

## Boston Duck Tours v. Super Duck Tours: Duck Tours of a Feather Can Flock Together

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## *Boston Duck Tours v. Super Duck Tours*: Duck Tours of a Feather Can Flock Together

IN *BOSTON DUCK TOURS v. SUPER DUCK TOURS*,<sup>1</sup> the United States Court of Appeals for the First Circuit decided whether a trademark's conceptual strength should be considered in determining whether its use is likely to cause consumer confusion.<sup>2</sup> The court held that both the commercial and conceptual strength should be considered in determining the strength of the mark.<sup>3</sup> In so holding, the majority opinion conflated the first and second elements of its trademark infringement analysis.<sup>4</sup> The court failed to adhere to First Circuit precedent, which does not consider a mark's legal classification in determining whether the mark will result in practical consumer confusion.<sup>5</sup> The court's new test gives conceptual strength more weight than commercial strength and permits alleged infringers an escape from admission of Lanham Act protection in the first element.<sup>6</sup> The test used by the court also violates the "anti-dissection" rule of trademark infringement analysis.<sup>7</sup> Finally, merging the first and second elements fails to fulfill the purpose of the "likelihood of confusion" analysis.<sup>8</sup> Even if the court would have used the proper test and considered the mark's conceptual strength exclusively in the first prong of the trademark infringement analysis and its commercial strength in the second prong, the court would have likely reached the same conclusion.<sup>9</sup>

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1. 531 F.3d 1 (1st Cir. 2008).
2. *Id.* at 16.
3. *Id.* The strength of the mark is one of eight factors that the First Circuit uses to evaluate the second prong of the trademark infringement analysis. *Id.* at 15.
4. *See infra* Part IV.
5. *See infra* Part IV.A.
6. *See infra* Part IV.A.
7. *See infra* Part IV.B.
8. *See infra* Part IV.C.
9. *See infra* Part IV.D.

I. THE CASE

Boston Duck Tours and Super Duck Tours offer sightseeing tours via land and water in the Boston area.<sup>10</sup> Both use amphibious vehicles, commonly called “ducks” because the tour vehicles are DUKWs or are modeled from DUKWs, amphibious military vehicles used during World War II.<sup>11</sup>

Boston Duck began offering tours in 1994 using actual refurbished DUKWs.<sup>12</sup> Its amphibious vehicles bear Boston Duck Tour’s logo.<sup>13</sup> Boston Duck has received national and international press coverage and received awards for its services.<sup>14</sup>

Super Duck began in 2001 in Portland, Maine,<sup>15</sup> and uses custom-made amphibious vehicles called Hydra-Terras, which are larger and more modern than DUKWs.<sup>16</sup> The company has a super-hero theme, reflected in its name “Super Duck Tours,” the company’s advertising, and its logo, which bears a white cartoon duck with muscular arms and a cape.<sup>17</sup> Super Duck started planning operations in Boston by purchasing an existing tour company, New England Tours, in 2006 to obtain permits and licenses for its tours.<sup>18</sup> Super Duck created a website and began advertising in late 2006 and early 2007, and in May 2007 introduced its duck tour, which takes a different path than Boston Duck.<sup>19</sup>

Boston Duck “owns several state and federal trademark registrations for the composite word mark BOSTON DUCK TOURS and a composite design mark” with the company’s logo and word mark, in connection with its tour service.<sup>20</sup> There are disclaimers on the words “duck” and “tours” because Boston Duck does not have exclusive rights to those terms apart from the full registered mark.<sup>21</sup> Boston Duck has two additional federal trademark registrations in connection with apparel, first for its composite word mark BOSTON DUCK TOURS and second for its composite design mark.<sup>22</sup> It claims a first-use date of 1993 for three of the registrations, and 1995 as the first-use date for the word mark in connection with clothing.<sup>23</sup>

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10. Boston Duck Tours, LP v. Super Duck Tours, LLC, 531 F.3d 1, 8 (1st Cir. 2008).

11. *Id.*

12. *Id.*

13. *Id.* The logo consists of a duck image and Boston Duck’s trade name. *Id.* at 29–30.

14. *Id.* at 8.

15. *Id.* at 9.

16. *Id.* at 8.

17. *Id.* at 8–9. Hydra-Terras are “virtually unsinkable,” which contributed to the company’s choice of name and theme of Super Duck Tours. *Id.* at 8. The company’s website continues the theme with a Superman parody: “It’s a bus. It’s a boat. It’s Super Duck!” *Id.* at 9.

18. *Id.* at 9.

19. *Id.*

20. *Id.* (footnote omitted).

21. *Id.*

22. *Id.*

23. *Id.*

Super Duck has one federal registration for SUPER DUCK TOURS as a word mark in connection with its tour services.<sup>24</sup> Super Duck filed to have the mark on the Principal Register, but was rejected by the United States Patent and Trademark Office, which thought the mark was only descriptive.<sup>25</sup> Super Duck instead had the word mark registered on the Supplemental Register in 2003, and disclaimed the use of the phrase “duck tours.”<sup>26</sup>

On July 2, 2007, Boston Duck filed a complaint against Super Duck, alleging federal trademark infringement under section 32(1) of the Lanham Act for “federal and state unfair competition, tortious interference with prospective business relationships, and a flock of other state and federal claims” in the district court.<sup>27</sup> Boston Duck requested a temporary restraining order and preliminary injunction preventing Super Duck from using its trademark, logo, “or any other mark confusingly similar to Boston Duck’s mark BOSTON DUCK TOURS.”<sup>28</sup> Boston Duck also sought to enjoin Super Duck from interfering with Boston Duck’s prospective customers.<sup>29</sup>

On July 11, 2007, the district court held a hearing for the preliminary injunction.<sup>30</sup> The court, using the eight-part likelihood of confusion test, found the phrase “duck tours” to be non-generic for land-water sightseeing in Boston, and thus eligible for trademark protection.<sup>31</sup> The court enjoined Super Duck from using the term “duck tours,” as well as from using the cartoon duck as a logo in association with amphibious vehicle tours in the Boston area.<sup>32</sup> The court also enjoined Super Duck from using “duck” in conjunction with the words “Boston” or “tours.”<sup>33</sup> The court, however, denied the preliminary injunction on the tortious interference claim.<sup>34</sup>

On December 5, 2007, the district court held that Super Duck’s purchase of sponsored links for the phrase “Boston Duck Tours” on Google.com was not a trademark infringement and did not violate the preliminary injunction.<sup>35</sup>

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24. *Id.* at 9–10.

25. *Id.* at 10.

