

THE JOHN MARSHALL REVIEW OF INTELLECTUAL PROPERTY LAW



PAINSTAKING SEMANTICS: SELECTING WEBSITE TRADE DRESS ELEMENTS TO SURVIVE A COPYRIGHT PREEMPTION CHALLENGE

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ABSTRACT

The intersection between trade dress law and copyright law must be understood when seeking trade dress protection for elements that may fall within the subject matter of copyright. The technological elements that create the look and feel of a website may include both trade dress elements and copyrightable works. Website owners are beginning to rely on the protections of trade dress law instead of or in addition to copyright law when the look and feel of a website is imitated by a competitor. Asserting trade dress protection for website look and feel requires careful pleading and will provoke a variety of defenses, including copyright preemption. This paper will discuss the identification and selection of trade dress elements in order to satisfy the trade dress requirements and survive a challenge based on copyright preemption.

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Cite as J. Scott Anderson, Painsstaking Semantics: Selecting Website Trade Dress Elements To Survive a Copyright Preemption Challenge, 7 J. MARSHALL REV. INTELL. PROP. L. 97 (2007).

PAINSTAKING SEMANTICS: SELECTING WEBSITE TRADE DRESS ELEMENTS TO SURVIVE A COPYRIGHT PREEMPTION CHALLENGE

J. Scott Anderson*

INTRODUCTION

Advances in technology are allowing consumers to access and view websites in a variety of new ways. In the future, a consumer may not locate a website using a traditional web address, but instead may view web content with little or no indication of the actual web address or content owner. For example, mobile devices with web access are increasingly common, yet the page displays may be too small to clearly indicate the web address. On the Internet, techniques such as deep linking¹ and framing² may display a page view with no web address or an incomplete or otherwise misleading address. The next-generation Internet may not include a bar for displaying a web address. Without a web address as a source indicator, the website's look and feel may be the consumer's only clue about the source of the goods or services being offered.

In general, copyright law protects website content such as text and graphics, as well as the underlying software or code that produces a website display. Trademark law protects the marks displayed in connection with goods or services. Trade dress protection may be available for selected elements that create the "look and feel" of a website. One goal of this article is to explore the various ways to identify and select website features that are best suited for trade dress protection.

Copyright preemption represents perhaps the greatest barrier to a successful trade dress infringement suit to protect web content. Most courts and practitioners understand that web content is generally protected by copyright. Plaintiffs want the lower burden of proof required to establish trade dress infringement (likelihood of confusion³) as opposed to copyright infringement (substantial similarity⁴). This

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¹ See, e.g., *Ticketmaster Corp. v. Tickets.com, Inc.*, 54 U.S.P.Q.2d 1344 (C.D. Cal. 2000) (order granting plaintiff's motion for preliminary injunction) (explaining how a "deep link" transfers the consumer not to a home page, but to an interior page deep within the website).

² 4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 25:70 (4th ed. 2007) (defining "framing" as bringing the content of a target website into the display, where it is surrounded or framed by a primary website). The act of incorporating certain distinctive elements of the target website, through framing, may create consumer confusion as to source and, thus, may constitute trade dress infringement. *Id.*

³ See *Insty*Bit, Inc. v. Poly-Tech Indus., Inc.*, 95 F.3d 663, 667 (8th Cir. 1996).

⁴ See *Nichols v. Universal Picture Corp.*, 45 F.2d 119 (2d Cir. 1930).

paper will explain that the price of obtaining the lower burden of proof includes identifying and selecting protectable trade dress elements that fall outside the subject matter of copyright, and pleading specifically in order to avoid overlapping trade dress and copyright claims based on the same factual allegations.

I. TRADE DRESS, GENERALLY

Trade dress refers to the overall look and feel of a product or service, including any element or feature that may indicate the source of the product or service.⁵ To be protected, trade dress must be distinctive and non-functional.⁶ Different levels of distinctiveness are required, depending on whether the trade dress element is placed into the category of product design, product packaging, or a third category known as *tertium quid*.⁷

The owner can identify any number of elements for which trade dress protection is being asserted.⁸ The particular trade dress elements selected, however, must function as a source identifier.⁹ The selected elements must also be sufficiently tangible.¹⁰ The “aura” of prestige or status surrounding a product, for example, cannot serve as trade dress.¹¹ The selected elements must constitute more than a mere advertising theme in order to be protectable.¹²

Trade dress may be protected under the Lanham Act as long as: (1) the trade dress is inherently distinctive or has acquired distinctiveness; (2) the trade dress is primarily non-functional; and (3) the imitation of the trade dress would result in a likelihood of confusion for consumers as to the source of the goods or services.¹³ When comparing trade dress against an infringer, all the selected elements will be grouped together to create a total, overall impression.¹⁴

⁵ *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162 (1995); *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 764 (1992); *LeSportsac, Inc. v. K Mart Corp.*, 754 F.2d 71, 75 (2d Cir. 1985).

⁶ *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 210 (2000); *TraFFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 28–29 (2001).

⁷ *Wal-Mart*, 529 U.S. at 215.

⁸ *See, e.g., Hershey Foods Corp. v. Mars, Inc.*, 998 F. Supp. 500, 517–18 (M.D. Pa. 1998) (stating that “a trademark holder can seek to protect a combination of elements making up less than the complete trade dress if, for whatever reason, the holder believes that combination has acquired secondary meaning”).

⁹ *See Duraco Prods. v. Joy Plastic Enters.*, 40 F.3d 1431 (3d Cir. 1994); *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 995 (2d Cir. 1995) (holding that the design on a sweater was not protectable trade dress because “the primary purpose of [the design was] aesthetic rather than source-identifying”).

¹⁰ *Abercrombie & Fitch Stores, Inc. v. Am. Eagle Outfitters, Inc.*, 280 F.3d 619, 631 (6th Cir. 2002) (“Trade dress is tangible or otherwise objectively observable by the senses.”).

¹¹ *See id.* at 630.

¹² *See, e.g., Haagen-Dazs, Inc. v. Frusen Gladje Ltd.*, 493 F. Supp. 73 (S.D.N.Y. 1980) (denying trade dress protection for a Scandinavian theme for marketing ice cream).

¹³ *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 769 (1992); *Insty*Bit, Inc. v. Poly-Tech Indus., Inc.*, 95 F.3d 663, 667 (8th Cir. 1996); *Philip Morris USA Inc. v. Cowboy Cigarette Inc.*, 70 U.S.P.Q.2d 1092 (S.D.N.Y. 2003); *Faegre & Benson LLP v. Purdy*, 367 F. Supp. 2d 1238, 1244 (D. Minn. 2005).

¹⁴ *See Gateway, Inc. v. Companion Prods., Inc.*, 384 F.3d 503, 507 (8th Cir. 2004) (“Trade dress is the overall image of a product, the overall impression created, not the individual features.”);

The burden is on the trade dress owner to identify precisely the elements for which trade dress protection is being sought.¹⁵ Failure to articulate exactly which elements comprise its distinctive trade dress elements may be fatal.¹⁶ A broad, general claim of trade dress rights without reference to specific elements may indicate to the court that the plaintiff is seeking protection for an “unprotectable style, theme or idea.”¹⁷ Mere advertising themes are not protectable under the Lanham Act.¹⁸

Selection of website trade dress elements is difficult because web content includes a wide variety of subject matter, ranging from plain text to subtle design elements. Most websites include a mixture of all different types of web content. Also, websites serve a variety of purposes, such as news, retail, search, e-mail, auction, web logs, and combinations thereof. The sheer variety of web content, together with the requirements of careful pleading, will require content owners to select and describe website features carefully when asserting trade dress protection.¹⁹

In light of the trade dress requirements of distinctiveness and non-functionality, the process of selecting the elements that create the look and feel of a website and that are protectable as trade dress is a formidable challenge. In addition to the trade dress requirements, the website elements must be selected in anticipation of a copyright preemption challenge. Selecting protectable trade dress elements is not enough; the elements must be described with precision to avoid claiming trade dress rights in copyrightable subject matter.²⁰ Several recent decisions suggest that the preemption question could turn on semantics²¹ rather than legal principle.

