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## FAMILY FEUD: THE TENSION BETWEEN FAMILY NAMES AND TRADEMARKS

*By Christopher P. Bussert\**

### I. INTRODUCTION

The FAMILY FEUD game show is a well-known television show that was popularized initially in the United States in the late 1970s, and later in many countries around the world. It pits two families against each other in a friendly contest in which the families compete to name the most popular responses to a series of survey questions that were answered in advance by the show's audience. The winning family is then given the opportunity to play an additional round of the game for cash prizes. FAMILY FEUD contests have permeated trademark law as well, albeit in a much less friendly environment. The trademark law version often pits family members against one another in a legal competition in which a far more valuable prize is at stake, the right to use a well-known family name as a trademark in connection with one or more business ventures.

This article examines reported decisions involving disputes between family members who own trademarks consisting primarily of the family name<sup>1</sup> and another party (in most cases another family member) who later desires to use the family name in connection with another commercial venture. The decisions examined reflect an evolution in the standard that has been applied to determine trademark infringement in family name conflicts, and a surprising disparity in the relief that has been ultimately awarded.

### II. STANDARD OF REVIEW

Some very early decisions held that an individual had an "absolute right" to use one's family name in connection with one's

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1. As evidenced herein, courts have been inconsistent in the terminology used to identify "family names," often opting for terms believed to be synonymous such as "personal names," "last names," and "surnames."

business, regardless of whether a senior family member already had acquired trademark rights in the same family name.<sup>2</sup> However, the U.S. Supreme Court, in *Brown Chemical Co. v. Meyer*,<sup>3</sup> began a retreat from this historical rule and limited the junior family name user's right to uses that are "reasonable, honest and fair," indicating the senior family name user may enjoin such use where the junior family name user evidences an intent to trade upon the goodwill or reputation of the senior family name user.<sup>4</sup>

In 1914, in *Thaddeus Davids Co. v. Davids*<sup>5</sup> and *L.E. Waterman Co. v. Modern Pen Co.*,<sup>6</sup> the Supreme Court further qualified one's right to use one's family name in connection with a commercial venture. In *Thaddeus Davids Co.*, the Supreme Court reversed a Court of Appeals and reinstated an injunction restraining the defendants' use of the family name Davids on bottles of ink.<sup>7</sup> That holding was premised on the Supreme Court's conclusion that the junior family name user had an affirmative obligation to distinguish their goods and services from those offered by the senior family name user with the same or similar family name:<sup>8</sup>

In this case, for instance, if the defendants had so chosen, they could have adopted a distinct mark of their own, which would have served to designate their inks and completely to distinguish them from those of the complainant. It was not necessary that, in exercising the right to use their own name in trade, they should imitate the mark which the complainant used, and was entitled to use under the [trademark] statute, as a designation of its wares; or that they should use the name in question upon their labels without unmistakably

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2. See generally 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 13:7 (4th ed. 1996) [hereinafter McCarthy].

3. 139 U.S. 540 (1891) (denying injunctive relief to seller of BROWN'S IRON BITTERS against sale of BROWN'S IRON TONIC where BROWN'S IRON TONIC was prepared by one Brown, and evidence demonstrated advertising and labels distinguished the two products).

4. *Id.* at 544; see also *Tharp-Bultman-Sontheimer Co. v. Tharp-Sontheimer-Tharp, Inc.*, 147 La. 705, 770-71, 85 So. 906, 908 (1920) (the use of a family name was initially excluded by jurisprudence from trademark or trade name protection absent a contract or the other party's use of the family name by artifice or deceit "for the purpose, or with the intent and effect of misleading or confusing the public and palming off his services, goods, or products as that of another"); *White v. White*, 68 So. 2d 648, 650 (La. Ct. App. 1953).

5. 233 U.S. 461 (1914).

6. 235 U.S. 88 (1914).

7. 233 U.S. at 472.

8. *Id.* at 471-72.

differentiating their goods from those which the complainant manufactured and sold.

*L.E. Waterman Co.* brought the case law in this area into even closer alignment with modern trademark law by clarifying that likelihood of confusion is the appropriate test for determining whether the plaintiff is entitled to relief:

But, whatever generality of 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 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. There is no distinction between corporations and natural persons in the principle, which is to prevent a fraud.<sup>9</sup>

In that case, the Supreme Court upheld an injunction that required the defendant to use the full name Arthur A. Waterman & Co. and a disclaimer of affiliation with the plaintiff L.E. Waterman Co. in connection with the sale of pens.<sup>9</sup>

Although a few modern cases have retreated to the historical, more deferential standard in assessing the right to use one's family name in connection with one's business,<sup>10</sup> most courts have followed the Supreme Court's lead and, treating these cases as ordinary infringement actions, applied a traditional likelihood of confusion test in determining whether the plaintiff is entitled to

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9. *Id.* at 98.

10. *See, e.g., Brody's, Inc. v. Brody Bros., Inc.*, 454 A.2d 605, 607-08 (Pa. Super. Ct. 1982) (stating "the test for infringement is completely different under Pennsylvania law when, as in the instant case, the trade name sought to be enjoined is also the personal name of the party using it," and allowing junior use of name "even if [it] . . . presents a likelihood of confusion . . . absent any artifice or act calculated to mislead the public . . ."); *Crane Co. v. Crane Heating & Air Conditioning Co.*, 299 F.2d 577, 578 (6th Cir. 1962) ("In our opinion, the Crane brothers had the right to use their family name in their business so long as they did not attempt to palm off the products which they handled as products of Crane Co. or mislead the public into believing that they were dealing with Crane Co."); *Société Vinicole de Champagne v. Mumm*, 143 F.2d 240, 241 (2d Cir. 1944) ("To prevent all use of [an individual's family name] is to take away his identity; without it he 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"); *Horlick's Malted Milk Corp. v. Horlick*, 143 F.2d 32, 35 (7th Cir. 1944) (upholding restrictions on defendant's use of family name in connection with dog food to prevent likely confusion with plaintiff's malted milk product, but stating "in cases concerned with a person's use of his own surname, the power of the court is properly directed towards the correcting of an abuse of the right to use a personal name rather than the denial of that right").

relief.<sup>11</sup> In many cases following the modern approach, the family name issue affects the outcome of the case in two possible ways: (1) through application of the general principle that family names are usually considered to be descriptive marks, entitled to the most limited scope of trademark protection in the absence of significant secondary meaning;<sup>12</sup> and/or (2) by balancing (a) the defendant's right to use the family name in the course of business against (b) the public interest in preventing consumer confusion.<sup>13</sup> Consequently, the right of a senior user of a family name to preclude use and/or registration by a junior user family member currently appears to be measured by the same standards applied in traditional trademark cases. The junior user's right to use the family name, however, likely will be considered as being at least a factor affecting the remedy to which the senior user may be entitled.<sup>14</sup>

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11. *See, e.g.*, *Basile, S.p.A. v. Basile*, 899 F.2d 35 (D.C. Cir. 1990) (discussing the historic changes in the judicial treatment of family name cases); 2 McCarthy at § 13:8 and cases cited therein. The Trademark Trial and Appeal Board has applied a similar analysis in inter partes proceedings involving family member surnames disputes. *See, e.g.*, *Ford Motor Co. v. Ford*, 462 F.2d 1405, 1406-07 (C.C.P.A. 1972); *E.I. duPont de Nemours & Co. v. duPont Publ'g, Inc.*, 2001 TTAB LEXIS 740 (T.T.A.B. Sept. 27, 2001) (applying a traditional likelihood of confusion analysis in sustaining an opposition to the application of a duPont family member to register the marks DUPONT REGISTRY, DUPONT REGISTRY AND DESIGN, and DUPONTREGISTRY.COM, for a broad range of merchandise, and publication and advertising services, upon the opposer's showing that concurrent use of the two marks was likely to result in consumer confusion).