26. *Id.* Marks that warrant Lanham Act protection because they are suggestive, arbitrary, or fanciful may be registered on the Principal Register. *Id.* at 13. Marks that are inherently non-distinctive but are capable of receiving Lanham Act protection by acquiring a second meaning are eligible for registration on the Supplemental Register. *Id.* at 9 n.5. Generic marks cannot be registered on either the Principal or Supplemental Registers. *Id.*

27. *Id.*

28. *Id.*

29. *Id.*

30. *Id.*

31. *Id.*

32. *Id.*

33. *Id.*

34. *Id.*

35. *Boston Duck Tours, LP v. Super Duck Tours, LLC*, 527 F. Supp. 2d 205, 208 (D. Mass. 2007), *rev’d*, 531 F.3d 1 (1st Cir. 2008). This issue was not raised on appeal. For more information about the intersection of trademark infringement law and the purchase of trademarked keywords from Google, see Regina Nelson Eng, A

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On appeal, the First Circuit considered whether the district court's preliminary injunction was an abuse of discretion, and reviewed *de novo* the trademark infringement analysis.<sup>36</sup>

**II. LEGAL BACKGROUND**

The Lanham Act<sup>37</sup> governs trademark infringement claims, which occur when an entity attempts to use a mark in commerce that is similar to a registered mark, such that its effect on consumers is "likely to cause confusion, or to cause mistake, or to deceive."<sup>38</sup> The First Circuit uses a two-part test to evaluate a trademark infringement claim.<sup>39</sup> In the first inquiry, the court determines whether the mark warrants trademark protection under the Lanham Act.<sup>40</sup> In the second inquiry, the court determines whether the allegedly infringing use is likely to result in consumer confusion.<sup>41</sup>

*A. The Court First Determines Whether the Mark Warrants Trademark Protection Under the Lanham Act*

To succeed on an infringement action, the plaintiff must first prove that its mark warrants federal protection.<sup>42</sup> The Lanham Act defines a trademark as "any word, name, symbol, or device, or any combination thereof"<sup>43</sup> used by any person "to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown."<sup>44</sup> Thus, in order to be registered and warrant protection, the mark must be able to distinguish the applicant's goods from those of others.<sup>45</sup>

A mark must be distinctive in order to qualify for registration with the United States Patent and Trademark Office.<sup>46</sup> An identifying mark is distinctive if it "either (1) is inherently distinctive or (2) has acquired distinctiveness through secondary

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*Likelihood of Infringement: The Purchase and Sale of Trademarks as AdWords*, 18 ALB. L.J. SCI. & TECH. 493 (2008).

36. *Boston Duck Tours*, 531 F.3d at 11.

37. 15 U.S.C. §§ 1051–1141 (2006).

38. 15 U.S.C. §1114(1)(a).

39. *Borinquen Biscuit Corp. v. M.V. Trading Corp.*, 443 F.3d 112, 116 (1st Cir. 2006).

40. *See infra* Part II.A. All federal circuit courts must identify whether the trademark is protectable before it can proceed in determining whether it is infringed. *See* 15 U.S.C. §1114(1)(a). The crux of a trademark infringement claim is that a person "without the consent of the registrant" is using a mark that is confusingly similar to a registered mark. *Id.*

41. *See infra* Part II.B.

42. *Borinquen Biscuit Corp.*, 443 F.3d at 116.

43. 15 U.S.C. § 1127.

44. *Id.*

45. 15 U.S.C. § 1052.

46. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992).

meaning.”<sup>47</sup> Marks are typically classified in order of increasing distinctiveness, or “conceptual strength”: generic, descriptive, suggestive, arbitrary, and fanciful.<sup>48</sup> The marks in three of the classifications—suggestive, arbitrary, and fanciful—identify the source of the product, and therefore are inherently distinctive and warrant protection.<sup>49</sup> A mark is suggestive if it “requires imagination, thought and perception to reach a conclusion as to the nature of goods.”<sup>50</sup> A mark is arbitrary if it is a word or symbol that is common language, but is arbitrarily applied to the product in a way that is not descriptive or suggestive.<sup>51</sup> Finally, a mark is fanciful if it is a “coined word” for the purpose of functioning as a trademark.<sup>52</sup>

At the other end of the spectrum, generic marks are not eligible for registration or protection because they refer “to the genus of which the particular product is a species.”<sup>53</sup> The court looks to evidence from consumer surveys, use of the term in media publications, use of the term by competitors in the industry, purchaser testimony regarding the term, and plaintiff’s use of the term to determine the public conception of the mark, and ultimately, whether the term is generic.<sup>54</sup>

Finally, a descriptive mark is not inherently distinct because it describes the type of product but does not inherently identify its source.<sup>55</sup> At common law, there was no protection available for marks that were generic or descriptive.<sup>56</sup> However, the Lanham Act provided an exception to the common law by protecting descriptive marks, so long as they had acquired a “second meaning.”<sup>57</sup> According to

47. *Id.* at 769.

48. *Id.* at 768; *see also* *Borinquen Biscuit Corp. v. M.V. Trading Corp.*, 443 F.3d 112, 116 (1st Cir. 2006) (noting the continuum consists of five categories: generic, descriptive, suggestive, arbitrary, and fanciful). However, it is sometimes difficult to categorize a mark because a term that is in one category for one product may be in a different category for another product or a term may in time move from one category to another because its usage has changed. *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976), *overruled by* *N.Y. Racing Ass’n v. Perlmutter Publ.*, 959 F. Supp. 578 (2d Cir. 1997) (overruling the *Abercrombie* test for evaluating inherent distinctiveness). Additionally, a term could have one meaning to one group of users and a different meaning to a different group of users, or the same term could be used in different ways with respect to a single product. *Id.*

49. *Two Pesos*, 505 U.S. at 768.

50. *Equine Techs., Inc. v. Equitechnology, Inc.*, 68 F.3d 542, 544 (1st Cir. 1995) (quoting *Blinded Veterans Ass’n v. Blinded Am. Veterans Found.*, 872 F.2d 1035, 1040 (D.C. Cir. 1989)).

51. *Union Nat. Bank of Tex., Laredo, Tex. v. Union Nat. Bank of Texas, Austin, Tex.*, 909 F.2d 839, 845 (5th Cir. 1990). “Apple” is an example of an arbitrary term; it is a common word but does not in any way describe the products that Apple sells.

52. *Id.* (identifying “Xerox” and “Kodak” as examples of fanciful terms).

53. *Abercrombie & Fitch Co.*, 537 F.2d at 9.

54. *Colt Def. LLC v. Bushmaster Firearms, Inc.*, 486 F.3d 701, 706 (1st Cir. 2007).

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

56. *Abercrombie & Fitch Co.*, 537 F.2d at 9.

57. 15 U.S.C. § 1052(f) (2006); *see also* *Two Pesos*, 505 U.S. at 769 (noting descriptive marks may only be registered where they have acquired a second meaning). The Lanham Act, however, provided no such exception for generic marks. *Abercrombie & Fitch Co.*, 537 F.2d at 9.

the Act, a second meaning is established when the mark “has become distinctive of the applicant’s goods in commerce.”<sup>58</sup>

For the purposes of a trademark infringement claim, registration of a trademark is “prima facie evidence of the validity of the registered mark.”<sup>59</sup> Thus, the owner of a registered trademark is entitled to a presumption that the mark is distinctive and merits protection.<sup>60</sup> However, the effect of this presumption is dependent on the status of the mark as contestable.<sup>61</sup> If the mark’s status is incontestable because its owner followed the statutory requirements of 15 U.S.C. § 1065, then the presumption is conclusive.<sup>62</sup> However, if the mark is still contestable, then the defendant in the trademark infringement suit may allege that the mark is not distinctive and only descriptive.<sup>63</sup> Thus, demonstrating the mark is registered but still contestable shifts the burden of proof from the plaintiff to the defendant, who must rebut the presumption that the mark warrants protection, using sufficient evidence.<sup>64</sup>

Finally, under the Lanham Act, an applicant with an otherwise registrable composite mark may disclaim an unregistrable component of a mark to avoid rejection.<sup>65</sup> The disclaimer demonstrates that the applicant does not have exclusive rights to the disclaimed portion of the composite mark.<sup>66</sup> However, all elements of a composite mark cannot be disclaimed because this makes the mark unregistrable.<sup>67</sup>

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58. 15 U.S.C. § 1052(f).