II. COPYRIGHT PREEMPTION

Claims asserting trade dress protection for website look and feel will most likely provoke the defense of copyright preemption. Section 301 of the Copyright Act of 1976 abolishes common law copyright and expressly preempts certain state law claims. Section 301(a) reads:

August Storck K.G. v. Nabisco, Inc., 59 F.3d 616, 620 (7th Cir. 1995) (“[T]he overall appearance is what matters.”); Bristol-Myers Squibb Co. v. McNeil-PPC, Inc., 973 F.2d 1033, 1042 (2d Cir. 1992) (“[I]n an action for trade dress infringement each aspect should be viewed in relation to the entire trade dress.”).

¹⁵ See, e.g., Crown Awards, Inc. v. Trophy Depot, No. 2:03-CV-02448-DRH, 2003 WL 22208409, at *19 (E.D.N.Y. Sept. 3, 2003) (“[T]he Court will not speculate as to the elements of the claimed trade dress or *sua sponte* consider unidentified elements. Crown Awards has the affirmative responsibility to establish those elements.”).

¹⁶ See Yurman Design, Inc. v. PAJ, Inc., 262 F.3d 101 (2d Cir. 2003).

¹⁷ Landscape Forms, Inc. v. Colum. Cascade Co., 113 F.3d 373, 381 (2d Cir. 1997).

¹⁸ See Haagen-Dazs, Inc. v. Frusen Gladje Ltd., 493 F. Supp. 73, 75 (S.D.N.Y. 1980).

¹⁹ See generally Xuan-Thao N. Nguyen, *Should It Be a Free For All? The Challenge of Extending Trade Dress Protection to the Look and Feel of Web Sites in the Evolving Internet*, 49 AM. U. L. REV. 1233 (2000) (discussing whether trade dress protection should extend to websites).

²⁰ See *Landscape Forms, Inc.*, 113 F.3d at 381.

²¹ See WEBSTER'S THIRD INTERNATIONAL DICTIONARY, UNABRIDGED 2062 (2002) (defining “semantics” as “the study of meanings,” or “the meaning or relationship of meanings of a sign or a set of signs,” or “the management or exploitation of connotation and ambiguity”).

On and after January 1, 1978, all legal or equitable rights that are *equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106* in works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright as specified by sections 102 and 103, whether created before or after that date and whether published or unpublished, are governed exclusively by this title. Thereafter, no person is entitled to any such right or equivalent right in any such work under the common law or statutes of any State.²²

On its face, section 301 preempts only state law claims. Section 301(d) provides: “Nothing in this title annuls or limits any rights or remedies under any other Federal statute.”²³ Despite this provision, courts apply section 301 as a limit on the applicability of Lanham Act claims in areas traditionally occupied by copyright law, or where the Copyright Act provides an adequate remedy.²⁴

Applying section 301, a claim or cause of action is preempted if: (1) the work is “within the subject matter of copyright” as specified in sections 102 and 103; and (2) the rights asserted are “equivalent” to any exclusive rights within the scope of the federal rights as set forth in section 106.²⁵ The preemption analysis therefore includes two requirements: a subject matter requirement, and an equivalency requirement.²⁶ Both the subject matter and equivalency requirements must be met for preemption to occur.

For example, consider the text²⁷ displayed on a website. A state law prohibiting the unauthorized copying of website text would most likely be preempted by the Copyright Act.²⁸ The state law covers the subject matter of copyright because the original text may be protected as a literary work. The state law right to prohibit unauthorized copying is equivalent to the exclusive right of reproduction provided in section 106(1) of the Copyright Act.²⁹ Because both requirements are satisfied, a cause of action brought under the state law would be preempted and the author’s only recourse would be to file an action under the Copyright Act for infringement of

²² 17 U.S.C. § 301(a) (2006) (emphasis added).

²³ 17 U.S.C. § 301(d).

²⁴ *Cf. Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 34 (2003) (“Thus, in construing the Lanham Act, we have been ‘careful to caution against the misuse or over-extension’ of trademark and related protections into areas traditionally occupied by patent or copyright.” (quoting *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 29 (2001))).

²⁵ *Harper & Row Publishers v. Nation Enters.*, 723 F.2d 195, 199–200 (2d Cir. 1983), *rev’d on other grounds*, 471 U.S. 539 (1985); *Wrench LLC v. Taco Bell Corp.*, 256 F.3d 446, 453 (6th Cir. 2001) (analyzing state law contract rights).

²⁶ *Nat’l Basketball Ass’n v. Motorola, Inc.*, 105 F.3d 841, 848 (2d Cir. 1997); *United States ex rel. Berge v. Bd. of Trs. of the Univ. of Ala.*, 104 F.3d 1453, 1462–63 (4th Cir. 1997); *Ehat v. Tanner*, 780 F.2d 876, 878 (10th Cir. 1985); *see also* Steven T. Lowe, *Preemptive Strike*, L.A. LAWYER, May 2003, at 37, 37–39 (discussing the two-part test to determine whether a state cause of action is preempted by federal copyright law).

²⁷ The term “text” may include all the words and characters on the screen, including names, words, headlines, topic headings, descriptions, instructions, captions, stories, and the like, in any language.

²⁸ *See generally* MARSHALL A. LEAFFER, UNDERSTANDING COPYRIGHT LAW 531–32 (4th ed. 2005) (relating the requirements for federal copyright preemption).

²⁹ *Id.*

the section 106 rights.³⁰ Other types of web content require a more careful analysis of the subject matter and equivalency requirements.

A. *The Subject Matter Requirement*

The Copyright Act of 1976 protects “original works of authorship fixed in any tangible medium of expression,” including literary works, musical compositions and sound recordings, drama, pantomime and choreography, pictures, graphics, sculpture, film, architecture, and computer programs.³¹ To be copyrightable, a work must be original.³²

Copyright protects the expression of an idea, but not the underlying idea itself.³³ Section 102(b) of the Act expressly excludes ideas and concepts from the subject matter of copyright.³⁴ Non-original elements, commonplace *scenes à faire*,³⁵ and ideas that can be expressed only in one way³⁶ will generally not be protectable by copyright. When an expression is “indispensable, or at least standard, in the treatment of a given idea, the expression is protected only against verbatim, or

³⁰ See 17 U.S.C. § 106 (2006). Section 106 reads:

Subject to sections 107 through 122, the owner of copyright under this title has the exclusive rights to do and to authorize any of the following:

- (1) to reproduce the copyrighted work in copies or phonorecords;
- (2) to prepare derivative works based upon the copyrighted work;
- (3) to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending;
- (4) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and motion pictures and other audiovisual works, to perform the copyrighted work publicly;
- (5) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, including the individual images of a motion picture or other audiovisual work, to display the copyrighted work publicly; and
- (6) in the case of sound recordings, to perform the copyrighted work publicly by means of a digital audio transmission.

