

The Right to Use One's Own Name in Business*

DAVID GOLDBERG

Introduction

The legal protection afforded an individual who uses his own name to identify his business has changed over the years in conformity with, and in implicit recognition of, the changing patterns of commercial interactions.

In the late nineteenth and early twentieth centuries, courts safeguarded an individual's right to use his own name in business even though the same name was already being used by another. Because of the personal nature of business transactions at that time, commercial use of the same name by two individuals did not adversely affect the public: consumers learned to associate an individual's name with a specific trade through personal contact with that person within the confines of a particular geographic locality.¹

Today, such a "personal element" is largely lacking in our transformed economy which is marked by "corporate activity, mass production, and national distribution,"² and consumers are forced to rely on reputations created by advertising, rather than by personal knowledge.³ The courts, perhaps sensitive to the increased vulnerability of the consuming public today, have given less weight to the rights of an individual to use his name, and have given greater consideration to the rights of consumers to be free from potential confusion caused by two businesses concurrently using the same name.

The earlier notion that an individual has some legal right to use his own name⁴ in business still makes itself felt, however, in the limited nature of

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relief afforded the first user of the name. In contrast to other cases where trademark infringement is found, most courts today, in a personal name case, allow the second user to continue to use his name to identify his goods in some circumscribed manner.

Names also function as trademarks, and as such can be registered in the United States Patent and Trademark Office. The registrability of surnames under the federal trademark laws also has undergone a change similar to that which has occurred under the common law, so that today it is easier to obtain a federal registration evidencing exclusive rights in a surname.

I. Historical Background and Development

A. The “Sacred” Right Doctrine – The Interest in Affording Every Person the Right to Use His Own Name in Business

Typically, the personal name defense was invoked when an individual who had been using his name to identify his business brought an action against a person of the same name who subsequently began using his own name commercially. In the nineteenth century, courts variously described the right of the second user to use his name as sacred,⁵ absolute,⁶ fundamental and inherent,⁷ and natural and inalienable.⁸ In addition, it was regarded as a personal right,⁹ a property right,¹⁰ and a constitutional right.¹¹ Consequently, the courts refused to enjoin the second party’s use of his name because it was thought that “a personal name cannot be exclusively appropriated by anyone as against others having a right to use it.”¹² Accordingly, any person could use his own name in business “even though he may thereby interfere with or injure the business of another,”¹³ and any commercial loss occasioned by the confusion would not be actionable.¹⁴

The courts would only prevent a party from using his own name if there was evidence of bad faith or a fraudulent intent to deceive.¹⁵ Thus, the courts applied a subjective test: the state of mind of the alleged infringer was dispositive.¹⁶

B. Balancing the Interests – The Right to Use One’s Own Name and the Public’s Right to be Free from Confusion

In the landmark case of *L.E. Waterman Co. v. Modern Pen Co.*,¹⁷ the United States Supreme Court rejected the previously existing case law, and implicitly balanced the right of an individual to use his name in business against the right of the public to be free from any confusion

resulting from the concurrent use of similar names.¹⁸ Consequently, the Court held that if the first user's personal name had acquired secondary meaning – if the public had come to associate and identify particular goods with a certain source – and if the potential *effect* of the concurrent use of the names on the public was confusion, the alleged infringer's use could be enjoined.¹⁹ Justice Holmes wrote:

But, whatever generality or expression there may have been in the earlier cases, it now is established that when the use of his own name upon his goods by a later competitor will and does lead the public to understand that those goods are the product of a concern already established and well known under that name, and when the profit of the confusion is known to and, if that be material, is intended by the later man, the law will require him to take reasonable precautions to prevent the mistake.²⁰

The Court did not, however, detail the extent of the necessary “precautions” that a later competitor was required to take. In *Thaddeus Davids Co. v. Davids*, decided earlier the same year, the Supreme Court affirmed the issuance of an absolute injunction against the defendant's use of the name DAVIDS or DAVIDS MFG. CO. in connection with the manufacturing and sale of inks.²¹ In *Waterman*, by contrast, the Court, having found that defendant's use of the name “Waterman” for fountain pens infringed a prior user's right in the same name for the same goods, affirmed a limited injunction which allowed defendant to use the name WATERMAN if his first name, “Arthur,” and a notice of disclaimer accompanied the surname.²²

C. Appropriate Relief – Judicial Reluctance to Prohibit all Use of a Later Competitor's Name

In subsequent years, the federal and state courts were reluctant to preclude entirely a second comer's use of his name. Generally, absolute injunctions were issued only where there existed evidence of fraudulent conduct on the part of the defendant,²³ or where an intent to appropriate plaintiffs' goodwill had been demonstrated,²⁴ or where the defendant had previously sold his business, its goodwill, and the rights to his name to the plaintiff.²⁵

In contrast to the usual relief afforded plaintiffs in other instances of trademark infringement, in personal name cases the relief often has been limited or qualified in nature.²⁶ Injunctions frequently prevented a second party's use of his name only to the extent that he was required to comply with prescribed limitations on the manner of use of the name. The

purported purpose of such limitations was to prevent or correct the confusion resulting from the concurrent use of the same name. These limitations usually prescribed that the surname be accompanied by initials or a first name,²⁷ and by a disclaimer explaining that the two businesses were in no way affiliated.²⁸ The interest in merely requiring the “newcomer to differentiate the business name so as to eliminate” potential confusion²⁹ stemmed from the concern that depriving an individual of the right to use his name was akin to “taking away his identity.”³⁰ Justice Holmes once commented that “[a]n absolute prohibition against using the name would carry trademarks too far. Therefore the rights of the two parties have been reconciled by allowing the use.”³¹ Another court cited the protective nature of injunctive relief as another basis for restricting the plaintiff’s remedy. Because an injunction is only intended to protect a person in his property rights – not to punish the defendant for his wrongdoing³² – the addition of prefixes and explanatory matter was considered sufficient to protect the plaintiff from confusion as to the source of the goods.

