

# What's Old Is New in Web Site Protection

## A new look at the 'look and feel' doctrine.

By Fred H. Perkins and Alvin C. Lin

In the early "wild west" days of the Internet, legal remedies always seemed a step behind the intellectual property dilemmas presented by the new technological medium. Companies could be blackmailed into paying millions just to use their own trademarks as domain names, copyrighted materials were "copied and pasted" with abandon, and hackers could access sites as "pranks" without violating any specific laws.

Congress has gradually responded by enacting new laws to tackle high-tech loopholes, and the courts have creatively applied traditional concepts in an effort to prevent unscrupulous people from exploiting others' Internet-based intellectual property.

Just as courts have "rediscovered" the trespass doctrine to give it entirely new force to protect Web sites and their data, so too have some courts suggested a new life for the "look and feel" concept. This article examines this approach to protecting Web sites, and how a largely discarded doctrine has been recycled to help provide a remedy for certain Internet wrongs.

### Traditional Forms of Protection

As developers have poured more resources and innovation into development on the Web, the stakes for protecting Internet content and innovation have increased dramatically.

Because the primary intellectual property laws were not written for the Internet, the existing legal protections create a patchwork that protect particular elements or features of Web sites, but which do not necessarily protect the sites in their entirety. As is often the case, the law remains a step behind technological innovation, thus exposing potential gaps

in the protection for Web-based intellectual property.

Enforcement of Web site IP rights has generally focused on federal statutes in three areas: trademark, copyright and patent. The laws codifying these protections have been used to address Internet issues in varying ways.

A copyright claim may prevent the use of substantially similar images and text as well as source and object code.<sup>1</sup> The Lanham Act, in addition to being employed to prevent the infringing use of trademarks appearing on Web pages and as domain names, has also been used with varying success to challenge the use of a trademarked term in the "metadata" or "meta tags" embedded in Web sites and used by search engines to direct traffic towards a particular site.<sup>2</sup> Meanwhile, patent laws may protect certain patented business methodologies and processes that are used in Web sites.<sup>3</sup> There are also potential remedies under the common law. A claim for misappropriation or unfair competition may be used to prohibit copying of Web site data so as to prevent others from "reaping where they have not sown."<sup>4</sup> A more innovative claim is one for trespass to chattels, which has been used to prohibit "bots," "spiders" and other devices from wrongfully interfering with a Web site owner's possessory interest in the site.<sup>5</sup>

Congress has also responded, albeit slowly, by enacting legislation designed to address specific intellectual property problems. For example, in 1999, it passed the Anti-Cybersquatting Consumer Protection Act, an amendment to the Lanham Act prohibiting the wrongful registration and use of domain names that are based on a trademark owned by another.<sup>6</sup> In 2003, Congress amended

§§1030 and 2701 of the Criminal Code to prohibit "cyberspace trespassing" or computer "hacking" by making it a crime to access computer networks without authorization.<sup>7</sup> Both laws help address particular activities that were not specifically prohibited by previously existing statutes.

### **The Limitations of Existing Remedies**

While Web site owners are clearly not without a variety of weapons to combat infringement, the existing remedies are an imperfect fit because they were not developed with Web sites in mind, and clever infringers are constantly developing new methods to exploit the gaps in protection. Infringement runs from simple unauthorized copying of wholesale Web pages or elements (as a cheap alternative to creating a new and original site) to diversion of Web traffic to garner advertising dollars, or to the exploitation of consumer recognition associated with a plaintiff's Web site by falsely suggesting an affiliation from which the infringer will benefit.

Web sites pose special challenges. They typically contain many different pages, and the particular content and format of the material displayed can vary significantly depending upon how users of the site interface with them. The quick and constant evolution of content may make it difficult or impractical for a site owner to maintain copyright registrations for all of the site's existing content. A frequent change in trademark usage might also pose a challenge by undermining an owner's argument that it is continually using the same mark.

There may also be a substantial gap between the structural framework (or source code) of a Web site and its actual appearance. Code can be protected through copyright registration, but is hidden from the user. Two sites may use entirely different code and yet might appear very similar, especially in similarities in font, style and color of text

and background, and the use of similar graphic design elements. Whereas copying code, specific text or images clearly fall within the confines of a copyright infringement claim, the similar appearance of general graphic and visual format elements may not. At least some courts have suggested that Web page formatting is not subject to copyright registration at all.<sup>8</sup>

Another important limitation is copyright preemption. A state law claim will be preempted if the work in question falls within the scope of the Copyright Act and the protections of the state law are commensurate with the federal remedy.<sup>9</sup> Preemption may apply even if the work has been refused registration, so long as it still falls within the purview of the Act. Because the scope of copyright registration for Web sites may be limited, a plaintiff could be refused federal registration and still find its state law remedies preempted.