Id.

³¹ 17 U.S.C. § 102(a).

³² *Id.*; Feist Publ'ns, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 345 (1990) (“The *sine qua non* of copyright is originality.”); Darden v. Peters, 402 F. Supp. 2d 638, 641 (E.D.N.C. 2005).

³³ See Baker v. Selden, 101 U.S. 99, 104–05 (1880).

³⁴ 17 U.S.C. § 102(b). “In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.” *Id.*

³⁵ See, e.g., Apple Computer Corp. v. Microsoft Corp., 35 F.3d 1435, 1444 (9th Cir. 1994) (concluding that the expression of overlapping windows is inherent in the idea of a window-based display and, therefore, is one of the unprotectable *scenes à faire* for graphical user interfaces).

³⁶ See, e.g., Ets-Hokin v. Skyy Spirits Inc., 323 F.3d 763, 765 (9th Cir. 2003) (affirming summary judgment for the defendant photographer because the idea of photographing a Skyy vodka bottle “merged” with the expression, and the resulting photograph was not identical). When an idea and its expression are indistinguishable or “merged,” the expression will not be given copyright protection. *Id.*

virtually identical copying.”³⁷ Claims brought under state and federal laws protecting such non-copyrightable ideas and concepts may not be preempted.³⁸

1. A Work May Be Unprotected by Copyright, Yet Still Fall “Within the Subject Matter of Copyright.”

If a work does not meet the requirements for copyrightability, that does not necessarily mean it falls outside the subject matter of copyright. The scope of subject matter preempted by the Copyright Act is broader than the literal definition of protectable subject matter set forth in sections 102(a) and (b).³⁹ For example, as the Second Circuit concluded in *Harper & Row Publishers v. Nation Enterprises*,⁴⁰ the fact that copyrightable material contains unprotectable ideas should not remove the entire work from the subject matter of copyright to be preempted under section 301.⁴¹

A failure to achieve copyright protection for a work due to a lack of originality or creativity should not determine whether the Copyright Act preempts other state or federal causes of action related to the work. In *Harper & Row*, the Second Circuit held that the fact that portions of the President Ford memoirs were uncopyrightable did not take the work as a whole outside the subject matter of copyright.⁴²

Were this not so, states would be free to expand the perimeters of copyright protection to their own liking, on the theory that preemption would be no bar to state protection of material not meeting federal statutory standards. That interpretation would run directly afoul of one of the Act’s

³⁷ *Johnson Controls, Inc. v. Phoenix Control Sys., Inc.*, 886 F.2d 1173, 1175 (9th Cir. 1989) (citing *Rachel v. Banana Republic, Inc.*, 831 F.2d 1503, 1507 (9th Cir. 1987)).

³⁸ *See Wrench LLC v. Taco Bell Corp.*, 256 F.3d 446, 454 n.3; *Canter v. West Publ’g Co.*, 31 F. Supp. 2d 1193, 1202 (N.D. Cal. 1999) (“To the extent Plaintiffs seek compensation for the underlying concepts, processes and procedures . . . rather than the specific expression . . . [the] cause of action is not preempted . . .”); *Lattie v. Murdach*, 42 U.S.P.Q.2d 1240 (N.D. Cal. 1997) (“[I]deas do not come under the subject matter of copyright, and claims based upon them are not preempted . . .”); *Mayer v. Josiah Wedgwood & Sons, Ltd.*, 601 F. Supp. 1523, 1532 n.16 (S.D.N.Y. 1985) (“[S]tate laws that protect ideas, as distinct from their expression, are without the subject matter of copyright . . .”).

³⁹ *See, e.g., Wrench*, 256 F.3d at 455; *Nat’l Basketball Ass’n v. Motorola, Inc.*, 105 F.3d 841, 849 (2d Cir. 1997) (holding that the subject matter of copyright under section 301 includes uncopyrightable as well as copyrightable elements); *United States ex rel. Berge v. Bd. of Trs. of the Univ. of Ala.*, 104 F.3d 1453, 1463 (4th Cir. 1997) (holding that uncopyrightable ideas that are part of a copyrightable work are within the subject matter of copyright because “scope and protection are not synonyms”); *ProCD, Inc. v. Zeidenberg*, 86 F.3d 1447, 1453 (7th Cir. 1996) (finding that the uncopyrightable data underlying a copyrightable computer program are within the subject matter of copyright). The Second, Fourth, Sixth, and Seventh Circuits have held that the scope of the Copyright Act’s subject matter extends beyond the tangible expressions that can be protected under section 102 to include the elements which themselves cannot be protected. *Wrench*, 256 F.3d at 455.

⁴⁰ 723 F.2d 195 (2d Cir. 1983).

⁴¹ *Id.* at 200; *see also Wrench*, 256 F.3d at 455 (“[T]he fact that copyrightable material contains uncopyrightable expressions should not remove the work from the subject matter of copyright under § 301 . . .”).

⁴² *Harper & Row*, 723 F.2d at 200.

central purposes, to “avoid the development of any vague borderline areas between State and Federal protection.”⁴³

Similarly, the Sixth Circuit in *Wrench LLC v. Taco Bell Corp.*⁴⁴ declined to “separate out appellants’ intangible ideas from these tangible [and protectable] expressions” because to do so would allow appellants to pursue a state law claim in the face of clear congressional intent to preempt such claims.⁴⁵ When applying the subject matter requirement, the fact that a copyrightable work includes one or more unprotectable ideas will not automatically remove the work from the scope of subject matter preempted by the Copyright Act.⁴⁶

2. The Overall Format or Layout of a Work Generally Falls Outside the Subject Matter of Copyright.

The general arrangement of elements in a given space represents subject matter that is generally not covered by the Copyright Act.⁴⁷ In *Darden v. Peters*,⁴⁸ the district court upheld the Copyright Office’s denial of registration for the arrangement and formatting of a website.⁴⁹ The website displayed a series of maps that were derived from existing U.S. Census maps.⁵⁰ The website owner sought registration for website’s “compilation and arrangement of maps, text, graphics and data,” and later amended the application to “text, maps, and formatting of an Internet web page.”⁵¹

“[T]he examiners noted that in general, formatting of web pages is not copyrightable.”⁵² In denying the registration, the Copyright Office explained: “The 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.”⁵³ The district court held that the Copyright Office did not abuse its discretion in denying the registration.⁵⁴

Applying *Darden* in the context of preemption and the subject matter requirement, a court may find no preemption of a claim that someone imitated the arrangement and layout of the website because those elements are outside the

⁴³ *Id.* at 200 (quoting H.R. REP. NO. 94-4176, at 131 (1976)).

⁴⁴ 256 F.3d 446.

⁴⁵ *Id.* at 455.

⁴⁶ *See generally id.* (holding the scope of section 301 includes both copyrightable material and uncopyrightable material).

⁴⁷ *See, e.g., Darden v. Peters*, 402 F. Supp. 2d 638, 642 (E.D.N.C. 2005). Section 101 defines a compilation as “a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship.” 17 U.S.C. § 101 (2006).

⁴⁸ 402 F. Supp. 2d 638.

⁴⁹ *Id.* at 644.

⁵⁰ *Id.* at 640.

⁵¹ *Id.* at 643.

⁵² *Id.* at 644.

