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September 21, 2018

Via US Mail and email to
eto@floridabar.org

Elizabeth Clark Tarbert
Ethics Counsel
The Florida Bar
651 E. Jefferson Street
Tallahassee, Florida 32399-2300

Re: Memorandum in Support of Alex Hanna's August 30, 2018 Proposed Rule
Amendment and Comment to Florida Bar Rule 4-7.13

Dear Ms. Tarbert:

On August 30, 2018, we submitted a proposed rule amendment and comment to Florida Bar Rule 4-7.13 on Alex Hanna's behalf, which prohibits lawyers from using deceptive and inherently misleading advertisements. We did so to address a growing problem in the legal marketplace concerning a lawyer's use, without permission, of another lawyer's or law firm's name, tradename, trademark, or logo for purposes of generating an online, internet, or website advertisement in response to an internet search for that specific lawyer or law firm. We offer this memorandum in support of that proposed rule amendment and comment.

I. Introduction

In 2013, the Standing Committee on Advertising recommended the adoption of an advisory opinion to curtail the improper use of other lawyer's names in online advertising. The Board of Governors decided against it because the Board at the time was "of the opinion that the purchase of ad words is permissible as long as the resulting sponsored links clearly are advertising," and that the existing rules against deceptive and misleading information were sufficient to curtail any misconduct. Agenda Item Summary (March 2018).

Unfortunately, Mr. Hanna has continued to sustain actual injuries from competitors using his trademarked name and firm name to advertise online. Several customers seeking his traffic-related legal services have mistakenly believed that they had retained him following an internet search for his name. In reality, these consumers had accidentally retained another lawyer's services. Evidence of the consumer confusion is attached to this letter as Composite Exhibit A.

A change to the advertising rules to prohibit the inappropriate use of another lawyer's or law firm's name for online marketing purposes is long-overdue and necessary to prevent this from happening to other members of the Bar and to protect Florida consumers. The justification for the proposed rule change is simple: using another lawyer's or law firm's name to advertise

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online for commercial purposes is illegal as it constitutes federal trademark infringement and violates Florida's common law. And even if not illegal, the practice is unethical in that it allows a lawyer to circumvent other Bar rules through the deceptive and misleading use of another lawyer's name and hard-earned reputation, such as the prohibition on referring to oneself as a specialist without a board certification.

II. Using a competitor's name to advertise online violates federal trademark law.

To prove a trademark violation, a plaintiff must prove five elements: (1) a valid mark; (2) the defendant's use of the mark; (3) that the use occurred "in commerce"; (4) that the use occurred "in connection with the sale ... or advertising of any goods"; and (5) that the defendant used the mark in a manner "likely to confuse" consumers. *N. Am. Med. Corp. v. Axiom Worldwide, Inc.*, 522 F.3d 1211, 1218 (11th Cir. 2008); 15 U.S.C. § 1051 *et. seq.* (the "Lanham Act"). Consumer confusion is determined based on a balancing of several factors, including: the similarity between the marks; the similarity of the products; the area and manner of concurrent use of the products; the degree of care likely to be exercised by consumers; the strength of the plaintiff's marks; any evidence of actual confusion; and the defendant's intent to "pass off" its goods as those of the plaintiff's. *See Promatek Indus., Inc. v. Netscape Commc'ns Corp.*, 300 F.3d 808, 812 (7th Cir. 2002).

The majority of courts that have addressed whether the use of a competitor's name for purposes of online advertising (whether through keywords, metatags, etc.) constitutes a trademark "use" have held that it does either expressly or by implication. *See Brookfield Communications, Inc. v. West Coast Entm't Corp.*, 174 F.3d 1036 (9th Cir. 1999); *Internet Profit Assocs., Inc. v. Paisola*, 461 F. Supp. 2d 672 (N.D. Ill. 2006); *800-JR Cigar, Inc. v. Goto.com, Inc.*, 437 F. Supp. 2d 273 (D.N.J. 2006); *J.G. Wentworth v. Settlement Funding LLC*, 2007 WL 30115 (E.D. Penn. Jan 4, 2007); *Gov't. Employees Ins. Co. v. Google, Inc.* 330 F. Supp. 2d 700 (E.D. Va. 2004).