12. *See, e.g.*, *Brennan's, Inc. v. Brennan's Rest., L.L.C.*, 360 F.3d 125 (2d Cir. 2004) (unrelated parties) ("A family name such as Brennan's is descriptive because it does not by itself identify a product; however, if a name develops secondary meaning, it may come to identify a product as originating from a single source"); *id.* at 131 (citations omitted) (BRENNAN'S mark ultimately held to have achieved distinctiveness through its long history and numerous media reviews); *see also* *S.C. Johnson & Son, Inc. v. Johnson*, 116 F.2d 427, 430 (2d Cir. 1940) ("When all is said, if a man allows the good will of his business to become identified with a surname so common as Johnson, it is fair to impose upon him some of the risk that another Johnson may wish to sell goods not very far afield; and he must show a substantial interest if he would seriously impair the second Johnson's privilege to use his own name in customary ways."); *Simon Prop. Group L.P. v. mySimon, Inc.*, 104 F. Supp. 2d 1033, 1037 (S.D. Ind. 2000) ("common" family names are generally weaker trademarks); *Frances Denney, Inc. v. New Process Co.*, 670 F. Supp. 661, 671 (W.D. Va. 1985); *Scott Paper Co. v. Scott's Liquid Gold, Inc.*, 589 F.2d 1225, 1231 (3d Cir. 1978). *But see* *Arthur Young, Inc. v. Arthur Young & Co.*, 579 F. Supp. 384 (N.D. Ala. 1983) (ARTHUR YOUNG is an arbitrary or fanciful mark because it does not describe plaintiff's executive search services).

13. *Basile, S.p.A. v. Basile*, 899 F.2d at 39 (unrelated parties) (absolute injunction against use of family name on watches because of likelihood of confusion with plaintiff's use of mark in connection with fashion apparel, leather goods, and accessories).

14. For example, this is almost certainly the rule in Georgia and the Eleventh Circuit. Although some early cases adhered to the "absolute right" theory, *see, e.g.*, *Carter v. Carter Elec. Co.*, 119 S.E. 737 (Ga. 1923) (unrelated parties); *Richter v. Richter*, 43 S.E.2d 635 (Ga.

### III. THE NATURE AND EXTENT OF EQUITABLE RELIEF

While the modern trend is to examine family name conflicts under a traditional trademark infringement lens, courts have shown a surprising amount of unpredictability with respect to the ultimate remedy, and particularly in the nature and extent of equitable relief. The outcomes of these cases generally fall into the following categories:

- No remedy or limited injunction;
- An injunction that permits the junior family member to use the full family name as a trademark or trade name in connection with an affirmative disclaimer of affiliation with the senior family name user;
- An injunction that restrains all trademark use of the family name by the junior user, but permits descriptive use by the junior user of the full family name, whether with or without a disclaimer, to notify consumers of the junior family name user's affiliation with the business;
- An injunction restraining all use of the family name and narrowly circumscribing the manner in which the junior family name user can use the full name to describe the affiliation with the junior user's business; or
- An absolute injunction against any and all use of the senior user's family name in connection with the junior family name user's business.

#### *A. No Remedy or Limited Injunction*

Many cases in which injunctive relief was denied entirely or granted only narrowly share one predominant feature: a substantial time period of overlapping use of a common family

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1947) (defendants were plaintiff's former business partners); *Vick Med. Co. v. Vick Chem. Co.*, 11 F.2d 33 (5th Cir. 1926) (unrelated parties), more recent cases have either explicitly overruled these earlier holdings, *see, e.g.*, *Baker Realty Co. v. Baker*, 187 S.E.2d 850 (Ga. 1972) (dealing with unrelated users of same family name and holding cases such as *Carter* were superseded by enactment of UDTPA), or clearly stated that likelihood of confusion is the appropriate test. *See, e.g.*, *Howard Stores Corp. v. Howard Clothing Inc.*, 308 F. Supp. 70 (N.D. Ga. 1969) (unrelated parties) (Howard was defendant's middle name); *John R. Thompson Co. v. Holloway*, 366 F.2d 108 (5th Cir. 1966) (dealing with unrelated parties and denying injunctive relief without prejudice because current circumstances did not support finding of likelihood of confusion); *Conagra, Inc. v. Singleton*, 743 F.2d 1508 (11th Cir. 1984) (dealing with related parties and determining that record revealing likelihood of confusion justified reversal and remand to district court for consideration of appropriate injunctive relief).

name in the same trade.<sup>15</sup> For example, in both of the following cases, the plaintiff and defendant used the same family name for many years without incident, and a conflict arose only when the defendant sought to expand the business.

In *Brody's, Inc. v. Brody Brothers, Inc.*,<sup>16</sup> members of the Brody family independently operated Brody's apparel stores in geographically separate locations for a number of years. The plaintiff's store had been in existence since 1939, and was about 90 miles from the defendant's store, which was founded in 1913.<sup>17</sup> A dispute arose when the defendant proposed to open a new Brody's store about 25 miles southeast of the plaintiff's store. Concluding under Pennsylvania law that in cases involving use of one's family name during the course of business "the otherwise central issue of likelihood of consumer confusion bows to the doctrine that . . . [e]very man has the absolute right to use his own name in his business . . . provided he does not resort to [fraud],"<sup>18</sup> the Pennsylvania Superior Court affirmed the trial court's denial of the plaintiff's motion for a preliminary injunction.<sup>19</sup>

*David B. Findlay, Inc. v. Findlay*<sup>20</sup> involved two brothers who started out jointly operating an art gallery business that had been founded by their grandfather in Kansas City, Missouri, and gradually expanded to include two additional branches, one in Chicago and one on 57th Street in New York City.<sup>21</sup> After a dispute, the two brothers separated, with the defendant brother retaining control of the Chicago gallery and the plaintiff brother assuming complete ownership and control of the New York

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15. Courts have refused to intervene where there has been extended concurrent use without incident and no present likelihood of expansion exists. *See, e.g.*, *Continente v. Continente*, 378 F.2d 279, 282 (9th Cir. 1967) (plaintiff, the owner/operator of the trademark CONTINENTE for a juice grape business, who was defendant's aunt, unsuccessful in enjoining nephew's JOHN C. CONTINENTE juice grape business). In these cases, however, the court's conclusion rested upon a finding of no likelihood of confusion, rather than a balancing of the equities. *Id.*

16. 454 A.2d 605 (Pa. Super. Ct. 1982), *cf.* *Pizitz, Inc. v. Pizitz Mercantile Co.*, 467 F. Supp. 1089 (N.D. Ala. 1979) (enjoining defendant's proposed entry into plaintiff's market based on showing of bad faith).

17. *Brody's, Inc. v. Brody Bros., Inc.*, 454 A.2d at 605-06.

18. *Id.* at 607.

19. *Id.* at 608. In reaching its decision, the Superior Court may have been influenced somewhat by the lower court's finding that plaintiffs had failed to present evidence that the Brody family name had acquired secondary meaning in the proposed new market. Thus, consumer confusion was probably unlikely in any event. *Id.* at n.3.

20. 18 N.Y.2d 12, 218 N.E.2d 531 (N.Y. Ct. App. 1966).

21. *Id.* at 16.

gallery.<sup>22</sup> When the defendant brother moved into a location down the street from the plaintiff brother's Findlay Gallery and began operating his Wally Findlay Galleries, the plaintiff brother brought suit to enjoin his defendant brother's use of the family name.<sup>23</sup> After reviewing the evidence presented below regarding numerous instances of actual confusion, the New York Court of Appeals affirmed the entry of narrowly tailored injunctive relief.<sup>24</sup>

In framing its injunction the trial court went no farther than was necessary to avoid the harm threatened. It prevented the use of the name Findlay but limited this to the particular area in which its use would cause confusion and diversion – East 57th Street. It resolved the conflict with as little injury as possible to Wally. The proof showed and the trial court found that many, if not most of the leading art galleries, are now located on Madison Avenue and in the area of the 60's, 70's and 80's in New York City. Wally could probably have found an appropriate place for his New York gallery other than at 17 East 57th Street and can now either find such another location or remain where he is under some name such as "W.C.F. Galleries."