⁵³ *Id.*

⁵⁴ *Id.*

subject matter of the Copyright Act.⁵⁵ If the arrangement and layout creates a look and feel that satisfies the threshold trade dress requirements, then a cause of action for infringement of those trade dress elements may survive a copyright preemption challenge.⁵⁶

B. The Equivalency Requirement

Equivalency exists if the right may be abridged or infringed by an act which, in and of itself, would infringe one of the exclusive rights set forth in section 106.⁵⁷ If the right is equivalent, and the subject matter requirement is also met, then a cause of action for infringement of that right would be preempted by the Copyright Act. Conversely, such a cause of action would not be preempted if an extra element must be proven and the rights and remedies are *qualitatively different* from those provided under the Copyright Act.⁵⁸

There is no copyright preemption if an extra element of proof is required and the extra element changes the nature of the action so that it is qualitatively different from a copyright infringement claim.⁵⁹ The courts have not been consistent in their approach to the equivalency requirement. In *Mayer v. Josiah Wedgwood & Sons, Ltd.*,⁶⁰ the plaintiff's snowflake design appeared on Wedgwood products and she sued for conversion and misappropriation.⁶¹ The court found the snowflake design, even though unregistered and in the public domain, was within the subject matter of copyright.⁶² On the equivalency requirement, the court found that the conversion and misappropriation claims were the functional equivalents of the exclusive rights of reproduction and distribution found in section 106 of the Copyright Act, the state law claims included no extra element, and therefore could not escape preemption.⁶³

The reasoning in *Mayer* has not been followed by other courts. In *ProCD, Inc. v. Zeidenberg*,⁶⁴ the Seventh Circuit held that the private rights created by contract are not equivalent to the exclusive rights set forth in the Copyright Act.⁶⁵ The decision in

⁵⁵ See *generally id.* (“[T]he arrangement of elements lacked even a minimal degree of creativity, and that protection for the overall format of a web page is inconsistent with copyrightability.” (citation omitted)).

⁵⁶ See *generally id.* (“[W]hile certain elements of the website might be copyrightable, including the arrangement of data into categories, Plaintiff’s request for registration was far too broad since it included a claim for uncopyrightable Maps, unoriginal formatting elements, and an uncreative layout of those elements.”).

⁵⁷ *Wrench LLC v. Taco Bell Corp.*, 256 F.3d 446, 456; *Harper & Row Publishers, Inc. v. Nation Enters.*, 723 F.2d 195, 200 (2d Cir. 1983).

⁵⁸ *Schuchart & Assocs. v. Solo Serve Corp.*, 540 F. Supp. 928, 943 (W.D. Tex. 1982) (citing *Harper & Row*, 723 F.2d at 200).

⁵⁹ *Rosciszewski v. Arete Assocs.*, 1 F.3d 225, 229–30 (4th Cir. 1993); *Nat’l Car Rental Sys., Inc. v. Computer Assocs.*, 991 F.2d 426, 431 (8th Cir. 1993); *Harper & Row*, 723 F.2d at 200.

⁶⁰ 601 F. Supp. 1523 (S.D.N.Y. 1985).

⁶¹ *Id.* at 1526.

⁶² *Id.* at 1535.

⁶³ *Id.* at 1536.

⁶⁴ 86 F.3d 1447 (7th Cir. 1996).

⁶⁵ *Id.* at 1454.

ProCD suggests that no contract claim could ever be preempted—a result that has been criticized as too broad.⁶⁶

Proof of trade dress infringement involves a number of extra elements, including distinctiveness, non-functionality, and a likelihood of consumer confusion.⁶⁷ When evaluating the likelihood of confusion factor, the court considers: (1) the strength of the owner's trade dress; (2) the similarity between the owner's trade dress and the alleged infringer's trade dress; (3) the degree of competition between the respective goods or services; (4) the alleged infringer's intent; (5) the evidence of actual confusion; and (6) the type of goods or services, its costs or value, and the conditions surrounding the purchase.⁶⁸ These elements make the trade dress cause of action qualitatively different from a copyright infringement action.⁶⁹

Several recent decisions approached the interplay between trade dress and copyright, but none of the rulings addressed the equivalency requirement directly. In *Peri Hall & Associates, Inc. v. Elliot Institute for Social Sciences Research*,⁷⁰ the district court granted the plaintiff's motion for a preliminary injunction against a defendant who allegedly copied the look and feel of the plaintiff's website; however, the defense of copyright preemption was not discussed.⁷¹ Similarly, the court in *Crown Awards, Inc. v. Trophy Depot*⁷² considered a motion for preliminary injunction based on allegations of both copyright infringement and trademark infringement, yet did not address the defense of copyright preemption in its order.⁷³

More recently, in *Blue Nile, Inc. v. Ice.com, Inc.*,⁷⁴ the district court granted the defendant's motion to dismiss Blue Nile's state law claims alleging violation of the state consumer protection act, unfair competition, and unjust enrichment.⁷⁵ Regarding the state law claims and the equivalency requirement, the district court concluded: "The gravamen of the action here is plaintiff's claim that defendants copied portions of plaintiff's website."⁷⁶ Although the elements of Blue Nile's state law claims were not identical to its copyright claims, the district court concluded that the additional allegations did not transform the nature of the action and dismissed Blue Nile's state law claims.⁷⁷ In addressing Blue Nile's trade dress infringement claim, however, the district court did not reach the equivalency requirement in its

⁶⁶ *E.g.*, *Ballas v. Tedesco*, 41 F. Supp. 2d 531, 537 n.14 (D.N.J. 1999); *Green v. Hendrickson Publishers*, 770 N.E.2d 784, 789–90 (Ind. 2002) (citing 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 1.01 [B][1][a] (2007)).

⁶⁷ *See, e.g.*, *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 28–29 (2001); *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 215 (2000); *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 769 (1992).

⁶⁸ *Insty*Bit, Inc. v. Poly-Tech Indus., Inc.*, 95 F.3d 663, 667 (8th Cir. 1996).

⁶⁹ *Cf.*, *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 361 (1991) ("To establish [copyright] infringement, two elements must be proven: (1) ownership of a valid copyright, and (2) copying of constituent elements of the work that are original.").

⁷⁰ No. 060202CVWGAF, 2006 WL 742912 (W.D. Mo. 2006).

⁷¹ *Id.* at *3–4.

⁷² No. 2:03-CV-02448-DRH, 2003 WL 22208409 (E.D.N.Y. 2003).

⁷³ *Id.* at *21.

⁷⁴ 478 F. Supp. 2d 1240 (W.D. Wash. 2007).

⁷⁵ *Id.* at 1252.

⁷⁶ *Id.* at 1250.

⁷⁷ *Id.*

analysis.⁷⁸ The district court denied the defendant's motion to dismiss the trade dress claim on the basis of the subject matter requirement alone.⁷⁹

These recent decisions do not provide clear guidance on the specific question of whether a cause of action for the infringement of the selected trade dress elements that create website look and feel is qualitatively different from a cause of action for copyright infringement. Copyright infringement requires proof of ownership of a valid copyright, proof of copying by the defendant, and proof that defendant's act of copying amounts to an improper appropriation.⁸⁰ Proof of improper appropriation may be satisfied by showing the two works are substantially similar.⁸¹ Trade dress infringement requires proof of distinctiveness, non-functionality, and a likelihood of consumer confusion as to source.⁸²

Although the similarity of defendant's trade dress is a factor, the trade dress need not be "substantially similar" and the likelihood of confusion analysis includes a variety of other factors as discussed *supra*.⁸³ Likewise, the copyright infringement cause of action does not require any proof of consumer confusion when evaluating whether the defendant's copying conduct was improper.⁸⁴ Because the consumer confusion element is both additional to and qualitatively different from the proof required in a copyright infringement action, the trade dress cause of action should not be considered equivalent for copyright preemption purposes.

