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Note

Protecting Internet Trade Dress: What To Do About Product Configurations?

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Protecting Internet Trade Dress: What To Do About Product Configuration?*

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I. INTRODUCTION

1. The Internet and the World Wide Web offer a nearly limitless range of practical uses and potential opportunities for profit.¹ The Internet is a new outlet through which cyberspace entrepreneurs offer a variety of goods and services.² The individual designs, features, and identifying characteristics of the goods and services, which cyberspace entrepreneurs offer via virtual “storefronts,” deserve similar legal protection as their tangible counterparts in the physical world. Trademark and trade dress law protects such individual designs, features, and identifying characteristics for physical products and services. Some circuit courts’ interpretations of trade dress law, however, if applied to Internet “storefronts” without first accounting for the Internet’s unique qualities, suggest that trade dress protection will not be available in cyberspace and, in fact, may be more difficult to obtain for Internet-based products and services. The application of these courts’ interpretations to Internet products insufficiently protects product trade dress and is at odds with existing trade dress policy.

2. Part II of this note is a brief discussion of the general policies which trade dress law furthers and why those policies may apply to the trade dress of Internet sites, followed by an overview of the present conflict among the circuit courts on this issue. The conflict among the circuits centers on the characterization of a product’s trade dress as either packaging or product configuration. Product packaging refers to the manner and overall appearance of a product’s packaging, as distinct from the

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¹ See Michael J. Schallop, *Protecting User Interfaces: Not As Easy as 1-2-3*, 45 EMORY L.J. 1533, 1534 n.1 (1996) (citing INT’L TRADE ADMIN., U.S. DEPT. OF COMMERCE, U.S. GLOBAL TRADE OUTLOOK 1995-2000: TOWARD THE 21ST CENTURY, at 134-35 (1995)) (stating that from 1991 to 1994, the computer software market was one of the fastest growing sectors in the economy); Steven Schortgen, Note, “*Dressing*” Up Software Interface Protection: The Application of Two Pesos to “*Look and Feel*,” 80 CORNELL L. REV. 158, 160 n.7 (1994) (citing Victoria Slind-Flor, “*Trade Dress*’ Seen to Protect Trademarks: Computer Software Producers Seek Additional Safeguards,” NAT’L L.J., May 17, 1993, at 1) (noting that in 1991, information technology sales grossed over \$234 billion).

² The World Wide Web now provides individuals with the ability to purchase nearly everything from books to airline tickets and even automobiles.

product itself.³ Product configuration, on the other hand, refers to the specific design of the product, as opposed to any extrinsic features, such as its packaging.⁴ Circuits that follow this dichotomy grant trade dress protection more readily for product packaging than for product design, whereas circuits that disclaim the existence of a dichotomy provide trade dress protection based only on the requirements for product packaging.

3. Part III first discusses the unique properties of the Internet that make application of current trade dress law and the packaging/configuration dichotomy problematic. It next examines the problems that will arise, in view of these unique qualities, if courts apply current trade dress law to the Internet. Part IV suggests a possible solution to these problems, in light of recent developments in trade dress legislation that take into account both the inherent features of the Internet as well as the general policies underlying trade dress law.

II. Trade Dress Law

A. Trade Dress Law and Policies

4. Courts have generally defined trade dress as the overall “total image of a product;” it includes “features such as size, shape, color or color combinations, texture, graphics, even particular sales techniques” used to market a product.⁵ For the most part, trade dress law finds its origin in trademark law, and section 43(a) of the Lanham Act lists its statutory protections.⁶ One of the underlying policies of the Lanham Act is to protect the owner of a mark from the deceptive and unfairly competitive practices of others.⁷ Protecting a mark ensures that the mark’s owner will receive the benefits of his investment in building and maintaining consumer goodwill in the mark. Protecting marks further encourages competition by securing

³ See *Fun-Damental Too, Ltd. v. Gemmy Indus. Corp.*, 111 F.3d 993, 1000-01 (2nd Cir. 1997).

⁴ See *Landscape Forms, Inc. v. Columbia-Cascade Co.*, 113 F.3d 373, 378-79 (2nd Cir. 1997).

⁵ *John H. Harland Co. v. Clarke Checks, Inc.*, 711 F.2d 966, 980 (11th Cir. 1983) (quoting the district court’s jury instructions); see also *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 764 n.1 (1992).

⁶ See 15 U.S.C. § 1125(a) (1996) (“Any person who, on or in connection with *any goods or services, or any container for goods*, uses . . . any word, term, name, symbol or device, or any combination thereof . . . shall be liable in a civil action . . .”) (emphasis added).

⁷ See 15 U.S.C. § 1127 (“The intent of this chapter is to regulate commerce . . . by making actionable the deceptive and misleading use of marks; . . . to protect persons engaged in such commerce against unfair competition; to prevent fraud and deception . . .”); 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 5:4, at 5-13 (4th ed. 1997) (“[T]rademark infringement ‘inhibits competition’ and ‘subverts both goals of the Lanham Act’ by . . . depriving consumers of the ability to distinguish among goods of competing manufacturers.”).

the benefits of a good reputation to its owner.⁸ Additionally, the Lanham Act's protection of intellectual property rights also serves the general public policy of protecting consumers from deceptive trade practices that result in consumer confusion as to the source of goods and services.⁹ This protection allows consumers to distinguish between those goods and services with which they trust the source and quality and for which they are repeat customers, and those products having a source and quality they wish to avoid. Because a product's trade dress may also identify for a consumer the product's source and, therefore, has some commercial significance to its owner, the rationales for protecting trademarks also justify protecting trade dress.¹⁰

5. Although the Lanham Act does not specifically mention trade dress, the fact that trade dress serves similar source-identifying functions as trademarks has led courts to look to trademark law when developing a framework for the protection of trade dress.¹¹ The availability of trademark protection depends primarily on the level of distinctiveness accorded to the mark. The landmark decision, *Abercrombie & Fitch Co. v. Hunting World*, set forth the accepted test for distinctiveness, delineating the so-called *Abercrombie factors*: whether a mark is arbitrary, fanciful, suggestive, descriptive, or generic.¹² Protection is given to those marks that are inherently distinctive, which are marks that are arbitrary, fanciful, or suggestive.¹³ Generic marks never receive protection.¹⁴ Descriptive marks receive protection if they achieve secondary meaning, which is an association or form of source-identification that accrues over time in the minds of consumers.¹⁵ The

⁸ See *Two Pesos*, 505 U.S. at 774 ("Protection of trade dress . . . serves the Act's purpose to 'secure to the owner of the mark the goodwill of his business and to protect the ability of consumers to distinguish among competing producers. . . . [T]rademarks foster competition and the maintenance of quality").

⁹ See *id.*

¹⁰ See *id.* (stating that there is no "textual basis in § 43(a) for treating inherently distinctive trademarks differently from inherently distinctive trade dress").

¹¹ See *id.* at 770 (holding that "[t]here is no persuasive reason to apply to trade dress a general requirement of secondary meaning which is at odds with the principles generally applicable to infringement suits under § 43(a)").

¹² See *Abercrombie & Fitch Co. v. Hunting World*, 537 F.2d 4, 9 (2nd Cir. 1976).

¹³ See *id.* at 11 (discussing methods of protecting suggestive marks and stating that "[i]t need not be added that fanciful or arbitrary terms enjoy all the rights accorded to suggestive terms . . .").

¹⁴ See *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 116-119 (1938).

