



# ELECTRONIC COMMERCE & LAW

## REPORT

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### Trademarks

#### **Trademark Attorneys Testing Application Of Trade Dress Theory to Web Page Imitations**

**T**rademark attorneys in two pending lawsuits are testing the application of trade dress theories to Web sites they claim mimic the “look and feel” of Web pages associated with well-known brands.

In *Facebook Inc. v. Studivz Ltd.*, N.D. Cal., No. 08-3468, 7/8/09, attorneys for the Facebook social network sued a German company they allege created a social network that imitates the structure and features of Facebook’s design and merely changed the background color.

LegalJiffy.com Inc., a company that sells self-help legal documents online, has also filed a Web trade dress complaint against a competitor. The company argues that the competitor’s Web site looks remarkably similar to its own, and that consumers are likely to be confused (*LegalJiffy.com Inc. v. LegalCPU.com*, C.D. Cal., No. 09-1867, 3/18/09).

To date, a handful of other plaintiffs have attempted Web site trade dress claims. Courts have on a few occasions addressed the issue in preliminary rulings, but a lawsuit alleging that a party imitated the trade dress of a Web site itself has yet to proceed to a final judicial resolution.

Intellectual property attorneys experienced in trade dress litigation told BNA that trade dress could be a good option for plaintiffs seeking to address alleged Web site copying—in the right case. Copyright does not protect a Web site’s overall “look and feel” and a successful copyright claim requires evidence of access and copying, so trade dress can potentially fill in where a plaintiff cannot allege copyright infringement, they said.

However, plaintiffs must take care to ensure a trade dress claim rests on alleged imitation of a Web site’s form, not the functions of design elements therein such

as buttons and menus, they cautioned. A successful trade dress claim will require, among other things, allegations that a party has infringed the “look and feel” of a Web site’s design, not the page’s function.

#### **Trade Dress Requires Distinctive, Nonfunctional Design.**

Section 43(a) of the Lanham Act provides a cause of action for the use of any unregistered symbol, device, or “trade dress” that is likely to cause confusion as to the origin of a plaintiff’s goods.

In *Abercrombie & Fitch Stores, Inc. v. American Eagle Outfitters, Inc.*, 280 F.3d 619, 629 (6th Cir. 2002), the Sixth Circuit explained what a plaintiff must prove, by a preponderance of the evidence, to prevail on a trade dress infringement claim:

- (1) that the trade dress in question is distinctive in the marketplace, thereby indicating the source of the good it dresses;
- (2) that the trade dress is primarily nonfunctional; and
- (3) that the trade dress of the competing good is confusingly similar.

#### **Facebook, Legal Research Site Knock-Offs Alleged.**

In the *Facebook* case, attorneys for the social network assert that a copycat Web site created in Germany infringes on its trade dress.

“Because [the German site] looks like Facebook and incorporates nearly identical features and functionality to Facebook, users have and will continue incorrectly to believe that [the service] is associated with Facebook,” Facebook argued.

According to the complaint, the German company mimicked Facebook’s carefully designed “look and feel” by, among other things:

- incorporating a feature permitting users to greet other users using the German equivalent of the Facebook “poke”;
- permitting users to write on other users’ “walls”;
- graphically breaking up Web pages into distinct frames, which are quite similar to Facebook’s design; and

■ placing its logo, search, and photo upload tools in the same location as on the Facebook page.

Facebook also raised breach of contract and Computer Fraud and Abuse Act, 18 U.S.C. § 1030, claims. Facebook asserts that the German company accessed its site, in violation of its Terms of Service, in order to copy it.

In the *LegalJiffy* case, a company operating a Web site through which it sells self-help legal documents, alleges that a competitor made a “drastic change” to its Web site after the company refused to enter into a partnership with the competitor.

The company asserts that the competitor’s site is “a literal copy” of its Web site, including the services offered, clip art, and almost word-for-word copying of service descriptions.

#### **Attorneys Say Trade Dress Should Protect Web ‘Feel.’**

Trade dress can play a role in protecting Web sites, but only to the extent a plaintiff challenges the imitation of a site’s “look and feel,” attorneys told BNA.

**Milord Keshishian**, an intellectual property attorney with Milord & Assoc. in Los Angeles, explained that though individual elements of Web sites, such as buttons, menus, and toolbars, could be considered “functional” attributes, their overall impression could qualify for trade dress protection.

For example, if a company’s use of certain distinctive colors and fonts on a Web site makes the company’s association with the site apparent, considering the overall “look and feel,” a copycat design could infringe the company’s trade dress. Even though the color or font may have been part of a functional element, it would be the “feel” of that element, not the element itself, that would warrant the protection.

However, in filing a complaint, the rights holder must choose words carefully. “The trade dress owner must identify its protectable trade dress with specificity, its non-functionality, and the likelihood of confusion caused by copying,” **Keshishian** said.