III. TRADE DRESS OR COPYRIGHT?

A review of several recent cases addressing various aspects of the intersection between trade dress law and copyright law should provide insight into how a court might decide whether copyright preemption bars trade dress protection for website look and feel.

In *Crown Awards, Inc. v. Trophy Depot*,⁸⁵ the district court considered a motion for preliminary injunction based on allegations of both copyright infringement and trademark infringement.⁸⁶ The district court did not address copyright preemption in its order.⁸⁷ On the copyright infringement claims, the court found a likelihood of

⁷⁸ *Id.* at 1244–45.

⁷⁹ *Id.* ("Determining the elements of plaintiff's website that are subject to copyright protection, and what portions of the website related to the 'look and feel' of its trade dress claim requires greater factual development.").

⁸⁰ *See, e.g.*, *Bright Tunes Music Corp. v. Harrisongs Music, Ltd.*, 420 F. Supp. 177, 181 (S.D.N.Y. 1976).

⁸¹ *See, e.g.*, *Nichols v. Universal Picture Corp.*, 45 F.2d 119, 122 (2d Cir. 1930).

⁸² *See, e.g.*, *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 28–29 (2001); *Wal-Mart Stores v. Samara Bros., Inc.*, 529 U.S. 205, 215 (2000); *Two Pesos v. Taco Cabana, Inc.*, 505 U.S. 763, 769 (1992).

⁸³ *Insty*Bit, Inc. v. Poly-Tech Indus., Inc.*, 95 F.3d 663, 670 (8th Cir. 1996) (stating plaintiff had "demonstrated similarities in the trade dress between Insty*Bit and Snappy" and "demonstrated sufficient similarity in the shape and design").

⁸⁴ *See Segrets, Inc. v. Gillman Kintwear Co.*, 207 F.3d 56, 60 (1st Cir. 2000) (noting that to prove copyright infringement the plaintiff must show ownership of a valid copyright and the copying of constituent elements of the work that are original).

⁸⁵ No. 2:03-CV-02448-DRH, 2003 WL 22208409 (E.D.N.Y. Sept. 3, 2003).

⁸⁶ *Id.* at *1.

⁸⁷ *Id.* at *21.

success on the merits involving the catalog, but not the plaintiff's website or e-mail advertising.⁸⁸ The plaintiff's printed catalog formed "a protectable compilation of unprotectable elements."⁸⁹ Eighteen of the sixty-four pages in the defendant's catalog were found by the court to be substantially similar to the plaintiff's protectable compilation, creating a likelihood of success on the merits and supporting the issuance of a preliminary injunction.⁹⁰

The plaintiff in *Crown Awards* asserted copyright protection for: (1) the "product line tabs at the top of the page"; (2) the three-frame website design with a thumbnail image of the catalog; and (3) the specific text of the website.⁹¹ The court found no copyrightable expression in these website features:

The mere use of a three frame design, the use of a small picture of the catalogue on the upper right side and the use of promotional language stating "SAME DAY SHIPPING In Stock for Immediate Delivery" are insufficient to create an "original" compilation of elements that forms the basis for copyright protection.⁹²

Although the court found some similarity between the two websites, "the similarity derives from unprotectable elements."⁹³

The district court in *Crown Awards* found no likelihood of success on the merits of the trade dress infringement claim.⁹⁴ The plaintiff failed to identify which elements comprise the trade dress for which protection was being sought, why they were primarily non-functional, and how those elements were distinctive.⁹⁵ The plaintiff directed the court to a page in its memorandum of law; however, "this page solely contains a discussion of the copyright claim."⁹⁶ The plaintiff also directed the court to testimony about the creation of the "look and feel" of the catalogs and website.⁹⁷ However, the court stated:

[T]his testimony does not describe what elements comprise the "look and feel" or how those elements are distinctive . . . [T]he Court will not speculate as to the elements of the claimed trade dress or *sua sponte*

⁸⁸ *Id.* at *11, *15.

⁸⁹ *Id.* at *5 (relying on *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 348–51 (1991)).

⁹⁰ *Id.* at *11.

⁹¹ *Id.* at *12.

⁹² *Id.* at *13.

⁹³ *Id.* at *15.

⁹⁴ *Id.* at *19.

⁹⁵ *Id.* at *18.

⁹⁶ *Id.* at *18. Although the district court in *Crown Awards* did not address the defense of copyright preemption, the practice of claiming trade dress protection in the same elements, which form the basis of a copyright infringement claim, would likely not survive a motion to dismiss based on copyright preemption.

⁹⁷ *Id.*

consider unidentified elements. Crown Awards has the affirmative responsibility to establish those elements.⁹⁸

The court did not address the remaining elements of the plaintiff's trade dress claim, and denied the motion for a preliminary injunction.⁹⁹ Although the court did not address the defense of copyright preemption in its order, the court seemed open to the idea that trade dress elements, if selected properly, may form the basis of a trade dress infringement action separate and apart from the copyright infringement action. The decision in *Crown Awards* should provoke plaintiffs to select and identify trade dress elements carefully and early in the litigation rather than risk dismissal.

In *Faegre & Benson LLP v. Purdy*,¹⁰⁰ the district court denied the plaintiff's motion for contempt of a preliminary injunction because the defendant Purdy's use of elements similar to those trade dress elements appearing on the plaintiff's web site was not likely to cause consumer confusion.¹⁰¹ The preliminary injunction enjoined Purdy from "displaying any web site, the appearance of which is identical or confusingly similar to the trade dress of [plaintiff's] web site."¹⁰² In support of its allegations of similarity, the plaintiff noted Purdy's use of "the same color scheme, layout, buttons, fonts, and graphics" created an "overall impression" dominated by elements of the plaintiff's own home page.¹⁰³ In response, Purdy noted the prominent display of a parody disclaimer on his website and argued that the photographs and other content he displayed were so different from the plaintiff's law firm website that Internet users would not be confused.¹⁰⁴ The district court agreed with Purdy and denied the plaintiff's motion for contempt.¹⁰⁵ Although the court did not address copyright preemption, the preliminary injunction ordering Purdy not to display a website with confusingly similar trade dress represents a willingness to grant relief for infringement of website trade dress elements.

In *Peri Hall & Associates, Inc. v. Elliot Institute for Social Sciences Research*,¹⁰⁶ the district court granted the plaintiff's motion for a preliminary injunction against a defendant who allegedly copied the look and feel of the plaintiff's website.¹⁰⁷ The website was marked with a copyright notice.¹⁰⁸ The plaintiff sought relief for copyright infringement, trademark infringement, and trade dress infringement.¹⁰⁹ The plaintiff asserted trade dress protection for "the graphic design, look and feel of

⁹⁸ *Id.* at *18–19. "Similarly, citation to conclusory testimony that the Crown Awards trade dress acquired secondary meaning and was distinctive does not aid the Court's analysis or satisfy Crown Awards' burden." *Id.* at *19.

⁹⁹ *Id.*

¹⁰⁰ 367 F. Supp. 2d 1238 (D. Minn. 2005).

¹⁰¹ *Id.* at 1245.

¹⁰² *Id.* at 1244.

