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LEGAL ISSUES

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Cases of Note — Trademark

If It Quacks Like a DUKW ...

by **Bruce Strauch** (The Citadel) <strauchb@citadel.edu>

Boston Duck Tours v. Super Duck Tours, United States Court of Appeals for the First Circuit, 531 F.3d 1; 2008 U.S. App. LEXIS 12771 (2008).

The WWII amphibious vehicle DUKW (pronounced “duck”) spawned a post-war water-borne sightseeing business around the US called “duck tours.” In 1994, **Boston Duck Tours** began business in — you guessed it — Boston. They used renovated DUKWs painted in rainbow colors and blazoned with the company logo. They were the sole company and were well established in the city.

Then in 2001 along came a competitor. **Super Duck** opened for business using custom-made boats called Hydra-Terras with fancy designs that make them virtually unsinkable. Their ad parodies Superman (“It’s a bus. It’s a boat. It’s a Super Duck!”), and their logo is a cartoon duck with muscular arms and a cape.

Boston Duck has a registered trademark with disclaimers for “duck” and “tours” which it cannot possess exclusively apart from the full mark.

Like “Against the Grain” which is also the name of a local surf board shop whose mail sometimes comes here to ATG World Headquarters. Not to mention the barber trade journal of that name we were getting a subscription to for a while.

Super Duck also has a registered mark and sells all kinds of apparel branded with it.

Ooo-kay. So who exactly wants to wear a golf shirt with the name of an amphibious tour on it? Are people just compelled to buy things for grandchildren back home?

At any rate, **Boston Duck** sued and got **Super Duck** enjoined from using the term “duck tours” or a cartoon duck as a trademark. Of course you’re already saying “huh?”, so let’s go to the appeal.

Trademark

Trademarks are not explicitly authorized by the Constitution like copyright and patent, but they provide such benefit in interstate commerce that they are protected by the **Lanham Act**. See generally 15 U.S.C. §§ 1051-1129.

Consumers rely heavily on trademarks when making choices, so naturally producers of shoddy goods love to create confusion by infringing marks.

In suing, you must show (1) your mark is entitled to protection, and (2) the allegedly infringing use is likely to cause consumer confusion. *Int’l Ass’n of Machinists and Aerospace Workers, AFL-CIO v. Winship Green Nursing Ctr.*, 103 F.3d 196, 200 (1st Cir. 1996).

You get protection if your mark can function as a source-identifier of goods. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 769 (1992). There is a spectrum of distinctiveness running from least to greatest: (1) generic, (2) descriptive, (3) suggestive, (4) arbitrary, or (5) fanciful. *Id.* At 768. **Suggestive**: COPPERTONE for sunscreen. (AGAINST THE GRAIN for a journal??). **Arbitrary**: APPLE for computers (Against the Grain with a tree??). **Fanciful**: EXXON for petroleum products.

Descriptive marks “convey an immediate idea of the ingredients, qualities or characteristics of the goods.” See *Equine Techs., Inc. v. Equitechology, Inc.*, 68 F.3d 542, 544 (1st Cir. 1995). SPORTS ILLUSTRATED pretty much tells you what you’ll find between the covers. But it doesn’t really identify the source of the product — *Time-Life*. Only when the title — dare I say — over time becomes distinct in the public mind as a particular publication of *Time-Life* does it have “acquired distinctiveness” or “secondary meaning” and receive trademark protection.

A generic term like “car” or “pizza” only tells what it is and not where it came from. See *Colt Def. LLC v. Bushmaster Firearms, Inc.*, 486 F.3d 701, 705 (1st Cir. 2007). You’d need DOMINO’S PIZZA for that. Which as you can see is taking us right into the issue of duck tours. The district court found “duck tours” was non-generic and **Super Duck Tours** would confuse the public.

Eight-Factor Pignons Test

Pignons S.A. de Mecanique de Precision v. Polaroid Corp., 657 F.2d 482 (1st Cir. 1981) gives us an eight-factor test for ...