¹⁵ See *id.* at 118, cited in *Inwood Lab., Inc. v. Ives. Lab., Inc.*, 456 U.S. 844, 851, n.11 (1982) (stating that to demonstrate secondary meaning a manufacturer must show that "in the minds of the public, the primary significance of a product feature or term is to identify the source of the product rather than the product itself). See also RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 13 cmt. e

manufacturer or trademark owner can use surveys and extensive advertising to prove such acquired meaning.¹⁶ To prove infringement of a mark deserving protection, there are two other prerequisites in addition to the distinctiveness inquiry: a mark must be nonfunctional and some likelihood of confusion must exist.¹⁷

6. Although courts have consistently followed the *Abercrombie* framework when adjudicating trademark disputes, the outcome of product trade dress disputes prior to 1992 was somewhat more difficult to predict. Prior to the United States Supreme Court's decision in *Two Pesos, Inc. v. Taco Cabana, Inc.*, lower courts differed as to whether trade dress protection required secondary meaning, despite a showing of inherent distinctiveness.¹⁸ Some circuits held a product's trade dress, though inherently distinctive, did not receive protection unless secondary meaning could be shown.¹⁹ In other circuits, a product's trade dress, like a trademark, did receive protection upon a mere showing of inherent distinctiveness.²⁰

7. In *Two Pesos*, the Supreme Court resolved a trade dress dispute involving competing Mexican fast-food restaurant designs, both of which incorporated similar

(Tentative Draft No. 2, 1990) ("Although secondary meaning may sometimes be inferred from evidence of long and continuous use, no particular length of use is required.").

¹⁶ See *Stuart Hall Co. v. Ampad Corp.*, 51 F.3d 780, 789 (8th Cir. 1995) (considering such factors as consumer surveys, expenditures on advertising, and other anecdotal evidence showing consumer identification of source); *Duraco Prods., Inc. v. Joy Plastic Enters., Ltd.*, 40 F.3d 1431, 1452 (3rd Cir. 1994) (stating that the plaintiff failed to show consumer association in its surveys and insufficiently emphasized its Grecian urns' trade dress in advertisements to support a finding of secondary meaning); *Aromatique, Inc. v. Gold Seal, Inc.*, 28 F.3d 863, 870 (8th Cir. 1994) (holding that the defendant's copying of the plaintiff's trade dress for potpourri packaged in pillow-shaped double bags, without circumstantial evidence of duration of advertising or consumer surveys, was insufficient to constitute secondary meaning.); *International Jensen, Inc. v. Metrosound U.S.A.*, 4 F.3d 819, 824-25 (9th Cir. 1993) (reporting the lower court's decision that the plaintiff's efforts at creating consumer association with its speakers was ineffective in creating acquired meaning).

¹⁷ See *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 769 (1992).

¹⁸ Compare *Chevron Chemical Co. v. Voluntary Purchasing Groups, Inc.*, 659 F.2d 695, 702 (5th Cir. 1981) (holding that secondary meaning is not required if the trade dress is distinctive) with *Vibrant Sales, Inc. v. New Body Boutique, Inc.*, 652 F.2d 299, 303 (1981) (holding that secondary meaning is required even if the trade dress is inherently distinctive).

¹⁹ See, e.g., *Merchant & Evans, Inc. v. Roosevelt Bldg. Prods. Co.*, 963 F.2d 628, 633 (3rd Cir. 1992) (requiring distinctiveness, secondary meaning, and likelihood of consumer confusion for trade dress protection).

²⁰ See, e.g., *Fuddrucker's, Inc. v. Doc's B.R. Others, Inc.*, 826 F.2d 837, 843 (9th Cir. 1987) (noting the appeal of not requiring secondary meaning in the distinctiveness test, though the Court does not resolve the issue); *Blau Plumbing, Inc. v. S.O.S. Fix-it, Inc.*, 781 F.2d 604, 608 (7th Cir. 1986) (finding that secondary meaning is not required if trade dress is distinctive); *Ambrit, Inc. v. Kraft, Inc.*, 805 F.2d 974, 979 (11th Cir. 1986) (stating the same).

design elements.²¹ The Court resolved the circuit courts' split by holding that section 43(a) of the Lanham Act made no distinction between trade dress and trademarks.²² A product's trade dress, like a trademark, need not have secondary meaning if it is inherently distinctive.²³ The Court held that requiring secondary meaning for inherently distinctive trade dress, under section 43(a), would undermine the Lanham Act's purposes.²⁴ Such a requirement, rather than advancing the Lanham Act's goal of encouraging competition, "could have anti-competitive effects, creating particular burdens on the startup of small companies."²⁵

8. *Two Pesos* provides a useful framework for justifying and formulating trade dress protection for Internet-based products. The Court in *Two Pesos* ultimately held that trade dress may protect a particular restaurant's design, decor, and overall impression in the mind of a consumer, provided it is inherently distinctive.²⁶ The particular design of an Internet web page or interface, which allows a user to obtain a business's services, is analogous to the product configuration of the Mexican restaurant protected in *Two Pesos*. Virtual "storefronts" and their contents, arrangement, and decor only differ from their three-dimensional shop and restaurant counterparts in their physicality. For the same reasons that cyber-trademarks receive equal protection as physical trademarks,²⁷ Internet trade dress should receive the same protection as physical trade dress.

9. Subsequent to the *Two Pesos* decision, however, the circuit courts began to fundamentally disagree as to what constitutes inherently distinctive trade dress.²⁸ This conflict has serious implications on the question of whether Internet products

²¹ See *Two Pesos*, 505 U.S. at 774.

²² See *id.* at 773.

²³ See *id.* at 773-74.

²⁴ See *id.* at 774 (stating that the additional requirement "would hinder improving or maintaining the producer's competitive position").

²⁵ See *id.* at 775.

²⁶ See *id.* at 776.

²⁷ See Alan J. Hartnick, *Copyright & Trademark on the Internet - and Where to Sue*, N.Y. L.J., Feb. 2, 1997, at 5 (discussing available trademark protection for Internet domain names and other cybermarks).

²⁸ Compare *Stuart Hall Co. v. Ampad Corp.*, 51 F.3d 780, 788 (8th Cir. 1995) (applying the *Abercrombie* factors to determine inherent distinctiveness), with *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996, 1008 (2nd Cir. 1995) (applying a more rigid standard), and *Duraco Prods., Inc. v. Joy Plastics Enters., Ltd.*, 40 F.3d 1431, 1448-49 (3rd Cir. 1994) (applying a separate, more rigid standard).

may obtain trade dress protection. Like the design and decor of the Mexican restaurant at issue in *Two Pesos*, an Internet Web site's trade dress and virtual "storefront" serve to identify for the consumer the source of the site's services. Trade dress protects consumer recognition of the goods and services' source and ensures that the trade dress owner secures the returns on her investment in building and maintaining the goodwill associated with the trade dress.²⁹ Based on these purposes, there appears to be little reason for denying Internet-based trade dress the same protection that physical goods and services' trade dress enjoys.

B. The Circuit Court Conflict

10. Although the *Two Pesos* decision clearly required secondary meaning, in addition to a showing of inherent distinctiveness for trade dress protection, it was silent as to what constituted distinctive trade dress.³⁰ The Court approvingly cited the traditional *Abercrombie* factors, but merely assumed that the Fifth Circuit was correct in holding the trade dress at issue was inherently distinctive.³¹ Although one could imply from the Court's application of the *Abercrombie* factors that the court was approving those factors as determinative of trade dress distinctiveness, some post-*Two Pesos* circuit court decisions have held otherwise.

