

PROTECTING THE “LOOK & FEEL” OF YOUR WEBSITE

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NEIL KATHOL

You have developed a website that promotes your business’s goods and services. Perhaps your website also contains an online “store.” If your website is distinctive, its look and feel may be protectable. Here’s how.

THE NATURE OF PASSING OFF

Historically, you would sue an entity under the common-law action of “deceit.” A passing off action is similar: you can sue an entity that makes a false representation that causes its goods or services to be associated with yours in the minds of the relevant public. The association can be through use of a similar trade-mark, but can also be through use of a similar “get-up” (which can include the look and feel of its website).

Section 7(b) of the Canadian *Trade-marks Act* expressly codifies your cause of action in such instances. This provision is often the basis for obtaining a court order stopping an organization from directing attention to its wares or services in such a way as to cause or be likely to cause confusion between its wares or services and the claimant’s wares or services.

The critical question is: what kind of “confusion” is sufficient to justify a suit under the law of passing off? In recent years, the Courts have broadened the kinds of confusion that are actionable. Originally, the Courts considered only “classic passing off” cases: where the Defendant causes consumers to mistakenly believe they are purchasing wares and services from you, when they are not. However, the Courts are now willing to find infringement in “initial-interest confusion” cases. Courts have found infringement where consumers mistakenly believe they are dealing with you for a significant period of time - such as when they are navigating the other organization’s website and learning about what wares and services are offered and promoted by the Defendant organization. Such confusion has been held to be actionable as - even if the consumer discovers the error before a purchase is made - enough damage has been done.

As an example, if your website contains distinctive content, words and phrases, other material and functionality - and you generate a lot of business via your website either as a promotional tool or as an e-commerce site or both - then, if a third-party adopts the look-and-feel and the “get-up” of your site, consumers encountering the third-party’s website may mistakenly believe they are on your site for enough time that they become interested in the third-party’s goods or services, even after they discover that the other site is not operated by the organization they are familiar with (namely you).

Of course not every site - and not many sites - will qualify for this kind of protection. Only sites that are distinctive and visited so frequently as to be instilled in the minds of a significant quantity of relevant consumers will qualify. Because the medium of online websites is very limited (everything is restricted to certain colours, an overall rectangular format, no textures, and the limited illusions and functionality that can be used), to qualify for protection of this kind your site would have to be quite distinctive from the websites of all other organizations selling similar goods and services.

To avail yourself of the passing off remedy, you must prove that consumers encountering the Defendant’s website would think of you because of the similarity in look and feel of the two websites. This isn’t easy. While normally only a small percentage of the relevant consumer base must claim that they were confused, it is still very difficult to prove. Typically, experts must be retained, and often survey evidence is the only way to table the relevant proof (as ordinary witnesses who are effective in Court are often difficult to obtain).

It is worth noting that in certain circumstances copyright law can also protect the look and feel of a website. Websites that are sufficiently original may be protected by copyright where a substantial part of the claimant’s website is copied by the third party website. Whether a “substantial” part is copied is decided by the *quality* of the copied material rather than the quantity, but may include cutting and pasting relevant portions of the website

400 THE LOUGHEED BUILDING
604 1 STREET SW
CALGARY, AB T2P 1M7
PH: 403.260.8500

2000, 10235 - 101 STREET
EDMONTON, AB T5J 3G1
PH: 780.423.3003

201, 5120 - 49TH STREET
YELLOWKNIFE, NT X1A 1P8
PH: 867.920.4542

www.fieldlaw.com



or by reproducing a substantial part of the look and feel of the website. Sometimes the copying of phrases, sentences, subject headings, distinctive click-button names, designs, pictures, fields of colour, and other expressive elements of the claimant's website can be the basis of a successful copyright infringement claim. We also note that copyright registration is reasonably uncomplicated and inexpensive. Those interested in protecting the look and feel of their websites are therefore advised to build the most distinctive website possible, given the commercial reality that sites must be practical and user-friendly. Further, to establish a case against a competitor who launches a site with the same or similar features, one must establish a significant period of use and many visits by members of the relevant consumer group. One might also have to act quickly after the confusing website launches - as delay is often argued in defence of passing off claims.

As each case requires examination on its own facts and circumstances, including industry and consumer circumstances and habits, the above is to be considered general information only, and not advice.

DISCLAIMER

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The Business Group
Edmonton 780-423-3003
Calgary 403-260-8500

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