¹⁰³ *Id.*

¹⁰⁴ *Id.* "[Purdy] asserts that the large pictures purporting to show dismembered fetuses are not the type of picture that would appear on [plaintiff's] official web site and, thus, are unlikely to confuse the internet user." *Id.*

¹⁰⁵ *Id.* at 1245.

¹⁰⁶ No. 060202CVWGAF, 2006 WL 742912 (W.D. Mo. 2006).

¹⁰⁷ *Id.* at *3–4.

¹⁰⁸ *Id.* at *1.

¹⁰⁹ *Id.*

the website.”¹¹⁰ In reviewing the motion and evidence, the district court concluded, “Plaintiffs own copyrights to the code and graphic design of the website.”¹¹¹ The district court did not address copyright preemption in its order.¹¹² The court appears to base its ruling on the plaintiff’s ownership and the striking similarities¹¹³ between the two websites. The order granting the motion for preliminary injunction is the final entry in the docket. Additional litigation and discovery may or may not have provoked the defense of copyright preemption.

In *Blue Nile, Inc. v. Ice.com, Inc.*,¹¹⁴ an online diamond retailer, Blue Nile, sued a competitor for trade dress infringement, alleging the defendant’s website was confusingly similar to “Blue Nile’s distinctive diamond search features associated with its quality, reliability, reputation and goodwill.”¹¹⁵ As described in the complaint, the “Blue Nile Diamond Search” webpage “compiles and displays to customers . . . the key factors in diamond selection.”¹¹⁶ The diamond search feature includes “vertical visual scales for each criterion with ‘sliders’ that are a visual expression of parameters that diamond-buying customers may consider in evaluating potential diamond purchases.”¹¹⁷ Blue Nile alleged that its diamond search feature was “one of the most distinctive creative elements” on its website.¹¹⁸ Blue Nile obtained numerous copyright registrations for its website, including three registrations for its “Blue Nile Diamond Search” pages.¹¹⁹

The district court in *Blue Nile* granted the defendant’s motion to dismiss Blue Nile’s state law claims alleging violation of the state consumer protection act, unfair competition, and unjust enrichment.¹²⁰ With regard to these state law claims, the district court acknowledged Blue Nile’s copyright registrations and noted that its state law claims expressly include the same allegations as those supporting its copyright infringement claim.¹²¹ Because the state law claims rested entirely on the same allegations, “the Court conclude[d] that the ‘look and feel’ of plaintiff’s website is within the subject matter of copyright.”¹²² Regarding the equivalency requirement, the district court concluded: “The gravamen of the action here is plaintiff’s claim that defendants copied portions of plaintiff’s website.”¹²³ Although the elements of Blue Nile’s state law claims were not identical to its copyright claims, the district court ruled that the additional allegations did not transform the nature of the action and dismissed Blue Nile’s state law claims.¹²⁴

With regard to Blue Nile’s trade dress infringement claim, the district court reached a different result: “Determining the elements of plaintiff’s website that are

¹¹⁰ *Id.*

¹¹¹ *Id.* at *3.

¹¹² *Id.* at *3–4.

¹¹³ *Id.* at *3.

¹¹⁴ 478 F. Supp. 2d 1240 (W.D. Wash. 2006).

¹¹⁵ First Amended Complaint at para. 52, *Blue Nile*, 478 F.Supp.2d 1240 (No. C-06-1002 RSL).

¹¹⁶ *Id.* at para. 16.

¹¹⁷ *Id.*

¹¹⁸ *Id.*

¹¹⁹ *Id.* at para. 17.

¹²⁰ *Blue Nile, Inc.*, at 1252.

¹²¹ *Id.* at 1248.

¹²² *Id.*

¹²³ *Id.* at 1250.

¹²⁴ *Id.*

subject to copyright protection, and what portions of the website relate to the 'look and feel' of its trade dress claim requires greater factual development."¹²⁵ The district court compared the look and feel of a website to the user interface of a computer program:

"Whether the nonliteral components of a program, including . . . the user interface [the 'look and feel' of the program], are protected [by copyright] depends on whether, *on the particular facts of each case*, the component in question qualifies as an expression of an idea, or an idea itself." Because section 102(b) of the Copyright Act states: "In no case does copyright protection for an original work of authorship extend to any idea," factual development is necessary here before the Court can determine what portions of plaintiff's website are protected.¹²⁶

The district court also noted that preemption of a Lanham Act claim is "a narrower inquiry than the two-part test for preemption of state law claims under § 301 of the Copyright Act."¹²⁷ "The Lanham Act limitation is aimed at whether copyright provides an 'adequate remedy.'"¹²⁸ "There can be no 'adequate remedy' if the work cannot be copyrighted."¹²⁹ Because the availability of an adequate remedy could not be addressed based on the facts in the record at the early stage of the case, the district court denied the defendant's motion to dismiss.¹³⁰

The district court in *Blue Nile* did not address the equivalency requirement with respect to the trade dress infringement claim. The decision to allow more factual development appears to be based on the subject matter requirement alone.

There are several problems with the court's reasoning in *Blue Nile*. First, regarding the subject matter requirement, the court's reasoning appears to be internally inconsistent. With regard to the state law claims, the district court concluded that "the 'look and feel' of plaintiff's website is within the subject matter of copyright."¹³¹ With regard to the trade dress claim, the district court concluded that "what portions of the website relate to the 'look and feel' of its trade dress claim requires greater factual development."¹³² The subject matter requirement should be considered independently of the type of claim being brought.¹³³ If there were sufficient facts on the record to determine the subject matter requirement for the state law claims, then those facts should be sufficient to reach a conclusion for the trade dress claim.

¹²⁵ *Id.* at 1244–45.

¹²⁶ *Id.* at 1245 (quoting *Johnson Controls, Inc. v. Phoenix Control Sys., Inc.*, 886 F.2d 1173, 1175 (9th Cir. 1989)).

¹²⁷ *Id.* at 1246.

¹²⁸ *Id.*

¹²⁹ *Id.* See also *Shaw v. Lindheim*, 919 F.2d 1353, 1364–65 (9th Cir. 1990) (stating "we decline to expand the scope of the Lanham Act to cover cases in which the Federal Copyright Act provides an adequate remedy").

¹³⁰ *Blue Nile, Inc.*, 478 F. Supp. 2d at 1245.

¹³¹ *Id.* at 1248.

¹³² *Id.* at 1245.

¹³³ *Id.* at 1247. The equivalency requirement addresses the elements of the particular claim. *Harper & Row Publishers, Inc. v. Nation Enters.*, 723 F.2d 195, 200 (2d Cir. 1983).

Second, the district court's rationale for allowing additional factual development appears to be premised upon the need to divide the website elements into two groups: protected works and unprotected works.¹³⁴ This piecemeal approach is not supported by existing precedent¹³⁵ and will not help the court analyze the subject matter requirement later. Even if certain elements of Blue Nile's website are not protected by copyright, that does not mean the website falls outside the "subject matter of copyright" for preemption purposes.¹³⁶ Additional discovery about which specific elements are protected works and which are unprotected will not aid the subject matter analysis. The decision to allow additional factual development could have been based solely on Blue Nile's freedom to amend its pleadings later in the litigation to identify its trade dress elements with greater specificity. As the district court observed, the complaint merely puts the defendant on notice as to the plaintiff's claims.¹³⁷

The additional factual development sought by the court did not take place because the *Blue Nile* litigation ended with a Stipulation of Dismissal filed about two weeks after the order on defendant's motion to dismiss.¹³⁸

IV. THE REWARD FOR A PAINSTAKING SELECTION OF TRADE DRESS ELEMENTS: A LOWER BURDEN OF PROOF

The inherent variety of types of web content typically requires pleading and proving multiple causes of action. Suits against infringers of web content, as the cases demonstrate, often include claims of copyright infringement and trade dress infringement in the same complaint. Copyright preemption represents perhaps the strongest defense and the greatest hope for dismissal of trade dress claims based on elements that fall within the subject matter of copyright.