The Lanham Act will cover a claim concerning the use of a trademark that appears on a Web site, and may also protect a highly distinctive site's trade dress. However, the boundaries of the Lanham Act remain untested. One of the key problems is that many of the similarities between two Web sites may only be similar common elements, such as drop-down menus, pop-up windows, background colors, hyperlinks and general layout. A plaintiff has to be specific in describing the basis for its claimed trade dress, must base it on non-functional elements and also must establish distinctiveness.<sup>10</sup> Demonstrating secondary meaning and acquired distinctiveness of a Web site trade dress may prove a difficult hurdle, especially for new or frequently revised sites.<sup>11</sup>

The interactive nature of Web sites is another important difference. Web pages are not just static pages; rather, the text, photos, images, and layout and design may depend on the manner in which the

site is used. It may be difficult to define the elements that are eligible for protection.

Web sites are often not just used for advertising and information, but can form part of the product offered itself. A car or movie rental site may offer an interface that allows one to make a reservation or order a film directly online, thus forming part of the service that is being provided. Patent or copyright law may assist in protecting IP rights if the process is so innovative as to warrant registration, but if the combination and sequence of drop down menus, links and pop-ups is not sufficiently unique to warrant a registration, then there may be no basis for a claim against a would-be infringer based on use of similar elements.

The ease and low cost of entry into the Internet marketplace present new opportunities for infringement of intellectual property. A newcomer who lacks the resources to invest in designing an effective site may find it easy to simply adopt the look and feel of a competitor's site, including the user interface, the design layout and various graphic elements. Particularly where there has been an industry pioneer that created an effective site, that design will be vulnerable to copycats who will trade off the senior Web site as well as the expectations built by it with customers for the products or services at issue.<sup>12</sup>

The ease of access and start-up has also led to another type of infringement that is more "political" in nature. A political opponent on such controversial issues as abortion may infringe a Web site by building a parallel site that mimics the original one, but advocates the diametrically opposing political message, thereby seeking to attract Web users with opposing political views to visit its site, even if mistakenly.<sup>13</sup> The Internet, as opposed to traditional media like pamphlets or brochures, presents a simpler method of quickly asserting an opposing political (or commercial)

message. Combined with the use of metadata to divert Internet traffic (which may or may not be barred by the Lanham Act), the creation of a site that looks and feels like the competing site would undermine the opponent's message (or business).

### **One Solution: Reviving 'Look and Feel'**

A defendant that is "smart" and intent upon trading upon another's Web site could fashion a new one that looks so similar to the original as to cause confusion, yet be able to argue that it has not violated copyright or trademark law. In the absence of legislative amendments aimed at offering more deliberate protection for Web sites, one potential solution lies in advocating the extension of existing principles through artful pleading that tries to address the more "intangible" qualities of a site.

Focusing on a site's overall "look and feel" may be a way to provide a court with greater flexibility to fashion the scope of protection needed to shield a plaintiff from a "careful" infringer who has wrongly imitated the "essence" of a Web site without copying its specific traditionally protectable elements.

The "look and feel" concept finds its roots both in copyright and trademark. In copyright, the concept has been limited in application.<sup>14</sup> Nonetheless, the Second Circuit has looked at the "total concept and overall feel" as part of the analysis for inexact copies,<sup>15</sup> and the Northern District of Illinois recently denied a motion to dismiss a claim of infringement based on a registration that purportedly included the "look and feel" of Web sites.<sup>16</sup>

The concept also bears similarity to the "overall impression" test for a claim of trade dress infringement. Like the application of "look and feel" in the copyright context, the "overall impression" of a trade dress must still be closely tied to the particular elements that are

articulated by the plaintiff and which form the basis of the trade dress. At least one court has suggested that the "total feel" may be an actionable basis for a claim of trade dress infringement separate and apart from any specific claims it had for copyright infringement.<sup>17</sup> Nevertheless, the "total feel" standard in the context of a trade dress claim has not generally been applied to Web sites, and its viability remains untested.

Articulating claims in terms of the "total look and feel" of a site may prove an effective way to keep a court from overlooking its intangible elements. A "look and feel" claim might encompass not only static elements such as particular photos, colors, borders or frames, but also interactive elements and the overall mood, style or impression of the site.

When faced with a situation where the essence of a client's Web site has been copied - but few, if any, traditionally protectable features - one should consider pleading a claim under copyright, trade dress and/or common law unfair competition where the critical part of the claim is that the overall "look and feel" of the site has been wrongly usurped to the client's detriment.

The plaintiff should identify to the extent possible all the specific elements that create the "total look and feel," including all of the visual or graphic elements and features that contribute to the site's overall impression or "gestalt." This manner of pleading may increase the chances that the court will incorporate intangibles like usability, interface and specific design style and format into the protected content. Naturally, wherever possible, one should also plead claims based on particular text, photos, source code, innovative registered features and trademarks that are subject to specific protection.