Although neither court explicitly relied on the existence of acknowledged concurrent use of the family name in the same business for a number of years, this factor is a potential point of distinction. The fact that both brothers had independently, over a number of years, contributed to the goodwill associated with the family name in a particular industry was clearly relevant to the balance of equities to be considered by the court when it fashioned appropriate relief, particularly if the concurrent use had overlapped geographically as well as temporally.<sup>25</sup>

In fact, a substantial number of modern cases involving disputed rights to a common family name highlight this one factor

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22. *Id.* at 16-17.

23. *Id.* at 17.

24. *Id.* at 20-21. *See also* *Visser v. Macres*, 29 Cal. Rptr. 367 (Ct. App. 1963) (plaintiff, successor-in-interest to floral business of Mary Macres and Elizabeth Fiscle, successful in enjoining Mary Macres's son, Albert Macres, from opening competing Macres floral business in the City of Anaheim, but son was allowed to continue operating a Macres Florist business in another city where plaintiff had no presence).

25. *See, e.g., Haviland & Co. v. Johann Haviland China Corp.*, 269 F. Supp. 928 (S.D.N.Y. 1967) (concluding that, where evidence showed plaintiff's acquiescence in defendant's concurrent use of mark incorporating family name for over 40 years, laches defense barred relief); *John P. Dant Distillery Co. v. Schenley Distillers, Inc.*, 189 F. Supp. 821 (W.D. Ky. 1960), *aff'd*, 297 F.2d 935 (6th Cir. 1962) (reaching same conclusion on similar facts).

prominently in discussing relief to be awarded to the senior family name user when the junior family name user has created a likelihood of confusion. For example, in *Rosario D. Salerno's Sons, Inc. v. Butta*,<sup>26</sup> the Illinois Court of Appeals concluded that the defendant's right to make use of her family name would turn upon the extent to which she had contributed to the goodwill of the senior family name user over the years:

If, after an evidentiary hearing, the judge determines that defendant has been known professionally under the name "Salerno" and/or that she was employed by the [plaintiff's] funeral home between 1972 and 1986, then she will have contributed considerably to the good will of the name which Salerno's Sons is attempting to prevent her from using. Additionally, she will have established that she has developed a reputation over the years in the funeral business as "Rosemary Salerno." Thus, she would have a "legitimate and compelling interest" in using the name "Salerno" in connection with her business. Consequently, to require her to use the name "Butta-Salerno" to identify her business may have the impermissible result of preventing her from exploiting her reputation and the good will she has helped to develop over the years because the public which knows her will not identify her with the name "Butta." In such a case, allowing her to use her full name "Rosemary Butta Salerno" in conjunction with a disclaimer that she is not affiliated with Salerno's Sons may be sufficient to avoid confusion and, at the same time, allow her to capitalize on her reputation.<sup>27</sup>

In other cases in which limited or no injunctive relief was awarded, the court was persuaded that the junior family name user had taken adequate steps to distinguish the name of its business, eliminating the need for any such relief. For example, in *Ramsey's Manufacturing Jewelers, Inc. v. Ramsey*, the Louisiana Court of Appeals considered whether the use of a business owner's

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26. 635 N.E.2d 1339, 1334 (Ill. App. Ct. 1994) (collecting and discussing cases).

27. *Id.* at 1346. *See also* *Conagra, Inc. v. Singleton*, 743 F.2d 1508, 1515 n.9 (11th Cir. 1984) (addressing plaintiff's founder's son's right to use family name and concluding: "An individual generally will be given some opportunity to use his own name and establish a reputation for that name, even in the face of a prior user's trademark rights in the name, so long as the person using the name distinguishes his business and use of the name from the business owning the trademark rights."); and *Taylor Wine Co., v. Bully Hill Vineyards, Inc.*, 569 F.2d 731, 735 (2d Cir. 1978), discussed *infra* ("Speaking generally, when the defendant demonstrates a genuine desire to build a business under his own name, courts have been reluctant to proscribe all surname use whatever even though the defendant's conduct has been less than exemplary").

family name, either alone or in conjunction with his first name, constituted trade name infringement.<sup>28</sup> Beginning in 1972, Robert Ramsey, Sr., manufactured and sold precious and semi-precious stones in New Orleans under the trade name Ramsey's Jewelers.<sup>29</sup> The business was incorporated in 1985 under the legal trade name Ramsey's Manufacturing Jewelers, Inc. Subsequently, Ramsey Manufacturing Jewelers, Inc. registered the trade names Ramsey's Manufacturing Jewelers, Ramsey's Jewelry, and Ramsey's Diamond Jewelers in conjunction with its jewelry business.<sup>30</sup> The business eventually fell into the hands of Robert Sr.'s two sons, Robert Jr. and Stephen.<sup>31</sup>

After a falling out with brother Robert Jr., Stephen and his wife formed a limited liability company, also in New Orleans, trade named Steve Ramsey's Diamonds Direct, LLC.<sup>32</sup> Concerned about the likelihood of confusion, Robert Jr. demanded that Stephen stop using the Ramsey family name in conjunction with the word diamonds, jewelry, or jewelers.<sup>33</sup> Shortly thereafter, Robert Jr. filed suit against Stephen and obtained a preliminary injunction against Stephen's use of the Ramsey family name.<sup>34</sup>

Subsequently, Stephen changed the trade name of his company to Brilliantov by Steve Ramsey, LLC. At the conclusion of a trial on the merits, the lower court found in favor of Stephen and dismissed all of Robert Jr.'s claims, and the court dissolved the preliminary injunction. While the court observed that there would be confusion in the marketplace if Stephen were allowed to use the Ramsey family name *alone* in connection with the word jewelers, jewelry, or diamonds, it concluded that Stephen had sufficiently distinguished his business by including Stephen's first name in his business's trade names.<sup>35</sup> Accordingly, the court held that Stephen was entitled to use both of the trade names Steve Ramsey's Diamonds Direct, LLC and Brilliantov by Steve Ramsey, LLC<sup>36</sup> in business.

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28. 924 So. 2d 1045, 1048 (La. Ct. App. 2006).

29. *Id.*

30. *Id.*

31. *Id.*

32. *Id.* at 1048.

33. *Id.*

34. *Id.*

35. *Id.* at 1057-58.

36. *Id.*; see also *Brennan's Inc. v. Brennan's Rest., L.L.C.*, 360 F.3d at 125 (owner of well-known Brennans New Orleans restaurant unsuccessful in enjoining third party's use of Terrance Brennan's Seafood and Chop House in connection with a New York restaurant);

#### IV. INJUNCTION ALLOWING TRADEMARK USE OF FULL NAME WITH DISCLAIMER

Most family name cases involve a family member who had worked for some period of time in a common family enterprise, and then terminated the relationship with the family enterprise and sought to become established in the same or a related business. For example, in the following three cases, the courts considered significant the fact that the defendant family member did not enter a business with the sole intent to exploit the family name, but instead evinced a desire to capitalize upon the goodwill and personal reputation that the family member had helped develop while working in the family enterprise.

The defendant in *Berghoff Restaurant Co. v. Lewis W. Berghoff, Inc.*<sup>37</sup> opened the Lewis Berghoff Inn (also known as the Lewis Berghoff's Mountain House Restaurant) 40 miles outside of Chicago after the defendant's employment at the family's The Berghoff restaurant in Chicago was terminated.<sup>38</sup> On appeal, the U.S. Court of Appeals for the Seventh Circuit upheld an injunction that permitted the defendant to make trademark use of his full name, with the first and last name in letters of equal size, and with a disclaimer of any affiliation with the plaintiff's restaurant.<sup>39</sup> In determining the proper scope of the injunction, both the trial court and the Court of Appeals considered relevant the fact the defendant had previously worked in the plaintiff's business:

While recognizing that plaintiff's goodwill was established through effort and labor and deserving of some consideration despite the fact that defendant's surname was identical, the court noted that the individual defendant had previously contributed to the Berghoff name, thus requiring a delicate balancing of the equities. Instead of affording complete relief to plaintiff, the court fashioned an injunction requiring defendants to use the individual defendant's given name "Lewis" with his surname in operating a restaurant business. "Lewis" was to be in the same size letters as "Berghoff." Except for one billboard and the sign above the [defendants']

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Abraham Zion Corp. v. Lebow, 593 F. Supp. 551 (S.D.N.Y. 1984) (Harry Lebow, the son of the founder of Lebow Brothers, a clothing manufacturer that was eventually acquired by plaintiff, was permitted to use Harry Lebow and H. Poe Lebow on clothes he designed for Oakloom Clothes and retain a registration for the Harry Lebow trademark), *aff'd*, 761 F.3d 93 (2d Cir. 1985).

