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

By Matt Mikels

I. INTRODUCTION

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

To say that the Internet is an important part of modern life is uncontrover-sial. People all over the world use the Internet for everything from banking, to entertainment, social networking, and to weight loss. The most popular sites are valued in the billions of dollars, demonstrating that popular and ground-breaking sites are big business.

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

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1 Senior Note and Comment Editor, CommLaw Conspectus: Journal of Communications Law and Technology, Volume 23, J.D. Candidate, May 2015, The Catholic University of America, Columbus School of Law, B.S. Indiana University, 2006, M.S. University of Florida, 2008. I would like to thank Professor Megan La Belle for her guidance and comments; everyone at the CommLaw Conspectus for their hard work during the editing process; Jeff Greco for his insights into website design; and my wife Laura for her love, support, and proofreading.


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

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

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

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


courts have been apprehensive to apply trade dress law to websites. One of
the first cases to consider that trade dress protection for a website was possible,
Blue Nile, Inc. v. Ice.com, Inc., was not decided until 2007. Consequently,
this area remains mostly unexplored by courts.

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

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

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18 See Blue Nile, 478 F. Supp. 2d at 1246 (calling trade dress protection of websites a “a
novel legal theory”).
19 Id. at 1242.
20 See, e.g., Nguyen, supra note 15, at 1234; Lisa M. Byerly, Look and Feel Protection
of Web Site User Interfaces: Copyright or Trade Dress?, 14 SANTA CLARA COMPUTER &
HIGH TECH. L.J. 221, 222-24 (1998); Gary Franklin, Esq., Kevin Henry, Esq., Protecting
Your Company’s Website: The Application of Intellectual Property to the Digital Marke-
3863928, at *4, *5 (E.D.N.Y. July 24, 2013); see also Creative Co-Op, Inc. v. Elizabeth
4961702 (C.D. Cal. Nov. 19, 2010); see also Conference Archives, Inc. v. Sound Images,
23 Conference Archives, 2010 WL 1626072, at *16.
how websites may still find strong protection within existing United States intellectual property law.

II. INTELLECTUAL PROPERTY IN THE UNITED STATES

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

A. United States Patent Law

1. Utility Patents Basics

Utility patents are awarded to anyone who invents a new and useful process, method, machine, manufacture, or composition of matter.27 The claimed invention must be novel28 and non-obvious,29 and it must comply with the statutory requirements for the patent specification.30 A patent gives the inventor the right to exclude others from making or using the claimed invention for a period of twenty years from the filing date of the application for the patent;31 after that time, the patent enters the public domain and the patent owner cannot sue for infringement.32 Patents have been issued for everything from light bulbs,33 to barcode scanners,34 and to new types of plastic.35

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

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26 See Franklin & Henry, supra note 20.
28 See id. § 102 (the America Invents Act amended the specific requirements for novelty effective March 16, 2013, but still requires novelty).
30 See id. § 112 (the America Invents Act amended the previous Patent Act of 1952 effective March 16, 2013, but has similar requisites for the specification).
31 Id. § 154(a)(2).
32 See id. § 154(a)(1). The term can be adjusted, however, under the provisions of 35 U.S.C. § 154(b). Id. §154(b).
35 US Patent No. 8,349,924 (filed 2010).
36 See § 154(a)(2) (providing the limited timeframe of twenty years from the date of filing the application for the patent).
gains the new technical knowledge disclosed in the patent by the inventor, is at the heart of the United States patent system. Because of this goal, utility patents are only given to functional designs that increase the technical knowledge available to the public. For example, once Edison’s light bulb patent expired, anyone could use the technology that was disclosed in the patent. Any patent that seeks only to protect a purely ornamental design is invalid. Design patents, however, were created to protect ornamental designs that are not eligible for utility patent protection.

2. Design Patents and Recent Changes in Their Law

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

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

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


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

40 Richardson, 597 F.3d at 1293-94.

41 Id.


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

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


47 Egyptian Goddess, Inc. v. Swisa, Inc. 543 F.3d 655, 678 (Fed. Cir. 2008) (rejecting the “point of novelty” and “non-trivial advance” tests and adopting the “ordinary observer” test as the sole test for whether a design patent has been infringed).
the defendant had infringed the design of the plaintiff’s nail buffer, which was disclosed in a design patent. 48 The Court of Appeals for the Federal Circuit rejected the old “point of novelty test,” holding that the “ordinary observer test” is the proper test for design patent infringement. 49 This test considers an ordinary observer who is familiar with prior art designs and decides whether that observer would be deceived by the accused infringing design. 50 This decision and the move to the ordinary observer test were widely seen as making it easier to prove design patent infringement. 51

B. United States Copyright Law Fundamentals

Copyright protects “original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.” 52 These works can include literary works, musical works, dramatic works or graphical works. 53 Like patents, copyrights expire after a certain span of time. Usually, this time period is seventy years after the author’s death for works published after January 1, 1978. 54 Also like patent law, copyright law seeks to give the creator of the copyrighted work rights to his or her work for a set time period, until the work passes to the public domain and becomes freely available. 55

