

**INTELLECTUAL PROPERTY—LANHAM ACT—Injunctive relief for trademark infringement is not available when likelihood of confusion does not exist as to the source of the goods or services or when an entity abandons a trademark—*Major League Baseball Properties, Inc. v. Sed Non Olet Denarius, Ltd.*, 817 F. Supp. 1103 (S.D.N.Y. 1993).**

September 8, 1957, will forever be ingrained in the minds and hearts of the residents of Kings County, New York.<sup>1</sup> That was the day the Brooklyn Dodgers did the unthinkable — they abandoned their 137 year-old Brooklyn home.<sup>2</sup> The team announced that it was moving the franchise west to Los Angeles.<sup>3</sup> Then team owner,

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1. HARVEY FROMMER, *NEW YORK BASEBALL: THE LAST GOLDEN AGE: 1947 - 1957* 10 (1980). Frommer captured the moment when he described the fans' reaction to the proposed move of September 8, 1957:

Thousands wore blue and white buttons that said, 'Keep the Dodgers in Brooklyn.' Rallies at Brooklyn's Borough Hall became a weekly event. Pickets would march in front of Ebbets Field and 215 Montague Street, the main office of the Dodgers. O'Malley had once called them 'the most loyal fans in the world.' Always vocal, always unrestrained, the fans of the Dodgers were showing the world their loyalty. Kids dressed in baseball uniforms and carried printed signs produced by adults. ' . . . Don't You Dare Take Our Dodgers Out Of Brooklyn. Our Answer To Queens and To L.A. Is No! They Stay in Brooklyn . . . Brooklyn Is The Dodgers. The Dodgers ARE Brooklyn.'

*Id.*

2. Emanuel Perlmutter, *Dodgers Accept Los Angeles Bid to Move to Coast*, *N.Y. TIMES*, Oct. 9, 1957, at 1. See PETER GOLENBOCK, *BUMS: AN ORAL HISTORY OF THE BROOKLYN DODGERS* 438-48 (1984). Golenbock quoted Bobby McCarthy, a Brooklyn resident at the time of the announcement, as follows:

I never believed the Dodgers would ever leave Brooklyn. I don't think a lot of people did. I didn't think O'Malley would take them to L.A. The day it was announced you'd have thought it was a wake. This was like seceding from the Union. It was hard to believe that one of your own kind, O'Malley, could do this. Willie [a friend] was a sick Dodger fan, and Willie wanted to go find Walter O'Malley and kill him. He wanted to kidnap him. He wanted to go get him and shoot him. He figured if he shot him, the Dodgers wouldn't move. We said, 'there will be another Brooklyn team. Whoever thought they'd go out to L.A. and keep the name Dodgers? Whoever thought California should have a baseball team' . . . We figured we would always have the Brooklyn Dodgers, even after they said they were moving. But it didn't happen. And when they tore down Ebbets Field, that was like tearing away part of your heart .

*Id.* at 446.

3. Perlmutter, *supra* note 2, at 1. Brooklyn Dodger cameraman, Jack Carney, noted that:

The move was like saying good-bye to your best friend who you were never going to

Walter O'Malley, stated that the Los Angeles ball club would continue to play under the "Dodgers" name.<sup>4</sup> Brooklyn Dodgers fans expressed their concern that the team name characterized and originated in Brooklyn<sup>5</sup> and the name should be reserved for the team that replaces them.<sup>6</sup> Despite the protest, the team changed its name from "The Brooklyn National Baseball Club, Inc." to "The Los Angeles Dodgers, Inc."<sup>7</sup>

Since departing to Los Angeles in 1957, the Los Angeles Dodgers made only infrequent and sporadic references<sup>8</sup> to "The Brooklyn Dodgers" trademark.<sup>9</sup> The Los Angeles Dodgers did not have a licensing agreement which included "The Brooklyn Dodger" name, symbol, or logo until 1981.<sup>10</sup> From 1981 to 1988, the Los Angeles

see again. Get out of here and go to California and never come back . . . I don't think any of those true Dodger and Giant fans ever got over it. I know I never will because from that moment on I was firmly convinced that sports was big business and that baseball was not what I had thought it was when I was a kid. They did it for a buck and nothing will ever change it. They could play in California for hundreds of years and it'll never be the same.

FROMMER, *supra* note 2, at 27.

4. *Dodger Officials Arrive on Coast*, N.Y. TIMES, Oct. 24, 1957, at 40. O'Malley stated that the "Dodger" name had become a national trademark and was "synonymous with pennant winning baseball". *Id.* Indeed, the Brooklyn Dodgers won nine pennants and one World Series. THE BASEBALL ENCYCLOPEDIA 2697-737 (9th ed. 1993). Other Brooklyn Dodger highlights include National League Most Valuable Player Awards, Roy Campanella (1955) and Don Newcombe (1956); National League Rookie of the Year Awards, Jackie Robinson (1947), Don Newcombe (1949), Joe Black (1952), and Junior Gillium (1953); Cy Young Award Winner, Don Newcombe (1956); and World Series Most Valuable Player, Johnny Podres (1955). *Id.* at 19-21.

5. PAUL DICKSON, THE DICKSON BASEBALL DICTIONARY 72 (1989). Dickson explained that:

The nickname Dodgers was originally used by baseball writers in the late 1890s when the team was known as The Bridegrooms and it was customary to refer to the residents of Brooklyn as trolley-dodgers. Trolley-dodging was a term for jay-walking in Brooklyn, where pedestrians had to avoid being hit by the numerous street cars that crisscrossed the borough. The team went through several nickname changes . . . but always seemed to revert to the name Dodgers.

*Id.*

6. A. Hoyt Levy, "Dodgers" Linked to Brooklyn, N.Y. TIMES, June 8, 1957, at 18.

7. *Dodger Officials Arrive on Coast*, *supra* note 4, at 40.

8. *Major League Baseball Properties*, 817 F. Supp. at 1115. In 1959, the Los Angeles Dodgers commercially used the Brooklyn Dodgers name to promote Roy Campanella night and also used the name during old-timer games. *Id.* at 1114. The Los Angeles Dodgers also authorized the use of "Brooklyn Dodger History" through photographs and pennants displayed in several establishments. *Id.* The establishments included Dodger Pine Golf and Country Club, Dodgertown Conference Center, and the Stadium Club at Dodger Stadium. *Id.* at 1115.

9. *Id.*

10. *Id.* The Los Angeles Dodgers entered into a licensing agreement with Major League

team utilized the "Brooklyn Dodgers" name on various promotional items,<sup>11</sup> but none of the uses involved restaurant or tavern services.<sup>12</sup>

The purpose of a trademark<sup>13</sup> is to protect the source of an article and to preclude another person or company from palming off their goods or business as the goods or business of the original source.<sup>14</sup> In conjunction with that purpose, a plaintiff must demon-

Baseball Promotions Co. on April 6, 1981. *Id.* The agreement gave Major League Baseball Promotions Co. the licensing right to use the Brooklyn Dodger name, symbol, and team logo. *Id.* Major League Baseball Promotions Co. was the predecessor to Major League Baseball Properties, Inc. *Id.*

11. *Major League Baseball Properties*, 817 F. Supp at 1115. Promotional items included jackets, t-shirts, sportswear, mugs, lighters, pens, ornaments, and wristbands. *Id.* The Los Angeles Dodgers allowed the mark "Brooklyn" to be used for promotional photographs, commercials, books, and the title of a television series, "Brooklyn Bridge". *Id.* at 1115-16. Additionally, in 1986, Major League Baseball Properties, Inc. started promoting "old-time" trademarks which included the "Brooklyn Dodgers" mark. *Id.* at 1115.

12. Major League Baseball Properties, Inc. 817 F. Supp. at 1116. *See generally* note 123 and accompanying text. The "Brooklyn Dodgers" name is never used on either a restaurant or tavern. *Id.*

13. 15 U.S.C. § 1127 (1988). Section 1127 provides in pertinent part that:

The term 'trademark' includes any word, name, symbol, or device or any combination thereof (1) used by a person, or (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this Act, to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown . . .

15 U.S.C. § 1127.

14. 74 AM. JUR. 2D *Trademarks and Tradenames* § 1 (1969). Congressional intent of a trademark is captured by an opinion written by Justice Holmes in *Prestonettes, Inc. v. Coty*, 264 U.S. 359 (1924). He stated that:

[A trademark] does not confer the right to prohibit the use of the word or words. It is not a copyright . . . A trademark only gives the right to prohibit use of it so far as to protect the owner's goodwill against the sale of another's product as his . . . When the mark is used in the way that does not deceive the public, we see no such sanctity in the word as to prevent its being used to tell the truth . . .

*Id.* at 368.