11. In *Duraco Products v. Joy Plastic Enterprises, Ltd.*, the Third Circuit did not apply the *Abercrombie* factors and denied trade dress protection to a particular Grecian urn design because it was not inherently distinctive.³² The Third Circuit distinguished *Two Pesos*, stating that *Two Pesos* involved product packaging while *Duraco* involved product configuration.³³ The court concluded that a product's configuration could not be arbitrary or fanciful in relation to the product itself.³⁴ The Third Circuit developed its own standard for determining product configuration distinctiveness: a product's configuration must be "(i) unusual and memorable; (ii) conceptually separable from the product; and (iii) likely to serve primarily as a designator of origin of the product."³⁵ The Third Circuit's test, which requires

²⁹ See *supra* text accompanying notes 7-9.

³⁰ See Schortgen, *supra* note 1, at 189; Jenny Johnson, *Two Pesos, Inc. v. Taco Cabana, Inc.: The Supreme Court's Expansion of Trade Dress Protection Under Section 43(A) of the Lanham Act*, 24 LOY. U. CHI. L.J. 285, 301 (1993) ("[T]he majority declined to decide what makes a product's trade dress distinctive and what amount of copying is necessary to constitute infringement.").

³¹ See *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 766-70 (1992).

³² See *Duraco Products v. Joy Plastic Enters., Inc.*, 40 F.3d 1431, 1451 (3rd Cir. 1994).

³³ See *id.* at 1442.

³⁴ See *id.* at 1440-41.

³⁵ *Id.* at 1448-49.

product configurations to be memorable or serve *primarily* as an indicator of source, essentially reinstated a secondary meaning requirement for inherent distinctiveness in product configuration cases.³⁶

12. In *Stuart Hall Co. v. Ampad Corp.*, the Eighth Circuit responded to the Third Circuit's distinction of *Two Pesos* by holding that *Two Pesos* was controlling authority in both product configuration and packaging cases.³⁷ The Eighth Circuit found that *Two Pesos* involved product configuration as well as packaging, and interpreted the Supreme Court's silence regarding the product packaging/configuration dichotomy as an indication that trade dress is a singular concept encompassing both packaging and configuration.³⁸ The Eighth Circuit held that the distinction between a product's packaging and configuration was largely irrelevant in determining a product's distinctiveness.³⁹ Courts should evaluate a product's distinctiveness should be evaluated against a continuum of possibilities, rather than one exclusive category or another.⁴⁰ Thus, in the Eighth Circuit's view, products such as restaurants and Internet "storefronts" incorporate aspects of both packaging and configuration.

13. The Eighth Circuit also found the Third Circuit's deviation from *Two Pesos* erroneous because it failed to distinguish inherent distinctiveness from secondary meaning, collapsing the two elements into one requirement of secondary meaning.⁴¹ The Third Circuit's "memorableness" and likelihood of consumer recognition elements become closer to "actual consumer recognition," an important factor for achieving secondary meaning.⁴² Accordingly, the Eighth Circuit disagreed with the Third Circuit's approach.

14. In *Knitwaves Inc. v. Lollytogs Ltd.*, the Second Circuit sided with the Third Circuit, but developed its own test for distinctiveness.⁴³ The court held that

³⁶ See *Stuart Hall Co., Inc. v. Ampad Corp.*, 51 F.2d 780, 788 (8th Cir. 1995) (stating that the *Duraco* test "would undermine *Two Pesos*" by requiring inherently distinctive trade dress to show secondary meaning).

³⁷ See *id.* at 787.

³⁸ See *id.* at 788 ("[A] product's trade dress is not the entire product itself, but specific features of the product; we find no difficulty in looking at a specific feature of a product and determining whether and to what degree the feature is dictated by the nature of the product.").

³⁹ See *id.*

⁴⁰ See *id.* (stating that some trade dress, such as restaurant decor, will include either product configurations and packaging, or both).

⁴¹ See *id.* (stating that the *Duraco* test would "bear a very close resemblance to the standard for secondary meaning").

⁴² See *id.*

⁴³ 71 F.3d 996, 1008 (2nd Cir. 1995).

for a product configuration to be distinctive, the product's features must primarily serve as a designation of the product's origin.⁴⁴ The *Knitwaves* test also considers whether a claimant intends a product's design to identify its source.⁴⁵ In *Krueger International, Inc. v. Nightingale Inc.*, however, a district court in the Second Circuit rejected *Knitwaves* and criticized its test as inconsistent with *Two Pesos*.⁴⁶ The district court stated that the *Two Pesos* decision did not provide a legal foundation for *Knitwaves's* intent element and that the *Knitwaves* test erroneously forced courts to determine distinctiveness based on a product's aesthetic or source-identifying function.⁴⁷ The *Krueger* court ultimately decided that *Seabrook Foods, Inc. v. Bar-Well Foods Ltd.*⁴⁸ set the proper test for distinctiveness.⁴⁹ The *Krueger* test, adopting *Seabrook Foods*, requires a court to consider whether a particular product design is so unique within its market that the product owner can assume, without proof of secondary meaning, that consumers will automatically perceive the design as an indicium of origin.⁵⁰

15. Because distinctiveness "cannot be considered in a vacuum"⁵¹ outside a product's market, the *Krueger* test effectively demands that the courts in the Second Circuit determine distinctiveness on a case-by-case basis.⁵² Under this test, a product is inherently distinctive if its design or features differ significantly from that of its competitors. Thus, in the stackable chairs market,⁵³ a particular chair design that immediately causes a consumer to distinguish the chair from others in the market can be considered inherently distinctive. Conversely, in the fall fashion-

⁴⁴ See *id.* (holding that the plaintiff's sweater designs were not likely to serve primarily as a designator of origin and, thus, were not inherently distinctive).

⁴⁵ See *id.* at 1009 (holding that the plaintiff's sweater designs were not primarily intended as source identifiers and, thus, failed to qualify for protection).

⁴⁶ See *Krueger Int'l, Inc. v. Nightingale Inc.*, 915 F. Supp. 595 (S.D.N.Y. 1996).

⁴⁷ See *id.* at 602. ("*Knitwaves's* new test for inherent distinctiveness confuses the analytical requirements for inherent distinctiveness with those of secondary meaning.>").

⁴⁸ 568 F.2d 1342 (C.C.P.A. 1977).

⁴⁹ See *Krueger*, 915 F. Supp. at 603.

⁵⁰ See *id.*

⁵¹ *Id.*

⁵² See *id.*; see also *Thompson Med. Co. v. Pfizer Inc.*, 753 F.2d 208, 213 (2d Cir. 1985) ("[T]he determination whether a mark is descriptive or suggestive cannot be made in a vacuum; it is necessary to surmise the mental processes of those in the marketplace at whom the mark is directed.>").

⁵³ See *Krueger*, 915 F. Supp. at 598.

wear market,⁵⁴ sweaters with autumn or “leaf” motifs may not be immediately distinguishable to consumers and thus, not protected.

16. In *Landscape Forms v. Columbia Cascade Co.*,⁵⁵ the Second Circuit expressed concern over the Second Circuit’s previous *Knitwaves* and *Fun-Damental Too, Ltd. v. Gemmy Industries Corp.* decisions.⁵⁶ The Second Circuit’s *Landscape Forms* opinion discussed the compatibility of *Seabrook* and *Knitwaves* and sought to close any remaining gaps between *Knitwaves* and prior cases, such as *Fun-Damental Too*, by generally reiterating fundamental trade dress policy.⁵⁷ The court justified its decision on broad policy considerations and held that the *Knitwaves* analysis was appropriate because it ultimately furthered the underlying policy of protecting competition.

