

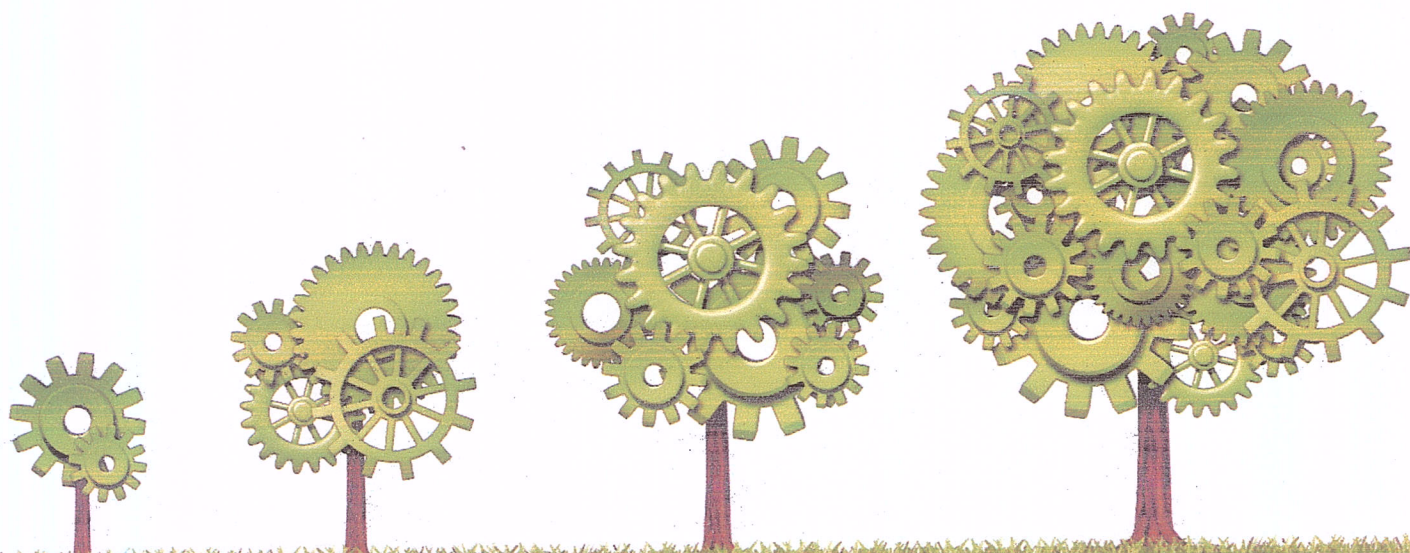
Not just trademark
one can acquire exclusive rights to
Trade Dress

SC upholds slogans
Taglines to be
valid and enforceable
Trademarks



www.ipera.in | 15 Nov-15 Dec 2014 | Vol. 1 | Issue 4 | ₹ 100

Safeguarding **DESIGNS** THE FIRST STEP TO PROTECTING IP



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Trade Dress

and the Protection of Websites

The layout of websites may receive protection from competition law provided their graphic projects are not functional and are distinctive enough or acquire secondary meaning

Introduction:

The World Wide Web ("www") probably is one of the most important steps in the evolution of the Internet. Such network protocol transformed the internet's "face" into something much more accessible as well as interesting to the common user, allowing a universal communication between computers distributed around the world.

The "www" was mainly responsible for popularization of the internet. Along with the evolution of internet navigators, it offered its users images, sounds, and movement, instead of the tedious static simplicity of the text expressed in

green letters on a black background, therefore creating the necessity of legal protection.

According to Brazilian Copyright Law, many elements constantly presented in websites - such as graphic projects, musical works, photos, and illustrations, literary works, audiovisual works, database and font codes may be protected.

In order to protect the layout of a website, it is necessary that it constitutes an intellectually securable work. Despite all the information and data, as well as other items that compose the website being structured in a systematic manner, that is, according to selection criteria, organization and layout

of its content, in order to optimize its functionality, the elaboration of visual aspects and graphic differences of each page that compose the website, may constitute a creative activity that reveals, most of the times, originality.

