

WEBSITE “LOOK AND FEEL”: TRADE DRESS OR WINDOW DRESSING?

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THE PROBLEM:

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Your client invested thousands of dollars establishing a distinctive online identity through its website—the primary means by which it interacts with its customers and prospective customers.

Suddenly, your client's chief competitor changes its website to be remarkably similar to your client's.

YOUR CLIENT

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marmoset

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🔍 Find the right soundtrack for your story.

BROWSE MUSIC

ORIGINAL MUSIC



Handcrafted sounds from the Great Northwest



▶ ⏮ ⏭ Hand of Sand (Instrumental) by Achille Lauro 2:54 of 4:54



THE COMPETITOR

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The screenshot displays the homepage of 'The Music Bed' website. The main visual is a video player with a dark background showing hands playing a piano. The text 'Licensing Relevant Music' is prominently displayed in the center, with the tagline 'TO HELP YOU TELL BETTER STORIES' below it. A large play button icon is centered over the video, with the text 'Watch Our Full Film' underneath. The left sidebar contains navigation links: 'Browse', 'Playlists', 'Custom', 'Community', and a help icon. The right sidebar has 'Search', 'Login', and 'Register' links. Below the video player, there are five category buttons: 'Staff Picks', 'Cinematic', 'Pop Rock', 'Folk', and 'Indie', each with a play button icon. At the bottom, a video player interface shows the current track as 'Brothers - Instrumental' by 'Prince of Spain', with a progress bar at 00:16 of 00:30. Additional icons for volume, full screen, playlist, and shopping cart are visible.

THE MUSIC BED

Browse
Playlists
Custom
Community

Search
Login
Register

Licensing Relevant Music

TO HELP YOU TELL BETTER STORIES

Watch Our Full Film

Staff Picks Cinematic Pop Rock Folk Indie

Brothers - Instrumental
Prince of Spain

00:16 00:30

YOUR CLIENT

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File Edit View Favorites Tools Help

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Singles

Originals

Our Story

Contact

Blog



Find the right soundtrack for your story.

BROWSE MUSIC

ORIGINAL MUSIC



Handcrafted sounds from the Great Northwest



Hand of Sand (Instrumental) by Achille Lauro
4:19 of 4:54



THE COMPETITOR

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The screenshot displays the homepage of 'The Music Hub'. The background is a black and white photograph of two musicians performing on stage. The main heading 'Music Licensing Made Easy' is centered in a large, white, serif font. Below this heading are two prominent teal buttons: 'Browse Music' and 'Create a Custom License'. The left sidebar contains a vertical menu with icons and labels for 'Browse', 'Playlists', 'Custom', and 'Community', along with a help icon and social media links for Facebook, Instagram, Twitter, and YouTube. The top right corner features a vertical stack of icons for 'Search', 'Login', and 'Register'. At the bottom, a video player interface is visible, showing the title 'Brothers - Instrumental' by 'Prince of Spain', a progress bar at 00:02 of 00:30, and icons for volume, play/pause, full screen, and a shopping cart.

THE MUSIC HUB™

Browse

Playlists

Custom

Community

?

f

ig

tw

v

Search

Login

Register

Music Licensing Made Easy

Browse Music

Create a Custom License

Brothers - Instrumental
Prince of Spain

00:02 00:30

Volume Play/Pause Full Screen + Shopping Cart

YOUR CLIENT

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F E A T U R E D A R T I S T S



Tony Ozier

Beats, Electronic, Soulful



MORE FROM THIS ARTIST



Hand of Sand (Instrumental) by Achille Lauro
1:10 of 4:54



THE COMPETITOR

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The screenshot shows the homepage of 'The Music Bed' website. The main header area features a large, dark image of Benj Heard with the text 'Benj Heard' and 'Start Listening Now' overlaid. A play button icon is centered below the text. To the left of the main image is a vertical sidebar with icons for 'Browse', 'Playlists', 'Custom', 'Community', and a help icon. To the right are links for 'Search', 'Login', and 'Register'. Below the main image is a horizontal row of five artist thumbnails: Taylor Turner, Benj Heard, Landon Austin, Johnny Scimmon, and Parade of Queens. At the bottom, a section titled 'Recently Added Pop Staff Picks' displays a music player for 'Brothers - Instrumental' by 'Prince of Spain'. The player includes a progress bar at 00:07 of 00:30, volume controls, and icons for a clock, plus, and shopping cart.