Glenn D. Bellamy, an intellectual property attorney with Greenebaum Doll & McDonald PLLC, in Cincinnati, also agreed that the trade dress theory should translate to the Internet space. “In my opinion, there is no reason why trade dress would not apply to electronic commerce in the same way as it does to a brick and mortar store,” he said.

However, proving distinctiveness can be challenging, he said. Application of the theory would likely be easiest in a typosquatting situation, where a squatter registers a domain name similar to one for a well-known brand, Bellamy predicted. “If a typosquatter created a page that looked like the real site, trade dress would apply there,” he said.

#### **Theory Could Apply Where Copyright Claim Unavailable.**

**Keshishian** said that trade dress may be a useful option for plaintiffs who allege Web site copying, but cannot establish a copyright claim.

Copyright does not protect the overall “look and feel” of a Web site, he explained, pointing to *Darden v. Peters*, 402 F.Supp.2d 638 (E.D.N.C. 2005)(11 ECLR 19, 1/4/06).

In *Darden*, the court held that the Register of Copyrights properly denied registration of a Web site, and the series of maps is contained. The plaintiff could not make a legitimate copyright claim for the Web site’s format, layout, or page design, the court said.

The Copyright Act defines copyrightable material as “original works of authorship fixed in any tangible medium of expression.” 17 U.S.C. § 102. Works of authorship include “pictorial, graphical and sculptural works.” 17 U.S.C. § 102 (a)(5).

However, regulations issued by the Copyright Office, at 17 C.F.R. § 202.1, provide that “[w]ords and short phrases such as names, titles, and slogans; familiar symbols or designs; mere variations of typographic ornamentation, lettering or coloring; mere listing of ingredients or contents,” are not copyrightable.

In the *Darden* case, examiners noted that, in general, formatting of Web pages is not copyrightable. While registrations are available for compilations, the court said the Copyright Office acted within its discretion in concluding that “[t]he longstanding practice of the Copyright Office is to deny registration of the arrangement of elements on the basis of physical or directional layout in a given space, whether that space is a sheet of paper or a screen of space meant for information displayed digitally.”

Trade dress could provide a remedy where a plaintiff cannot establish copying, Bellamy predicted. “Copyright never protects ideas, and it requires actual copying. Independent creation is a defense.”

**Few Courts Have Applied Theory to Web Sites.** No court has yet held that a Web site created Lanham Act liability under a trade dress theory, although a number of online trade dress cases have been filed.

The U.S. District Court for the Western District of Washington, the U.S. District Court for the Central District of California, and the U.S. District Court for the Northern District of California have discussed the issue, however.

In *Blue Nile Inc. v. Ice.com Inc.*, 478 F. Supp. 2d (W.D. Wash. 2007)(12 ECLR 107, 1/31/07), the court declined to dismiss trade dress claims predicated on alleged infringement of the “look and feel” of a jewelry sales Web site.

The defendant in the case moved to dismiss, arguing the trade dress claim overlapped with the plaintiff’s copyright claims. The court denied the motion for two reasons.

First, the court said, alleged trade dress infringement in the Web context is a novel theory. The claim warranted greater factual development before the court could determine whether the copyright claims would provide an adequate remedy. The court noted that the defendant provided no authority that copyright protected the “look and feel” of the plaintiff’s Web site.

Second, the court noted that motions to dismiss should rarely be granted, particularly in cases that involve “a novel legal theory.”

The court never addressed the issue further, because the parties settled.

The U.S. District Court for the Central District of California was also persuaded that an online trade dress infringement theory was viable in *Calyx Technologies Inc. v. Ellie Mae Inc.*, No. 04–1640 (N.D. Cal. Sept. 9, 2004).

There, a technology company asserted that a competitor deliberately copied its unique loan software screen displays.

The competitor argued that the company’s broad purported categories of trade dress—including selection of text, placement of texts, placement of fields, and use of

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color—were not pleaded with sufficient specificity to support a claim, but the court disagreed.

The court found the plaintiff sufficiently plead that its screen displays had acquired distinctiveness. The parties settled.

In *SG Services Inc. v. God's Girls Inc.*, No. 06-989 (C.D. Cal. May 9, 2007), the court said that Web site colors and phraseology can qualify as non-functional and be protected under the Lanham Act. However, trade dress protections only apply if the elements are “merely adornment” and “do not constitute the actual benefit that the customer wishes to purchase.”

In *God's Girls*, the Web site owner failed to establish that the site's pink color and use of specific phrases was distinctive. That lack of evidence, coupled with other pleading deficiencies, warranted a grant of summary judgment to the defendant, the court held.

By AMY E. BIVINS

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*Full text of the Facebook complaint available at <http://pub.bna.com/eclr/08cv3468.pdf>*

*Full text of the LegalJiffy complaint available at <http://pub.bna.com/eclr/09cv1867.pdf>*