37. 499 F.2d 1183 (7th Cir. 1974).

38. *Id.* at 1184.

39. *Id.* at 1185.

restaurant, defendants were directed to use the disclaimer “Not affiliated with the Berghoff Restaurants of Chicago” in their advertising and on the front of their menus. . . .

. . .

As to the Lanham Act, Congress granted the district court “power to grant injunctions, according to the principles of equity and upon such terms as the court may deem reasonable.” The Lanham Act did not require the court below to restrain all use of the “BERGHOFF” name. Although we do not adopt all of the reasoning of the district court, the carefully tailored result is supportable on the evidence presented and is akin to the relief fashioned in [our earlier cases].<sup>40</sup>

In *Santucci Construction Co. v. Carlo V. Santucci, Inc.*,<sup>41</sup> the defendant was owned and operated by the son-in-law of the plaintiff’s founder.<sup>42</sup> The son-in-law had been employed by the plaintiff for nearly 20 years, during which time he served as an engineer, a superintendent, and eventually as the president.<sup>43</sup> Ultimately, he left the plaintiff’s employ and began operating his own business, under the Santucci name, in competition with the plaintiff.<sup>44</sup> After concluding that the defendant’s unrestricted use of Santucci as a company name resulted in a likelihood of confusion, the district court granted a limited injunction:<sup>45</sup>

The court agrees that an injunction is appropriate under the circumstances of this case, but it finds that a complete ban on [defendant’s] use of SANTUCCI is unwarranted. When the infringer’s name is a surname, courts generally grant only limited injunctive relief. Accordingly, the court will limit the injunction by requiring [defendant] to use some form of notice or disclaimer of affiliation or relation to Santucci Construction Company. The notice or disclaimer shall be designed to eliminate the confusion experienced by persons and companies doing business with [defendant] and [plaintiff]. [Defendant] is enjoined from using its trade name Carlo V. Santucci, Inc., absent this notice or disclaimer.

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40. *Id.* at 1185-86 (internal citations omitted).

41. 200 U.S.P.Q. 783 (N.D. Ill. 1978).

42. *Id.* at 785.

43. *Id.*

44. *Id.*

45. *Id.* at 787-88 (internal citations omitted).

The defendant in *R.J. Toomey Co. v. Toomey, Jr.*,<sup>46</sup> whose father founded the plaintiff company in 1936, acted as president of the plaintiff for five years—from 1976 until 1981—then left to start his own business in competition with the plaintiff.<sup>47</sup> Interestingly, in applying the traditional likelihood of confusion analysis, the trial court concluded that the defendant’s operation of his business using the family name, when viewed in light of his knowledge of the plaintiff’s prior use, supported a conclusion that he had acted in bad faith in adopting the mark.<sup>48</sup> In spite of this finding, however, the court allowed the defendant to make trademark use of his family name in connection with a geographic identifier and the following disclaimer: “Not Connected With Or a Successor to the R.J. Toomey Co. of Worcester, Mass.”<sup>49</sup> The court premised this limited relief on the general rule that “in fashioning injunctive relief in a trademark case where, as here, a surname is the subject of the dispute, this Court is mindful that such injunctive relief is generally limited. Rather, in such cases, courts must fashion a remedy that ensures no further confusion will be generated by the mark of the party junior user in right.” This case is particularly notable because the injunction required the defendant to include additional descriptive matter, i.e., the geographic identifier, because use of his full name alone would not have been enough to dispel confusion.

In other cases, courts have considered a junior user family member’s established reputation in another field in fashioning equitable relief. For example, in *Pimentel & Sons Guitar Makers, Inc. v. Pimentel*,<sup>50</sup> the court considered whether the defendants had violated an earlier injunction on how they were allowed to use the Pimentel family name. The plaintiff was established in 1963 by Lorenzo Pimentel as a family business that is now known as Pimentel & Sons Guitar Makers, Inc., and that manufactures and sells handcrafted instruments. In 1988, the plaintiff brought suit against Hector Pimentel, a son of Lorenzo and a professional guitarist and guitar instructor, individually, and against Hector Pimentel Guitar Center for trademark infringement based upon the defendants’ use of the Pimentel family name. The court entered an injunction order in 1989 (“1989 Injunction”), which held, in relevant part:

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46. 683 F. Supp. 873 (D. Mass. 1988).

47. *Id.* at 875.

48. *Id.* at 878.

49. *Id.* at 880.

50. No. Civ-04-0360JBRLP, 2006 WL 3664269 (D.N.M. Oct. 12, 2005).

1. The defendants may conduct business under a name . . . that contains the word “Pimentel”; they are, however, permanently enjoined from including in any such name, d/b/a, trademark or trade name the word “guitar” . . . or any other word or words suggestive of the making or selling of guitars.

2. The defendants are further enjoined in the event they or any of them elect to use the word “Pimentel” in the manner set forth above, to print a disclaimer of association with the plaintiff on every form, letterhead, advertisement, and any other written or printed document bearing the business name . . . of the defendants.

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5. In the event that the defendants elect to use the word “Pimentel” in the name of a business, as permitted by paragraph 1 of this Order and Judgment, there shall be placed a sign in every place of business at which any of the defendants is doing business stating: “We are not affiliated in any way with Pimentel and Sons, Guitar Makers.” The sign shall be conspicuously placed so that customers will be advised of the absence of any business association between the parties.<sup>51</sup>

Since 1994, Hector Pimentel, and his former wife Danette Pimentel, have used the following trademarks to promote and sell the goods and entertainment services of various business ventures: (i) PIMENTEL MUSIC; (ii) HECTOR PIMENTEL MUSIC; (iii) PIMENTEL MUSIC ENTERPRISES; and (iv) HECTOR PIMENTEL MUSIC ENTERPRISES.<sup>52</sup> However, several of these trademark uses were unaccompanied by a disclaimer, including uses on a website and a billboard and in telephone directory advertising. As a result, the plaintiff brought suit against Hector and Danette and moved for a preliminary injunction alleging that the defendants had repeatedly violated the 1989 Injunction.<sup>53</sup> The defendants argued in turn that “the 1989 Injunction [did] not require a disclaimer any time Hector Pimentel conducts business under a name or trade name that contains the word ‘Pimentel,’ but rather the Injunction is more limited in scope and only requires Hector Pimentel to print a disclaimer when using the word

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51. *Id.* at \*2.

52. *Id.* at \*3.

53. *Id.*

'Pimentel' in conjunction with three activities: (i) guitar making; (ii) guitar selling; and (iii) guitar repair."<sup>54</sup>

However, the court came to a different conclusion and held that the 1989 Injunction required that the defendants include a disclaimer *every* time they used the Pimentel family name.<sup>55</sup> On the other hand, the court observed that the defendants were not prohibited by the 1989 Injunction from using the word guitar in close proximity to Hector Pimentel so long as the word guitar was not part of a trade name or trademark that included Pimentel.<sup>56</sup>

#### V. INJUNCTION RESTRAINING TRADEMARK USE OF FAMILY NAME BUT ALLOWING DESCRIPTIVE USE OF FULL NAME (WITH AND WITHOUT DISCLAIMER)

Many of the following cases, like those discussed in the foregoing section, addressed a situation in which the defendant had a previous relationship, such as an employment relationship, with the plaintiff. However, in the cases discussed below, the balance of equities tipped in favor of an injunction (or enforcement of an injunction) that restricted the defendants from making trademark use of the family name, while allowing secondary

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54. *Id.* at \*7.

55. *Id.* at \*9.

