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**A SQUARE PEG INTO A ROUND HOLE:
TRADE DRESS PROTECTION OF WEBSITES,
THE PERSPECTIVE OF THE CONSUMER
AND THE DILEMMA FOR THE COURTS**

AMBER R. COHEN*

“The Internet is very, very much like the physical world. And we keep applying a lot of nonsensical rules to it that don’t match our current experience. The physical world is a dangerous place. Have you forgotten?”¹

INTRODUCTION

Trade dress protection of websites was not intended by the Legislature, has not been provided for by the Courts, and simply is not the proper safeguard for website owners. Most legal theorists will argue that trade dress law is the appropriate law to protect the ‘look and feel’ of a website; however, this is simply not so. By deduction, it seems the Courts are in a whirlwind as to *how* to protect the ‘look and feel’ of a website and rightly so, because it is not a straightforward analysis.

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¹ Tony Rutkowski, Vice President for Internet Business Development at Silicon Valley and software developer for General Magic, Inc., HARVARD CONFERENCE ON THE INTERNET AND SOCIETY: PUBLIC POLICY 333 (May 31, 1996).

The initial infringement stems from the virtual world where collisions of similar websites occur frequently and affect consumers daily. Due to confusingly similar websites, consumers are forced to make a decision which not only affects their lives but also affects the virtual merchant who may not have captured a sale. The economic effects on both sides of a transaction create concern for how to protect the 'look and feel' of a website. Particularly disconcerting is the deception consumers experience when they realize the website they transacted with is *not* the website they intended to use.

The dilemma continues for a merchant who creates a website for business and is exposed to additional vulnerabilities created only by the Internet. A website owner is typically aware of the common issues to circumvent, such as domain name infringement² and the obligation to minimize cyber crime.³ Indeed a merchant may instinctively decide that he wants to create a unique website to attract his customers. However, what he may not be able to anticipate is whether there is another company creating another website, somewhere in cyberspace, for the same product which looks identical to his own. Whether intentional or not, the creation of a confusingly similar website will impede a company's sales and overall success.

Currently, trade dress law is figuratively under construction when applied to the protection of the 'look and feel' of a website. The application of trade dress law in order to preserve the integrity of a company's website is considered

² "Cybersquatting, which refers to the deliberate, bad-faith, and abusive registration of Internet domain names in violation of the rights of trademark owners." *Virtual Works, Inc. v. Volkswagen of Am., Inc.* 238 F.3d 264, 267 (4th Cir. 2001). Congress enacted the Anticybersquatting Consumer Protection Act (ACPA) in response in 1999. *See* Pub. L. No. 106-113, 113 Stat. 1536 (codified at 15 U.S.C. § 1125(d)).

³ Cybercrime occurs when criminal behavior occurs which would not be possible without the use of a computer and its technology. For a detailed analysis of this topic *see* DARLENE DEMELO MOREAU ET AL., *CYBERCRIME: THE INVESTIGATION, PROSECUTION, AND DEFENSE OF A COMPUTER-RELATED CRIME* (Ralph D. Clifford ed., Carolina Academic Press 2006) (2001).

a novelty of the law and is at a pivotal point of debate.⁴ Effectively, every business is at risk for trade dress infringement.⁵ A local or international company, a service oriented company, or perhaps an individual, the types of business entities do not seem to effect a consumer's decision to search for a business online.⁶ With increased customer exposure to the Internet, the likelihood of consumer confusion is prevalent whereby it mandates this discussion for all business owners on how to appropriately protect their company's website.

Consider the following hypothetical to outline the relevant issues. Connie the consumer is interested in buying the perfect *Gizmo* gadget for her father, as it is almost his fiftieth birthday. As most young college students, she decides to "Google" the product description based on several terms.⁷ When she enters the information and hits the search icon, a result list appears with 52 million hits. However, Google conveniently prioritizes in descending order, the highest match to the lowest. She examines the top two websites in order to make a purchase. The problem is, she is personally unfamiliar with her dad's favorite hobby of collecting gadgets, and both websites are very similar. They look the same and have what appear to be the same products for sale. She knows her father prefers to collect *Gizmo* gadgets, but she can't decipher which website *actually* sells them. The websites look identical, but it is almost impossible to determine which one is the *Gizmo* website and which one is not. How does she decide which website to buy from? If

⁴ See *Blue Nile, Inc. v. Ice.com, Inc.*, 478 F. Supp. 2d 1240, 1246 (W.D. Wash., 2007).

⁵ Trade dress infringement is defined pursuant to the Lanham Act, 15 U.S.C. §§1051 – 1127 (2000).

⁶ David Roselund, *E-Commerce Companies Must Globalize to Thrive*, E-COMMERCE TIMES, Nov. 4, 2005, <http://www.ecommercetimes.com/story/46841.html?wlc=1226768571> (last visited Jan. 5, 2009).

⁷ To "Google" refers to performing a search on the Google website search engine. Often it is referred to as "Google it" or "I googled it." The term is also used for any general search for information on the web. The secondary meaning, which this term is closely embracing, is another topic which will not be discussed within this Note.

she chooses the website because ‘she thinks’ this is the website that sells the *Gizmo’s* gadgets, but she is not sure, should this consumer confusion be protectable? Unfortunately, the law has not yet adequately provided a remedy even with the exponential growth of Internet purchases.

This Note explores the legalities of trade dress protection for a website, the enforcement of such protection, and what is necessary to protect the ‘look and feel’ of a website. Further, this Note claims it is nearly impossible to protect the ‘look and feel’ of a website because the functionality of the site will always trump protection.

Part I begins by discussing the electronic commerce [*hereinafter* e-commerce]⁸ explosion and the effective mitigation of geographic importance of companies. Part II outlines the current law of trade dress protection under the Lanham Act.⁹ Part III discusses whether there is a possible

⁸ “Electronic commerce” is defined as “any transaction conducted over the Internet or through Internet access, comprising the sale, lease, license, offer or delivery of property, goods, services, or information, whether or not for consideration, and includes the provision of Internet access.” 47 U.S.C.A. 151 § 1105(3) (2001). Further, “e-commerce” is defined as “the practice of buying and selling goods and services through online consumer services on the Internet” BLACK’S LAW DICTIONARY 551 (8th ed. 2004). *See also* the definition of e-commerce used by the Federal Financial Institutions Examination Council (*hereinafter* FFIEC) as “the remote procurement and payment by businesses or consumers of goods and services through electronic systems such as the Internet.” FFIEC Information Technology Examination Handbook Glossary, *available at* http://www.ffiec.gov/ffiecinfbase/html_pages/gl_01a.html#E (last visited Jan. 5, 2009).

⁹ Lanham Act §43(a), 15 U.S.C.A. § 1125(a)(1) (2006). Subsection (a)(1) provides:

(a) 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 description of fact or false or misleading representation of fact, which

(1) is likely to cause confusion, or to cause mistake, or deceive as to the affiliation,

remedy for those who seek to protect the ‘look and feel’ of a storefront created by their website. Lastly, Part IV discusses the possible ideas for protection of websites and the challenges business owners encounter.

