

Ghostly Misstep: No Confusion Means No Preliminary Injunction

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In a trademark case involving an incontestable registration, the US Court of Appeals for the First Circuit affirmed a district court ruling denying the registrant a preliminary injunction (PI) for failure to establish likelihood of confusion. *US Ghost Adventures, LLC v. Miss Lizzie's Coffee LLC*, Case No. 23-2000 (1st Cir. Nov. 15, 2024) (**Selya**, Barron, Gelpí, JJ.)

In 1892, prosecutors alleged that Lizzie Borden hacked her parents to death in their family home. Borden was acquitted of all charges, leaving the murder unsolved. This mystery made Borden's ancestral home a travel destination for all intrigued by the legend.

US Ghost Adventures owns a bed and breakfast located at the Lizzie Borden House in Fall River, Massachusetts. Ghost Adventures also owns an incontestable federal trademark on the LIZZIE BORDEN name as used in its services and on its hatchet logo displaying a notched blade.

Miss Lizzie's Coffee opened a coffee shop next door to the Lizzie Borden House, displaying storefront signage with the words "Miss Lizzie's Coffee" between a cup of coffee and a stylized hatchet spewing blood. The store also displayed a second sign claiming Miss Lizzie's as "The Most Haunted Coffee Shop in the World," with a similar hatchet containing a handle and dramatic blood splatters. Since the opening of Miss Lizzie's, there has been confusion regarding its affiliation with the Lizzie Borden House.

Ghost Adventures brought a trademark infringement and unfair competition suit against Miss Lizzie's Coffee in federal district court. Ghost Adventures also moved for a temporary restraining order and/or PI seeking to enjoin Miss Lizzie's use of either the LIZZIE BORDEN trademark or the hatchet logo in the coffee shop's trade names, trade dress, and marketing materials.

The district court applied the customary four-part test for PIs. The test typically emphasizes likelihood of success on the merits because if the movant cannot show a likelihood of success, the rest of the factors "become matters of idle curiosity." The district court determined that Ghost Adventures failed to show a likelihood of success on the merits and denied the PI. Ghost Adventures appealed.

The First Circuit reviewed the district court's finding for clear error and affirmed. The First Circuit agreed with the district court's assertion that Miss Lizzie's displays were neither "the trademarked hatchet nor a colorable imitation" of Ghost Adventures' hatchet display. Further, the Court found that the Miss Lizzie's mark was not associated with Ghost Adventures' mark, but rather with the historical story of Lizzie Borden. The Court agreed that both businesses sold different goods to different customers. Similarly, the Court concluded that any consumer confusion was not due to the similarity of their marks but was due to non-trademarked similarities between the businesses: their proximity to one another, the use of Lizzie Borden lore, and customers' perception of nearby cafés in association with the historical site itself. Ghost Adventures' mark could not prevent other businesses from using the Lizzie Borden story or from conducting business near the Lizzie Borden House. Moreover, the First Circuit agreed with the district court that the parties relied on different forms of advertising and that the Miss Lizzie's storefront explicitly disclaimed a relationship with the Lizzie Borden House next door, tipping the scales in its favor. The Court emphasized that despite achieving incontestability, Ghost Adventures' mark was not strong enough to displace consumers' association with the real Lizzie Borden.

Sarah Mezini also contributed to this article.

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