D. Efficacy of Limited Relief

Although requiring the use of explanatory material, disclaimers and given names to avoid confusion produced by the concurrent use of surnames by two businesses was an attempt to reconcile the competing interests of the rights of individuals and the public,³³ the effectiveness of such limited relief has been questioned, and the frequency of its use has been criticized both by courts³⁴ and commentators.³⁵ It has been suggested that because a name generally draws its significance from advertising and not through personal association, the “name has become a purely impersonal symbol”³⁶ and, consequently,

[t]he purchaser, long taught to identify the product by the [surname] alone, promptly registers the identity as complete upon catching the surname without noticing and pondering the significance of initials or suffix. And even the occasional purchaser who notices the suffix is not enlightened. For one who has known of one Dobbs only, suddenly confronted with the suggestion that there are in existence varieties of the species, is not informed which Dobbs is “his” Dobbs. Confusion is created by the very explanation intended to avert confusion.³⁷

Accordingly, some commentators have suggested that courts should issue only absolute injunctions against the second user because no other relief is effective in preventing the public’s confusion as to the source of the goods.³⁸

II. Recent Cases

A. The Interests in Protecting Both the Public from Confusion and the Established Reputation of the First User Irrespective of the Defendant's Intent

In the late 1950s through the 1970s, courts, balancing the countervailing interests of an individual's right to use his name and the public's right to be free from confusion, seemed to find more frequently that the public interest outweighed the interest of the second user.³⁹ In addition, the defendant's state of mind was no longer deemed relevant to the determination of whether use of his name could be enjoined: courts held that proof of defendant's fraudulent intent was no longer a pre-requisite to relief if the public was likely to be confused by the concurrent uses of the same name.⁴⁰ However, in contrast to the relief typically granted in trademark infringement cases, the courts often granted only limited relief in cases involving names.⁴¹

All of these threads came together in *David B. Findlay, Inc. v. Findlay*.⁴² David Findlay operated an art gallery on East 57th Street in Manhattan, known as "Findlay Galleries." Wally Findlay, David's brother, attempted to open an art gallery on the same street under the name "Wally Findlay Galleries." The New York Court of Appeals sustained an absolute injunction against Wally Findlay's use of his name on East 57th Street; the defendant was permitted, however, to remain on East 57th Street if he used the name W.C.F. Galleries, or to use his own name in another location. The Court stated that

[t]he so-called 'sacred right' theory that every man may employ his own name in his business is not unlimited. Moreover, fraud or deliberate intention to deceive or mislead the public are not necessary ingredients to a cause of action.

The present trend of the law is to enjoin the use of a family name when such use tends or threatens to produce confusion in the public mind The *bona fides* of Wally's intentions do not change the applicable principles. The objective facts of this unfair competition and injury to plaintiff's business are determinative, not the defendant's subjective state of mind.⁴³

The Court emphasized the inequity of allowing someone to benefit unfairly from another's years of effort in establishing a business reputation. The Court found a potential for confusion resulting from the similarity of the art displayed in these galleries, the reliance of the public on the reputation of galleries, and the public's lack of personal knowledge of paintings.⁴⁴

The concern for preventing a defendant from unfairly benefitting from a first user's established goodwill and yet, the continued reluctance to preclude absolutely the use of one's own name in business is further demonstrated in *Taylor Wine Co. v. Bully Hill Vineyards, Inc.*⁴⁵ There, the Court of Appeals for the Second Circuit modified and remanded a preliminary injunction order issued by the district court so as to allow the defendant to use his signature on labels and advertising if it was accompanied by a disclaimer stating that he was not affiliated with, or a successor to, the plaintiff company.⁴⁶

The Second Circuit's decision in *Levitt Corp. v. Levitt*⁴⁷ suggests that, in certain instances, an absolute injunction will issue to prevent public confusion in a personal name case. Defendant had sold his construction business to the plaintiff, including the use of his name and the goodwill attached to it, and had agreed not to engage in the construction business. Later, when the defendant once again entered the construction business under his own name, plaintiff sought to enjoin him from violating the agreement. The court, in an exception to the general practice of affording only limited relief to a plaintiff where the infringer has a genuine interest in establishing a business under his own name, unqualifiedly enjoined the defendant's use of this name, even beyond the terms of the existing agreement between the parties, in order to prevent the dilution of the goodwill purchased by the plaintiff.

B. The Declining Significance Accorded Surnames – Application of General Trademark Law Principles

The failure in recent years by some courts to use a special analysis in trademark infringement actions involving the use of personal names may suggest that, in the future, personal names may be treated no differently from any other trademark or trade name.⁴⁸ The treatment of infringement claims involving the use of surnames reveals a tendency to analyze the issue under the general principles of common law trademark infringement.⁴⁹ Since a surname by itself is not considered to be distinctive,⁵⁰ a plaintiff will be protected from another's use of his name only if he demonstrates that (1) his mark has acquired secondary meaning⁵¹ and (2) there is a likelihood of confusion resulting from defendant's use.⁵² However, despite the recent emphasis on likelihood of confusion – the critical issue in any trademark infringement claim – the relief granted thus far in these personal name cases usually has remained limited and, consequently, the defendant has usually retained the right to use his name in some manner.