THE MUSIC BED®

Browse

Playlists

Custom

Community

Search

Login

Register

Benj Heard

Start Listening Now

Taylor Turner

Benj Heard

Landon Austin

Johnny Scimmon

Parade of Queens

Recently Added Pop Staff Picks

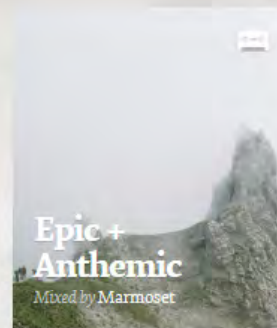
Brothers - Instrumental
Prince of Spain

00:07 00:30

YOUR CLIENT

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M I X T A P E S

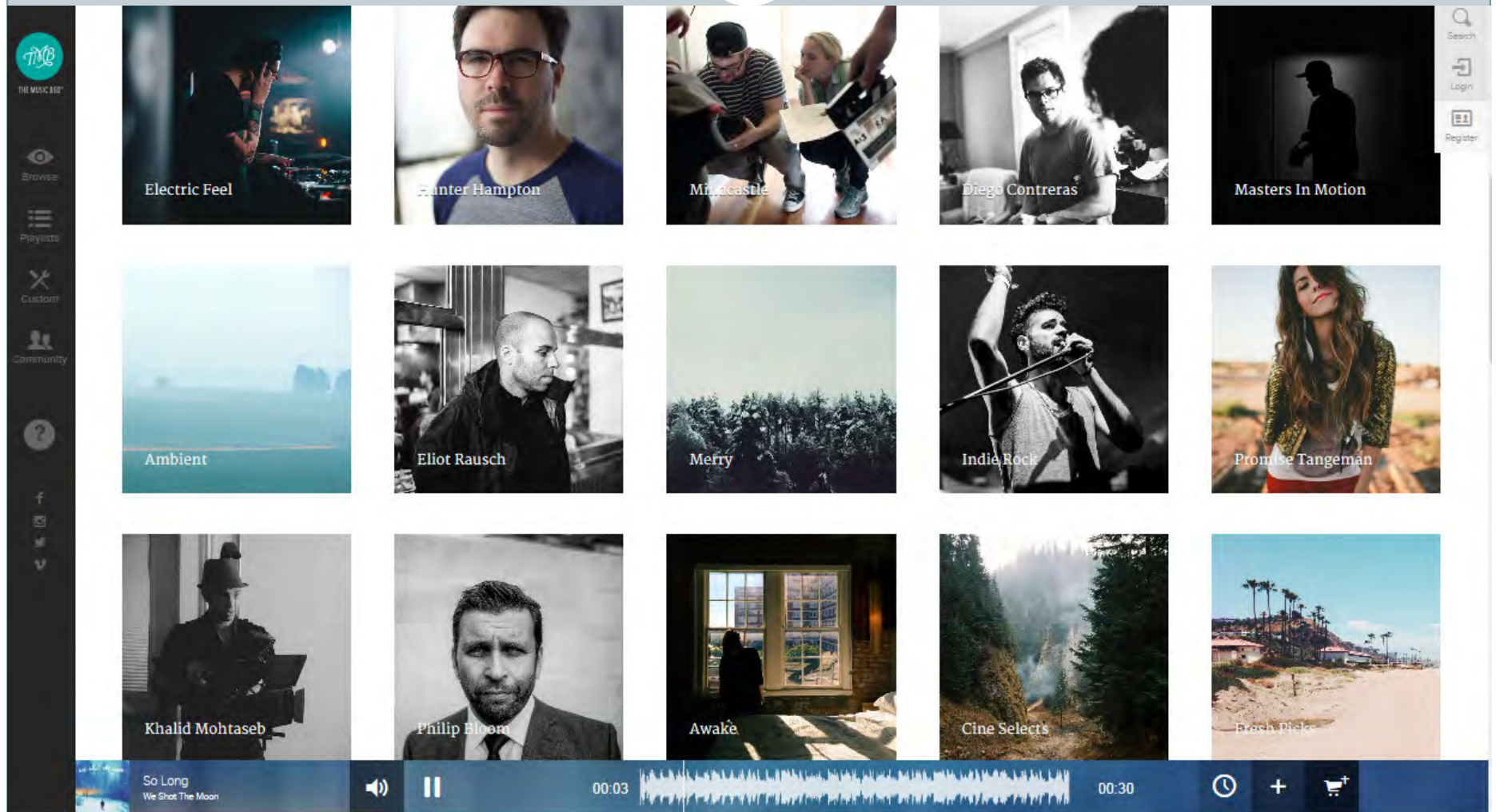


Summer Dharma (Instrumental) by Alameda
1:50 of 3:38



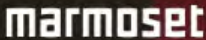
THE COMPETITOR

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YOUR CLIENT

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SinglesOriginalsOur StoryContactBlog

FILTER

SEARCH

MOODENERGYARC™LENGTHVOCALSGENRESCUSTOMIZABLE?

AmbientBeatsBlues & JazzCountryElectronicFolk




OrchestralPopRockSoulfulSpiritualWorld

1 ResultsFiltered By: FolkStringsNo VocalsSteadyMedium EnergySombreClear All

Heavy Rotation








Track	Artist	Genre	ARC™	Energy	Length
Cradle On Fire (Instrumental)	The Builders and The Butchers	Folk		Medium	3:53

Want to try out a track before you pay for it?



Moments (Edit 1) by Altadore

1:00 of 5:15



THE COMPETITOR

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The screenshot displays a music application interface. On the left is a dark sidebar with navigation icons: a logo, 'Browse', 'Playlists', 'Custom', 'Community', a help icon, and social media links for Facebook, Instagram, Twitter, and YouTube. The main content area features a filter sidebar on the left with categories: 'Non-Commercial' (checked), 'Commercial', 'Genre', 'Mood', 'Artist', 'Characteristics', 'Instrument', 'Length', 'Instrumental only' (checked), 'Lyrical only', 'Vocals', and 'Clear All Filters'. The 'Genre' list includes Alternative, Ambient, Blues, Cinematic, Classical, Country, Electronic, Folk (highlighted), Hip Hop, Indie, Jazz, Pop, Post Rock, R&B, Rock, Singer-Songwriter, and Soul. The top of the main area has 'Sorting options', 'All Songs', 'Staff Picks', a 'View Songs' button, and a 'View Artists' link. Below this, 'Selected Filters' shows: Non-Commercial, Somber, BPM: Medium, Strings, Instrumental only, and Folk. The main list displays one song: 'You Only Love Yourself - Instrumental' by 'Carrousel', categorized as 'Folk, Indie' with a duration of '3:30'. The bottom of the screen shows a music player for 'We're Wild Animals. We Always...' by 'Weaver At The Loom', with a progress bar at 00:07 of 00:30 and playback controls.

THE SOLUTION?

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What can your client do?

Is the website design—its look and feel—protectable?

TRADE DRESS UNDER THE LANHAM ACT

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- Sections 2 and 3 provide for the registration of:

Trademarks, *i.e.*, “any word, name, symbol, or device, or any combination thereof [used/intended to be used] to identify and distinguish [a person’s] goods ... from those manufactured or sold by others and to indicate the source of the goods” § 45.

Service marks, *i.e.*, “any word, name, symbol, or device, or any combination thereof [used/intended to be used] to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services” § 45.

- Registered marks entitled to a presumption of validity. § 7.

TRADE DRESS UNDER THE LANHAM ACT

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- **Trade dress** may comprise a “mark” protectable under the Lanham Act – *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 209 (2000) (concluding that “trade dress constitutes a ‘symbol’ or ‘device’ for purposes of the relevant sections [of the Lanham Act]”).
- Trade dress is the “manner in which the goods or services are presented to prospective purchasers.” Restatement (Third) of Unfair Competition § 16 cmt. a (1995).
- Trade dress involves the “total image” and may include features such as size, shape, color, color combinations, texture, or graphics.

See *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 764 n.1 (1992); *Clicks Billiards, Inc. v. Sixshooters, Inc.*, 251 F.3d 1252, 1257 (9th Cir. 2001); *Vision Sports, Inc. v. Melville Corp.*, 888 F.2d 609 (9th Cir. 1989).

