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TRADEMARK PROTECTION OF PUBLIC SPECTACLES: BOSTON ATHLETIC CHANGES THE RULES

I. INTRODUCTION

In *Boston Athletic Association v. Sullivan*¹ ("*Boston Athletic*"), the First Circuit Court of Appeals significantly altered traditional trademark law by granting broad protection to those who conduct well-known events such as concerts and athletic competitions.² The First Circuit held that a person may be enjoined from selling goods referring to the registered name of a well-known event regardless of whether the public is likely to be confused into believing that the "infringing" goods are officially connected to the event.³

II. T-SHIRTS AND TRADEMARKS

A. *The Business Of Selling T-Shirts*

Selling T-shirts at sporting events is as American as apple pie. Sports fans proclaim their affiliation with their favorite team by wearing T-shirts emblazoned with the team's name or emblem.⁴ Spectators commemorate their attendance at championship games⁵ by purchasing merchandise⁶ decorated with the name of the competition.⁷ In fact, consumers are willing to pay higher prices for products bearing the insignia of professional sports teams than for goods without such decorations.⁸ It should therefore come as no surprise that the sale of

1. 867 F.2d 22 (1st Cir. 1989).

2. *Id.*

3. *Id.* at 32-35.

4. See Oddi, *Consumer Motivation In Trademark And Unfair Competition Law: On The Importance Of Source*, 31 VILL. L. REV. 1, 47-48 (1986); Comment, *Trademarks: Protection of Merchandising Properties In Professional Sports*, 21 DUQ. L. REV. 927-28 (1983) (authored by David Kelly); Denicola, *Institutional Publicity Rights: An Analysis of the Merchandising of Famous Trade Symbols*, 62 N.C.L. REV. 603-5 (1984); *Boston Professional Hockey Ass'n v. Dallas Cap & Emblem Mfg., Inc.*, 510 F.2d 1004, 1011 (5th Cir.), *cert. denied*, 423 U.S. 868 (1975) (hockey fans buy emblems embroidered with symbols of favorite teams to show public allegiance or to identify with the teams themselves).

5. Such championship games may include the Super Bowl or the World Series.

6. See *National Football League v. Governor of the State of Delaware*, 435 F. Supp. 1372, 1381 (D. Del. 1977) (Professional sports teams today franchise pennants, T-shirts, helmets, drinking glasses, and a wide range of other products); Kelly, *supra* note 4 at 928 ("Products displaying NFL team colors and insignia range from adults' and childrens' sweaters, tee shirts, jerseys, and socks to glassware, key rings, posters, and buttons.").

7. See *supra* note 4.

8. See Denicola, *supra* note 4 at 604.

merchandise emblazoned with the name of athletic teams has become a multi-million dollar business.⁹

B. A Short Discussion Of Trademark Law And The Sponsorship Issue

Many people are willing to violate a professional sports team's trademark¹⁰ by selling products bearing the team's name or logo.¹¹ The Trademark Act of 1946 ("the Lanham Act") governs modern¹² causes of action for trademark infringement.¹³ Under the Lanham Act, a person is liable for infringement if he, without the consent of the registrant, uses in commerce any registered mark which is "likely to cause confusion, or to cause mistake, or to deceive."¹⁴

Although there is almost universal agreement that the "likelihood of confusion" issue has proven to be the key factor in the majority of infringement cases,¹⁵ there is much debate over whether plaintiffs must prove that consumers are likely to be confused into believing that the defendant's product or service is *officially sponsored* by the plaintiff.¹⁶

Traditionally, courts require plaintiffs to prove confusion of source or sponsorship.¹⁷ As one commentator explains:

The modern rule of law gives the trademark owner protection against use of its mark on any product or service which would reasonably be thought by the consuming public to come from the same source, or thought to be affiliated with, connected

9. Wong, *Recent Trademark Cases Involving Professional and Intercollegiate Sports*, DET. C.L. REV. 87 (1986) (NFL receives millions each year from sale of goods bearing its logo).

10. The Lanham Act of 1946, ch. 540, 60 Stat. 427 (1946) (codified as amended by 15 U.S.C. §§ 1051-1127 (1982 & Supp. V. 1987)) defines a trademark as including "any word, name, symbol, or device or any combination thereof adopted and used by a manufacturer or merchant to identify and distinguish goods . . . from those manufactured or sold by others." 15 U.S.C. § 1127 (Supp. V. 1946). A service mark, on the other hand, is used to distinguish one's services from those offered by others. See *Boston Athletic*, 867 F.2d at 23 n.1.

11. See generally Wong, *supra* note 9 at 88 (growth in use of sports trademarks results in increased litigation); Kelly, *supra* note 4 at 929 (large number of counterfeiters attempt to capitalize on goodwill and market established by professional sports teams); *Boston Hockey*, 510 F.2d at 1004 (permanent injunction against sale of patches); *National Football League Properties, Inc. v. Wichita Falls Sportswear, Inc.* 532 F. Supp. 651 (W.D. Wash. 1982) (injunction against sale of patches). But see Denicola, *supra* note 8 at 605 (trademark owners have sometimes lost suits to enjoin sale of infringing goods).

12. Modern trademark law has its origins in the common law tort of unfair competition. See 2 J. MCCARTHY, TRADEMARKS AND UNFAIR COMPETITION § 5:2, at 133-35 (2d ed. 1984).