In both *Caesars World, Inc. v. Caesar's Palace*,⁵³ and *Purofied Down Products Corp. v. Purodown International of N.J. Corp.*,⁵⁴ the courts rejected the defense that an individual has the absolute right to use his own name in business. The second comer's use of his name was limited in order to protect both the public from the possible confusion resulting from the concurrent use of similar names and the first user of the mark who had acquired consumer recognition of his business name.

In *Caesars World*, the plaintiff used the name "CAESARS PALACE" in Romanesque typeface to identify a resort hotel in Nevada for many years. The defendant similarly adopted the same name with similar typeface to identify his beauty salon. The court enjoined the defendant's commercial use of his first name "CAESAR," so long as it was used alone or in combination with the word "PALACE," but allowed the defendant to use his first name if it was followed by his surname "CRIMI," and not followed by the word "PALACE."⁵⁵

Similarly, in *Purofied Down*, the court limited the manner in which defendant's name could be used to identify his business. Applying the likelihood of confusion test, the court enjoined the defendant, Arthur Puro, from further use of the word "Down" in connection with the use of his name "PURO" in light of the plaintiff's trade name of Purofied Down Products Corp. and trademarks of PUROFOAM, PUROFIED and PURON. The court found a great potential for confusion caused by the concurrent use of such similar names both of which represented businesses in the bulk feathers and down markets.⁵⁶

The similarity – or dissimilarity – of the channels of trade in which the concurrent use of similar names occurred was likewise an important factor within the likelihood of confusion analysis in two recent cases.

In *E.T.F. Enterprises, Inc. v. Nina Ricci*,⁵⁷ the defendant attempted to register the name "VICTORIO RICCI" for a shoes and accessories business. Plaintiff opposed the application and while the opposition to the defendant's trademark registration was pending, defendant's principal legally changed his name to Todd Ricci. The plaintiff, Nina Ricci, had been engaged in an established perfume business for many years, and the name was derived from one of the business' founders. One of the founder's sons, Robert Ricci, was then the president of the company. The court, reversing the Trademark Trial and Appeal Board which had sustained the opposition, allowed the defendant to register the name "VICTORIO RICCI" on the basis that no confusion would result from the concurrent use of the names. The court emphasized that the plaintiff had no intention of going into the footwear business and, consequently, the

sophisticated consumers buying products in these dissimilar markets would not be confused by the concurrent use of the similar name.

By contrast, the existence of dissimilar markets was of no consequence in *Tiffany and Co. v. Parfums Lamborghini*.⁵⁸ where the court issued an absolute injunction preventing the defendant from using the plaintiff's name even though the plaintiff company had no intention of entering the defendant's line of business. The court found, on the basis of the strength and renown of plaintiff's mark, that the public would likely be confused by the defendant's use of his great-grandfather's name "TIFFANY" to identify his line of perfumes because consumers would believe that the plaintiff company, Tiffany, had gone into the perfume business.

III. Federal Registrability

The manner in which surnames have been treated for purposes of registrability under the federal statutes has been similar to the way in which names have been dealt with by the common law.

The Trade-Mark Act of 1905 paralleled the early common law approach to surnames: the Act prohibited federal registration of a mark which consisted merely of an individual's name.⁵⁹ Guided by the early notion that a name cannot be exclusively appropriated,⁶⁰ the 1905 Act refused registration to surnames,⁶¹ complete names,⁶² and composite names consisting of two surnames.⁶³ The Act recognized two exceptions to this rule, however, and permitted the registration of an individual's name if it was "written, printed, impressed or woven in some particular or distinctive manner."⁶⁴ In addition, if the name was refused registration on the basis that it was merely a surname and did not appear otherwise distinctive, it could, nonetheless, qualify for registration if the applicant could demonstrate actual and exclusive use of the mark for a period of ten years prior to February 20, 1905.⁶⁵

Congressional intent to liberalize the prior practice of refusing to register any word "which was in use as a surname" has resulted in more flexible statutory requirements with respect to the registrability of surnames.⁶⁶ Section 2(e) (3) of the Trademark Act of 1946 (the "Lanham Act") provides that a mark may be refused registration if it consists of a term which "is primarily merely a surname."⁶⁷ The Patent and Trademark Office bears the burden of proving that the mark fits the above language.⁶⁸ If the mark is refused registration under Section 2(e) (3), an applicant may, nonetheless, obtain registration if he demonstrates that the mark "has become distinctive of the applicant's goods in commerce" under Section 2(f).⁶⁹

The legislature's addition of the prefix "primarily" was intended to, and did, increase the registrability and statutory protection of surnames. This effect is similar to that achieved by the increased judicial willingness to accord some limited protection to the first users of surnames where a second comer's use may have the effect of potentially injuring the business of the former.

The test now to be applied in determining whether a mark is to be regarded as "primarily merely a surname" focuses on the mark's primary significance to the purchasing public.⁷⁰ In addition, the Patent and Trademark Office's method of making such a determination has changed. The Office no longer can rely conclusively on a finding of the existence of several listings of the name in telephone directories to determine that the name is primarily merely a surname.⁷¹

If the public would regard the name as having meanings other than that of a surname, registration has been allowed.⁷² Recent examples of names that did not qualify as "primarily merely a surname" and consequently were registrable, indicate a greater willingness to protect surnames to the extent that the public would view the name as identifying something other than an individual. While "HARRIS" was denied registration because of the great number of listings in the telephone directories,⁷³ "FAIR-BANKS" had a geographic connotation just as dominant in character as the surname significance and, consequently, was held registrable.⁷⁴

