



# INTELLECTUAL PROPERTY AND INNOVATION AMERICAN INN OF COURT

Thursday, October 28, 2021

## Inn Luncheon Roundtable

### **CLE Materials**

#### **Topic**

What's In a Name?: A Brief History of Trademarking Surnames and a Recent Local Case Study

#### **Facilitated By**

Sarah Jaeger, Director | GE Licensing

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15 U.S.C. § 1125

New York General Business Law § 349

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*Compass Group USA, Inc. v. Mazzone et al.*

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TESS Record for “MAZZONE HOSPITALITY”

“Mazzone Hospitality Sues Son of Angelo Mazzone in Federal Court”

“Family Feud: The Tension Between Family Names and Trademarks”

“The Limited Right to Use Your Own Name”

## 15 U.S. Code § 1125 - False designations of origin, false descriptions, and dilution forbidden

U.S. Code    Notes

### **(a) CIVIL ACTION**

**(1)** Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—

**(A)** is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or

**(B)** in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities,

shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

**(2)** As used in this subsection, the term "any person" includes any State, instrumentality of a State or employee of a State or instrumentality of a State acting in his or her official capacity. Any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this chapter in the same manner and to the same extent as any nongovernmental entity.

**(3)** In a civil action for trade dress infringement under this chapter for trade dress not registered on the principal register, the person who asserts trade dress protection has the burden of proving that the matter sought to be protected is not functional.

# New York Consolidated Laws, General Business Law - GBS § 349. Deceptive acts and practices unlawful

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« Prev (a) Deceptive acts or practices in the conduct of any business, trade or commerce or in the furnishing of any service in this state are hereby declared unlawful. Next »

(b) Whenever the attorney general shall believe from evidence satisfactory to him that any person, firm, corporation or association or agent or employee thereof has engaged in or is about to engage in any of the acts or practices stated to be unlawful he may bring an action in the name and on behalf of the people of the state of New York to enjoin such unlawful acts or practices and to obtain restitution of any moneys or property obtained directly or indirectly by any such unlawful acts or practices. In such action preliminary relief may be granted under article sixty-three of the civil practice law and rules.

(c) Before any violation of this section is sought to be enjoined, the attorney general shall be required to give the person against whom such proceeding is contemplated notice by certified mail and an opportunity to show in writing within five business days after receipt of notice why proceedings should not be instituted against him, unless the attorney general shall find, in any case in which he seeks preliminary relief, that to give such notice and opportunity is not in the public interest.

(d) In any such action it shall be a complete defense that the act or practice is, or if in interstate commerce would be, subject to and complies with the rules and regulations of, and the statutes administered by, the federal trade commission or any official department, division, commission or agency of the United States as such rules, regulations or statutes are interpreted by the federal trade commission or such department, division, commission or agency or the federal courts.

(e) Nothing in this section shall apply to any television or radio broadcasting station or to any publisher or printer of a newspaper, magazine or other form of printed advertising, who broadcasts, publishes, or prints the advertisement.

(f) In connection with any proposed proceeding under this section, the attorney general is authorized to take proof and make a determination of the relevant facts, and to issue subpoenas in accordance with the civil practice law and rules.

(g) This section shall apply to all deceptive acts or practices declared to be unlawful, whether or not subject to any other law of this state, and shall not supersede, amend or repeal any other law of this state under which the attorney general is authorized to take any action or conduct any inquiry.

(h) In addition to the right of action granted to the attorney general pursuant to this section, any person who has been injured by reason of any violation of this section may bring an action in his own name to enjoin such unlawful act or practice, an action to recover his actual damages or fifty dollars, whichever is greater, or both such actions. The court may, in its discretion, increase the award of damages to an amount not to exceed three times the actual damages up to one thousand dollars, if the court finds the defendant willfully or knowingly violated this section. The court may award reasonable attorney's fees to a prevailing plaintiff.

(j) Notwithstanding any law to the contrary, all monies recovered or obtained under this article by a state agency or state official or employee acting in their official capacity shall be subject to [subdivision eleven of section four of the state finance law](#).

# New York Consolidated Laws, General Business Law - GBS § 360-I. Injury to business reputation; dilution

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« Prev Likelihood of injury to business reputation or of dilution of the distinctive quality of a mark or trade name shall be a ground for injunctive relief in cases of infringement of a mark registered or not registered or in cases of unfair competition, notwithstanding the absence of competition between the parties or the absence of confusion as to the source of goods or services. Next »

UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF NEW YORK

COMPASS GROUP USA, INC., a Delaware corporation, and MAZZONE HOSPITALITY, LLC, a New York limited liability company,

Plaintiffs,

v.

MATTHEW MAZZONE, an individual, SUZY MAZZONE, an individual, and MAZZONE WEDDING GROUP, LLC a New York limited liability company,

Defendants.