In *Prestonettes*, the plaintiff, Coty complained that the defendant, *Prestonettes*, used the registered trademark "Coty" and "L'Origan" on toilet powders and perfumes. *Id.* at 366. The United States Supreme Court affirmed the decision of the trial court which allowed the defendant to sell the perfume and toilet powders but ordered them to put labels on the goods which clarified that the items were made by Coty and were independently rebottled by *Prestonettes*. *Id.* at 367. *See Inwood Lab. v. Ives Lab.*, 456 U.S. 844, 854 n.14 (1982) (addressing whether injunctive relief was available when the defendant manufacturer intentionally produced a generic form of the plaintiff's drug, Cyclospasmol); *Hanover Star Milling Co. v. Metcalf*, 240 U.S. 403, 424 (1915) (concluding that trademark infringement existed when the defendant Metcalf intentionally deceived purchasers in believing that the "Tea Rose" flour they were selling was made by Hanover Star Milling Company); *Goodyear's India Rubber Glove Mfg. Co. v. Goodyear Rubber Co.*, 128 U.S. 598, 604 (1888) (stating that relief will not

strate that defendant's use of the trademark in question will cause confusion to the public as to the original owner of the trademark.<sup>15</sup>

Trademark legislation dates back to 1791 when Thomas Jefferson proposed that a record of the name used on an item should be recorded and should be illegal for others to put the same mark on their goods.<sup>16</sup> In 1870, Congress enacted the first federal trademark statute,<sup>17</sup> but the Supreme Court held this act to be unconstitutional in 1879.<sup>18</sup> In 1881 and 1905, Congress promulgated two limited trademark statutes.<sup>19</sup> It was not until July 5, 1946, that President Truman signed a comprehensive trademark act, the Lanham Act.<sup>20</sup> Congress revised the Lanham Act in the Trade-

be awarded where the defendant did not try to represent its goods as those of the plaintiff); *Boston Athletic Ass'n. v. Sullivan*, 867 F.2d 22 (1st Cir. 1989) (holding that the Boston Athletic Association was entitled to injunctive relief when the defendant sold t-shirts bearing the Boston Marathon logo).

15. 15 U.S.C. § 1114. Section 1114 provides in pertinent part that:

Any person who shall, without the consent of the registrant, . . . (a) use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive . . . shall be liable in a civil action by the registrant for the remedies hereinafter provided.

15 U.S.C. § 1114(a). Section 1115(a) provides in pertinent part:

(a) Any . . . mark registered . . . shall be admissible in evidence and shall be prima facie evidence of registrant's exclusive right to use the registered mark in commerce on the goods or services specified in the registration . . .

15 U.S.C. § 1115(a). Section 1117 provides in pertinent part:

When a violation of any right of the registrant of a mark registered in the Patent and Trademark Office, or a violation under section 43(a) of this title, shall have been established in any civil action arising under this chapter, the plaintiff shall be entitled, subject to the provisions of sections 1111 and 1114 of this title, and subject to the principles of equity, to recover (1) defendant's profits, (2) any damages sustained by the plaintiff, and (3) the costs of the action

15 U.S.C. § 1117.

16. Beverly W. Pattishal, *The Constitutional Foundations of American Trademark Law*, 78 TRADEMARK REP. 456, 459 (1988).

17. *Id.* at 459-60.

18. *United States v. Steffens*, 100 U.S. 82 (1879). Congress' authority to enact trademark legislation emanates from the Commerce Clause, requiring that trademarks must be tied to use in interstate commerce. *Id.* This act was deemed unconstitutional because it was based on the Patent and Copyright Clause of the Constitution rather than the Commerce Clause. *Id.* The Patent and Copyright Clause states, "The Congress shall have Power To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." U.S. CONST. art. I, § 8, cl.8.

19. Pattishal, *supra* note 16, at 461-62. These statutes were an act of 1881, which was limited to trademarks made with foreign nations or Indian tribes, and a general trademark legislation of 1905. *Id.*

20. 15 U.S.C. §§ 1051 - 127 (1982). The Lanham Act was originally drafted and intro-

mark Law Revision Act of 1988<sup>21</sup> as well as in November, 1989.<sup>22</sup> Under the Lanham Act, an applicant for a trademark has superior rights to the mark except for those who used the mark or filed an application before an applicant's first filing.<sup>23</sup> Trademarks benefit both consumers and trademark owners.<sup>24</sup> Trademarks protect consumers by allowing them to identify brands and buy them without being confused or deceived.<sup>25</sup> Trademarks also protect trademark owners by preventing others from reaping the benefits of the creator's mark.<sup>26</sup> Once a trademark has been obtained, it can be lost if it is abandoned by the trademark owner.<sup>27</sup>

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duced by Edward S. Rogers in 1924. Pattishall, *supra* note 16, at 462. In 1938, Texas Congressman Fritz Lanham reintroduced the act which eventually passed, following World War II. *Id.*

21. Lanham Act, Pub. L. No 100-667, 100 Stat. 2925 (codified as amended at 15 U.S.C. § 1125(a) (1988)). Section 43(a) of the Lanham Act reads as follows:

(a) 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 of fact which (1) 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 (2) 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.

15 U.S.C. § 1125(a).

22. JANE C. GINSBURG ET AL., TRADEMARK AND UNFAIR COMPETITION LAW 42 (1991). Federal Trademark rights can be acquired provided that an intent to use the mark in commerce is shown versus the prior rule which required that a good be used in commerce before applying for the registration. *Id.* at 215. An applicant who applies for registration under an intent-to-use notion must still actually use the mark prior to gaining registration. Roy H. Wepner, *Intent To Use (or Consequences)*, 131 N.J.L.J. 1270 (1992). The advantage of applying by intent-to-use is that it gives the applicant common law trademark rights as well as constructive use from the date of filing, provided that the mark is eventually used. *Id.* This procedure eliminates "token-use" and strengthens section 1127 of the Lanham Act which defines "use in commerce" as "... a bona fide use of a mark on the ordinary course of trade, and not made merely to reserve a right in a mark" GINSBURG, *supra*, at 214. Section 1051(b) reads, in pertinent part, that "a person who has a bona fide intention, under circumstances showing the good faith of such person, to use a trademark in commerce may apply to register the trademark under this Act on the principal register hereby established." 15 U.S.C. § 1051(b) (1989). The original section, 15 U.S.C. § 1051(a), required actual use in commerce prior to applying for the registration. GINSBURG, *supra* note 22, at 215.

23. Kenneth R. Pierce, *The Trademark Law Revision Act*, 64 FLA. BAR J. 39 (1990).

24. 15 U.S.C. § 1125 (1988).

25. *Id.*

26. *Id.*

27. 15 U.S.C. § 1127. Section 1127 states in pertinent part:

*Major League Baseball Properties, Inc. v. Sed Non Olet Denarius, Ltd.* presented a trademark infringement issue in the United States District Court for the Southern District of New York.<sup>28</sup> The court elaborated on the standard which should be applied under the Lanham Act when determining the likelihood of confusion<sup>29</sup> and abandonment of a trademark.<sup>30</sup>

In *Major League Baseball Properties*, the Los Angeles Dodgers, Inc.<sup>31</sup> (Los Angeles Dodgers) and Major League Baseball Properties, Inc.<sup>32</sup> (Properties) filed a trademark infringement action against three individual defendants, David Sentore, Richard Picardi, and Kevin Boyle, and their corresponding corporations<sup>33</sup>

A mark shall be deemed to be 'abandoned' when either of the following occurs:  
 (1) When its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for two consecutive years shall be prima facie evidence of abandonment. 'Use' of a mark means the bona fide use of that mark made in the ordinary course of trade, and not made merely to reserve a right in a mark.

(2) When any course of conduct of the owner, including acts of omission as well as commission, causes the mark to become the generic name for the goods or services on or in connection with which it is used or otherwise to lose its significance as a mark. Purchaser motivation shall not be a test for determining abandonment

15 U.S.C. § 1127.

28. 817 F. Supp. 1103 (S.D.N.Y. 1993).

29. *W.W.W. Pharmaceutical Co., Inc. v. Gillette Co.*, 984 F.2d 567, 571 (2d Cir. 1993). Plaintiff must show that "an appreciable number of ordinarily prudent purchasers are likely to be misled, or indeed simply confused, as to the source of the goods in question." *Id.* See *Mushroom Makers, Inc. v. R.G. Barry Corp.*, 580 F.2d 44, 47 (2d Cir. 1978) (per curiam), cert. denied, 439 U.S. 1116 (1979) (finding that the defendant's mark "Drizzle" for women's coats did not infringe on the plaintiff's "Drizzler" mark for men's windbreakers because the trademarks were distinct from each other and there was no likelihood of confusion between the two marks). See also *McGregor -- Domiger Inc. v. Drizzle Inc.*, 599 F.2d 1126 (2d Cir. 1979) (holding that there was a substantial difference between women's jackets and golf jackets, and consequently, there was not a trademark infringement).

30. 15 U.S.C. § 1127. See *Cerveceria Centroamericana, S.A. v. Cerveceria India, Inc.*, 892 F.2d 1021, 1023 (Fed. Cir. 1989) (holding that a foreign brewer could cancel another brewer's federally registered trademark on the grounds of abandonment when the mark had not been used for the statutory period of at least two years and the trademark holder failed to rebut the prima facie abandonment). See also *Roulo v. Russ Bernie & Co.*, 886 F.2d 931, 935 (7th Cir. 1989), cert. denied, 493 U.S. 1075 (1990) (finding abandonment is an affirmative defense to trademark infringement); *Societe do Developments et D'Innovations des Agriculteurs v. International Yogurt Co.*, 662 F. Supp. 839, 843 (D.Or. 1987) (concluding that the Lanham Act permits cancellation of a trademark at any time where the registered mark has been abandoned).