The increasing receptiveness to the registration of surnames is represented in the ability to register a composite name, that is, a name consisting of a combination of two surnames. In prior years, composite names were denied registration on the ground that if the individual names comprising the composite names were viewed as primarily merely surnames, such as "KIMBERLY-CLARK," the name as a whole would likewise be denied registration.⁷⁵ More recently, however, one court held that the mark must be viewed in its entirety, rather than dissected into its parts, and consequently the name "SCHAUB-LORENZ" was held registrable.⁷⁶ Continuing this trend, it was held insufficient that the name "LESNEY," a combination of "LES" from "Leslie Smith" and "NEY" from "Rodney Smith," looks and sounds like a surname; viewing the name as a whole, the Trademarks Trial and Appeal Board held that it was registrable.⁷⁷

Conclusion

The judicial deference accorded personal names in prior years has been substantially eroded in the past century. The courts' more recent concern

has been with protecting the established goodwill of a business and with attempting to minimize the potential confusion and deception resulting from the simultaneous use of the same names by different commercial sources. The loss felt by an individual who is required to limit the manner in which he commercially uses his name is counted as a small sacrifice in the face of a larger gain: encouraging an informed consumer public.

Notes

¹See *Hat Corp. v. D.L. Davis Corp.*, 4 F. Supp. 613, 623 (D. Conn. 1933).

²*Id.*

³Comment, *Use of Own Name in Business Enjoined Without a Showing of Fraud*, [1967] Utah L. Rev. 191, 194.

⁴Various advantages may stem from use of a surname to identify a business. The public's association of an individual's name with particular goods may encourage the saleability of particular products because it suggests that an individual stands behind the goods. Thus, the name may act as an indirect endorsement, and it may suggest a certain degree of reliability. It has also been suggested that the use of a surname may have advantages over the use of another kind of trademark because: (1) a consumer may be more capable of distinguishing between surnames than between other kinds of marks; (2) the goods may be thought of as symbolizing "the integrity of the maker"; and (3) the goods may be regarded as products of an established family business continuing the particular expertise of the founder. Cassidy, *Surnames as Trade-Marks*, 41 T.M.R. note 6, at 301-03 (1951).

Although most consumers today would no longer be influenced by these factors, the commercial advantages offered by the use of surnames may still be relied on in businesses with high levels of personal contact, such as tailoring or operating a neighborhood grocery store and the legal, medical and accounting professions.

⁵*Levitt Corp. v. Levitt*, 593 F.2d 463, 467 (2d Cir. 1979); *D&W Food Corp. v. Graham*, 134 Cal. App. 2d 668, 686 P.2d 77 (1955); Comment, *Unfair Competition: Injunctive Relief and the Personal Name Exception*, 51 Minn. L. Rev. 782, 784 (1967); 3 Callmann, *Unfair Competition, Trademarks, and Monopolies* § 83.3(a) (2), at 1609 (1969); 1 Gilson, *Trademark Protection and Practice* § 2.08, at 56-57 (1982); 1 McCarthy, *Trademarks and Unfair Competition*, § 13.3, at 451 (1973); Comment, *The Family Name Dilemma: A Question of "Fairness"*, 8 B.C. Indus. & Com. L. Rev. 319, 323-25 (1966).

⁶*Singer Manufacturing Co. v. June Manufacturing Co.*, 163 U.S. 169, 187 (1896); *Meneely v. Meneely*, 62 N.Y. 427, 431-32 (1875).

⁷*Mozzochi v. Luchs*, 201 U.S.P.Q. 796, 797 (Conn. Sup. Ct. 1977).

⁸*Hilton v. Hilton*, 89 N.J. Eq. 182, 104 A. 375, 376 (1918).

⁹*Mozzochi v. Luchs*, 201 U.S.P.Q. 796, 797 (Conn. Sup. Ct. 1977).

¹⁰*Brown Chemical Co. v. Meyer*, 139 U.S. 540, 544 (1891) ("A man's name is his own property, and he has the same right to its use and enjoyment as he has to that of any other species of property.").

¹¹*Hilton v. Hilton*, 89 N.J. Eq. 182, 104 A. 375, 376 (1918) (A man's right to use his own name in business is "guaranteed by our [state] Constitution, without which the right to acquire, possess, and protect property would be of little worth.").

¹²*Howe Scale Co. v. Wyckoff, Seamans & Benedict*, 198 U.S. 118, 134 (1905); see *Meneely v. Meneely*, 62 N.Y. 427, 432 (1875) ("A person cannot . . . obtain a monopoly of [his name] which will debar all other persons of the same name from using their own names in their own business.").

¹³*Meneely v. Meneely*, 62 N.Y. 427, 431 (1875); accord, *Singer Manufacturing Co. v. June Manufacturing Co.*, 163 U.S. 169, 187 (1896).

¹⁴*Singer Manufacturing Co. v. June Manufacturing Co.*, 163 U.S. 169, 187 (1896); *Brown Chemical Co. v. Meyer*, 139 U.S. 540, 544 (1891). This was an application of the principle “*damnum absque injuria*,” that is, a loss without a legal injury: a loss that does not give rise to a legal action. *Black’s Law Dictionary* 354 (1979).

