

TRADESITE OR WEB DRESS?: TRADE DRESS PROTECTION FOR WEBSITE INTERFACES

by

Kurt M. Saunders*

Your client is the fortunate owner of a dot-com business that started up in the late 1990's and survived the "dot-bomb" days of 2000. In fact, your client's business, which is entirely operated from an Internet website, is quite successful. The website is composed of various elements that give it a distinct "look and feel." Your client discovers one day that a competitor's Internet website has taken on a familiar cast. The competitor's site has incorporated a number of the elements found in your client's website. In fact, the logo, layout, color scheme, fonts, user interface, and other graphical features closely resemble those found on your client's site. Your client demands that you send a cease and desist letter to the competitor, arguing that the competitor has copied the look and feel of your client's website. On what legal grounds can this be done?

The answer to this question may be found in the law of trade dress protection. Trade dress is the overall appearance of a product and its packaging. Not only do conventional packaged consumer goods possess a trade dress, but entire commercial enterprises can do so as well. Such trade dress covers architectural features, color schemes, and décor. To be protectable, trade dress must first be distinctive--either inherently or by virtue of secondary meaning. Second, the trade dress must be non-functional, which is to be determined by considering all the elements of the trade dress in combination, not in isolation.

This article considers the potential liability of those who use appropriate the look and feel of the of another's website. We begin with an overview of the law of trade dress and the scope of protection afforded by the Lanham Act. The availability of protection under alternative intellectual property regimes is considered alongside this discussion. Next, the article considers the applicability of trade dress protection to websites. Finally, the author concludes that trade dress law (or shall we refer to it as tradesite or web dress law?) can afford useful protection for a website's graphical user interface.

I The Availability of Design Patent and Copyright Protection for Graphical User Interfaces

There are three principal legal schemes for protecting industrial and product designs against unauthorized copying: design patents, copyrights, and trade dress. In this part, we focus on the first two of these. The nature of the Internet is that of a dynamic, highly interactive environment. These forms of legal protection must be responsive and adaptive enough to account for the nature of online business. As we shall see, design patents and copyrights are subject to significant qualifications that limit their viability as a method of protecting website interfaces.

A. Design Patent Protection

Although most of the patents issued in the United States take the form of utility patents, which protect the functional aspects of new, useful, and nonobvious inventions, the aesthetic appearance of a product may be protected by a design patent. A design patent may be obtained for "any new, original and ornamental design for an article of manufacture" for a term of 14 years.¹ Such patents have been issued for a variety of subject matter, including furniture, fountain water patterns, containers, silverware, cement mixers, hats, automobile designs, televisions, and shoes.

Design patents protect the nonfunctional features of useful inventions. Appearance, as opposed to usefulness, is the crux of design patent protection. A design is "the visual characteristics or aspects displayed by the object. It is the appearance presented by the object which creates a visual impact upon the mind of the observer."² Thus, a design may consist of product configuration, surface ornamentation, or a combination of both of these. A patentable design must be decorative or ornamental; that is, it "must be the product of aesthetic skill and artistic conception."³ A design that is "primarily functional rather than ornamental" or "dictated by functional considerations" is not patentable.⁴ It is possible that an ornamental design may have functional elements, the design must not embody a function that is necessary for others to

compete in the market. As such, if the functional aspect of a design may be achieved by other design techniques, then it is not primarily functional.⁵

Design patents have played a minimal role in the realm of computer technology, perhaps due to the greater willingness of courts to extend copyright protection to software. Since a design must be applied to an article of manufacture, a picture alone does not comprise design patentable subject matter.⁶ Whether a computer display or a website interface can be thought of as a picture or a design applied to an article of manufacture is a critical question. The case of *Ex parte Donaldson*⁷ may be instructive as to this matter. *Donaldson* was an appeal from an examiner's decision to reject the application for a design of display screen of a computer program on the grounds that the design was unprotectable subject matter. Donaldson argued that the design should be considered surface ornamentation upon the computer display screen. The Board of Patent Appeals & Interferences, however, concluded that the claimed "design, as shown and described [in the application], is merely a picture which has not been disclosed applied to any article."⁸

In 1996, the U.S. Patent & Trademark Office issued guidelines instructing examiners to accept design patent applications relating to computer screen icons, provided that the applicant claims the icon in connection with a computer screen, monitor, or display.⁹ The Patent Office's focus in this area appears to be on computer icons and their appearance and role as part of an overall computer screen, monitor, or display.¹⁰ Nonetheless, it is uncertain whether design patent protection would be afforded to an entire computer or website interface.