31. *Major League Baseball Properties*, 817 F. Supp. at 1110.

32. *Id.* at 1110. Major League Baseball Properties, Inc. was a New York corporation responsible for the official trademark licensing, publishing, and marketing of all Major League Baseball Clubs and items. *Id.*

33. *Major League Baseball Properties, Inc. v. Sed Non Olet Denarius, Ltd.*, 817 F. Supp.

seeking injunctive relief.<sup>34</sup> The United States District Court for the Southern District of New York held that the defendants' use of the Brooklyn Dodger name did not raise a likelihood of confusion<sup>35</sup> and that Los Angeles Dodgers had abandoned the Brooklyn Dodgers name,<sup>36</sup> thereby preventing the Los Angeles Dodgers from having any superior rights to the mark.<sup>37</sup>

In October 1987, following a trademark search,<sup>38</sup> the defendants formed a corporation,<sup>39</sup> and opened a restaurant in Brooklyn, New York, called "The Brooklyn Dodger Sports Bar and Restaurant".<sup>40</sup> On August 9, 1988, the defendants registered the name "The Brooklyn Dodger" as a service mark<sup>41</sup> with the New York Secretary of State.<sup>42</sup> The defendants also registered<sup>43</sup> "The Brook-

1103, 1111 (S.D.N.Y. 1993). David Sentore and Richard Picardi were owners of the three New York based corporations — Sed Non Olet Denarius, LTD. (SNOD), BUMS, Inc., and 9506, Inc. *Id.* Kevin Boyle, also a defendant, was a part owner of the latter two corporations and assisted in forming SNOD. *Id.*

34. *Id.* at 1110. Injunctions are "restraining orders and more definitely as prohibitory writs restraining a person from committing or doing an act, other than a criminal act, which appears to be against equity or conscience." 42 AM. JUR. 2D *Injunctions* § 1 (1969).

35. *Id.* at 1118. Judge Motley found that the Los Angeles Dodgers failed to prove a likelihood of confusion stemming from the defendants' trademark, "The Brooklyn Dodger" even though it is similar to the trademark the Los Angeles Dodgers held while the team was in Brooklyn. *Id.*

36. *Id.* at 1134.

37. *Id.* at 1132. In 1988, the defendant had equal rights with the plaintiff in using and acquiring the "Brooklyn Dodger" trademark. *Id.*

38. *Major League Baseball Properties, Inc. v. Sed Non Olet Denarius, Ltd.*, 817 F. Supp. 1103, 1111-12 (S.D.N.Y. 1993). The trademark search did not uncover any registration of any "Brooklyn Dodger" mark, but the defendants were aware that the Los Angeles Dodgers owned a federal trademark for the word "Dodgers." *Id.*

39. *Id.* at 1112.

40. *Id.* The restaurant opened March 17, 1988. *Id.*

41. 15 U.S.C. § 1127. Section 1127 defines a service mark as:

[A]ny word, name, symbol, or device, or any combination thereof —

(1) used by a person, or (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this Act, to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if that source is unknown .

15 U.S.C. § 1127.

42. *Major League Baseball Properties*, 817 F. Supp. at 1124.

43. 15 U.S.C. § 1051(b). Section 1051 requires in pertinent part that:

A person who had a bona fide intention, under circumstances showing good faith of such person, to use a trademark in commerce may apply to register the trademark under this Act on the principal register hereby established: (1) By filing in the Patent and Trademark Office—(A) a written application, . . . [verifying] applicant's bona fide intention to use the mark in commerce, the goods on or in connection with which the applicant has a bona fide intention to use the mark and the mode or

lyn Dodger" name<sup>44</sup> along with a cartoon character<sup>45</sup> with the United States Patent and Trademark office.<sup>46</sup>

The restaurant's exterior displayed the registered logo on both a sign and an awning.<sup>47</sup> Defendants and their employees wore, sold, and distributed promotional items bearing "The Brooklyn Dodger" logo.<sup>48</sup> The establishment made further use of the logo by dividing the terms "Dodger" and "Brooklyn" and using them separately on merchandise and food products.<sup>49</sup> The inside of the restaurant ex-

manner in which the mark is intended to be used on or in connection with such good, including a statement to the effect that the person making the verification believes himself, [or] in whose behalf he or she makes the verification, to be entitled to use the mark in commerce, and that no other person, firm corporation, or association, to the best of his or her knowledge and belief, had the right to use such mark in commerce either in the identical form of the mark or in such near resemblance to the mark as to be likely, when used on or in connection with the goods of such other person to cause confusion, or to cause mistake, or to deceive . . . (2) By paying in the Patent and Trademark Office the prescribed fee. (3) By complying with such rules or regulation, not inconsistent with law, as may be prescribed by the Commissioner, . . . an applicant who has made use of the mark in commerce may claim the benefit of such use for purposes of this Act, by amending his or her application to bring it into conformity .

15 U.S.C. § 1051(b).

44. *Major League Baseball Properties, Inc. v. Sed Non Olet Denarius, Ltd.*, 817 F. Supp. 1103, 1112 (S.D.N.Y. 1993). Defendants' mark consisted of three words — "The," "Brooklyn," and "Dodger." *Id.* The logo resembled the Los Angeles Dodger mark. *Id.* The two marks shared similar style, script, and color, and made reference to professional baseball. *Id.* at 1113.

Plaintiff's Mark



Defendant's Logo



45. *Id.* The character resembled the Charles Dickens' character, the "Artful Dodger," from the book *Oliver Twist*. *Id.* The defendants used the cartoon to capture the spirit of the "Brooklyn Bum" character who was associated with the Brooklyn Dodger professional baseball team. *Id.* See *Dodger Officials Arrive on Coast*, *supra* note 4, at 40.

46. *Major League Baseball Properties*, 817 F. Supp. at 1112. The defendants filed the service mark application for restaurant and tavern services in Washington D.C. on April 28, 1988. *Id.*

47. *Id.* at 1113.

48. *Id.* The promotional items were "staff shirts," t-shirts, hats, bumper stickers, and gift certificates. *Id.*

49. *Major League Baseball Properties, Inc. v. Sed Non Olet Denarius, Ltd.*, 817 F. Supp. 1103, 1113 (S.D.N.Y. 1993). Employee uniforms included a shirt displaying the name "Dodger Staff." *Id.* Additionally, several menu items, such as, "Dodger Blue" cheese, "Deep Dish Dodg-



hibited memorabilia collected from the Brooklyn Dodgers professional baseball team.<sup>50</sup> Additionally, the defendants drew checks and published advertisements which altered the mark and added an "s" to the end of the Brooklyn Dodger name.<sup>51</sup>

In February 1989, the defendants opened another Brooklyn Dodger Sports Bar and Restaurant.<sup>52</sup> This restaurant closed in November 1990, but the defendants later attempted to open a third establishment with the same name.<sup>53</sup>

Prior to the opening of the first restaurant, Boyle sent a letter to the owner of the Los Angeles Dodgers,<sup>54</sup> Peter O'Malley, seeking O'Malley's "best wishes" for the new restaurant.<sup>55</sup> In July 1988, Boyle also sent a menu exhibiting "The Brooklyn Dodger" logo to the Los Angeles Dodgers.<sup>56</sup> Upon receipt of the menu, the Los An-

er" pizza, "Dodger Seafood Chowder," ribs with "Dodger Sauce," and "Dodger Pee-Wee Pasta" used the "Dodger" name. *Id.*

50. *Id.* at 1114. The defendants decorated the walls with Brooklyn Dodger jerseys, hats, bats, autographed balls, a mural of Ebbets Field, photos, newspaper clippings, and cartoons depicting the Brooklyn Dodgers "Bum" character. *Id.*

51. *Id.*

52. *Id.* BUMS, Inc. formed the restaurant and located it on Coney Island Avenue in Brooklyn, New York. *Id.*

53. *Id.* Corporation 9506 established the third restaurant. *Id.*

54. *Major League Baseball Properties, Inc. v. Sed Non Olet Denarius, Ltd.*, 817 F. Supp. 1103, 1110 (S.D.N.Y. 1993).

55. *Id.* at 1116. Neither the defendants nor the Los Angeles Dodgers have located this letter. Telephone Interview with Ronald G. Russo, Esq., attorney for the defendants (July 26, 1993). The document was referenced by discussions between the two parties. *Id.* The Plaintiffs' included in their evidence another document which made reference to the "best wishes" letter. *Id.* The undated letter is quoted, in pertinent part, as follows:

Dear Peter,

A short time ago you were generous enough to send me a 'Best Wishes' letter to this Yankee fan in Brooklyn . . . As I think I mentioned to you, I'll be opening a restaurant with a heavy sports and nostalgia theme. And since my place will be in Brooklyn, I must forgo [sic] my urge to open a "Yankee Bar" and will, instead, emphasize 'Dem Bums' of yesteryear.