I. GEOGRAPHY IS IRRELEVANT FOR THE REASON THAT COMMERCE IS INTERNATIONAL

To be successful, it is imperative that a company create a website in order for their business to flourish.¹⁰ An estimated 1.3 billion people used the Internet in December of 2007,¹¹ which defined a worldwide usage growth of 265.6% from 2000 - 2007.¹² The exponential increase in online business activity requires the creation of websites in order to present to the consumer the product or service for which it represents.¹³

The United States is a focal point of economic success throughout the world.¹⁴ The success of E-commerce has been

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....

¹⁰ David Roselund, *E-Commerce Companies Must Globalize to Thrive*, E-COMMERCE TIMES, Nov. 4, 2005, <http://www.ecommercetimes.com/story/46841.html?wlc=1226768571> (last visited Jan. 5, 2009).

¹¹ The Internet is the “myriad of computer and telecommunications facilities, including equipment and operating software, which comprise the interconnected world-wide network of networks that employ the Transmission Control Protocol/Internet Protocol, or any predecessor or successor protocols to such protocol to communicate information of all kinds by wire or radio.” Internet Tax Freedom Act § 1101(3)(C) (as amended), 47 U.S.C.A. § 151 (2007).

¹² See Internet World Stats, Usage and Population Statistics at <http://www.internetworldstats.com/stats.htm> (last visited March 11, 2008). See Table 1, *infra* note 21.

¹³ STEPHEN SEGALLER, NERDS 2.0.1: A BRIEF HISTORY OF THE INTERNET 358 (1998).

¹⁴ See generally Sean T. McGann et al., *Globalization of E-Commerce: Growth and Impacts in the United States of America* (Case Western Reserve University, USA, Sprouts: Working Papers on Information Systems, 2(11)), available at <http://sprouts.aisnet.org/2-11> (last visited

no exception to this phenomenon. It is generally known that the U.S. is one of “the most wired populations on earth”¹⁵ and is “the best country to initiate E-commerce”.¹⁶ With the population at 330 million, the U.S. is positioned as the third largest country, and further the “U.S. has the largest and most technologically powerful economy in the world”¹⁷ These numbers allow -E-commerce to thrive in this country.¹⁸

[The U.S.] is the world’s wealthiest country in terms of Gross Domestic Product, at USD 10.2 trillion as of early 2001. The US GDP per capita is about 1.5 times higher than that of the OECD country average . . . In the past, this skewed distribution of wealth has created a phenomenon known as [sic] the US Government as the ‘Digital Divide’, which has created a large technology gap between the affluent and less affluent population. However, this divide is actively being narrowed at present by the implementation of significant government funding for technology in schools, more widespread availability of affordable Internet access in American homes and the downward trend in personal computer prices.¹⁹

In sum, the digital millennium has created an astronomical flux for the use of the Internet. To discuss the applicability of *our* laws to the Internet where such a notion is relatively new to academia, practitioners, and most importantly the courts, these facts must be considered. Physical location of a company is an important facet in the discussion of trade dress

December 14, 2008)(discussing the globalization of Ecommerce and its expansion throughout the United States).

¹⁵ *Id.* at 60.

¹⁶ *Id.*

¹⁷ Central Intelligence Agency, THE WORLD FACTBOOK, available at <https://www.cia.gov/library/publications/the-world-factbook/geos/us.html> (last modified March 20, 2008).

¹⁸ *Supra* note 8.

¹⁹ McGann et al., *supra* note 14.

protection where two or more companies may be on opposite sides of the country, and yet have a trade dress infringement case.²⁰ Table 1 below demonstrates how much the Internet has taken over the world.

The substantial increase in e-commerce can be attributed to influential factors such as the increased use of the Internet as a learning tool in education, the - wide use of credit cards in consumer purchases, the availability of broadband access to both businesses and consumers, and that the U.S. has one of the highest percentages of population penetration of Internet use in the world.²¹

The geographic location of a company has become somewhat irrelevant. Two companies that are physically located across the globe from one another are now literally next-door neighbors when viewing them in the virtual world. In the hypothetical, Connie's "Google" search produced an exhaustive results list for her to choose where to purchase her *Gizmo* gadgets. The top two choices may be located thousands of miles from one another, but only centimeters apart on the viewing screen. Generally, if she were not making an online purchase, she would be faced with driving to a store and picking out the merchandise. The physical location will absolutely affect whether the 'look and feel' of a business should be protected.²² Does a virtual location affect the protection by trade dress law as well? If two companies have a 'look and feel' similar to each other, and an Internet search causes the companies to be 'close', potentially causing consumer confusion, then will the courts see Connie's virtual dilemma?

²⁰ See generally, *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 763 (1992).

²¹ McGann et al., *supra* note 14; see also Table 1.

²² See generally, *Two Pesos, Inc.*, 505 U.S. 763 (1992) (stating that trade dress protection must be inherently distinctive or have acquired secondary meaning under the Lanham Act).

Table 1²³

WORLD INTERNET USAGE AND POPULATION STATISTICS						
World Regions	Population		Internet Usage, Latest Data (Million)	% Population Penetration	Usage % of World	Usage Growth 2000-2007
	2007 Est. (Million)	% of World				
Africa	941	14.2	44	4.7	3.4	882.7
Asia	3,733	56.5	510	13.7	38.7	346.6
Europe	802	12.1	348	43.4	26.4	231.2
Middle East	193	2.9	34	17.4	2.5	920.2
North America	335	5.1	238	71.1	18.0	120.2
Latin America/ Caribbean	569	8.6	126	22.2	9.6	598.5
Oceania / Australia	34	0.5	19	57.1	1.5	151.6
TOTAL	6,606	100.0	1,329	20.0	100.0	265.6

At the moment a consumer is confused upon use of a website, the dilemma of how to prevent confusion starts. This is hardly a trend that will disappear with a new generation.²⁴ By and large, the expansion of Internet use amongst consumers, an implied need for companies to be available online, and the commanding virtual competition are all factors that contribute to this pioneering area of the law.

Further, the expansion of E-commerce is an essential element in this discussion because it demonstrates the increased need for legal protection to prevent consumer confusion. A company's virtual advertisements and sales are more at risk for direct copying because the websites are available to *anyone* at anytime. Consequently, E-commerce

²³ Internet Usage and World Population Statistics are for December 31, 2007, <http://www.internetworldstats.com> (Copyright © 2000 - 2008, Miniwatts Marketing Group) (last visited April 28, 2008).

²⁴ Sowmyan Raman, *E-Commerce and Globalization Yesterday, Today, and Tomorrow*, Engineering Management Society, 2000. Proceedings of the 2000 IEEE, August 13-15, 2000, at 249, 250.

has a direct effect on trade dress law and is a catalyst to develop this essential area of the law.