¹⁵*Howe Scale Co. v. Wyckoff, Seamans & Benedict*, 198 U.S. 118, 137 (1905) (issue is whether the “use is reasonable and honest, or is calculated to deceive”); *Singer Manufacturing Co. v. June Manufacturing Co.*, 163 U.S. 169, 187 (1896) (person “cannot resort to any artifice or do any act calculated to mislead the public as to the identity of the business”); *Brown Chemical Co. v. Meyer*, 139 U.S. 540, 544 (1891) (requiring that use be “reasonable, honest and fair”); *Meneely v. Meneely*, 62 N.Y. 427, 431–32 (1875) (requiring that an individual not “resort to any artifice or contrivance for the purpose of producing the impression that the establishments are identical or do anything calculated to mislead”); *see John R. Thompson Co. v. Holloway*, 141 U.S.P.Q. 355, 360 (N.D. Texas 1964) (recognizing the right to use one’s name in absence of fraud or bad faith); *Paul Westphal v. Westphal’s World’s Best Corp.*, 216 App. Div. 53, 215 N.Y.S. 4, 7, (1926) (requiring fraud or deceit).

¹⁶Comment, *The Family Name Dilemma: A Question of “Fairness,”* 8 B.C. Indus. & Com. L. Rev. 319, 323, 325 (1966); Comment, *Use of Own Name in Business Enjoined Without a Showing of Fraud*, [1967] Utah L. Rev. 191, 192.

¹⁷235 U.S. 88 (1914).

¹⁸The Court rejected prior holdings that “courts will not interfere with the use of a party’s own name ‘where the only confusion, if any, results from the similarity of the names and not from the manner of use.’ ” *Id.* at 94, citing *Howe Scale Co. v. Wyckoff, Seamans & Benedict*, 198 U.S. 118, 140 (1905); *accord, Meneely v. Meneely*, 62 N.Y. 427, 432 (1875).

¹⁹The same year, the Court had expressly held that direct proof or an inference of defendant’s wrongful intent was not a pre-requisite to relief. *Thaddeus Davids Co. v. Davids Manufacturing Co.*, 233 U.S. 461, 471 (1914).

²⁰235 U.S. at 94.

²¹233 U.S. 461 (1914).

²²235 U.S. at 94.

²³*Westphal v. Westphal’s World Best Corp.*, 216 App. Div. 53, 215 N.Y.S. 4, 7, *aff’d*, 243 N.Y. 639, 154 N.E. 638 (1926); Comment, *Use of Own Name in Business Enjoined Without a Showing of Fraud*, [1967] Utah L. Rev. 191, 193; Comment, *The Family Name Dilemma: A Question of “Fairness,”* 8 B.C. Indus. & Com. L. Rev. 319, 323 (1966); 3 Callmann, *Unfair Competition, Trademarks and Monopolies* 1679 (2d ed. 1950); *see Visser v. Macres*, 214 Cal. App. 2d 249, 253, 29 Cal. Rptr. 367, 371 (1963); *MacSweeney Enterprises, Inc. v. Tarantino*, 235 Cal. App. 2d 549, 45 Cal. Rptr. 546 (1965).

²⁴*Westphal v. Westphal’s World Best Corp.*, 216 App. Div. 53, 215 N.Y.S. 4, 7, *aff’d*, 243 N.Y. 639, 154 N.E. 638 (1926); *Goldberg v. Goldberg*, 159 Ga. 761, 126 S.E. 823 (1925); *Handler & Pickett, Trade-Marks and Trade Names – An Analysis and Synthesis*, 30 Colum. L. Rev. 168, 199 n. 96 (1930).

²⁵*Hat Corp. of America v. D.L. Davis Corp.*, 4 F. Supp. 613, 619, 623 (D. Conn. 1933); *Guth v. Guth Chocolate Co.*, 224 F. 932 (4th Cir.), *cert. denied*, 239 U.S. 640 (1915).

²⁶*Mandell, Personal Name Trademarks – Your Name May Not Be Your Own*, 70 T.M.R. 326, 329–30 (1980); Comment, *The Family Name Dilemma: A Question of “Fairness,”* 8 B.C. Indus. & Com. L. Rev. 319, 323 (1966).

The personal name cases reveal the most frequent application of qualified injunctions. *Handler & Pickett, Trade-Marks and Trade Names – An Analysis and Synthesis*, 30 Colum. L. Rev. 168, 196 (1930).

One court has suggested that, in prior years, the courts’ statements that one has an absolute right to the use of one’s name were “broader” than “the facts require[d]” because in those cases confusion could have been “effectively averted” if the newcomer were required to qualify his use of the name by a “prefix, suffix, or explanation.” *Hat Corp. of America v. D.L. Davis Corp.*, 4 F. Supp. 613, 620–21 (D. Conn. 1933).

²⁷*Friend v. H. A. Friend & Co.*, 416 F.2d 526, 534 (9th Cir. 1969), *cert. denied*, 397 U.S. 914 (1970); *Berghoff Restaurant Co. v. Louis W. Berghoff, Inc.*, 357 F. Supp. 127 (N.D. Ill. 1973),

aff'd, 499 F.2d 1183 (7th Cir. 1974); Crane Co. v. Crane Heating & Air Conditioning Co., 299 F.2d 577 (6th Cir. 1966); Horlick's Malted Milk Corp. v. Horlick, 143 F.2d 32 (7th Cir. 1944); Sullivan v. Ed Sullivan Radio & TV Inc., 1 App. Div. 2d 609, 152 N.Y.S.2d 227 (1956).

²⁸Friend v. H. A. Friend & Co., 416 F.2d 526, 534 (9th Cir. 1969), *cert. denied*, 397 U.S. 914 (1970); Coty v. Parfums de Grande Luxe, Inc., 298 F.2d 865 (2d Cir. 1964); Stetson v. Stetson, 85 F.2d 586 (2d Cir.), *cert. denied*, 299 U.S. 605 (1936); National Distillers Prods. Corp. v. K. Taylor Distilling Co., 31 F. Supp. 611, 615–16 (E.D. Ky. 1940); David B. Findlay, Inc. v. Findlay, 18 N.Y.2d 12, 21–22, 271 N.Y.S.2d 652, 218 N.E.2d 531, *cert. denied*, 385 U.S. 930 (1966).