Aside from this concern, there are other factors that make doubtful the extension of design patents to website interfaces. As with utility patents, the subject matter of a design patent application must be both novel and nonobvious. Novelty is established if no prior art shows exactly the same design. A design is novel if the "ordinary observer," viewing the new design as a whole, would consider it to be different from, rather than a modification of an already existing design.¹¹ Furthermore, a design must be nonobvious, demonstrating the "exercise of the inventive or originative faculty."¹² Whether a design is nonobvious is measured by whether the differences between the design and designs in the prior art would have been obvious to a "designer of ordinary capability who designs articles of the type presented in the application."¹³ As with utility patents, the novelty and nonobvious requirements are formidable hurdles that have led to a high rate of invalidation of design patents during enforcement actions. The examination process is time-consuming and expensive.¹⁴ As a consequence, design patent protection is unsuitable and impractical for the rapid pace of electronic commerce.

B. Copyright Protection

Under the Constitution and the Copyright Act, copyright protection extends to "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."¹⁵ The copyrightability of computer programs is explicitly established in section 901 of the Copyright Act;¹⁶ however, the copyrightability of Internet website is less clear. Such a determination must be measured by the basic requirements for copyright protection: fixation of original expression. As to the fixation requirement, the courts have held that information embedded in computer read-only memory (ROM) is fixed in a tangible medium.¹⁷ Similarly, data stored on a computer hard drive or diskette is fixed. Website page files, which contain the instructions for generating the user interface are saved on a computer's hard drive and would likely satisfy the fixation requirement.

For a work to be considered original, there must be some independent creation by the author, and some minimal level of creativity in the work.¹⁸ Artistic merit or novelty is not required. Thus, the graphical user interface of a website will likely be considered original if there is at least a minimally creative visual presentation. For those websites that merely compile or list information or hyperlinks, there may be no protection unless the compilation reflects originality in the selection, coordination, sequencing, or arrangement of the information.¹⁹

Although the requirements of originality and fixation in a tangible medium of expression may be met when it comes to website "look and feel," the limitation found in section 102(b) of the Copyright Act may be of greater concern. Under section 102(b), copyright protection extends only to expression, not to an "idea, procedure, process, system, method of operation, concept, principle, or discovery."²⁰ This is one of the most well-established limitations in copyright law. A corollary to this principle is that when a work communicates an idea is such that it can only be expressed in one way, the work is ineligible for copyright protection. Known as the merger doctrine because the underlying idea and the mode of its expression are

said to merge, this distinction maintains the dichotomy between unprotectable ideas and protectable expression in order to preserve both freedom of expression and the competitive interests in dissemination of concepts that are not sufficiently inventive to qualify for patent protection.

To the extent that there are only a few alternative means available for creating the design of a website, such that the idea merges with the expression, or that the design has become an industry standard, it is possible to argue that the “look and feel” of a website is little more than an unprotectable idea or method of operating the computer.²¹ Indeed, this issue has been considered in several cases involving the user interface of computer programs. One of the earliest of these cases was *Atari, Inc. v. North American Philips Consumer Electronics Corp.*,²² in which the Seventh Circuit Court of Appeals reversed a district court's order denying a request for a preliminary injunction by Atari, the manufacturer of the “Pac-Man” computer game, against the manufacturer of another game. The competing game featured a character known as “K.C. Munchkin” and at issue was the audiovisual copyright in the game’s screen displays. In finding that Atari had met its burden of showing a reasonable likelihood of success on the merits, the Seventh Circuit compared the details of the audiovisual displays of the two works, finding that a number of similarities in the Pac-Man and the K.C. Munchkin “gobblers” were the dispositive factors in Atari’s favor on the issue of infringement. While observing that there was no identical copying, the court found that defendant's game had captured the “total concept and feel” of the Atari game.²³