II. TRADE DRESS PROTECTION: THE LAW AS IT STANDS

The applicability of trade dress protection to websites has yet to be fully realized. The discussion in this section begins by analyzing what trade dress law protects followed by a review of the individual elements of a trade dress claim. Lastly, the elements are discussed in totality, as a trade dress claim must be examined as a whole in order to properly determine whether or not it will invoke protection.²⁵

A. *What Does Trade Dress Law Protect?*

Ultimately trade dress law protects any *thing* which may be dressed.²⁶ In its modern form, trade dress protection includes “the design and shape of a product and its packaging and even includes the design and shape of the product

²⁵ *Chesebrough Mfg. Co. v. Old Gold Chem. Co.*, 70 F.2d 383, 384 (6th Cir. 1934) (the court stating “Simulation amounting to unfair competition does not reside in identity of single features of dress or markings nor in indistinguishability when the articles are set side by side, but is to be tested by the general impression made by the offending article upon the eye of the ordinary purchaser or user.”).

²⁶ Additionally, described as:

[T]otal image and overall appearance of a product. Or put another way, it is the ‘manner in which the goods or services are presented to prospective purchasers . . .’ to indicate source. Trade dress encompasses the ‘arrangement of identifying characteristics or decoration connected to a product, whether by packaging or otherwise, intended to make the source of the product distinguishable from another and to promote it for sale.’ Once source significance is attached to the appearance or image of the goods and services offered for sale, ‘the appearance then functions as a trademark.’

Lisa M. Byerly, *Look and Feel Protection of Website User Interfaces: Copyright or Trade Dress?*, 14 SANTA CLARA COMPUTER & HIGH TECH. L.J. 221, 250 (1998).

itself.”²⁷ Trade dress also refers to “the image and overall appearance of a product. It embodies ‘that arrangement of identifying characteristics or decorations connected with a product, whether by packaging or otherwise, [that] make[s] the source of the product distinguishable from another and . . . promote[s] its sale.’”²⁸ Trade dress additionally “involves the total image of a product and may include features such as size, shape, color or color combinations, texture, graphics, or even particular sales techniques.”²⁹ It is the combined overall appearance of the product, which encompasses the law of trade dress.

A *prima facie* case of a trade dress infringement claim is established pursuant to the Lanham Act³⁰ where a Plaintiff must possess an interest in the trade dress design;³¹ second, the trade dress sought must be nonfunctional;³² and lastly there must be consumer confusion in regards to the source of

²⁷ 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS & UNFAIR COMPETITION § 8:04 at 8–11 (3rd ed. 1996) (The conventional approach of trade dress was limited in scope to the general appearance of labels, wrappers, and containers used in packaging a product). *See also* John H. Harland Co. v. Clarke Checks, Inc., 711 F.2d 966, 980 (11th Cir. 1983) (stating “ ‘[t]rade dress’ involves the total image of a product and may include features such as size, shape, color or color combinations, texture, graphics, or even particular sales techniques”).

²⁸ *Esercizio v. Roberts*, 944 F.2d 1235, 1238–39 (6th Cir. 1991) (quoting *Allied Mktg. Group, Inc. v. CDL Mktg., Inc.*, 878 F.2d 806, 812 (5th Cir.1989), and *Mr. Gasket Co. v. Travis*, 299 N.E.2d 906, 912 n. 13 (Ohio Ct. App.1973)).

²⁹ *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 764 n. 1 (1992) (quoting *John H. Harland Co. v. Clarke Checks, Inc.*, 711 F.2d 966, 980 (11th Cir. 1983)).

³⁰ Lanham Act §43(a), 15 U.S.C. § 1125(a) *supra* note 9.

³¹ *See Keystone Camera Prod. Corp v Ansco Photo-Optical Corp*, 667 F.Supp. 1221, 1229 (N.D. Ill. 1987). (“whether Keystone has a protectable trade dress for its cameras which bear clashing, contrasting, and multiple color combinations with a distinctive dot pattern.”).

³² Lanham Act § 43(a)(3), 15 U.S.C.A. §1125(a)(3) (“In a civil action for trade dress infringement under this Act for trade dress not registered on the principal register, the person who asserts trade dress protection has the burden of proving that the matter sought to be protected is not functional.”).

the goods or services.³³

B. The Prerequisite: Protected Interest in Trade Dress

The plaintiff must assert an interest in the trade dress to pursue a claim.³⁴ In order to prove a plaintiff's interest in the claim there are several elements which must be met. First, the particular trade dress claimed must be in use by the claimant at the time the claim arises.³⁵ Second, the use of the trade dress must be consistent and stable.³⁶ Third, the goods which are dressed must already be sold in interstate commerce.³⁷ Fourth, a plaintiff must show the trade dress is either inherently distinctive or has acquired secondary meaning as perceived by consumers.³⁸ Lastly, the plaintiff

³³ Pac. Coast Condensed Milk Co. v. Frye & Co., 147 P. 865, 869 (Wash. 1915).

³⁴ Keystone Camera Prod. Corp., 667 F.Supp. at 1225.

³⁵ Hughes v. Design Look Inc., 693 F.Supp. 1500 (S.D.N.Y. 1988). Elements of trade dress claim must be indicative of a source and similar to trademark, those elements must have been "used in such a manner as to denote product source." Thus, a product feature whose only impact is decorative and aesthetic, with no source-identifying role, cannot be given exclusive rights under trade dress law. For example, where "dark wood paneling, large produce areas and low produce-display 'gondolas'" were claimed as the trade dress of a grocery store, the Ninth Circuit rejected the claim because plaintiff could not prove that these elements served any purpose "other than to provide an attractive means of displaying produce." In *Re Hudson News*, 39 U.S.P.Q.2d 1915 (T.T.A.B. 1996). The same rule applies to applications to register a product shape or configuration as a trademark. 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 8:1 (4th ed.) (citing *Fabrication Enters. v. Hygienic Corp.*, 64 F.3d 53, 35 U.S.P.Q.2d 1753, 1756 (2d Cir. 1995) ("[T]o earn protection under the Lanham Act, a manufacturer must show that its trade dress is capable of distinguishing the owner's goods from the competitor's and identifying the source of the goods.")).

³⁶ Rally's Inc. v. Int'l Shortstop Inc., 776 F.Supp. 451, 457 (E.D. Ark. 1990).

³⁷ Gen. Motors Corp. v. Keystone Auto. Indus., Inc., 453 F.3d 351, 356 (6th Cir. 2006).

³⁸ Two Pesos, Inc. v. Taco Cabana Inc., 505 U.S. 763, 769 (1992) (the element sought to be satisfied either by inherent distinctiveness or secondary meaning, is the most difficult to analyze).

must be the *senior company*, which may further be described as the original user of the trade dress.³⁹ The totality of these elements will establish the prerequisite protected interest for a trade dress claim.

The first three elements require only basic analysis. But the fourth element is a little more involved and requires further discussion. A protectable trade dress claim must be either “*inherently distinctive* or have acquired *secondary meaning* in the minds of consumers.”⁴⁰ Where a trade dress claim is not inherently distinctive there must be proof of secondary meaning.