This is so because the graphic concept of a website, most of the time, is not limited to a merely technical work, destined to solve functionality problems. The graphic conception may involve a high degree of aesthetic sensibility as well as artistic creativity, which is protected by copyright standards.

However, the protection of graphic conception of a website isn't limited to its existence solely as a protected intellectual work. The increasing popularity of the internet and involvement of its tools, has led to the emergence of new definitions pertaining to already existing values deeply rooted in our society, and, consequently, the need to revisit these concepts.

Seeing that the domain name may be equated to a commercial name, excluding civil and commercial rules, the website, depending on its content, may be considered as a virtual commercial establishment, having its graphic project corresponding to the façade as well as its internal architectural project, seeing that, in addition to the visual identity of its layout, the webdesigner projects the website's map with the objective of making navigation easy and amicable, aiming to better use the website's contents.

In such a context, and with no pretension to exhaust the discussion, we call upon a reflection considering the possibilities as well as legal viability of using the trade dress, a principle pertaining to the competitive law sphere in order to promote the visual-graphic protection of the website's layouts, a kind of media that grows more important each day to companies, who offer either services, products or institutional information, working in cases of e-commerce sites, as is the case of the virtual and commercial establishment.

Trade Dress:

Considering that any product or service acquired/engaged in order to satisfy certain desires/necessities, the advertiser and propaganda as well as marketing professionals, aim for elaboration of a concept when creating a marketing strategy, given that what is actually being sold is the concept and not the product or service itself. When the appearance of a service or product sports creative and innovative characteristics, they acquire their own distinctiveness' in terms of packaging or commercial establishment, clearly setting them apart from competitors.

In order to do so, the packaging of products and internal or external environments of commercial establishments are specially created by specialists with the objective of providing the consumer with the immediate capacity of identifying the origin and manufacturer / dealer / supplier of a certain product or service.

Often, consumers identify products on supermarket shelves or in stores in commercial centers through the visual impression caused by the characteristics of the whole image before even noting their trademark or fantasy name. Such



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a phenomenon has been called the “trade dress” and/or “the whole image concept” of a product, service, or establishment.

About the “trade dress” institute and its protection in Brazil, João da Gama Cerqueira explains that: “Among the methods of creating confusion with products or articles of a competitor, surfaces the idea of using identical distinctive signs or even similar signs. When these distinctive signs are found to be registered as trademarks, we find ourselves under the domain of the respective law, being punishable as forgery (Code Article 175, II). When pertaining to unregistered signs, it is a mandatory condition, the action based in unfair competitiveness that these signs, in addition to having all of the intrinsic requirements that make them distinctive and susceptible to constituting trademarks, also be in prolonged use, in order that they become known as trademarks belonging to competing products. The same principle is applied when relating to imitation or reproduction

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of a characteristic aspect of a product or in relation to its presentation (packaging, recipients, etc.), when they refrain from being vulgar or belonging to the public domain. Products include, for the purpose of their protection against unfair competition, as stated before, the services offered to the public by a company or establishment”.

The whole image concept usually includes singular characteristics that makes it possible for consumers to immediately identify what product or establishment they refer to. Such characteristics maintain important relevance

among products and services, making it possible to exercise a strong influence among the public, causing consumers to associate, unconsciously even, the quality of products and services to such characteristics.

This way, it is just as important to create both a whole image concept as well as a product or service capable of attracting and even creating loyalty in relation to clients, but also, protecting it in such a way that it prevents others from benefiting from the characteristics of products and services already well known and famous in the market.

Websites and Trade Dress:

With each passing day, the internet is becoming increasingly ubiquitous in our daily lives. It is difficult to imagine how we survived for so long with no e-mails, blogs, photo logs, research, virtual social networks and information websites, VoIP services, instant messaging, among other communication tools and information brought by the internet.

The importance of the internet nowadays is so much that the fact that a company does not possess and maintain a website may signify the loss of numerous business opportunities. For this reason, investment in the development of a website with attractive visual and graphic elements, with tools and links that may be easily accessed, has become the priority of many companies.