17. Although the Supreme Court, in *Two Pesos*, intended to accord trade dress the same protection as trademarks under section 43(a) of the Lanham Act, the Court did not set forth a framework for determining inherent distinctiveness.⁵⁸ The absence of a unified framework created the present split in the circuit courts. *Two Pesos* affirmed and validated the Fifth Circuit’s approach. The Second and Third Circuits, however, use a packaging/configuration distinction and distinctiveness test that resembles a secondary meaning test and circumvents the *Two Pesos*’s holding. The later approach essentially marks a return to a pre-*Two Pesos* methodology for determining distinctiveness and trade dress protection.

18. The current circuit court conflict has important implications for Internet trade dress protection. The conflicting policies fail to offer any significant guidance to Internet entrepreneurs as to how they can protect their investments. Under the Fifth Circuit and *Krueger* approach, no significant problems are likely to arise in determining trade dress protection because this approach follows existing trademark law practices. Furthermore, if courts treat Web site “storefronts” or layouts of Internet-based products as product packaging, few problems will likely arise because this approach would rely on the *Abercrombie* factors, which are already accepted. The problem addressed by this Note arises when a court views an Internet storefront as product configuration, in which case trade dress protection will be difficult, if not impossible, to obtain, due to the Internet’s unique qualities or

⁵⁴ See *Knitwaves Inc. v. Lollytogs Ltd.*, 71 F.3d 996 (2nd Cir. 1995) (action brought alleging, *inter alia*, trade dress infringement of sweaters with “squirrel” and “leaf” designs).

⁵⁵ 113 F.3d 373 (2nd Cir. 1997).

⁵⁶ 111 F. 3d 993 (2d Cir. 1997) (applying the *Abercrombie* test and rejecting the *Seabrook* test in the product packaging context); see also Robert C. Scheinfeld & Parker H. Bagley, *Trade Dress Update*, N.Y. L.J., July 23, 1997, at 3 (stating that the Second Circuit has appeared to soften the *Knitwaves* test in response to criticisms made in *Krueger*).

⁵⁷ See *Landscape Forms*, 113 F.3d at 380 (holding that the court’s decision in *Knitwaves* was consistent with the policy in *Abercrombie*).

⁵⁸ See *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 770 (1992).

“fluidity.” Part III will discuss the Internet’s unique qualities, the difficulty in characterizing Internet products as packaging or configuration, and these items’ effects on the packaging/configuration dichotomy and the availability of Internet trade dress protection.

III. PROBLEMATIC PROPERTIES OF THE INTERNET AND THE INADEQUACIES OF EXISTING LAW

A. Problematic Properties of the Internet

19. The product configuration/packaging distinction that underlies the conflict between the circuit courts has a significant impact on the application of trade dress law to the Internet. The question of whether a particular Internet-based product, service, or Web page constitutes configuration or packaging and, therefore, requires a showing of inherent distinctiveness will greatly impact the availability of trade dress protection for the respective item. Any serious discussion of the application of the configuration/packaging dichotomy to the Internet must begin with a consideration of the Internet’s characteristics and how those characteristics make applying the packaging/configuration methodology difficult.

20. In the context of this discussion, the Internet’s most important characteristic is its ability to allow programmers to update Web sites or online services at any time and with minimal cost, due to its intangible and electronic nature. This characteristic, which this Note calls “fluidity,” underlies the central barrier to extending trade dress protection to the Internet. The trade dress of physical objects does not possess fluidity, and this distinction has important implications for the formulation of Internet trade dress law.⁵⁹ For example, unlike automotive designs,⁶⁰ restaurant designs,⁶¹ chair designs,⁶² or the designs of other products that mostly remain static or unaltered over a relatively lengthy period of time, the designs of Internet-based products exist in a medium that is constantly changing and, therefore, can continuously change themselves.

⁵⁹ See generally, Schortgen, *supra* note 1, at 175 n.88 (“The computer industry tends to exhibit super-fluidity because information and programming techniques typically disseminate quickly throughout the entire market.”).

⁶⁰ See *Esercizio v. Roberts*, 944 F.2d 1235 (6th Cir. 1991) (holding that an automobile’s design was protected trade dress).

⁶¹ See *Two Pesos*, 505 U.S. at 763.

⁶² See *Krueger Int’l, Inc. v. Nightingale Inc.*, 915 F. Supp. 595 (S.D.N.Y. 1996) (holding that a distinctive chair design was protected trade dress).

21. The software companies that create Internet browsers⁶³ and Internet Service Providers (ISPs)⁶⁴ continue to introduce technological advances and update services nearly every year,⁶⁵ constantly altering the manner in which a Web site programmer, and ultimately the consumer, interacts with the Internet. A Web page designer may use virtual “frames” to divide and organize her Web page.⁶⁶ A site designer may also incorporate any number of innovative proprietary “plug-ins”⁶⁷ and “applets,”⁶⁸ which increase a site’s “virtual-ness” and enhance a Web site visitor’s experience. Although the use of similar programming and design devices will not by itself violate another’s trade dress, the use of the same devices in conjunction with other visual and audio displays *when considered as a whole* may violate the trade dress of a site that provides similar goods or services.

22. The fundamental objectives of trademark and trade dress law are to prevent consumer confusion and protect source identification.⁶⁹ The achievement of these goals is greatly affected by fluidity. The Internet’s fluidity will likely complicate the determination of whether consumers identify a product’s source through its design. Source identification of a product generally requires distinctiveness; a product is either inherently distinctive or acquires distinctiveness by achieving secondary meaning in the mind of ordinary consumers.⁷⁰ Fluidity is unlikely to affect the determination of inherent distinctiveness because inherent

⁶³ Internet browser software companies generally provide the software through which the user interacts with the Internet.

⁶⁴ America On-Line and Prodigy are examples of ISPs.

⁶⁵ Browser software companies such as Netscape and Microsoft continually make minor updates to existing browser software that repair prior glitches and bugs. Netscape, Inc. released Netscape Communicator Version 4.00 in the Fall of 1997. As of this writing, Communicator 4.0.4 is available for download at <http://www.netscape.com>.

⁶⁶ See BRYAN PFAFFENBERGER, *WORLD WIDE WEB BIBLE* 571 (2d ed. 1996) (describing frames as “tags for dividing . . . HTML documents into independently scrollable panels”). Both Netscape Navigator and Microsoft Explorer can read frames. See also Matt Jackson, *Linking Copyright to Homepages*, 49 FED. COMM. L.J. 731, 739 (1997) (stating that frames allow a programmer to create “windows” within his web page, which allows users to view other pages within the “window” while staying within the confines of the original web page).

⁶⁷ See PFAFFENBERGER, *supra* note 66, at 193 (defining “plug-ins” as an “add-on program that expands your browser’s capabilities, enabling it to deal with specific types of multimedia”). Examples of plug-ins include VDOLive (streaming video clips), RealAudio (streaming, real-time audio), and Shockwave (graphical animation clips).

⁶⁸ See CURTIS E. A. KARNOW, *FUTURE CODES: ESSAYS IN ADVANCED COMPUTER TECHNOLOGY AND THE LAW* 34 (1997) (defining “applets” as small multimedia programs using Sun Microsystems’s Java programming language).

⁶⁹ See *Two Pesos, Inc. v. Taco Cabana, Inc.* 505 U.S. 763, 773 (1992).