56. *Id.* at \*13. *See also* *Donnell v. Herring-Hall-Marvin Safe Co.*, 208 U.S. 267 (1908) (sons of the founder of the predecessor to plaintiff safe manufacturing company were entitled to use Hall family name in connection with a new safe manufacturing business but were enjoined from indicating that their new business was the successor to the founder's company or that their goods were the product of that company or its successors); *Petrie Method, Inc. v. Petrie*, 1988 U.S. Dist. LEXIS 14189 (E.D.N.Y. Dec. 6, 1988) (son of plaintiff's founder allowed to use his full name David Petrie in connection with a competitive seminar business in which he had an established reputation provided that he include a disclaimer of any relationship to plaintiff in advertising that used the David Petrie name); *Int'l Election Sys. Corp. v. Shoup*, 452 F. Supp. 684 (E.D. Pa. 1978) (allowing defendants to use RANSOM F. SHOUP & CO. as a trademark in combination with a disclaimer in view of defendants' use of that name for more than 20 years; however, defendants enjoined from representing that they are the successors to plaintiff's business), *aff'd without opinion*, 595 F.2d 1212 (3d Cir. 1979); *H.A. Friend & Co. v. Friend & Co.*, 276 F. Supp. 707 (C.D. Cal. 1967), *aff'd*, 416 F.2d 526 (9th Cir. 1969) (son of plaintiff's founder permitted to use Friend family name as a trade name or trademark, but must be directly preceded by Wilbur and include a disclaimer of affiliation with plaintiff); *Nat'l Distillers Prods. Corp. v. K. Taylor Distilling Co.*, 31 F. Supp. 611 (E.D. Ky. 1940) (allowing defendant, whose president Kenner Taylor had earlier sold a whiskey manufacturing business to the plaintiff including the right to use the family name Taylor, to commence a new business marketing TAYLOR whiskey so long as defendant included a statement that defendant was not the successor to or connected with the maker of OLD TAYLOR whiskey and that its product was not the product of E. H. Taylor, Jr. & Sons or its successors).

descriptive use of the full family name, usually accompanied by a disclaimer.

*Berlitz School of Languages, Inc. v. Everest House*<sup>57</sup> describes one such injunction that was entered against Charles Berlitz, grandson of the founder of the famous Berlitz School of Languages.<sup>58</sup> After a previous trial on the merits in an action involving two consolidated infringement actions, a court had enjoined Charles Berlitz from using his name “as part of the name of a foreign language teaching text or as part of the name of a publishing company which prepares foreign language materials.”<sup>59</sup> The injunction permitted Charles to use his full name to “identify himself as the editor or author of the books . . . so long as he makes it clear that he is not connected with plaintiffs in any way.”<sup>60</sup>

*Joseph Scott Co. v. Scott Swimming Pools, Inc.*<sup>61</sup> resulted in a similar injunction. In this case, Joseph Scott, Jr. and his brother worked in the family business Scott Swimming Pools, Inc. that had been established by their father, Joseph Scott, Sr.<sup>62</sup> Joseph Jr. left the family business for about ten years, but he eventually returned in 1965 and continued his previous work as a salesman and company service representative for the family business. In 1969, Joseph Jr.’s brother purchased the business from their father and acceded to the role of president of the company.<sup>63</sup> The two brothers frequently quarreled, and in 1972 Joseph Jr. left the company again and embarked on a new venture under the trade name Scott AquaScapes.<sup>64</sup> The two businesses operated in harmony and to their mutual benefit until 1983, when Joseph Jr. terminated an agency relationship that had existed between Scott AquaScapes and Scott Swimming Pools, and then changed his company’s trade name from Scott AquaScapes to Joseph Scott Pools, Inc.<sup>65</sup> After Scott Swimming Pools, Inc. formally protested Joseph Jr.’s actions, Joseph Scott Pools, Inc. filed a declaratory judgment action against

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57. 619 F.2d 211 (2d Cir. 1980).

58. *Id.* at 213. Rather than addressing the correctness of the prior holding, the case presented the issue of whether it was res judicata as to the action at bar.

59. *Id.*

60. *Id.*

61. 764 F.2d 62 (2d Cir. 1985).

62. *Id.* at 63.

63. *Id.*

64. *Id.*

65. *Id.* at 64.

Scott Swimming Pools, Inc., and Scott Swimming Pools, Inc. counterclaimed and moved for a preliminary injunction.<sup>66</sup>

After a hearing, the trial court entered a preliminary injunction that restrained Joseph Jr. from using the family name as a trademark or company trade name on or in connection with his business, and that strictly limited the ways in which Joseph Jr. could proclaim his affiliation with his firm.<sup>67</sup> Joseph Jr. appealed, and the U.S. Court of Appeals for the Second Circuit affirmed that portion of the injunction which enjoined Joseph Jr. from using the Scott family name as part of his company's trade name, but relaxed the limitations on how Joseph Jr. could use his own name to describe his affiliation with his business:<sup>68</sup>

Under these circumstances, we believe Joseph Jr. should be permitted to use his name to describe his past accomplishments and expertise in connection with the design, construction and sale of swimming pools. Of course, he must make perfectly clear that his firm is no longer associated with, and is not a successor to, SSPI. We do not believe, however, that narrow restrictions regarding type size or design are necessary to avoid confusion among potential pool purchasers. A modification of this kind will minimize the hardship on Joseph Jr., while at the same time maintaining the requisite safeguards to protect SSPI's position in the marketplace.

Another leading case, *E. & J. Gallo Winery v. Gallo Cattle Co.*,<sup>69</sup> also arose out of a brotherly dispute over entitlements to make commercial use of the family name. The two eldest brothers, Ernest and Julio Gallo, made the Gallo family name famous in the wine industry.<sup>70</sup> Their much-younger brother Joseph had worked on and off over the years in his brothers' wine-making business, but he had declined an offer of partnership in the business.<sup>71</sup> Eventually, Joseph established the Gallo Cattle Company, which sold cheese in large blocks to commercial distributors, which repackaged it for consumer consumption. Joseph operated this concern, without interference from Ernest and Julio, until 1984.<sup>72</sup> In 1984, the Gallo Cattle Company began to sell consumer-sized

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66. *Id.*

67. *Id.* at 65.

68. *Id.* at 67-69.

69. 967 F.2d 1280 (9th Cir. 1990).

70. *Id.* at 1284-85.

71. *Id.* at 1285.

72. *Id.*

packages of cheese identified by a trademark that incorporated Joseph's full name.<sup>73</sup> Upon learning of Joseph's latest enterprise, the winery made famous by his two older brothers promptly filed suit against the Gallo Cattle Company for trademark infringement.<sup>74</sup>

After the trial court entered a permanent injunction restricting Joseph's use of the family name, Joseph appealed.<sup>75</sup> The U.S. Court of Appeals for the Ninth Circuit upheld the trial court's finding of a likelihood of confusion and of trademark infringement, and affirmed the injunction in most respects.<sup>76</sup> The injunction restricted Joseph Gallo's use of the family name as follows:<sup>77</sup>

Paragraphs 7-10 of the injunction, titled "Actions and Practices Enjoined," prevent Joseph from using the words GALLO or JOSEPH GALLO as a trademark for retail cheese. They further prohibit advertisement or registration of such a trademark. Paragraph 9 specifically prohibits the use of the word GALLO for any purpose in audible advertising. Paragraphs 11-15, titled "Actions and Practices Not Enjoined," expressly allow the use of GALLO and JOSEPH GALLO on non-retail cheese. They also allow the use of "Joseph Gallo Farms" and "Gallo Cattle Company" as trade names, and the use of Joseph Gallo's name or signature on retail cheese labels and in written advertisements if limited in size and accompanied by a trademark not containing the word GALLO.<sup>78</sup>

Another interesting permutation of family name law involves the family member who conveys a business bearing the family name and then later desires to reenter the same field. In *Ed Kalis Memorial Services, LLC v. McIntee Holdings, LLC*,<sup>79</sup> Ed Kalis, Sr., who had operated Kalis Funeral Home, sold his funeral home business in 1994 to the plaintiff and entered into a ten-year non-compete agreement as a part of the sale. Kalis Sr. and his son both continued to work at plaintiff's funeral home after the sale. Upon the expiration of the ten-year non-compete agreement in 2004,

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73. *Id.*

74. *Id.* at 1286-87.