In fact, I intend to call the restaurant 'The Brooklyn Dodger' with the Artful Dodger as part of the logo and theme. I expect our customers who will generally be in their twenties and early thirties will [sic] view our place with curiosity and humor. Certainly, those few people who harbor resentment towards the Dodgers have moved to Long Island . . . or retired to California! And now that Dick Young has died I'm sure most people will forget that the Dodgers played in Brooklyn! Besides, nobody's imagination is vivid enough to picture Steve Garvey in Brooklyn!

Letter from Kevin Boyle, part owner of The Brooklyn Dodger Sports Bar and Restaurant, to Peter O'Malley, owner of the Los Angeles Dodgers (date unknown) (on file with author and the Los Angeles Dodgers).

56. *Major League Baseball Properties*, 817 F. Supp. at 1116. Los Angeles discovered defendants' use of the Brooklyn Dodger logo when plaintiff received a copy of the menu of

geles Dodgers contacted Major League Baseball Properties<sup>57</sup> to investigate a potential trademark infringement.<sup>58</sup> Nine months later, the Los Angeles Dodgers contacted the defendants and claimed that the restaurant was infringing on its trademark and demanded that the tavern cease and desist<sup>59</sup> from further acts of infringement.<sup>60</sup>

Having failed to resolve the conflict with the Brooklyn tavern by March 1990,<sup>61</sup> Major League Baseball Properties and the Los Angeles Dodgers filed trademark infringement causes of action<sup>62</sup> in

defendant SNOD bearing the allegedly infringing mark. *Id.*

57. *Id.* at 1110.

58. *Id.* at 1116. On July 20, 1988, Los Angeles sent the menu to Major League Baseball Properties to investigate potential infringement but asked them to consider the potential negative publicity before taking any actions. *Id.*

59. BLACK'S LAW DICTIONARY 223 (6th ed. 1990). A cease and desist is an order of an administrative agency or court prohibiting a person or business firm from continuing a particular course of conduct. *Id.* See *F.T.C. v. Mandel Bros., Inc.*, 359 U.S. 385 (1959) (requiring the charged party to stop the conduct found illegal and take specified affirmative action designed to remedy the unfair labor practice). *Id.*

60. *Major League Baseball Properties, Inc. v. Sed Non Olet Denarius, Ltd.*, 817 F. Supp. 1103, 1117 (S.D.N.Y. 1993).

61. Mike McAlary, *L.A.'s the Team I Love to Hate*, N.Y. TIMES, July 9, 1993, at 9. In 1990, the Los Angeles Dodgers offered to let Picardi and Boyle use the team's old name and logo for \$1. *Id.* In return, the Los Angeles Dodgers would have become partners in the restaurants. *Id.* The defendants rejected this offer and proclaimed that "if we lose [the threatened suit], we'll just rename the place O'Malley's Revenge." *Id.*

62. *Major League Baseball Properties*, 817 F. Supp. at 1108. The complaint alleged: (a) an infringement upon the rights of plaintiffs' trademarks in violation of 15 U.S.C. § 1114 and § 1115; (b) a wrongful appropriation of plaintiffs' trademarks in violation of 15 U.S.C. § 1125; (c) a violation of plaintiffs' common law trademark and property rights; (d) a violation of plaintiffs' rights under the New York General Business Law § 368-d; (e) unfair competition; and (f) the intentional use by defendants of a counterfeit mark in violation of 15 U.S.C. § 1117(b-f).

*Id.*

Federal and state common laws both protect trademarks. MARGRETH BARRETT, INTELLECTUAL PROPERTY 66 (1991). Barrett stated that:

The Lanham Act draws from the common law in determining what qualifies as a mark, who qualifies as an owner of a mark, and what constitutes infringement of a mark, but provides enhanced legal rights, beyond what is provided at common law, to mark owners who register their trademarks on the Lanham Act Principal register.

*Id.*

The term "unfair competition" applies to the improper behavior of businesses that injure the reputation and good will of others. *Id.* at 107. Federal causes of action for trademark infringement are derived from the common law of "passing off," which occurs when a defendant makes a false representation leading consumers to believe that the defendant's goods or services come from the plaintiff. *Id.*

New York State's common laws of unfair competition share many of the same elements with the Lanham Act for trademark infringement. *Major League Baseball Properties*, 817 F. Supp. at 1135. This includes proof of actual confusion before an award of damages may be

the United States District Court for the Southern District of New York against the three corporate defendants as well as the three individual defendants, Sentore, Picardi, and Boyle, alleging misuse of the trademark "The Brooklyn Dodger".<sup>63</sup> Defendants denied any infringement violations and pleaded the affirmative defense of abandonment<sup>64</sup> and laches.<sup>65</sup> In addition, the defendants filed a counterclaim.<sup>66</sup>

On July 29, 1991, plaintiffs filed a motion seeking a preliminary injunction to prevent the use of the names "Brooklyn Dodger" and "Dodger" in regard to the opening of the defendants' third establishment.<sup>67</sup> On March 31, 1992, Judge Wood, originally assigned to hear the case, granted a preliminary injunction.<sup>68</sup> The court denied the plaintiffs' motion for summary judgment<sup>69</sup> and amended the plaintiffs' damage claim to include only injunctive relief and the destruction of all objects which used "The Brooklyn Dodger" trademark.<sup>70</sup> Subsequent to a preliminary hearing, a bench trial ensued

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granted. *Id.* New York's anti-dilution statutes provides, in pertinent part:

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

N.Y. GEN. BUS. LAW § 368-d (McKinney 1984).

63. *Major League Baseball Properties*, 817 F. Supp. at 1108.

64. *Id.* at 1109. Defendants' based their abandonment defense on the fact that plaintiff failed to make any commercial or trademark use of the disputed trademark for over 25 years. *Id.* See 15 U.S.C. § 1127.

65. *Major League Baseball Properties, Inc. v. Sed Non Olet Denarius, Ltd.*, 817 F. Supp. 1103, 1109 (S.D.N.Y. 1993). Laches is neglect to assert a right or claim which, taken together with lapse of time and other circumstances causing prejudice to adverse party, operates as bar in court of equity. BLACK'S LAW DICTIONARY 875 (6th ed. 1990).

The Los Angeles Dodgers and Major League Baseball Properties failed to act on the alleged infringement for over a year and a half. *Major League Baseball Properties*, 817 F. Supp. at 1109. Over this time, the defendants relied on the mark. *Id.*

66. *Major League Baseball Properties*, 817 F. Supp. at 1109. The defendants sought cancellation of various "Brooklyn Dodgers" trademark registrations which the plaintiffs filed after the defendants' April, 1988, trademark application. *Id.* In 1989 the Los Angeles Dodgers and Major League Baseball filed registrations for three different "Brooklyn Dodgers" trademarks. *Id.* at 1109 n.2. Additionally, in July 1992, the plaintiffs filed a trademark for "Brooklyn" in athletic script. *Id.*

67. *Id.* at 1109.

68. *Id.*

69. *Id.* Summary judgment is a procedure "designed for the prompt disposition of the action where there is no genuine issue regarding any material facts." 73 AM. JUR. 2D *Summary Judgment* § 2 (1969).

70. *Major League Baseball Properties, Inc. v. Sed Non Olet Denarius, Ltd.*, 817 F. Supp.

presided by Judge Motley.<sup>71</sup>

Judge Motley, writing for the court, held that the plaintiffs had not shown actual confusion or likelihood of confusion arising from the defendants' use of "The Brooklyn Dodger" trademark.<sup>72</sup> The court further concluded that the plaintiffs' failure to use the "Brooklyn Dodgers" trademark for over twenty-five years was equivalent to abandoning the mark.<sup>73</sup>

The leading case on trademark infringement prior to the passage of the Lanham Act was *Aunt Jemima Mills Co. v. Rigney & Co.*<sup>74</sup> *Aunt Jemima* presented the Court of Appeals for the Second Circuit with the issue of whether injunctive relief for trademark infringement was available when two different products that were often used together shared the same name.<sup>75</sup> The court held that injunctive relief was available provided that the different goods were used in relation to one another, and that by using the same mark on the goods, the second user sought to reap the benefits of the first user's reputation or advertising, or that the second user

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1103, 1109 (S.D.N.Y. 1993). Section 1118 of the Lanham Act provides, in pertinent part:

In any action arising under this chapter, in which a violation of any right of the registrant of a mark registered in the Patent and Trademark Office or a violation under section 43(a), shall have been established, the court may order that all labels, signs, prints, packages, wrappers, receptacles, and advertisements in the possession of the defendant, bearing the registered mark or, in the case of a violation of section 43(a), the word, term, name, symbol, device, combination thereof, designation, description, or representation that is the subject of the violation, or any reproduction, counterfeit copy, or colorable imitation thereof, and all plates, molds, matrices, and other means of making the same, shall be delivered up and destroyed.