13. See Lanham Act, *supra* note 9.

14. See Section 32(1) of the Lanham Act, 15 U.S.C.A. § 1114(1).

15. See Wong, *supra* note 9 at 89.

16. See *infra* notes 17-48, and accompanying text.

17. See 2 J. MCCARTHY, *supra* note 12, § 24:3 at 166.

with, or sponsored by, the trademark owner.¹⁸

Thus, the Girl Scouts were denied an injunction against the production of posters depicting a pregnant girl wearing a Girl Scout uniform because it was unlikely that the public would believe that the Girl Scouts sponsored the poster.¹⁹ Similarly, the University of Notre Dame was unable to stop the release of a book and movie depicting the university and its president in an unfavorable light, since national readers and movie viewers would assume that the depicted events were fictional and not authorized by the plaintiff.²⁰

However, some courts have rejected the traditional approach. Several courts have indicated that protection will be given in cases where the purchasing public is likely to *identify* the infringing product with the plaintiff's goods. For instance, one court enjoined the defendants from printing and selling posters with the "Coca-Cola" trademark modified to read "Enjoy Cocaine" in the familiar Coca-Cola script.²¹ The court determined that the public could not disassociate the poster from the famous soft drink.²² Similarly, the Second Circuit, in *Dallas Cowboys Cheerleaders Inc. v. Pussycat Cinema, Ltd.*,²³ enjoined defendants from exhibiting a movie which depicted a woman engaging in various sexual acts while wearing an outfit which resembled the Dallas Cowboys Cheerleaders' uniform.²⁴ Although it was unlikely that viewers would believe that the Dallas Cowboys sponsored the movie, the Second Circuit granted the injunction because "it is hard to believe that anyone who had seen defendants' sexually depraved film could ever disassociate it from plaintiff's cheerleaders."²⁵

The most famous²⁶ decision granting protection even though there was no confusion regarding sponsorship was issued by the Fifth Circuit Court of Appeals.²⁷ In *Boston Professional Hockey Association v. Dallas Cap & Emblem Mfg.*²⁸ ("*Boston Hockey*"), the Fifth Circuit enjoined the

18. *Id.*

19. *Girl Scouts of the United States v. Personality Posters Mfg. Co.*, 304 F. Supp. 1228 (S.D.N.Y. 1969).

20. *University of Notre Dame Du Lac v. Twentieth Century-Fox Film Corp.*, 22 A.D.2d 452, 256 N.Y.S.2d 301, *aff'd*, 15 N.Y.2d 940, 207 N.E.2d 508, 259 N.Y.S.2d 832 (1965).

21. *Coca-Cola Co. v. Gemini Rising, Inc.*, 346 F. Supp. 1183 (E.D.N.Y. 1972).

22. *Id.* at 1183.

23. 604 F.2d 200 (2d Cir. 1979).

24. *Id.*

25. *Id.* at 205.

26. See Denicola, *supra* note 4, at 606-07 (*Boston Hockey* most famous, if not the most infamous).

27. *Boston Hockey*, 510 F.2d at 1004.

28. *Id.*

manufacture of emblems embodying several professional hockey teams' marks, even though there was not a showing of confusion regarding sponsorship or source.²⁹ The National Hockey Association and its member teams sought to stop an emblem manufacturer from making and selling cloth emblems containing the teams' registered trade and service marks.³⁰ The Fifth Circuit granted the injunction, even though it was unlikely that purchasers would believe that the patches were manufactured or sponsored by the plaintiff.³¹ The court determined that the confusion requirement was met since the public would probably *identify* the defendant's product with the plaintiff's mark.³² The court stated:

The confusion question here is conceptually difficult The confusion or deceit requirement is met by the fact that the defendant duplicated the protected trademarks and sold them to the public knowing that the public would identify them as being the teams' trademarks. The certain knowledge of the buyer that the source and origin of the trademark symbols were in plaintiffs satisfies the requirement of the act. The argument that confusion must be as to the source of the manufacture of the emblem itself is unpersuasive, where the trademark, originated by the team, is the triggering mechanism for the sale of the emblem.³³

The Fifth Circuit's reasoning did not go unchallenged. Scholars characterized the court's analysis as "conclusory"³⁴ and incoherent.³⁵ Other critics emphasized that the decision granted owners of sports emblems a virtual monopoly.³⁶ One commentator chided, "[t]he *Boston Hockey* decision, by equating recognition with confusion, had effectively precluded the unauthorized merchandising of famous trade symbols without the inconvenience of explicit analysis."³⁷

Courts also voiced concern. One court described the *Boston Hockey*

29. *Id.*

30. *Id.* at 1009.

31. *Id.* at 1012.

32. *Boston Hockey*, 510 F.2d at 1012.

33. *Id.*

34. See Denicola, *supra* note 4 at 609.

35. *Id.* at 607.

36. See generally, Denicola *supra* note 4 at 613; Laff and Saret, *Further Unraveling of Sears-Compco: Of Patches, Paladin and Laurel and Hardy*, 66 TRADE-MARK REP. 427 (1976) (by counsel for Dallas Cap & Emblem Mfg., Inc.); Keating, *Patches on the Trademark Law*, 67 TRADE-MARK REP. 315 (1977).