TRADE DRESS UNDER THE LANHAM ACT

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- Section 32 provides a cause of action for infringement of registered marks, including registered trade dress.
- Section 43(a) provides a cause of action with respect to unregistered marks, including unregistered trade dress. It imposes liability on any person who uses ***“any word, term, name, symbol, or device, or any combination thereof ... 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 [such person’s] goods, services, or commercial activities”*** (Emphasis added.)

ELEMENTS OF §43(a) TRADE DRESS CLAIM

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- (1) Likelihood of Confusion. § 43(a)(1)(A).
- (2) Distinctiveness. *Wal-Mart*, 529 U.S. at 209
- (3) Non-Functionality. § 43(a)(3).

ELEMENT (1): LIKELIHOOD OF CONFUSION

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- *Sleekcraft* factors:

1. Strength of the mark;
2. Proximity of the goods;
3. Similarity of the marks;
4. Evidence of actual confusion;
5. Marketing channels used;
6. Type of goods and the degree of care likely to be exercised by the purchaser;
7. Defendant's intent in selecting the mark; and
8. Likelihood of expansion of the product lines.

AMF Inc. v. Sleekcraft Boats, 599 F.2d 341, 348-49 (9th Cir. 1979)

ELEMENT (2): DISTINCTIVENESS

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- Distinctiveness intertwined with likelihood of confusion – “without distinctiveness the trade dress would not ‘cause confusion ... as to the origin, sponsorship, or approval of [the goods or services],’ as the [Lanham Act] requires”. *Wal-Mart*, 529 U.S. at 210.
- Trade dress (other than product design) is protectable if it either (a) is inherently distinctive or (b) has acquired distinctiveness through secondary meaning.

ELEMENT (2): DISTINCTIVENESS

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- Inherent distinctiveness arises where the “intrinsic nature” of the trade dress “serves to identify a particular source”:
 - ✦ Does it “almost automatically tell a customer that [it] refer[s] to a brand”?
 - ✦ Does it “immediately ... signal[s] a brand or a product ‘source’”?

Wal-Mart, 529 U.S. at 210, 212.
- Acquired Distinctiveness / Secondary Meaning
 - ✦ “[A] mark has acquired distinctiveness ... if it has developed secondary meaning, which occurs when, ‘in the minds of the public, the primary significance of a [mark] is to identify the source of the product rather than the product itself.’” *Wal-Mart*, 529 U.S. at 211.

ELEMENT (3): NOT FUNCTIONAL

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- Non-Functionality

- ✦ Trade dress protection does not extend to functional features.
- ✦ Functional features are those “which constitute the actual benefit that the consumer wishes to purchase, as distinguished from an assurance that a particular entity made, sponsored, or endorsed a product.” *Disc Golf Ass'n, Inc. v. Champion Discs, Inc.*, 158 F.3d 1002, 1006 (9th Cir. 1998).
- ✦ *Disc Golf* factors:
 1. Whether the design yields a utilitarian advantage;
 2. Whether alternative designs are available;
 3. Whether advertising touts the utilitarian advantages of the design; and
 4. Whether the particular design results from a comparatively simple or inexpensive method of manufacture.

Id. at 1006.

ELEMENT (3): NOT FUNCTIONAL

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- Functionality doctrine – underlying policy considerations:
 - ✦ Trademark law seeks to promote legitimate competition by protecting a provider's reputation.
 - ✦ Functionality doctrine prevents anti-competitive effects that would result from allowing one to exercise perpetual monopoly control over useful product features.
 - ✦ Patent law – not trademark law – grants inventors a monopoly over new designs or functions for a limited time after which competitors are free to use the innovation.
 - ✦ If functional features could be asserted as trademarks, a monopoly over such features could be obtained without regard to patentability and could be extended forever.

Qualitex Co. v. Jacobson Prods. Co., 514 U.S. 159, 164-65 (1995).

“LOOK AND FEEL” AS TRADE DRESS

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Seminal “look and feel” case:

Blue Nile, Inc. v. Ice.com, Inc.,
478 F. Supp. 2d 1240 (W.D. Wash. 2007).

Plaintiff, an online diamond retailer, alleged that Defendant Ice.com copied the “overall look and feel” of its diamond search webpages. Defendant moved to dismiss Plaintiff’s allegations on the basis of copyright preemption.

The district court denied the motion, holding:

- The novelty of the “look and feel” claim called for greater factual development; and
- Under *Johnson Controls, Inc. v. Phoenix Control Sys., Inc.*, 886 F.2d 1173 (9th Cir. 1980), the question whether copyright law provided adequate protection for a look and feel claim depends on the particular facts of each case.

“LOOK AND FEEL” AS TRADE DRESS

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After Blue Nile, courts have further defined the nature and scope of “look and feel” infringement claims:

Conference Archives, Inc. v. Sound Images, Inc.,
2010 WL 1626072 (W.D. Pa. 2010).

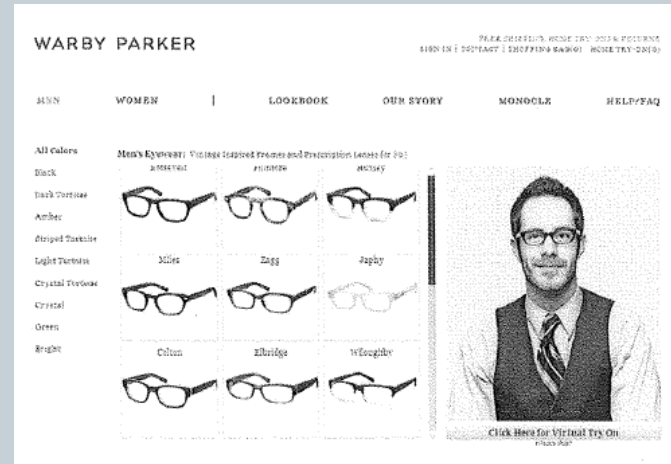
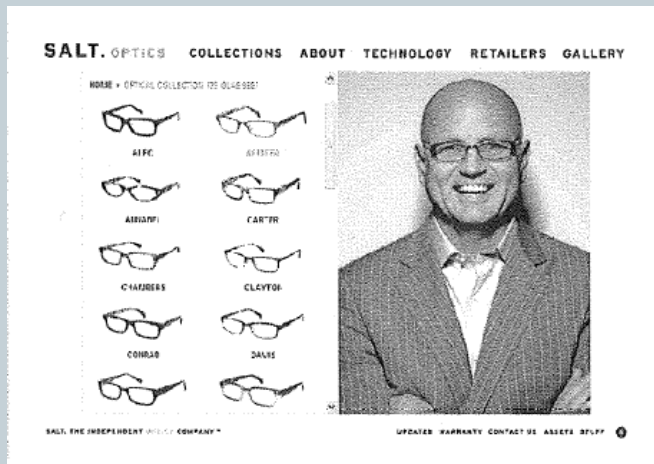
- Identifies color, orientation, and code elements as technical elements defining the look and feel;
- Treats “look” and “feel” as two separate concepts;
- “Combined, the ‘look’ and ‘feel’ coalesce to form a protectable virtual experience that provides the user with ‘cognitive absorption’; a graphical user interface that facilitates the development of an intuitive engagement.”
- **Functionality requirement** – The mere presence of functional elements on a website does not preclude trade dress protection. As long as there are alternative ways to design the element, it may be considered nonfunctional.