59. 15 U.S.C. § 1115(a).

60. *Borinquen Biscuit Corp. v. M.V. Trading Corp.*, 443 F.3d 112, 117 n.2 (1st Cir. 2006); *see also Two Pesos*, 505 U.S. at 776 (indicating a secondary meaning is not required to prevail on a trademark infringement claim where the mark is inherently distinctive).

61. *Borinquen Biscuit Corp.*, 443 F.3d at 117.

62. *Id.* A mark is incontestable under 15 U.S.C. § 1065 if the mark has been registered and in continuous use for five consecutive years after registration, and is still in use in commerce. 15 U.S.C. § 1065 (2006). There must also be “no final decision adverse to registrant’s claim of ownership” of the mark, no pending proceeding regarding the registrant’s ownership, an affidavit filed with the Director of the Patent and Trademark Office within a year after the conclusion of five years of continuous use stating the mark has been in continuous use and is still in use in commerce, and no incontestable right in a mark will be acquired in a mark that is generic or the portion of the mark that is generic. *Id.* § 1065(1)–(4).

63. *Borinquen Biscuit Corp.*, 443 F.3d at 117.

64. *Id.* (citing *Keebler Co. v. Rovira Biscuit Corp.*, 624 F.2d 366, 373 (1st Cir. 1980)). The alleged infringer must show by a preponderance of the evidence that the mark is merely descriptive before the burden of proof will shift back to the plaintiff to prove a secondary meaning. *Id.* at 118. If the infringer fails to prove descriptiveness by a preponderance of the evidence, the presumption of distinctiveness still holds. *Id.*

65. *See* 15 U.S.C. § 1056(a).

66. *Dena Corp. v. Belvedere Int’l, Inc.*, 950 F.2d 1555, 1560 (Fed. Cir. 1991). The disclaimer provision strikes a balance between providing protection for composite marks with unregistrable components and preventing “an applicant from claiming exclusive rights to disclaimed portions apart from composite marks.” *Id.*

67. 15 U.S.C. § 1056(a).

*B. The Court Next Determines Whether the Allegedly Infringing Mark Is Likely to Cause Confusion*

In the second part of the trademark infringement analysis, the court analyzes whether the “allegedly infringing use is likely to result in consumer confusion.”<sup>68</sup> Developed in *Pignons S.A. de Mecanique de Precision v. Polaroid Corp.*,<sup>69</sup> the First Circuit assesses the likelihood of consumer confusion by weighing eight factors, which measure the mark’s practical impression on consumers.<sup>70</sup> The court applies the eight *Pignons* factors in no particular sequence and depending upon the facts of the case, may give some more weight than others.<sup>71</sup> In evaluating the eight factors, the court must be careful not to violate the anti-dissection rule, which requires the court to review the “total effect of the designation, rather than a comparison of individual features.”<sup>72</sup>

One of the eight factors the court evaluates is the strength of the mark.<sup>73</sup> In the First Circuit, the evaluation of the mark’s strength is exclusively dependent on the practical, commercial strength of the mark and not the legal classification of the mark, which is typically analyzed under the first prong of infringement analysis.<sup>74</sup> Factors commonly considered in evaluating the strength of the mark include the

68. *Borinquen Biscuit Corp.*, 443 F.3d at 116. A mark causes consumer confusion when its similarity to a registered mark causes consumers to believe that the good or service it represents is in some way connected to the good or service the registered mark represents. 15 U.S.C. § 1114(1)(a). A mark is also confusing when it misrepresents goods or services as those of another entity’s goods or services. *Id.* § 1114(1)(b).

69. 657 F.2d 482, 487 (1st Cir. 1981).

70. *Id.*

71. *See Attrezzi, LLC v. Maytag Corp.*, 436 F.3d 32, 39 (1st Cir. 2006) (noting the First Circuit uses a consultation of these eight factors rather than a mechanical formula); *Int’l Ass’n of Machinists & Aerospace Workers, AFL-CIO v. Winship Green Nursing Ctr.*, 103 F.3d 196, 203 (1st Cir. 1996) (noting the facts of the case rendered some of the factors irrelevant or difficult to apply).

72. *Pignons*, 657 F.2d at 487 (quoting *Alpha Indus., Inc. v. Alpha Steel Tube & Shapes, Inc.*, 616 F.2d 440, 444 (9th Cir. 1980) (internal quotations omitted)). Composite trademarks, or marks containing more than one element, should be considered as a whole in evaluating the “likelihood of confusion” prong of the trademark infringement analysis. 4 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION 23-179 to 23-180 (J. Thomas McCarthy ed., 4th ed. 2009). The rationale behind the rule is that the overall commercial impression of a trademark comes from the trademark as a whole, not its individual components. *Id.*; *see also Estate of P.D. Beckwith, Inc. v. Comm’r of Patents*, 252 U.S. 538, 545–46 (1920).

73. *Pignons*, 657 F.2d at 491.

74. *See Attrezzi*, 436 F.3d at 40 (indicating that considering a mark’s legal classification in its strength of mark analysis “is not a proposition supported by any First Circuit case law and its logic is not apparent”). However, other circuits consider both a mark’s conceptual and commercial strength in the “strength of mark” analysis. *See Am. Rice., Inc. v. Producers Rice Mill, Inc.*, 518 F.3d 321, 330 (5th Cir. 2008) (considering the strength of the mark in two ways: where it falls on the distinctiveness spectrum and the standing of the mark in the marketplace); *Banff, Ltd. v. Federated Dep’t Stores, Inc.*, 841 F.2d 486, 491 (2d Cir. 1988) (evaluating the strength of the mark by its conceptual strength plus third parties’ impression of the mark); *Safeway Stores, Inc. v. Safeway Disc. Drugs, Inc.*, 675 F.2d 1160, 1164 (11th Cir. 1982) (same).

