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People as Trademarks

Trademark law has a few rules that explicitly apply to names and other attributes of personal identity. Before we discuss them, though, it is worth asking why special rules for name marks might be necessary? Judge Posner ventured an answer to that question in *Peaceable Planet, Inc. v. Ty, Inc.*, a lawsuit over competing plush camel toys named “Niles”:

Although cases and treatises commonly describe personal names as a subset of descriptive marks, it is apparent that the rationale for denying trademark protection to personal names without proof of secondary meaning can’t be the same as the rationale just sketched for marks that are “descriptive” in the normal sense of the word. Names, as distinct from nicknames like “Red” or “Shorty,” are rarely descriptive. “Niles” may evoke but it certainly does not describe a camel, any more than “Pluto” describes a dog, “Bambi” a fawn, “Garfield” a cat, or “Charlotte” a spider. (In the Tom and Jerry comics, “Tom,” the name of the cat, could be thought descriptive, but “Jerry,” the name of the mouse, could not be.) So anyone who wanted to market a toy camel, dog, fawn, cat, or spider would not be impeded in doing so by having to choose another name.

The reluctance to allow personal names to be used as trademarks reflects valid concerns (three such concerns, to be precise), but they are distinct from the concern that powers the rule that descriptive marks are not protected until they acquire secondary meaning. One of the concerns is a reluctance to forbid a person to use his own name in his own business. Supposing a man named Brooks opened a clothing store under his name, should this prevent a second Brooks from opening a clothing store under his own (identical) name even though consumers did not yet associate the name with the first Brooks’s store? It should not.

Another and closely related concern behind the personal-name rule is that some names are so common

— such as “Smith,” “Jones,” “Schwartz,” “Wood,” and “Jackson” — that consumers will not assume that two products having the same name therefore have the same source, and so they will not be confused by their bearing the same name. If there are two bars in a city that are named “Steve’s,” people will not infer that they are owned by the same Steve.

The third concern, which is again related but brings us closest to the rule regarding descriptive marks, is that preventing a person from using his name to denote his business may deprive consumers of useful information. Maybe “Steve” is a well-known neighborhood figure. If he can’t call his bar “Steve’s” because there is an existing bar of that name, he is prevented from communicating useful information to the consuming public.¹

A An Example

Consider *David B. Findlay, Inc. v. Findlay*.² David Findlay operated an art gallery at 11-13 East 57th Street in Manhattan as “Findlay Galleries.” In 1963, his estranged brother Wally opened a gallery at 17 East 57th Street as “Wally Findlay Galleries” — literally two doors down from his brother.³

An unrelated non-Findlay who pulled a stunt like this would have been enjoined into oblivion in a heartbeat. Numerous consumers in the fine-art market knew of David’s gallery simply as “Findlay’s on 57th Street.” Such consumers might well walk into the wrong gallery, especially since they both specialized in French impressionist and post-impressionist paintings, and since Wally’s had a big canopy out front, whereas David had an understated second-floor premises.

Wally, however, was truthfully using his own name to describe his gallery. This wasn’t an absolute shield, despite some loose language in earlier cases suggesting that there was a “sacred right” to use one’s own name in business. Instead, although David still won, the court’s injunction was narrow: it prohibited Wally from using the name “Findlay Galleries” on 57th Street. He was free to keep his storefront there, and run it under a different name, such as “W.C.F. Galleries.” Or, he was free to keep the name and move off of 57th Street. So he did. He opened the “Wally Findlay Gallery” on the same block, but around the corner on Fifth Avenue, and there he remained, far enough away to avoid consumer confusion, for another three decades.

B Name Marks Under the Lanham Act

Section 2(c) of the Lanham Act denies registration to marks consisting of “a name, portrait, or signature identifying a particular living individual except by his written consent.”⁴ In effect, this rule reserves each person’s

1. *Peaceable Planet, Inc. v. Ty, Inc.*, 362 F.3d 986 (7th Cir. 2004).

2. *David B. Findlay, Inc. v. Findlay*, 218 N.E.2d 531 (N.Y. 1966).

3. Their grandfather had founded the first Findlay gallery in Kansas city in 1870, which grew into an important importer of European art. David and Wally had their falling-out and split up the family business in 1938, with David keeping the company and its New York branch, and Wally the Chicago branch. Today, the Findlay Galleries are under combined ownership again. James Borynack, Wally’s business partner, took over the Wally Findlay Galleries after Wally’s death in 1996. He bought out the Findlay Galleries from David’s granddaughter in 2016. They operate out of 32 East 57th Street, on the other side of the street from the brothers’ dueling galleries.

4. Lanham Act §2(c). The protection also applies to “a deceased President of the United States during the life of his widow,” which I mean, come on, seriously, if you’re going to do that for presidents, why not protect everyone’s name during the lifetime of their surviving spouse?

identity for them as a trademark. I don't have to use JAMES GRIMMEL-MANNN as a trademark, but no one else can unless I let them.

The Section 2(c) bar on using the identity of "a particular living individual" is now subject to an important carve-out for "commentary and criticism regarding a political figure." In *In re Elster*, Steve Elster applied to register the mark TRUMP TOO SMALL for T-shirts.⁵ The USPTO rejected the application under Section 2(c) because it identified then-President Trump. But the Federal Circuit reversed, holding that under *Matal v. Tam* and *Iancu v. Brunetti*, the government could not use the trademark-registration system to restrict Elster's speech criticizing a public official.

In addition, Lanham Act § 2(d)(4) denies registration to a mark which is "primarily merely a surname."⁶ The word "merely" indicates that surnames are descriptive; they can be registered with proof of secondary meaning. The word "primarily" indicates that this rule applies only when the public perceives the mark *as a surname*.⁷

Problems

Melting Bad, Redux²

Blancorp has come to you with even more ideas for trademarks for its clumpless ice-melter. (Recall that its CEO is Walter Blanco.) Evaluate:

- JONES
- BETTE MIDLER
- JAY Z
- WALTER BLANCO
- ROBIN HOOD
- CALVIN COOL EDGE⁸
- BLANCO'S BLUE

5. elster



Elster's T-shirt. Are there any other grounds for rejection?

6. Lanham Act § 4(d)(4).
7. This is the same test used for "primarily ... geographically descriptive" marks.
8. Calvin Coolidge (1872–1933) was the 30th President of the United States.