Courts have held that computerized works stored on the Read Only Memory (ROM) of a computer are protectable by copyright. 56 Copyright protection does not extend to any process, system, or other similar functional thing that embodies the copyrighted work. 57 However, courts have held that copyright protection

48 Id. at 668.
49 See id. at 670-71 (the “point of novelty test” requires the plaintiff who is alleging infringement to point out the novelty in the design that the defendant allegedly copied).
50 See id. at 676 (adopting the “ordinary observer” test, in which the ordinary observer is assumed to notice the minor differences between the patented design and the alleged infringing design).
51 Id.
52 Gene Quinn, Google Granted Design Patent on Search Webpage, IP WATCHDOG (Sept. 9, 2009), http://www.ipwatchdog.com/2009/09/03/google-granted-design-patent-on-search-webpage/id=5512/.
54 Id.
55 Id. § 302(a).
56 See id. § 302(c).
58 § 102(b).
extends to source code for computer programs and operating systems.\textsuperscript{59}

C. Trademarks in the United States

1. Traditional Trademarks and Basic Governing Law

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

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

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

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

\textsuperscript{59} Apple Computer, 714 F.2d at 1249; see also discussion infra Section III, B, 2.
\textsuperscript{61} See Marshak v. Green, 746 F.2d 927, 929 (2d Cir. 1984).
\textsuperscript{62} Prestonettes, Inc., v. Coty, 264 U.S. 359, 368 (1924).
\textsuperscript{63} Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4, 9 (2d Cir. 1976).
\textsuperscript{64} Compare “generic marks” in Delaware & Hudson Canal Co. v. Clark, 80 U.S. 311, 322-323 (1871) (holding that “Lackawanna coal” was not a phrase that could be trademarked), with “suggestive marks” in Stix Products, Inc. v. United Merchants & Mfrs., Inc., 295 F. Supp. 479, 488 (S.D.N.Y. 1968) (granting patent to “CON-TACT” for self-adhesive decorating plastics).
\textsuperscript{66} See Retail Servs., Inc. v. Freebies Publ’g, 364 F.3d 535, 538 (4th Cir. 2004).
\textsuperscript{67} Id.
\textsuperscript{68} Miller Brewing Co. v. G. Heileman Brewing Co., Inc., 561 F.2d 75, 79 (7th Cir.
“Holiday Inn” is descriptive because the hotel chain is the “inn” where travelers stay while on vacation or “holiday.”\(^{69}\) Marks that are “merely descriptive” cannot be registered, because they are not inherently distinctive.\(^{70}\) A mark that consumers perceive as coming from one source is distinctive,\(^{71}\) i.e. the mark “has become distinctive of the applicant’s goods in commerce,” and may be protected or registered.\(^{72}\) “Holiday Inn” has acquired distinctiveness, because when an individual states, “I’m staying at the Holiday Inn in Washington, D.C.,” most consumers would recognize this name as the well-known national hotel chain.

Distinctiveness\(^{73}\) for descriptive marks is shown if the mark has a secondary meaning.\(^{74}\) Factors that demonstrate secondary meaning and thus source-identification,\(^{75}\) include consumer testimony and surveys, how long the trademark has been used, advertising, and sales volume.\(^{76}\) While all of these factors are important to a secondary meaning analysis, customer surveys are the most effective at demonstrating source-identification and essential to showing secondary meaning.\(^{77}\)

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

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


\(^{71}\) RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 1052 (2012).


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

\(^{74}\) RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 7.

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

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


Suggestive marks are therefore inherently distinctive,^{81} so they may be registered without proving secondary meaning.^{82} As a result, determining whether or not a trademark is descriptive or suggestive is one of the most-contested areas in trademark litigation.^{83} Arbitrary or fanciful is the final classification of trademark.^{84} Arbitrary marks take a word or symbol and use it in an arbitrary manner with respect to the product, so that it does not describe or suggest the product.^{85} Fanciful marks create a new word or mark to associate with the product or service. Examples of this include “Apple” (applied to computers and other technological products) or “Exxon” (applied to petrochemicals). “Apple” is an arbitrary mark, since the word “apple” existed prior to the mark, but it is now being used to name a technology company in an arbitrary way. “Exxon” is fanciful: the word did not exist before the oil company created the word as its company name.^{86} Like suggestive marks, arbitrary marks are automatically entitled to trademark protection, because they are also inherently distinctive.^{87} Arbitrary or fanciful marks avoid the commonly contested descriptive/suggestive distinction.^{88}