⁷⁰ See *id.* at 769.

distinctiveness generally requires only an “immediate effect” impression in consumers’ minds.⁷¹ Secondary meaning, conversely, is only achieved over time.⁷² Five years exclusive presence of a product in a specific market is prima facie evidence of secondary meaning under § 43(a) of the Lanham Act.⁷³ Additionally, evidence of consumer surveys and product advertising can be used to prove secondary meaning.⁷⁴

23. Any trade dress requirement that includes a time factor is problematic if product designers are able to change their products overnight.⁷⁵ Secondary meaning may be nearly impossible to prove if an Internet-based product is not inherently distinctive, and if the time required for consumer recognition remains a relevant legal consideration. Within hours a business’s Internet appearance, services, or manner of providing services may change and, within days or weeks, these aspects may change again.⁷⁶

24. Adequate methods for determining consumer recognition on the Internet are also absent. Traditional tools such as consumer surveys are difficult to apply and, when used, may yield faulty results. Polling consumers of online products and services requires the ability to locate significant numbers of consumers who not only have Internet access, but who also have encountered the particular product or service. Although “hit counters”⁷⁷ provide a rough estimate of the popularity of a particular web site, it is difficult to judge the significance of these numbers due to the uncertainty of whether each “hit” originated from separate or individual computers, or whether the site’s trade dress changed between hit totals. Furthermore, counters that track the location of each site visitor are equally unreliable because they only reveal information regarding the originating

⁷¹ See *Stuart Hall Co. v. Ampad Corp.*, 51 F.3d 780, 785 (8th Cir. 1995) (rejecting the notion that a manufacturer’s trade dress must be “striking” or “memorable” to be inherently distinctive).

⁷² See *Two Pesos*, 505 U.S. at 769.

⁷³ See 15 U.S.C. § 1052(f) (1996); see also *Stuart Hall*, 51 F.3d at 789.

⁷⁴ See cases cited *supra* note 16.

⁷⁵ Web pages are written in Hypertext Markup Language (“HTML”). HTML is easy to learn, and a programmer can quickly transform existing documents into HTML form for use on the Internet. See Andy Johnson-Laird, *The Internet: The Good, The Bad, and The Ugly*, in *THE CLA COMPUTER LAW COMPANION VOLUME III* 81, 100 (C. Ian Kyer & Christopher E. Erikson eds., 1996).

⁷⁶ See *id.*

⁷⁷ Hit counters are “add ons” that keep track of the number of times an outside source has accessed a particular web page. See John M. Willhite, Note, *NTN Communications v. Interactive Network: Denial of Copyright and Trademark Protection for Interactive Games*, 16 *LOY. L.A. ENT. L.J.* 789, 791 n.19 (1996).

computer, and not the computer user.⁷⁸ These counters cannot distinguish between hits resulting from one person visiting a site several times and multiple persons each visiting a site once from the same computer.⁷⁹

25. Evaluating the amount of advertising conducted for the product as an indicator of public recognition, in order to measure a product's consumer recognition, is somewhat less problematic. Selling Web "space" on a Web page is the equivalent of selling television commercials or newspaper advertisements. The Internet is different from these other media forms, however, because users may "hyperlink"⁸⁰ to other sites or bypass certain pages by "bookmarking"⁸¹ others. These capabilities pose a myriad of contract issues that are not the focus of this Note. Hyperlinking and bookmarking do have important implications for trade dress, however, because they contribute to the Internet's fluidity and the difficulty Internet businesses will experience if they must prove their product or service's consumer recognition to obtain trade dress protection. Unlike television commercials and newsprint advertisements, hyperlinking or bookmarking may severely cut a cyberspace billboard's audience. Television commercial and newsprint purchasers expect a reasonable return from their purchases. Although an Internet company may place advertisements on a multitude of Web pages, site visitors may not see the ads because the visitors can hyperlink away from or bookmark past the pages containing the ads.

26. The difficulty of measuring consumer source-identification demonstrates some of the problems Internet entrepreneurs face if they must prove that their products or services have acquired secondary meaning. The Internet's fluidity is the main source of these difficulties and should weigh heavily in any consideration of Internet trade dress law. In addition to the inadequacies of existing law that are discussed in part B below, fluidity clearly makes the application of the packaging/configuration dichotomy to Internet trade dress inappropriate. Courts must implement a methodology for determining inherent distinctiveness that accounts for the Internet's fluidity, if Internet-based products are going to receive adequate protection.

⁷⁸ A user's Internet Protocol (IP) address, which is like a phone number, defines a visitor's location. See Johnson-Laird, *supra* note 75, at 86.

⁷⁹ "There is no way of knowing how many users share access to a given computer or groups of computers." *Id.* at 88.

⁸⁰ "Hyperlinking" allows a user to access another Web site by clicking on the listing of the destination page's location. See THOMAS J. SMIDINGHOFF, *ONLINE LAW* 22, 454 (Thomas J. Smidinghoff ed. 1996).

⁸¹ "Bookmarking" a Web page creates a reference to that page so the visitor may quickly and directly access the particular page in the future.

B. Inadequacies of Existing Law

27. *Two Pesos* generally stands for the idea that a product's trade dress is entitled to the same protection as a product's trademark.⁸² The circuit courts' split, discussed above, has weakened this principle and eroded *Two Pesos's* authority.⁸³ In jurisdictions following the Second or Third Circuit tests for inherent distinctiveness, the parties' burdens are such that the mere characterization of the case as one involving product configuration or packaging will often be dispositive.⁸⁴ Conversely, in jurisdictions following the Eighth Circuit, the focus is not on the packaging/configuration question, but on the product's overall distinctiveness.⁸⁵

28. The Internet's intangible nature challenges the circuit courts' notions of configuration and packaging. In *Duraco Products, Inc. v. Joy Plastic Enterprises, Ltd.* and *Knitwaves, Inc. v. Lollytogs Ltd.*, the Third and Second Circuit courts, respectively, avoided directly conflicting with *Two Pesos* by characterizing a particular product feature as rooted in either design or packaging.⁸⁶ Products such as Grecian urns, in the view of one court, clearly involved product configuration,⁸⁷ whereas "toilet banks" implicated product packaging.⁸⁸ The packaging/configuration dichotomy, however, cannot be applied to Internet-based products because distinctions based on product packaging or configuration are fundamentally dependent on the physicality of the product they describe. In cyberspace, the consumer does not interact with physical Greek urns⁸⁹ or fall fashion sweaters,⁹⁰ but with virtual products over a graphical user interface

⁸² See *Stuart Hall Co. v. Ampad Corp.*, 51 F.3d 780, 787-88 (8th Cir. 1995) (interpreting *Two Pesos* as holding that inherently distinctive trade dress does not require any additional proof of secondary meaning).

⁸³ See *supra* Part II.B.

⁸⁴ See *Fun-Damental Too, Ltd. v. Gemmy Indus. Corp.*, 111 F.3d 993, 999, 1001 (2nd Cir. 1997) (finding the "toilet bank's" trade dress to be packaging and protected); *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996, 1009 (2nd Cir. 1995) (finding sweaters' design was not trade dress and not protected product design); *Duraco Prods. v. Joy Plastic Enters., Ltd.*, 40 F.3d 1431, 1440-41 (3rd Cir. 1994) (finding that the trade dress of Grecian urns constituted product configuration).

⁸⁵ See *Stuart Hall*, 51 F.3d at 787-88.

⁸⁶ See *Knitwaves*, 71 F.3d at 1009; *Duraco Prods.*, 40 F.3d at 1440-41.

⁸⁷ See *Duraco Prods.*, 40 F.3d at 1440-41.

⁸⁸ See *Fun-Damental Too*, 111 F.3d at 1001.

⁸⁹ See generally *Duraco Prods.*, 40 F.3d at 1431.

⁹⁰ See generally *Knitwaves*, 71 F.3d at 996.

(“GUIs”)⁹¹ or services such as real-time stock trading⁹² and online gaming.⁹³ Thus, courts that rely on the product packaging/configuration distinction are faced with the problem of maintaining uniform trade dress rules as applied to both physical and virtual products.

