

World Trademark Report

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Dictionary definition cannot save DUCK TOURS from being generic

In *Boston Duck Tours LP v Super Duck Tours LLC* (Case 07-2078, -2246, June 18 2008), the US Court of Appeals for the First Circuit has lifted a preliminary injunction against *Super Duck Tours*, finding that the phrase 'duck tour' was generic.

Boston Duck Tours LP began operating its amphibious vehicle tours in Boston in 1994. Boston Duck Tours owns several state and federal trademark registrations for:

- the composite word mark BOSTON DUCK TOURS; and
- a composite design mark consisting of the company's name and logo.

It owns federal registrations on the Principal Register that are subject to disclaimers for the terms 'duck' and 'tours'.

Super Duck Tours began its operations in 2001 by offering tours in Portland, Maine. Super Duck Tours began operating in Boston in late 2007. Super Duck Tours owns a federal registration for the word mark SUPER DUCK TOURS on the Supplemental Register. In its registration, Super Duck Tours disclaimed the phrase 'duck tours'.

Boston Duck Tours sued Super Duck Tours under the *Lanham Act* for infringement of both its word and composite marks, along with a host of other federal and state law claims. As part of its suit, Boston Duck Tours sought a preliminary injunction against Super Duck Tours. The district court, as part of its analysis under *Pignons SA de Mécanique de Précision v Polaroid Corp*, relied heavily on a dictionary definition of 'duck' which, not surprisingly, included no reference to amphibious vehicles. The district court thus concluded that the term 'duck tours' was not generic in terms of the services at issue. After completing the rest of the eight-part likelihood of confusion analysis, the district court found that Boston Duck Tours had established a likelihood of success on the merits. Therefore, the court enjoined Super Duck Tours from using the terms 'duck tours' and 'duck' in two or three-word trademarks in conjunction with the words 'Boston' or 'tours'. Super Duck Tours appealed.

In reviewing the determination that the term 'duck tours' was not generic, the First Circuit expressed its appreciation of the time pressure that the court faced in ruling on Boston Duck Tours' preliminary injunction motion. Nevertheless, it concluded that the district court had failed to identify and apply the appropriate legal standard. As a result, the district court's factual conclusion as to whether 'duck tours' was generic was erroneous. The district court was faulted for relying on a single dictionary definition of 'duck', rather than the primary significance to the relevant public. Specifically, the First Circuit stated that the district court had wrongly overlooked relevant evidence in the record as to whether the term 'duck tour' was generic in terms of the tour services at issue.

As explained by the First Circuit, the district court, as part of its determination, should have considered:

- uses by the media and other third parties;
- uses within the industry generally; and
- uses by Boston Duck Tours itself.

With respect to the media and other third parties, the court found ample evidence in the Boston media to support the position that the term 'duck tours' is generic when referring to amphibious vehicle tours. As to the second type of use, the court found that 36 companies provide a similar type of tour services, 32 of which use the word 'duck' in their name and 10 of which use both 'duck' and

'tour(s)' in their trade name. Finally, focusing on articles provided by Boston Duck Tours to the district court for the purpose of establishing the fame (and its promotion) of the mark, the court concluded that Boston Duck Tours' evidence proved only that Boston Duck Tours itself used the phrase 'duck tours' as a common phrase to describe amphibious sightseeing tours generally, as opposed to uniquely identifying Boston Duck Tours' services.

Although the court went on to address the other *Pignons* factors, its finding that the phrase 'duck tours' is generic essentially sounded the death knell for Boston Duck Tours. For example, turning to the similarity analysis, the court found that when emphasis is properly placed on the words 'Boston' and 'Super' (disregarding the generic term 'duck tours'), the marks are substantially dissimilar. To the extent that any similarity exists between the composite marks, the court concluded that such similarity is a result of each party's decision to include in its respective marks a generic phrase that described the services offered.

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