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

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

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^{80} See id. at 212.
^{81} Star Indus., Inc. v. Bacardi & Co. Ltd., 412 F.3d 373, 385 (2d Cir. 2005).
^{83} See B. Brett Heavner and Marcus H.H. Luepke, Avoiding Trademark Pitfalls in the “Land of the Unlimited Possibilities”, FINNEGAN (July-Aug. 2008), http://www.finnegan.com/resources/articles/articlesdetail.aspx?news=72244da2-f0ae-432f-80a8-2f88a8b2bd0c (determining whether a mark is suggestive or descriptive requires precise evaluation and objective judgment).
^{84} See, e.g., Abercrombie & Fitch, 537 F.2d at 9.
^{85} MCCARTHY, supra note 73, § 11:4.
^{86} See EXXON, Registration No. 922,511.
^{87} See, e.g., Star Indus., Inc. v. Bacardi & Co. Ltd., 412 F.3d 373, 385 (2d Cir. 2005).
^{88} See, e.g., Abercrombie & Fitch, 537 F.2d at 11.
^{90} Nutri/System, Inc. v. Con-Stan Indus., Inc., 809 F.2d 601, 605 (9th Cir. 1987).
can be a trademark. Classifying color somewhere on the trademark spectrum can be difficult.\footnote{Qualitex Co. v. Jacobson Products Co., Inc., 514 U.S. 159, 160-61, 166 (1995).} The Supreme Court tackled this issue in \textit{Qualitex Co. v. Jacobson Products Co., Inc.}\footnote{Id.} The plaintiff Qualitex had registered the green-gold color of its dry cleaning pads as a trademark, and the defendant Jacobson began using a similar color in its pads.\footnote{Id. at 161.} Jacobson argued there are special reasons why the law should forbid the use of color alone as a trademark; for instance, if the law were to permit color as a trademark, Jacobson argues that such a result would “produce uncertainty and unresolvable court disputes about what shades of a color a competitor may lawfully use.”\footnote{Id. at 166-67.}

The Court rejected Jacobson’s arguments, finding no reason why color alone could not be protectable as a trademark, so long as that particular color acquired secondary meaning.\footnote{Id. at 163.} A product feature such as color is functional if it is either essential to the product’s use or if it somehow affects the product’s cost or quality.\footnote{Inwood Labs, Inc. v. Ives Labs, Inc., 456 U.S. 844, 850 n.10 (1982).} Colors can meet the requirements of trademarks.\footnote{Qualitex Co., 514 U.S. at 166.} In this case, the dry cleaning pad falls into the arbitrary category. There is no competitive reason why a dry cleaning pad should be green-gold, and the color performs no significant function.\footnote{Id. at 166 (citing Qualitex Co. v. Jacobson Products Co., Inc., No. CV 90 1183 HLH(JRX), 1991 WL 318798, at *4 (C.D. Cal. Sept. 3, 1991)).}

\textit{Qualitex} illustrates the large range of objects and designs that can be protected by a trademark. If something identifies its source and is not functional, trademark protection is possible.\footnote{Inwood Labs, 456 U.S. at 850-51 nn.10-11.} These ideas provide the foundation for a special type of trademark protection: trade dress.

2. Trade Dress: A Special Form of Trademark

Trademark protection can extend not only to words or logos, but to other objects related to a product’s source. Trade dress is a special type of trademark “that originally included only the packaging, or dressing, of a product.”\footnote{Wal-Mart Stores, Inc. v. Samara Bros., Inc., 529 U.S. 205, 209 (2000) (internal quotations omitted).} However, that definition has expanded over the years to include product design as well.\footnote{Id.} This enlarged definition now encompasses “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. Under this new definition, trade dress protection has been extended to greeting cards, magazine covers, a bathroom scale, and a variety of other products. However, this expansion led to problems in defining the alleged trade dress.

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

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

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

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105 Landscape Forms, Inc. v. Columbia Cascade Co., 113 F.3d 373, 381 (2d. Cir. 1997); see McCarthy, supra note 73, § 8:7.25 (“[h]azy and indefinite references to the protectable and allegedly infringed aspect of trade dress in a Web site as its “look and feel” fall far short of the exactitude that is required.”).
107 Jeffrey Milstein, Inc. v. Greger, Lawlor, Roth, Inc., 58 F.3d 27, 33 (2d Cir. 1995).
110 Brunswick Corp. v. Spinit Reel Co., 832 F.2d 513, 517 (10th Cir. 1987).
112 See id. § 1125(a)(3) (“the person who asserts trade dress protection has the burden of proving that the matter sought to be protected is not functional”); Freixenet, S.A. v. Admiral
functional design is the scope of patent law, not trademarks. Trademarks should only identify the source of the goods or service to the consumer and not preclude competitors the right to use a functional design they would otherwise have the right to use.