By contrast, the Ninth Circuit Court of Appeals came to an opposite conclusion in *Apple Computer, Inc. v. Microsoft Corp.*,²⁴ in which Apple sued Microsoft and Hewlett-Packard for copyright infringement of the graphical user interface on its Macintosh computer. The Macintosh user interface included overlapping windows, icons, pull-down menus, among other features. The Ninth Circuit affirmed the district court’s holding that the “look and feel” of the Macintosh computer user interface was uncopyrightable. The court rejected the approach of considering the entire look and feel of an interface to find copyright protection of the whole interface.²⁵ Instead, it determined that each of the command features of the user interface was utilitarian or functional, and therefore not protectable under copyright law when viewed together with other protectable elements in the interface.²⁶

Finally, in *Lotus Development Corp. v. Borland International, Inc.*,²⁷ the United States Supreme Court was confronted with the issue of whether the command hierarchy portion of a computer program’s user interface was protectable under copyright law. The First Circuit Court of Appeals had ruled that the menu structure of the spreadsheet program, “Lotus 1-2-3,” was a method of operation and therefore unprotectable by copyright. The First Circuit relied on the express language in section 102(b) of the Copyright Act, which exempts methods of operation from copyrightable subject matter, to reason that the Lotus 1-2-3 command hierarchy was a method of operation akin to the buttons on a VCR because the hierarchy “provided the means by which users control and operate Lotus 1-2-3.”²⁸ The Supreme Court affirmed the First Circuit without issuing an opinion.

Although these cases did not consider the copyrightability of a website’s “look and feel,” they are instructive as to the where the analytical spotlight should shine. Like the software menu commands in the *Apple* and *Lotus* cases, the means for navigating, operating, and manipulating a website—the hyperlinks, icons, task bars, buttons, pull-down or pull-out menus, are probably unprotectable methods of operation. Moreover, as discussed earlier, it may be difficult to find sufficient originality in a website interface for copyright protection if the site merely presents and organizes facts or data, which are unprotectable. Likewise, many individual elements in a user interface may be left unprotected after expression is dissected from unprotectable ideas, as was done in *Apple*. As such, the amount of protection for website “look and feel” provided by copyright law may be negligible at best.

II. The Viability of Trade Dress Protection for Website “Look and Feel”

Trade dress refers to the “total image and overall appearance of a product.”²⁹ It includes the “arrangement of identifying characteristics or decoration connected to a product, whether by packaging or otherwise, intended to make the source of the product distinguishable from another and to promote it for sale.”³⁰ This form of intellectual property protection emerged as a subset of trademark law. In this part, we begin with a brief overview of the scope of federal trademark law and then move to a general discussion of trade dress protection. From there, we consider the viability of trade dress law as a source of protection for website user interfaces.

A. *The Ambit of Federal Trademark Law*

Typically, a trademark takes the form of “any word, name, symbol, or device, or any combination thereof ... used ... to identify and distinguish ... goods ... from those manufactured or sold by others and to indicate the source of the goods.”³¹ Trademarks serve as an indicator of quality for consumers, allowing them to associate the mark with a product’s superiority or inferiority to competing products. As such, they lower costs of consumer search by providing a reliable signal of product quality.³² The Lanham Trademark Act provides federal protection³³ to both registered³⁴ and unregistered trademarks³⁵ used in interstate commerce.³⁶

The Lanham Act prohibits infringement and dilution,³⁷ allowing trademark owners to obtain injunctions,³⁸ and in some cases monetary damages,³⁹ for the improper use of their marks.⁴⁰ To establish a trademark infringement claim under the Lanham Act, the plaintiff must demonstrate that the defendant is using a mark confusingly similar to the plaintiff’s own mark.⁴¹ In order to prevail in such a claim, the plaintiff must show that there exists a likelihood that an appreciable number of ordinarily prudent purchasers are likely to be confused as to the source of the goods or services in question.⁴² Likelihood of confusion constitutes the core element in an infringement claim.⁴³

