IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF PENNSYLVANIA

TYLER GREEN	:	CIVIL ACTION
	:	
vs.	:	
	:	
GREG FORNARIO and TYLER GREEN SPORTS	:	NO. 04-1159
	:	

MEMORANDUM

ROBERT F. KELLY, Sr. J. **APRIL 11, 2006**

On March 17, 2004, Plaintiff filed suit against the Defendants for among other things, the illegal use of Plaintiff's name in connection with the Defendants' business activities in violation of the Lanham Act, 15 U.S.C.A. § 1125(a)(c)(d). The docket reflects that the Complaint was served on Defendants on March 23, 2004. On April 29, 2004 a Consent Decree was entered in which the Defendant generally agreed that he would not use the name Tyler Green in connection with his business activities, but with no express admission of liability.

Nothing further appeared on the docket until this Court entered an Order on January 25, 2006, dismissing the case for lack of prosecution under R. Civ. P. 41(a). After being advised by Plaintiff's counsel that the case was still viable we vacated the Order dismissing the action on January 27, 2006.

Though the docket does not reflect it, after the entry of the Consent Decree, the Plaintiff did conduct discovery, including the deposition of Defendant Greg Fornario in an effort to determine if any damages had been suffered by Plaintiff. No claim for damages has ever been filed and in his reply memo, document 13 at page 9, Plaintiff concedes that there is no claim for damages.

Shortly after the reinstatement of this action on January 27, 2006, Plaintiff filed a Motion for Counsel Fees in the amount of $23,791 plus Costs, which is now before this Court for determination.

PREVAILING PARTY

The U.S. Supreme Court has held, that a party that secures a court ordered consent decree is considered a "prevailing party" for the purposes of receiving attorneys fees. Buckhannon Board and Care Home, Inc. v. W. Virginia Department of Health and Human Services, et al., 532 U.S. 598, 600 (2001) ("court-ordered consent decrees create the 'material alteration of the legal relationship of the parties' necessary to permit an award of attorneys fees." (internal citations omitted)). In this case Plaintiff accomplished part of what he sought when he filed the lawsuit, i.e., Defendant stopped using the name "Tyler Green" in relation to his business. I believe this is sufficient under the case law to qualify him as a prevailing party for the purpose of being awarded attorneys fees.

LAW WITH REGARD TO COUNSEL FEES UNDER THE LANHAM ACT

The Lanham Act expressly provides for an award of attorney fees at the discretion of the Court in "exceptional cases" 15 U.S.C. §1117(a). In order to make an award of attorneys fees under the Lanham Act, a Court must make a finding of culpable conduct on the part of the losing party, such as bad faith, fraud, malice or knowing infringement, before a case qualifies as "exceptional". Ferrero U.S.A. Inc. v. Ozak Trading, Inc. 952 F.2d 44; Securacomm Consulting, Inc. v Securacom Incorporation 224 F.3d 273, 280 (2000).

<u>DISCUSSION</u>

In an effort to prove that this case is "exceptional" Plaintiff argues that the following conduct evidences bad faith or knowing infringement on the part of Greg Fornario: that no one at Defendant Tyler Green Sports was named Tyler or Green; that Defendants reasons for choosing the name Tyler Green Sports defy belief, (Plaintiff's original memorandum at page 2); that Defendant had specific knowledge of Tyler Green as early as October 3 when Tyler Green's agent advised Plaintiff that he was using Tyler Green's name without authorization, (Exhibit A to Plaintiff's original memorandum); that two letters from Plaintiff's attorney, (Exhibits B and E to Plaintiff's original memorandum, dated February 20, 2004 and March 2, 2004) informed Defendant of the conflict.

Therefore, Plaintiff argues that at least by February 20, 2004 Defendants were in bad faith knowingly using Plaintiff's name in connection with their business activities, (Plaintiff's original memorandum at page 3).

The Defendant testified in his deposition that when he was working for his father's mushroom company in the Kennett Square area of Chester County he came up with the idea for a sports handicap service. (Dep. 6-7.[1]) He advertised this business one time in the Daily Local, a newspaper in Chester County, but did not have the money to continue advertising it, so it was inactive for years. (Dep. 8, 9.) The handicap service operated for one day. (Dep. 24.)

In late 2001 or early 2002 Fornario started to get into the entertainment business advertising on a website and on one occasion he advertised Tyler Green Sports on station MMR.

[1]Fornario explained the handicap business as follows . . . "people who gamble on sports will call these companies up and actually pay for picks." Dep. 7.

(Dep. 10, 11.) The Defendants never had a credit card for Tyler Green Sports, (dep. 14), and never filed a corporate tax return for Tyler Green Sports. (Dep. 17.)

When asked:

> "Q. How did you come up with the name Tyler Green?
>
> A. Well, like I said, due to the fact that it was for the handicap service at first, the competition had a lot of - - lot of names, lot of catchy names, lot of unique names, and had to do with money. So Green was not taken on the list, you know, so I used Green. And then I probably pretty much put every name with Green and Tyler rang a bell. And I got Tyler from - - to be honest with you, from Aerosmith's Steven Tyler, from his name." Dep. 21, 22.

When asked if he liked the Philadelphia sports teams Fornario described himself as being from New York and a fan of the New York Yankees, Jets and Giants. (Dep. 18.) He was never asked and the record does not reveal when he moved from New York to Kennett Square, Pennsylvania, a fact that would be helpful in trying to determine whether Mr. Fornario knew of Tyler Green the baseball player. The record does reveal, however, that Mr. Fornario graduated from Kennett Square High School in the year 1992. (Dep. 6.)

At the time Mr. Fornario was contacted by Tyler Green's attorney, he did not know who Tyler Green was. (Dep. 106.) In his bar promotions Mr. Fornario and Tyler Green Sports never used anything associated with Major League Baseball. (Dep. 106, 109.)

As evidence of Defendants' bad faith Plaintiff points to the fact that Defendants continued to operate under the name "Tyler Green Sports" even after being advised by Plaintiff's agent and later by his attorney that their conduct was an improper use of Tyler Green's name.

I believe that Defendants' conduct in this respect is just as consistent with innocent use of the name as it is with intentional use of a known celebrity name. One who brazenly decided to profit from another's fame would be more likely to cut and run at the first sign of being found out. One who innocently chooses a name for a business - has it registered as a fictitious name with the State of Pennsylvania after a search, and has put time and effort into making a go of it, is far less likely to abandon its use when first told that he has no right to use it.

Once a lawsuit was actually filed, requiring the Defendants to hire an attorney, it is quite understandable that Defendant would make the practical decision to agree to stop using the name because he could not afford the attorney's fees involved in a legal fight.

The record in this case does not support a finding of bad faith, fraud, malice or knowing infringement and it is therefore not an "exceptional case" under 15 U.S.C. § 1117(a). I therefore deny Plaintiff's request for counsel fees. I find however, that Plaintiff is entitled to costs.

I therefore enter the following Order.

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O R D E R

AND NOW, this 11th day of April, 2006, after considering Plaintiff's Motion for Counsel Fees and Costs (Doc. No. 10), it is hereby **ORDERED** that:

1. Plaintiff's request for counsel fees is **DENIED**.

2. Plaintiff's request for costs is **GRANTED**. Plaintiff should file a Bill of Costs with the Clerk of this Court in accordance with Local Civil Rule 54.1.

BY THE COURT:

/s/ Robert F. Kelly
ROBERT F. KELLY
SENIOR JUDGE