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

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

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114 RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 17 (1995).
116 Id. at 1332; see TrafFix Devices, Inc., 532 U.S. at 29-30 (finding that expired utility patents do not prevent a finding of functionality, but are strong evidence of functionality).
117 In re Morton-Norwich Prods., 671 F.2d at 1334.
118 Id. at 1340-41.
119 Id. at 1341.
120 Id.
121 Id.
122 Id.; see Disc Golf Ass’n, Inc. v. Champion Discs, Inc., 158 F.3d 1002, 1006 (9th Cir. 1998).
123 Fisher Stoves, Inc. v. All Nighter Stove Works, Inc., 626 F.2d 193, 195 (1st Cir. 1980).

The mere fact that something can be made in alternative ways does not automatically render the contested design non-functional.\footnote{See Application of Honeywell, Inc., 532 F.2d 180, 182 (C.C.P.A. 1976) (finding that the existence of alternative thermostat designs does not "detract from the functional character" of the design).} Moreover, the existence of only a few workable alternatives strongly implies a functional design.\footnote{Id.} Such a situation leads to the fourth factor of cost, by requiring a competitor to design a new and potentially less useful design to avoid trade dress infringement even though such a design is not patented.\footnote{Brunswick Corp., 35 F.3d at 1531.} The Restatement of Unfair Competition has stated the functional doctrine thusly:

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

One example that illustrates this concept is the case \textit{Brunswick Corp. v. British Seagull Ltd.}, where the plaintiff, a manufacturer of outboard motors, sought to register the color black for outboard motors as its trade dress.\footnote{Id.} The USPTO and the court both found the use of that color was functional, even though it did not make the motor function better.\footnote{Id. at 1531.} Rather, the court and the USPTO found the use of the color black was a "competitive need" in the outboard motor industry, because many other outboard motor manufacturers use black for many different reasons. For example, black "goes well" with most boat colors, allowing it to be used on many more boats than a different colored motor would, and it makes the motor look smaller.\footnote{Id.}

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

The seminal case for trade dress is \textit{Two Pesos, Inc. v. Taco Cabana, Inc.} Taco Cabana operated a chain of Mexican restaurants that featured a unique combination of vivid colors, murals, and paintings to create a festive atmos-
phere for patrons. Shortly thereafter, Two Pesos built restaurants with similar designs and colors. Taco Cabana sued for trade dress infringement, and Two Pesos argued that Taco Cabana had not shown secondary meaning.

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

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

III. PROTECTING WEBSITE DESIGN WITHIN CURRENT INTELLECTUAL PROPERTY LAW

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

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135 Id. at 765.
136 Id. at 765-66.
137 Id. at 774.
138 Id.
139 Id. at 766.
140 Id. at 776.
141 Id. at 775.
A. Website Basics and Common Web Design Principles

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

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

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

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150 Id.
151 Id.
152 Id.
154 Martin, supra note 150.
ades, and departing from this convention would likely confuse users.\textsuperscript{155}

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

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

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

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

\textsuperscript{155} Id.
\textsuperscript{156} Id.
\textsuperscript{157} Nguyen, supra note 15.
\textsuperscript{158} See Martin, supra note 150 (examples under “Relationships”).
\textsuperscript{159} Id.
\textsuperscript{160} Id.
\textsuperscript{161} Id.
\textsuperscript{162} Id.
\textsuperscript{163} Fadeyev, supra note 153.
\textsuperscript{164} Id.
\textsuperscript{165} Id.
\textsuperscript{166} Fadeyev, supra note 148.
\textsuperscript{167} Id.
For example, the Google search page incorporates many of these elements.\textsuperscript{168} The page is simple, and the search bar is in the middle of the page, making it absolutely clear where a user is to type the search query.\textsuperscript{169} There is very little else on the page, making the site easy to navigate.\textsuperscript{170} When the list of results is displayed, previously visited links are denoted with purple text, and sites that have not been visited are displayed with blue text.\textsuperscript{171} This use of color helps the user remember what sites have already been visited, so the user does not revisit the same site again while searching. All these design elements reinforce the function of web searching.\textsuperscript{172}

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

B. Intellectual Property Protection for Websites

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

\textit{a. Utility Patents May Protect Functional Software Methods}

A website owner may gain patent protection for the functional aspects of his website, provided these are patentable subject matter,\textsuperscript{177} useful,\textsuperscript{178} novel,\textsuperscript{179} non-obvious\textsuperscript{180} and meet the statutory requirements of the patent specification.\textsuperscript{181}

\begin{flushleft}
\textsuperscript{169} \textit{Id}.
\textsuperscript{170} \textit{Id}.
\textsuperscript{171} \textit{Id}.
\textsuperscript{172} \textit{Id}.
\textsuperscript{174} \textit{Id}.
\textsuperscript{175} \textit{Id}.
\textsuperscript{176} \textit{Id} (“There needs to be a clear and continuous relationship between form and function.”).
\textsuperscript{178} \textit{Id}.
\textsuperscript{179} \textit{Id} § 102.
\textsuperscript{180} \textit{Id} § 103.
\textsuperscript{181} \textit{Id} § 112.
\end{flushleft}
However, such an endeavor leads the site owner into the complex realm of software patents. Methods generally are patentable subject matter, and software is patented as a method of performing some operations on a computer-readable medium. Software patents are controversial, but they still remain a valid form of intellectual property protection. However, software patents have been increasingly subject to more restrictions on their scope. In *Alice Corp. v. CLS Bank International*, the Supreme Court held that abstract ideas implemented on a computer do not translate into a patentable invention. What exactly this means for software patents as a whole remains to be seen, as now more than ever software patents are subject to restrictions that are not fully defined. This uncertainty presents problems for those seeking to protect their intellectual property.