Inherent distinction may be categorized in four groups which determine whether it will be protected by trade dress law.⁴¹ On the continuum, an inherent distinction may be arbitrary or fanciful, suggestive, descriptive, or generic.⁴² In order for protection to be upheld the trade dress must either be arbitrary, fanciful or suggestive. A descriptive mark generally requires proof of secondary meaning. Never will a

³⁹ See *Jolly Good Indus., Inc. v. Elegra, Inc.*, 690 F.Supp. 227, 229 (S.D.N.Y. 1988).

⁴⁰ *Two Pesos Inc.*, 505 U.S. at 763 (The ultimate goal of this element is to protect the consumers under the Lanham Act from misleading origins of products and/or services. A trade dress that meets either of these elements can be associated with a single source and only such a trade dress is entitled to a claim of protection from infringement.); see also the 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. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 13, pp. 37–38, and Comment *a* (Tent. Draft No. 2, Mar. 23, 1990); see generally, *Two Pesos, Inc.*, 505 U.S. at 763 (holding that secondary meaning is not required for trade dress protection where the design is distinctive). *Coach Leatherware Co. v. Ann Taylor Inc.*, 933 F.2d 162, 168 (2nd Cir. 1991) (court states “The trade dress of a product attains secondary meaning when the purchasing public ‘associates’ its design with a single producer or source rather than simply with the product itself.”). The courts require secondary meaning to a design or description where the trade dress is merely descriptive. This prevents frivolous suits and allows only the strong marks to receive the necessary protection of trade dress the company has earned to keep.

⁴¹ *Barnes Group Inc. v. Connell Ltd. P’ship*, 793 F.Supp. 1277, 1295 (D. Del. 1992).

⁴² *Id.*

generic trade dress claim be protectable under trade dress law.⁴³

The Supreme Court has ruled that secondary meaning is not required where the trade dress is inherently distinctive.⁴⁴ In the *Two Pesos* case, the trade dress description was specific and focused on exactly what the restaurant was determined to protect.⁴⁵ The court held that the description was inherently distinctive and should be protected under the Lanham Act. The Court's decision to remove the additional element of secondary meaning for a mark which is inherently distinctive has proven to lift a legal burden for plaintiffs to come.

In the case where the trade dress is descriptive, secondary meaning will be present when a significant number of consumers associate the features claimed as trade dress to a particular source rather than the product itself.⁴⁶ If there is no

⁴³ *Two Pesos, Inc.* at 763..

⁴⁴ *Id.* (stating that proof of secondary meaning is not required where the trade dress is *inherently distinctive*). A trade dress claim which requires proof of secondary meaning is a difficult task; however, courts prefer litigants to demonstrate secondary meaning in all claims in order to secure and strengthen the legitimate claims. Accordingly, a trade dress that is merely descriptive of the product or service with which it is used must have acquired secondary meaning in order to be protectable. *E.g.*, *Vaughan Mfg Co. v. Brikam Int'l Inc.*, 814 F.2d 346 (7th Cir. Ill. 1987) (Whereby, an *inherently distinctive* claim presented by the plaintiff may offer evidence as it only strengthens the trade dress assertion). As will be discussed further in this Note, the crucial aspect of a trade dress claim is consumer confusion, and if secondary meaning can be established it would only help to prove the claim.

⁴⁵ The description of the restaurant and asserted trade dress was as follows:

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.

Two Pesos, Inc. v. Taco Cabana Inc., 505 U.S. 763, 765 (1992).

⁴⁶ *Coach Leatherware Co. v. Ann Taylor Inc.*, 933 F.2d 162, 168 (2nd Cir. 1991) (citing *Inwood Lab., Inc. v. Ives Lab., Inc.*, 456 U.S. 844, 851

secondary meaning established, the plaintiff's claim will be denied.⁴⁷

The last element needed to satisfy whether a claimant has a relevant interest in the claim is satisfied when the company is the *first* to use the trade dress. A "senior" company is the first company which has established a mark and is the first to use it as such.⁴⁸ The "junior" company is the infringer which has violated the senior company's rights by unauthorized use.

Where a claimant is able to establish these prerequisites, the claim will stand only to be faced with the next hurdles of trade dress law.

C. Trade Dress Must be Nonfunctional

A trade dress claim is protectable as long as it is principally nonfunctional.⁴⁹ A trade dress claim must be nonfunctional in order to receive protection under the law.⁵⁰ Trade dress may encompass nonfunctional and functional elements; it is the entire trade dress, as a whole, that is examined and may still be protectable if it is non-functional.⁵¹

n. 11 (1982); *Centaur Commc'n Ltd. v. A/S/M Commc'n, Inc.*, 830 F.2d 1217, 1221 (2d Cir. 1987)).

⁴⁷ *Coach Leatherware Co.*, 933 F.2d at 168 (Secondary meaning requires rigorous evidentiary proof that an association does exist) (some plaintiffs use market analysis and surveys to test the general public to establish secondary meaning with their product source. However, this is both costly and time consuming, and courts have discretion and *may* not rely on the gathered data due to the volatile nature of market surveys).

⁴⁸ *See Jolly Good Indus., Inc. v. Elegra, Inc.*, 690 F.Supp. 227, 230 (S.D.N.Y. 1988).

⁴⁹ *See Sunbeam Corp. v. Equity Indus., Corp.*, 635 F.Supp. 625, 635 (E.D.Va. 1986).

⁵⁰ *See, e.g., Id.* at 635 (stating that where the overall appearance and design, if functional, the trade dress will not be protected by the Lanham Act).

⁵¹ Xuan-Thao N. Nguyen, *Should it be a Free for All? The Challenge of Extending Trade Dress Protection to the Look and Feel of Websites in the Evolving Internet*, 49 AM. U. L. REV. 1233, 1238 (stating that Courts will examine trade dress "as a whole" in order to determine its functionability and citing *Tools USA & Equip. Co. v. Champ Frame Straightening Equip., Inc.*, 87 F.3d 654, 658 (4th Cir. 1996); *Computer Care v. Serv. Sys. Enter., Inc.*, 982 F.2d 1063, 1067 (7th Cir. 1992); *Hartford House, Ltd. v.*

The courts vary and struggle with the idea of what determines *functionality*. For a plaintiff's claim, the advantageous view for nonfunctionality is best when narrowly defined under the 'Utility Doctrine'.⁵² This doctrine states that where a feature does not promote a utilitarian purpose it will be considered nonfunctional. Additionally, courts that generally apply this doctrine state that the trade dress feature must be essential to the utility of the product in order to be deemed functional. This is a very restricted view of functionality, which will allow for more plaintiffs' claims to stand.

There is a spectrum of nonfunctional doctrines. The *Aesthetic Functionality Doctrine*, considered the broadest view as applied to nonfunctionability, is premised on the idea that if the trade dress is attractive to customers then function is attached, and thereby not protected under trade dress theory.⁵³ Under the *Commercial Success Doctrine*, where a feature is important to the commercial success of a company it will be deemed functional.⁵⁴ Lastly, the *Competitiveness Doctrine*, a more moderate viewpoint, bases functionality on whether when a feature is removed from the public domain it affects the market competitors.⁵⁵ These three differing doctrines are broadly based when analyzing functionality. In order to have a valid claim, the trade dress must be nonfunctional, where it is more difficult to argue amongst these encompassing doctrines.