37. See Denicola, *supra* note 4 at 607.

rationale as "naive."³⁸ Courts rebuffed both musical groups³⁹ and universities⁴⁰ that claimed that no confusion need be proven regarding source or sponsorship. Other courts warned that *Boston Hockey* turned trademark law into copyright law⁴¹ and granted trademark owners a "complete monopoly over its use . . . in commercial merchandising."⁴²

Boston Hockey did not last very long. In *Kentucky Fried Chicken Corp. v. Diversified Packaging Corp.*,⁴³ the Fifth Circuit retreated from the broad language in *Boston Hockey* by construing it to require actual confusion of sponsorship.⁴⁴ Then, in *Supreme Assembly v. J.H. Jewelry Co.*,⁴⁵ the Fifth Circuit explicitly reaffirmed the traditional view that the Lanham Act requires a showing of confusion regarding source or sponsorship.⁴⁶

Supreme Assembly appeared to hammer the final nail in *Boston Hockey's* coffin. Even after its demise, scholars and courts criticized *Boston Hockey*.⁴⁷ The *Boston Hockey* principle, however, was resurrected in *Boston Athletic Association v. Sullivan*.⁴⁸

III. *BOSTON ATHLETIC ASSOCIATION V. SULLIVAN*: STATEMENT OF THE CASE

A. *The Race Begins — The Facts*

The Boston Athletic Association ("BAA") and the Boston Marathon share a long history together. BAA has sponsored the Boston Marathon since it was first run in 1897.⁴⁹ In fact, the race used to be called

38. *International Order of Job's Daughters v. Lindeburg & Co.*, 633 F.2d 912 (9th Cir. 1980).

39. *Bi-Rite Enterprises, Inc. v. Button Master*, 555 F. Supp. 1188 (S.D.N.Y. 1983) (no confusion as to source on buttons displaying name of musical group).

40. *University of Pittsburgh v. Champion Prods., Inc.*, 566 F. Supp. 711 (W.D. Pa. 1983) (no confusion of sponsorship in sale of clothing bearing name of university).

41. *General Mills, Inc. v. Henry Regency Co.*, 421 F. Supp. at 362 n.2 (N.D. Ill. 1976).

42. *Job's Daughters*, 633 F.2d at 918.

43. 549 F.2d 368 (5th Cir. 1977).

44. *Id.* at 390.

45. 676 F.2d 1079 (5th Cir. 1982).

46. *Id.* at 1082. See also *Conan Properties, Inc. v. Conan's Pizza, Inc.*, 752 F.2d 145, 156 (5th Cir. 1985) (plaintiff must prove likelihood of source, affiliation, or source in mind of the ordinary consumer).

47. See *supra* notes 34-42. But see *University of Pittsburgh v. Champion Products*, 686 F.2d 1040, 1045-47 (3d Cir. 1982) (approving of *Boston Hockey*); *Processed Plastic*, 675 F.2d at 855; *University of Georgia v. Laite*, 756 F.2d 1535, 1546 (11th Cir. 1985).

48. *Boston Athletic*, 867 F.2d 22.

49. *Id.* at 24.

the "Boston Athletic Association Marathon."⁵⁰ A few days before the annual race, BAA would sponsor an exposition where various businesses sold merchandise⁵¹ in anticipation of the race.⁵²

In 1983, BAA began a campaign to market its name via licensing agreements.⁵³ BAA registered the names "Boston Marathon" and "BAA Marathon" in Massachusetts in 1983.⁵⁴ Then, in 1985, BAA registered the name "Boston Marathon" with the United States Patent and Trademark Office.⁵⁵

Defendants Beau Tease Inc. and Mark Sullivan⁵⁶ were also interested in merchandising products referring to the Boston Marathon. Sullivan retails wearing apparel in Hopkinton, Massachusetts.⁵⁷ Beau Tease is a Massachusetts corporation which imprints and distributes shirts in the trade.⁵⁸ In 1978, Beau Tease began to imprint and Sullivan began to sell shirts bearing the "Boston Marathon" name.⁵⁹

At first, BAA and Beau Tease had a friendly relationship. In 1984, BAA entered into an agreement with Beau Tease whereby Beau Tease sold to BAA a large quantity of shirts which BAA gave away to athletes and volunteers during the 1985 race.⁶⁰

However, the cordial relationship between Beau Tease and BAA ended in 1986.⁶¹ In that year, BAA entered into an exclusive licensing agreement with Image Impact ("Image") for BAA's service mark⁶² on wearing apparel.⁶³ After executing their agreement, BAA and Image notified the relevant market that Image was BAA's exclusive licensee.⁶⁴ They also warned that any unauthorized use of the name "Boston Marathon" or any similar name would violate the exclusive rights of BAA and Image.⁶⁵

50. *Id.* at 28. The race was also called "Boston A.A. Marathon." The race has been called "Boston Marathon" since 1917. *Id.*

51. *Id.* at 24. Businesses would sell merchandise such as T-shirts and running apparel.

52. *Boston Athletic*, 867 F.2d at 24. At the BAA booth, the registered runners would pick up their numbers and other official information. *Id.*

53. *Id.* at 24.

54. *Id.* at 24-25.

55. *Id.* at 25.

56. *Boston Athletic*, 867 F.2d at 35. Sullivan was doing business as "Good Life." *Id.*

57. *Id.* at 24.

58. *Id.*

59. *Id.* at 25.

60. *Boston Athletic*, 867 F.2d at 25.

61. *Id.*

62. *See supra* note 10.