While the courts have not yet fully embraced protection for the "look and feel" of Web sites, the potential

framework exists. This approach provides a method of giving courts greater flexibility to address the peculiar Internet infringement cases that defy the specific parameters of existing intellectual property law. In this way, the courts may be able to extend copyright or trademark principles to address the total "look and feel" of a Web site and thus protect legitimate intellectual property rights from wrongs for which there otherwise might be no remedy.

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## Endnotes:

1. See, e.g., *Iconix Inc. v. Tokuda*, 457 F. Supp. 2d 969 (N.D. Cal. 2006) (protecting code and visual expression of code).

2. The Second Circuit courts have held that the use of trademarks as metadata is not "use" under the Lanham Act. See *Site Pro-1 Inc. v. Better Metal, LLC*, 506 F. Supp. 2d 123, 125 (E.D.N.Y. 2007). Courts outside the Circuit have generally upheld Lanham Act claims based on metadata use. See *id.* (listing cases).

3. See, e.g., *eBay Inc. v. MercExchange, LLC*, 547 U.S. 388 (2006) (infringement of "business method patent for electronic market").

4. *NBA v. Motorola Inc.*, 105 F.3d 841, 852 (2d Cir. 1997) (misappropriation in trademark infringement); *X17 Inc. v. Lavandeira*, 563 F. Supp. 2d 1102, 1106 (C.D. Cal. 2007) (publication of photos on Web site).

5. *eBay v. Bidder's Edge Inc.*, 100 F. Supp. 2d 1058 (N.D. Cal. 2000).

6. 15 U.S.C. §1125(d)(1).

7. 18 U.S.C. §§1030 and 2701.

8. See *Blue Nile Inc. v. Ice.com Inc.*, 478 F. Supp. 2d 1240, 1245 n.4 (W.D. Wash. 2007) (citing *Darden v. Peters*, 402 F. Supp. 2d 638, 644 (E.D.N.C. 2005) (upholding denial of copyright registration for Web format)); but see *Mortg. Mkt. Guide, LLC v. Freedman Report, LLC*, 2008 U.S. Dist. LEXIS 56871, at \*107 (D.N.J. July 28, 2008) ("The unique customization options [on the Web site] . . . combined with its selection and arrangement of such options is protectable under the copyright laws.").

9. 17 U.S.C. §301.

10. *Crown Awards Inc. v. Trophy Depot*, 2003 U.S. Dist. LEXIS 25205 (E.D.N.Y. Sept. 3, 2003) (must describe "what elements comprise the 'look and feel' of the trade dress or how those elements are distinctive").

11. See, e.g., *SG Serv. Inc. v. God's Girls Inc.*, 2007 U.S. Dist. LEXIS 61970, at \*\*29-30 (C.D. Cal. May 9, 2007) (plaintiff failed to establish public associated it with the elements of its Web design).

12. See, e.g., *Blue Nile Inc. v. Ice.com Inc.*, supra (involving competing jewelry Web sites, where the defendant infringer copied the search sections of its site from plaintiff).

13. In *Faegre & Benson, LLP v. Purdy*, 70 U.S.P.Q.2d (BNA) 1315 (D. Minn. Jan. 5, 2004), later proceeding, *Faegre & Benson, LLP v. Purdy*, 447 F. Supp. 2d 1008 (D. Minn. 2006), plaintiff obtained injunctions against defendant, a pro-life activist, who, in response to plaintiff's participation as counsel in anti-cybersquatting actions against defendant, registered domains using the plaintiff's trademark and created Web sites mimicking its site but containing anti-abortion messages. In *Peri Hall & Assocs., v. Elliot Inst. for Soc. Scis. Research*, 78 U.S.P.Q.2d (BNA) 1414 (W.D. Mo. March 20, 2006), the court issued an injunction in favor of the owner of a stem cell research initiative against an infringing site by an anti-abortion group.

14. See Melville B. Nimmer & David Nimmer, 4 Nimmer on Copyright §13.03[A][1][c] (Matthew Bender & Company Inc., 2007).

15. *Tufenkian Import/Export Ventures Inc. v. Einstein Moomjy Inc.*, 338 F.3d 127, 133 (2d Cir. 2003).

16. *Int'l Union, Local 150 v. Team 150 Party Inc.*, 88 U.S.P.Q.2d (BNA) 1532 (N.D. Ill. Sept. 5, 2008); see also *QSRSoft Inc. v. Rest. Tech. Inc.*, 2006 U.S. Dist. LEXIS 76120 (N.D. Ill. Oct. 19, 2006) (preliminary injunction where defendant stole plaintiff's software and "look and feel" of its new main page looked like plaintiff's).

17. *Blue Nile Inc. v. Ice.com Inc.*, supra, 478 F. Supp. 2d at 1241-42.