Once a trade dress claim is determined inherently

Hallmark Cards, Inc., 846 F.2d 1268, 1271 (10th Cir. 1988), *cert. denied*, 488 U.S. 908 (1988); Fuddrucker's, Inc. v. Doc's B.R. Others, Inc., 826 F.2d 837, 842 (9th Cir. 1987); AmBrit, Inc. v. Kraft, Inc., 812 F.2d 1531, 1538 (11th Cir. 1986)).

⁵² *E.g.*, Stormy Clime Ltd. v. Progroup, Inc., 809 F.2d 971, 977 (2nd Cir. 1987).

⁵³ Schwinn Bicycle Co. v. Diversified Prod. Corp., 740 F.Supp. 517, 520 (N.D. Ill. 1990).

⁵⁴ Words & Data, Inc. v. GTE Commc'n Serv., Inc., 765 F.Supp. 570, 580 (W.D. Mo. 1991).

⁵⁵ Inverness, Corp. v. Whitehall Lab., 678 F. Supp. 436, 440 (S.D.N.Y. 1987).

distinctive and nonfunctional,⁵⁶ the decisive obstacle is whether the trade dress causes a likelihood of confusion in consumers' minds.⁵⁷

*D. Consumer Confusion: Only a 'Likelihood'
Threshold Required*

The crux of a plaintiff's claim rests on the ability to prove the trade dress infringement claim causes a likelihood of consumer confusion.⁵⁸ It is undisputed that liability under the Lanham Act requires proof of the likelihood of confusion.⁵⁹ The relevant factors which influence the determination of whether a *likelihood* of consumer confusion exists are the relative strength of the trade dress claim,⁶⁰ similarity of the parties' products,⁶¹ and the similarity of the trade dress.⁶²

A merchant who seeks action for trade dress infringement has a higher likelihood to prove consumer confusion when the parties use the same means to market their products, i.e. a website.⁶³ Ultimately, the plaintiff will need to be prepared to show how the likelihood of confusion occurs for consumers, and generally the medium in which their purchasing occurs greatly influences this. The court will expect to hear an argument on whether the products are sold in proximity to each other and how this may ultimately influence the likelihood of consumer confusion.⁶⁴ If a

⁵⁶ As discussed, *supra*, Part II.B., the claim may also be upheld with a merely descriptive mark with secondary meaning attached.

⁵⁷ See generally, *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992).

⁵⁸ *Freixenet, S.A. v. Admiral Wine & Liquor Co.*, 731 F.2d 148, 151 (1984).

⁵⁹ *Two Pesos, Inc.*, 505 U.S. at 769..

⁶⁰ In general, confusion is more likely where the trade dress claim is strong. *Hard Rock Cafe Licensing Corp. v. Pacific Graphics, Inc.*, 776 F.Supp. 1454, 1461 (W.D. Wash. 1991).

⁶¹ *Id.*

⁶² *Sunbeam Corp. v. Equity Indus., Corp.*, 635 F.Supp. 625, 633 n. 2 (E.D.Va. 1986).

⁶³ See *Merchant & Evans Inc. v. Roosevelt Bldg. Prod. Co.*, 963 F.2d 628, 637 (3rd Cir. 1992).

⁶⁴ See *supra* discussion in Part I detailing the location of a website and the effect it may have on the Courts.

plaintiff is able to demonstrate consumer confusion adequately, the infringement claim will prevail.

E. All the Elements are Viewed in Totality to Examine the Claim

Broadly speaking, trade dress must be analyzed in the totality of the circumstances.⁶⁵ Courts are more apt to look at the broad description of the plaintiff's asserted claim to compare to the junior company's composite. When the similarities are overwhelming and likely to cause consumer confusion, the plaintiff will prevail.⁶⁶ The specificity of claims that the plaintiff asserts is determinative of whether there is a trade dress infringement. The plaintiff who seeks to protect the "combination of elements,"⁶⁷ if successful, "[is] capable of acquiring exclusive legal rights as a type of identifying symbol of origin" through trade dress.⁶⁸ The detailed description of the asserted trade dress must in fact represent the product source.⁶⁹

To summarize, the courts examine whether the claim is distinctive or not, whether there is functionality attached to the claim and if there really is a likelihood towards consumer confusion. It is the combined overall appearance, which encompasses the law of trade dress. All of these elements rely on each other to determine whether the next element is viable or not. Although it may appear simple to bring forth a trade dress claim, it is an intricate process that must be viewed on a global level rather than as an isolated element.

⁶⁵ *Tripledge Prod. Inc. v. Whitney Res. Ltd.*, 735 F.Supp. 1154 , 1161 (E.D.N.Y. 1990).

⁶⁶ *Id.*

⁶⁷ 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 8:1, 8-2 (4th ed. 1999).

⁶⁸ *Id.*

⁶⁹ *Id.* at 8-3 n.8 (citing *Fabrication Enters. v. Hygienic Corp.*, 64 F.3d 53, 57 (2d Cir. 1995) ("[T]o earn protection under the Lanham Act, a manufacturer must show that its trade dress is capable of distinguishing the owner's goods from the competitor's and identifying the source of the goods.")).

III. THE EFFECT: IS A WEBSITE'S 'LOOK AND FEEL' PROTECTABLE UNDER TRADE DRESS LAW?

Legally, to protect a web page layout as a whole is not possible with the law as it stands. The increase of globalization and e-commerce has the potential effect to undermine the current law of trade dress and its usefulness in the anticipated application.⁷⁰ The 'look and feel' of a website refers to the user interface, generally manifested by the display screens that a computer program generates and the keystroke combinations that are used for particular program functions."⁷¹ However, the 'look and feel' of a website has further developed as technology has expanded to include color, clipart, graphics, designs, animation, and even sounds.⁷² The law provides *trademark* law to protect an individual element contained in a website page and copyright law to protect a picture, graphic or music.⁷³

⁷⁰ Geri L Haight and Philip Catanzano, *The Effects of Global Priority of Trademark Rights*, 91 MASS.L.REV. 18, 19 (Spring 2007).

⁷¹ David Bender & Craig Nethercott, *Lotus v. Borland: At the United States Supreme Court*, 430 PLI/Pat. 7, n.1 (1996).

⁷² Xuan-Thao N. Nguyen, *supra* note 50 at 1240.