15 U.S.C. § 1118.

71. *Major League Baseball Properties*, 817 F. Supp. at 1109. The trial was conducted from May 18, 1992, to May 21, 1992. *Id.*

72. *Id.* at 1126. Judge Motley stated that the ". . . plaintiffs have failed to prove by a fair preponderance of the credible evidence, actual confusion, or a likelihood of confusion between plaintiffs' 'Brooklyn Dodgers' mark as used by them in Brooklyn and defendants' 'The Brooklyn Dodger' mark." *Id.*

73. *Id.* at 1134. *See Mission Dry Corp. v. Seven-up Co.*, 193 F.2d 201 (CCPA 1951) (holding that the Lanham Act allows for the cancellation of the registration of any abandoned mark regardless of whether the marks of the parties were confusingly similar).

74. 247 F. 407 (2d Cir. 1917).

75. *Id.* *Aunt Jemima Mills Co.*'s predecessor Davis Milling Co. had registered the trademark "Aunt Jemima's" for the use of flour in 1906. *Id.* at 408. In 1908, defendant Rigney & Co. registered the same name for syrups and sugar creams. *Id.* When Davis Milling Co. was made aware of the registration, they wrote to Rigney & Co. and said that they believed that Rigney & Co. could use the name without violating any laws. *Id.* Rigney & Co. adopted the trademark upon the advice of counsel and in full belief that they had a right to use it for their specific products. *Id.*

prevented the first user from extending his business into a market which the second user had begun to exploit.<sup>76</sup> Judge Ward, writing for the majority, reversed the lower court's decision and granted Aunt Jemima Mills Co. injunctive relief.<sup>77</sup> In a dissenting opinion, Judge Hand stated that Rigney & Co. had received constructive consent to use the name by being in business for nearly eight years prior to the cause of action.<sup>78</sup> For the court to then stop the defendant from using the mark was inconsistent with prior case law which holds that relief should be prevented due to laches.<sup>79</sup>

In *S.C. Johnson & Son, Inc. v. Johnson*,<sup>80</sup> the Court of Appeals for the Second Circuit addressed the issue of whether the Lanham Act should be read literally in regard to granting injunctive relief for trademark infringement between two items with dissimilar properties.<sup>81</sup> In *S.C. Johnson*, the plaintiff, owner of the registered mark "Johnson's", which was used on floor wax and polishes, sought injunctive relief against the defendant from using the name Johnson on his cleaning fluid products.<sup>82</sup> The court held that de-

76. *Id.* at 409. The lower court concluded that a trademark may be appropriated by anyone in any market for goods not in competition with those of prior use. *Aunt Jemima Mills Co. v. Rigney & Co.*, 234 F. 804 (E.D.N.Y. 1916). While the court of appeals held that even though the goods, flour, and syrup were different, they were both food products and were commonly used together. *Aunt Jemima Mills Co. v. Rigney & Co.*, 247 F. 407, 410 (2d Cir. 1917). The court determined that the public would perceive that the products came from a single source. *Id.*

77. *Id.* at 409. Where the defendant knowingly adopted as a trademark and name for its syrup a trademark and name extensively advertised by complainants predecessor for flour, "the adoption must have been either to get the benefit of the complainant's reputation or to get the benefit of the advertising of the flour or to forestall an extension of its trade." *Id.*

78. *Id.* at 412 (Hand, J., dissenting).

79. *Id.* (Hand, J., dissenting). See *Creswell v. Knights of Pythias*, 225 U.S. 246, 261 (1911) (holding that because of laches, injunctive relief would be inequitable). *Id.*

80. 175 F.2d 176 (2d Cir. 1949).

81. *Id.* at 179. The conflict arose as a result of a different interpretation of the Lanham Act and the Trademark Act of 1905. *Id.* The Lanham Act states:

Any person who shall in commerce (a) use . . . any reproduction . . . of a registered mark, which use is likely to cause confusion or mistake or deceive purchasers as to the source or origin.

*Id.* at 178 (citing 15 U.S.C. § 1125). This is compared to the parallel section of the Trademark Act of 1905:

[Trademark infringement] only [applies to] those who should 'affix' the registered mark to merchandise of substantially the same descriptive properties as those set forth in the registration.

*Id.* at 178.

82. *Id.* at 176. In 1932, defendant John W. Johnson began using the Johnson name on his products. *Id.* at 180. In 1941, the plaintiff originally tried unsuccessfully to stop the defendant from using the mark. *Id.* The court held that even though confusion existed, the

spite the fact that some confusion existed, injunctive relief was not available because the plaintiff's reputation was not tarnished.<sup>83</sup>

Judge Clark issued a vigorous dissent in *S.C. Johnson*,<sup>84</sup> asserting that Congress did not intend the Lanham Act to be declaratory of existing law.<sup>85</sup> Read literally, the Lanham Act grants recov-

resulting prejudice to the plaintiff did not counterbalance defendant's interest in doing business under his own name. *Id.* (citing from the 1941 case, *S.C. Johnson & Son, Inc. v. Johnson*, 116 F.2d 427, 430 (2d Cir. 1940)). A second suit followed after the passage of the Lanham Act. *S.C. Johnson*, 175 F.2d at 178.

83. *Id.* at 180. The *S.C. Johnson* court held that:

The mere fact of confusion should not in itself tip the scales in favor of the prior user. Here, the court reasoned that since the plaintiff did not sell cleaning fluids, but only made waxes and other polishes, the defendant could not possibly turn away customers who would buy these instead of the cleaning fluids.

*Id.*

Writing for the majority of the court, Judge Hand concluded:

[I]f Congress really meant to allow every first user of a mark so to stifle all excursions into adjacent markets upon showing no more than that confusion would result, it seems to us that it would have said so more clearly.

*Id.*

84. *Id.* at 180. (Clark, J., dissenting). The dissent believed that under the language of the newly enacted Lanham Act, relief should be granted wherever a violator intended to use a mark to cause confusion or mistake or deceive purchasers. *Id.*

85. *Id.* at 182. (Clark, J., dissenting). Judge Clark concluded that Congress' intention was to codify the Restatement of Torts rather than follow the existing precedent under the Trademark Act of 1905. *Id.* at 182 n.7. Section 730 of the Restatement of Torts states:

The interest in a trademark is protected with reference to (a) competing goods, services or businesses, and (b) other goods, services or businesses which, in view of the designation used by the actor, are likely to be regarded by prospective purchasers as associated with the source identified by the trademark or trade name.

RESTATEMENT OF TORTS § 730 (1938). Section 731 states, in pertinent part:

In determining whether one's interest in a trademark or trade name is protected the following factors are important:

- (a) the likelihood that the actor's goods, services or business will be mistaken for those of the other;
- (b) the likelihood that the other may expand his business so as to compete with the actor;
- (c) the extent to which the goods or services of the actor and those of the other have common purchasers or users;
- (d) the extent to which the goods or services of the actor and those of the other are marketed through the same channel;
- (e) the relation between the functions of the goods or services of the actor and those of the other;
- (f) the degree of distinctiveness of the trademark or trade name;
- (g) the degree of attention usually given to trade symbols in the purchase of goods or services of the actor and those of the other;
- (h) the length of time during which the actor has used the designation;
- (i) the intent of the actor in adopting and using the designation.

ery of trademark infringement when the mark is used to cause confusion or to deceive purchasers as to the source of the product.<sup>85</sup>

Thirteen years later, in *Polaroid Corp. v. Polarad Elec. Corp.*,<sup>87</sup> the United States Court of Appeals for the Second Circuit addressed whether a trademark should be protected with respect to goods other than those to which its owner has applied for protection.<sup>88</sup> Judge Friendly, writing for the majority, stated that since confusion existed as to the interpretation of the law,<sup>89</sup> the court adopted a multi-variable test<sup>90</sup> to determine whether a plaintiff will be protected when suing for trademark infringement between different products.<sup>91</sup> The court decided that an owner's only interests in preventing the use of his mark in an unrelated good is that he may want to enter the market of the unrelated good at a later time or prevent his reputation from being used or damaged by the unrelated good.<sup>92</sup> As a result, the court ruled that even though the plaintiff's trademark was strong and the similarity between the two marks was great, the evidence of actual confusion was not suffi-

RESTATEMENT OF TORTS § 731.

86. *S.C. Johnson*, 175 F.2d at 182 (Clark, J., dissenting). As the facts indicate, defendant was permitted to reap the rewards of the diligence and money expended by the original exploiter. *Id.* at 183.

87. 287 F.2d 492 (2d Cir. 1961).

88. *Id.* at 495. Polaroid Corporation alleged that Polarad Electronics' use of the name Polarad as a trademark and as part of its corporate title infringed on plaintiff's trademark. *Id.* at 493.

89. *Id.* at 495.

90. *Id.* The court adopted a multi-variable test from Restatement of Torts, §§ 729, 730, 731. *Id.* The test included:

- (1) the strength of the mark;
- (2) the degree of similarity between the two marks;
- (3) the proximity of the products;
- (4) the likelihood that the prior owner will bridge the gap;
- (5) actual confusion;
- (6) the reciprocal of defendants good faith in adopting its own mark;
- (7) the quality of the defendants product; and
- (8) the sophistication of the buyers.