In addition to a trademark infringement claim, a plaintiff may bring an action for trademark dilution. Under the Federal Trademark Dilution Act,⁴⁴ dilution refers to the decreased capacity of a famous mark to identify and distinguish goods or services, regardless of competition between the parties or likelihood of confusion.⁴⁵ Dilution usually takes the form of “blurring”⁴⁶ or “tarnishment.”⁴⁷ Rather than focusing on whether marks of competing substitutes are confusingly similar, a court will determine whether a famous mark is being used in such a way that “blurs” or its distinctiveness or “tarnishes” its reputation in the minds of consumers.⁴⁸ The owner of a famous mark is entitled to an injunction against another person’s commercial use of the mark if that use begins after the mark has become famous and causes dilution of the distinctive quality of the mark.⁴⁹ Monetary damages may also be available if that person willfully intended to trade on the owner’s reputation or to cause dilution of the famous mark.⁵⁰

B. *Legal Protection for Trade Dress*

Trademark law, in the guise of trade dress protection, has also been extended to various nontraditional formats, including the shape of either a product or its container, the color of a product, and the appearance of a building. Trade dress, like traditional trademarks in the form of names, words, or logos, may be registered with the Trademark Office. Irrespective of whether a trade dress is registered under the Lanham Act, section 43(a) of the Act guards against false designations of origin that lead to confusion or the likelihood of confusion as to source, sponsorship, or association between the products of competitors.⁵¹

The shape of a product or its container may be protected as a trademark—and federally registered—if two tests are met. First, the shape must be distinctive, which requires proof of secondary meaning. Second, the shape must be “nonfunctional;” that is, it must not improve the performance of the product or container in any way. The nonfunctionality requirement ensures that useful product improvements will be available to all firms unless protected by a patent.

Similarly, color combinations will be protected as trademarks where they are both distinctive and nonfunctional. The courts have been reluctant to grant exclusive rights to use a *single* overall color on goods or packaging, but where there is no risk of burdening competition and where consumer recognition of the color as a brand-identifying symbol is strong, trademark protection is allowed. Finally, the design of a building can be protected as a federally registered servicemark under the Lanham Act if the design meets the tests of distinctiveness and nonfunctionality.⁵²

As with trademarks, trade dress will be protected when it is both distinctive and nonfunctional. According to the United States Supreme Court, trade dress is distinctive when it has secondary meaning, or when it is inherently distinctive.⁵³ To assess distinctiveness, the courts have developed a set of factors for consideration. If a mark is either arbitrary or fanciful, it is inherently distinctive and proof of second meaning is not required. If a mark is descriptive or suggestive, secondary meaning must be established by evidence of long use, degree of advertising, volume of sales, and identity of service or origin in the minds of consumers.⁵⁴

Functionality of design or configuration will preclude protection because it undermines free competition and patent law’s goal of advancing technology through disclosure. A product’s trade dress

may be composed of many elements, each of which is arguably function standing alone. However, the combination of elements may not be functional in that others could compete effectively by employing a different set of elements in the texture, design, coloring, and packaging of their products.⁵⁵

C. Application of Trade Dress Law to Website User Interfaces

No court has yet considered the issue of whether an Internet website's "look and feel" is protectable by trade dress law. Likewise, there have been few courts that have considered trade dress protection for computer user interfaces. In one such case, *Engineering Dynamics, Inc. v. Structural Software, Inc.*,⁵⁶ the Fifth Circuit Court of Appeals rejected a trade dress claim, holding that protectable trade dress did not apply to the input protocols, output reports, manuals, or overall look and feel of the plaintiff's computer program. The court found that copying the screen display of a sophisticated engineering software program could not constitute trade dress infringement because the programming company's name was displayed and the purchasing public was limited and highly sophisticated. Ultimately, however, trade dress protection for online user interfaces will be measured by an assessment of whether the interface is either inherently distinctive or has acquired secondary meaning in the minds of Internet users. In addition, the website's design and layout must be deemed nonfunctional.