b. Design Patents are a Potential Alternative

The *Egyptian Goddess* case changed the standard for proving design patent infringement. Some viewed this decision as a victory for design patent owners and a more economical cause of action for website owners. In fact, not long after the *Egyptian Goddess* decision, Google obtained a design patent for its search website. Design patents, which require new and novel designs, could be used to protect the overall look and feel of a website. When courts determine the merits of a design patent infringement claim, they evaluate all aspects of the

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182 Id. § 100.
185 *See, e.g.*, Bilski v. Kappos, 561 U.S. 593, 130 S. Ct. 3218, 3227 (2010) (holding that the claimed subject matter is subject to the Machine or Transformation test, i.e. the subject matter must be tied to a particular machine or transform something); *see also* Diamond v. Diehr, 450 U.S. 175, 185 (1981) (“Excluded from such patent protection are laws of nature, natural phenomena, and abstract ideas.”).
187 *See Bilski*, 561 U.S. 593, 130 S. Ct. at 3226-27 (2010) (holding that while the machine-or-transformation test is useful, it’s not the sole test for determining patent eligibility); *see also* Jason Rantaten, *Alice v. CLS Bank: Claims Invalid Under Section 101*, PATENTLYO (June 19, 2014), http://patentlyo.com/patent/2014/06/claims-invalid-section.html (stating that parts of the ruling are “going to tie folks in knots”).
188 Quinn, *supra* note 52.
claimed design. In other words, the construction of the design patent claim avoids the functionality limits on trademarks and trade dress.\footnote{OddzOn Products, Inc. v. Just Toys, Inc., 122 F.3d 1396, 1405 (Fed. Cir. 1997).} In fact, some courts have suggested this path for other aspiring trademark owners.\footnote{Du Mont & Janis, supra note 46.} With software patents in a state of flux,\footnote{Alice Corp. Pty. Ltd. v. CLS Bank Int'l, No. 13-298, slip op. at 16-17 (U.S. June 19, 2014); see also Bilski v. Kappos, 561 U.S. 593, 130 S. Ct. 3218, 3226, (2010) (holding that while the machine-or-transformation test is useful, it is not test for determining patent eligibility); see also Rantaten, supra note 187 (stating that parts of the ruling are “going to tie folks in knots”).} design patents for websites are a promising alternative.\footnote{Quinn, supra note 52.}

2. Copyright Protects Purely Artistic Elements

Artistic works like graphics, music, or literary works may be protected by copyright.\footnote{17 U.S.C. § 102(a) (2012).} Some courts view “literary works” to include the source code of computer programs and websites.\footnote{Computer Assocs. Int’l, Inc. v. Altai, Inc., 982 F.2d 693, 702 (2d Cir. 1992) (“It is now well settled that the literal elements of computer programs, i.e., their source and object codes, are the subject of copyright protection.”).} That protection also extends to all expression embodied in the computer.\footnote{U.S. Copyright Office, Circular 61.0812: Copyright Registration for Computer Programs, LIBRARY OF CONGRESS 1 (Aug. 2012), http://copyright.gov/circs/circ61.pdf.} However, copyright protection of the source code is rather limited.\footnote{Id.} To make a valid copyright infringement claim, plaintiffs must show that they own the copyright and that the copyright work was imitated.\footnote{Feist Publ’ns., Inc. v. Rural Tel. Serv. Co., Inc., 499 U.S. 340, 361 (1991).} While seemingly straightforward for works like books or songs, it can cause problems for computer code.\footnote{See id. at 346, 349 (“The primary objective of copyright is not to reward the labor of authors, but “[t]o promote the Progress of Science and useful Arts.”); see also U.S. Copyright Office, supra note 197, at 1-2.} To establish the second element of infringement, the plaintiff must show that the defendant copied the work and that copying rendered the works substantially similar.\footnote{Feist Publ’ns, Inc., 499 U.S. at 361.} This second prong is significant for computer code, because two different sets of code can create a program or website that look identical to the original and can perform the same functions.\footnote{See id. at 345-46 (“Originality does not signify novelty; a work may be original even though it closely resembles other works so long as the similarity is fortuitous, not the result of copying.”).}