²⁹D.W.G., Inc. v. Gordon's Jewelry Co., 635 P.2d 326, 329 (Sup. Ct. Okla. 1981) (citing John R. Thompson Co. v. Holloway, 366 F.2d 108 (5th Cir. 1966)).

³⁰Societe Vinicole de Champagne v. Mumm, 143 F.2d 240, 241 (2d Cir. 1944) (Without the use of his name an individual "cannot make known who he is to those who may wish to deal with him; and that is so grievous an injury that courts will avoid imposing it, if they possibly can").

³¹Herring-Hall-Marvin Safe Co. v. Hall's Safe Co., 208 U.S. 554, 559 (1908). Justice Holmes added that "[o]f course [an] explanation must accompany the use, so as to give the antidote with the bane." *Id.* Thus, the Court permitted the defendant to use his name Hall as long as the name was accompanied by an explanation that the defendant did not purport to be the original Hall's Safe And Lock Company, or its successor and, in addition, that defendant's products did not come from the plaintiff's company. *Id.* at 560.

³²Hilton v. Hilton, 89 N.J. Eq. 182, 104 A. 375, 376 (1918).

³³Comment, *Unfair Competition: Injunctive Relief and the Personal Name Exception*, 51 Minn. L. Rev. 782, 784 (1967).

³⁴Hat Corp. of America v. D.L. Davis Corp., 4 F. Supp. 613, 622–23 (D. Conn. 1933); *see* Taylor Wine Co. v. Bully Hill Vineyards, Inc., 590 F.2d 701, 704 (2d Cir. 1978) ("Thirsty folk want beer, not explanations") (quoting Montgomery v. Thompson [1891], A.C. 217, 225).

³⁵Handler & Pickett, *Trade-Marks and Trade Names – An Analysis and Synthesis*, 30 Colum. L. Rev. 168, 198–200 (1930); Comment, *Use of Own Name in Business Enjoined Without a Showing of Fraud*, [1967] Utah L. Rev. 191, 194; Comment, *The Family Name Dilemma: A Question of "Fairness"*, 8 B.C. Indus. & Com. L. Rev. 319, 327 (1966); 1 Gilson, *Trademark Protection and Practice*, § 2.08, at 62–64 (1982); 1 Nims, *Unfair Competition and Trademarks* §§ 69, 71 (4th ed. 1947).

³⁶Hat Corp. of America v. D.L. Davis Corp., 4 F. Supp. 613, 622 (D. Conn. 1933).

³⁷*Id.*

³⁸1 Nims, *Unfair Competition and Trademarks* § 69, at 200 (4th ed. 1947); Handler & Pickett, *Trade-Marks and Trade Names – An Analysis and Synthesis*, 30 Colum. L. Rev. 168, 198–200 (1930). Professor Handler proposed that a plaintiff should obtain an absolute injunction if he "acts promptly", whereas if the defendant had already acquired good will, only a qualified injunction should issue. *Id.*

³⁹1 Gilson, *Trademark Protection and Practice*, § 2.08, at 57 (1982); *see* Levitt Corp. v. Levitt, 593 F.2d 463 (2d Cir. 1979); Taylor Wine Co. v. Bully Hill Vineyards, Inc., 569 F.2d 731 (2d Cir. 1978); Friend v. H. A. Friend and Co., 416 F.2d 526, 534 (9th Cir. 1969) *cert. denied*, 397 U.S. 914 (1970); Santucci Construction Co. v. Carlo v. Santucci, Inc., 200 U.S.P.Q. 783 (N.D. Ill. 1978); International Election Systems Corp. v. Shoup, 452 F. Supp. 684 (E.D. Pa. 1978); David B. Findlay, Inc. v. Findlay, 18 N.Y.2d 12, 218 N.E.2d 531, 271 N.Y.S.2d 652 (1966), *cert. denied*, 385 U.S. 930 (1966); MacSweeney Enterprises, Inc. v. Tarantino, 235 Cal. App. 2d 549, 45 Cal. Rptr. 546 (1965); King's of Boise, Inc. v. M.H. King Co., 88 Idaho 267, 274, 398 P.2d 942, 945 (1965); Mayo Clinic v. Mayo's Drug and Cosmetic, Inc., 262 Minn. 101, 107–08, 113 N.W.2d 852, 856 (1962). *But see* Scott Paper Co. v. Scott's Liquid Gold, Inc., 589 F.2d 1225 (3d Cir. 1978) (holding that plaintiff was not entitled to relief because there was no likelihood of confusion).

⁴⁰D.W.G., Inc. v. Gordon's Jewelry Co., 635 P.2d 326, 329 (Sup. Ct. Okl. 1981); Comment, *The Family Name Dilemma: A Question of "Fairness"*, 8 B.C. Indus. & Com. L. Rev. 319, 324–27 (1966); *see, e.g.*, Taylor Wine Co. v. Bully Hill Vineyards, Inc., 569 F.2d 731 (2d Cir. 1978); MacSweeney Enterprises, Inc. v. Tarantino, 235 Cal. App. 2d 549, 45 Cal. Rptr. 546 (1965); David B. Findlay, Inc. v. Findlay, 18 N.Y.2d 12, 218 N.E.2d 531, 271 N.Y.S.2d 652 (1966), *cert. denied*, 385 U.S. 930 (1966); Sullivan v. Ed Sullivan Radio & TV, Inc., 1 A.D.2d 609, 152

N.Y.S.2d 227 (1956); *Holmes v. Borden Brokerage Co.*, 51 Wash. 2d 746, 321 P.2d 898 (1958). *But see* *Pizitz, Inc. v. Pizitz Mercantile Co. of Tuscaloosa*, 204 U.S.P.Q. 707 (N.D. Ala. 1979) (applying the earlier test of whether the second comer acted in bad faith).