“LOOK AND FEEL” AS TRADE DRESS

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Salt Optics v. Jand, Inc.,
2010 WL 4961702 (C.D. Cal. 2010).

- Dismissed because Plaintiff listed the elements constituting protectable trade dress but failed to “synthesize these elements in order to describe the way that the listed elements, in conjunction, combined to create the website’s protectable ‘look and feel.’”
- Particularity requirement** – Plaintiff must list with particularity the discrete elements constituting the protectable trade dress. Salt Optics, 2010 WL 4961702, at * 5 (citing Sleep Science Partners v. Lieberman, 2010 WL 1881770 (N.D. Cal. 2010)).



“LOOK AND FEEL” AS TRADE DRESS

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Challenges in “look and feel” cases:

- Sleep Science Partners v Liebermann, 2010 WL 1881770 (N.D.Cal. 2010).
- Salt Optics v Jand Inc, 2010 WL 4961702 (C.D.Cal. 2010).
- Parker Waichman LLP v Gilman Law LLP, 2013 WL 3863928 (E.D.N.Y. 2013).

But see:

- Ingrid and Isabel LLC v Baby Be Mine LLC, 70 F.Supp.3d 1105 (N.D.Cal. 2014).

PLEADING “LOOK AND FEEL” TRADE DRESS

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Particularity requirement:

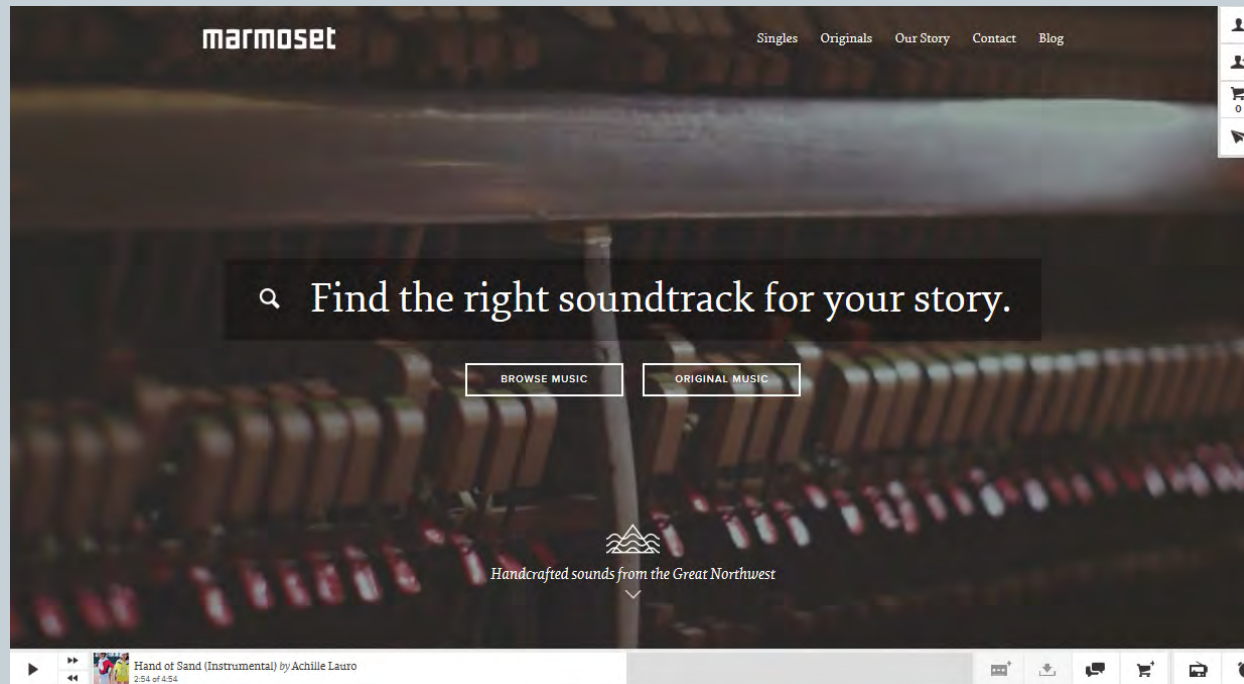
- Must list with particularity the discrete elements constituting the trade dress. See Sleep Science Partners, 2010 WL 1881770 at (N.D. Cal. 2010).
- “Overall look” is too vague. See McCarthy on Trademarks and Unfair Competition § 8:7.25.
- Must synthesize the manner in which the listed elements together constitute the protectable trade dress. Salt Optics, 2010 WL 4961702, at *5.

Remedies:

- Injunctive relief;
- Compensatory damages, including lost profits attributable to infringement and misappropriation;
- Corrective advertising.

