Abstract:

In our society mass advertisement campaigns and strong brand name identifications are commonplace, as a result your name may not be your own. Pre-existing trademarks and copyrights limit one’s ability to name products and companies. Floyd A. Mandell evaluates several personal name trademark suits where the defendant was barred from the use of his personal name. The article discusses the criteria courts employ to evaluate these disputes and the remedies that they have commonly granted in such cases.

PERSONAL NAME TRADEMARKS — YOUR NAME MAY NOT BE YOUR OWN

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[326] In his classic “Essay on Walking,” Thoreau expressed the notion that there is nothing in a name. This view has been vigorously rejected by both parties to this litigation, not to mention almost all of mankind to whom a name is an important means of identification. Very often, intangible connotations which are not facially apparent are attached to a name. The long history of the development and growth of the companies involved in this controversy bears testimony to the force of the biblical aphorism that “a good name is better than precious ointment,” particularly in the corporate and commercial life of this nation.

Through the years laymen and lawyers alike have suffered the consequences of a common misconception that one has an absolute right to use one's own name as a trade name, trademark or service mark. Although clear case law to the contrary has existed for decades, defendants continue to be sued for trademark infringement resulting from their use of personal name trademarks, and many continue to assert the defense that they have the right to use their names as they please, in connection with their businesses.

Early authority was divided as to whether the right to use one's name was absolute, some cases going so far as to categorize the personal name as a property right. However, in 1914 the United States Supreme Court clarified previous case law and held that use of WATERMAN by defendant as a trademark for its fountain pens infringed plaintiff’s rights to the trademark WATERMAN for fountain pens, notwithstanding the fact that defendant's trademark was the surname of defendant's principal officer. The Supreme Court held that in order for the trademark to achieve protected status, the public must come to recognize the personal name as a symbol for goods or services sold under the trademark:

[W]hatever 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 a 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.
Herring-Hall-Marvin Safe Co. v. Hall’s Safe Co., 208 U.S. 554, 559.9

In holding that defendant had infringed plaintiff’s trademark, however, the Supreme Court
refused to preclude the defendant from all use of WATERMAN, but rather required that the mark
be used only in conjunction with the full name of defendant's founder, and then only in connection
with a prominent disclaimer of affiliation with plaintiff.10

Today the courts generally handle disputes regarding personal name trademarks in much the
same manner as the United States Supreme Court handled the dispute in Waterman.11 The court will
first determine whether a plaintiff has established notoriety or secondary meaning in connection
with the personal name trademark.12 If so, the court, using the same analysis it [*329] would use
in any other trademark dispute, will determine whether defendant's use of the personal name as a
trademark is likely to deceive or to cause confusion or mistake with plaintiff’s prior use of the same
name.13

Although a court may absolutely prohibit a defendant from use of a personal name trademark,
The secondary meaning required for a personal name mark is no different from that required
traditionally for descriptive or geographic terms, i.e., a showing that the public recognizes the term
primarily as a source of origin for particular goods or services rather than primarily as a personal
name. See Scott Paper Co. v. Scott's Liquid Gold, Inc., supra note 1, 200 USPQ at 424 (“Secondary
meaning is generally established through extensive advertising which creates in the mind of
consumers an association between different products bearing the same mark.”); cf Scarves by Vera,
Inc. v. Todo Imports, Ltd. (Inc.), 544 F2d 1167, 192 USPQ 289 (CA 2 1976) (court considered
plaintiff’s sales figures, its advertising expenditures, and many articles written about plaintiff as
tending to establish secondary meaning).

