.3d at 375, 51 U.S.P.Q.2d (BNA) at 1617 ("Thus, as far as trade dress law is concerned, a company can compete by copying every useful feature of a competitor's product.").

259. *Id.*; see also *AmBrit*, 812 F.2d at 1538, 1 U.S.P.Q.2d (BNA) at 1166 (noting that defendant is free to use foil wrapper for its ice cream bar, but not a foil wrapper with an overall appearance similar to plaintiff's).

260. See *Hartford House, Ltd. v. Hallmark Cards, Inc.*, 846 F.2d 1268, 1273, 6 U.S.P.Q.2d (BNA) 2038, 2042 (10th Cir. 1988) (indicating that "the availability of alternative appealing designs is a key factor in determining that a trade dress is nonfunctional").

261. See generally JEFF CANNON, *MAKE YOUR WEB SITE WORK FOR YOU*, Introduction Chapter xxiii (2000) ("[T]he Internet is a growing communication medium . . . it does have a long way to go before we realize its full potential, but it is already a very powerful medium that brings with it a number of very real benefits."); Thomas E. Anderson, *Aces—Emerging Intellectual Property Issues in Cyberspace*, 78 MICH. B.J. 1260, 1260 (1999) ("Cyberspace is a new frontier, with its own brand of frontier justice However, just as in old frontier days, the rules are uncertain in cyberspace."). Security is threatening e-commerce as recently planned attacks disrupted most popular and important commercial sites such as Yahoo, AOL, Amazon.com, E*Trade, Buy.com, ebay, and CNN. See John Markoff, *The Strength of the Internet Proves to Be Its Weakness*, N.Y. TIMES, Feb. 10, 2000, at C1 (discussing the growing problems of Internet security); Matt Richtel, *Spread of Attacks on Web Sites Is Slowing Traffic on the Internet*, N.Y. TIMES, Feb. 10, 2000, at A1; see also Jonathan Rabinowitz, *The Internet Economy Gets a Reality Check*, INDUS. STAND. 85, 88 (Dec. 6-19, 1999 Issue); Nicholas G. Carr, *The Strategy Behind Business Models: In the New Economy, Testing Hypotheses Matters More Than Proving Theories*, INDUS. STAND. 195 (Dec. 6-19 Issue).

262. See SUSAN SWEENEY, 101 WAYS TO PROMOTE YOUR WEB SITE 3 ("If building and reinforcing corporate and brand identity are important to you, your Web site must have a consistent look and feel.").

appropriate protection to e-companies in the network economy.²⁶³ Providing this protection will signal a recognition and legitimization of e-commerce. Unfair competition should not become the normative business method merely because the companies are competing in the network economy.²⁶⁴ Unfair competition in the form of causing likelihood of confusion among consumers and palming off another company's goodwill and reputation should not be allowed.²⁶⁵

Most importantly, the purpose of providing appropriate protection to e-companies, such as trade dress protection for the overall look and feel of web sites, is to protect consumers. As highlighted in the introductory example of customdisc.com and customdiscs.com, customers could be confused as to the source of web information if both companies have the same look and feel for their web sites. Consumers of e-commerce should receive the same protection as other consumers.²⁶⁶ The purpose of Section 43(a) of the Lanham Act is to protect consumers from being deceived as to the source of a product or service. To fulfill that purpose, it is logical to extend trade dress protection to the overall look and feel of web sites that are

263. In recognition of the importance of trademark protection to e-companies, on November 29, 1999, the President signed into law the Anti-Cybersquatting Consumer Protection Act, 15 U.S.C.A. § 1125(d) (West Supp. 2000). The Act adds a new Section 43(d) to the Lanham Act, 15 U.S.C. § 1125(d).

264. Many Internet users view the Internet as a "huge repository of public domain to which traditional copyright laws might not apply" and where "ideas and information should flow freely." J. DIANNE BRINSON & MARK F. RADCLIFFE, MULTI MEDIA, LAW AND BUSINESS HANDBOOK, 273 (1996).

265. The underlying purpose of Section 43(a) of the Lanham Act "is to protect both consumers and competitors from a wide variety of misrepresentations of products and services, implicating 'a broad spectrum of marks, symbols, design elements and characters.'" *M. Kramer Mfg. Co. v. Andrews*, 783 F.2d 421, 448 n.25, 228 U.S.P.Q. (BNA) 705, 724 (4th Cir. 1986) (quoting *Warner Bros. v. Gay Toys, Inc.*, 658 F.2d 76, 78, 211 U.S.P.Q. (BNA) 1017, 1018 (2d Cir. 1981)).

266. It is settled in *Two Pesos* that the *Abercrombie* test for trademarks, inherent distinction, should be applied equally to trade dress. See *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 773, 23 U.S.P.Q.2d (BNA) 1081, 1085 (1992). Trademarks serve important economic functions such as (a) encouraging the protection of quality products and services; (b) reducing customer's search costs about products and services; and (c) encouraging competition by preventing "free rider"—economic parasite. See William M. Landes & Richard A. Posner, *Trademark Law: An Economic Perspective*, 30 J.L. & ECON. 265, 270-85 (1987) (recognizing the benefits of trademark laws in reducing consumer's search costs and preventing free riding); see also *Fun-Damental Too, Ltd. v. Gemmy Indus. Corp.*, 111 F.3d 993, 999, 42 U.S.P.Q.2d (BNA) 1348, 1352 (2d Cir. 1997) ("Congress recognized that a trademark aids competition in the marketplace because it helps a consumer distinguish among competing products. Trademarks also encourage producers to maintain a high quality product by assuring that any goodwill associated with their products is not misappropriated by competitors.") (citing S. REP. NO. 79-1333, at 1 (1946), reprinted in 1946 U.S.C.C.A.N. 1274, 1275 (recognizing that trademark law facilitates competition)). Likewise, trade dresses serve those economic functions and deserve equal protection like trademarks.

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inherently distinctive or have acquired secondary meaning and are non-functional.

CONCLUSION

The Internet environment creates significant challenges to creating a look and feel of a web site that is qualified for trade dress protection. A qualified web site must avoid the paradoxical problems related to becoming the most popular web site with the newest content and simplest usability. A qualified web site must overcome problems associated with access to the Internet, browsers, computers, and their screens. The Internet environment challenges, however, do not block all web sites with inherently distinctive and non-functional look and feel from qualifying for trade dress protection. Providing trade dress protection to such web sites is necessary at this stage in the development of e-commerce because both on-line consumers and e-companies should be entitled to protection from unfair competition. Applying traditional trade dress law to the Internet context encounters some imitations that require modifications in both secondary meaning and likelihood of confusion inquiries. Such limitations, however, should not be an excuse for a failure to protect the look and feel of web sites, thus permitting World Wide Web commerce to become World Wild West commerce.