MARMOSET V. THE MUSIC BED

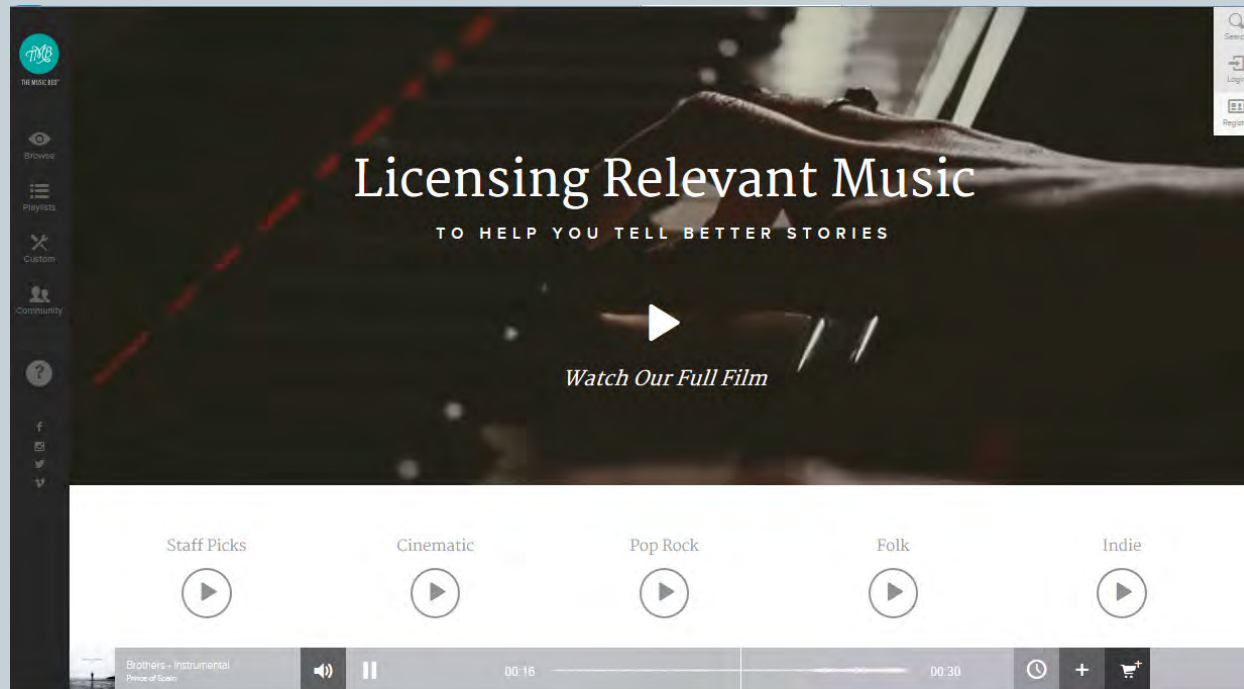
28



Marmoset home page sets the narrative and the basic look and feel.

MARMOSET V. THE MUSIC BED

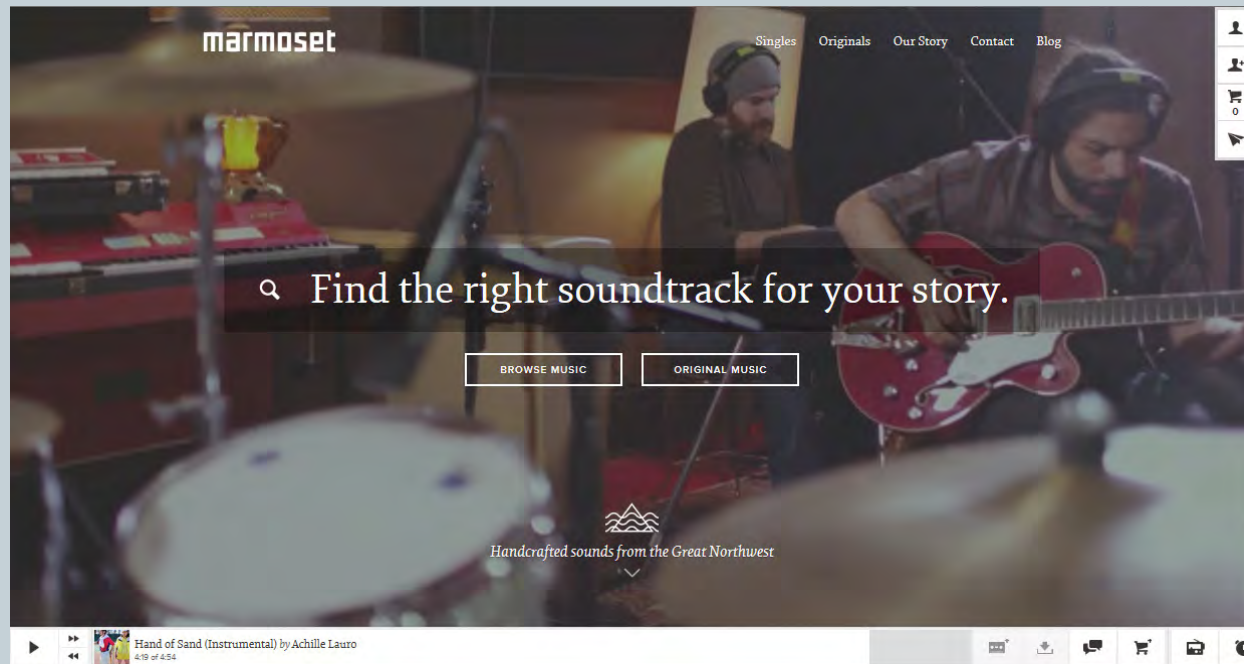
29



The Music Bed website.