63. *Boston Athletic*, 867 F.2d at 25.

64. *Id.*

65. *Id.* at 25.

But Beau Tease and Sullivan failed to heed the warning. In March of 1986, defendants began to merchandise⁶⁶ shirts referring to the 1986 Marathon.⁶⁷

BAA attempted to prevent Beau Tease and Sullivan from selling the shirts by filing for a preliminary injunction in Massachusetts Superior Court.⁶⁸ The superior court denied BAA's request.⁶⁹ BAA appealed, but the denial was affirmed by a single justice on the Massachusetts Court of Appeals, and the action was dismissed without prejudice.⁷⁰

Fresh from their victory, Beau Tease and Sullivan prepared to sell more shirts. In late 1986 and early 1987, Beau Tease began to manufacture and Sullivan began to retail shirts and other apparel referring to the 1987 Boston Marathon.⁷¹

On April 1, 1987, BAA and Image sued Beau Tease and Sullivan in the United States District Court for the District of Massachusetts.⁷² BAA and Image claimed that the defendants' 1986 and 1987 shirts infringed on BAA's marks.⁷³ In their complaint, BAA and Image alleged confusion in violation of the Lanham Act.⁷⁴ BAA and Image also filed a motion for a preliminary injunction to stop the defendants from manufacturing or selling any article bearing the name "Boston Marathon" or any similar name.⁷⁵

On April 8, 1987, the district court conducted a hearing at which it combined the preliminary injunction hearing with a trial on the merits.⁷⁶ The President of Image, Mickey Lawrence, testified that purchasers told him that they confused the plaintiffs' shirts with the defendants' shirts.⁷⁷ In a bench opinion, the court did not enjoin Sullivan, but did prelimina-

66. Beau Tease imprinted shirts and other apparel referring to the Boston Marathon and Sullivan sold the apparel to the public. *Id.*

67. *Id.* at 25. The defendant's 1986 shirts included a logo which contained the year, a picture of runners, and the words "Hopkinton-Boston."

68. *Boston Athletic*, 867 F.2d at 25.

69. *Id.*

70. *Id.*

71. *Id.* The 1987 shirts had an imprint which contained the words "1987 Marathon," a picture of runners, and the phrase "Hopkinton-Boston." Beau Tease and Sullivan planned to sell the shirts and other items at the exposition. *Id.*

72. *Boston Athletic*, 867 F.2d at 25.

73. *Id.*

74. *Id.* at 25. The complaint also included state law counts for dilution, sale of counterfeits and imitations, and unauthorized use of a name. *Id.*

75. *Id.*

76. *Boston Athletic*, 867 F.2d at 25.

77. *Id.*

rily enjoin Beau Tease from selling shirts directly at the exposition.⁷⁸

On April 17, 1987, BAA appealed and moved for an injunction. The court of appeals, however, denied the injunction and the appeal was dismissed without prejudice.⁷⁹

The case returned to the district court where the plaintiffs moved for summary judgment, a declaratory judgment with respect to their rights in the name "Boston Marathon," and an injunction against the defendants' design.⁸⁰

B. The District Court's Holding — Defendants Take The Lead

On March 7, 1988, the district court denied the plaintiffs' motion for an injunction and granted summary judgment for Beau Tease and Sullivan.⁸¹ The court reasoned that although BAA's marks were valid, there was no confusion as a matter of law between plaintiffs' and defendants' shirts.⁸² The court determined that since the public was unaware that BAA sponsored the race, the public could not infer that the official sponsor of the race endorsed defendants' shirts.⁸³ In addition, the court found that the evidence presented by Lawrence was not only self-serving, but was inadmissible hearsay.⁸⁴ There was no testimony from "disinterested persons" that people were confused regarding the source of defendants' shirts.⁸⁵ The preliminary injunction was dissolved. BAA and Image appealed to the First Circuit Court of Appeals.⁸⁶

C. First Circuit's Holding — Plaintiffs Take The Gold

1. BAA's Right to Run: Plaintiffs Clear the Genericness and Prior Usage Hurdles

The First Circuit Court of Appeals began its analysis⁸⁷ by con-

78. *Id.* at 26. The court also enjoined Beau Tease from marketing shirts to anyone who it knew would sell the 1987 shirts at the exposition. *Id.*

79. *Id.*

80. *Boston Athletic*, 867 F.2d at 26. The plaintiff also moved for a preliminary injunction, an injunction against defendants' 1988 shirts and design, and an injunction against the defendants' design with any year on it. *Id.*

81. *Id.* at 26-27.

82. *Id.* at 27.

83. *Id.* at 26.

84. *Boston Athletic*, 867 F.2d at 26-27.

85. *Id.* at 27.