29. It is, in fact, conceptually difficult to ascertain how the product packaging/configuration distinction can remain viable in cyberspace. The difficulty experienced when applying the distinction provides support for the proposition that such a distinction is no longer valid and should be abandoned. As applied to physical objects, the dichotomy is justified only if a product’s configuration is less likely to denote the product’s source than the product’s packaging.⁹⁴ For example, in *Fun-Damental Too*, “toilet banks” were displayed in packaging⁹⁵ that indicated the manufacturer, or source, of the product, whereas in *Duraco* and *Krueger International*, the chairs or urns at issue were rarely packaged and, therefore, less likely to indicate source.⁹⁶ Furthermore, the justification for creating separate tests or burdens depends on the ability of the courts to characterize products as involving configuration or its packaging. With regard to Internet products, the question arises, “What constitutes packaging for intangible products?” Consider software companies that provide their subscribers with the ability to play online games.⁹⁷ A customer interacts with the product via the company’s web site, which besides being the product itself, will likely provide product information. The Web page serves both dichotomy purposes: it acts as packaging prior to use, while the advertising function becomes secondary when the Web page becomes the gaming interface.

30. This note asserts that the judicial rationale underlying the present packaging/configuration distinction provides inadequate trade dress protection for Internet-based products. Part IV suggests that, in light of recent developments in trade dress legislation, policy considerations favor a unified trade dress law that

⁹¹ Graphical user interfaces (“GUIs”) are “supposed to make [a] computer easier to use by creating graphical objects such as *icons*, *buttons*, and *windows* for the user to interact with, rather than the sterile systems of text commands that preceded GUIs in the historical evolution of computer software.” PATRICK M. DILLON & DAVID C. LEONARD, *MULTIMEDIA TECHNOLOGY FROM A TO Z* 75 (1995).

⁹² See, e.g., *Charles Schwab* (visited Mar. 26, 1999) <<http://www.schwab.com>>; *Ameritrade* (visited Mar. 26, 1999) <<http://www.ameritrade.com>>.

⁹³ See, e.g., *Heat* (last modified Mar. 15, 1999) <<http://www.heat.net>>.

⁹⁴ See *Duraco Prods.*, 40 F.3d at 1440-41.

⁹⁵ See *Fun-Damental Too, Ltd. v. Gemmy Indus. Corp.*, 111 F.3d 993, 997-98 (2nd Cir. 1997).

⁹⁶ See *Duraco Prods.*, 40 F.3d at 1434; cf. *Krueger Int’l, Inc. v. Nightingale Inc.*, 915 F. Supp. 595, 607 (S.D.N.Y. 1996) (holding that a chair’s source indication lays in its design, not its packaging).

⁹⁷ See, e.g., *Heat*, *supra* note 93.

takes into account product market considerations, while at the same time implementing the traditional *Abercrombie* factors to determine trade dress distinctiveness for Internet products.

IV. A PROPOSED SOLUTION

A. The *Abercrombie* Test, Secondary Meaning, and Recent Developments

1. An *Abercrombie-Seabrook* Market Test

31. The packaging/configuration distinction is problematic for courts, which must choose a standard for determining whether a Internet product's trade dress is distinctive, and for Internet entrepreneurs and Web site designers, who wish to protect their products. Based on the difficulty of determining what specifically constitutes an Internet-based product's packaging and configuration, this Note proposes that the distinction be abandoned in favor of a standard that is grounded on the traditional *Abercrombie* factors, but that also accounts for the Internet's fluidity and market placement. Such a test would be more fully aligned with the central holding of *Two Pesos* and the underlying policy goals of trade dress law.

32. The *Duraco* and *Knitwaves* tests, which are primarily concerned with the problem of measuring a product's trade dress distinctiveness in circumstances where the trade dress is the product itself,⁹⁸ rely on whether a physical products' features are, among other things, unusual, memorable, and conceptually separable from the product.⁹⁹ These requirements confuse the traditional definition of inherent distinctiveness,¹⁰⁰ and commentators and courts criticize these requirements because they inject elements of secondary meaning into the inherent distinctiveness analysis.¹⁰¹

33. If courts apply the *Duraco/Knitwaves* tests to Internet products, the products may not obtain trade dress protection unless a claimant can successfully show that the product's features are conceptually separable from the product itself. Under such a test, trade dress protection would be available in only the most limited occasions. Requirements such as unusualness and memorableness are difficult to determine due to the Internet's fluidity. Fluidity affects the rate at which consumers are exposed to product features, as well as the rate at which consumers are exposed to multiple features of one product, because product designers can change a product's features easily and quickly.

⁹⁸ See *Duraco Prods.*, 40 F.3d at 1441; *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996, 1007 (2nd Cir. 1995).

⁹⁹ See *Duraco Prods.*, 40 F.3d at 1434.

¹⁰⁰ See *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2nd Cir. 1976).

¹⁰¹ See cases cited *supra* notes 36, 41, 47 and accompanying text.

34. If a product is inseparable from its trade dress, trade dress claimants may not need to show secondary meaning because of a default “exception” to the trade dress tests that is inherent to the packaging/configuration dichotomy. If, however, the *Duraco/Knitwaves* approach were to be applied directly to the Internet, this “exception” would essentially swallow the “rule.” Unlike physical objects, the features of a Web-based product cannot be conceptually separate from the product itself; the features are inherently part of the product. Thus, Internet products would never give rise to product packaging cases. Every Internet product case would involve product configuration instead of packaging, and where the claimant could not overcome the heavy burden of demonstrating memorableness and conceptual separability, trade dress protection would not be available.

35. This Note proposes that a standard for distinctiveness based on the *Abercrombie* factors would best advance Internet trade dress policy. Such a rule, modified to account for the Internet’s fluid nature, would better balance the need to prevent consumer confusion and to protect claimants’ investments with the policy of encouraging competition. Under this standard, Internet-based products would be considered inherently distinctive and accorded trade dress protection if, assuming the existence of any consumer confusion, it was shown to be arbitrary, fanciful, suggestive, or descriptive with secondary meaning.¹⁰² Internet-based products would similarly not receive trade dress protection if they were merely descriptive or generic.¹⁰³

36. The question still remains: What constitutes an arbitrary or fanciful trade dress if the design of the product or service sought to be protected is the product itself? To answer this inquiry, the approach set forth by the *Seabrook* court¹⁰⁴ and implemented in *Krueger*¹⁰⁵ is most helpful. Under *Seabrook*, courts determine arbitrariness, and thus distinctiveness, by analyzing whether a product is “a ‘common’ basic shape or design, whether it [is] unique or unusual in a particular field, whether it [is] a mere refinement of a commonly-adopted and well-known form or ornamentation for a particular class of goods viewed by the public as a dress or ornamentation for the goods, or whether it [is] capable of creating a commercial impression distinct from the accompanying words.”¹⁰⁶ This standard takes into account the notion that product designs cannot be considered

¹⁰² See *Abercrombie & Fitch*, 537 F.2d at 9.

¹⁰³ See *id.*

¹⁰⁴ See *Seabrook Foods, Inc. v. Bar-Well Foods Ltd.*, 568 F.2d 1342, 1344 (C.C.P.A. 1977).

¹⁰⁵ See *Krueger Int’l, Inc. v. Nightingale Inc.*, 915 F. Supp. 595 (S.D.N.Y. 1996).