Good grief! Surely

you don’t expect me to go through all eight. Usually a three-prong test is too exhausting. And anyhow, what’s the point of this column if it isn’t abbreviated?

Strength of Boston Duck mark

The “strength” of the mark refers to its placement on the spectrum of distinctiveness.

See above.

The district court did not classify “duck tours” as descriptive, suggestive, or fanciful but simply said it was non-generic and could receive trademark protection. They arrived at this by going to the dictionary and looking up “duck,” which is sure enough generic. Then they looked up “tours.” Yep, generic. Then they put the two together and said “non-generic” descriptor of the offered service based on the tour — *I’m not making this up* — not involving duck watching or duck hunting.

In fact, two generic words can be put together and be just as generic as ever. See *AmkCan Enters., Inc. v. Renzi*, 32 F.3d 233, 234 (7th Cir. 1994) (“yellow pages” generic for the business part of phone directory); *American Express Co. v. Mastercard Int’l.*, 685 F. Supp. 76, 78 (S.D.N.Y. 1988) (“gold card” generic for fancy credit card).

And also in fact, “duck tours” is generic for the amphibious sightseeing tours each company provides. Remember, a generic term is one whose impact on the consumer lies in telling the nature of the good and not its source.

Newspapers and the duck tour industry use the word generically in the same way they use “town trolley” or “harbor cruise.” **Boston Duck’s** Website notes that they did not originate the style of tour; it had been in existence for decades. Of the thirty-six companies worldwide that do this, thirty-two have “duck” in their company name. The public sees this as a product and not a source.

Super Duck could call their business “amphibious tours” but that would imply the boats rolled around on land part of the time. It would not describe the tour service the way the public sees it. See *Bayer Co. v. United Drug Co.*, 272 F. 505, 511 (S.D.N.Y. 1921) (which found “Aspirin” generic because consumers couldn’t accept alternative names for the product).

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Questions & Answers — Copyright Column

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QUESTION: *An interlibrary loan librarian in an academic library has received requests to photocopy a chapter instead of sending the book. If it is just a chapter from a book that the library owns, does the library own the copyright? Must the library pay copyright fees in order to supply the requested copy?*

ANSWER: The library does not own the copyright just because it purchased a copy of the book; the author or publisher owns the copyright. However, Section 108(d) of the *Copyright Act* permits libraries to make single copies of articles, book chapters, etc., at the request of a user if the copy becomes the property of the user, and the library displays prominently where the orders are placed and on the order form a notice about copyright. Further, libraries may provide copies of the same to borrowing libraries through interlibrary loan if the borrowing library makes the appropriate CONTU ILL guidelines certifications. So, under these conditions, there is no problem with reproducing book chapters for interlibrary lending.

QUESTION: *In a public library, if discarded books are sold at a nominal fee, is this not making a profit so that it would make the library ineligible for the library exceptions?*

ANSWER: Section 108(a) of the Act establishes the criteria that a library must satisfy in order to qualify for the section 108 exceptions. Section 108(a)(1) says that the reproduction and distribution must

not be for direct or indirect commercial advantage. A public library is not organized as a for-profit entity under the tax code of the United States. A public library is non-profit even though it may charge for some services such as selling discarded books if the income from these activities goes back to support the library.

QUESTION: *May a library circulate software, i.e., Microsoft Office products, with a copyright warning?*

ANSWER: Yes, nonprofit libraries may do so. Section 109(b) of the *Copyright Act* permits nonprofit libraries to lend copies of software for nonprofit purposes. In order to this, however, the library must include a copyright warning on the software package specified by the *Register of Copyrights* and published in the *Code of Federal Regulations*, see <http://www.law.cornell.edu/copyright/regulations/201.24.html>.