If likelihood of confusion is found, however, the relief generally granted by the courts often
differs from that granted in traditional trademark cases. Instead of absolutely prohibiting the
defendant's use of its personal name trademark, the court will often grant only limited injunctive
relief.14 This relief will vary according to the circumstances of each case, but may include a
requirement that defendant change the manner in which the name is used — e.g., by including his
first name or initials,15 or by changing the size of the lettering,16 or, most often, by disclaiming any
connection with the plaintiff whenever the personal name trademark is used.17

On the other hand, when such a trademark has gained great notoriety among the public through
extensive use by its owner, the addition of a first name or initials on a disclaimer may do more to
foster confusion than to prevent it. In such cases, only an absolute injunction can protect the
trademark owner and the [*330] general public. In Hat Corp. of America v. D. L. Davis Corp.,18 the
Court recognized the need for such relief in enjoining the defendant from making trademark use
of the surname “Dobbs” on its hats:

More doubtful, perhaps, is the task of determining now whether any explanatory suffix to the
name, such as “not connected with the original Dobbs,” would suffice to avoid the confusion. . .
Precisely the same images are evoked by the sight or sound of “Wm. H. Dobbs,” and the effect is no
different if followed by such a phrase as “not connected with the original Dobbs.” For the eye of the
purchaser, long taught to identify the product by the name Dobbs alone, promptly registers the identity as complete upon catching the surname without noticing and pondering the significance of initials or suffix. And even the occasional purchaser who notices the suffix is not enlightened. For one who has known of one Dobbs only, suddenly confronted with the suggestion that there are in existence varieties of the species, is not informed which Dobbs is “his” Dobbs. Confusion is created by the very explanation intended to avert confusion and in some instances may require a defendant to pay damages to a plaintiff. Such relief is generally limited to situations in which a plaintiff is able to establish that defendant used the personal name trademark in bad faith, with the intent to misappropriate plaintiff’s good will.

Such an intent to misappropriate has been found when the alleged infringer has sold his business and good will to the plaintiff. Recently, in Levitt Corp. v. Levitt, the Court of Appeals for the Second Circuit dealt with precisely such an infringer. In that case, William Levitt, until 1968, was a controlling shareholder of Levitt & Sons, a company which was best known for residential communities in New York and Pennsylvania called LEVITTOWN. In 1968 he sold his ownership in the corporation, and in the LEVITT marks, to the plaintiff’s predecessor for stock valued in excess of sixty million dollars. He also agreed not to use the name LEVITT as a corporate title, trademark or trade name in the construction business.

Notwithstanding Mr. Levitt’s sale of his business, and his agreement not to use the LEVITT marks, he began a construction venture in Florida, which advertised on a national basis his intent to build a new “Levittown” in Florida, which identified him as the founder of the company that had built “Levittowns” in New York, New Jersey, and elsewhere. Those advertisements resulted in a great deal of confusion in the form of telephone calls, letters, and even reservation deposits, which were sent to the plaintiff.

The court found that the activities of Mr. Levitt amounted to an intentional infringement, and entered an absolute injunction, prohibiting Mr. Levitt from any use of the LEVITT marks, requiring him to initiate corrective advertising, and prohibiting him from publicizing his prior connection with the plaintiff’s predecessor. In awarding this relief, the court was careful to distinguish the facts of the Levitt case from those of another personal name trademark case which was decided one year previously, Taylor Wine Co., Inc. v. Bully Hill Vineyards, Inc.

In the Taylor Wine case, the Second Circuit Court of Appeals granted only a “limited” injunction, and allowed the defendant, whose surname was “Taylor,” to use his signature on bottles of wine, sold in competition with plaintiff’s well-known TAYLOR wines. The court expressed a belief that it would be unfair to preclude a party from all use of his own name, where he has had some experience of his own in the industry, and wishes to establish a business under his name. However, it found that the same considerations do not apply when the accused infringer has sold his own business and assigned the rights in his name to another.

In those cases where courts have flatly refused to forbid defendants from use of a personal name trademark where infringement is found, they seem to be reaching a judicial compromise to protect three separate interests: (1) that of the plaintiff in protecting the good will in his trademark; (2) that of the public in being free from confusion; and (3) that of the defendant in the use of his own name in connection with his business. It is of course the latter consideration which has caused
conflicting decisions, and which has caused personal name trademark cases to differ in many ways from other trademark disputes.