¹⁰⁶ *Seabrook*, 568 F.2d at 1344. “In reality, all three questions are merely different ways to ask whether the design, shape or combination of elements is so unique, unusual or unexpected in this market that one can assume without proof that it will automatically be perceived by customers as an indicator of origin—a trademark.” MCCARTHY, *supra* note 7, § 8:13, at 8-33.

independently in the absence of a specific market.¹⁰⁷ Thus, for example, an online gaming company's graphical interface may be arbitrary, fanciful, or suggestive, and therefore inherently distinctive, in relation to the interfaces of other online gaming companies. The distinctiveness inquiry for online games would require a consideration of the entire market of online games and their interfaces. Under this proposed methodology, a court would first determine into which *Abercrombie* category the product or service falls by considering the extent to which the product or service satisfies the *Seabrook* formulation.

2. An Altered Notion of Secondary Meaning

37. If an Internet product's trade dress is not arbitrary, fanciful, or suggestive, it may still obtain protection if it is descriptive and has achieved secondary meaning. Although the determination of secondary meaning generally requires a consideration of long-term consumer exposure to a particular product, the Internet's fluidity makes such determination difficult at best. The Lanham Act states that five years of continuous use of a particular trade dress is prima facie evidence of secondary meaning.¹⁰⁸ Because Web site designs and appearances are unlikely to remain static, a requirement of five years continuous use is clearly inappropriate for Internet trade dress protection.

38. This Note proposes that, given the Internet's unique quality, a pre-determined time period for proof of prima facie secondary meaning should be established for Internet products. The Lanham Act's five years continuous and exclusive use requirement may appear at first to constrain the power of the Commissioner to grant secondary meaning.¹⁰⁹ In fact, however, the Act's language suggests that the five year time period is flexible and not absolutely binding.¹¹⁰ Two alternatives are possible; (i) congress could amend the Lanham Act to include a pre-determined time period for secondary meaning on the Internet; or (ii) the judiciary could develop a new time period through judicial precedent.¹¹¹ Without

¹⁰⁷ See *Krueger*, 915 F. Supp. at 603.

¹⁰⁸ See 15 U.S.C. § 1052(f) (1996).

¹⁰⁹ See *id.*

¹¹⁰ See *id.* ("The Commissioner *may* accept as prima facie evidence that the mark has become distinctive . . . proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made.") (emphasis added). See also *Stuart Hall Co. v. Ampad Corp.*, 51 F.3d 780, 789-90 (8th Cir. 1995) (stating that "[a]lthough 'no absolute time span can be posited as a yardstick in cases involving secondary meaning,' length and exclusivity of continuous use is a factor bearing on secondary meaning") (citations omitted).

¹¹¹ A court-developed system of secondary meaning adapted for the Internet would be a slow process, dependant on individual cases brought before the circuit courts and developed on a case-by-

changing the period delimited for showing acquired meaning, the current rule would force Internet businesses having descriptive Web sites would to maintain their sites' trade dress far past its commercial viability and desirability among consumers. Given the pace of technological advances, such a constraint would force businesses to use technology that is inferior to their competitors to obtain trade dress protection for nearly useless trade dress. These restrictions would make trade dress protection an unavailable or unattractive option for protecting Internet commercial interests.

39. The present five year period set forth in the Act,¹¹² when applied to Internet trade dress, effectively eliminates a secondary meaning requirement from the *Abercrombie* test. Rather than attempt to obtain Internet trade dress protection by showing secondary meaning, which would limit them to technologically inferior trade dress, businesses would most likely expend additional resources to redesign their products and services to be arbitrary, fanciful, or suggestive. A time period more in tune to the Internet's fluidity and the speed of technology, such as a year or less of documented continuous use, would more reasonably provide Internet businesses with a way of obtaining trade dress protection for descriptive Internet products.

40. The approach to Internet trade dress protection proposed in this Note, unlike that of the configuration rule, avoids the question of the conceptual separability of a product's feature from a product's design, as well as whether a product's feature is primarily source indicative to consumers. When implementing this proposed test, courts would be more concerned with the nature or essence of a product or product feature, and how these aspects fit within preexisting categories of distinctiveness, than with the significantly more difficult question discerning primary source indication and secondary meaning.

41. The following examples best illustrate the advantages of the proposed approach over one based on the configuration test. Imagine an exclusively Internet-based business that provides audio and video movie reviews.¹¹³ The business's Web page has photos of the reviewers on the edge of the Web page and a large console with volume control and numerous other buttons on which the names of movies appear. When a user clicks on the name of a movie, a separate, smaller window appears, showing a clip of the movie accompanied by the reviewer's commentary. Imagine also a company that specializes in online gaming services.¹¹⁴ The Web site contains a navigation bar at the top of the screen through which a player interacts with the service. The site contains a console that looks like a futuristic computer

case basis. A congressionally determined system in the form of an amendment to the Lanham Act, would likely provide a speedier resolution to this problem.

¹¹² See 15 U.S.C. § 1052(f) (1996).

¹¹³ See, e.g., *Siskel & Ebert*, (last modified Mar. 9, 1999) <<http://tvplex.go.com/BuenaVista/SiskelAndEbert>>.

¹¹⁴ See, e.g., *Heat*, *supra* note 93.

screen and through which a player interacts with a particular game. If a court uses the configuration approach, the determination of distinctiveness merely becomes one of secondary meaning, with its requisite elements of unusualness and memorableness. Even if secondary meaning analysis in this approach accounts for the Internet's fluidity, the likely end result in both examples is the denial of trade dress protection because neither product's trade dress is capable of serving primarily as a designator of the product's origin or being conceptually separable from the product.

42. Under the approach proposed in this Note, a more structured framework for determining distinctiveness exists. A court would first consider whether a given product's trade dress is distinctive according to the *Abercrombie* factors. In doing so, the court would consider whether the trade dress is fanciful or generic within the limits of the product's market. If the product's trade dress is neither inherently distinctive nor generic, the claimant may obtain trade dress protection by showing that the trade dress has obtained some semblance of secondary meaning after, for example, six months to a year of continuous use on the Internet. Thus, in the first example, the console may be considered arbitrary and, therefore, inherently distinctive because its design is either unusual or otherwise unrelated to the market of consoles used for displaying movie reviews. The console in the second example, conversely, will not likely be distinctive in relation to the market of online gaming consoles, but may acquire distinctiveness over the refined time requirement adopted for showing secondary meaning.

3. Recent Developments

43. A proposed bill to amend the Lanham Act supports, in part, the *Abercrombie-Seabrook* market approach proposed in this Note. H.R. 3163, or the Trade Dress Protection Act, seeks to clarify and grant explicit trade dress protection under the Lanham Act.¹¹⁵ The bill affirms the Court's *Two Pesos* holding by stating

¹¹⁵ Trade Dress Protection Act, H.R. 3163, 105th Cong. (1998). Relevant portions of H.R. 3163 are:

(g) Except as expressly excluded . . . trade dress which functions as a mark may be registered and protected without the need to show that it has become distinctive . . . if the relevant public is likely to identify the source of the product or service by reference to the subject matter claimed as trade dress. In determining whether the relevant public is likely to identify the source of the product or service . . . the factors to be considered shall include, but not be limited to –

(1) whether the trade dress is unique or unusual in the particular field to which the subject matter pertains;

...

(4) whether the trade dress is capable of creating a commercial impression distinct from any accompanying words.