Case No. 1:21-cv-801 (BKS/ML)

**COMPLAINT FOR UNFAIR  
COMPETITION, TRADEMARK  
DILUTION, AND UNFAIR AND  
DECEPTIVE TRADE PRACTICES**

JURY TRIAL DEMANDED

Plaintiffs Compass Group USA, Inc. (“Compass”) and Mazzone Hospitality, LLC (“MH LLC”) (collectively, “Plaintiffs”), by and through undersigned counsel, for their complaint against defendants Matthew Mazzone (“Mr. Mazzone”), Suzy Mazzone (“Mrs. Mazzone”), and Mazzone Wedding Group, LLC (“Mazzone Wedding Group”) (collectively, “Defendants”) for false designation of origin, unfair competition, and state trademark infringement, state trademark dilution, and false and deceptive claims, plead and allege as follows:

**NATURE AND BASIS OF THE ACTION**

1. Compass is a leading foodservice and support service company, having earned a reputation for its offering of large-scale corporate catering, stadium concessions, and food service for, among others, the education and healthcare communities.

2. Compass expanded its services in 2017 to include wedding and events catering through Compass’s acquisition of Mazzone Hospitality and Mazzone Catering (the “Acquisition”), which were started by Angelo Mazzone in the Albany, New York area in 1980.

3. Through the Acquisition, Plaintiffs became owners of all rights in the names,

trademarks, trade names, service marks, logos, insignias, and designations MAZZONE HOSPITALITY and MAZZONE CATERING (the “MAZZONE” Marks). Although the ownership of the business changed upon the Acquisition, Plaintiffs, working closely with Angelo Mazzone, continue to offer the same unsurpassed events and quality catering services long offered under the MAZZONE Marks.

4. Plaintiffs recently became aware that Angelo Mazzone’s son, Defendant Matthew Mazzone (who previously worked for his father’s business and then for Plaintiffs following the Acquisition), and his wife Defendant Suzy Mazzone, have started, in the Albany, New York area, a competing wedding and events business using the names Mazzone Wedding Group and Mazzone Weddings. Defendants advertise this competing business as being “family owned and operated,” tout Mr. Mazzone’s prior experience with Mazzone Hospitality, and use the confusingly similar service marks MAZZONE WEDDING GROUP and MAZZONE WEDDINGS (the “MAZZONE WEDDING GROUP Marks”) in promoting their competing business.

5. Plaintiffs bring this action to stop Defendants from continuing to unlawfully misappropriate the valuable service marks, trade names, and designations owned by Plaintiffs and used by Plaintiffs in offering the trend-setting and high-quality wedding and events services that Plaintiffs, and their predecessors in interest, have long provided in the Albany, New York area under the MAZZONE Marks.

6. More specifically, Plaintiffs assert claims under the Lanham Act, 15 U.S.C. § 1125(a), state common law, and Section 349 and 360-1 of New York General Business Law against Defendants, and seek preliminary and permanent injunctive relief and damages relating to Defendants’ unauthorized and unlawful use of the MAZZONE WEDDING Marks in

connection with hospitality and event services.

7. Unless Defendants' infringing acts are preliminarily and permanently enjoined, Plaintiffs will suffer irreparable injury for which there is no adequate remedy at law.

### **PARTIES**

8. Plaintiff Compass Group USA, Inc. is a corporation organized under the law of the State of Delaware with a place of business at 2400 Yorkmont Road, Charlotte, North Carolina 28217.

9. Plaintiff Mazzone Hospitality, LLC is a limited liability company organized under the law of the State of New York, with a place of business at 2400 Yorkmont Road, Charlotte, North Carolina 28217. Mazzone Hospitality a subsidiary of Compass Group.

10. On information and belief, Defendant Mazzone Wedding Group, LLC is a limited liability company organized under the law of the State of New York with its principal place of business at 743 Albany Shaker Road, Latham, New York 12110, and is engaged in the business of catering and hospitality services in interstate commerce in and around the area of Albany, New York.

11. On information and belief, Defendants Matthew Mazzone and Suzy Mazzone are individuals residing at 2 Lavant Lane, Bunt Hills, New York 12027. On information and belief, Mr. Mazzone and Mrs. Mazzone are members and managers of Mazzone Wedding Group and, as such, have the right and ability to supervise Mazzone Wedding Group's infringing activities, actually do direct and supervise Mazzone Wedding Group's infringing activities, and also have a direct financial interest in such activities.

### **JURISDICTION AND VENUE**

12. The Court has subject matter jurisdiction over the federal false designation of



origin and unfair competition claims pursuant to the Lanham Act, 15 U.S.C. §§ 1121 and 1125(a), and 28 U.S.C. §§ 1331 and 1338(a) and (b). The Court has supplemental jurisdiction over the claims arising under state law pursuant to 28 U.S.C. § 1367.

13. The Court has personal jurisdiction over Defendants because, upon information and belief, Defendants are present and doing business in the State of New York either directly or through their agents or, alternatively, because Defendants are subject to personal jurisdiction under the principles set forth in New York Civil Practice Law and Rules § 302.

14. Venue is appropriate in this Court pursuant to 28 U.S.C. § 1391 because Defendants are subject to personal jurisdiction in this Judicial District and because a substantial part of the events giving rise to Plaintiffs' claims occurred in this Judicial District.