\begin{itemize}
  \item \footnote{OddzOn Products, Inc. v. Just Toys, Inc., 122 F.3d 1396, 1405 (Fed. Cir. 1997).}
  \item \footnote{Du Mont & Janis, supra note 46.}
  \item \footnote{Alice Corp. Pty. Ltd. v. CLS Bank Int'l, No. 13-298, slip op. at 16-17 (U.S. June 19, 2014); see also Bilski v. Kappos, 561 U.S. 593, 130 S. Ct. 3218, 3226, (2010) (holding that while the machine-or-transformation test is useful, it is not test for determining patent eligibility); see also Rantaten, supra note 187 (stating that parts of the ruling are “going to tie folks in knots”).}
  \item \footnote{Quinn, supra note 52.}
  \item \footnote{17 U.S.C. § 102(a) (2012).}
  \item \footnote{Computer Assocs. Int’l, Inc. v. Altai, Inc., 982 F.2d 693, 702 (2d Cir. 1992) (“It is now well settled that the literal elements of computer programs, i.e., their source and object codes, are the subject of copyright protection.”).}
  \item \footnote{U.S. Copyright Office, Circular 61.0812: Copyright Registration for Computer Programs, LIBRARY OF CONGRESS 1 (Aug. 2012), http://copyright.gov/circs/circ61.pdf.}
  \item \footnote{Id.}
  \item \footnote{Feist Publ’ns., Inc. v. Rural Tel. Serv. Co., Inc., 499 U.S. 340, 361 (1991).}
  \item \footnote{See id. at 346, 349 (“The primary objective of copyright is not to reward the labor of authors, but “[t]o promote the Progress of Science and useful Arts.”); see also U.S. Copyright Office, supra note 197, at 1-2.}
  \item \footnote{Feist Publ’ns, Inc., 499 U.S. at 361.}
  \item \footnote{See id. at 345-46 (“Originality does not signify novelty; a work may be original even though it closely resembles other works so long as the similarity is fortuitous, not the result of copying.”).}
\end{itemize}
words, copyright only protects the code, not the end result of the code. Therefore, in order to avoid a copyright infringement claim, a potential infringer would just need to write different source code that produces the same end result. For this reason, some website owners have sought trade dress protection in order to safeguard their sites.

3. Attempts to Apply Trade Dress to Websites

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

_**a. The Blue Nile Case**_

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

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

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202 MCCARTHY, supra note 73, § 8:7.25.

203 Blue Nile, 478 F. Supp. 2d at 1243.

204 Id.

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

206 Id.

207 Id.

208 Id.

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

210 Id. at 1246.

211 Id.
settled out of court before any additional facts could be discovered.\textsuperscript{212}

\textit{b. Legal Scholars Have Considered the Issue in More Depth}

Legal commentators have also studied this issue; in fact, the current literature mostly reflects work from legal scholars rather than decided cases or judicial opinions. However, most articles focus on different issues, e.g. the copyright/trade dress distinction\textsuperscript{213} or distinctiveness.\textsuperscript{214} Functionality is discussed in passing, if at all.\textsuperscript{215}

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

\textbf{IV. THE CONFERENCE ARCHIVES CASE AND THE COURT’S OPINION REGARDING WEBSITE TRADE DRESS}

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

\textsuperscript{213} See e.g., Byerly, supra note 20.
\textsuperscript{214} See e.g., Nguyen, supra note 15.
\textsuperscript{216} Byerly, supra note 20; See Fuddruckers, Inc. v. Doc GraphicOthers, Inc., 826 F.2d 837, 842 (9th Cir. 1987).
\textsuperscript{217} Byerly, supra note 20.
\textsuperscript{218} See Fuddruckers, Inc., 826 F.2d at 842.
\textsuperscript{219} See id. at 842 (citing Sicilia Di Ri Biebow & Co. v. Cox, 732 F.2d 417, 429 (5th Cir. 1989) for the proposition that the “ultimate inquiry in functionality analysis is whether protecting a feature will hinder competition.”).
non-disclosure agreement it had signed with the plaintiff and recreated Conference Archives’ site. Conference Archives moved for summary judgment on the violation of the non-disclosure agreement and violation of intellectual property in its Web site. However, the motion contained a “nebulous” discussion of the grounds on which Conference Archives had relied to support its claim. The court then evaluated the various potential theories, eventually discussing trade dress protection for Web sites. This case was one of the first to analyze what is required, to support a trade dress claim for a Web site, noting three elements of a Web site’s “look and feel”: color, orientation and code elements.

For the element of color, the court discussed how colors are denoted in Web sites. Web sites use hexadecimal notation to identify over 16,777,216 unique colors. Every color can be made as a mixture of red, green and blue, the primary colors of light and computer displays. A value ranging from zero to 256 is assigned to each color, and these values are interpreted by a computer to obtain the desired color. For example, to give a grayish-blue color, red is given a value of 36, green a value of 104 and blue a value of 160. This three-number coding scheme allows web designers to distinguish colors with a great deal of precision.