⁷³ Trade dress protection is considered a subset of trademark law. *See* Lanham Act, 15 U.S.C. §§ 1051 – 1141, the Trademark Act of 1946. Copyright law protects the graphics and language in a website. The Copyright Act of 1976, 17 U.S.C. §§ 101-1101 (1994) [hereinafter "Copyright Act"]. The law is undisputed that a tangible fixed work of authorship is protected under the Copyright Act. The ownership of a copyright is automatic to the author. As such, authorship may be created through other means such as "work for hire" or "joint authorship" 17 U.S.C. § 101. Where an author publishes a website, the copyright enumerated rights will attach automatically without notice or registration, *see* 17 U.S.C. § 106(1)-(6). In other words, every website is entitled to copyright protection under the presumption that the website owner is not infringing another website owner's rights under § 106 of the Copyright Act. The problem is that the protection afforded to copyright owners is *not* what a merchant necessarily needs. Infringement of a copyright does not require knowledge of a copyright, intent to infringe, or a motive for commercial gain. *See* CoStar Group Inc. v. LoopNet Inc., 373 F.3d 544

(4th Cir. 2004) (court held that there must be a minimal “volition or causation” by the defendant).

Trade dress protection seeks to enjoin another party from using the design or ‘look and feel’ of a product in order to protect and reinforce the commercial monopoly on such a claim. Whereas copyright protection is used as an incentive for authors to create “works” for the public to enjoy, while allowing the author to be rewarded for the work. Enumerated Rights under 17 U.S.C. § 106 of the Copyright Act include exclusive rights of an owner of a copyright to authorize: reproduction of the copyrighted work, preparation of a derivative work based upon the copyrighted work, distribution of copies or phonorecords to the public, the performance of dramatic, musical or literary performances, and to perform a sound recording publicly. 17 U.S.C. §§ 106(1)-(6). Section 102(a) of the Copyright Act states that copyright protection will be applied to original works of authorship “now known or later developed, from which they can be perceived, reproduced or otherwise communicated.” 17 U.S.C. § 102(a) states “Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.” *Id.* The prima facie case requires that the copyrightable material must be ‘original’ and be a ‘tangible medium of expression’. 17 U.S.C. § 102(a). In order for a work to be considered original, there must be at least a minimal amount of creativity. *See Feist Publ’n, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991) (where the selection and arrangement of the white pages was not protected under copyright law because the level of creativity was not satisfied under the originality requirement of the Copyright Act). The Court in *Feist Publications* states that in order for the element of originality to be met there must be slight derivation of creativity, but the court does not allude to how much. Applied to the current discussion, perhaps a website’s ‘look and feel’ may be protectable. A website that maintains minimal originality but ‘just enough’ may pass the court’s scrutiny. The intent behind these two categories of law is very different and therefore presents different forms of protection. Where trade dress does have the appropriate intent to protect the ‘look and feel’ of a website, it will ultimately fail where the law is not established to be applied as such.

In a recent benchmark case, *Blue Nile, Inc., v. Ice.com, Inc.*, 478 F.Supp.2d 1240 (W.D. Wash. 2007) the U.S. District Court denied a motion to dismiss and stated it *is* possible for a trade dress claim to stand where copyright infringement may not provide an adequate remedy for protection of the ‘look and feel’ of a website. *Id.* at 1245. The defendant brought a motion to dismiss based on federal preemption in that the copyright claim provides ‘adequate remedy.’ *Id.* at 1244. The plaintiff argued “the trade dress claim is not limited by the Copyright Act because

As applied to trade dress protection of a website, the plaintiff will want to establish and describe the similarities between the two websites,⁷⁴ the products or services are similar to each other,⁷⁵ and that they are perceived by the public to be so similar that it is deceiving and confusing to the consumer.⁷⁶ As discussed herein, consumer confusion may not be actual confusion, but merely a likelihood of confusion in order to warrant an infringement case.⁷⁷ If

the 'look and feel' of its website is not copyrightable." *Id.* The court acknowledges that the plaintiff is applying a "novel legal theory" and is unwilling to deny the argument based on the defense. *Id.* at 1246.

Upon the outcome of the *Blue Nile* case, the question of whether trade dress law will *actually* protect the 'look and feel' of a website is still unanswered. The court did allow the copyright claim and trade dress claims to withstand a motion to dismiss challenge, which seems to indicate trade dress may be applicable to the 'look and feel' of a website. However, the court does indicate the argument will be fatal without a more intensive factual background. The *Blue Nile* case is not indicative that every website owner possesses a trade dress protection claim for their website. It is suggestive, however, that upon the right facts, pleadings, and particularity of a trade dress claim, there *may* be entitlement to protection. *See generally*, *Blue Nile, Inc. v. Ice.com Inc.*, 478 F. Supp. 2d 1240 (W.D. Wash. 2007).

The concept of protecting the 'look and feel' of a website to prevent consumer confusion is very different than preventing the unauthorized use of an original work created by an author. Due to the very nature of trade dress law and copyright law, it is apparent the Lanham Act is better suited for this type of website protection. "Copyright law looks at the similarity between two types of expression, while trademark law focuses on the likelihood of consumer confusion." Lisa M. Byerly, *Look and Feel Protection of Website User Interfaces: Copyright or Trade Dress?*, 14 SANTA CLARA COMPUTER & HIGH TECH. L.J. 221, 248 (1998). Thus, Copyright law is not the best legal avenue for protection of the 'look and feel' of a website for purposes of enjoining an infringer from use of a website.

⁷⁴ For the purposes of this discussion the website and products will be terms used interchangeably. However, trade dress protection will span to products, services, and packaging, as discussed in Raman, *supra* note 24, at 249, 250.

⁷⁵ *Eldon Indus., Inc. v. Rubbermaid, Inc.*, 735 F.Supp. 786, 819 (N.D. Ill. 1990).

⁷⁶ *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 769 (1992).

⁷⁷ *Hard Rock Cafe Licensing Corp. v. Pacific Graphics, Inc.* 776 F.Supp. 1454, 1461 (W.D. Wash. 1991) (court stating that the confusion

consumers are exposed to a product through the Internet, it is understandable why that would lead to a higher possibility of confusion.

Nevertheless, will the law expand to protect the total 'look and feel' of a website and not just an element of the website? Judges have slowly crafted this facet of law and "must do their best to fit legal disputes about the Internet into pre-existing legal frameworks, and legislators, who struggle to understand the technology they govern [sic]."⁷⁸ Some type of protection is necessary to preserve the integrity of a company to ensure that consumers will continue to use the original website and not an infringing imposter.⁷⁹ The good will created by a company, through the Internet, should be entitled to protection.

Trade dress protection is undergoing attempted applications by claimants in the realm of websites, but it is not the appropriate law to apply for the protection of the 'look and feel' of a website. The implication provided in the *Blue Nile* case is notable in the law because it is a case of first impression.⁸⁰ The court appears to be willing to hear the argument that a website owner may in fact be entitled to protection of the "look and feel" under a trade dress theory.⁸¹ Where a claim may infringe a copyright issue, the courts are apprehensive and usually limit the application of the Lanham Act to such a claim.⁸² However, the *Blue Nile* case implies the court will not follow this approach.⁸³ Where a trade dress protection claim is not defeated by copyright preemption, it may just have a chance to withstand the scrutiny under the

must be likely among a *substantial* [emphasis added] amount of potential consumers).