⁴¹*Santucci Construction Co. v. Carlo v. Santucci, Inc.*, 200 U.S.P.Q. 783 (N.D. Ill. 1978); *International Election Systems Corp. v. Shoup*, 452 F. Supp. 684 (E.D. Pa. 1978); *Dulong Freres & Fils v. Dulong*, 192 U.S.P.Q. 664 (S.D.N.Y. 1976).

⁴²18 N.Y.2d 12, 218 N.E.2d 531, 271 N.Y.S.2d 652 (1966), *cert. denied*, 385 U.S. 930 (1966).

⁴³271 N.Y.S.2d at 655–56.

⁴⁴*Id.* at 655 (“[m]odern art is sold only to those who see it. . . . [David’s] good will brings in customers who look for a work of art that suits their fancy and, if Wally were to continue to use the name Findlay, it is inevitable that some would walk into Wally’s by mistake and would have their tastes satisfied there, to David’s great harm.”)

⁴⁵569 F.2d 731 (2d Cir. 1978).

⁴⁶569 F.2d at 736. The subsequent District Court preliminary injunction order was modified on a second appeal. *Taylor Wine Co. v. Bully Hill Vineyards, Inc.*, 590 F.2d 701 (2d Cir. 1978).

⁴⁷593 F.2d 463 (2d Cir. 1979).

⁴⁸1 Gilson, *Trademark Protection and Practice*, § 20.8, at 57 (1982) (quoting *John R. Thompson Co. v. Holloway*, 366 F.2d 108, 113 (5th Cir. 1966)); *see* *Purofied Down Prods. Corp. v. Puro Down Int’l of N.J. Corp.*, 530 F. Supp. 134 (E.D.N.Y. 1982); *Buitoni Foods Corp. v. Gio. Buton & C. S.p.A.*, 530 F. Supp. 949 (E.D.N.Y. 1981); *E.T.F. Enterprises, Inc. v. Nina Ricci*, 523 F. Supp. 1147 (S.D.N.Y. 1981); *Lebow Bros., Inc. v. Lebole Euroconf*, 503 F. Supp. 209 (E.D. Pa. 1980); *Caesars World, Inc. v. Caesar’s Palace*, 490 F. Supp. 818 (D.N.J. 1980); *Ashe v. Pepsico, Inc.*, 205 U.S.P.Q. 451 (S.D.N.Y. 1979).

⁴⁹A separate and distinct issue is presented, and a different analysis is applied, when a defendant, using his own name to identify his business, raises a personal name defense under section 33(b) (4) of the Lanham Act. 15 U.S.C. § 1115 (b) (4). That provision provides in pertinent part:

“If the right to use the registered mark has become incontestable under section 1065 of this title, the registration shall be conclusive evidence of the registrant’s exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the affidavit filed under the provisions of said section 1065 subject to any conditions or limitations stated therein except when one of the following defenses or defects is established:

* * *

“(4) That the use of the name, term, or device charged to be an infringement is a use, otherwise than as a trade or service mark, of the party’s individual name in his own business, or of the individual name of anyone in privity with such party.”

This so-called “fair use” defense protects a party’s good faith use of his name in a nontrademark or personal manner. *See generally* 1 Gilson, *Trademark Protection and Practice*, § 2.08, at 57, 60–61 (1982). For no apparent reason, this statutory defense has rarely been litigated with respect to personal names, and courts have not expressly applied this provision in personal name cases.

⁵⁰*E.g.*, 1 Gilson, *Trademark Protection and Practice*, § 2.08, at 54 (1982).

⁵¹Proof of secondary meaning requires a showing that the public has learned to associate certain products with a specific source. *See, e.g.*, *Scott Paper Co. v. Scott’s Liquid Gold, Inc.*, 589 F.2d 1225, 1228 (3d Cir. 1978). *See generally* 1 McCarthy, *Trademarks and Unfair Competition*, § 15:1 (1981).

⁵²In general, a likelihood of confusion results when defendant’s mark is so similar to plaintiff’s mark that, “when [the two marks] are used on particular products sold through certain channels of trade, there is likely to be confusion as to source or sponsorship.” 1 Gilson, *Trademark Protection and Practice*, § 5.01 at 6 (1982). *See, e.g.*, *Scott Paper Co. v. Scott’s Liquid Gold, Inc.*, 589 F.2d 1225, 1229 (3d Cir. 1978); *Mushroom Makers, Inc. v. R. G. Barry Corp.*, 580 F.2d 44, 47 (2d Cir. 1978), *cert. denied*, 439 U.S. 1116 (1979). The tests for determining likelihood of confusion vary by circuit. In the Second Circuit, a court is required to evaluate and consider the following factors in reaching a decision as to likelihood of confusion: strength of the senior user’s mark; degree of similarity between the marks; proximity of the products; actual confusion; sophistication of the relevant purchasers; likelihood that the senior user will “bridge the gap” between the products; junior user’s good faith; and quality of the junior user’s product. *See* *McGregor-Doniger Inc. v.*

Drizzle Inc., 599 F.2d 1126 (2d Cir. 1979); Mushroom Makers, Inc. v. R. G. Barry Corp., 580 F.2d 44 (2d Cir. 1978); Goldberg & Borcard, *Related Goods Trademark Cases In The Second Circuit*, 70 T.M.R. 287, 305–06 (1980).