MARMOSET V. THE MUSIC BED

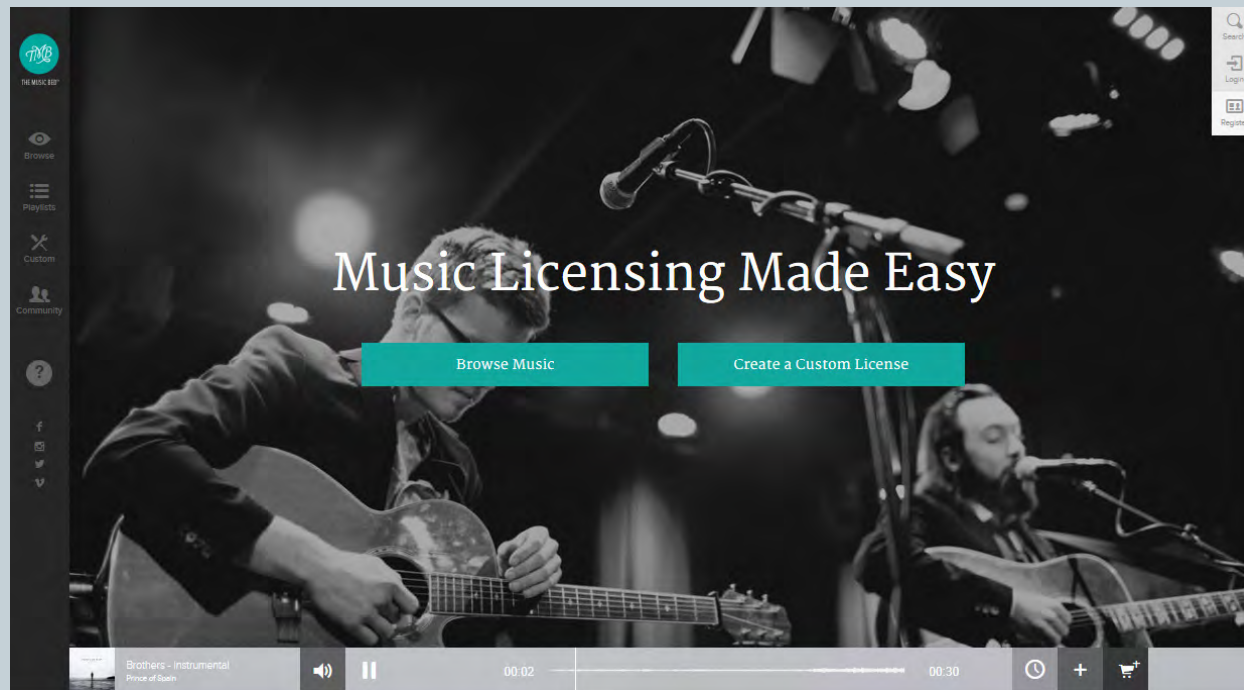
30



Marmoset website, with full-screen auto-play motion picture and options to “browse music” or explore “original music.”

MARMOSET V. THE MUSIC BED

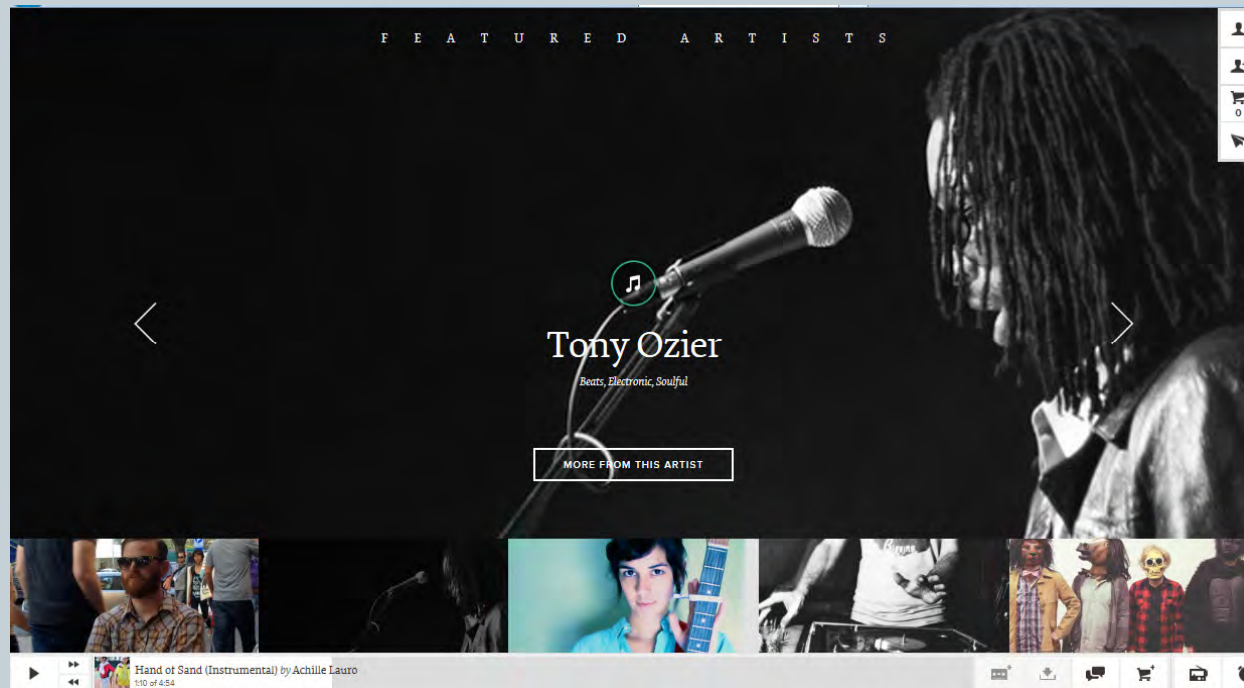
31



The Music Bed website.

MARMOSET V. THE MUSIC BED

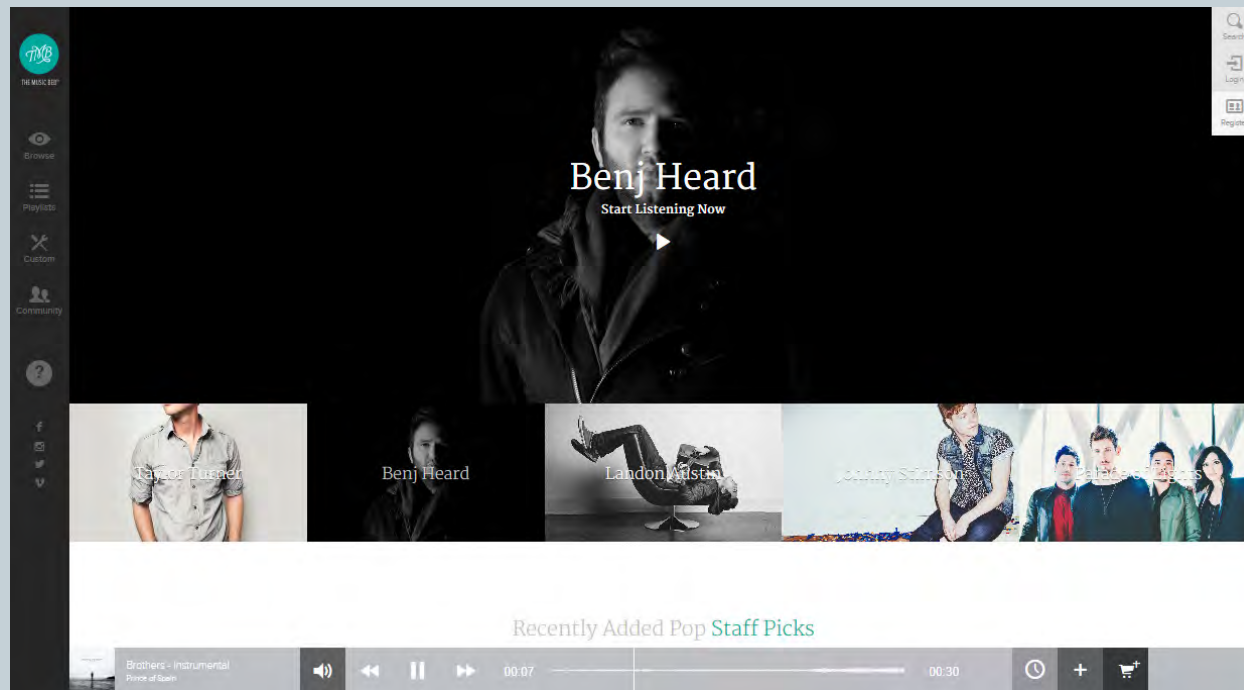
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Marmoset website, with large image of selected featured artist set above five smaller images of other featured artists (with selected feature artist in second position).