Therefore, in order to establish a link between their products and services and internet consumers through their websites, companies have created as well as developed their own patterns and a completely original graphic project, in order for internet users, when accessing the referred sites, to immediately identify them.

Thus, at first, the layout of a site, allied to other sensorial elements, may constitute the whole image of an internet service. Nevertheless, considering that many of the internet sites work as virtual product and service stores, is it possible, in those cases, to apply the concept of trade dress?

In order to answer such a question, we must first observe if, in a generic form, the essential requirements of the trade dress may be applied to the websites.

The first requirement that has to be analyzed is mandatorily that of the whole image concept and whether it is intrinsically distinctive or if it acquired a secondary meaning. That way, in order for the protection of the layout of the internet page the elements that compose the page should be necessarily distinctive. In relation to such a requirement, we see no obstruction in following it, seeing that the owner has only to show evidence that he/she was the first one in its development as well as the first one to apply the sensorial elements brought by the website, seeing that any other competitor that uses them wrongfully will not only violate the owner's rights but also and more importantly, competing unfairly.

The second requirement is the fact that the whole image brought by a certain site may not be functional, that is, the characteristics held as innovative or distinct may not

be useful for the well-being of the site. Also in relation to this requirement, we see no barriers in attending to it, once that, even though certain basic technical configurations are imperative for its regular function, these tools function are inserted in the program of the website and not in its layout, which, among other elements, constitute its whole image package.

The last requirement analyzed would be the possibility of similarities among sites that create confusion in relation to consumers pertaining to the origin of the respective services or products. Such a requirement deserves special attention given that most times, the access to an internet page occurs through the navigator of the electronic address by typing the electronic address to which a particular website is being directed. This way, it would be difficult for an internet user to acquire a product or service offered by a website, believing he is accessing the page of another provider.

However, the practice of typosquatting may not be forgotten. It is the malicious usage of orthographic errors while accessing internet addresses, such a practice has become more frequent and is also considered an act of unfair competition. A simple typing error could direct the internet user to another website without him/her noticing it.

Just as there exists the occurrence of reproduction or illegal imitation of unauthorized trademarks in products and commercial establishments, the core of domain names may be reproduced the same way, presenting both graphics and phonetics sufficiently similar or identical that leads to confusion in the unadvised internet user leading him to the competing website. Once he/her comes in contact with a similar layout or even identical layout as to the website he/she actually wanted to visit, he will fail to perceive his/her mistake so easily.

In addition to typosquatting, linking and metatags may also be used for the purpose of deviating to the competitor's page.

Therefore, the allegation that consumers wouldn't be prone to mistaking websites is not true seeing that in order for users to access such websites, it is imperative that they type

in a domain name. From the moment in which the bad faith competitor reproduces or imitates the layout of another website, the usage of typosquatting as well as of metatags may be implemented in order to redirect to the competing website, therefore maintaining the possibility, even if on a smaller scale, of the similarities existing between the websites creating confusion among internet users in relation to the origin of products and services in question.

Conclusion:

Competition, as an expression of free enterprise, is beneficial in so far as it stimulates business and develops productive activities. However, such competition must be fair, through the use of appropriate means as well as an ethical conduct.

In order to prevent actions that are contrary to commercial usage, the Industrial Property Law, establishes as illegal acts which propagate unfair competition that causes confusion among competing companies, deviates consumers or acts that are contrary to commercial morality. The same occurs in e-commerce when protecting against unfair competition, especially in relation to the website that represents both a commercial point and establishment title.

Once all the requirements are analyzed in order for the product or service to receive trade dress protection, it may be concluded that the layout of websites may in fact receive protection by competition law, provided that its graphic project isn't functional and is distinctive enough or acquires a secondary meaning, requirements that may be easily attended upon by other websites.

Aside from attending to the requirements mentioned above, in order for the layout of a website to receive protection by trade dress, the existence of confusion risk is necessary, which might occur with the arduous practice of typosquatting and linking as well as the use of metatags by a competitor.

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