Likewise, many courts that have addressed the issue of consumer confusion in this context have held that such a use is, indeed, likely to cause confusion. *See Axiom Worldwide*, 522 F.3d at 1222 ("we ultimately conclude that a company's use in meta tags of its competitor's trademarks may result in a likelihood of confusion."); *Playboy Enters, Inc. v. Netscape Commc'ns Corp.*, 354 F.3d 1020, 1024 (9th Cir. 2004); *Promatek Indus.*, 300 F.3d at 813; *Rosetta Stone Ltd. v. Google, Inc.*, 676 F.3d 144, 160 (4th Cir. 2012); *Binder v. Disability Grp., Inc.*, 772 F. Supp. 2d 1172, 1176 (C.D. Cal. 2011); *Hearts on Fire Co. v. Blue Nile, Inc.*, 603 F. Supp. 2d 274, 289 (D. Mass 2009).

Whether the consumer ultimately realizes the true identity of the advertiser is irrelevant. Under the "initial interest confusion" doctrine, a trademark claim exists by virtue of the fact that a customer is "lured to a product by the similarity of the mark, even if the customer realizes the true source of the goods before the sale is consummated." *Promatek Indus., Ltd.*, 300 F.3d at 812. By diverting internet traffic through the improper use of a trademark or tradename, the competitor has improperly "capitaliz[ed] on a trademark holder's goodwill," and thus violated the law. *Australian Gold, Inc. v. Hatfield*, 436 F.3d 1228, 1238-39 (10th Cir. 2006).

The Lanham Act also prohibits individuals from "passing off," or "palming off," which occurs where an individual misrepresents that his or her goods or services are someone else's. *See Suntree Technologies, Inc. v. Ecosense Intern., Inc.*, 693 F.3d 1338, 1347 (11th Cir. 2012). That is precisely what happens when a lawyer purchases keywords or otherwise uses the name of another lawyer or law firm to divert traffic to his or her website.

The Lanham Act further provides that the owner of a famous mark can enjoin another person from using mark or trade name “that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.” 15 U.S.C. § 1125(c). Dilution by blurring is “an association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark” and dilution by tarnishment is “an association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark.” *Brain Pharma, LLC v. Scalini*, 858 F. Supp. 2d 1349, 1356 (S.D. Fla. 2012). Both apply here. Competitors use of Alex Hanna’s trade name impairs its distinctiveness and—as evidenced by the consumer complaints—harms his reputation.

While there are cases where courts have held such a use in online advertising does not result in a trademark violation, those cases typically involve no evidence of actual confusion, *see, e.g., Network Automation, Inc. v. Advanced Sys. Concepts, Inc.*, 638 F.3d 1137, 1145 (9th Cir. 2011), or the target consumers are sophisticated, *see, e.g., Multi Time Machine, Inc. v. Amazon.com, Inc.*, 804 F.3d 930 (9th Cir. 2015).

Here, Mr. Hanna has proof of actual consumer confusion. Moreover, the consumers of his traffic-ticket services consist of anyone with a speeding ticket, which naturally includes unsophisticated consumers who drive. Considering the price of these particular legal services is low, usually less than \$100, customers understandably use a lower degree of care when shopping for such services as compared to those shopping for other legal services. These consumers are particularly at risk of confusion when it comes to deceptive and misleading online advertisements, and the Bar rules should be amended with these consumers in mind.

III. Using a competitor’s name in online advertising violates Florida common law on unfair competition.

To prevail on Florida common law unfair competition claim, a plaintiff must establish “deceptive or fraudulent conduct of a competition and a likelihood of consumer confusion.” *Alphamed Pharmaceuticals Corp. v. Arriva Pharmaceuticals, Inc.*, 391 F. Supp. 2d 1148, 1166 (S.D. Fla. 2005).