75. *Id.* at 1286.

76. *Id.* at 1298.

77. *Id.* at 1296-97.

78. However, the injunction permitted trademark use of the Gallo family name on non-retail cheese, in part because the plaintiffs had never previously protested that use.

79. 932 So. 2d 491 (Fla. Dist. Ct. App. 2006).

Kalis Sr. left the plaintiff's employment and opened a funeral, burial, and cremation business identified by the trade name Ed Kalis Memorial Services, which he located less than 100 yards from the plaintiff's Kalis Funeral Home.<sup>80</sup> Shortly thereafter, the plaintiff sued Ed Kalis and Ed Kalis Memorial Services and obtained a temporary injunction against the use of the Ed Kalis Memorial Services trade name. Kalis Sr. then changed his trade name to Edwards Cremation & Funeral Services. Despite the trade name change, issues continued to arise, which led the plaintiff to request clarification of the original injunction. The trial court agreed to do so, but thereafter placed significant restrictions on how Kalis Sr. could use his name and photograph in advertisements for Edwards Cremation & Funeral Services:<sup>81</sup>

The Defendant, ED KALIS, may use his name and photograph when identifying himself as the Licensed Funeral Director on the website for Edwards Cremation & Funeral Services. The Uniform Resource Locator (URL) for the website may not contain the name "Kalis" in the URL.

The Defendant, ED KALIS, may not place his name identifying himself as Licensed Funeral Director on any other signage for Edwards Cremation & Funeral Services in Broward County, Florida.

The Defendant, ED KALIS, may not use his name identifying himself as the Licensed Funeral Director for Edwards Cremation & Funeral Services on any advertising, including, but not limited to, the Bellsouth Yellow Pages, or any other advertising and/or promotional materials to be circulated in Broward County, Florida, except as provided above.<sup>82</sup>

Upon appeal, the Florida Court of Appeals found that the trial court's restrictions on the plaintiff's right to use his name were overly restrictive. While the court agreed that Kalis Sr.'s name should not be the predominant feature of advertisements, it held that Kalis Sr. was entitled to identify himself as the director of Edwards Cremation & Funeral Services, whether on signage, in advertising, or on the Internet, and that such usage was unlikely to cause confusion in the minds of the public or work a fraud by

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80. *Id.* at 492.

81. *Id.*

82. *Id.*

diverting to Edwards Cremation & Funeral Services business that was intended for the plaintiff.<sup>83</sup>

An injunction prohibiting trademark use of a family name, but allowing secondary or descriptive use of the defendant's full name, may be particularly appealing in cases dealing with industries where business reputations are commonly built around full names. For example, in *Gucci v. Gucci Shops, Inc.*,<sup>84</sup> a case that involved Paolo Gucci, the grandson of the famous designer, who had built a reputation for himself while employed in the family business, the court was particularly concerned with preserving the grandson's right to identify his designs. In this context, the court also expressed approval for the view that primary use of a house label in connection with non-trademark, descriptive use of the defendant's full name with a disclaimer would be sufficient to alleviate the likelihood of consumer confusion.<sup>85</sup>

#### VI. INJUNCTION RESTRAINING TRADEMARK USE OF FAMILY NAME AND NARROWLY CIRCUMSCRIBING USE OF FULL NAME

Courts appear to be more willing to circumscribe closely the junior family name use in cases where the junior family name user has no prior reputation associated with his or her family name in the particular industry. *Taylor Wine Co. v. Bully Hill Vineyards, Inc.*<sup>86</sup> involved such a situation. The defendant in this case was a concern established by Walter S. Taylor, the grandson of the plaintiff's founder.<sup>87</sup> In contrast to some of the junior family name users discussed above, Walter had no prior experience in the family business.<sup>88</sup> Rather, he repurchased the family vineyards

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83. *Id.*; cf. *Levitt Corp. v. Levitt*, 201 U.S.P.Q. 164 (E.D.N.Y. 1978) (imposing enhanced restrictions on defendant's use of "William J. Levitt" in connection with defendant's business in part because of his failure to comply fully with earlier voluntary restrictions following his sale of the Levitt & Sons business to plaintiff), *aff'd*, 593 F.2d 463 (2d Cir. 1979); *Lazzaroni USA Corp. v. Steiner Foods*, No. Civ. 05-4476 (JAG), 2006 WL 932345 (D.N.J. Apr. 11, 2006); *Barr v. Sasser*, 24 U.S.P.Q.2d 1942 (N.D. Okla. 1992); the latter two cases are discussed *infra*.

84. 688 F. Supp. 916 (S.D.N.Y. 1988).

85. *Id.* at 927. The grandson was enjoined from using his family name alone as a trade name or trademark but was allowed to use Paolo Gucci to identify himself as the designer of products marketed under a different mark with a disclaimer that he was no longer affiliated with any of the GUCCI entities.

86. 569 F.2d 731 (2d Cir. 1978).

87. *Id.* at 733.

88. *Id.*

from an unrelated third party and entered into competition with the plaintiff, to which all rights in the family concern had previously been assigned.<sup>89</sup> The plaintiff brought suit, and the trial court granted a preliminary injunction that prevented Walter from making any use of his family name in connection with the business of the defendant.<sup>90</sup>

On appeal, the U.S. Court of Appeals for the Second Circuit concluded that the injunction should be modified to permit Walter to use his full signature on wine labels and in winery advertisements, so long as it was accompanied by an appropriate disclaimer.<sup>91</sup> After remand, the case once again came before the Second Circuit for a review of the modified preliminary injunction.<sup>92</sup> As modified by both the trial court and the Second Circuit, the injunction prohibited Walter S. Taylor from making any use of the Taylor family name as a trademark and placed a number of restrictions of how Walter's full signature could be used on wine labels to identify his connection with the winery.<sup>93</sup>

Tighter restrictions on the junior family name user's right to make descriptive use of the family name may also be appropriate where some evidence indicates the junior family name user adopted a family name mark in order to exploit the family name. In *Dulong Frères & Fils v. Dulong*,<sup>94</sup> the defendant had acted on the plaintiff's behalf for several years by importing and distributing the plaintiff's wine.<sup>95</sup> The parties terminated their business arrangement after a disagreement arose in 1974.<sup>96</sup> After the defendant began importing and distributing other wines under the trade name Dulong Wine Distributors, Inc.,<sup>97</sup> the plaintiff sued. In reaching its conclusion that preliminary injunctive relief was appropriate, the trial court held that, having once acted as an agent and fiduciary of the plaintiff, the defendant was under a greater obligation to distinguish his company and its goods from those of the plaintiff:<sup>98</sup>

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89. *Id.*

90. *Id.*

91. *Id.* at 736.

92. *Taylor Wine Co. v. Bully Hill Vineyards, Inc.*, 590 F.2d 701 (2d Cir. 1978).

93. *Id.* at 703-04.

94. 192 U.S.P.Q. 664 (S.D.N.Y. 1976).

95. *Id.* at 665.

96. *Id.* at 665-66.

97. *Id.* at 666.

98. *Id.*

Here defendant was acting as an agent of the plaintiff company. One cannot but conclude that he came to the United States in 1963 and studied the wine importing business for the benefit of the family winery Dulong Frères & Fils. It was only after the disagreement arose that defendant began operating on his own. It is appropriate to recall Justice Cardozo's words in *Meinhard v. Salmon*, 249 N.Y. 458, 464 (1928):

“Many forms of conduct permissible in a workaday world for those acting at arm's length, are forbidden to those bound by fiduciary ties. A trustee is held to something stricter than the morals of the market place. Not honesty alone, but the punctilio of an honor the most sensitive, is then the standard of behavior.”

How much more is this the case where the agent is a trusted family member acting on behalf of a family enterprise.