The most significant identifying feature of a website is its design and appearance of the user interface, composed of such features as frames, logos, typefonts, windows, menus, buttons, and pictorial and graphic representations. There are a variety of website designs and a number of graphical elements that might be included in a website user interface. Such a design may be inherently distinctive if it was unique. On the other hand, most websites tend to incorporate a number of elements, such as icons, command hierarchies, or toolbars, which have become standardized. Such elements would be considered unprotectable. The greatest obstacle to establishing distinctiveness is graphical user interface standardization. Standardization results in response to the user's need to reduce learning curve for using a class of products. "Look and feel" standardization will prevent the establishment of secondary meaning, and this will prove fatal to the acquisition of trade dress protection. Nevertheless, the issue of distinctiveness will be considered in the aggregate and a court would likely consider the entire layout of the website interface. Thus, if a user would recognize the source of a website by the unique audiovisual design or its overall combination of features and colors, then that website is distinctive and capable of trade dress protection.

A website will incorporate a variety of features that may be functional or utilitarian. As we have seen, a feature that is purely functional is ineligible for trade dress protection. Nevertheless, the totality of otherwise functional elements on a website may be protectable as trade dress if the site as a whole identifies its owner as the creator or product source. Thus, the presence of functional elements will not necessarily preclude trade dress protection.

The overall design of a website user interface would be functional if the utility or efficiency of particular design could not be easily reproduced by an alternative design. For instance, the arrangement of the user interface might make it more user friendly, or make it easier to navigate the product information. On the other hand, if a competitor would be able to generate this user benefit in a different manner, there may not be a functionality problem. Moreover, a particular arrangement or layout of a website for purpose of source identification would likely be nonfunctional. So long as a particular display or layout did not prevent others from competing, the site's interface should not be considered functional.

III. Conclusion

A website is much like a storefront. As this article has demonstrated, trade dress law is a superior source of intellectual property protection for website graphical user interfaces than either design patents or copyrights. In order to secure and enforce trade dress rights, the design and layout of the website must be either inherently distinctive or have acquired secondary meaning in the minds of Internet users. In addition, the website's design and layout must be nonfunctional.

Returning to our point of departure for this discussion, your dot-com client should be advised of the potential availability of trade dress protection for its website. A careful evaluation of the overall appearance and combination of features that make up the website in light of the factors discussed in this article will yield a preliminary determination of whether trade dress law is a viable option. If so, it will be

possible to send a cease and desist letter to the competitor on the basis that the competitor has copied the “look and feel” of your client’s website and that relief under the Lanham Act may be obtained.⁵⁷

FOOTNOTES

* Assistant Professor of Business Law, California State University, Northridge.

¹ 35 U.S.C. § 171.

² U.S. Patent & Trademark Office, Manual of Patent Examining Procedure, §1502 (6th ed., 2d rev. 1996).

³ *Blisscraft of Hollywood v. United Plastics Co.*, 294 F.2d 694, 696 (2d Cir. 1964).

⁴ *Power Controls Corp. v. Hybernetics, Inc.*, 806 F.2d 234, 238 (Fed. Cir. 1986).

⁵ *See Avia Group Int’l, Inc. v. L.A. Gear Cal.*, 853 F.2d 1557, 1563 (Fed. Cir. 1988).

⁶ *See In re Schnell*, 46 F.2d 203 (C.C.P.A. 1931).

⁷ 26 U.S.P.Q.2d 1250 (Bd. Pat. App. & Int. 1992).

⁸ *Id.* at 1251. *Accord Ex parte Strijland*, 26 U.S.P.Q.2d 1259 (Bd. Pat. App. & Int. 1992).

⁹ U.S. Patent & Trademark Office, Manual of Patent Examining Procedure, §1504.01 (5th ed., 2d rev. 1996). For a discussion of the patentability of computer icons, see Lance L. Vietzke, *Software as the Article of Manufacture in Design Patents for Icons*, 21 AM. INTELL. PROP. L. ASS’N Q.J. 138 (1993).

¹⁰ *See supra* note ___ and accompanying text.

¹¹ *See Clark Equip. Co. v. Keller*, 570 F.2d 778, 799 (8th Cir. 1978).