*Id.*

Even this extensive list does not exhaust the possibilities and the court may have to take other variables into account. *Id.* See generally David Goldberg & William Borchard, *Related Goods Trademark Cases in the Second Circuit*, 70 TRADEMARK REP. 287 (1980); David Goldberg et al., *Mushrooms Revisited: More on Related Goods in the Second Circuit*, 74 TRADEMARK REP. 207 (1984).

91. *Id.* After addressing and weighing the eight factors, the court determined that the defendant's use of the mark did not infringe upon the plaintiff's Polaroid trademark. *Id.*

92. *Polaroid Corp. v. Polarad Elec. Corp.*, 287 F.2d 492, 497 (2d Cir. 1961).

ciently persuasive and precluded the plaintiff from any relief.<sup>93</sup>

In *Abercrombie & Fitch Co. v. Hunting World, Inc.*,<sup>94</sup> the United States Court of Appeals for the Second Circuit defined the terms deserving of trademark protection under the Lanham Act.<sup>95</sup> Judge Friendly, writing for the majority determined that the plaintiff's mark had become generic in regard to certain items<sup>96</sup> and was not entitled to trademark protection.<sup>97</sup> The court concluded that although generic terms are not protected,<sup>98</sup> descriptive words which have acquired a secondary meaning<sup>99</sup> are protected under the

93. *Id.* at 493.

94. 537 F.2d 4 (2d Cir. 1976). Abercrombie & Fitch Co. filed suit for trademark infringement against Hunting World, Inc. for the use of the registered trademark "safari" pertaining to clothing and other articles. *Id.*

95. *Id.* at 9. Types of categories considered included:

- (1) generic - A generic term actually defines the product or service and is never available for trademark protection;
- (2) descriptive - Identifies a significant characteristic of a good or service. Descriptive marks may be protected provided that they become distinctive and acquire secondary meaning;
- (3) suggestive - If a mark conveys the nature of the product only through the exercise of imagination, thought, or perception, it is suggestive. If a mark is suggestive, there is no need for proof of secondary meaning [for registration] as long as it is not primarily descriptive; and,
- (4) fanciful or arbitrary - A word is fanciful if it was invented solely for the use of a trademark. While it is labeled arbitrary if the word is common but is applied in an unfamiliar way.

ARTHUR R. MILLER & MICHAEL H. DAVIS, INTELLECTUAL PROPERTY PATENTS, TRADEMARKS, AND COPYRIGHT 167-68 (1990).

96. *Abercrombie*, 537 F.2d at 12. The word "safari" in connection to wearing apparel is widely used by the general public and people in the trade, but the word "safari" as used in relation to the plaintiff's boots is protected. *Id.*

97. *Id.* at 14.

98. *Id.* at 9. According to Judge Friendly, "A generic term is one that refers to the genus of which the particular product is a species." *Id.* This type of term can not be given legal protection. *Id.* A competing manufacturer can not be deprived of using the generic name for its product. *Id.* See *W.E. Basset Co. v. Revlon, Inc.*, 435 F.2d 656 (2d Cir. 1970) (holding that the word "spoon" as part of the title of a product was generic and was not registrable).

99. *Id.* at 10. Section 1052 of the Lanham Act provides, in pertinent part:

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on principal register on account of its nature unless it —

- (a) Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute;
- (b) Consists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof;



Lanham Act.<sup>100</sup>

The court's multivariable balance test<sup>101</sup> used in determining the likelihood of confusion is not exclusive and may be expanded.<sup>102</sup> In *Centaur Communications, Ltd. v. A/S/M Communications*,<sup>103</sup> the United States Court of Appeals for the Second Circuit addressed the issue of what standard should be used when determining the likelihood of confusion in a trademark infringement suit.<sup>104</sup> The court expanded the test developed in *Polaroid* by setting forth three additional factors.<sup>105</sup> Writing for the majority, Judge Cardamone, after analyzing each factor, granted injunctive relief because a likelihood of confusion existed as to the source of

(c) Consists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent, or the name, signature, or portrait of a deceased President of the United States during the life of his widow, if any except by the written consent of the widow;

(d) Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when applied to the goods of the applicant, to cause confusion, or to cause mistake, or to deceive;

...  
 (f) Except as expressly excluded in paragraphs (a)-(d) of this section, nothing in this chapter shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce. The Commissioner may accept as *prima facie* evidence that the mark had become distinctive, as applied to the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years next preceding the date of the filing of the application for its registration.

15 U.S.C. § 1052 (1982).

100. *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 10 (2d Cir. 1976).

101. *Id.*

102. *Id.*

103. 830 F.2d 1217 (2d Cir. 1987).

104. *Id.* at 1217. Publisher of "Marketing Week" magazine brought a trademark infringement suit against publisher of "ADWEEKS Marketing Week." *Id.* The lower court decision found that Centaur Communications, Ltd. established that the phrase "Marketing Week," was a protectable trademark and that A/S/M Communications, Inc. infringed on the mark by using the name "ADWEEK's Marketing Week" for the name of its publication. *Centaur Communications, Ltd. v. A/S/M Communications, Inc.*, 652 F. Supp. 1105 (S.D.N.Y. 1987).

105. *Centaur*, F.2d at 1228 n.2. The list of *Polaroid* factors are not exclusive. *Id.* The court also looked at (1) the nature of the senior user's priority, (2) its delay in asserting its claim, and (3) the balance of harm and benefit that would result from granting an injunction against the junior user's use of the mark. *Id.* See *Chandon Champagne Corp. v. San Marino Wine Corp.*, 335 F.2d 531, 536 (2d Cir. 1964). In *Chandon Champagne Corp.*, the court addressed these factors in finding that the plaintiff were not entitled to relief when defendant had used the plaintiff's name without consulting the plaintiff first. *Id.* The court stressed that, "against these legitimate interests of the senior user are to be weighed the legitimate interests of the innocent second user and that we must balance the conflicting interests both parties have in the unimpaired continuation of their trade mark use." *Id.*

who produced the magazines, "Marketing Week" and "ADWEEK's Marketing Week".<sup>105</sup> Judge Sprizzo concurred with the decision but expressed disapproval with the court's view of the likelihood of confusion test.<sup>107</sup>

Similarly, in *W.W.W. Pharmaceutical, Co. v. Gillette Co.*,<sup>108</sup> the United States Court of Appeals for the Second Circuit faced the issue of whether reverse confusion<sup>109</sup> between the sources of a trademark constituted sufficient confusion to recover damages for trademark infringement.<sup>110</sup> When deciding if confusion existed, the court adhered to precedent and applied the *Polaroid* multi-variable balance test.<sup>111</sup> Judge Oakes concluded that in order to recover damages, real and precise actual consumer confusion is required.<sup>112</sup> In this instance, *W.W.W. Pharmaceutical Company* had not shown the level of confusion needed for recovery.<sup>113</sup>

106. *Centaur*, 830 F.2d at 1228-29.

107. *Id.* at 1219. (Sprizzo, J., concurring). In his concurrence, Judge Sprizzo stated: [T]hat he disagreed with the majority's view that the factors for the likelihood of confusion were merely 'the right formula' akin to Ali Baba's magical incantation 'open sesame' . . . [The] ultimate conclusion as to whether likelihood of confusion exists is not to be determined in accordance with some rigid formula.

*Id.* at 1230 (Sprizzo, J., concurring).

108. 984 F.2d 567 (2d Cir. 1993).

109. *Id.* at 571. Reverse confusion is the injuring of the reputation of a prior user of a mark by misleading potential customers to consider the prior user as a trademark infringer. *Id.*

110. *Id.* at 567. In *W.W.W. Pharmaceutical*, the owner of the trademark "Sport Stick" lip balm brought action under the Lanham Act for trademark infringement against the owner of the mark "Right Guard Sport Stick" deodorant. *Id.* *W.W.W. Pharmaceutical Company* alleged that *Gillette's* use of the name "Sport Stick" caused *W.W.W. Pharmaceutical Company's* potential customers to assume that *Gillette* was the source of *W.W.W. Pharmaceutical Company's* mark and to believe that *W.W.W. Pharmaceutical Company* was the infringer. *Id.* at 571.

111. *Id.* at 571.

112. *Id.* at 576 n.6.

113. *W.W.W. Pharmaceutical Co. v. Gillette Co.*, 984 F.2d 567, 576 (2d Cir. 1993). Judge Oakes stated:

[P]laintiff's view of the reverse confusion doctrine is overly expansive. Plaintiff claims that the reverse confusion theory of liability prevents a larger, more successful defendant company from extensively promoting a similar mark in such a way that plaintiff's trademark is 'swallowed-up, digested and destroyed for plaintiff's use. . . . However, where the parties are using similar marks on different products and where the balance of considerations ensures against a likelihood of confusion, the law does not give the plaintiff exclusive rights to usage of a particular trademark.