86. *Id.*

87. The court noted that the case was really a service mark infringement case, not a trademark infringement case. *Id.* at 23. However, the court observed that for purposes of the matter at hand the distinction between the two types of marks was irrelevant. Consequently, cases discussing either types of marks could be applied to the instant case. *Id.* at n.1.

fronting two of the defendants' arguments. Beau Tease and Sullivan contended that BAA's marks were unworthy of protection because (1) the term "Boston Marathon" is "generic"⁸⁸ and because (2) defendants' use of the term "Boston Marathon" since at least 1978 constitutes a "prior usage."⁸⁹

Regarding the "genericness" argument, the court stated that the defendants had failed to present any relevant evidence showing that the term "Boston Marathon" had become a generic term.⁹⁰ The court noted that the defendants relied on *Anti-Monopoly Inc. v. General Mills Fun Group*⁹¹ ("*Anti-Monopoly*") to support their contention that "Boston Marathon" had become a common descriptive term.⁹² The *Boston Athletic* court stated that *Anti-Monopoly* stood for the proposition that a term may be deemed generic if it is used to denote a unique product or service.⁹³ The *Boston Athletic* court then determined that Congress nullified the *Anti-Monopoly* holding in 1984 by a congressional amendment which stated that a term was not to be deemed generic merely because the mark is used as a name of or to identify a unique product or service.⁹⁴ According to the congressional amendment, the primary significance of the registered mark to the relevant public (rather than purchaser motivation) was to be the test for determining whether the registered mark has become generic.⁹⁵ Finally, the First Circuit concluded that since the defendants introduced no evidence on the "primary significance" issue, they failed to prove that "Boston Marathon" is a common descriptive term.⁹⁶

88. If a term is deemed generic, it is unworthy of protection. A term is generic when it becomes a common descriptive name of goods or services. See 2 J. MCCARTHY, *supra* note 12, § 12.1 at 520-21.

89. *Boston Athletic*, 867 F.2d at 27.

90. *Id.*

91. 611 F.2d 296 (9th Cir. 1979); *Anti-Monopoly, Inc. v. General Mills Fun Group, Inc.*, 515 F. Supp. 448 (N.D. Cal. 1981) (granting permanent injunction to plaintiff on remand), *aff'd*, 684 F.2d 1316 (9th Cir. 1982), *cert. denied*, 459 U.S. 1227 (1983).

92. *Boston Athletic*, 867 F.2d at 27.

93. *Id.* The First Circuit stated:

In its first opinion, the Ninth Circuit concluded its summary of the law of genericness by stating that "when members of the consuming public use a game name to denote the game itself, and not its producer, the trademark is generic and, therefore, invalid (citation omitted). In its second opinion, the court relied heavily on a survey, which measured the motive of purchasers in selecting a "Monopoly" game, in deciding that "Monopoly" was a generic term."

Id.

94. *Id.*

95. *Id.*

96. *Boston Athletic*, 867 F.2d at 27. The First Circuit reasoned:

The burden of proof is on the party seeking to have a registered mark declared a generic to show that it has become so . . . Here, the defendants have introduced no

The First Circuit quickly disposed of the defendants' argument that their use of the term "Boston Marathon" on shirts from 1978 constituted a "prior usage."⁹⁷ The court reasoned that the "uncontradicted evidence," showing that BAA had been using the term "Boston Marathon" since 1917, defeated defendants' "prior use" contention.⁹⁸ Moreover, the court noted that a mark protects not only a product or service, but also related items or services.⁹⁹ The court explained that the apparel sold by BAA is related to the service which BAA provides,¹⁰⁰ and BAA is therefore entitled to enjoin the use of its marks on such items.¹⁰¹

2. The Longest Stretch: Likelihood of Confusion Issue

a. Two Track Analysis

On the issue of whether there was likelihood of confusion, the First Circuit Court of Appeals began its analysis by stating that the confusion issue involves two "distinct but inseparable questions."¹⁰² The first question is whether the public is likely to confuse the defendants' T-shirts with the plaintiffs' T-shirts.¹⁰³ The second question, often called the "promotional goods issue," is whether the purchasing public is likely to believe that the sponsor of the Boston Marathon endorses defendants' shirts.¹⁰⁴

b. Confusion of Goods Track

The First Circuit commenced its discussion of the "confusion of goods" question by listing eight factors courts in that circuit have used to determine whether there is "likelihood of confusion" between goods.¹⁰⁵ These factors include: the similarity of the marks; similarity of the goods; the relationship between the parties' channels of trade; the relationship between the parties' advertising; the classes of prospective purchasers; evidence of actual confusion; the defendant's intent in adopting

evidence on the issue of "primary significance" and thus, have failed to meet the burden of proof.

Id.

97. *Id.*

98. *Id.* at 27-28.

99. *Id.* at 27.

100. The services provided by BAA included the operation and sponsorship of the Boston Marathon. *Boston Athletic*, 867 F.2d at 23, 28.

101. *Id.* at 28.

102. *Id.*

103. *Id.* at 28-29.

104. *Id.* at 27-28.

105. *Boston Athletic*, 867 F.2d at 29.

its mark; and the strength of plaintiff's mark.¹⁰⁶ The court noted that "[n]o one factor is necessarily determinative, but each must be considered."¹⁰⁷

The court¹⁰⁸ observed that all eight factors weighed heavily in favor of the plaintiffs.¹⁰⁹ First, the court observed that the defendants' logos referred specifically to the Boston Marathon race.¹¹⁰ In addition, the court noted that the parties manufactured virtually the same goods—T-shirts.¹¹¹ The court then stated that the parties sold the products at the same time during the race and in the same area.¹¹² Furthermore, the court emphasized that the parties used the same method of advertising,¹¹³ and distributed the goods to the same class of people.¹¹⁴ The court also noted that the parties sold the shirts under hectic conditions for about the same amount of money.¹¹⁵ Moreover, the court stated that the plaintiffs offered substantial evidence that some people were actually confused about who sponsored defendants' shirts.¹¹⁶ The court also determined that defendants intended to trade on BAA's sponsorship and

106. *Id.*

107. *Id.*

108. Chief Judge Campbell disagreed with the majority's view that plaintiffs were entitled to summary judgment on the confusion of goods question. In Judge Campbell's opinion, there remained a question of material fact whether prospective purchasers would be likely to confuse defendants' T-shirts with plaintiffs'. However, Judge Campbell joined with the court's opinion regarding the "promotional goods" issue. *Id.* at 29 n.5.