In Santucci Construction Co. v. Carlo V. Santucci, Inc., Senior Judge Edwin Robson of the United States District Court for the Northern District of Illinois recently granted a plaintiff summary judgment in a personal name trademark dispute involving interesting and unusual facts. In that case, plaintiff was operating as an underground construction business under the surname SANTUCCI, that of its founder, since 1934. From 1956 to 1976, Carlo V. Santucci, a son-in-law of plaintiff's founder, was employed by the plaintiff. He served as an engineer, superintendent, and as plaintiff's president. Then in 1976 he left plaintiff's employ and formed his own corporation, operating under the trade name and service mark CARLO V. SANTUCCI, INC., in an underground construction business competitive with that of his former employer, SANTUCCI CONSTRUCTION COMPANY.

Plaintiff's lawsuit charged that defendant's use of SANTUCCI as the salient part of its corporate name and service mark was likely to cause confusion, mistake or deception, in that persons would be likely to believe that defendant's business was plaintiff's business or was in some way legitimately connected with plaintiff's business. Plaintiff sought an injunction prohibiting the defendant from using the name SANTUCCI, together with an accounting of profits and punitive damages.

Defendant asserted, inter alia, that the right of every man to use his own name honestly in his own business is sacrosanct, and claimed that that right rendered its use of its founder's surname as a trade name and service mark an exception to the general rules of trademark infringement and unfair competition.

In an opinion which reflects the current state of the law, the court rejected defendant's arguments with regard to liability, and granted plaintiff's motion for summary judgment on its claims for service mark infringement, violation of Section 43(a) of the federal Lanham Act, and violation of the Illinois Consumer Fraud and Deceptive Trade Practices Act.

As in the Waterman and Taylor Wine cases, however, the court in Santucci refused to completely ban defendant's use of its founder's surname. Rather, the Court required that in all of defendant's uses of its corporate name and service mark, a prominent disclaimer of affiliation with the plaintiff be used, and stated:

[A]n injunction is appropriate under the circumstances of this case, but . . . a complete ban on CVSI's [defendant's] use of SANTUCCI is unwarranted. When the infringer's trade name is a surname, courts generally grant only limited injunctive relief.

In fashioning its relief, the court in Santucci relied heavily on Berghoff Restaurant Co., Inc. v. Lewis W. Berghoff, Inc., another case decided in the Northern District of Illinois involving a surname mark. In the Berghoff case, defendant's founder was employed for fourteen years by plaintiff's well-known restaurant, which had been operating under the surname mark BERGHOFF since 1898. The defendant operated its restaurant under the mark LEWIS BERGHOFF INN in Elgin, Illinois, some forty miles from plaintiff's restaurant. The court, finding that a likelihood of
confusion existed, enjoined defendant from further use of BERGHOFF unless preceded by the name LEWIS, in the same size print as BERGHOFF and accompanied by a prominent disclaimer of association with the plaintiff.

The Court in Santucci also refused to award plaintiff an accounting of profits or punitive damages, indicating that damages would have been awarded had the plaintiff been able to show that it lost business as a result of confusion with the defendant:

... Santucci has not shown that it lost a bid to contract for performance of underground construction services because of any confusion fostered by CVSI’s infringement of the SANTUCCI trade name. Therefore, because this kind of relief is “not an automatic concomitant of the grant of injunctive relief,” the court will not make such an award here. Grotian, Helfferich, Schulz, Th. Steinweg Nachf. v. Steinway & Sons, 532 F2d 1331, 1344, 186 USPQ 436, 446-47 (CA 2 1975).35

Although the Santucci court did not discuss the point, damages are also appropriate where a defendant has been unjustly enriched as a result of the confusing similarity between its mark and that of plaintiff 36 or where the plaintiff can establish a wrongful intent to benefit from confusion.37