*W.W.W. Pharmaceutical Co. v. Gillette Co.*, 984 F.2d 567, 576 (2d Cir. 1993) (quoting *W.W.W. Pharmaceutical Co. v. Gillette Co.*, 808 F. Supp. 1013, 1025-26 (S.D.N.Y. 1992) (quoting *Information Clearing House, Inc. v. Find Magazine*, 492 F. Supp. 147, 163 (S.D.N.Y.

In *Major League Baseball Properties*, the court, in determining whether a likelihood of confusion existed between the Los Angeles Dodgers and the owners of the tavern, followed the precedent set by the United States Court of Appeal for the Second Circuit and applied the factors established in *Polaroid*.<sup>114</sup> The court found the first and second factors in plaintiffs' favor.<sup>115</sup> It concluded that "The Brooklyn Dodger" mark was readily linked<sup>116</sup> by the public to the former Brooklyn Dodgers baseball team.<sup>117</sup> As a result, the mark was strong<sup>118</sup> and worthy of protection.<sup>119</sup> The court also found that the trademark was similar<sup>120</sup> to "The Brooklyn Dodgers" mark used by the plaintiff.<sup>121</sup>

Writing for the court in *Major League Baseball Properties*, Judge Motley determined that the parties did not share a common name, were not competing with each other, and were in totally separate markets.<sup>122</sup> The court also determined that since Los Angeles and Properties never ran or owned a restaurant or bar,<sup>123</sup>

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1980))).

114. *Major League Baseball Properties, Inc. v. Sed Non Olet Denarius, Ltd.*, 817 F. Supp. 1103, 1118 (S.D.N.Y. 1993).

115. *Id.* at 1118.

116. See MILLER & DAVIS, *supra* note 95 and accompanying text.

117. *Major League Baseball Properties*, 817 F. Supp. at 1119.

118. *Id.* at 1118. See *W.W.W. Pharmaceutical Co., v. Gillette Co.*, 984 F.2d 567, 572 (2d Cir. 1993). In *W.W.W. Pharmaceutical*, the United States Court of Appeals for the Second Circuit held that the strength of the mark is determined by "the distinctiveness of the mark, or more precisely, its tendency to identify the goods sold under the mark emanating from a particular, although possibly anonymous source." *Id.* A mark's strength is determined by its "origin-indicating" quality. *Id.* Two factors determine the strength of a mark: (1) degree to which it is inherently distinctive; and (2) the degree to which it is distinctive in the marketplace. *Id.* at 572.

119. *Major League Baseball Properties, Inc. v. Sed Non Olet Denarius, Ltd.*, 817 F. Supp. 1103, 1119 (S.D.N.Y. 1993).

120. *Id.* at 1120. The defendants' "The Brooklyn Dodger" mark was basically the same as the plaintiffs' "Brooklyn Dodgers" logo. *Id.* They both shared the same color and script. *Id.* See *W.W.W. Pharmaceutical*, 984 F.2d at 573 (questioning whether similarity of the marks is likely provoked confusion among customers).

121. *Major League Baseball Properties*, 817 F. Supp. at 1120.

122. *Id.* See *Lang v. Retirement Living Pub Co.*, 949 F.2d 576, 582 (2d Cir. 1991) (stating that when goods or trade names have the same purpose, used generally the same, or are used with each other, the use in similar designation is likely to cause confusion). See also *Transamerica Corp. v. Transamerica Abstract*, 689 F. Supp. 1067, 1074 (E.D.N.Y. 1988) (holding that issues of trademark infringement did exist so as to preclude summary judgment).

123. *Major League Baseball Properties*, 817 F. Supp. at 1121. Los Angeles Dodgers and Major League Baseball Properties have never operated a sports bar or restaurant and have never indicated a desire to do so. *Id.*

they did not intend to "bridge the gap"<sup>124</sup> and enter the defendants' field of operation.<sup>125</sup>

Since plaintiffs sought injunctive relief, only the likelihood of confusion needed be proven.<sup>126</sup> However, the lack of actual confusion may be used to infer that the likelihood of confusion does not exist.<sup>127</sup> Plaintiff used a survey in order to demonstrate confusion as to the source of ownership on the part of local Brooklyn residents.<sup>128</sup> The court ruled that the survey was flawed and failed to prove actual confusion.<sup>129</sup> The proof further indicated that defendants' actions were taken in good faith<sup>130</sup> and with no intent to capitalize on plaintiffs' reputation.<sup>131</sup> The court deter-

124. *W.W.W. Pharmaceutical Co. v. Gillette Co.*, 988 F.2d 567, 574 (2d Cir. 1993) (citing *Scarves by Vera, Inc. v. Todo Imports, Ltd.*, 544 F.2d 1167, 1172 (2d Cir. 1976)). To "bridge the gap" refers to a senior users interest in being able to enter a related field at some future time. *Id.*

125. *Major League Baseball Properties, Inc. v. Sed Non Olet Denarius, Ltd.*, 817 F. Supp. 1103, 1121 (S.D.N.Y. 1993). Since the Los Angeles Dodgers and Major League Baseball have not "bridged the gap" for over 100 years, there is no evidence that they intend to "bridge the gap" in the future. *Id.*

126. *Id.* (citing *W.W.W. Pharmaceutical Co. v. Gillette Co.*, 808 F. Supp. 1013, 1021 (S.D.N.Y. 1992) *aff'd*, 984 F.2d 567 (2d Cir. 1993)).

127. *Major League Baseball Properties*, 817 F. Supp. at 1122. See *W.W.W. Pharmaceutical*, 808 F. Supp. at 1024 (citing *Plus Products v. Plus Discount Foods, Inc.*, 722 F.2d 999, 1006 (2d Cir. 1993) stating that without evidence of actual confusion over a several-year period is a strong implication that the likelihood of confusion is nominal); *Universal City Studios v. T-Shirt Gallery, Ltd.*, 634 F.Supp. 1468, 1478 (S.D.N.Y. 1986) (holding that no likelihood of confusion can be inferred from the absence of any evidence of actual confusion).

128. *Major League Baseball Properties*, 817 F. Supp. at 1122.

129. *Id.* at 1123. The court found that the surveys used by the plaintiff to show actual confusion were flawed and lacked any value. *Id.* The defendants retained Dr. Michael Rappoport, who concluded that questions 5(a) and 5(b) of the survey "do not yield any meaningful evidence with regard to the remaining issue of likelihood of sponsorship or authorization." *Id.* The two questions read as follows:

5(a). Do you believe that the restaurant had to get authorization, that is, permission to use the name, "The Brooklyn Dodger?"

5(b). From whom did they have to get authorization, that is permission?

*Id.* The expert concluded that because of the leading nature of the questions and the lack of a "Don't Know" option, the survey was flawed and did not show that the public believed that the restaurant was authorized or got permission to use the name from the plaintiffs. *Id.*

130. *Major League Baseball Properties, Inc. v. Sed Non Olet Denarius, Ltd.*, 817 F. Supp. 1103, 1124 (S.D.N.Y. 1993). Defendants properly registered the mark with the New York State Secretary of State and properly filed application with the U.S. Patent and Trademark office. *Id.* In addition, they informed the owner of the Los Angeles Dodgers of their intentions to use "The Brooklyn Dodger" name. *Id.* See *Edison Bros. Store, Inc. v. Cosmar, Inc.*, 651 F. Supp. 1547, 1560 (S.D.N.Y. 1987) (holding that even if a junior user had notice of a senior mark, this is not an indication of bad faith).

131. *Major League Baseball Properties*, 817 F. Supp. at 1124. Defendants made no effort to capitalize on plaintiffs' reputation. *Id.* In fact, some Brooklynites are still bitter about the

mined that based on the sophistication of the restaurant patrons, virtually no chance existed that a customer of the restaurant would think that the Los Angeles ball club and restaurant were related.<sup>132</sup>

Additionally, the court considered the three "Centaur Factors".<sup>133</sup> The court found that the plaintiff resumed use of the trademark in only a limited capacity in 1981, seven years prior to defendants' usage of the trademark.<sup>134</sup> The plaintiffs' suit was untimely,<sup>135</sup> and all issues considered, equity favored the defendants.<sup>136</sup> The court concluded that the plaintiffs did not prove a likelihood of confusion but did acquire the mark to the extent of their resumed use.<sup>137</sup>

The court addressed the defendants' affirmative defense<sup>138</sup> of abandonment<sup>139</sup> and determined that the plaintiffs' occasional noncommercial uses<sup>140</sup> of the trademark between 1958 and 1981

*Dodgers departure to Los Angeles and continue to despise the Los Angeles Dodgers and the O'Malley family. Id.* Judge Motley stated:

. . . the trial testimony establishes that, given the notoriety of Los Angeles's departure from Brooklyn and the ill will that flows from that event even to this day, trading upon Los Angeles' 'good will' in Brooklyn would have been fatal to defendants because many Brooklynites despise the Los Angeles Dodgers.'

*Id.*

132. *Id.* at 1125. See *W.W.W. Pharmaceutical, Co. v. Gillette Co.*, 984 F.2d 567, 575 (2d Cir. 1993).