#### **ALLEGATIONS COMMON TO ALL CLAIMS**

##### **A. The MAZZONE Brand and Plaintiffs' Rights in the MAZZONE Marks**

15. Mazzone Hospitality and Mazzone Catering trace their roots to 1980, when Angelo Mazzone purchased Peggy's restaurant in Schenectady, New York. Angelo Mazzone grew the business to offer not only restaurant services but to also provide catering.

16. Based on his desire to offer catering services on an even larger scale, in 1988, Angelo Mazzone purchased and renovated Glen Sanders Mansion, a historic mansion on the banks of the Mohawk River, in Scotia, New York, which is about twenty miles west of Albany, New York, and later added an inn to the mansion. The mansion quickly became known as a premiere wedding and events venue, providing guests with full-service catering and planning, as well as lodging, for weddings and receptions and business meetings and events.

17. Following the purchase of Glen Sanders Mansion, Angelo Mazzone also started providing catering at off-site events, and over time became the exclusive caterer at many large

venues in Upstate, New York, including Hall of Springs in Saratoga, Empire State Plaza in Albany, Prime at Saratoga National, Fasig-Tipton in Saratoga Springs, Key Hall at Proctors in Schenectady, 90 State in Albany, and Hilton Garden Inn-Clifton Park.

18. Angelo Mazzone built a reputation on sourcing the highest quality ingredients, a commitment to excellent service, a passion for providing people with an unforgettable dining experience, and a dedication to giving back to the local community.

19. Angelo Mazzone grew Mazzone Hospitality to become a culinary empire in the Upstate, New York area. It has been characterized as “the dominant restaurant and catering company in the Capital Region” (Capitol Region Chamber, May 11, 2017), and the “largest local caterer” (*The Daily Gazette*, January 16, 2013) by the press. Moreover, the press has called Angelo Mazzone “a dining powerhouse in the Capital Region” (*Times Union*, July 11, 2017) and “the Capital Region’s most recognized restaurateur” (*Business Review*, November 18, 2011), and Angelo Mazzone and his businesses have won numerous awards.

20. After decades of hard work in building the highly-respected and well-known MAZZONE brand, in 2017 Angelo Mazzone decided to sell his catering and executive events businesses, including the MAZZONE Marks, to a fellow leader in the foodservice industry, Plaintiffs.

21. On May 8, 2017, Angelo Mazzone, by and through his companies Mazzone Management Group, Ltd. and Mazzone Management, Inc. (the “Mazzone Entities”), entered into an asset purchase agreement with Plaintiffs for the sale of the Mazzone Hospitality and Mazzone Catering businesses (the “Asset Purchase Agreement”).

22. The terms of the sale in the Asset Purchase Agreement provide for the transfer of certain intellectual property from Angelo Mazzone and the Mazzone Entities to Plaintiffs,

including “[a]ll rights, title and interest of Sellers in any inventions, trade secrets, know-how, recipes, proprietary processes and formulae, and similar information relating primarily to [Plaintiffs], including any trade names, trademarks, service marks, any applications and registrations therefor, all registered and unregistered copyrights, internet web sites, social media presences and internet domain names owned and used by Sellers as of the Closing Date related to the Purchased Business, all as listed on Schedule 1(d).” Schedule 1(d) of the Asset Purchase Agreement entitled “Transferred Intellectual Property” specifically enumerates the following trade names: (1) Mazzone Catering and (2) Mazzone Hospitality.

23. There is no question, therefore, that by virtue of the Asset Purchase Agreement, Plaintiffs own the Mazzone Entities’ rights, and all associated goodwill, in the MAZZONE Marks under which Plaintiffs currently advertise, market, offer, and provide hospitality and catering services, including wedding and event planning and catering.

24. Following the acquisition of assets from Angelo Mazzone and the Mazzone Entities, Plaintiffs have continued offering, in interstate commerce in and around the Albany, New York, area, the same high-quality wedding and event planning and catering services under the trade names Mazzone Hospitality and Mazzone Catering, with Angelo Mazzone still closely involved in the business.

25. Plaintiffs promote their catering events services through various media, including on their Mazzone Hospitality and Mazzone Catering websites at <https://mazzonehospitality.com/> and <https://mazzonecatering.com/>, the websites for the venues where Mazzone Hospitality is the exclusive caterer, social media, in wedding magazines, and at wedding shows. Printouts of example pages from Plaintiffs’ Mazzone Hospitality and Mazzone Catering websites are attached as Exhibits A and B, respectively. Even though Plaintiffs’ services under the

MAZZONE Marks are offered primarily in and around the Upstate New York, area, Plaintiffs' customers and vendors include persons from outside the State of New York, and Plaintiffs' activities occur in interstate "commerce" as that term is defined in Section 45 of the Lanham Act, 15 U.S.C. §1127.

26. Based on Plaintiffs' and their predecessors-in-interest's long use, advertising, and promotion of services under the MAZZONE Marks, the MAZZONE Marks have acquired enormous goodwill and have come to be immediately identified with Plaintiffs as the source of their hospitality and catering services.

27. In addition to common law rights from extensive use, Compass owns the following pending U.S. federal trademark applications for the MAZZONE Marks:

- MAZZONE HOSPITALITY (App. Ser. No. 90/579,735) in connection with "catering services"; and
- MAZZONE CATERING (App. Ser. No. 90/579,700) in connection with "catering services."

