

Jon O. Newman, *Circuit Judge*, concurring in part and dissenting in part:

A person's name is a valuable possession.¹ Broadly prohibiting its use is an extraordinary step that a court should not take except in the unlikely event that a person has clearly given someone else the right to obtain such a prohibition. In this case, I concur only in part because I cannot approve that portion of the District Court's preliminary injunction that prohibits Hayley Gutman from making any use of her own name in trade or commerce.

Gutman gave JLM Couture, her former employer, for a limited time, an exclusive limited license to use her name on clothing "provided [Gutman] has substantially participated in the design or creation of such clothing or related items during her employment." Employment Contract, § 10(a). Now that she has breached her employment contract, the District Court was entitled to prohibit her from using her name in

¹ "He that filches from me my good name robs me of that which enriches him and makes me poor indeed." WILLIAM SHAKESPEARE, *OTHELLO*, Act III, Scene 3.

marketing bridal wear that she helped design, a use that would violate the exclusive license she gave her former employer.

However, the preliminary injunction now on appeal goes much further than that and prohibits Gutman from using her name in trade or commerce, *i.e.*, on *any* product. In my view, her former employer has no right to such a sweeping prohibition on Gutman's use of her name.

The District Court and now this Court find authority for this sweeping extension of subsection 10(a) in subsection 10(b) of Gutman's employment contract. Subsection 10(b) contains two relevant sentences. The first provides: "The Employer hereby irrevocably . . . assigns . . . all right . . . to register the Designer's Name or any derivatives(s) thereof as trademarks." The second provides: "[T]he Employee . . . shall have no right to the use of the Trademarks, Designer's Name or any confusingly similar marks or names in trade or commerce . . . without the . . . consent of the Company."

The first sentence of subsection 10(b) does not authorize a broad prohibition against Gutman's use of her name. That sentence gives JLM Couture only the right to register Gutman's name or derivatives "as trademarks." It does not prohibit her

from making a nontrademark use of her name, such as putting her name on a website that informs the public that she has products or services to sell having nothing to do with bridal wear.

There are three reasons why the second sentence of subsection 10(b) also does not authorize a broad prohibition of Gutman's use of her name. First, because subsection 10(b) is a trademark provision, not only the first sentence but also the subsection as a whole should not be construed to do more than limit Gutman's use of her name as a trademark. "A writing is interpreted as a whole." Restatement of Contracts, § 202(2).

Second, although the second sentence itself contains a phrase that purports to prohibit Gutman from using "Designer's Name" in trade or commerce, that phrase continues with "or any confusingly similar marks or names." "Confusingly similar" is the language of trademark law, and the sentence, fairly construed, means that Gutman cannot use her name or a confusingly similar mark or a confusingly similar name *as a trademark*.

Third, the "Designer's Name" that JLM Couture can prohibit Gutman from using is only the name to the extent the company has been given a license to use it pursuant to subsection 10(a). "[A]ll writings that are part of the same transaction

are interpreted together.” *Id.* The only use of the name “Gutman” that JLM Couture can use, or can prevent Gutman from using, is the name the company acquired with respect to bridal wear that she helped design or create. For any one of these reasons, subsection 10(b) does not support the sweeping prohibition against Gutman’s use of her name.²

A prohibition on using one’s name must be clear. *See Madrigal Audio Laboratories v. Cello, Ltd.*, 799 F.2d 814, 822 (2d Cir. 1986) (citation omitted). A prohibition on using one’s name “as trademarks,” contained in a subsection concerned with trademarks, is surely not a clear prohibition on using the name for nontrademark purposes. And a limited prohibition in a trademark subsection should not be broadly interpreted to override a specific limitation in a provision licensing use of a name in another subsection of the same contract.

For these reasons, I concur in part and, to the extent indicated above, respectfully dissent in part.

² Subsection 10(c), which the Court quotes as saying that Gutman “assign[ed] to [JLM] . . . the Designer’s Name and the Trademarks,” Maj. Op. at 9 (brackets and ellipsis in original), refers to “the assignment,” obviously meaning the limited assignment in subsection 10(a). Subsection 10(c) entitles Gutman to some additional compensation for making “the assignment.” The additional compensation is not, as the Court says, “for assigning the Designer’s Name and Trademarks to JLM,” Maj. Op. at 10; the additional compensation is for making only the limited assignment of name in subsection 10(a).