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“length of time the mark has been used, its renown in the plaintiff’s field of business, and the plaintiff’s actions to promote the mark.”<sup>75</sup>

The court also contemplates the similarity of the marks.<sup>76</sup> In evaluating the similarity of the marks, the court looks to the total effect of the mark, rather than a comparison of the marks’ individual features.<sup>77</sup> Additionally, the court gives weight to the dominant portion of the composite marks.<sup>78</sup> Evidence reviewed in analyzing the similarity of the marks includes the sound, sight, and meaning of the marks.<sup>79</sup> The court also considers the comparability of the goods and services represented by the mark.<sup>80</sup> In evaluating this factor, the court may review not only the type and features of the product, but also the price and appearance of the product.<sup>81</sup>

The court examines the relationship between the parties’ channel of trade, the relationship between the parties’ advertising, and the classes of prospective purchasers.<sup>82</sup> The court often considers these three factors together because they are frequently factually interrelated.<sup>83</sup> In evaluating these factors, the court looks to evidence of the venues and locations where the product or service is sold, the type and location of advertising, the targeted market, and the content of advertising.<sup>84</sup>

Another factor the court investigates is evidence of actual confusion between the marks.<sup>85</sup> Evidence of actual confusion is the best predictor of future confusion.<sup>86</sup> For this factor, the court typically looks to evidence such as consumers contacting

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75. *Star Fin. Servs., Inc. v. AASTAR Mortgage Corp.*, 89 F.3d 5, 11 (1st Cir. 1996) (citing *Equine Techs., Inc. v. Equitechnology, Inc.* 68 F.3d 542, 547 (1st Cir. 1995)); *see also* *Beacon Mut. Ins. Co. v. OneBeacon Ins. Group*, 376 F.3d 8, 19 (1st Cir. 2004) (considering market share percentages, consumer surveys, amount invested in promoting the mark and length of time the mark was used in evaluating the strength of the mark).

76. *Pignons*, 657 F.2d at 487.

77. *Id.*

78. *Beacon Mut. Ins. Co.*, 376 F.3d at 18 (finding similarity of marks where the dominant portion of both marks was “Beacon”).

79. *Volkswagenwerk Aktiengesellschaft v. Wheeler*, 814 F.2d 812, 817 (1st Cir. 1987).

80. *Pignons*, 657 F.2d at 487.

81. *See id.* at 487–88 (evaluating the similarity of the goods by comparing the features, appearance, accessories, and price of the cameras); *see also* *Attrezzi, LLC v. Maytag Corp.*, 436 F.3d 32, 39 (1st Cir. 2006) (looking to the breadth of products the mark applied to in evaluating the similarity of goods).

82. *Pignons*, 657 F.2d at 488.

83. *See id.* (considering simultaneously the relationship between the parties’ channels of trade, the relationship between the parties’ advertising, and the classes of prospective purchasers because the same facts illustrated these three factors).

84. *Id.* at 488–89.

85. *Id.* at 489.

86. *Beacon Mut. Ins. Co. v. OneBeacon Ins. Group*, 376 F.3d 8, 18 (1st Cir. 2004).

one company seeking the product or service of the other company<sup>87</sup> or media confusion regarding the products.<sup>88</sup>

Finally, the court may consider the defendant's intent in adopting the mark.<sup>89</sup> In determining whether there was bad faith in using the mark, courts have looked to evidence of advice from counsel regarding adoption of the mark,<sup>90</sup> as well as evidence of intent to benefit from the reputation of the holder of the other mark.<sup>91</sup>

### III. THE COURT'S REASONING

The First Circuit held that Boston Duck's trademark infringement claim was not likely to succeed on the merits, and therefore the district court erred in issuing a preliminary injunction.<sup>92</sup> Writing for the majority, Judge Lipez first reviewed the standard for deciding a motion for preliminary injunction.<sup>93</sup> The court noted that the touchstone factor of the preliminary injunction inquiry is the plaintiff's likelihood of success on the merits.<sup>94</sup> The court considered the likelihood of success on the composite word mark infringement claim separately from the design mark infringement claim.<sup>95</sup>

#### A. The Court's Word Mark Infringement Analysis

In evaluating the first prong of a trademark infringement claim, the court performed a genericism analysis of the term "duck tours," despite Super Duck's admission "that the mark BOSTON DUCK TOURS is entitled to trademark

87. See *Attrezzi, LLC v. Maytag Corp.*, 436 F.3d 32, 40 (1st Cir. 2006) (listing instances of customers confusing one of the company's stores as a subsidiary of the other company); *Pignons*, 657 F.2d at 489–90 (considering instances in which orders for the products of one company were sent to the other company).

88. *Pignons*, 657 F.2d at 489 (analyzing alleged misspellings of the trademark in advertisements, catalogues, magazines and newspapers as evidence of actual confusion).

89. *Id.* at 491.

90. See *Attrezzi*, 436 F.3d at 40 (finding bad faith where the company was advised by in-house counsel of the risk of confusion and adopted the mark regardless).

91. *Volkswagenverk Aktiengesellschaft v. Wheeler*, 814 F.2d 812, 819 (1st Cir. 1987) (finding that the defendant adopted the mark with the intention of indicating his auto repair shop specialized in the repair of Volkswagen cars in an attempt to benefit from Volkswagen's reputation).

92. *Boston Duck Tours, LP v. Super Duck Tours, LLC*, 531 F.3d 1, 31 (1st Cir. 2008).

93. *Id.* at 11. The court weighs several factors in a preliminary injunction inquiry, including the plaintiff's likelihood of success on the merits, the potential for irreparable harm without an injunction, whether issuing an injunction would burden defendants less than denying an injunction would burden the plaintiffs, and the effect on the public interest. *Id.*

94. *Id.* (quoting *Philip Morris, Inc. v. Harshbarger*, 159 F.3d 670, 674 (1st Cir. 1998), *rev'd on other grounds*, 267 F.3d 45 (1st Cir. 2001)). When considering a preliminary injunction on appeal, the court reviews the findings of fact for clear error and the substantive legal claims *de novo*, overturning the district court decision only if the court clearly erred or abused its discretion. *Id.* (quoting *Wine & Spirits Retailers, Inc. v. Rhode Island*, 418 F.3d 36, 46 (1st Cir. 2005)).

95. Compare *id.* at 14 ("We begin with Boston Duck's trademark infringement claim against Super Duck based on the parties' word marks."), with *id.* at 27 ("We turn now to the infringement analysis of the parties' composite design marks." (footnote omitted)).

protection, thereby conceding the first element” of the trademark infringement claim.<sup>96</sup> However, as a result of Super Duck’s concession that Boston Duck’s mark was protectable under the Lanham Act, the court noted that its main focus was on the second prong of the trademark infringement analysis—likelihood of confusion—which uses the eight-factor *Pignons* test.<sup>97</sup>

Before specifically addressing the eight *Pignons* factors, the court concentrated the beginning of its likelihood of confusion analysis on evaluating the genericism of the phrase “duck tours” because of its impact on the *Pignons* factors, particularly strength of the mark.<sup>98</sup> The court stated that the district court was proper in analyzing both the conceptual and commercial strength of the plaintiff’s mark in the likelihood of confusion analysis, particularly where a mark contains an arguably generic phrase,<sup>99</sup> despite First Circuit precedent, which focuses solely on commercial strength.<sup>100</sup> The court feared that by measuring the strength of BOSTON DUCK TOURS “only on the basis of practical, commercial factors, [it] would risk affording greater protection to the mark than is warranted. Specifically, [the court] would risk recognizing commercial strength that is the result of the descriptive force of the unprotectable generic element ‘duck tours.’”<sup>101</sup> The court thus determined that it was not foreclosed from assessing both the conceptual and commercial strength in its evaluation of the likelihood of confusion analysis.<sup>102</sup> Mirroring the district court’s analysis by evaluating the mark’s conceptual and commercial strength, the First Circuit nevertheless rejected the district court’s conclusion and determined that the

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96. *Id.* at 11. Generic terms are incapable of becoming trademarked because they do not identify the source of the product, but rather, describe the product. *Id.* at 14.

97. *Id.* at 15.