To survive a copyright preemption challenge, the trade dress elements must be specifically identified and painstakingly selected. The reward for a proper selection of trade dress elements includes survival of the trade dress claim and a lower burden of proof required to establish trade dress infringement. Proving trade dress

¹³⁴ *Blue Nile*, 478 F. Supp. 2d at 1244–45 (“Determining the elements of plaintiff’s website that are subject to copyright protection, and what portions of the website relate to the ‘look and feel’ of its trade dress claim requires greater factual development.”).

¹³⁵ See *Wrench v. Taco Bell Corp.*, 256 F.3d 446, 455 (6th Cir. 2001) (declining to “separate out appellants’ intangible ideas from these tangible [and protectable] expressions” because to do so would allow appellants to pursue a state law claim in the face of clear congressional intent to preempt such claims).

¹³⁶ *Blue Nile*, 478 F. Supp. 2d at 1248. The district court itself stated: “[E]ven if, as defendant Odimo asserts, plaintiff’s website or elements thereof are unprotected under § 102(b), this does not mean that the website is outside copyright’s subject matter for the preemption purposes under § 301.” *Id.* See also *United States ex rel. Berge v. Bd. of Trs. of the Univ. of Ala.*, 104 F.3d 1453, 1463 (4th Cir. 1997) (holding that uncopyrightable ideas that are part of a copyrightable work are within the subject matter of copyright because “scope and protection are not synonyms”).

¹³⁷ *Blue Nile*, 478 F. Supp. 2d at 1244 (citing *Abercrombie & Fitch Stores, Inc. v. Am. Eagle Outfitters*, 280 F.3d 619, 635 (6th Cir. 2002)).

¹³⁸ Stipulation for Dismissal of Action, *Blue Nile*, 478 F. Supp. 2d 1240 (No. C-06-1002 RSL).

distinctiveness, non-functionality, and a likelihood of consumer confusion¹³⁹ is generally easier than proving copying and substantial similarity¹⁴⁰ between competing works of authorship.

In addition to the substantial similarity burden of proof, it may be difficult to show the existence of any copyrightable expression in the website features sought to be protected. For example, the court in *Crown Awards* held: “The mere use of a three frame design, the use of a small picture of the catalogue on the upper right side and the use of promotional language . . . are insufficient to create an ‘original’ compilation of elements that forms the basis for copyright protection.”¹⁴¹ Furthermore, even if the website features include copyrightable expressions, substantial similarity and infringement cannot be proven if the similarities are found only in unprotectable elements.¹⁴²

A. *A Hypothetical Cruise Along the Virtual Blue Nile*

The district court in *Blue Nile* denied a motion to dismiss on the grounds that the trade dress claim required “greater factual development.”¹⁴³ The suit was dismissed about two weeks after entry of the order.¹⁴⁴ If the litigation had continued, Blue Nile would bear the burden of proving that its trade dress infringement claim was based on trade dress elements that fall outside the subject matter of copyright. Additionally, Blue Nile would need to prove those trade dress elements were distinctive and non-functional.

The subject matter requirement represents a particularly high barrier because Blue Nile was seeking trade dress protection for its diamond search feature—for which Blue Nile had obtained three copyright registrations.¹⁴⁵ Copyright registrations are strong evidence that the subject matter sought to be protected by trade dress actually falls within the subject matter of copyright.¹⁴⁶ All three copyright registrations were filed under class TX,¹⁴⁷ which is for non-dramatic literary works, including computer programs:

¹³⁹ *Insty*Bit, Inc. v. Poly-Tech Indus., Inc.*, 95 F.3d 663, 667 (8th Cir. 1996) (listing elements that must be proven to satisfy trade dress protection under the Lanham Act).

¹⁴⁰ *See, e.g., Nichols v. Universal Picture Corp.*, 45 F.2d 119, 121 (2d Cir. 1930) (addressing the question of “whether the part [of the play] taken was ‘substantial’ and therefore not a ‘fair use’ of the copyrighted work; it is the same question that arises in the case of any other copyright work”).

¹⁴¹ *Crown Awards, Inc. v. Trophy Depot*, No. 2:03-CV-02448-DRH, 2003 WL 22208409, at *13 (E.D.N.Y. Sept. 3, 2003).

¹⁴² *Id.* at *15 (asserting there is no copyright infringement if “the similarity derives from unprotectable elements”).

¹⁴³ *Blue Nile*, 478 F. Supp. 2d at 1246.

¹⁴⁴ Stipulation for Dismissal of Action, *Blue Nile*, 478 F. Supp. 2d 1240 (No. C-06-1002 RSL).

¹⁴⁵ First Amended Complaint at para. 17, *Blue Nile*, 478 F. Supp. 2d 1240 (No. C-06-1002 RSL).

¹⁴⁶ *See generally* 2 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 7.16 (2007) (discussing the significance of copyright registration).

¹⁴⁷ 37 C.F.R. § 202.3(b)(1)(i) (2007) (“*Class TX: Nondramatic literary works.* This class includes all published and unpublished nondramatic literary works. Examples: Fiction; nonfiction; poetry; textbooks; reference works; directories; catalogs; advertising copy; and compilations of information.”).

1. Registration TX 6-349-238; “Blue Nile Diamond Search (Public Beta Version)—Sliders Section”; Pre-existing work described as “Preexisting html code, text, and pictorial and graphic elements”; Added material described as “html code.”¹⁴⁸

2. Registration TX 6-349-239; “Blue Nile Diamond Search with Vertical Sliders (Public Beta Version)”; Pre-existing work described as “Preexisting html code, text, and pictorial and graphic elements”; Added material described as: “Text, compilation and html code.”¹⁴⁹

3. Registration TX 6-349-240; “Blue Nile Diamond Search (Public Beta Version)—‘How to Narrow Your Search’ Section”; Pre-existing work described as “Preexisting html code, text, and pictorial and graphic elements”; Added material described as: “Text, compilation and html code.”¹⁵⁰

In support of its claim for protection of these pages as trade dress elements, Blue Nile would have needed to characterize the copyrighted works as separate from and merely underlying the overall trade dress elements displayed on the website. The trade dress elements, in other words, do not include the “html code” itself, but instead include the look and feel created by the resulting display. As the district court observed in its order,¹⁵¹ the look and feel of a website is comparable to the user interface of a computer program, not the underlying code itself. In addition, Blue Nile could have elected to amend its complaint to identify additional or different trade dress elements that were not based on copyrighted works.

The trade dress requirement of non-functionality also represents a substantial barrier for Blue Nile because its diamond search feature includes “vertical visual scales for each [search] criterion with ‘sliders’” that, when moved, vary the selection parameters displayed on the screen.¹⁵² The defense may argue that the diamond search feature is functional because the active sliders serve a primarily utilitarian function; namely, displaying a wider or narrower range of a specific parameter.¹⁵³ The active sliders may represent patentable subject matter; discovery may reveal that a utility patent has been applied for or issued.¹⁵⁴ Blue Nile would need to argue and prove that its diamond search feature acts primarily as a source identifier.¹⁵⁵ The extent to which the diamond search feature is functional may be tested using one

¹⁴⁸ First Amended Complaint at para. 17, *Blue Nile*, 478 F. Supp. 2d 1240 (No. C-06-1002 RSL).