⁷⁸ JOHN MAWHOOD & DANIEL TYSVER, *INTERNET ETHICS* 96 (Duncan Langford ed., St. Martin's Press 2000).

⁷⁹ See Lisa M. Byerly, *Look and Feel Protection of Website User Interfaces: Copyright or Trade Dress?*, 14 *SANTA CLARA COMPUTER & HIGH TECH. L.J.* 221, 250 (1998).

⁸⁰ *Blue Nile, Inc. v. Ice.com, Inc.*, 478 F. Supp. 2d 1240, 1244 (W.D. Wash. 2007).

⁸¹ *Id.*

⁸² 1 MELVILLE B. NIMMER & DAVID NIMMER, *NIMMER ON COPYRIGHT* § 1.01 at 1-83 (2005).

⁸³ *Id.*

trade dress requirements.⁸⁴

Still, this does not allocate automatic protection in any way. Even though trade dress protection may be a closer fit, there is no indication it will function properly to afford the necessary protection that website owners seek. The elements laid out for sustaining a trade dress protection claim are clear and established.⁸⁵ A trade dress claim must be evaluated based upon an overall appearance rather than the individual components.⁸⁶ The Second Circuit notes “if the overall dress is arbitrary, fanciful, or suggestive, it is inherently distinctive despite its incorporation of generic or descriptive elements.”⁸⁷ Thus, if a website owner has generic elements on the site, this may not be fatal if the overall ‘look and feel’ is inherently distinctive.⁸⁸

A merchant who loses a sale to another due to a confusingly similar website has been harmed and is entitled to some type of protection. The protection sought is not the typical loss of sale to a competitor, but a loss of business because the consumer isn’t allowed to make an educated choice due to the confusing nature of the site. The facets of

⁸⁴ This may still be an uphill battle. The court in *Blue Nile*, further notes that “[a]s a novel legal theory [sic], there are more articles supporting trade dress protection for the ‘look and feel’ of websites than there are published cases deciding the merits of this theory.” *Blue Nile, Inc. v. Ice.com Inc.*, 478 F. Supp. 2d 1240, 1246, n. 8 (W.D. Wash. 2007).

⁸⁵ See *supra* Part I of this note.

⁸⁶ Deborah F. Buckman, J.D., Annotation, *Lanham Act Trademark Infringement Actions in Internet And Website Context*, 197 A.L.R. FED. 17, 33 (2004); Deborah F. Buckman, J.D., Annotation, *When is trade dress “inherently distinctive” for purposes of trade dress infringement actions under § 43(a) of Lanham Act (15 U.S.C.A. § 1125(a))—Cases after Two Pesos*, 161 A.L.R. FED. 327, 345(2004).

⁸⁷ *Paddington Corp. v. Attiki Imp. & Distrib., Inc.*, 996 F.2d 577, 584 (2d Cir. 1993).

⁸⁸ The court stated, “one could no more deny protection to a trade dress for using commonly used elements than one could deny protection to a trademark because it consisted of a combination of commonly used letters of the alphabet.” Deborah F. Buckman, J.D., Annotation, *When is trade dress “inherently distinctive” for purposes of trade dress infringement actions under § 43(a) of Lanham Act (15 U.S.C.A. § 1125(a))—Cases after Two Pesos*, 161 A.L.R. FED. 327, 343 (2004).

trade dress may prove to be too difficult for a website protection claim to prevail. If the test for trade dress was a disjunctive test and not conjunctive, then perhaps a claim would stand a better chance to succeed. What seems impossible to prove, the elements of trade dress require an inherent distinction, of non-functional components and consumer confusion, is the application to a technological changing virtual world. Contrary to this Note, it has been argued that trade dress protection is absolutely the correct avenue for this piece of the law.⁸⁹ Respectfully, this author disagrees. The law, as it stands, does not provide adequate protection for website owners.

Presumably, it is Congress who will need to provide the Courts with the tools necessary to make the decisions on how to protect a website user interface. Legislation will ultimately answer this question. The law as it stands is not encompassing enough to target the complex, transforming and ever expanding environment of the Internet.⁹⁰ Although technology may be intimidating for the courts and the legislature, eventually, these questions will ripen and have to be answered.

⁸⁹ Described by Lisa M. Byerly:

The Web site is like a large store display for products or services of a particular entity. However, this Internet display is better than a poster or mannequin because it is interactive, much like a live demonstration. The trade dress at issue when evaluating the total look and feel of a Web site includes the visual screen display and the command buttons or icons used for navigating the site. Trade dress is specifically concerned with protecting the overall organization and concept presented in a display used to present a product or source to a potential consumer. So, trade dress is well suited to protect the entire look and feel of a Web site interface....

Lisa M. Byerly, *Look and Feel Protection of Website User Interfaces: Copyright or Trade Dress?*, 14 SANTA CLARA COMPUTER & HIGH TECH. L.J. 221, 251 (1998).

⁹⁰ See generally the Lanham Act, *supra* note 5.

IV. ENTITLEMENT TO PROTECTION: HOW SHOULD MERCHANTS PROTECT THEIR ‘ELECTRONIC STOREFRONTS’?

As with most cases in the law, a cause of action will be successful for protection of the “look and feel” of a website based on facts and circumstances. The application of the current law will not resolve the issue but will instead “proliferate litigation, create confusion among courts, and prevent the Internet from ever reaching its potential.”⁹¹ The website merchants are entitled to protection for their sales, the companies’ good will, and the companies’ reputation which it built through the use of E-commerce. We are in the era of technological explosions, while the courts and the respected justices seem to lag behind. Perhaps somewhere there is a sitting justice who has recently been appointed to the bench, making it more probable that she or he retain some computer knowledge and understanding and appropriately so, the ability to handle the rulings of these cases.

For now, the merchants are forced to manipulate the law as it stands in order to seek protection of their electronic storefront which has yet to be a prevailing argument. Lawyers understand the impossible uphill battle this poses, judges understand they don’t want to handle these cases, and ultimately consumers pay the price. The entire legislative intent of the Lanham Act is “to regulate commerce within the control of Congress by making actionable deceptive and misleading use of marks in such commerce.”⁹² The consumers confusion is the benchmark for infringement and decidedly so, once this occurs, as it often does, there is potential for a cause of action.⁹³

⁹¹ Jason R. Berne, *Court Intervention But Not in a Classic Form: A Survey of Remedies in Internet Trademark Cases*, 43 ST. LOUIS U.L.J. 1157, 1158 (1999) (citing Deborah Howitt, *War.Com: Why the Battles over Domain Names Will Never Cease*, 19 HASTINGS COMM. & ENT. L.J. 719 (1997)).

⁹² 15 U.S.C. § 1127 (1994 & Supp. 1997).