109. *Id.* at 29-32.

110. *Boston Athletic*, 867 F.2d at 29-30. The court bolstered its argument by noting that there is only one Boston Marathon race. In addition, the court observed that the defendants' logos refer to the term "Boston Marathon" and depicts runners. The race is run annually, and the defendants refer to a specific year implying an annual event. In addition, the court noted that the race begins in Hopkinton and ends in Boston, and the defendants shirts refer to these cities. "Despite this, defendants have introduced no evidence showing that they have taken steps to turn their similarly marked products into dissimilar ones by clearly distinguishing their products, and their lack of BAA sponsorship, from those sold by plaintiffs." *Id.* at 29.

111. *Id.* at 30.

112. The court noted that the parties sell their shirts mostly in Boston area retail shops, at the exposition and along the race course. The parties center their activities on the day of the race. *Id.*

113. *Id.* at 30. The court observed that the plaintiffs and defendants advertised the shirts in store display windows, in booths at the exposition, and along the race course. *Id.*

114. *Boston Athletic*, 867 F.2d at 30. The court noted that prospective purchasers were drawn from the public at large. *Id.*

115. *Id.* at 30. The shirts retail for about \$7.00-10.00. *Id.*

116. *Boston Athletic*, 867 F.2d at 31. The court emphasized that Lawrence, the President of Image Impact, reported that a shopper at a department store was surprised when Lawrence told her that defendants' shirt, which the shopper was wearing, was not an "official" Boston Marathon Shirt. The court argued that although the evidence presented by Lawrence may not be as accurate as survey data, the evidence sufficiently demonstrated that some people were actually confused about who sponsored defendants' shirts. *Id.*

management of the Boston Marathon.¹¹⁷ Finally, the court observed that BAA's mark was strong.¹¹⁸

The court concluded that the plaintiffs were entitled to summary judgment on the confusion of goods issue.¹¹⁹ In so holding, the court reasoned that there was undisputed evidence showing that the purchasing public was likely to mistake defendants' T-shirts with the plaintiffs' T-shirts.¹²⁰ The court also noted that since BAA's mark was very strong, it was worthy of broad protection.¹²¹

c. Promotional Goods Issue Track

i. Rules of the Race: Or What the Plaintiffs Must Prove

The First Circuit began its discussion of the sponsorship issue¹²² by stating that although the plaintiffs must establish that the defendants are trading on plaintiffs' mark or goodwill, the plaintiffs do not "also have to prove that members of the public will actually conclude that defendants' product was *officially* endorsed by the Marathon's sponsor (whoever that sponsor may be)."¹²³ The court suggested two reasons why it did not require plaintiffs to prove likelihood of confusion regarding sponsorship.¹²⁴

First, the court stated that it is virtually impossible to determine whether the public believes that a person's use of a logo is officially endorsed by the logo's owner.¹²⁵ The court reasoned:

[F]ew people, other than legal specialists, could venture an informed opinion on whether someone using the logo of a sponsor of a sporting event is required to have the permission of the event's sponsor. Lacking such knowledge, the question of approval is pure guesswork. To ask a factfinder to determine whether the public would think that defendants' shirts were "authorized" or "official" shirts is to ask it to resolve a confus-

117. *Id.* at 32. The court emphasized that the defendants placed their logos referring to the Boston Marathon on the same type of product which the plaintiffs marketed, and sold those products in the same location and at the same time that the plaintiffs sold their goods. *Id.*

118. *Id.* The court reasoned that BAA had used its mark for a long period of time before registering it and that the media constantly exposed the public to the fact that BAA sponsored the prestigious race. *Boston Athletic*, 867 F.2d at 32.

119. *Id.*

120. *Id.*

121. *Id.*

122. The *Boston Athletic* court referred to the sponsorship issue as the "promotional goods issue." *Id.* In this note, the two terms are used interchangeably.

123. *Boston Athletic*, 867 F.2d at 33.

124. *Id.* at 33-35.

125. *Id.* at 33.

ing and, in many contexts, virtually meaningless question.¹²⁶

The court buttressed this proposition by noting that the "pertinent case law recognizes the difficulty of asking factfinders to decide whether uses are 'authorized'."¹²⁷

Second, the court noted that determining whether the public believes that a product is officially sponsored raises "a problem of circularity."¹²⁸ The court quoted Professor McCarthy:

If consumers think that most uses of a trademark require authorization, then in fact they will require authorization because the owner can enjoin consumer confusion by unpermitted uses or charge for licenses. And if owners can sue to stop unauthorized uses, then only authorized uses will be seen by consumers, creating or reinforcing the perception that authorization is necessary. This is a "chicken and the egg" conundrum.¹²⁹

The court also observed that where the defendant *intentionally* copies another's design, courts should presume that there is confusion.¹³⁰ In cases of intentional copying, the second comer is generally "presumed to have intended confusing similarity of appearance and to have succeeded in doing so."¹³¹

ii. Plaintiffs Cross the Finish Line

The court concluded that the plaintiffs met their burden regarding the promotional goods issue.¹³² "Defendants' shirts are clearly designed to take advantage of the Boston Marathon and to benefit from the good will associated with its promotion by the plaintiffs."¹³³ The court stated that the defendants, like Rosie Ruiz,¹³⁴ obtained a "free ride" at BAA's expense.¹³⁵ In addition, the court observed that there was "undisputed" evidence showing that consumers were likely to purchase the shirts be-

126. *Id.*

127. *Id.*

128. *Boston Athletic*, 867 F.2d at 33.