Personal name trademark disputes are not limited to surnames, but may include first names38 and nicknames.39 An interesting example is Sullivan v. Ed Sullivan Radio & T.V., Inc.,40 [*335] in which the nationally prominent radio and television personality filed suit against a corporation engaged in the business of selling and repairing radios and television sets. Defendant was named after its incorporator, Edward J. Sullivan. However, plaintiff’s primary complaint was the use of the name “Ed” in conjunction with the surname “Sullivan”:

[A]ppellant voices no objection to use of the name “Sullivan” as such nor even “E. J. Sullivan,” nor the full name “Edward J. Sullivan,” since he feels that such forms of the name would not induce or result in any confusion in the public mind. The objection here stems from the use of the diminutive form “Ed” in conjunction with the surname “Sullivan” in the combined name “Ed Sullivan” which appellant has continuously used throughout his entire career. In this regard it is to be noted that our courts have, on a number of occasions, enjoined the use even of variants of a name where such use threatened confusion in the public mind.41

With the growth of national advertising and trademark owners’ increased appreciation that consumer recognition is of value to their businesses, disputes involving both personal name trademarks and traditional trademarks are likely to increase.42 An area of potential conflict, which should be of particular interest to the legal community, involves law firms’ use of the surnames of their senior partners or founders in connection with the rendering of legal services. This is particularly true in view of the fluidity of law firms today and the growth of lawyer advertising and national practices.

Under traditional trademark principles, a law firm’s use of its firm name in connection with the rendering of legal services gives it common law service mark rights in and to the firm name,43 so long as it can establish the requisite secondary meaning in the firm name.44
[336] In the hypothetical case of a law firm which has done business under the name Doe & Doe for fifteen years, what rights does the firm have if two other attorneys surnamed Doe establish a law firm and begin rendering legal services as Doe & Doe? As in any other trademark dispute, the similarity of the names, the geographic location of the firms, the nature of the legal services rendered, the location of the clients, the strength of the firm’s mark and any actual confusion would all be factors to be considered by a court in determining the likelihood of confusion. To the extent a court would find that there exists a likelihood of confusion between Doe & Doe and Doe & Doe for legal services, it is likely the court would somehow restrict the new firm in its use of Doe & Doe.

In a California decision touching on this problem, an attorney with the surname of Lyon left the firm of Lyon & Lyon and began rendering legal services as a sole practitioner under the firm name Lyon & Lyon. The court’s decision in the case was simplified by the fact that the alleged infringer operated as a sole practitioner rather than going into partnership with another attorney with the Lyon surname. However, the court used the traditional likelihood of confusion test in precluding attorney Lyon from using the firm name of his former partners:

In light of the personal confidential relationship between lawyer and client, the trial judge’s finding — that the public seeking defendants’ services, the courts and the United States Patent Office “are likely to believe that plaintiff is associated with or a partner in the firm of Lyon & Lyon, in which defendants are partners, and are truly likely to be and in some instances have been deceived and misled by [plaintiff’s] use” of said name — and the court’s power of discipline over attorneys at law [Art 6 Bus & Prof Code], we can only conclude that the restraining order is proper.

While attorney Lyon was not totally precluded from using his surname, he was required to tailor his use to eliminate the likelihood of confusion.

It is apparent that although the likelihood of confusion standard is the universal test in personal name trademark cases, results and relief will vary from case to case. As the Court noted in the Taylor Wine case, “the field is one that does not lend itself to strict application of the rule of stare decisis because the fact patterns are so varied . . .” It is clear, however, that in the absence of a situation such as Levitt, where the defendant has received consideration for the assignment of its mark, or other circumstances which demonstrate a lack of good faith in the use of a personal name, courts will attempt to fashion relief so as to allow use of one’s own name under “some” circumstances. However, variances in relief by the courts do make counseling difficult. As in any other case involving a trademark infringement claim, the following factors must be analyzed: the strength or notoriety of the plaintiff’s mark, whether the extent of plaintiff’s use entitles him to broad protection, as Ed Sullivan illustrates; whether defendant adopted plaintiff’s mark with an intent to benefit from confusion, in which case a finding of infringement is likely; differences in the products sold or services rendered under the marks, confusion being less likely when the products or services are distinct; the marketing environment in which the products are sold or services rendered including the geographic location of customers, the manner in which goods or services are marketed and customer sophistication; and the similarity of the marks involved.