Copies of these applications are attached as Exhibit C.

**B. Defendants' Unlawful Acts**

28. Matthew Mazzone was an employee of his father's company prior to the Acquisition by Plaintiffs, and became an employee of Plaintiffs after the Acquisition.

29. In connection with the Asset Purchase Agreement, Plaintiffs entered into an employment agreement with Mr. Mazzone, providing for a generous compensation package including an annual salary, bonus plan, and car allowance. The agreement also included a prohibition of Mr. Mazzone competing with Plaintiffs or soliciting Plaintiffs' customers following Mr. Mazzone's departure from Plaintiffs' employ.

30. On or around April 7, 2020, Mr. Mazzone left the employment of Mazzone Hospitality and signed a separation agreement that prohibited him from soliciting Plaintiffs' customers or employees for a competing business for eighteen months.

31. On information and belief, a week after Mr. Mazzone left Mazzone Hospitality, he registered the domain name MazzoneWeddings.com, despite the non-compete and non-solicitation provisions under his employment and separation agreements with Plaintiffs.

32. On information and belief, sometime in early 2021, Mr. Mazzone and Mrs. Mazzone launched Mazzone Wedding Group in Upstate New York, in or around the same vicinity as Mazzone Catering and Mazzone Hospitality, and started using the MAZZONE WEDDING Marks in connection with offering wedding and event planning and catering services. On information and belief, Defendants' services under the MAZZONE WEDDING Marks are offered in interstate "commerce" as that term is defined in Section 45 of the Lanham Act, 15 U.S.C. §1127.

33. On information and belief, Mr. Mazzone is the owner and President of Mazzone Wedding Group, and his co-owner, Mrs. Mazzone, is the Vice President.

34. On information and belief, Mr. Mazzone and Mrs. Mazzone selected the MAZZONE WEDDING Marks, and in their roles as owners and President and Vice President of Mazzone Wedding, have authorized and approved of the use of those Marks.

35. In adopting the trade name Mazzone Wedding Group and the MAZZONE WEDDING Marks, Mr. Mazzone and Mrs. Mazzone were clearly aware of Plaintiffs' use of and strong prior rights in the MAZZONE Marks, based on Mr. Mazzone's prior employment with his father and Plaintiffs, as well as their knowledge of the Asset Purchase Agreement.

36. Defendants nevertheless chose a trade name and service marks confusingly

similar to Plaintiffs' MAZZONE Marks, in an attempt to trade off of, and free ride upon, the goodwill in the MAZZONE brand, and to create an association with Plaintiffs' business.

37. Defendants' intent to create an association with the MAZZONE Marks and Plaintiffs is clear in Defendants' marketing.

38. Indeed, in promoting their competing services on the Mazzone Wedding Group website, <https://www.mazzoneweddings.com>, Defendants tout Mr. Mazzone's experience as "Former CFO & COO of Mazzone Hospitality," and reference Mr. Mazzone "[j]oining the family business at a young age." The website further discusses Mr. Mazzone's experience in "the family business" and advertises Mazzone Wedding Group as a "family owned and operated catering company." A printout of Defendants' Mazzone Wedding Group website is attached as Exhibit D.

39. Unsurprisingly, Defendants' use of the Mazzone Wedding Group trade name and MAZZONE WEDDING Marks has resulted in instances of actual confusion.

40. For example, a vendor emailed both Mazzone Hospitality and Defendants, apparently believing the two companies were related.

41. Similarly, a photographer tagged both Mazzone Hospitality and Defendants in a post about a wedding catered by Plaintiffs.

### **C. Plaintiffs' Attempts to Resolve This Dispute**

42. On March 10, 2021, Plaintiffs' in-house counsel sent Mr. Mazzone a letter reminding him of his post-employment obligations to Plaintiffs, including to refrain from: (i) using Plaintiffs' confidential information, soliciting or selling to Plaintiffs' customers, and (ii) soliciting or hiring Plaintiffs' employees. The letter also warned Mr. Mazzone of Plaintiffs' concern that his recently-launched competing wedding business would breach his contractual

post-employment obligations.

43. On March 22, 2021, Plaintiffs' in-house counsel sent Mr. Mazzone another letter, expressing Plaintiffs' concerns that Mr. Mazzone's use of the confusingly similar Mazzone Wedding Group mark was likely to cause consumer confusion and would violate Plaintiffs' trademark rights under federal and state law. The letter requested that Mr. Mazzone cease and desist use of the name "Mazzone" or any substantially similar mark in connection with a catering business in New York.

44. When Plaintiffs did not receive satisfactory responses to the letters from in-house counsel, outside counsel for Plaintiffs sent an additional letter on May 7, 2021, again requesting that Mr. Mazzone change the name of his business and warning that Plaintiffs would commence legal action, including the filing of a motion for preliminary injunction, absence compliance.

45. Despite Plaintiffs' repeated warnings and attempts to reach a resolution without the need for litigation, Defendants continue to use the MAZZONE WEDDING Marks in violation of Plaintiffs' rights.