QUESTION: *Is a home school class in a public library the same as a traditional classroom for fair use purposes?*

ANSWER: Typically a nonprofit educational institution is a school that is organized as a school under the tax codes of the country. In the copyright sense, the problem with home schooling is that the exceptions that apply for nonprofit educational institutions apply to schools themselves. Home schooling is not a school in the traditional sense. The exceptions recognize the public good of nonprofit educational

institutions, and there is no institution in a home schooling situation.

On the other hand, a public library is also a nonprofit institution and there is an argument that they have become an educational institution for home-schooled students. If public libraries so claim, then only their activities for home-schooled students count, and they will have to satisfy the same restrictions as do nonprofit educational institutions when taking advantage of the exceptions. For example, Section 110(1) permits these institutions to display or perform copyrighted works, such as motion pictures, in a classroom to students and teachers as a part of instruction. But the exception requires that no one else may be present for the performance. Most public libraries would be conflicted about excluding other members of the public from such performances, but in order to qualify for the nonprofit educational institution exception for home-schooled students, the library would have to do so.

QUESTION: *Is there sufficient creative content in cataloging records to make them eligible for copyright protection?*

ANSWER: Unfortunately, no. This is not to say that catalogers are not incredibly creative in what they do! But for copyright law purposes, a work must be original; originality requires that the work originate with creator (i.e., not be copied from someone else), and have a least a bit of creativity. Some works are simply excluded from copyright protection according to Section 102(b) of the *Copyright Act*: ineligible works include concepts, systems, procedures, principles, or discoveries no matter how they are explained, illustrated, or embodied in a work. Cataloging records consist almost entirely of facts, and facts are not copyrightable. So, cataloging records are not copyrightable.

QUESTION: *A librarian runs a community library in the virtual metaverse of Second Life, located on a charity sim, the West of Ireland, and the charity it supports is Project Children, a 501(c)(3) organization. A free client program called the Second Life Viewer enables its users, called Residents, to interact with each other through avatars. Residents can explore, meet other residents, socialize, participate in individual and group activities, and engage in activities from the purely social, to diverse role-play, advocacy, continuing education, as well as in the creation of music, art and literature. Storytellers read stories in the West of Ireland and sometimes at other locations as volunteers. They receive no currency or gain, and no admission is charged to the simulation in which stories are read. Readings are done live in voice rather than streamed. Must the librarian obtain permission for these readings?*

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If **Boston Duck** got exclusive rights to the term, it would create barriers to entry for other companies and limit competition. See *Devan R. Desai & Sandra L. Rierson, Confronting the Genericism Conundrum*, 28 Cardozo L. Rev. 1789, 1851 (2007).

So What About the Composite Mark?

The generic “duck tours” has been shoved together with “Boston” which is a weak descriptive term worthy of only minimal protection. Its strength comes from long years of operating in the area during which the company grew from four boats to twenty-four and served over 585,000 customers. So that makes it “reasonably strong” as an identifier of the source of the service.

But can consumers be confused with **Super Duck**? In the analysis, you drop the generic parts out — duck tours. “Boston” and “Super” both have two syllables, but they look and sound different. Consumer confusion has largely come out of **Boston Duck** being the sole provider in the market for so long.

And then there’s the two logos — ducks splashing in the water. Nearly every company in the world uses some version of a cartoon duck with water. This again is describing a service and not a source. See *Lawrence v. P.E. Sharpless Co.*, 203 F. 762 (E.D. Pa. 1913) (finding the image of a cow descriptive for dairy products).

With logo as in word marks, “similarity is determined on the basis of the total effect of the designation, rather than a comparison of individual features.” *Pignons*, 657 F.2d at 487; See also *Mcneil Nutritionals, LLC v. Heartland Sweeteners, LLC*, 511 F.3d 350, 359 (“[F]orceful and distinctive design features should be weighed more heavily because they are more likely to impact the overall impression.”).

Boston had a purple background, yellow cartoon duck, camouflage hat, duck flapping wings making water splash. Super had blue background, white cartoon duck shaped like an actual vehicle with passengers on it; duck in orange cape with powerful arms holding orange flag. 🦆