Relying in part on this conclusion, the trial court restrained the defendant from making any use of his family name as part of the trade name of his business, or on bottles of wine, except as French law required.<sup>99</sup>

These cases indicate that the junior user's intent in adopting the family name may influence significantly the scope of the injunctive relief granted. In situations where the junior family name user has a *bona fide* interest in using the family name, either in connection with the expansion of an existing use of the family name or as part of an effort to build upon an already established business reputation associated with the family name, courts have given more weight to the junior family name user's right to make commercial use of his or her family name when balancing the equities. In contrast, where the evidence suggests the junior family name user may be more interested in exploiting commercial goodwill that the junior family name user took no part in establishing, courts have been less solicitous and have granted broader injunctive relief.

## VII. ABSOLUTE INJUNCTION AGAINST ALL COMMERCIAL USE OF THE FAMILY NAME

In almost all of the cases discussed above in which an injunction was entered, the court's primary concern in balancing the equities was to alleviate a likelihood of confusion, while

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99. *Id.* at 667.

simultaneously preserving the junior family member user's right to make a commercial use of the family name. The remedies afforded in those cases therefore reflect the courts' beliefs that such measures would be sufficient to eliminate most, if not all, likelihood of confusion presented by the junior family name use of a common family name. However, to the extent that a senior family member user can show that a likelihood of confusion is *inevitable* unless the junior family member user's commercial use is completely enjoined, the senior family name user may be entitled to a total injunction against the junior use.

In *Alexis Lichine & Cie. v. Sacha A. Lichine Estate Selections, Ltd.*,<sup>100</sup> the defendant was the son of the founder of the plaintiff's successor in interest. When the defendant sought to establish his own competing business under the trade name Sacha A. Lichine Estate Selections in the early 1980s, the plaintiff sued, claiming trademark infringement.<sup>101</sup> After the trial court entered partial summary judgment in the plaintiff's favor, the parties entered into a consent decree "enjoining [defendant] from using the words 'Alexis Lichine' or any colorable imitation, including 'Sacha A. Lichine,' 'S.A. Lichine,' or 'Lichine,' in connection with the sale of any alcoholic beverage."<sup>102</sup> In 1991, the defendant sought relief from the burdens of the injunction, and in 1992, the defendant was allowed to seek modification of the injunction under Federal Rule of Civil Procedure 60(b)(5).<sup>103</sup>

The defendant urged three bases for the requested relief: (1) the death of his father, and his inheritance of his father's shares in the family vineyard;<sup>104</sup> (2) the decline in the quality of plaintiff's wine; and (3) the rise of the defendant's own reputation in the wine industry.<sup>105</sup> After a four-day hearing, a U.S. magistrate judge recommended denial of the plaintiff's request; the trial court agreed, and declined to order modification.<sup>106</sup> The defendant appealed, and the U.S. Court of Appeals for the First Circuit affirmed.<sup>107</sup> In addressing the defendant's contention that the trial court should have balanced the defendant's interest in using his

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100. 45 F.3d 582 (1st Cir. 1995).

101. *Id.* at 583-84.

102. *Id.* at 584 (internal quotation marks omitted).

103. *Id.*

104. The vineyard was not owned by, or affiliated with, the plaintiff. *Id.* at 583.

105. *Id.* at 584.

106. *Id.* at 584-85.

107. *Id.* at 587.

family name against the plaintiff's interest in its trademark, the Court of Appeals found no abuse of discretion in light of the consent decree that explicitly acknowledged that the defendant's use of the Lichine family name would likely cause confusion:<sup>108</sup>

We conclude by noting briefly appellant's contention that the district court did not balance ALC's trademark interest against his interest in using his own name. The principal cases cited give him little comfort. *E & J Gallo Winery v. Gallo Cattle Co.*, 967 F.2d 1280, 1288-89 (9th Cir. 1992), allowed a family member to continue using his name in a limited fashion on a different product – cheese, not wine. *Taylor Wine Co. v. Bully Hill Vineyards, Inc.*, 590 F.2d 701, 703-04 (2d Cir. 1978), wound up approving a very restrictive injunction, which also embodied a disclaimer. The same court, more recently, has evidenced deep skepticism of the utility of disclaimers and, in any event, would require empirical evidence demonstrating their effectiveness in avoiding confusion. *Home Box Office v. Showtime/The Movie Channel*, 832 F.2d 1311, 1315-17 (2d Cir. 1987).

In the case at bar, there was no argument or evidence concerning the subject of disclaimers. The only “balancing” suggested was a request that appellant be allowed to use his own full name in a different label format. In light of the not-so-old decree, which found that the use of the Lichine name would be likely to cause confusion, we see no abusive lack of balancing on the part of the court.

In sum, at this time, on this record, we cannot say that the district court abused its discretion.

A recurring pattern in which courts have also favored absolute injunctions is where a family member sold trademark rights in the family name to another party in connection with a particular business venture, without reserving any right of commercial use of the family name, and then later attempted to reenter the field using the same family name. In *Lazzaroni USA Corp. v. Steiner*

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108. *Id.*; *Bertolli USA, Inc. v. Filippo Bertolli Fine Foods Ltd.*, 662 F. Supp. 203, 204-06 (S.D.N.Y. 1987) (addressing right of great-grandson to use the Bertolli family name commercially and enjoining use of that name as part of defendants' corporate name in part because great-grandson had no prior reputation associated with his family name in the industry and had undertaken advertising suggesting a connection between the great-grandson's business and plaintiff's business); *Cunetto House of Pasta v. Tuma*, 689 S.W.2d 690, 692 (Mo. Ct. App. 1985) (addressing nephew's use of family name in the same industry and concluding: “The use here has caused confusion with the public as to whether ‘J. Cunetto's’ is related to ‘Cunetto's.’ Such use, even of surnames, can be enjoined, and there was no error in the trial court doing so.”).

*Foods*,<sup>109</sup> the Lazzaroni family had operated a macaroon cookie business identified by the trademarks LAZZARONI and AMARETTI DI SARONNO.<sup>110</sup> The family sold the macaroon business, D. Lazzaroni, to Campbell's in the early 1980s, but the family retained ownership of a liqueur business run by the defendant, Paolo Lazzaroni & Figli S.p.A.<sup>111</sup> However, in 2004 the family began to manufacture and sell macaroons under the LAZZARONI trademark throughout Italy.<sup>112</sup> An Italian court enjoined the family's use of the family name on its cookie packaging. Shortly thereafter the family began to export its macaroons to the United States in conjunction with Steiner Foods.<sup>113</sup>

In late 2005, plaintiff Lazzaroni USA Corp., the successor in interest to Campbell's rights, filed a complaint against Steiner Foods and the Lazzaroni family that alleged trademark infringement and that asked for a preliminary injunction against both the Lazzaroni family and Steiner Foods.<sup>114</sup> Although the defendants raised numerous affirmative defenses, the trial court observed that the family did not dispute that it had sold the goodwill, reputation, and trademark rights in the macaroon business, and that it was bound by the terms of the sale.<sup>115</sup> For these reasons, the trial court ultimately granted the plaintiff's motion for a preliminary injunction, noting:

[A]ll factors favor granting injunctive relief. This conclusion is supported by weighing the equities in this case. Analysis of the equities directs attention to an important aspect of the case: the infringer sold the business to Plaintiff's licensor. In this case, this tilts the balance heavily in favor of granting the injunction.<sup>116</sup>

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109. No. Civ. 05-4476 (JAG), 2006 WL 932345 (D.N.J. Apr. 11, 2006).

110. *Id.* at \*1.

111. *Id.*

112. *Id.*

113. *Id.*

114. *Id.*

115. *Id.* at \*9.