### **FIRST CLAIM FOR RELIEF**

#### **Unfair Competition and False Designation of Origin Under 15 U.S.C. § 1125(a)**

46. Plaintiffs repeat and reallege the averments contained in foregoing Paragraphs as if fully set forth herein again.

47. Defendants' conduct alleged above is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of Defendants with Plaintiffs, or as to the origin, sponsorship, or approval of Defendants' services, or commercial activities Plaintiffs, and therefore constitutes unfair competition and false designations of origin in violation of Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a).

48. By their unauthorized use of the service marks, trade names, and designations “Mazzone Wedding Group” and “Mazzone Weddings” in connection with their hospitality and event planning services and on marketing and advertising materials, Defendants have falsely designated the origin of their services, and competed unfairly with Plaintiffs, in violation of 15 U.S.C. § 1125(a).

49. On information and belief, Defendants’ acts of false designation of origin and unfair competition have been done willfully and deliberately.

50. Plaintiffs have been damaged and/or is likely to be damaged by the wrongful conduct of defendants.

51. Defendants’ violations of 15 U.S.C. § 1125(a) entitle Plaintiffs to recover damages, including but not limited to, Defendants’ profits from the sale of all infringing services, actual damages, treble damages, corrective advertising damages, litigation costs, and attorneys’ fees.

52. Defendants’ willful and deliberate acts described above have caused irreparable injury to Plaintiffs’ goodwill and reputation, and, unless enjoined, will cause further irreparable injury, whereby Plaintiffs have no adequate remedy at law.

### **SECOND CLAIM FOR RELIEF**

#### **Trademark Dilution Under New York Gen. Bus. Law § 360-1**

53. Plaintiffs repeat and reallege the averments contained in foregoing Paragraphs as if fully set forth herein again.

54. This claim is for injury to goodwill and business reputation pursuant to New York General Business Law Section 360-1, as amended.

55. The MAZZONE marks are distinctive within the meaning of New York General



Business Law Section 360-1.

56. Defendants' conduct alleged above causes injury to the goodwill and business reputation of Plaintiffs and their MAZZONE marks and creates a likelihood of dilution of the distinctive quality of those marks in violation of New York General Business Law Section 360-1.

57. Defendants' acts described above have caused injury and damages to Plaintiffs, and has caused irreparable injury to Plaintiffs' goodwill and business reputation and, unless enjoined, will cause further irreparable injury, whereby Plaintiffs have no adequate remedy at law.

### **THIRD CLAIM FOR RELIEF**

#### **Trademark Infringement and Unfair Competition Under State Common Law**

58. Plaintiffs repeat and reallege the averments contained in foregoing Paragraphs as if fully set forth herein again.

59. Defendants' use of the service marks, trade names, and designations "Mazzone Wedding Group" and "Mazzone Weddings" in connection with their hospitality and event planning services and on marketing and advertising materials, as alleged above, constitutes trademark infringement and unfair competition in violation of the common law of the State of New York.

60. On information and belief, Defendants' acts of common law trademark infringement and unfair competition have been done willfully and deliberately and Defendants have profited and been unjustly enriched by sales that Defendants would not otherwise have made but for their unlawful conduct.

61. Defendants' acts described above have caused injury and damages to Plaintiffs,

and have caused irreparable injury to Plaintiffs' goodwill and reputation and, unless enjoined, will cause further irreparable injury, whereby Plaintiffs have no adequate remedy at law.

#### **FOURTH CLAIM FOR RELIEF**

##### **Deceptive Acts and Practices Under New York Gen. Bus. Law § 349**

62. Plaintiffs repeat and reallege the averments contained in foregoing Paragraphs as if fully set forth herein again.

63. This claim is for deceptive acts and practices under New York General Business Law Section 349.

64. Defendants' use of the trademarks, trade name, and designations "Mazzone Wedding Group" and "Mazzone Weddings" in connection with their hospitality and event planning services and on marketing and advertising materials, as alleged above, constitutes a deceptive act and practice in violation of New York General Business Law Section 349.

65. On information and belief, Defendants' unlawful conduct has been willful and deliberate and Defendants have profited and been unjustly enriched by sales that Defendants would not otherwise have made but for their unlawful conduct.

66. Defendants' intentional and wrongful acts described above have caused injury and damages to Plaintiffs, and have caused irreparable injury to Plaintiffs' goodwill and reputation and, unless enjoined, will cause further irreparable injury, whereby Plaintiffs have no adequate remedy at law.