[338] Conclusion
Although no businessman wants to hear that there may be a problem in the manner in which he wishes to use his own name in connection with his business, if the possibility of confusion with another person's prior use of the same name exists, it is better to deal with the problem at an early stage in the business. Easy solutions cannot always be fashioned for problems generated by use of a personal name, particularly since an emotional factor is often involved. However, ignoring the problem will generally cause it to become more difficult and expensive as time goes on.

The decisions in the Levitt, Taylor Wine and Santucci cases represent not only excellent examples of the current state of the law with regard to intellectual property rights in a personal name trademark, but also exemplify the pitfalls awaiting an individual or corporation which blindly relies on a “right” to use one's own name. While most practitioners will evaluate the availability of a non-personal name trademark or service mark for use by a client, availability assessments respecting personal name trademarks are frequently and unfortunately omitted. Many lawsuits could be avoided if such judgments were made prior to expenditures for advertising, promotion and development of a business.

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2 Partner in the firm of Katten, Zavis, Pearl & Galler, Chicago, Illinois; Associate Member of USTA. Copyright (C) 1979 Floyd A. Mandell. All Rights Reserved. The author wishes to express appreciation to Scott Drane, a student at Northwestern University Law School, who anticipates receiving his degree in 1981, for assisting in the research for the updated version of this article.


4 These terms are defined under § 45 of the Lanham Act, 15 USC § 1127 (1976) as follows:

The terms “trade name” and “commercial name” include individual names and surnames, firm names and trade names used by manufacturers, industrialists, merchants, agriculturists, and others to identify their businesses, vocations or occupations; the names or titles lawfully adopted and used by persons, firms, associations, corporations, companies, unions, and any manufacturing, industrial, commercial, agricultural, or other organizations engaged in trade or commerce and capable of suing and being sued in a court of law.

The term “trademark” includes any word, name, symbol, or device or any combination thereof adopted and used by a manufacturer or merchant to identify his goods and distinguish them from those manufactured or sold by others. The term “service mark” means a mark used in the sale or advertising of services to identify the services of one person and distinguish them from the services of others. Titles, character names and other distinctive features of radio or television programs may be registered as service marks notwithstanding that they, or the programs, may advertise the goods of the sponsor.

The legal distinctions between these terms are not relevant for purposes of this article; therefore, reference to any one of these terms should be construed to include the others.
See, eg, L. E. Waterman Co. v. Modern Pen Co., 235 US 88 (1914) (enjoining a competing business, whose founder had the same surname as plaintiff's trademark, from use of corporate name on product unless accompanied by the disclaimer “not connected with the L. E. Waterman Co.”); Thaddeus Davids Co. v. Davids Mfg. Co., 233 US 461 (1914) (enjoining defendants having the same surname as plaintiff against a colorable imitation by the use of the word “Davids” at the top of their labels in connection with their competing business); Brooks Bros. v. Brooks Clothing of California Ltd., 60 F Supp 442, 65 USPQ 301 (SD Calif 1945), affd per curiam 158 F2d 798, 72 USPQ 66 (CA 9 1947); cert denied 331 US 824, 73 USPQ 550 (1947) (absolutely enjoining a newcomer to the clothing field from using the fictitious name “Brooks” in competition with plaintiff, an established firm); Hat Corp. of America v. D. L. Davis Corp., 4 F Supp 613, 19 USPQ 210 (D Conn 1947) (absolutely enjoining a newcomer to the clothing field from using the fictitious name “Brooks” in competition with plaintiff, an established firm); Hat Corp. of America v. D. L. Davis Corp., 4 F Supp 613, 19 USPQ 210 (D Conn 1947) (absolutely enjoining defendant from affixing corporate name to its products, where person having surname made valuable by plaintiff as a trade name, licensed defendant to use such name in competition with plaintiff).