98. *Id.* at 15–16. The court noted that the district court did not evaluate the strength of the composite mark, BOSTON DUCK TOURS, but rather, only evaluated the strength of the phrase “duck tours.” *Id.* at 16. If the district court’s conclusion that the phrase “duck tours” was non-generic and thus capable of protection under the Lanham Act was erroneous, then the district court’s analysis of the other *Pignons* factors was affected, so the First Circuit began by analyzing the genericism of the phrase “duck tours.” *Id.* at 16 n.15. The court noted that analyzing the genericism of the phrase “duck tours” did not violate the anti-dissection rule because it was only using this analysis as a preliminary step in determining customer reaction to the conflicting composites as a whole. *Id.* at 17 n.20.

99. *Id.* at 16–17. The court indicated that a mark’s classification on the spectrum of distinctiveness is dependent on societal and market conditions. *Id.* at 17 n.17 (“Words do not exist in a vacuum. They have definitions, associations, and connotations, all of which contribute to the conceptual strength analysis because they reflect how consumers view the words in the marketplace.”).

100. See *Attrezzi, LLC v. Maytag Corp.*, 436 F.3d 32, 40 (1st Cir. 2006) (stating practical matters and not legal classification of a mark are important in determining the strength of a mark). The court distinguished this case from precedent in *Attrezzi*, noting that the *Attrezzi* court considered a mark with only one element and was determining whether a mark was inherently weak because it was suggestive rather than arbitrary. *Boston Duck Tours*, 531 F.3d at 17 n.18 (citing *Attrezzi*, 436 F.3d at 40). In this case, the court was instead considering a mark with multiple elements and a “generic” classification rather than suggestive or arbitrary. *Id.* at 17.

101. *Boston Duck Tours*, 531 F.3d at 17.

102. *Id.* at 17 n.19.

phrase “duck tours” is generic.<sup>103</sup> The court found that in addition to using the wrong legal standard to evaluate a mark’s genericism,<sup>104</sup> the district court erred in focusing on the terms “duck” and “tours” separately.<sup>105</sup>

After reaching the conclusion that the phrase “duck tours” was generic and therefore did not warrant protection under the Lanham Act, the court, using the eight-factor *Pignons* analysis, evaluated the likelihood of consumer confusion of the composite mark, BOSTON DUCK TOURS.<sup>106</sup>

In analyzing the strength of the composite mark, the court again considered both the mark’s conceptual and commercial strength.<sup>107</sup> In evaluating its conceptual strength, the court stated the composite mark was highly descriptive because it combines a general phrase with “Boston,” a weak term deserving minimal protection.<sup>108</sup> Though the court found that the composite mark was weak, its relative weakness was mitigated by the secondary meaning developed from its continuous use in the Boston area for thirteen years.<sup>109</sup> In evaluating the marks’ commercial strength, the court determined that Boston Duck had received substantial national and international press coverage, as well as awards for its services in the Boston area.<sup>110</sup> Additionally, the company was using six times the amount of “ducks” it started with in 1994, and the number of customers had significantly increased.<sup>111</sup> Thus, the court concluded that the composite mark BOSTON DUCK TOURS was “reasonably strong overall as an identifier of Boston Duck’s tour services in the Boston area, although part of the mark—‘duck tours’—is entitled to no trademark protection at all.”<sup>112</sup>

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103. *Id.* at 18. The court found that the district court relied exclusively on the dictionary definition of “duck,” which did not include any reference to DUKWs or other amphibious vehicles. *Id.* at 16. In finding that the tour does not involve ducks, but rather is a play on the acronym DUKW, the district court believed “duck tours” was non-generic because it does not refer to the general meaning of the word. *Id.*

104. *Id.* at 18. The district court should have relied on several factors, including consumer surveys, use of the term in media publications, use of the term by competitors, purchaser testimony concerning the phrase, and the plaintiff’s use of the term; rather than just the dictionary definition. *Id.* (citing *Colt Def. LLC v. Bushmaster Firearms, Inc.*, 486 F.3d 701, 706 (1st Cir. 2007)). Had the district court evaluated these factors, it would have found that the *Boston Globe* used the term “duck tours” at least twice in its publication and that of 36 companies giving amphibious tour services in the world, 32 used the word “duck” in its name. *Id.* at 19. Additionally, the court should have considered that Boston Duck itself used the phrase “duck tours” generically on its website, as well as in documents provided to the court. *Id.* at 20.

105. *Id.* at 18–19 (finding the lower court should have considered the terms together because a complete phrase may signify something different than the sum of its parts). Ironically, in this part of the analysis, the court is considering the genericism of the phrase “duck tours” separate from the sum of the composite mark, BOSTON DUCK TOURS. *Id.* at 17–18.

106. *Id.* at 23.

107. *Id.*

108. *Id.*

109. *Id.*

110. *Id.*

111. *Id.* at 23–24.

112. *Id.* at 24.

*BOSTON DUCK TOURS v. SUPER DUCK TOURS*

The court next analyzed the degree of similarity between the two composite marks, BOSTON DUCK TOURS and SUPER DUCK TOURS.<sup>113</sup> The court only compared the non-generic components of the marks, “Boston” and “Super,” determining they were reasonably dissimilar because they had different looks, sounds, and meanings, though each was two syllables and followed by the same two-word phrase.<sup>114</sup>

Next, the court determined that the services offered by Boston Duck and Super Duck were virtually identical, with the exception of their tour routes.<sup>115</sup> The court considered three of the *Pignons* factors together—the relationship between the parties’ channels of trade, the relationship between the parties’ advertising, and the classes of prospective purchasers—and determined that the services had significant overlap and the two companies were close competitors.<sup>116</sup>

In analyzing the evidence of actual confusion, the court concluded that the documented instances of actual confusion by customers who thought the two companies were affiliated were diminished in value because they stemmed from the genericism of “duck tours” and Boston Duck’s lack of competition for thirteen years.<sup>117</sup>

Finally, the court analyzed Super Duck’s intent in adopting the mark and concluded Super Duck’s adoption of the mark was not suspect, similar to the district court’s conclusion, because the marks are reasonably dissimilar as a result of using the generic phrase “duck tours.”<sup>118</sup> The court also noted that Super Duck did not act in bad faith because they adopted their mark in Portland, Maine several years before Boston Duck was created.<sup>119</sup>

Thus, the court ultimately concluded that the district court erred in determining that Boston Duck was likely to succeed on the merits of its trademark infringement claim because the analysis of the *Pignons* factors did not establish a likelihood of confusion.<sup>120</sup>

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113. *Id.*

114. *Id.* at 25.

115. *Id.*

116. *Id.* In its cursory acceptance of the lower court’s analysis, the court noted that Super Duck did not dispute that it is a close competitor with Boston Duck. *Id.*

117. *Id.*

118. *Id.* at 26.

119. *Id.*

120. *Id.* at 26–27.