#### **PRAYER FOR RELIEF**

WHEREFORE, Plaintiffs pray that this Court enter judgment against Defendants as follows:

1. Ordering that Defendants be adjudged to have violated Section 43(a) of the

Lanham Act, 15 U.S.C. § 1125(a), to have committed acts of trademark infringement and unfair competition in violation of New York common law, to have caused trademark dilution in violation of New York Gen. Bus. Law § 360-1, to have committed unfair competition and deceptive acts and in violation of New York Gen. Bus. Law § 349, and to have committed breaches of contract in violation of state common law;

2. Ordering an accounting of all gains, profits, savings and advantages realized by Defendants from their aforesaid acts of false designation of origin, trademark infringement, unfair competition, and deceptive acts and practices;

3. Awarding such damages as Plaintiffs shall establish in consequence of Defendants' aforesaid acts of false designation of origin, trademark infringement, unfair competition, and deceptive acts and practices, including three times the amount found as actual damages by the trier of fact to properly compensate Plaintiffs for their damages, pursuant to 15 U.S.C. § 1117(a), and, pursuant to New York Gen. Bus. Law § 349(h), statutory damages of \$1,000 for each violation, together with appropriate interest thereon;

4. Awarding punitive damages on Plaintiffs' common law claims in an amount to be determined by the trier of fact for Defendants' willful and unauthorized use of Plaintiffs' Marks;

5. Granting a preliminary and permanent injunction restraining Defendants, their officers, directors, agents, employees, servants, attorneys, successors, assigns, and others controlling, controlled by or affiliated with them and all those in privity or active concert or participation with any of the foregoing, and all those who receive actual notice by personal service or otherwise:

- a. from using, orally or in writing, the trade names, service marks, or designations "Mazzone Wedding Group" and "Mazzone Weddings" or any other name, word,

mark or designation confusingly similar to Plaintiffs' MAZZONE Marks, for any and all products or services;

- b. from using, orally or in writing, or applying for registration of, any trade names, trademarks, service marks, logos, insignias, or designations containing the words "Mazzone Wedding Group" and "Mazzone Weddings" or anything similar thereto or derivative thereof, either alone or in conjunction with other words or symbols for any and all products or services;
- c. from representing that the "Mazzone Wedding Group" and "Mazzone Weddings" originates with, is sponsored by, emanates from, or otherwise is associated with Plaintiffs or the source of the Mazzone Catering and Mazzone Hospitality brand; and
- d. from otherwise competing unfairly with Plaintiffs.

6. Ordering that, pursuant to Section 34(a) of the Lanham Act, 15 U.S.C. § 1116(a), Defendants shall serve upon Plaintiffs within thirty (30) days after service on Defendants of an injunction, or such extended period as the Court may direct, a report in writing under oath setting forth in detail the manner and form in which Defendants have complied with the injunction;

7. Ordering Defendants to recall from publication, distribution, or dissemination, and deliver up for destruction, all advertising, marketing, promotional pieces, and other items, the dissemination of which by Defendants would violate the injunction herein granted;

8. Awarding Plaintiffs their costs and expenses of this action;

9. Declaring that this is an exceptional case, pursuant to 15 U.S.C. § 1117, because of the willful and deliberate nature of Defendants' acts of false designation of origin and unfair competition, and awarding Plaintiffs their reasonable attorneys' fees;

10. Awarding Plaintiffs their reasonable attorneys' fees; and
11. Granting such other and further relief as this Court may deem just and proper.

Dated: July 14, 2021

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# MAZZONE CATERING

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<b>Standard Characters Claimed</b>	
<b>Mark Drawing Code</b>	(4) STANDARD CHARACTER MARK
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# MAZZONE HOSPITALITY

<b>Word Mark</b>	<b>MAZZONE HOSPITALITY</b>
<b>Goods and Services</b>	IC 043. US 100 101. G & S: Catering services. FIRST USE: 20071231. FIRST USE IN COMMERCE: 20071231
<b>Standard Characters Claimed</b>	
<b>Mark Drawing Code</b>	(4) STANDARD CHARACTER MARK
<b>Serial Number</b>	90579735
<b>Filing Date</b>	March 15, 2021
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NEWS

# Mazzone Hospitality sues son of Angelo Mazzone in federal court

Robert Gavin

July 20, 2021 Updated: July 20, 2021 1:21 p.m.



The company that bought the sprawling Capital Region restaurant and catering businessman from Angelo Mazzone, pictured, is suing Mazzone's son and daughter-in-law in U.S. District Court for operating a competing wedding business using the family name in an alleged violation of a separation agreement. In this photograph, Angelo Mazzone speaks on June 19, 2019 at the newly renovated lobby and hotel rooms at Glen Saunders Mansion in Scotia. (Catherine Rafferty/Times Union)

Catherine Rafferty/Times Union

**ALBANY —** A North Carolina corporation that purchased Mazzone Hospitality from longtime Capital Region restaurant and catering businessman Angelo



Mazzone is suing his son and daughter-in-law in U.S. District Court for operating a competing wedding business using the family name in an alleged violation of a separation agreement.

The Charlotte-based Compass Group USA, which acquired Mazzone Hospitality in May 2017, is suing Matthew Mazzone, his wife, Suzy Mazzone, and their Latham-based business, Mazzone Wedding Group, alleging false designation of origin, unfair competition, state trademark infringement, state trademark dilution and false and deceptive claims.

Mazzone Hospitality, based in Clifton Park, the largest catering group in the region, is the creation of Angelo Mazzone, who began working in his grandfather's pizzeria at age 11 and at 27 operated a Schenectady pizzeria. After earning degrees in hotel and restaurant management, he managed the dining hall manager at Union College, opened the former Peggy's Restaurant in downtown Schenectady and in 1988 purchased the 17th century Glen Sanders Mansion on the Mohawk River in Scotia. Mazzone later launched 677 Prime in Albany, Prime at Saratoga National and several other high-profile ventures around the area.