⁵³490 F. Supp. 818 (D.N.J. 1980).

⁵⁴530 F. Supp. 134 (E.D.N.Y. 1982).

⁵⁵490 F. Supp. at 829. The court stated:

Defendant, in using a new trade name and corporate name, shall refrain from using the word “Palace”; however, the word “Caesar” may be used *only* if it is followed by the name “Crimi”, and the word “Caesar” shall not be printed in the romanesque lettering style used by the plaintiffs. For example, the new name for defendant’s shop could be Caesar Crimi’s Coiffures, Caesar Crimi’s Beauty Shop, etc.; but not Crimi’s Palace, Caesar Crimi’s Palace, nor Caesar’s or Caesars.

⁵⁶530 F. Supp. at 135–36.

⁵⁷523 F. Supp. 147 (S.D.N.Y. 1981).

⁵⁸214 U.S.P.Q. 77 (S.D.N.Y. 1981).

⁵⁹Federal Trademark Act of Feb. 20, 1905, c.592, § 5, 33 Stat. 726 (1905).

⁶⁰Comment, *Registration of Marks Which Are Primarily Merely Surnames*, 24 Geo. Wash. L. Rev. 368, 369 (1956).

⁶¹See *Ex parte Schultz-Rosky-Block Co.*, 67 U.S.P.Q. 15 (Comm’r Pat. 1945).

⁶²See *American Tobacco Co. v. Wix*, 62 F.2d 835 (C.C.P.A. 1947).

⁶³See *Ex parte Bendix Aviation Corp.*, 74 U.S.P.Q. 309 (Comm’r Pat. 1947).

⁶⁴Federal Trademark Act of February 20, 1905, c.592, § 5, 33 Stat. 726 (1905).

⁶⁵*Id.*

⁶⁶In *re Lesney Prods. & Co.*, 181 U.S.P.Q. 401, 402 (T.T.A.B. 1974) (quoting *Ex parte The Wayne Pump Co.*, 88 U.S.P.Q. 437, 439–40 (Comm’r Pat. 1951); *Lucien Piccard Watch Corp. v. Since 1868 Crescent Corp.*, 165 U.S.P.Q. 459 (S.D.N.Y. 1970); 1 McCarthy, *Trademarks and Unfair Competition*, § 13:11, at 474 (1981).

⁶⁷15 U.S.C. § 1052(e) (3) (1976).

⁶⁸*E.g.*, In *re Lesney Prods. & Co.*, 181 U.S.P.Q. 401, 402 (T.T.A.B. 1974).

⁶⁹15 U.S.C. § 1052(f) (1976). Of course, if the applicant wishes to register the name of another living individual, he must obtain written consent of that person before he will be allowed to do so under section 2(c) of the Act. 15 U.S.C. § 1052(c) (1976).

If the applicant cannot demonstrate distinctiveness under Section 2(f), the mark still might be registered on the Supplemental Register upon a showing of lawful use in commerce for one year and that the term is capable of distinguishing the goods or services. Lanham Act § 23, 15 U.S.C. § 1091. The Supplemental Register provides a lower level of protection but does afford some of the advantages of having a registered mark.

⁷⁰In *re Colt Industries Operating Corp.*, 195 U.S.P.Q. 75, 77 (T.T.A.B. 1977); *Application of Standard Elektrik Lorenz Aktiengesellschaft*, 371 F.2d 870 (C.C.P.A. 1967); *Ex parte Rivera Watch Corp.*, 106 U.S.P.Q. 145 (Comm’r Pat. 1955); 1 McCarthy, *Trademarks and Unfair Competition*, § 13:11, at 476 (1981); Fowler, *Tips From The TTAB – When Surnames Are Registrable*, 70 T.M.R. 66, 70 (1980).

⁷¹See *Application of Standard Elektrik Lorenz Aktiengesellschaft*, 371 F.2d 870, 873 (C.C.P.A. 1967); *Drexel Enterprises v. Colby*, 138 U.S.P.Q. 1 (S.D. Cal. 1963); *Ex parte Gemex Co.*, 111 U.S.P.Q. 443 (Comm’r Pat. 1956); 1 McCarthy, *Trademarks and Unfair Competition*, § 13:11, at 478 (1981).

⁷²See, *e.g.*, *Fisher Radio Corp. v. Bird Electronics Corp.*, 162 U.S.P.Q. 265 (T.T.A.B. 1969); *Ex parte Gemex Co.*, 111 U.S.P.Q. 443 (Comm’r Pat. 1956); 1 Gilson, *Trademark Protection and Practice*, § 2.08[2], at 66 (1982); 1 McCarthy, *Trademarks and Unfair Competition*, § 13:11, at 478 (1981).

⁷³In *re Harris-Intertype Corp.*, 518 F.2d 629 (C.C.P.A. 1975).

⁷⁴In *re Colt Industries Operating Corp.*, 195 U.S.P.Q. 75 (T.T.A.B. 1977).

⁷⁵*Kimberly-Clark Corp. v. Marzall*, 196 F.2d 772 (D.C. Cir. 1952).

⁷⁶*Application of Standard Elektrik Lorenz Aktiengesellschaft*, 371 F.2d 870, 873 (C.C.P.A. 1967).

⁷⁷In *re Lesney Prods. & Co.*, 181 U.S.P.Q. 401, 402 (T.T.A.B. 1974).