*B. Design Mark Infringement Analysis*

The court also went through the infringement analysis for Boston Duck's composite design mark.<sup>121</sup> The court decided that the lower court failed to properly analyze all of the *Pignons* factors in analyzing the likelihood of confusion between the marks, and thus its analysis was too limited.<sup>122</sup>

In analyzing the likelihood of confusion of the design marks, the court again went through a genericism analysis and determined the district court's comparison was improper because it assumed all of Super Duck's logo elements were nongeneric.<sup>123</sup> Though Super Duck contended that "virtually every duck tour company in the country uses a cartoon duck in its logo," the court determined that many did not.<sup>124</sup> The record lacked evidence demonstrating whether the public found the image of a cartoon duck synonymous with duck tours.<sup>125</sup> The court also determined that because there were available effective alternatives, giving one entity exclusive use of the design would not give an advantage.<sup>126</sup> However, the court ultimately concluded that it could not find the district court clearly erred in finding the mark non-generic, noting the mark was highly descriptive of its offered services and therefore a weak identifier of the source.<sup>127</sup>

The court then analyzed the strength of the composite design mark, considering again both the conceptual and commercial strength of the mark.<sup>128</sup> The court's analysis was similar to the word mark analysis, concluding that due to its long-term use in the Boston area, "the composite design mark is reasonably strong, despite the fact that it contains elements that have an inherently weak capacity as source-identifiers."<sup>129</sup>

Next the court analyzed the similarity of the marks, finding the marks substantially dissimilar after considering the "colors used, the text, and the various design elements contained therein."<sup>130</sup> The court again noted that despite sharing a duck, the mark is descriptive of its services, and not its source.<sup>131</sup>

121. *Id.* at 27.

122. *Id.* The district court only considered the similarity of the design marks separately. *Boston Duck Tours, LP v. Super Duck Tours, LLC*, 514 F. Supp. 2d, 119, 124 (D. Mass. 2007), *rev'd*, 531 F.3d 1 (1st Cir. 2008).

123. *Boston Duck Tours*, 531 F.3d at 27–28. The court noted that the strength of the mark weighs heavily in the consideration of other factors. *Id.*

124. *Id.* at 28.

125. *Id.*

126. *Id.*

127. *Id.*

128. *Id.* at 29.

129. *Id.* (noting that its strength is mostly derived from its exclusive use as the only duck tour provider in the Boston area for thirteen years).

130. *Id.* (indicating that the only similarity between the marks was the cartoon duck—the background scene, coloring, and font were all distinctive).

131. *Id.* at 30.

*BOSTON DUCK TOURS V. SUPER DUCK TOURS*

The court also reviewed evidence of actual confusion, concluding there was no specific evidence directly traceable to the companies' design marks.<sup>132</sup> For the remaining five *Pignons* factors, the court used the same analysis it used in its word mark analysis because these factors related to the parties and not the marks themselves.<sup>133</sup>

The court concluded that although five of the factors, including the strength of the mark, weighed in favor of Boston Duck, the lack of evidence demonstrating bad faith by Super Duck in adopting the mark went against finding infringement of the design mark.<sup>134</sup> Thus, the court held that the district court erred in determining Boston Duck was likely to be successful on the merits of the design mark infringement claim and erroneously issued a preliminary injunction.<sup>135</sup>

*C. Concurrence*

Judge DiClerico concurred with the majority that the preliminary injunction was erroneous.<sup>136</sup> However, Judge DiClerico would not have permitted a consideration of the genericism of the marks in the likelihood of confusion analysis: since both parties conceded that the word marks were protected under the Lanham Act, and thus satisfied the first element, the crux of the case was in the second element, the likelihood of confusion test.<sup>137</sup> In considering the eight factors, particularly the strength of mark, Judge DiClerico considered only the commercial, practical strength of the marks, following First Circuit precedent.<sup>138</sup> Despite using a different test, Judge DiClerico reached the same decision as the majority, finding that the district court improperly issued the preliminary injunction.<sup>139</sup>

IV. ANALYSIS

In *Boston Duck Tours v. Super Duck Tours*, the First Circuit held that Boston Duck's word and design mark infringement claims were unlikely to succeed on the merits, and therefore the district court erroneously issued a preliminary injunction.<sup>140</sup> The conflated test adopted by the First Circuit considers the conceptual and commercial strength in the eighth *Pignons* factor, "strength of the mark," thus ignoring First Circuit precedent and giving undue weight to a mark's legal classification by

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132. *Id.*

133. *Id.*

134. *Id.*

135. *Id.*

136. *Id.* at 31 (DiClerico, J., concurring in judgment).

137. *Id.* at 32–33.

138. *Id.* at 34–37.

139. *Id.* at 38.

140. *Id.* at 31 (majority opinion).

considering it in both prongs of the infringement analysis.<sup>141</sup> The *Super Duck Tours* infringement test also violates the “anti-dissection” rule.<sup>142</sup> Finally, the test offered by the *Super Duck Tours* court fails to fulfill the purpose of the “likelihood of confusion” analysis, which is determining the strength of the mark after its existence in the market.<sup>143</sup> However, even if the court used the proper test, and considered the first and second prongs separately, it would likely have reached the same conclusion.<sup>144</sup>

*A. The Court Ignored First Circuit Precedence and Gave Undue Weight to a Mark’s Legal Classification by Conflating the First and Second Prongs of the Trademark Infringement Analysis*

The First Circuit had previously adhered to a trademark infringement analysis that considered the mark’s conceptual strength strictly in the first prong of its analysis, and only analyzed its practical, commercial strength in the second prong.<sup>145</sup> A court is bound by precedent, unless there is an intervening circumstance that would warrant a change.<sup>146</sup> In this case there were no intervening circumstances that warranted a change in the administration of the traditional “strength of mark” analysis because the facts of *Super Duck Tours* were typical of a trademark infringement case.<sup>147</sup> Evaluating the conceptual strength—the mark’s placement on the spectrum of distinctiveness—in the second prong was not “a proposition supported by any First Circuit case law and its logic [was] not apparent.”<sup>148</sup> However, it should be noted that other circuits do consider a mark’s conceptual and commercial strength in their “strength of mark” analysis.<sup>149</sup> Regardless of the tests used in other circuits, the First Circuit in *Attrezzi* emphasized that the focus of the strength analysis was the mark’s perception in the marketplace, not the mark’s legal classification.<sup>150</sup> Though the *Super Duck Tours* court attempted to distinguish

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141. See *infra* Part IV.A.

142. See *infra* Part IV.B.

143. See *infra* Part IV.C.

144. See *infra* Part IV.D.

145. See *Pignons S.A. de Mecanique de Precision v. Polaroid Corp.*, 657 F.2d 482, 491 (1st Cir. 1981) (creating the eight-factor infringement analysis test and analyzing only evidence of practical, commercial strength in evaluating the “strength of the mark” factor).

146. *Boston Duck Tours, LP v. Super Duck Tours, LLC*, 531 F.3d 1, 33 n.35 (1st Cir. 2008) (citing *Amato v. United States*, 450 F.3d 46, 53 (1st Cir. 2006)).

147. *Id.* at 8–11 (the facts in *Boston Duck Tours* are not dramatically different from other infringement cases such that it would warrant a different test—the court was merely considering another word and design mark infringement case with basic word similarities and color/design similarities).

148. *Attrezzi, LLC v. Maytag Corp.*, 436 F.3d 32, 40 (1st Cir. 2006).

149. See *supra* note 74.

150. *Attrezzi*, 436 F.3d at 40.