Mazzone Hospitality is part of Restaurant Associates, a subsidiary of Compass Group USA that provides food service to Google, Sony, the Metropolitan Museum of Art and the U.S. Open tennis tournament. The elder Mazzone continues to run the local arm of the operation.

The lawsuit, dated July 14, noted that Angelo Mazzone is "still closely involved in the business." Matthew Mazzone left Mazzone Hospitality in April 2020, signing an agreement that prohibited him from later competing with Mazzone Hospitality or soliciting its customers, according to the lawsuit.

One week later, the lawsuit alleged, Matthew Mazzone registered the domain name, MazzoneWeddings.com. In 2021, it said, Matthew Mazzone and his wife launched the wedding company. Matthew Mazzone is the president, Suzy Mazzone vice president, of his company.

Reached Tuesday, Angelo Mazzone declined to comment. Matthew Mazzone could not be reached for immediate comment.

Compass Group USA contends Matthew Mazzone and his wife “chose a trade name and service marks confusingly similar” to those of Mazzone Hospitality “in an attempt to trade off of, and free ride upon, the goodwill in the Mazzone brand, and to create an association with (Mazzone Hospitality).”

"A vendor emailed both Mazzone Hospitality and defendants, apparently believing the two companies were related," the lawsuit said. "Similarly, a photographer tagged both Mazzone Hospitality and defendants in a post about a wedding catered by plaintiffs."

In promoting their business, the lawsuit alleged, Matthew and Suzy Mazzone have touted Matthew Mazzone's experience as a former chief operating financial officer and chief operating officer of Mazzone Hospitality and referenced the website saying he joined "the family business at a young age."

Lawyers for Mazzone Hospitality sent Matthew Mazzone three letters from March and May asking him to abide by his post-employment agreement, refrain from soliciting former customers, informed him the name was too similar to Mazzone Hospitality and asked him to change the name, threatening legal action if he did not, the lawsuit said.

The lawsuit, filed by Albany attorney David M. Cost, said when the sale took place, Angelo Mazzone transferred intellectual property to Compass USA that included "any inventions, trade secrets, know-how, recipes, proprietary processes and formulae, and similar information" related to "trade names, trademarks, service marks, any applications and registrations therefor, all registered and unregistered copyrights, Internet web sites, social media presences and Internet domain names owned and used by sellers as of the closing date."

The suit, which asks for thousands of dollars in attorney fees and damages, asks that a judge order an accounting of all profits made as a result of the alleged wrongdoing, prohibit the business from continuing to use the allegedly infringed names.

A telephone conference is scheduled for Oct. 20 at 10 a.m. before U.S. Magistrate Judge Miroslav Lovric.

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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.

...

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.

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## IP FRONTIERS

### The limited right to use your own name

What do barbeque sauce, wine and law firms have in common? Each frequently finds themselves at the center of legal disputes over the right to use and/or register one's family name (or "surname") as a trademark. Indeed, our region is no stranger to this controversial issue. See *The Taylor Wine Company, Inc., v. Bully Hill Vineyards, Inc.*, 590 F.2d 701 (2d Cir. 1978)(injunction granted which prohibited defendant, Walter S. Taylor, from using the Taylor family name as a trademark and placed restrictions of how his signature could be used on wine labels).

Trademark infringement suits over surnames typically stem from two situations: (1) disputes over the use of a family name by a "junior user," in particular where the original trademark has acquired considerable good will; or (2) common surnames which are being used by two different companies with similar profiles.

#### Factors considered to determine registrability

The right to trademark and/or use one's own family name is not an absolute right and the guiding principles are anything but straightforward. As a general rule, last names, i.e., "surnames," cannot be registered as trademarks as the federal trademark rules prohibit registration of trademarks that are primarily, or predominantly, merely a surname. See Lanham Act, Section 2(e)(4). Furthermore, even if you are successful in registering your name, it can be difficult to stop others from using it because, for the most part, the trademark laws favor the right of a person to use his or her name as a source identifier for their goods or services.



By ALANA M. FUIERER  
Daily Record  
Columnist

To register a surname as a trademark in connection with a business, the Trademark Office considers multiple factors in evaluating whether a trademark will be perceived as predominantly a "surname":

- (i) Is the proposed trademark a common surname, or is it rare? If rare, this weighs in favor of registration;
- (ii) Is the proposed trademark the applicant's last name? If not, this weighs in favor of registration;
- (iii) Does the proposed trademark have any other recognized meaning(s) other than a surname? If yes, this weighs in favor of registration;
- (iv) Does the proposed trademark "look and feel" like a surname? If yes, this weighs against registration; and
- (v) Is the proposed trademark sufficiently stylized or otherwise distinctive, and thus not primarily merely a surname? If yes, this weighs in favor of registration.

See Trademark Manual of Examining Procedure (TMPEP) 1211.01; see also *Miller v. Miller*, 105 USPQ2d 1615 (TTAB 2013) (precedential). Ultimately, the question that must be answered is would the public recognize or perceive the proposed trademark as a surname. If the proposed trademark is held to be "primarily merely a surname" under the above analysis, it will be refused registration on the Primary Register.