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

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221 Id. at *2.
222 Id. at *3-4.
223 See id. at *10, 14-18.
224 See id. at *4-5.
225 Id.
226 Id.
227 Id. at *4.
228 Id.
229 Id.
230 Id. at *5.
231 Id.
232 Id.
233 Id.
234 See id. at *5.
The final element of the court’s test was Web site coding. Web sites use HTML “tags” to instruct the computer’s web browser what type of object should be displayed on the screen and what features it should have. These objects may include headings, images, paragraphs or links. The court found that “the manner in which the code and tags are arranged directly impact how the page looks and feels.”

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

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

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

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

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235 Id.
238 Conference Archives, 2010 WL 1626072, at *5.
239 See id. at *5-8.
240 Id. at *14.
241 Id.
242 Id.
243 Id. at *17.
244 See id. (discussing Qualitex Co. v. Jacobson Products Co., Inc., 514 U.S. 159, 165 (1995)).
245 Id.
test, and the Supreme Court’s ruling in Two Pesos v. Taco Cabana, Inc.\textsuperscript{246} Arguments supporting the nonfunctional nature of websites fail because websites are different than anything before considered for trade dress protection; they are a collection of functional components and joined to make a functional whole.\textsuperscript{247} They are a visual medium, and users actively interact with that medium when they visit the site. Websites are inherently functional, so trade dress is not a viable form of intellectual property protection for websites.

A. Website Trade Dress When Viewed Through Two Pesos

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

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

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

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

\textsuperscript{248} Two Pesos, Inc., 505 U.S. at 771.

\textsuperscript{249} Id. at 765-67.

\textsuperscript{250} Id. at 771 (1992).


\textsuperscript{252} See id. (explaining why websites like to have their users open new browser windows).

\textsuperscript{253} Martin, supra note 150.

\textsuperscript{254} See Nielsen, supra note 251 (noting that failure to change the visited link’s color is a
logues were in Two Pesos; these parts individually perform some function, and they all join together to make the site functional.\textsuperscript{255}

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

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

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

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

\begin{itemize}
\item \textsuperscript{255} \textit{Two Pesos Inc.}, 505 U.S. at 765.
\item \textsuperscript{257} Application of Honeywell, Inc., 532 F.2d 180, 182 (C.C.P.A. 1976).
\item \textsuperscript{258} \textit{See} Martin, \textit{supra} note 150 (comparing good designs to faulty ones).
\end{itemize}
standards” that place further limitations on website design.\textsuperscript{259}

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

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

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

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

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

\textsuperscript{262} Nguyen, supra note 15.


\textsuperscript{264} Fuddruckers, Inc. v. Doc’s B.R. Others, Inc., 826 F.2d 837, 842 (9th Cir. 1987).

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

\textsuperscript{266} Martin, supra note 15 (explaining how to make the interface of a website more conducive to the internet user).
C. Web Design is Not Arbitrary

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

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

D. The Conference Archives Court’s Reasoning Was Flawed

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

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

267 Clicks Billiards, Inc. v. Sixshooters, Inc., 251 F.3d 1252, 1259, 1261 (9th Cir. 2001).
269 See Fadeyev, supra note 148.
270 Martin, supra note 15.
271 Fuddruckers, Inc. v. Doc’s B.R. Others, Inc., 826 F.2d 837, 842 (9th Cir. 1987).
273 Id.
274 Id. at *15.
275 Id. at *17 (internal quotations omitted) (quoting Kurt M. Saunders, Tradesite Or Web Dress?: Trade Dress Protection For Website Interfaces, ACAD. OF LEGAL STUD. IN BUS., http://alsb.roundtablelive.org/Resources/Documents/NP%202001%20Saunders.pdf)
feel of a page might be functional if it made viewing the site owner’s goods more efficient or facilitated the placing of orders on the owner’s site,” 276 but so long as there are alternatives, the site should not be considered functional. 277

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

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

Essentially, the court’s argument boils down to efficiency and facilitation. 283 These concepts are at the core of good interface design. 284 Objectives like consistency, screen layout, relationships between items, navigability, simplicity, clarity, distinctiveness, emphasis and readability each play a role to make a site more efficient and to facilitate the purpose of the site. 285 For example, a

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276 Conference Archives, Inc., 2010 WL 1626072 at *17 (internal quotations omitted).
277 See id. (discussing Lisa M. Byerly, Look And Feel Protection Of Web Site User Interfaces: Copyright Or Trade Dress?, 14 SANTA CLARA COMPUTER & HIGH TECH. L.J. 221, 260 (1998)).
282 See Conference Archives, 2010 WL 1626072 at *17 (internal quotations omitted) (“The look and feel of a page might be functional if it made viewing the site owner’s goods more efficient or facilitated the placing of orders on the owner’s site.”).
283 Id. (internal quotations omitted) (“The look and feel of a page might be functional if it made viewing the site owner’s goods more efficient or facilitated the placing of orders on the owner’s site.”).
284 Martin, supra note 150.
285 Id.
286 Id.
proper screen layout combined with simple relationships between items would assist the user in finding the most important links on the site quickly and efficiently. This is an important goal for all websites and web designers. Any site, be it sports, blogs, weather forecasts, streaming video, banking, or anything in between wants to facilitate the user finding its important content efficiently.287