MARMOSET V. THE MUSIC BED

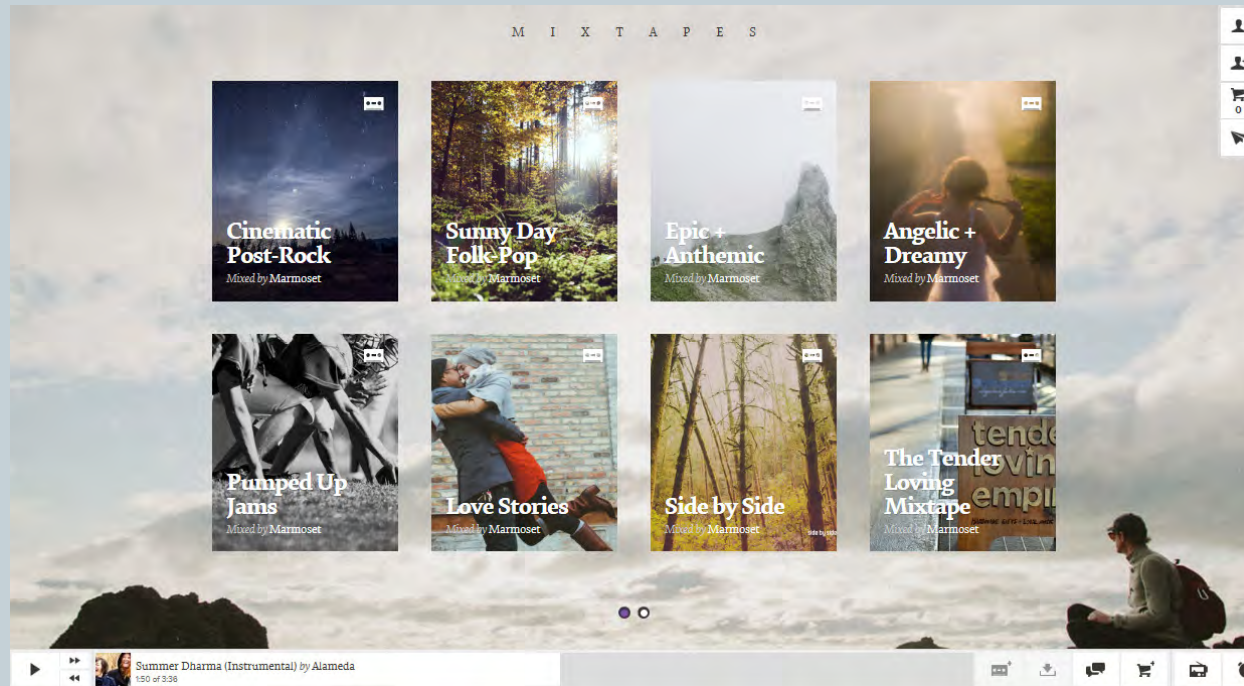
33



The Music Bed “featured artist” page.

MARMOSET V. THE MUSIC BED

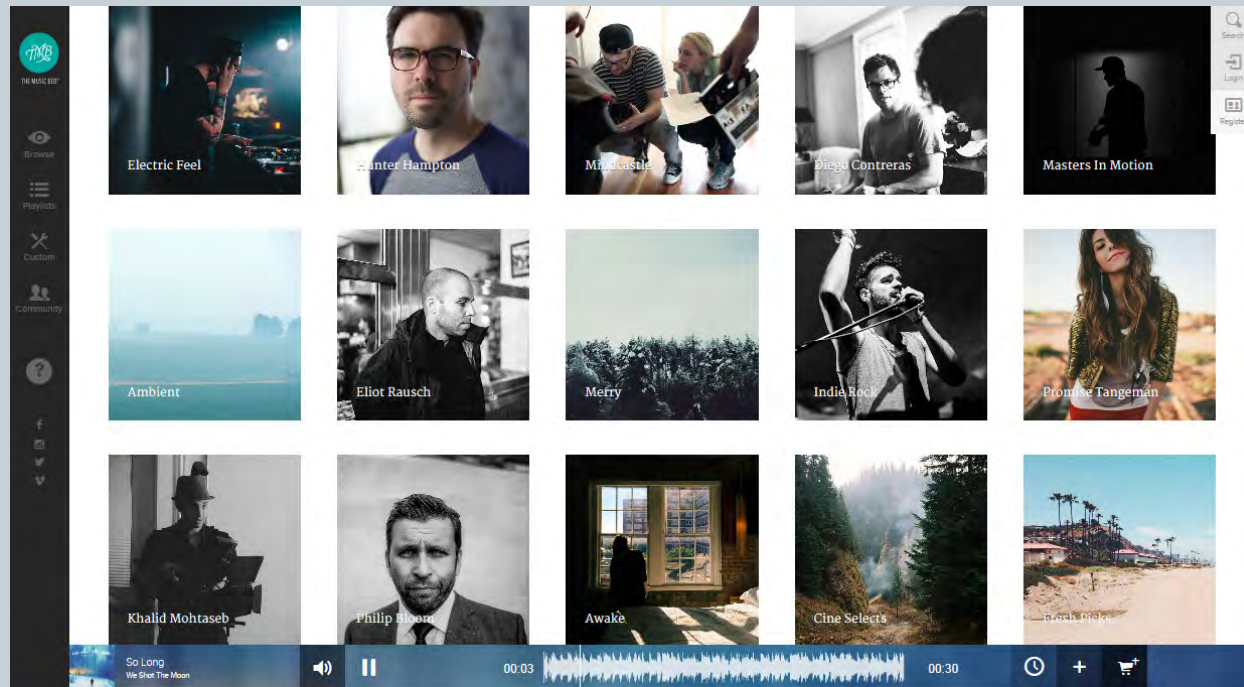
34



Marmoset “mix tapes” page, with radio music player at the bottom of page and featured images reflecting the story-driven, narrative approach underlying the website.