See id.

that distinctiveness alone, without proof of secondary meaning, is sufficient evidence for trade dress protection.¹¹⁶ The bill further states that absent proof of pure distinctiveness, trade dress protection is available if a claimant proves that the “relevant public is likely to identify the source of the product or service by reference to the subject matter claimed as trade dress.”¹¹⁷ The bill sets forth a nonexclusive list of factors to consider when determining whether the relevant public is likely to identify the source of a product’s trade dress.¹¹⁸ By using phrases such as “unusual in the particular field to which the subject matter pertains,” “commonly adopted and well known forms of ornamentation,” and “commercial impression,”¹¹⁹ the bill clearly adopts the *Seabrook* test, which considers the market in which a product competes.¹²⁰

44. The overall effect of the proposed bill seems to be the elimination of the product packaging/configuration dichotomy in favor of a methodology that provides protection for distinctive trade dress, which is determined according to the a product’s position and presence in the relevant market. Notably, H.R. 3163 does not contain the words “inherently distinctive.”¹²¹ Nevertheless, it would appear from the bill’s plain language that the bill intends to encompass the *Abercrombie* categories, which previously defined inherent distinctiveness, and add them to the *Seabrook* market test.

45. The Trade Dress Protection Act has several implications for the approach proposed in this Note and for the protection the trade dress of Internet products. Fundamentally, the proposed bill would adopt the basic *Abercrombie-Seabrook* approach, proposed here for Internet-based product trade dress, and apply it to physical objects. Thus, the result of the first example discussed in Part IV.A.2 above would be identical under both the proposed bill and the approach proposed in

¹¹⁶ See *Electronic Intellectual Property Protection: Hearings on H.R. 3163 Before the Subcomm. on Courts and Intellectual Property of the Comm. on the Judiciary*, 105th Cong. (1998), available in 1998 WL 8992115, (statement of Michael K. Kirk, Executive Director, American Intellectual Property Law Association) [hereinafter Kirk Statement]; see also *Electronic Intellectual Property Protection: Hearings on H.R. 3163 Before the Subcomm. on Courts and Intellectual Property of the Comm. on the Judiciary*, 105th Cong. (1998), available in 1998 WL 8992114, (statement of Theodore H. Davis, Jr., Chair of the Federal Trademark Legislation Committee of the Section of Intellectual Property Law of the ABA) [hereinafter Davis Statement].

¹¹⁷ H.R. 3163 § 2(g).

¹¹⁸ See *id.*

¹¹⁹ See *id.*

¹²⁰ See *Electronic Intellectual Property Protection: Hearings on H.R. 3163 Before the Subcomm. on Courts and Intellectual Property of the Comm. on the Judiciary*, 105th Cong. (1998), available in 1998 WL 61559 (F.D.C.H.), (statement of Jeffrey M. Samuels); Davis Statement, *supra* note 116.

¹²¹ See Kirk Statement, *supra* note 116.

this Note. A court would undertake a consideration of whether the trade dress in question is unique in the product's given market.

46. The result of the second example in Part IV.A.2, however, would be different and serves to illustrate not only where H.R. 3163 and this Note differ, but also how the Internet's fluidity characteristic is absent in physical objects. Because the proposed bill does not account for this special characteristic, the online gaming console's inability to pass the market distinctiveness test would deny trade dress protection in the second example, despite a showing that the trade dress had acquired secondary meaning. Furthermore, the proposed bill does not address the inability of Internet products to fulfill the five year rule for a showing of prima facie secondary meaning. The approach proposed in this Note, however, would remedy this Internet trade dress "loophole" by providing trade dress protection under a secondary meaning provision specifically tailored to the Internet's fluid character.

B. Shortcomings of the Proposal

47. The approach proposed in this Note would eliminate the difficulties that exist if the packaging/configuration distinction is applied directly to Internet trade dress. Although the proposed approach would provide protection for the trade dress of Internet goods and services in accord with current trade dress policy, there are a few potential shortcomings to the proposed approach.

48. The first potential concern is that Internet trade dress is limited to the extent that the state of technology defines functionality; courts may find it all too easy to hold a given Internet trade dress as merely functional and deny protection otherwise available. Furthermore, there is the related concern that the determination of whether an Internet product's trade dress is arbitrary, fanciful, or suggestive could ultimately devolve into a mere consideration of functionality. That is, apart from the evaluation of a product in relation to its particular market, a court may unintentionally comment on the extent to which the product's market dictates the product's design. In that circumstance, determining distinctiveness would simply become a question of whether the product design or feature was functional, and if not, then whether secondary meaning existed.

49. The fact that, unlike tangible, physical objects, consumers are rarely actually exposed to an Internet product's trade dress prior to viewing it and are less likely to base their initial decision to use the Internet product purely on the product's attractiveness mitigates concerns about functionality. Functionality is more likely to play a greater role when a consumer chooses, for example, to purchase a set of silverware¹²² than when a consumer decides to visit one Web page over another. The purpose of the functional element in the case of silverware is to attract consumers, which can be easily differentiated from the purpose of a Internet product's trade dress. Once a consumer visits or even merely browses a Web site, he has essentially bought the product; a consumer of physical goods, however, may

¹²² See *Wallace Int'l Silversmiths, Inc. v. Godinger Silver Art Co.*, 916 F.2d 76 (2nd Cir. 1990).

“window shop” for a variety of products, without having actually purchased the product.

50. Another area of concern is the possibility that in attempting to provide protection for Internet trade dress, the proposed approach may grant overly broad Internet trade dress rights compared to the configuration approach, which may overly restrict them.¹²³ Given the countervailing policy arguments against granting monopoly rights in marks and trade dresses, however, the possibility of a problematic shift from minimum protection to maximum protection of Internet trade dress is an unlikely event.

51. The final potential shortcoming which the proposed approach raises is the viability of the concept of secondary meaning on the Internet. This Note contends that a test based on the *Abercrombie* taxonomy is better suited to advancing general trade dress policy because it avoids the confusing and abstract separability and primary source identification questions posed by the configuration test, which inevitably dissolves into a determination of secondary meaning and the denial of Internet trade dress protection. Because the proposed approach provides for a lower burden of proof on the part of the claimant, it avoids the consideration of secondary meaning that is almost the default in the configuration test. The difficulty, however, in determining what efforts are required to obtain secondary meaning, in addition to or in place of the time of continuous use, will continue to make the determination of secondary meaning problematic. As discussed above, surveying consumer awareness of a particular product may be unreliable and measuring advertising efforts may be similarly difficult to gauge. The proposed approach depends, to some extent, on a reformulation of secondary meaning to account for the Internet’s fluid nature. If secondary meaning were in fact modified to do so, the *Duraco/Knitwaves* test would consist of a test for secondary meaning for distinctiveness and begin to resemble the proposed approach.

V. CONCLUSION

52. The current state of trade dress law makes the protection of trade dress of Internet products and services difficult, due to the inapplicability of the packaging/configuration distinction in cyberspace, as well as the Internet’s own inherent fluidity. A formula that determines distinctiveness while avoiding the packaging/configuration distinction and accounts for the Internet’s unique properties would be in accord with the existing goals of trade dress policy. In light of these points, the adoption of an *Abercrombie*-like test that requires consideration of a product’s distinctiveness in relation to its market and that contains an altered definition of secondary meaning for Internet trade dress will most likely avoid any packaging/configuration confusion and advance Internet trade dress law policies.

¹²³ See Tom W. Bell, *Virtual Trade Dress: A Very Real Problem*, 56 MD. L. REV. 384, 428 (1997) (discussing examples of overbroad protection of virtual trade dress that could result under current trade dress law).

H.R. 3163 failed to specifically address the problem of protecting Internet trade dress and the current manner in which courts and legislators specifically address this issue will likely cause consumers and entrepreneurs alike to suffer. Nevertheless, H.R. 3163 at least provided courts a bright guiding light away from the current confusion of the packaging/configuration dichotomy, towards a more unified and predictable law of trade dress that allows for the future protection of Internet trade dress.