129. *Id.* (quoting 2 J. MCCARTHY, TRADEMARK AND UNFAIR COMPETITION § 24:3, at 170 (2d ed. 1984)).

130. *Boston Athletic*, 867 F.2d at 34.

131. *Id.* at 34, (quoting *Warner Bros. v. Gay Toys, Inc.*, 553 F. Supp. 1018, 1021 (S.D.N.Y.), *aff'd*, 724 F.2d 327 (2d Cir. 1983)).

132. *Boston Athletic*, 867 F.2d at 34.

133. *Id.* at 33.

134. Rosie Ruiz was the first woman to cross the finish line at the 1980 Boston Marathon. However, she was stripped of her gold medal after it was discovered that she may have cheated. See Leavy, *Ruiz Stripped of Title in Boston; Ruiz Loses Race Title in Boston*, Wash. Post, Apr. 29, 1980, at D1.

135. *Boston Athletic*, 867 F.2d at 33.

cause of that reference.¹³⁶ The court reasoned that it is therefore fair to presume that purchasers would likely believe that defendants' shirts had some connection with the official sponsor of the Boston Marathon.¹³⁷ Finally, the court concluded that given the presumption in favor of plaintiffs and the fact that defendants offered no evidence that would rebut that presumption, there is no genuine issue of material fact about the promotional goods issue.¹³⁸

IV. IMPACT OF *BOSTON ATHLETIC*

Read broadly, *Boston Athletic* represents a significant change in traditional trademark law. At the very least, the court recognized a "rebuttable presumption" of confusion when the defendant intentionally refers to the plaintiff's mark, and the public is likely to buy defendant's product because of that reference.¹³⁹ Moreover, the *Boston Athletic* court implied that sponsors of famous events can obtain an injunction against any seller who "benefit(s) from the good will" associated with the event's promotion.¹⁴⁰ The court not only enjoined the defendants from selling products bearing the words "Boston Marathon," it also prohibited the merchandising of products with no direct reference to the race.¹⁴¹ Taken literally, the *Boston Athletic* decision seems to have created a new property right in the promotion of well-known events.

The holding, however, is ambiguous. *Boston Athletic* can be interpreted to mean that an event will only receive protection if the event is very well-known. In addition, the decision can also be construed to grant protection only in cases of intentional copying.¹⁴² The court also left open the possibility that sale of merchandise referring to an event would not be subject to an injunction if the seller of the "infringing" goods takes steps to clearly distinguish his products from the plaintiff's merchandise.¹⁴³

Whatever interpretation is adopted, it is clear that *Boston Athletic* sends a strong message to merchants that the First Circuit will have no sympathy for those who use another's mark without permission. The First Circuit opinion has a decidedly moral tone. The court compared

136. *Id.* at 34.

137. *Id.*

138. *Id.* at 35.

139. *Id.* at 34.

140. *Boston Athletic*, 867 F.2d at 33.

141. *Id.* at 35. For instance the court enjoined the defendants from selling shirts merely embodying the words "Boston," a picture of runners, and the date. *Id.*

142. *Id.* at 34-35.

143. *Id.* at 29.

the defendants to Rosie Ruiz¹⁴⁴ and stated that the defendants were unjustly enriched by their use of BAA's mark.¹⁴⁵ Moreover, it is highly unusual for a court's determination regarding the confusion issue to be reversed.¹⁴⁶

V. A CRITICAL LOOK AT *BOSTON ATHLETIC*

The First Circuit's opinion has four major flaws.¹⁴⁷ First, the court's decision is inconsistent. On the one hand, the court stated that determining whether there is confusion regarding sponsorship is impossible.¹⁴⁸ On the other hand, the court recognized a "rebuttable presumption" of confusion regarding sponsorship in cases of intentional copying.¹⁴⁹ How can there be a rebuttable presumption about a fact that cannot be proven? The First Circuit seems to believe that while it is unreasonable to make the plaintiff prove confusion of source, it is nonetheless fair to require the defendant to *disprove* confusion.¹⁵⁰

Second, it is possible for the factfinder to determine whether the public is likely to be confused regarding the source of a particular product. Plaintiffs can prove confusion by conducting a survey.¹⁵¹ In fact, courts have been critical of well-financed plaintiffs who have failed to conduct a survey on the confusion issue.¹⁵²

Third, the *Boston Athletic* court's use of precedent is flawed.¹⁵³ The First Circuit cited *Boston Hockey* to substantiate its conclusion that plaintiffs should not have to prove confusion regarding sponsorship.¹⁵⁴ But, as the First Circuit concedes,¹⁵⁵ *Boston Hockey* has been overturned.¹⁵⁶ The court's reliance on *Boston Hockey* is odd particularly since *Boston Hockey* has been criticized by scholars and courts alike for

144. *Boston Athletic*, 867 F.2d at 33.