*Attrezzi* from the instant case,<sup>151</sup> the First Circuit's precedent should have foreclosed the court from considering a mark's conceptual strength in the second prong of the infringement analysis, as it is already evaluated in the first prong.<sup>152</sup>

By considering the conceptual strength of the mark in both the first and second parts of the analysis, the court gave the mark's legal classification twice as much weight as its commercial strength. In determining the strength of the mark in the likelihood of confusion analysis, the *Super Duck Tours* court went through a "genericism" analysis, evaluating the mark's conceptual strength.<sup>153</sup> However, the genericism analysis is part of determining whether the mark is due protection under the Lanham Act, which is the first prong of the infringement analysis.<sup>154</sup> Having already conceded that Boston Duck's mark is protectable under the Lanham Act, the court should have limited the parties to arguing only the second prong: the likelihood of confusion analysis.<sup>155</sup> Thus, by considering the mark's conceptual strength again during the likelihood of confusion analysis, the court gave twice the consideration to the mark's conceptual strength than to its commercial, practical strength.<sup>156</sup>

It seems the majority was motivated, at least in part, to consider the mark's conceptual strength in the second prong of the infringement analysis because the court did not agree with Super Duck's concession that the mark deserved Lanham Act protection.<sup>157</sup> By performing a genericism analysis of the word mark in the second prong, the court was able to effectively sidestep the fact that Super Duck had already conceded the first prong.<sup>158</sup> Thus, the court opened up the possibility for future alleged infringers who concede the first element and admit the plaintiff's

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151. *Boston Duck Tours*, 531 F.3d at 17 n.18 (noting that the mark in *Attrezzi* was not a composite mark, unlike the composite marks at issue in this case). The court also elicited concern that failing to consider a mark's conceptual strength, especially when the composite mark contains a generic word or phrase, could potentially result in giving the mark more protection than necessary. *Id.* at 17. Essentially, the court would find commercial strength that is derived from the generic portion of the word. *Id.*

152. *See Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992) (evaluating the mark's placement on the distinctiveness spectrum in determining whether the mark warranted protection under the Lanham Act).

153. *Boston Duck Tours*, 531 F.3d at 16–18.

154. *See Two Pesos*, 505 U.S. at 768 (noting that a term is protected based on where it falls on the spectrum of distinctiveness).

155. *Boston Duck Tours*, 531 F.3d at 33 (DiClerico, J., concurring in judgment).

156. *Compare id.* at 9, 16 (majority opinion) (analyzing the mark's legal classification in the likelihood of confusion analysis despite Super Duck conceding Boston Duck's marks are protected and thus Boston Duck satisfies the first prong in the analysis), *with Borinquen Biscuit Corp. v. M.V. Trading Corp.*, 443 F.3d 112, 116–21 (1st Cir. 2006) (analyzing the mark's legal classification in the first prong of the trademark infringement analysis and solely its commercial strength in the second prong of the analysis, likelihood of confusion).

157. *Boston Duck Tours*, 531 F.3d at 17 (emphasizing that by measuring the strength of the word mark "only on the basis of practical, commercial factors, [the court] would risk affording greater protection to the mark than is warranted").

158. *See id.* at 11 (stating that although Super Duck "acknowledged that the mark BOSTON DUCK TOURS is entitled to trademark protection, thereby conceding the first element of Boston Duck's trademark infringement claim," the court still evaluated the genericism of the phrase "duck tours").

mark is protectable, like Super Duck, to later renege that concession and challenge the mark's legal classification in the second part of the infringement analysis. This may potentially give rise to increased litigation over already agreed upon issues, and essentially permit alleged infringers to collaterally challenge a mark's legal classification.<sup>159</sup>

*B. The Conflated Test Violates the "Anti-Dissection" Rule*

By analyzing the phrase "duck tours" separately from its composite mark, the majority violated the "anti-dissection" rule.<sup>160</sup> When analyzing a trademark infringement case, the court must consider composite marks as a whole in determining the likelihood of confusion prong.<sup>161</sup> The court is thus required when analyzing the eight *Pignons* factors to review "the total effect of the designation, rather than a comparison of individual features."<sup>162</sup> The anti-dissection rule ensures that courts evaluate the mark in the same way as a prospective buyer—by considering its commercial impression as a whole.<sup>163</sup> Here, the court separated the composite marks into two pieces: "duck tours" and the preceding word, either "Boston" or "Super."<sup>164</sup> Though the court claimed that it was not violating the anti-dissection rule by evaluating whether the "duck tours" component of the mark is generic,<sup>165</sup> the court ultimately dissected the word marks in evaluating the marks' likelihood of confusion by comparing only the different components of the marks, "Boston" and "Super."<sup>166</sup> By considering the likelihood of confusion of only the individual components of the marks, the court failed to evaluate the marks as a whole, in the way that a consumer in the marketplace would perceive the marks.<sup>167</sup>

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159. See *id.* at 33 (DiClerico, J., concurring in judgment) (indicating that the case should not turn on whether part of the mark is entitled to trademark protection because the parties already admitted in the first prong that the marks are entitled to trademark protection).

160. *Id.*

161. MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, *supra* note 72.

162. *Pignons S.A. de Mecanique de Precision v. Polaroid Corp.*, 657 F.2d 482, 487 (1st Cir. 1981) (quoting *Alpha Indus., Inc. v. Alpha Steel Tube & Shapes, Inc.*, 616 F.2d 440, 444 (9th Cir. 1980) (internal quotations omitted)). Compare *Alpha*, 616 F.2d at 444 (finding likelihood of confusion between two marks both utilizing the word "Alpha" was low because of the word's close proximity on the product to the uniquely identifying manufacturer's name and dissimilar packaging), with *Beacon Mut. Ins. Co. v. OneBeacon Ins. Group*, 376 F.3d 8, 18 (1st Cir. 2004) (finding similarity of marks where the dominant portion of both marks was "Beacon").

163. MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, *supra* note 72.

164. *Boston Duck Tours*, 531 F.3d at 15–16 (majority opinion) (analyzing the genericism of the phrase "duck tours" separately from the composite term in the likelihood of confusion prong of the trademark infringement analysis).

165. *Id.* at 17 n.20 (claiming that the court is not violating the anti-dissection rule because it is a "preliminary" analysis of probable customer reaction to the conflicting composite marks).

166. See *id.* at 23 (evaluating the strength of the mark and stating that the mark combined a generic phrase, "duck tours," with "Boston," a descriptive term, deserving minimal protection).