9Id at 94.

10Id at 95. The Court did not absolutely enjoin defendant corporation’s use of its founder’s name, although he had been found to have intended to profit from public confusion. Hill Vineyards, supra note 4; Santucci Construction Co. v. Carlo V. Santucci, Inc., supra


14For example, in Taylor Wine Co., Inc. v. Bully Hill Vineyards, supra note 4, the court enjoined the defendant from using the word “Taylor” as a trademark, but permitted the signature of defendant company’s owner to appear on labels and advertisements when accompanied by a disclaimer of affiliation with plaintiff company. In Santucci Construction Co. v. Carlo V. Santucci, Inc., supra note 4, the court enjoined the defendant from using its trade name, Carlo V. Santucci, Inc. without a disclaimer of affiliation with Santucci Construction Company. In Berghoff Restaurant Co., Inc. v. Lewis W. Berghoff, Inc, supra note 9, the court enjoined the use of defendant's surname in the restaurant business unless accompanied by his given name, Lewis. The court further required that all advertising and menus include the disclaimer “Not affiliated with the Berghoff Restaurants in Chicago.” See also International Election Systems Corp. v. Shoup, supra note 9.

See, eg, Scarves by Vera, Inc. v. Todo Imports, Ltd. (Inc.), supra note 10 (enjoining defendant from any prominent display of the word "Vera," but permitting use of founder's name in small type); Crane Co. v. Crane Heating & Air Conditioning Co., 299 F2d 577, 132 USPQ 478 (CA 6 1962) (defendant agreed to adopt a different style and type of lettering of the word "Crane" and to print the name "Crane" in the same style and size of type as the other words of its name).


Supra note 3. The evidence revealed that William H. Dobbs had licensed the defendant corporation to use his name on its products, but he had no particular reputation in the hat business or genuine desire to do business under his own name.

Id at 622, 19 USPQ at 219-20.

See, eg, Hat Corp. of America v. D. L. Davis Corp., supra note 3; David B. Findlay, Inc. v. Findlay, 18 NY2d 12, 218 NE2d 531, 271 NYS2d 652, 150 USPQ 223 (NY Ct App 1966), cert denied 385 US 930, 151 USPQ 757 (1966) (defendant had opened an art gallery next door to his brother’s gallery); A. W. Cox Dept. Store Co. v. Cox’s, Inc., 191 USPQ 220 (W Va Sup Ct App 1976). In the Cox case plaintiff corporation brought suit against defendant corporation which opened a competing retail store of soft goods a few miles from plaintiff’s largest store. In deciding to affirm an absolute injunction, the timeliness of defendant's action impressed the court. It observed that defendant's loss was minimal since it had not had much time to generate good will.

See, eg, John B. Stetson Co. v. Stephen L. Stetson Co., supra note 15 at 984, 54 USPQ 38 (court had previously granted plaintiff limited injunctive relief, which defendant evaded by printing infringing surname in much larger type than disclaimer of affiliation); W. R. Lynn Shoe Co. v. Auburn-Lynn Shoe Co., 100 Me 461, 62 A 499 (1905) (the defendant conducted its business in a manner which misled the public into believing that it was the plaintiff corporation or its successor); cf Santucci Construction Co. v. Carlo V. Santucci, Inc., supra note 4 (court would not award damages because plaintiff could not show any instance where it lost a bid to contract by reason of confusion caused by defendants' infringement of “Santucci” trade name).

Vick Medicine Co. v. Vick Chemical Co., 11 F2d 33 (CA 5 1926). See also cases in supra note 19.

201 USPQ 513 (CA 2 1979), affg 201 USPQ 164 (EDNY 1978).

Interestingly, the requirement which precluded Levitt from truthfully advertising his prior connection with plaintiff’s predecessor was beyond the scope of his original agreement when he sold his business. Unfortunately, the court did not address whether this requirement would be in violation of the First Amendment of the United States Constitution.