133. *Major League Baseball Properties*, 817 F. Supp. at 1125.

134. *Id.* at 1125.

135. *Major League Baseball Properties, Inc. v. Sed Non Olet Denarius, Ltd.*, 817 F. Supp. 1103, 1125 (S.D.N.Y. 1993). Plaintiffs learned of defendants' intentions in July 1988 and failed to take any action until April 1989. *Id.*

136. *Id.* at 1125-26. Judge Motley concluded that:

[p]laintiff [Major League Baseball] Properties might have found a way, between 1958 and 1989, of taking the simple and expedient step of filing an application for trademark registration . . . as it plainly did for each of the twenty-six (26) other [Major League Baseball] names in its collection. Having moved away from Brooklyn in 1957, having failed to put the 'Brooklyn Dodgers' mark to a trademark use of at least two decades and having failed to file an application to register the 'Brooklyn Dodgers' mark until 1989, the court concludes that equities lie in defendants' favor.

*Id.* at 1126.

137. *Id.* at 1136. The plaintiffs resumed use included clothes, novelty items, and promotional features. *Id.*

138. *Id.* at 1126. See *Roulo v. Russ Berrie & Co.*, 886 F.2d 931, 935 (7th cir.), cert. denied, 493 U.S. 1075 (1990) (stating that abandonment is an affirmative defense to trademark infringement and that once abandonment is shown, the burden shifts to the owner of the mark to explain the nonuse or intent to resume use of the mark).

139. 15 U.S.C. § 1127.

140. *Major League Baseball Properties, Inc. v. Sed Non Olet Denarius, Ltd.*, 817 F. Supp. 1103, 1127 (N.Y.S.D. 1993). See *Silverman v. CBS, Inc.*, 870 F.2d 40, 47 (2d Cir. 1989), cert.

established a *prima facie* case<sup>141</sup> for abandonment.<sup>142</sup> The court rejected plaintiffs' contention that the mark was actually "Dodgers" and concluded that "The Brooklyn Dodger" name was the issue at bar.<sup>143</sup>

Since the requirements for *prima facie*<sup>144</sup> abandonment were satisfied, the court looked to whether the plaintiff at the time of the abandonment intended to resume use<sup>145</sup> of the mark.<sup>146</sup> Judge Motley concluded that plaintiffs' failed to show any intent to resume use of the mark for nearly a quarter century,<sup>147</sup> even though the plaintiff did use the trademark in a limited capacity<sup>148</sup> prior to

*denied*, 492 U.S. 907 (1989) (finding that noncommercial activities will not establish the necessary "use" required for a trademark infringement case). In *Silverman*, it was concluded that sporadic licensing for noncommercial activities does not constitute use. *Id.* The court also found no merit in CBS's claims that they did not abandon the name of the former radio and television show, 'Amos & Andy,' since they had licensed the program noncommercially and periodically considered to resume broadcasting the program. *Id.*

141. 15 U.S.C. § 1127. *Prima facie* abandonment is found when a trademark is not used for two consecutive years. *Id.* See *Stetson v. Howard D. Wolf & Assoc.*, 955 F.2d 847, 850 (2d Cir. 1992) (holding that a defendant who did not cease using his trademark for the two year statutory period precluded the claim of trademark abandonment); see also *Cervceria Centroamericana, S.A. v. Cervceria India, Inc.*, 892 F.2d 1021, 1023 (Fed. Cir. 1989) (stating nonuse for more than two years is *prima facie* abandonment). *Id.*

142. *Major League Baseball Properties*, 817 F. Supp. at 1127. Evidence at trial showed absolutely no commercial use of the mark from 1958 to 1981. *Id.* When the team moved from Brooklyn to Los Angeles, the club changed its name thereby affecting the essential element of the mark. *Id.* The team did not use the marks concurrently, rather "Los Angeles" replaced "Brooklyn." *Id.* at 1128.

143. *Id.* The court noted that:

[i]t is not simply the "Dodgers" . . . that the defendants seek to invoke in their restaurant; rather defendants specifically seek to recall the nostalgia of the cultural institution that was the 'Brooklyn Dodgers.' It was the 'Brooklyn Dodgers' name that had acquired secondary meaning in New York . . . It was that cultural institution that Los Angeles abandoned.

*Major League Baseball Properties, Inc. v. Sed Non Olet Denarius, Ltd.*, 817 F. Supp. 1103, 1128 (1993).

144. BLACK'S LAW DICTIONARY 1353 (4th ed. 1952). A litigating party is said to have *prima facie* case when the evidence in his favor is sufficiently strong for his opponent to be called to answer it. *Id.* A *prima facie* case is one which is established by sufficient evidence, and can be overturned only by rebutting evidence adduced on the other side. *Id.*

145. 15 U.S.C. § 1127. See *Stetson*, 955 F.2d at 850; *Saratoga Vicky Spring Co. v. Lehman*, 625 F.2d 1037, 1043 (2d Cir. 1980) (holding that abandonment requires nonuse and intent not to resume). For Los Angeles to have an intent to resume, they had to show that they intended to use the trademark within two years after they left Brooklyn. *Major League Baseball Properties*, 817 F. Supp. at 1131.

146. *Major League Baseball Properties, Inc. v. Sed Non Olet Denarius, Ltd.*, 817 F. Supp. 1103, 1131 (S.D.N.Y. 1993).

147. *Id.* at 1134.

148. *Id.* In 1986 Properties promoted "The Cooperstown Collection" and Major League

the defendants' use of the trademark.<sup>149</sup> This resumption did not cure plaintiffs' initial abandonment.<sup>150</sup> In fact, the court stated that in 1988, the defendants and plaintiffs had equal rights to the trademark.<sup>151</sup> As a result, the court declared that the plaintiffs' rights to the mark were restricted to the limited applications made after 1981<sup>152</sup> and did not stop defendants from using "The Brooklyn Dodger" name for their Brooklyn restaurant.<sup>153</sup>

The *Major League Baseball Properties* court properly allowed the defendants to remain utilizing "The Brooklyn Dodger" name for their Brooklyn restaurants, but the decision fell short by singling out the Borough of Brooklyn as the only location in which the defendants could use the Brooklyn Dodger trademark. This judgment severely limits the defendants' rights to the trademark by precluding them from establishing any restaurants using "The Brooklyn Dodger" trademark anywhere but Brooklyn. Since the court determined that the defendants, Sentore, Picardi, and Boyle, acquired "The Brooklyn Dodger" trademark for their restaurants, it was inconsistent to limit the use to only one borough in New York City.

The court also decided that the Los Angeles Dodgers and Major League Baseball Properties retained the right to use the name "Brooklyn Dodgers" for merchandising purposes, but the court was unclear as to whether the bar could remain producing shirts, hats, and other assorted paraphernalia bearing the Brooklyn Dodger logo. Having found that no confusion existed as to the origin of the trademark, it would be unreasonable for the court to deny the defendant the right to produce promotional materials directly related

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Baseball Properties used the "Brooklyn" name in connection with the promotion. *Id.*

149. *Id.*

150. *Ambrit, Inc. v. Kraft, Inc.*, 812 F.2d 1531, 1551 (11th Cir. 1986). Judge Wisdom concluded that once a trademark is abandoned, it can be canceled even if original holder resumes use. *Id.* See *Defiance Button Mach. Co. v. C & C Metal Products Corp.*, 759 F.2d 1053, 1059 (2d Cir. 1985) (stating that once a mark is abandoned, and there is no intention to resume use, another party is not precluded from using the trademark since it no longer is associated with the original owner's goods or services). See also *First Nat'l Bank v. Autoteller Sys. Serv. Corp.*, 9 U.S.P.Q.2d 1740 (BNA) (Trademark Trial & App. Bd. 1988) (holding that abandonment of a trademark cannot be reversed by subsequent readoption of the mark).

151. *Major League Baseball Properties, Inc. v. Sed Non Olet Denarius, Ltd.*, 817 F. Supp. 1103, 1132 (S.D.N.Y. 1993).

152. *Id.* at 1134. Plaintiffs' use did not include restaurants or taverns. *Id.*

153. *Id.* See *Manhattan Indus., Inc. v. Sweater Bee by Banff, Ltd.*, 627 F.2d 628, 630 (2d Cir. 1980) (holding that the balancing of equities allowed both parties to share the same trademark even though one manufacturer used the trademark one day prior to when the mark was abandoned by its competitor).

thereto.

The Dodgers not only abandoned Brooklyn in 1958, they also abandoned "The Brooklyn Dodgers" trademark. The O'Malley's robbed Brooklyn of their beloved Dodgers over thirty-five years ago. On the site of the former home of the Brooklyn Dodgers, Ebbets Field, is a housing project whose walls carry the ironic warning, "No Ball Playing Allowed."<sup>154</sup> To further deprive Brooklyn Dodger fans of any remaining vestige of the Brooklyn Dodger spirit only pours salt on a still open wound.

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154. Mel Antonen, *Old Ballparks Live on in Memories*, USA TODAY, June 24, 1993, at 3c.