116. *Id.* See also *Osgood Heating & Air Conditioning, Inc. v. Osgood*, 75 U.S.P.Q.2d 1432 (W.D. Tex. 2004) (after Osgood sold his air conditioning business to plaintiff, Osgood began using 4-OSGOOD in connection with a competing business in telephone listings and URL; preliminary injunction granted); *Barr v. Sasser*, 24 U.S.P.Q.2d 1942 (N.D. Okla. 1992) (prohibiting use of Sasser name as trade name where defendant had previously assigned to plaintiff the right to use the name in connection with family drapery business; however, defendant allowed to use The Original Drapery Family); *MacSweeney Enters., Inc. v. Tarantino*, 45 Cal. Rptr. 546 (Cal. Dist. Ct. App. 1965) (plaintiff, successor-in-interest to

Finally, and most recently, the trial court in *Gucci America, Inc. v. Gucci* was again asked to address the right of family members to use the Gucci family name in connection with a wide range of products.<sup>117</sup> As previously discussed, Paolo Gucci, the grandson of the plaintiff's founder, had been enjoined in *Gucci v. Gucci Shops, Inc.* to make only non-trademark, descriptive use of his family name, together with a disclaimer in connection with the design of clothing, a field in which he had a substantial reputation.<sup>118</sup> In this case, Paolo Gucci's widow, Jennifer Gucci, and his daughter, Gemma Gucci, with substantial assistance from a licensing agent, purported to enter into licensing agreements for the use of the trademarks JENNIFER GUCCI and GEMMA GUCCI on or in connection with a wide range of products, including coffee, bedding, housewares, cosmetics, hosiery, handbags, wine, and gelato. After they were sued by the plaintiff for trademark infringement and trademark dilution, Jennifer Gucci and Gemma Gucci attempted to defend their use of the accused name trademarks by arguing that their uses were consistent with the limitations placed on Paolo Gucci in *Gucci Shops*.<sup>119</sup>

The trial court disagreed, and the court enjoined the defendants from using or attempting to register the JENNIFER GUCCI and GEMMA GUCCI trademarks on or in connection with any of the products identified above. In so holding, the court was influenced by at least the following factors: (1) neither Jennifer Gucci nor Gemma Gucci had any "reputation, skill or knowledge as a designer of any of the products at issue";<sup>120</sup> (2) even assuming *arguendo* that *Gucci Shops* applied to their activities, neither

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Tarantino's restaurant originally owned by two Tarantino family members, successful in enjoining other Tarantino family members from using Tarantino's family name in connection with cocktail sauce). Absolute injunctions have also been held appropriate in cases in which the junior user repeatedly fails to comply with previous judicial limitations on use of a family name. See *A. V. by Versace, Inc. v. Gianni Versace, S.p.A.*, No. 96 Civ. 9721 PKL/THK, 2002 WL 2012618 (S.D.N.Y. Sept. 3, 2002) (unrelated parties), in which the court modified an earlier injunction permitting limited use of DESIGNED BY ALFREDO VERSACE to one precluding any use of Versace as a result of defendant's civil contempt.

117. No. 1:07cv6820 (RMB) (JCF) (S.D.N.Y. Aug. 5, 2009).

118. See *supra* notes 85, 86.

119. Gemma Gucci also attempted to rely on a consent judgment entered into in a German proceeding in which the parties thereto purportedly agreed that Gemma Gucci could sell jewelry under her full name as long as the products or packaging contained the words "designed" or "styled" by or before the name Gemma Gucci. The plaintiff argued that the consent judgment was applicable, if at all, solely to use in Germany and noted that none of the parties to the consent judgment were parties to this case.

120. *Gucci Am., Inc.*, slip op. at 49.

Jennifer Gucci nor Gemma Gucci had complied with the restrictions imposed in that case; (3) the vast majority of products licensed by Jennifer Gucci and Gemma Gucci did not include a disclaimer of affiliation with the plaintiff; (4) the one product of Gemma Gucci that arguably did include a disclaimer included a discussion of the “Gucci family tradition” in a manner that the court concluded would tend to promote confusion; (5) Jennifer Gucci and Gemma Gucci had both unsuccessfully attempted on several occasions to obtain federal trademark registrations for JENNIFER GUCCI and GEMMA GUCCI, which were rejected by the United States Trademark Office because of confusing similarity to the plaintiff’s GUCCI trademark; and (6) the defendants failed to obtain a written legal opinion as to the scope of Jennifer Gucci’s and Gemma Gucci’s licensing rights.

In an interesting twist, however, the court authorized Jennifer Gucci and Gemma Gucci to use their full names in connection with future new products or services not involved in the lawsuit, subject to the following conditions:

(1) they shall have received prior written approval for any such proposed use from the USPTO; and

(2) they shall serve a copy of any USPTO application upon plaintiff or plaintiff’s successor contemporaneously with the filing of any registration application; and

(3) they shall have obtained a written opinion from recognized trademark counsel that any such use is lawful; and

(4) any such use shall relate to products or services actually designed by (or selected by) Jennifer Gucci and/or Gemma Gucci; and

(5) Jennifer Gucci and/or Gemma Gucci shall have acquired demonstrable reputation(s), skill and knowledge with respect to such products or services; and

(6) all uses of “Jennifer Gucci” and/or “Gemma Gucci” in connection with such products or services in advertisements or hang tags or promotional materials must be accompanied by a disclaimer, prominently displayed and unambiguously stating that Jennifer and/or Gemma Gucci, respectfully, is not affiliated or associated in any way with plaintiff or Gucci products; and

(7) Jennifer Gucci and Gemma Gucci shall adhere to . . . paragraphs 9 through 12 of [the] Final Judgment in *Gucci Shops*. . . .<sup>121</sup>

### VIII. CONCLUSION

As again most recently demonstrated in *Gucci America, Inc.*, family name cases have proven to be a challenge for courts, for they frequently involve competing interests of family members, some of which are more compelling than others. While predicting the ultimate outcome of these family name cases is difficult, it appears from the foregoing cases that one or more of the following factors seem to have a greater impact than others in that determination:

- whether the junior family member use is actually a continuation or expansion of a pre-existing concurrent use to which the senior family member user has given express or implied consent;
- whether the junior family name user has prior experience in the family business or has otherwise contributed to the goodwill associated with the family name;
- whether the junior family name user has made any effort to distinguish the junior user's family name trademark from the well-known family name trademark of the senior user;
- whether the senior family name user previously transferred rights in the family name to another party and then later attempted to reenter the same field under the same family name in some capacity;<sup>122</sup>

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121. *Id.*, slip. op. at 51-52. Although it will be difficult for Jennifer Gucci and Gemma Gucci to satisfy these requirements, if successful they arguably would have greater rights to use their full names than Paolo Gucci in *Gucci Shops*, as the court explicitly authorized use of their full names as trademarks, whereas Paolo Gucci was limited to use of his full name only in a descriptive, non-trademark context.

122. As explained above, this factor alone has not been dispositive in the analysis and decisions have varied widely, ranging from permitting use of the family name with a disclaimer to an absolute injunction. *Compare, e.g., supra* notes 57, 84, 117. The significance of this factor is again being debated currently, as in *JA Apparel Corp. v. Abboud*, 568 F.3d 390 (2d Cir. 2009). In that case, the plaintiff sought to enjoin Joseph Abboud's use of his name in advertising a new high-end line of clothing on the grounds that such use would (1) violate a sale agreement pursuant to which plaintiff allegedly acquired, *inter alia*, all rights in and to the Joseph Abboud name and mark; and (2) constitute trademark infringement and unfair competition. The district court ruled in favor of the plaintiff and permanently enjoined Mr. Abboud "from using his personal name to sell, market, or otherwise promote, goods, products, and services to the consuming public." *Id.* at 396. The Second Circuit, however, vacated the preliminary injunction and remanded the case for further proceedings

- whether the businesses of the senior and junior family name users are geographically close or are geographically remote; and
- whether the entire set of circumstances indicates that the junior family name use is based on an honest and straightforward desire by the junior family name user to build on a personal reputation earned by demonstrated skill, experience, or years of participation in an industry, or that the junior family name use is based on a bad faith intent to free ride on the reputation of a better-known party.

Whatever the weight given to these or other factors, courts clearly have made a concerted effort in family name trade name and trademark disputes to consider carefully all of the surrounding circumstances and to arrive at a resolution that takes into account the interests of all of the involved family members while protecting the consuming public from the likelihood of confusion.

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to consider extrinsic evidence on the meaning of certain provisions of the sale agreement and Mr. Abboud's fair use defense.