⁹³ This intent has traditionally been interpreted as protecting consumers from deceptive trade practices and producers from unfair competition. Thus, from its earliest conception, trademark law has had simultaneous,

The relevant factors which may prove to be fatal to a trade dress protection claim for a website owner are whether: (1) there is an *actual* ability to govern this infinite canvas created by the Internet and (2) the ability for a website to prove itself inherently distinctive with nonfunctional elements. With websites constantly changing and developing, how does a party monitor these elements? The subsequent proof of inherent distinctiveness, non-functionality, and consumer confusion will be an uphill battle to fully demonstrate in the virtual world.

Suggestions and proposals for dealing with the complex scenario do exist.⁹⁴ Some have even gone as far as to suggest a twenty-seventh Amendment to the United States Constitution.⁹⁵ “The sweeping reach of the Internet and its demonstrated potential for wreaking havoc with traditional notions of the law suggest that it may become an unruly beast unless given its own jurisdiction in which to roam.”⁹⁶ To this day, there are scholars who think that this is not a problem and the courts should be able to deal with the claims with the law as it stands.⁹⁷ This is truly not an advantageous option

sometimes conflicting goals of furthering commerce, while at the same time ensuring equitable transactions where money alone cannot set the wronged party right.

⁹⁴ In discussing remedies for trademark infringement on the Internet, Jason R. Berne descriptively outlines the following list:

- (1) a new system for applying traditional trademark law to Internet trademark disputes, (2) the creation of new non-judicial bodies for resolution of Internet disputes, (3) the creation of a new federal cause of action, (4) the creation of courts with limited jurisdiction over Internet disputes, and even (5) the enacting of an amendment to the United States Constitution.

Berne, *supra* note 91, at 1158–59.

⁹⁵ Kevin K. Ban, *Does the Internet Warrant a Twenty-Seventh Amendment to the United States Constitution?*, 23 J. CORP. L. 521, 540 (1998).

⁹⁶ *Id.* (This amendment is not the most practical solution offered to remedy the dilemma).

⁹⁷ Still others have put forth the proposition that “[r]eal trademark infringement using domain names is a rare and not very significant problem. . . . That the problem has been blown out of proportion

simply because the ability and capacity of the Internet to control a consumer's life truly deserves on point ground rules. The Internet is far more complex and superior and should be respected enough to warrant its own set of rules in this area. For the benefit of the consumers, merchants, and simply our Courts, as a society it is necessary to implement some sort of new system/law to assist in these technological legal battles.⁹⁸

There is no answer for how merchants should protect their websites. In the end, it will be a merchant's responsibility to maintain his website and evaluate potential infringing websites (or whether he is the infringing party). It is highly unlikely the system will be able to self regulate. A source of protection is needed for the merchants and consumers in order to mitigate consumer confusion.

V. CONCLUSION

Upon analyzing the case law, the groundwork to protect the "look and feel" of a website is not established. The dispositive factors such as consumer confusion, functionality, and specificity of claims are all infinite yet so limited on a screen of a computer. Trade dress protection of the 'look and feel' of a website has not been upheld by *any* court. The law of trade dress does not fit the requirements needed to protect the 'look and feel' of a website. Nevertheless, future cases are imminent and require an active discussion.⁹⁹

Currently, the federal courts have applied the Lanham Act

[, however,] is highly significant." Milton Mueller, *Trademark and Domain Names: Property Rights and Institutional Evolution in Cyberspace*, <http://faculty.ischool.syr.edu/mueller/study.html> (last visited Nov. 10, 2008).

⁹⁸ Similar to the Lanham Act, Congress should enact legislation specifically on point to this quandary. With the Internet growth at exponential rates and consistently increasing use, new laws are warranted.

⁹⁹ The *Blue Nile* case acknowledges the "new legal theory" of trade dress protection of a website, however, the court held it was too early into the case to make the decision whether a copyright claim did in fact afford the Plaintiff with adequate protection. Due to a subsequent stipulation of the parties to dismiss, the question remains unanswered. *Blue Nile, Inc. v. Ice.com Inc.*, 478 F. Supp. 2d 1240, 1246 (W.D. Wash. 2007). See also John Zabriskie, *Are You Trade-dressed for Success? Protect Your Website's "Look and Feel,"* WISCONSIN TECHNOLOGY NEWS, Nov. 27, 2007, <http://wistechnology.com/articles/4349/> (last visited Nov. 10, 2008).

to more than fifty cases that involve the Internet and trademark violations.¹⁰⁰ To date, the *Blue Nile* case is the closest the law has come to dealing with the issue. The courts are being forced to create a new *common law* on the subject. However, the Internet and technology change so rapidly that it is unlikely the Courts will ever catch up. In the end, the Legislature will need to create new law, a new governing body, or even a new Constitutional Amendment in order to adequately protect website merchants.¹⁰¹ Therefore, it is not possible to properly protect website owners from consumer confusion under trade dress law, as it stands today. The expansion of E-commerce, the growth of the Internet, and the apprehension of the courts have all contributed to the lack of protection for these merchants.¹⁰²

The electronic communication is unique and is arguably one of the most powerful advertising tools of this era. The cost of uploading a website can be very minimal and is extremely effective when trying to reach a target audience. A website is used as a means to gain sales and acquire goodwill for a business. Returning to Connie the consumer who wants to purchase her dad a *Gizmo* gadget by simply entering a keystroke, her Internet search brought the merchants directly to the forefront for her to choose from. There is absolutely nothing like this in the real world thereby requiring new rules to apply. Connie is unable to determine which website she should purchase from. There is no question that the merchants should be entitled to protection from this type consumer confusion.

As discussed above, copyright law is off the mark with

¹⁰⁰ Berne, *supra* note 91, at 1214 (trademark law encompasses the subject of trade dress law).

¹⁰¹ Berne, *supra* note 91 at 1158–59.

¹⁰² Companies whose businesses are on opposite sides of the country, or even the world, selling the same products, may have different business structures, and innocently enough create similar websites, which *may* cause confusion. Connie is left guessing from which website to purchase her *Gizmo* gadget. In this situation, the possibility exists that one of the companies has either lucked out with the sale, or possibly been injured by the loss of the sale.

the intent of the protection provided.¹⁰³ Does trade dress adequately protect this type of claim?¹⁰⁴ It seems to be the closest to the mark, however, as the old proverbial saying goes, it is a little like ‘trying to fit the square peg in the round hole,’ it just doesn’t fit.¹⁰⁵

¹⁰³ See discussion, *supra*, note 73.

¹⁰⁴ Further questions which stump the courts are: “What legal standard should be employed to measure the inherent distinctiveness of trade dress? What does it mean for trade dress to be ‘inherently distinctive’?” See Deborah F. Buckman, J.D., Annotation, *When is trade dress “inherently distinctive” for purposes of trade dress infringement actions under § 43(a) of Lanham Act (15 U.S.C.A. § 1125(a))—Cases after Two Pesos*, 161 A.L.R. FED. 327 (2004).

¹⁰⁵ The Court in *Krueger Intern., Inc. v. Nightingale Inc.* states this question is “one of the most difficult analytical issues in all of trade dress law.” *Krueger Intern., Inc.*, 915 F. Supp. 595, 600 (S.D.N.Y. 1996).