Two recent cases have shed some light

on how the Trademark Trial and Appeal Board (hereinafter "TTAB") is treating the "surname" trademark issue (and, arguably, the unintended significance of an apostrophe). In *Azeka Building Corp. v. Brian Kenji Azeka*, 122 USPQ2d 1546 (TTAB 2017) (precedential), the applicant sought to federally register AZEKA'S RIBS as a trademark for use with barbecue sauce. The opposer, a relative of the applicant, opposed registration of AZEKA'S RIBS arguing, among other things, that the proposed trademark was a surname. The TTAB agreed and refused registration. In refusing the registration, the TTAB focused on the public's perception of the name, including the fact that it contained an apostrophe "s," which signaled to consumers that it was a surname; the fact that "Azeka" was applicant's surname; and that AZEKA had no other meaning. Other evidence introduced included approximately 866 individuals using the last name "Azeka" and three websites that demonstrated use of the term "Azeka" as a surname.

In *In re Beds & Bars Limited*, 122 USPQ2d 1546 (TTAB 2017) (precedential), the TTAB affirmed the Examining Attorney's refusal to register BELUSHI'S. In evaluating whether the applied-for trademark was "merely a surname," and therefore not registrable as a trademark, the TTAB focused on (1) the fame of the "Belushi Brothers," arguing that fame increased the public's awareness of "Belushi" as a surname; and (2) the use of the apostrophe "s" in the proposed trademark, which connoted use as a surname to the

*Continued on next page*



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public. Based on these two factors, the TTAB refused registration under Section 2(e)(4), even though evidence was presented that the name “Belushi” is rare (only a handful of individuals share this last name) and the applicant’s last name was not “Belushi.”

### **Acquired distinctiveness exception**

The restriction against registering surnames as trademarks is not that simple. Not surprisingly, there is an exception to the general rule that surnames are not protectable as trademarks. Namely, the U.S. Trademark Office will register a surname if it has “acquired distinctiveness,” sometimes referred to as “secondary meaning.” See, e.g. *Brennan’s, Inc. v. Brennan’s Rest., LLC*, 360 F.3d 125, 131 (2d Cir. 2004) (BRENNAN’S trademark held to have achieved distinctiveness via history and unsolicited media). Once secondary meaning for a surname has been established, it can be registered and used to stop others from using their own name in connection with similar goods or services, provided such use might cause consumer confusion. This is why names like Trump, Disney, Gucci and Ford are registered trademarks. Under these circumstances, a person’s right to use his or her own name becomes much more complicated and can result in complex, lengthy and very expensive legal suits.

Establishing proof of acquired distinctiveness can be prohibitively expensive and frequently cannot be met. The applicant needs to submit proof of length and exclusivity of use, advertising and mar-

keting expenditures, prior registrations for similar goods or services, unsolicited media coverage, sales success and/or expensive consumer surveys in order to sufficiently establish the proposed trademark has acquired distinctiveness and is perceived by the public as a source identifier. In some limited circumstances, five years of continuous use may be sufficient to establish acquired distinctiveness without the need to submit other evidence. See Lanham Act, Section 2(f). But, typically, proving acquired distinctiveness is a heavy and expensive undertaking with uncertain results.

### **Practice tips**

While it may seem counterintuitive, there is no inalienable right to use one’s own name as a trademark. And, while using a family name may seem important and an obvious choice, one should weigh the risks and benefits of using a surname as a trademark. Given the uncertainty surrounding trademark rights associated with surnames, they are not always the best choice and it may be advisable to select an alternate trademark, i.e., one that is more unique or “distinctive,” and thus easier to use, register and/or enforce as a trademark.

In reality, despite the risks of using a surname commercially, many will continue to do so. In those cases, it is important to evaluate the pros and cons of seeking a trademark registration before filing; perform a trademark search; and carefully craft the trademark application in the best way possible to avoid a surname refusal. For example, some ways to avoid a surname refusal

include one or more of the following: (1) combining two or more names (i.e. “Smith and Wesson”); (2) combining a nondescriptive, distinctive word with a surname; (3) avoiding the use of apostrophe’s, which the Board recently has used to affirm surname refusals; (4) using your first name or initials with your last name; and/or (5) including a design component. If the Principal Registration does not work, the Supplemental Register may be an alternate option.

Also, be sure any agreements regarding assignment or shared use of the trademark are in writing, even if between family members. For example, in the recent *Stubbs* barbeque case, the original 1996 agreement regarding shared use of the trademark STUBBS for prepared food (i.e. barbeque sauce) vs. barbeque restaurants services was an informal “handshake” agreement. While the informal agreement worked well for several years, it ultimately ended in a lengthy and expensive litigation, followed by settlement wherein Stubbs Austin Restaurant Company had to change its name.

Finally, remember that when it comes to family conflicts over use of a name, a court’s ultimate goal is to minimize a likelihood of confusion to the public in connection with a registered trademark, while protecting a junior family member’s right to use his or her surname in commerce.

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