The Court in Levitt did not deal with the primary reason why an absolute injunction was warranted in that case, i.e., an absolute injunction was necessary to prevent additional confusion.

Supra note 4.

Id at 735, 196 USPQ 593.

The paramount right of the public to be free from confusion has often been recognized in trademark cases. See
Some courts have sidestepped consideration of this interest, stating that when the personal name mark is used by a corporation, a defense based on the use of one’s own name does not apply. See Everest & Jennings, Inc. v. E. J. Mfg. Co., 263 F2d 254, 120 USPQ 247 (CA 9 1958), cert denied 360 US 902, 121 USPQ 653 (1958); Charles J. Donnelly, Inc. v. Donnelly Bros., Inc., 96 R.I. 255, 191 A2d 143, 137 USPQ 677 (RI Sup Ct 1963).

15 USC § 1125(a) (1976).
Supra note 4 at 787-88.
Supra note 9.
Supra note 4 at 788.

Monsanto Chemical Co. v. Perfect Fit Products Mfg. Co., Inc., 349 F2d 389, 146 USPQ 512 (CA 2 1965), cert denied 383 US 942, 148 USPQ 772 (1965). Defendant’s infringement consisted of sale of mattress pads upon which plaintiff’s trademark was improperly placed. The court permitted an accounting of profits gained by the defendant in order to deter fraudulent sales practices.

See supra note 19.

See Jerrico, Inc. v. Jerry's, Inc., supra note 4 (nickname JERRY's infringed); Hirsch v. S.C. Johnson & Son, Inc., 205 USPQ 920 (Wis Sup Ct 1979) (reversing and remanding dismissal by trial court of action involving alleged infringement of nickname “Crazylegs”).

1 App Div2d 609, 152 NYS2d 227, 110 USPQ 106 (NY App Div 1956).
The court found that the general public would identify defendant’s business with plaintiff and reversed a lower court decision which had denied plaintiff an injunction pendente lite.
Id at 611, 152 NYS2d at 230, 110 USPQ at 107.
See Beverly W. Pattishall, Two Hundred Years of American Trademark Law, 68 TMR 121 (1978).
See supra note 10.
See Telemed Corp. v. Tel-Med, Inc., 588 F2d 213, 200 USPQ 427 (CA 7 1978), discussing factors relating to the strength of a mark.

Evidence of actual confusion is not necessary to prove likelihood of confusion but if established is entitled to great weight. Union Carbide Corp. v. Ever-Ready, Inc., 531 F2d 366, 383, 188 USPQ 623 (CA 7 1976), cert denied 191 USPQ 416 (US 1976); Tisch Hotels, Inc. v. America Inn, Inc., 350 F2d 609, 611-612, 146 USPQ 566 (CA 7 1965).


49 Id at 528, 54 Cal Rptr at 834, 152 USPQ at 723.

50 Ibid.


52 Supra note 4, 196 USPQ at 595.

53 Supra note 38. Although the plaintiff was not in competition with the defendant, the strong public recognition of his name entitled him to injunctive relief.

54 See DeNobili Cigar Co. v. F. G. Nobile Cigar Co., 56 F2d 324, 326, 12 USPQ 442 (1932), the defendant corporation issued a Francesco G. Nobile twenty shares of its stock as “a plausible excuse” to use plaintiff’s well-known trademark NOBILI in connection with its cigars.

55 See Scott Paper Co. v. Scott's Liquid Gold, Inc., supra note 1 at 1229-31, 200 USPQ 421. Although plaintiff had established secondary meaning of the trademark SCOTT in the paper products field, there was not such sufficient likelihood of confusion to warrant injunctive relief against the use of the registered trademark SCOTT’S LIQUID GOLD on household cleaners. Ibid.

56 For an excellent discussion of the relevance of marketing environment as a factor in determining likelihood of confusion, see Beverly W. Pattishall and David Craig Hilliard, Trademarks, Trade Identity and Unfair Trade Practices § 4.14 (1974).