“Actual customer confusion is not a necessary element to the establishment of this claim, but evidence of customer confusion does have probative value.” *B.H.Bunn Co. v. AAA Replacement Parts Co.*, 451 F.2d 1254, 1262-63 (Fla. 5th DCA 1971). The Florida common law tort of unfair competition is similar to trademark infringement, but as the *Bunn* points out: “unfair competition is a broader area than trademark infringement. In the area of unfair competition the use of a similar mark may be probative of intent,” and “intent is probative of unfair competition.” *B.H. Bunn Co.*, 451 F.2d at 1264. However, “intent has no relevance to trademark infringement, because customer confusion is the *sine qua non*.” *Id.*

In other words, there is a claim for unfair competition “[w]here palming off is shown.” *CBS, Inc. v. Garrod*, 622 F. Supp. 532, 535 (M.D. Fla. 1985). “However, the gist of unfair competition is more a question of defendant’s intent which can be proved in other ways besides palming off.” *Id.*

The generation of an online advertisement through the use of a competitor’s trade name is deceptive conduct of competition that is likely to cause consumer confusion. Furthermore, competitors undoubtedly intended for consumers to hire their services rather than to hire the

initially-searched lawyer. That is the objective of purchasing a competitor's name in a keyword search.

IV. Using a competitor's name to advertise online constitutes a commercial misappropriation of likeness under Florida's publicity rights law.

Publicity rights laws restrict the commercialization of a person's name without permission. Unlike trademark law, publicity rights do not require plaintiffs to show any consumer confusion.

Florida recognizes both a common law right of publicity, *see Loft v. Fuller*, 408 So.2d 619, 622 (Fla. 4th DCA 1981) (defining the tort as "commercial exploitation of the property value of one's name"), and a statutory one, *see* § 540.08(7), Fla. Stat. ("The remedies provided for in this section shall be in addition to and not in limitation of the remedies and rights of any person under the common law against the invasion of her or his privacy.").

To prevail on a claim under the common law or section 540.08, a plaintiff must prove the defendant (1) used the value of the plaintiff's name (2) for commercial, trade, or advertising purposes. *See Fuentes v. Mega Media Holdings, Inc.*, 721 F. Supp. 2d 1255, 1260 (S.D. Fla. 2010) (Florida common law elements); § 540.08(1) ("publish, print, display or otherwise publicly use for purposes of trade or for any commercial or advertising purpose."). Commercial, trade, or advertising purposes broadly means "the promotion of a product or service." *Tyne v. Time Warner Entm't Co.*, 901 So. 2d 802, 810 (Fla. 2005).

Examples as to what constitutes an actionable "use" under Florida law include:

- Using a golfer's name and photograph on a website to promote golf equipment. *John Daly Enterprises, LLC v. Hippo Golf Co., Inc.*, 646 F. Supp. 2d 1347, 1351 (S.D. Fla. 2009) (construing Florida law);
- Using a baseball player's name in advertising brochures that were never published or distributed. *Weinstein Design Grp., Inc. v. Fielder*, 884 So. 2d 990, 993 (Fla. 4th Dist. Ct. App. 2004); and
- Using an individual's name and reputation in connection with a proposal submitted to the county for a public works project. *Am. Ventures, Inc. v. Post, Buckley, Schuh, & Jernigan, Inc.*, No. C92-1817Z, 1993 WL 468643, at *5-6 (W.D. Wash. May 18, 1993) (construing Florida law).

These examples demonstrate that an actionable use is one that effectuates the direct promotion of a product or service. *See Tyne*, 901 So. 2d at 810 (noting legislative approval of prior decisions requiring "the statute to apply to a use that directly promotes a product or service"). The generation of an online advertisement through the misleading and deceptive use of a competitor lawyer's name—whether through the purchase of keywords or use of meta tags—undeniably qualifies as a "use that directly promotes a product or service," and thus constitutes a commercial misappropriation.