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

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

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

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

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

287 Powell, supra note 173, at 17-19.
288 Conference Archives, 2010 WL 1626072 at *17, n.50.
292 Powell, supra note 173, at 19.
294 Qualitex Co., 514 U.S. at 163.
295 Id. at 166.
296 Id.
competitors that those competitors cannot find a suitable color to use for their product and are placed at an unfair advantage. The Court did not find that situation to have arisen in the context of dry cleaning pads, but noted that if the problem did arise in the future, the “doctrine of functionality normally would seem available to prevent the anticompetitive consequences….”

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

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

VI. PROPOSAL

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

297 Id. at 168 (internal quotations omitted).
298 Id. at 169.
299 See Nielsen, supra note 251 (noting that failure to change the visited link’s color is a common problem in website design and the color of visited links is important to user navigation); see also Martin, supra note 150 (navigability is a design concept).
300 Martin, supra note 150.
301 Qualitex Co., 514 U.S. at 169.
303 Id. at 116 (quoting TrafFix Devices, Inc. v. Mtkg. Displays, Inc., 532 U.S. 23, 32 (2001) (reciting three elements for a trade dress claim, not three factors)).
patents. Together, these three forms of intellectual property form a strong basis of protection for websites.

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

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

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

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

\begin{itemize}
\item \textsuperscript{305} 35 U.S.C. § 171 (2012).
\item \textsuperscript{306} See OddzOn Products, Inc. v. Just Toys, Inc., 122 F.3d 1396, 1405 (Fed. Cir. 1997) (“Where a design contains both functional and non-functional elements, the scope of the claim must be construed in order to identify the non-functional aspects of the design as shown in the patent.”).
\item \textsuperscript{307} Du Mont & Janis, supra note 46, at 844.
\item \textsuperscript{311} U.S. Patent No. D571,819 (filed Mar. 30, 2007).
\item \textsuperscript{313} MPEP Ch. 1500 § 1502 (9th ed, Mar. 2014).
\item \textsuperscript{314} Egyptian Goddess, Inc. v. Swisa, Inc., 543 F.3d 665, 670 (Fed. Cir. 2008).
\item \textsuperscript{315} Quinn, supra note 52.
\item \textsuperscript{316} Id.
\item \textsuperscript{317} Apple Computer, Inc. v. Franklin Computer Corp., 714 F.2d 1240, 1249 (3d Cir. 1983).
\item \textsuperscript{318} 35 U.S.C. § 102 (2012); id. § 103.
\end{itemize}
a particular machine.\footnote{Bilski v. Kappos, 561 U.S. 593, 130 S. Ct. 3218, 3224 (2010).} While becoming increasingly difficult,\footnote{CLS Bank Int’l. v. Alice Corp. Pty. Ltd., 717 F.3d 1269, 1281 (Fed. Cir. 2013); see also Bilski v. Kappos, 561 U.S. 593 (2010) (the Machine or Transformation test is not the sole test for determining patent eligibility, but is a useful test); see Rantaten, supra note 187 (stating that parts of the ruling are “going to tie people in knots”).} different websites such as Facebook,\footnote{U.S. Patent No. 8,631,084 (filed Mar. 7, 2007) (issued Sept.1, 2009).} Google,\footnote{U.S. Patent No. 8,635,518 (filed July 21, 2011) (issued Jan. 24, 2014).} and Amazon\footnote{U.S. Patent No. 5,960,411 (filed Sept. 12, 1997).} have received utility patent protection for novel computerized methods on their websites.\footnote{8,631,084, supra note 321.}

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

Limiting website intellectual property protection to only these forms also serves the public at large. Trademarks and trade dress protection have no expiration date, so long as the owner of the trademark or trade dress continue to use it in commerce.\footnote{See 15 U.S.C. § 1059 (2012) (registration renewable every ten years); see also Brunswick Corp. v. British Seagull Ltd., 35 F.3d 1527, 1530 (Fed. Cir. 1994) (“[T]rademark protection is potentially perpetual in duration.”).} Copyright,\footnote{17 U.S.C. § 302(a) (2012).} design patents,\footnote{35 U.S.C. § 173 (2012) (14 years from the date of grant).} and utility patents\footnote{See id. § 154(a)(2) (twenty years from the date of filing the application for the patent, it would expire and enter the public domain).} all have defined expiration dates; after those dates the protected property enters the public domain. Internet technology and websites change rapidly. Giving one company or website exclusive use of a non-novel function or design that ordinarily would not be eligible for these forms of protection indefinitely may harm the marketplace of website designs.

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

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

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

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

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

330 § 101.
331 Id. § 171.