145. *Id.*

146. See Fletcher & Wald, *The Fortieth Year of Administration of the Lanham Trademark Act of 1946*, 77 TRADE-MARK REP. at 610 (1987) ("determinations of no likelihood of confusion after trial are reasonably conclusive").

147. This note will only analyze the court's treatment of the "sponsorship" issue.

148. *Boston Athletic*, 867 F.2d at 33.

149. *Id.* at 33-35.

150. *Id.* at 34-35.

151. *National Football League v. Wichita Falls Sportswear*, 532 F. Supp. 651, 659 (W.D. Wash. 1982) (survey indicating consumers believed jerseys were authorized by NFL). *Processed Plastics Co. v. Warner Communications*, 675 F.2d 852, 855 (7th Cir. 1982) (survey indicating children believed toy car sponsored by television show).

152. Evans & Gunn, *Trademark Surveys*, 79 TRADE-MARK REP. at 1, 26 (1989).

153. *Boston Athletic*, 867 F.2d at 33-34.

154. *Id.* at 33.

155. *Id.* at 33 n.10.

156. See *supra* notes 40-44, and accompanying text.

its incoherent reasoning and superficial analysis.¹⁵⁷

Fourth, *Boston Athletic* simply goes too far in protecting trademark holders who conduct events. Though the court quoted the well-known principle that a trademark is not "a right in gross,"¹⁵⁸ it virtually prevented any person from selling products at the site of the Boston Marathon. Beau Tease and Sullivan could not sell their shirts to anyone, even though a majority of people did not care who sponsored the Boston Marathon.¹⁵⁹ The court's decision is therefore inconsistent with the intent of the Lanham Act. As Judge Fletcher noted in *International Order of Job's Daughters v. Lindeburg & Co.*,¹⁶⁰

[T]he Lanham Act and its legislative history reveals no congressional design to bestow . . . broad property rights on trademark owners. Its scope is much narrower: to protect consumers against deceptive designations of the origin of goods and, conversely, to enable producers to differentiate their products from those of others.¹⁶¹

The monopoly granted to BAA is especially inequitable since people at the race do not care that BAA sponsored the race. Though people commonly identify themselves by wearing items embodying the insignia of their favorite sports team, "it would be naive to conclude that the name or emblem is desired because consumers believe that the product somehow originated with or was sponsored by the organization the name or emblem signifies."¹⁶²

Moreover, as the First Circuit conceded, until 1983 BAA had done little to promote its alleged mark.¹⁶³ In fact, the Marathon has historically failed to gain corporate sponsorship because it is held on a Monday, which is not attractive to spectators and the media.¹⁶⁴ Therefore, the First Circuit's conclusion (that defendants were trying to get a "free

157. See *supra* notes 25-31, and accompanying text.

158. *Boston Athletic*, 867 F.2d at 35 (quoting *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 703 F.2d 1372, 1374 (Fed. Cir. 1983)).

159. As Professor Denicola notes, such a prohibition:

reserve[s] to the plaintiff an exclusive right to the merchandising of its symbols despite the absence of any judicial or legislative analysis of the social or moral utility of the resulting monopoly Confusion may give good cause for relief, but a remedy that excludes others from the market on that rationale alone can only ensure inequity and forestall a direct assessment of the wisdom of a merchandising monopoly.

See Denicola, *supra* note 4 at 613.

160. 633 F.2d at 912.

161. *Id.* at 918.

162. *Id.*

163. *Boston Athletic*, 867 F.2d at 24-25.

164. N.Y. Times, Oct. 26, 1980, § 6 (Magazine) at 124, col. 4.

ride"¹⁶⁵ from the plaintiffs' "expenditure of labor, skill, and money")¹⁶⁶ appears to be nothing more than a hyperbole.

The First Circuit's decision leaves entrepreneurs in a state of limbo. It is unclear whether the injunction applies to all merchants who sell products referring to the Marathon or only to those who sell merchandise on the day of the race and in the Boston area. Under the guise of protecting a "charitable organization"¹⁶⁷ like the BAA, the First Circuit issued a decision which will financially crush small merchants who deceive no one while honestly peddling their wares.¹⁶⁸

VI. CONCLUSION

In *Boston Athletic*, the First Circuit significantly altered traditional trademark law by granting broad protection to those who conduct well-known events. The decision bestows to one class of people a virtual monopoly to sell goods referring to a public spectacle. Though sports franchisers and promoters may applaud the First Circuit decision, consumers and merchants should be gravely concerned.

*Alan I. Cyrlin**

165. *Boston Athletic*, 867 F.2d at 33.

166. *Id.* (quoting *International News Service v. Associated Press*, 248 U.S. 215, 239 (1918)).

167. *Boston Athletic*, 867 F.2d at 24.

168. The *Boston Athletic* court referred to the BAA as a "charitable organization." *Id.* In fact, the BAA is run more like a business. BAA's administrator, Guy Morse, admits that the BAA is "like any other small industry." The race elicits approximately \$12 million a year from corporate sponsors. See Reinert, *Boston Marathon Crosses the Finish Line in Black Ink*, B. Bus. J. Aug. 21, 1989 at 8.

* The author dedicates this Note to his Parents, Iser and Jacqueline Cyrlin, whose love and support made this Note possible.