It matters little that the use is not visible. The purpose of Florida's publicity rights law is "to prevent the unauthorized use of a name to directly promote the product or service of the publisher. Thus, the publication is harmful not simply because it is included in a publication that

is sold for a profit, but rather because of the way it associates the individual's name or his personality with something else.” *Loft*, 408 So. 2d at 622–23.

V. The Wisconsin decision of *Habush* is distinguishable and conflicts with Florida’s publicity rights law.

Habush v Cannon, 828 NW 2d 876 (Wis. Ct. of App. 2013), is the only known decision to examine a right of publicity claim based on sponsored links involving lawyers. The Wisconsin appellate court concluded that the competing law firm did not “use” the other lawyers’ names within the meaning of the Wisconsin publicity rights statute because the use was not “visible.” In support, the *Habush* Court explained that it is not actionable for another lawyer to place a Yellow Pages advertisement in close proximity to a competitor’s.

But the lawyer in that example is not using another lawyer’s name in the same way one does when he or she deliberately purchases another lawyer’s name or trademark when advertising online. While Yellow Pages may have been using the lawyer’s name with consent, the same cannot be said for the competitor lawyer who deliberately manipulates internet searches through the use of another lawyer’s or law firm’s name, tradename, trademark, or logo. *Habush* is also incompatible with Florida law and cannot be squared with cases such as *Weinstein*, where the public never saw the publication that was printed but never distributed.

Moreover, the Wisconsin publicity rights statute allows for relief only for “unreasonable” uses of other’s names. While the Wisconsin appellate court did not justify its ruling on this basis, most states (including Florida) have no such limitation in either their common-law or statutory protection of the right of publicity.

In sum, an impermissible “use” under Florida’s publicity rights law certainly includes the misleading and deceptive use of another lawyer’s name without permission to trigger advertisements and generate clicks on one’s website—whether through use of meta tags or keywords—regardless of whether the use is visible or not. The competing lawyer is using, without permission, another lawyer’s or law firm’s name and good will for his or her own commercial gain. That is a violation of Florida’s right of publicity laws and should be regulated by the Florida Bar.

VI. How other Bars regulate this conduct.

North Carolina issued an ethics opinion regulating this type of advertising. See N.C. Formal Ethics Op. 2010-14 (2012). In that state, a lawyer may not use another lawyer’s name as a keyword that, when used as search term, triggers the appearance of the lawyer’s own advertisement on a user’s computer screen. The North Carolina Bar enforced this restriction at least once. See Grievance Comm. of the North Carolina State Bar, *In re David J. Turlington, III*, Censure No. 13G0121 (2013).

American Bar Association guidance provides that lawyers may employ search engine optimization (SEO) techniques, including hidden text, metatags, and the purchase of advertising key words or phrases, “as long as they are not false, deceptive or misleading.” ABA/BNA Lawyers’ Manual on Professional Conduct Vol. 30, No. 4, p. 115. The ABA guidance then cites the North Carolina rule, implying that the use of a lawyer’s name in a keyword/metatags is an example of misleading or deceptive conduct that is prohibited.

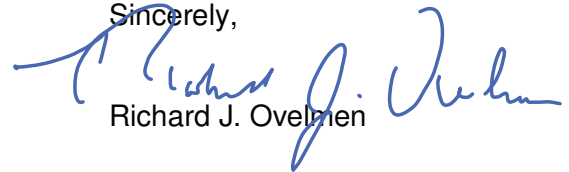
VII. Conclusion:

Consistent with the approaches taken by the North Carolina Bar and the American Bar Association, the Florida Bar should regulate the generation of online advertisements based on the name, tradename, trademark, or logo of another lawyer, regardless of the advertising technology used (which is sure to change over time). Mr. Hanna believes this can best be achieved in Florida by adding this activity as an additional example of a deceptive and inherently misleading advertisement under Rule 4-7.13(b).