¹⁴⁹ *Id.*

¹⁵⁰ *Id.*

¹⁵¹ *Blue Nile*, 478 F. Supp. 2d at 1245 (relying on the decision in *Johnson Controls, Inc. v. Phoenix Control Sys., Inc.*, 886 F.2d 1173, which defined the “user interface,” or “look and feel” of a program as generally referring to the “design of the video screen and that manner in which information is presented to the user”).

¹⁵² First Amended Complaint at para. 16, *Blue Nile*, 478 F. Supp. 2d 1240 (No. C-06-1002 RSL).

¹⁵³ See generally *Blue Nile*, http://www.bluenile.com/diamond_search.asp?track=56 (last visited May 10, 2007) (displaying Blue Nile’s search features).

¹⁵⁴ See *Traffix Devices, Inc. v. Mktg. Display, Inc.*, 532 U.S. 23, 25 (2001).

¹⁵⁵ See *Duraco Prods. v. Joy Plastic Enters.*, 40 F.3d 1431, 1442 (3d Cir. 1994).

or more of a variety of functionality tests.¹⁵⁶ In addition, Blue Nile could have elected to amend its complaint to identify additional or different trade dress elements that are also distinctive but, unlike the diamond search tool, have little or no utilitarian function.

B. Taking Pains: Selecting Protectable Trade Dress Elements

The subject matter cases illustrate the need to clearly identify and define the exact web content for which trade dress protection is being sought. Along a spectrum of possible trade dress elements, original text most clearly falls within the subject matter of copyright because it may be protected as a literary work. Control elements¹⁵⁷ such as the software code and underlying controls may also be protected as literary works. Original and creative graphics elements¹⁵⁸ may be protected by copyright as a pictorial or graphic work.

On the opposite end of the spectrum, certain design elements may fall completely outside the subject matter of the Copyright Act and, thus, escape preemption. The most protectable design elements are those that create the overall look and feel of the website, but do not include the simple text, underlying control elements, or mere graphics elements.¹⁵⁹ Under *Darden v. Peters*, the arrangement of elements or layout in a given space, such as a website, represents subject matter that is generally not covered by the Copyright Act.¹⁶⁰ The strongest design elements for creating a protectable trade dress may be so subtle and inconspicuous that the elements may be described as having virtually “no content” at all.

The term “look and feel” represents an important guidepost. Trade dress elements creating the look and feel should be selected, but mere graphics elements subject to copyright should not be relied upon. The look and feel elements need to include more than the plain graphics displayed on the site.

Whether the trade dress elements escape preemption and qualify as protectable trade dress may be a question of semantics. For example, if the trade dress is described as “use of a blue border and yellow text,” then these elements will likely be viewed as mere graphics elements protectable by copyright only. On the other hand, the trade dress could be described as “a display of information presented in a distinctive yellow color, on multiple web pages, arranged into groups and consistently displayed on a distinctive cobalt blue background, in order to indicate Acme as the source of the products and services offered.” These alternative descriptions may relate to the same web content, but the latter description is less likely to be construed as falling within the subject matter of copyright.

¹⁵⁶ Mitchell M. Wong, *The Aesthetic Functionality Doctrine and the Law of Trade Dress Protection*, 83 CORNELL L. REV. 1116, 1144 (1998) (describing six popular tests for functionality).

¹⁵⁷ As used herein the term “control elements” includes the software code and underlying controls that produce a website display, including HTML, XML, PHP, JavaScript, Flash, SQL scripts, and other such tools yet to be developed.

¹⁵⁸ As used herein, the term “graphics elements” includes the fonts, typestyles, colors, illustrations, logos, photographs, borders, boxes, display windows, and other graphic or pictorial elements on a website.

¹⁵⁹ *Darden v. Peters*, 402 F. Supp. 2d 638, 642 (E.D.N.C. 2005).

¹⁶⁰ *Id.* at 644.

Of course, the trade dress elements must be selected with the basic trade dress requirements in mind. The selected trade dress elements must function as a source identifier.¹⁶¹ The selected elements must also be sufficiently tangible and observable.¹⁶² Finally, the selected trade dress elements must constitute more than a mere “advertising theme” in order to be protectable.¹⁶³

The trade dress elements must be described with specificity for the court, yet the description should be broad and general enough to fall outside the subject matter of copyright, while also including tangible features that constitute more than a mere advertising theme.

A strong and distinctive trade dress element on a website “is a [virtual] merchandising short-cut which induces a purchaser to select what he wants, or what he has been led to believe he wants.”¹⁶⁴ “The consumer does not memorize the mark. He has a feeling about it from past exposure. That feeling may be vague, subliminal it is said, but it comes to consciousness when the article is seen with the trademark affixed.”¹⁶⁵ The most desirable and protectable website trade dress elements create a distinctive look and feel, while provoking subliminal and subconscious associations with the source of the goods or services offered on the website.

CONCLUSION

To say the Internet has changed the face of modern commerce is an understatement. The pressure to capture and retain online consumers has created a drive to build websites with a distinctive look and feel—and a concomitant drive to imitate them. The imitators know that copyright infringement requires proof of copying and substantial similarity, and their imitations reflect that knowledge.

For website elements outside the subject matter of copyright, trade dress law offers possible protection. Trade dress elements must be distinctive, non-functional, and constitute more than a mere advertising theme. Additionally, trade dress elements must be painstakingly selected and carefully described in order to fall outside the subject matter of copyright. When imitators face lawsuits for trade dress infringement, many will raise the defense of copyright preemption.

The reward for selecting protectable trade dress elements that will survive a copyright preemption challenge is a generally lower burden of proof. Instead of proving copying and substantial similarity, website owners would rather prove that the imitator’s copycat trade dress causes a likelihood of confusion. In addition to a lower burden of proof, the reward for selecting protectable trade dress elements includes potentially perpetual protection.

¹⁶¹ See *Duraco Prods. v. Joy Plastic Enters.*, 40 F.3d 1431, 1434 (3d Cir. 1994).

¹⁶² *Abercrombie & Fitch Stores, Inc. v. Am. Eagle Outfitters, Inc.*, 280 F.3d 619, 631 (6th Cir. 2002) (stating “trade dress is tangible or otherwise objectively observable by the senses”).

¹⁶³ See, e.g., *Haagen-Dazs, Inc. v. Frusen Gladje Ltd.*, 493 F. Supp. 73, 75 (S.D.N.Y. 1980) (denying trade dress protection for a Scandinavian marketing theme for ice cream).

¹⁶⁴ *Philip Morris Inc. v. Star Tobacco Corp.*, 879 F. Supp. 379, 384 (S.D.N.Y. 1995) (quoting *Mishawaka Rubber & Woolen Mfg. v. S.S. Kresge Co.*, 316 U.S. 203, 205 (1942)).

¹⁶⁵ *Id.* at 385 (quoting *Londontown Mfg. v. Cable Raincoat Co.*, 371 F. Supp. 1114, 1118 (S.D.N.Y. 1974)).

The asset of website look and feel can be protected by a thorough and creative application of the law of trade dress. Limited by copyright preemption and the traditional trade dress requirements, the scope of protectable trade dress for website look and feel can protect and reward those who create it while minimizing consumer confusion and preserving fair competition in the virtual marketplace.