MARMOSET V. THE MUSIC BED

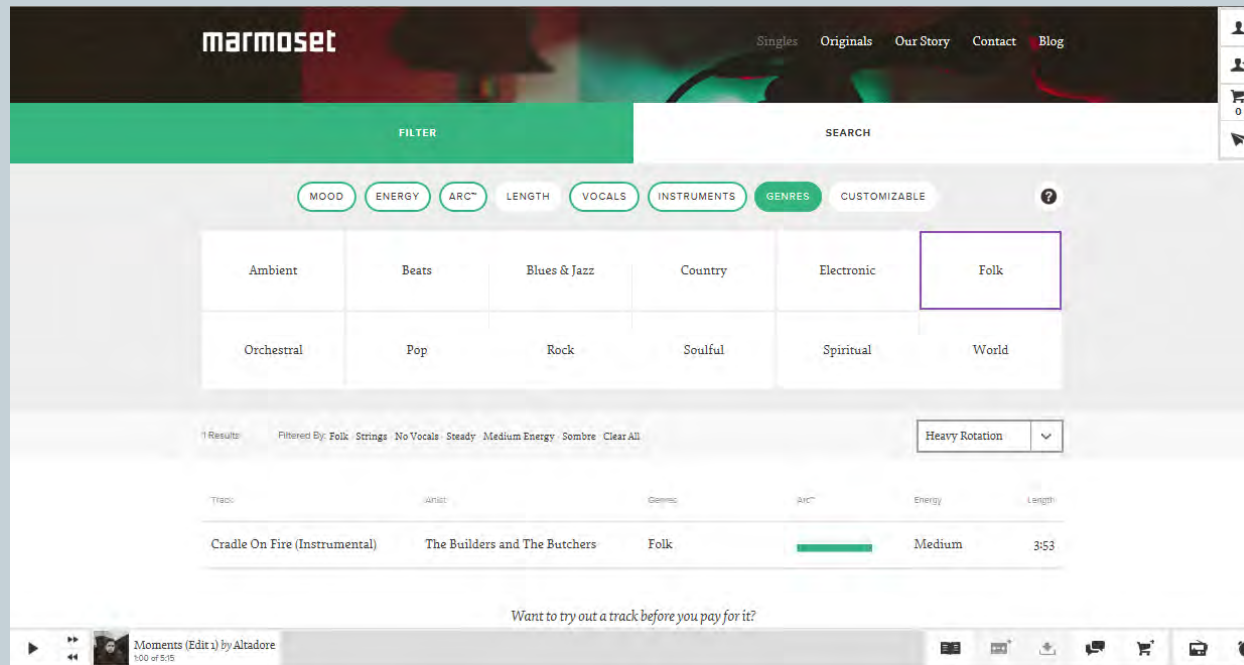
35



The Music Bed playlist page.

MARMOSET V. THE MUSIC BED

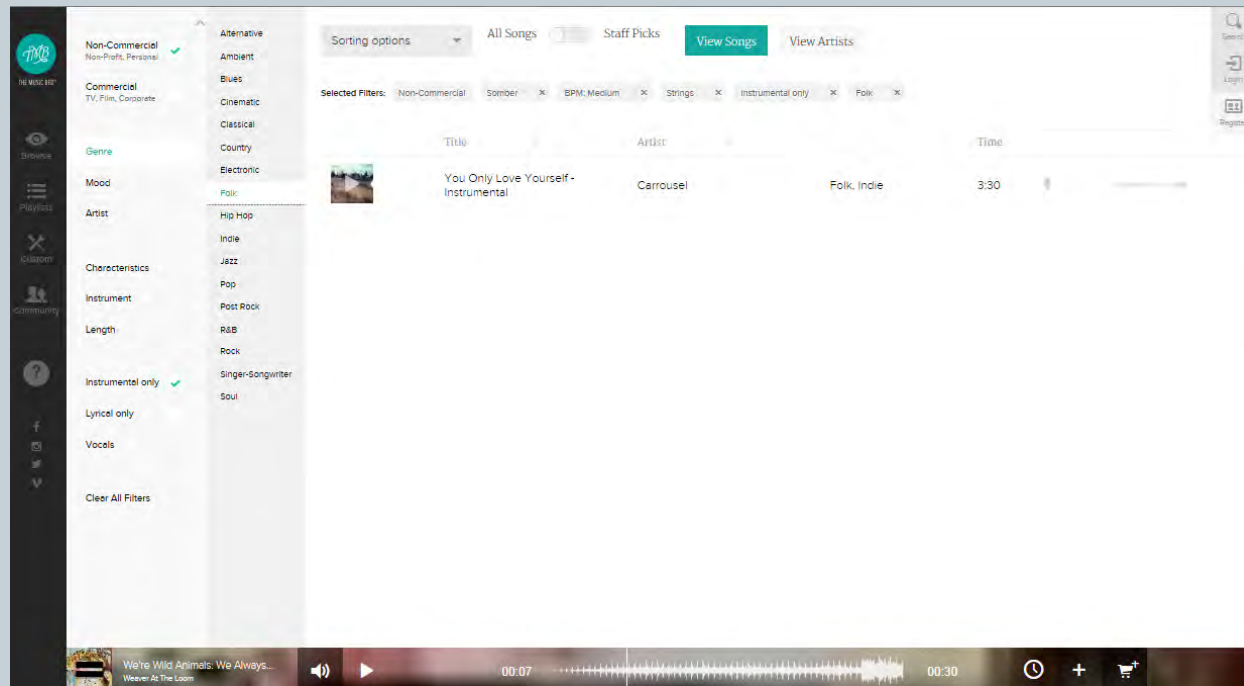
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Marmoset website, featuring music filtering and search functions highlighting music genres, moods, energy filters, instrument filters, etc.

MARMOSET V. THE MUSIC BED

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The Music Bed search page.

A FEW WORDS ABOUT COPYRIGHT

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