¹² *Smith v. Whitman*, 148 U.S. 674, 679 (1893).

¹³ *In re Nalbandian*, 661 F.2d 1214, 1216 (C.C.P.A. 1981).

¹⁴ For extended discussion of these criticisms, see William T. Fryer, III, *Industrial Design Protection in the United States of America—Present Situation and Plans for Revision*, 70 J. PAT. & TRADEMARK OFF. SOC’Y 821 (1988); Jerome H. Reichman, *Design Protection and the New Technologies: The United States Experience in a Transnational Perspective*, 19 U. BALT. L. REV. 6 (1991).

¹⁵ 17 U.S.C. § 102.

¹⁶ *Id.* § 901.

¹⁷ *See Apple Computer, Inc. v. Franklin Computer Corp.*, 714 F.2d 1240, 1243 (3d Cir. 1983).

¹⁸ *See Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991).

¹⁹ *Id.* (holding that an alphabetized phone directory was insufficiently original to warrant copyright protection).

²⁰ *Id.* §102(b). These articles are more properly the subject of patent or trade secret law.

²¹ *See Bruce G. Joseph & David A. Vogel, Copyright Protection of Software and Compilations: A Review of Critical Developments 1991-1996*, 441 PLI/PAT 369, 383 (May 1996).

²² 672 F.2d 607 (7th Cir. 1982).

²³ *See id.* at 617-18. *See also Whelan Assocs., Inc. v. Jaslow Dental Lab, Inc.*, 797 F.2d 1222 (3d Cir. 1986) (stating that “copyright protection of computer programs may extend beyond the program’s literal code to their structure, sequence, and organization”); *Broderbund Software, Inc. v. Unison World Inc.*, 648 F. Supp. 1127 (N.D. Cal. 1986) (concluding that “the overall structure, sequence, and arrangement of the screens, text, and artwork...are protected under copyright”); *OP Solutions, Inc. v. Intellectual Property Network, Ltd.*, 50 U.S.P.Q.2d. 1399 (S.D.N.Y. 1999) (holding that “it is clear that a user interface is entitled to protection”).

²⁴ 35 F.3d 1435 (9th Cir. 1994).

²⁵ *Id.* at 1445.

²⁶ *Id.*

²⁷ 516 U.S. 233 (1996).

²⁸ *Lotus Dev. v. Borland Int’l, Inc.*, 49 F.3d 807, 818 (1st Cir. 1995).

²⁹ *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 764-65 n. 1 (1992) (quoting *Blue Bell Bio-Medical v. Cin-Bad, Inc.*, 865 F.2d 1253, 1256 (5th Cir. 1989)).

³⁰ Restatement (Third) of Unfair Competition §16 cmt. a (1995).

³¹ 15 U.S.C. § 1127.

³² The economic analysis of trademark protection is presented in William M. Landes & Richard A. Posner, *Trademark Law: An Economic Perspective*, 30 J. L. & ECON. 265 (1987).

³³ Though most states provide for their own registration of trademarks, state registration is not an effective form of protection because trademarks used on the Internet are transmitted through interstate and international commerce. Federal registration of a trademark creates a presumption of validity, ownership, and the right to use the mark, and allows the owner to prevent importation of products into the United States that may infringe the mark.

³⁴ 15 U.S.C. §1114.

³⁵ *Id.* §1125(a)(1).

³⁶ *See* 15 U.S.C. §§ 1051-1127.

³⁷ *See* Federal Dilution Act of 1995, Lanham Act § 43, *id.* § 1125.

³⁸ *Id.* § 1116(a).

³⁹ *Id.* §1117.

⁴⁰ *Id.* §1125(a)(1) & (c).

⁴¹ Section 32(1) of the Lanham Act applies to federally registered marks and provides:

Any person who shall, without the consent of the registrant -(a) use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive;...shall be liable in a civil action by the registrant for the remedies hereinafter provided.

Id. § 1114(1). *See also* Rodeo Collection, Ltd. v. West Seventh, 812 F.2d 1215, 1217 (9th Cir. 1987). The same standard is set forth in section 43(a)(1) of the Lanham Act. This section applies to both registered and unregistered marks in unfair competition claims, a subject not covered in this paper.

Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name symbol, or devices, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact which - is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person...shall be liable in a civil action by any person who believes that he or she is or likely to be damaged by such act.

Id. § 1125(a)(1).

⁴² Factors that may be considered when determining the likelihood of confusion include:

- (1) the strength of the mark;
- (2) the degree of similarity between the two marks;
- (3) the proximity of the products;
- (4) the likelihood that the prior owner will “bridge the gap;”
- (5) actual confusion;
- (6) the defendant's good faith in adopting its mark;
- (7) the quality of the defendant's product; and
- (8) the sophistication of the buyers.

Western Pub. Co. v. Rose Art Indus. Inc., 910 F.2d 57, 59 (2d Cir. 1990) (citation omitted). *See also* Time, Inc., v. Petersen Publishing Co. L.L.C. 1999 U.S. App. LEXIS 7508, at p.6.

⁴³ *See* E. & J. Gallo Winery v. Gallo Cattle Co., 967 F.2d 1280, 1290 (9th Cir. 1992).

⁴⁴ 15 U.S.C. § 1127.

⁴⁵ *Id.*

⁴⁶ Blurring occurs where consumers mistakenly associate the famous mark with goods and services of the junior mark, thereby diluting the power of the senior mark to identify and distinguish goods and services. *See* Ringling Bros.-Barnum & Bailey Combined Shows, Inc. v. Utah Div. of Travel Dev., 955 F.Supp. 605, 616 (S.D.N.Y. 1997).

⁴⁷ “Dilution through tarnishing can occur where an accused, junior mark is used on unwholesome or inferior goods or services that may create a negative association with the goods or services covered by the famous mark.” *Id.* at 614. (citation omitted).

⁴⁸ To prove a dilution, a plaintiff must show:

- (1) the mark is famous;
- (2) the defendant is making a commercial use of the mark in commerce;

-
- (3) the defendant's use began after the mark became famous; and
 - (4) the defendant's use of the mark dilutes the quality of the mark by diminishing the capacity of the mark to identify and distinguish goods and services.

Panavision International v. Toeppen, 141 F.3d 1316, 1324 (9th Cir. 1998).

⁴⁹ 15 U.S.C. § 1125(c).

⁵⁰ *Id.*

⁵¹ 15 U.S.C. § 1125(a) (1994). Section 43(a) of the Lanham Act provides:

(a) Any person who, or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact or false or misleading representation of fact, which

(1) is likely to cause confusion, or to cause mistake, or deceive as to the affiliation, connection, or association of such person with another person or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person... .

⁵² For a review of the types of protectable trade dress, see ROGER E. SCHECHTER, UNFAIR TRADE PRACTICES & INTELLECTUAL PROPERTY 66-71 (2d ed. 1993).

⁵³ See *Two Pesos*, 505 U.S. at 1119.

⁵⁴ See *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4 (2d Cir. 1976).

⁵⁵ Cf. *Hartford House, Ltd. v. Hallmark Cards, Inc.*, 846 F.2d 1268 (10th Cir. 1988).

⁵⁶ 26 F.3d 1335 (5th Cir. 1994).

⁵⁷ For other treatments of this issue, see, e.g., 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 (1998); Lauren F. Kellner, Note, *Trade Dress Protection for Computer User Interfaces "Look and Feel,"* 61 U. CHI. L. REV. 1011 (1994); John P. Musone, *Obtaining and Enforcing Trade Dress for Computer Graphical User Interfaces—A Practitioner's Guide*, 4 RICH. J.L. & TECH. 2 (1997); Jane M. Rolling, *No Protection, No Progress for Graphical User Interfaces*, 2 MARQ. INTELL. PROP. L. REV. 157, 160 (1998); Jack Russo & Jamie Nafziger, *Software "Look and Feel" Protection in the 1990s*, 15 HASTINGS COMM. & ENT. L.J. 571, 572 (1993); Matthew E. Watson, *Trade Dress Theory and the Software Graphic User Interface: Sorting Through the Gooney Mess*, 34 JURIMETRICS J. 251 (1996).