167. See MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, *supra* note 72 (noting that the purpose of the anti-dissection rule is to ensure that the court evaluates the mark as a consumer would—by its whole commercial impression); see also 2 GILSON ON TRADEMARKS 5-44 (Anne Gilson Lalonde, ed. 2009) ("Consumers

Thus, the majority violated the anti-dissection rule, which prohibits consideration of individual pieces of a composite mark in the likelihood of confusion analysis.<sup>168</sup>

*C. Conflating the First and Second Elements Fails to Fulfill the Purpose of the “Likelihood of Confusion” Analysis*

By conflating the first and second elements of the trademark infringement analysis, particularly in the “strength of mark” factor, the court failed to fulfill the purpose of the “likelihood of confusion” analysis. The purpose of the second prong of the trademark infringement analysis is to determine whether the mark’s use in the marketplace is likely to create confusion.<sup>169</sup> In order to evaluate the mark’s likelihood of confusion in the marketplace, the court must look to practical matters, such as “the length of time a mark has been used and the relative renown in its field; the strength of the mark in plaintiff’s field of business; and the plaintiff’s action in promoting the mark.”<sup>170</sup> Analyzing a mark’s place on the spectrum of distinctiveness does not provide any information about the mark’s actual use in the marketplace and actual confusion among consumers.<sup>171</sup> Thus, by conflating the first part of the analysis, which considers the “legal issue of a mark’s conceptual strength,” and the second part of the infringement analysis, which focuses on “the practical issue of its commercial strength,” the court failed to fulfill the purpose of the likelihood of confusion analysis by failing to focus on the mark’s practical use in the marketplace.<sup>172</sup>

*D. The Court Would Have Reached the Same Conclusion If It Considered the First and Second Elements Separately*

Though the court erred in considering the marks’ legal classifications in the likelihood of confusion analysis, had the court used the appropriate test, it would have reached the same conclusion that Boston Duck was unlikely to succeed on the merits of its infringement claim.<sup>173</sup> Both parties conceded that Boston Duck’s composite marks were protectable, and in fact protected, under the Lanham Act.<sup>174</sup> Thus, the case should have exclusively hinged on the second part of the infringement analysis, the eight-factor likelihood of confusion test.<sup>175</sup>

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under actual product selection circumstances rarely analyze trademarks minutely or compare their various elements.”).

168. See *Astra Pharm. Prods., Inc. v. Beckman Instruments, Inc.*, 718 F.2d 1201, 1205 (1st Cir. 1983).

169. *Boston Duck Tours*, 531 F.3d at 34 (DiClerico, J., concurring in judgment).

170. *Equine Techs., Inc. v. Equitechnology, Inc.*, 68 F.3d 542, 547 (1st Cir. 1995) (quoting *Keds Corp. v. Renee Int’l Trading Corp.*, 888 F.2d 215, 222 (1st Cir. 1989) (internal quotation marks omitted)).

171. *Boston Duck Tours*, 531 F.3d at 34.

172. *Id.*

173. Compare *id.* at 31 (majority opinion), with *id.* at 38 (DiClerico, J., concurring in judgment).

174. *Id.* at 33 (DiClerico, J., concurring in judgment).

175. *Id.*

Under the “strength of mark” factor, the court, considering only evidence of the mark’s practical, commercial strength, would have likely found Boston Duck’s composite marks were relatively weak.<sup>176</sup> In analyzing the strength of mark, the court should have considered evidence of the mark’s source-identifying strength in the marketplace, such as length of the mark’s use, the holder’s renown in the industry, and the holder’s efforts to promote and protect the mark.<sup>177</sup> Though Boston Duck used its marks exclusively in the Boston area for over a decade, it is not the first company or longest-running duck tour in the industry—there are many other companies offering the same service using the word “duck” or “duck tour” in their marks.<sup>178</sup> Although Boston Duck’s marks are widely recognized in Boston, the common use of the phrase “duck tours” in describing the service offered by Boston Duck renders the mark weak.<sup>179</sup>

The court would have likely found that the similarity of the marks, considering the total effect of the marks, is minimal.<sup>180</sup> Though both marks contain the phrase “duck tours,” the marks have different first words, “Boston” and “Super,” and the court would have likely found the overall impression of the marks suggests the same service offered by two different companies.<sup>181</sup> The logos both show ducks, though in different contexts, and offer different colors and themes.<sup>182</sup> Thus, the logos would have reinforced the lack of similarity between the companies’ marks.

In evaluating actual confusion of the marks, the court would have likely found that the evidence of confusion was due to Boston Duck offering the only duck tour service in the Boston area for thirteen years, not because of the marks.<sup>183</sup> Also, the court would have likely found that companies’ channels of trade, advertising, and customers are shared because the parties concede these elements.<sup>184</sup> Finally, the court would have also likely found the similarity of services between Boston Duck and Super Duck is virtually identical.<sup>185</sup>

Thus, in weighing the eight factors in the likelihood of confusion analysis, without considering the marks’ conceptual strength, the court would have probably

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176. *See id.* at 37.

177. *See id.* at 36.

178. *Id.* at 37.

179. *See id.*

180. *See id.* at 34 (noting that if the dominant features of the marks are similar, then that may cause confusion and that disclaimed portions of marks are typically not the dominant part of a composite word mark).

181. *Id.* at 35.

182. *Id.*

183. *See id.* at 35–36 (noting that the majority of confusion between the two companies arose during Super Duck’s first weeks of operation).

184. *Id.* at 35.

185. *Id.*; *see also id.* at 25 (majority opinion) (finding that the similarity of services offered by the two companies is virtually identical excepting the actual tour routes).

found that while some of the factors show a tendency for consumer confusion, most of the marks weigh strongly against finding a likelihood of consumer confusion.<sup>186</sup> Though the court used a conflated test that could be problematic in the future, the court would have ultimately reached the same holding using the appropriate test, finding that the district court improperly issued the preliminary injunction.<sup>187</sup>

V. CONCLUSION

The court held that Boston Duck failed to establish a likelihood of success on the merits of its trademark infringement claims and thus the district court erred in issuing a preliminary injunction.<sup>188</sup> In so holding, the court conflated the first and second elements of the trademark infringement analysis.<sup>189</sup> The court ignored First Circuit precedent, which does not consider a mark's conceptual, legal classification in the likelihood of confusion analysis.<sup>190</sup> In so doing, the court gives conceptual strength more weight than commercial strength and permits future alleged infringers an escape from conceding that the mark qualifies for Lanham Act protection in the first element of the trademark analysis.<sup>191</sup> Additionally, the court's new test violates the "anti-dissection" rule of trademark infringement analysis.<sup>192</sup> Finally, the *Super Duck Tours* test fails to fulfill the purpose of the likelihood of confusion analysis.<sup>193</sup> Despite merging the first and second elements, if the court had used the proper test and considered these elements separately, it would have likely reached the same conclusion.<sup>194</sup> By following this particular test, the First Circuit may have been attempting to conform to other circuits' tests, which consider a mark's conceptual strength and commercial strength in the "strength of mark" analysis.<sup>195</sup> However, the fact that other circuits are using that particular test does not make it the correct test—the anti-dissection rule, the purpose of the "likelihood of confusion" test, and the doubled weight of the mark's conceptual strength are still issues that make the conflated test problematic.<sup>196</sup> Thus, unless and until the Supreme Court decides whether the conceptual strength of a mark should be considered in evaluating a mark's likelihood of confusion, the First Circuit should continue to follow its precedent and continue to consider a mark's conceptual strength only in the first part of the infringement analysis.

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186. *Id.* at 37 (DiClerico, J., concurring in judgment).

187. *Id.* at 38.

188. *Id.* at 31 (majority opinion).

189. *See supra* Part IV.

190. *See supra* Part IV.A.

191. *See supra* Part IV.A.

192. *See supra* Part IV.B.

193. *See supra* Part IV.C.

194. *See supra* Part IV.D.

195. *See supra* note 74 and accompanying text.

196. *See supra* notes 190–94 and accompanying text.