This proposed rule is not intended to hinder internet advertising, but rather to prohibit conduct that is illegal, immoral, unethical, and yet goes unchecked. Nor is it Mr. Hanna's intention to inhibit competition. Competition should be encouraged; however, it should be done without violating the law or taking advantage of the name and hard-earned reputation of another lawyer. Indeed, such a regulation is necessary to maintain the integrity of the profession and protect the public and reputation of all Florida lawyers.

We hope the Board will fully consider Mr. Hanna's proposal and approve it. We look forward to discussing this matter with you at the Amelia Island meeting in October.

Sincerely,



Richard J. Overman

cc: Alex Hanna; Alina Gonzalez

AFFIDAVIT OF FACTS

STATE OF FLORIDA
COUNTY OF MIAMI DADE

I, Eladio M. Paez licensed as a Private Investigator in the State of Florida, do hereby state under penalty of perjury that the following facts are true:

1. I am over the age of 18 and a resident of the State of Florida.
I have personal knowledge of the facts herein, and if called as a witness, will testify competently thereto.
2. I, Investigator Eladio M. Paez was retained to provide investigative support on an apparent false advertisement campaign, where by clients who searched for Alex Hanna's services on mobile phone Google search, were directed to "The Ticket Clinic."
3. My involvement in the mentioned case and research of the facts drove me to interview several clients that suffered confusion and in fact hired The Ticket Clinic when they were seeking Alex Hanna's representation.
4. I contacted Bryan Rodriguez of 29587 SW 144 Ave. Homestead FL 33033. Mr. Rodriguez stated that through his mobile phone he contacted the offices of Alex Hanna at least that's who he thought he had hired. He found out that he had hired The Ticket Clinic when he called the offices of Alex Hanna to obtain an update on his case. In reviewing court records the attorney of record for Mr. Rodriguez case is Ted Hollander who represents The Ticket Clinic.
5. I also contacted Karla Hufford of 77 NW 38 Street Miami FL 33127, Jakhia R. Lawrence of 2728 NW 173 Terrace, Miami Gardens FL 33056 and Orlando Paz of 2240 E. Preserve Way, Miramar, FL 33025, these clients expressed that they were confused by the add and found themselves having great difficulty in reaching Alex Hanna's office through the mobile search engine. These clients believed that they were calling Alex Hanna due to his specialization in traffic tickets and that Alex Hanna was only charging \$49.00 for his services.
6. The clients interviewed are under the impression and it appears according to the advertisement that The Ticket Clinic is impersonating Alex Hanna by using his name in The Ticket Clinic's Google advertisement. By pretending to be Alex Hanna, the clients called the ticket clinic thinking they were calling Alex Hanna.

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Exhibit A

7. The Clients agreed to pay money to the ticket clinic thinking that they were paying Alex Hanna to represent them.
8. The advertisement in question is misleading, confusing and specifically puzzling to those clients who are not proficient in the English language.



Eladio M. Paez
Private Investigator licensed in the State of Florida
State of Florida license# C2100879

STATE OF FLORIDA
COUNTY OF MIAMI DADE

Sworn to and subscribed before me January 5, 2016 by Eladio M. Paez who produced the following identification - State of Florida Private Investigator License #C2100879

Briseida Sosa

Notary Public for the State of Florida

(Sign) Briseida Sosa

My Commission expires: 4/20/2019



Briseida Sosa
COMMISSION #FF222457
EXPIRES: April 20, 2019
WWW.AARONNOTARY.COM

Memorandum

DATE: October 28, 2015
TO: ALEX HANNA
FROM: PRECISE PROTECTIVE RESEARCH, INC.
RE: MOBIL APP FALSE ADVERTISEMENT

SINOPSIS:

Precise Protective Research was retained to investigate an apparent false advertisement campaign perpetrated by "The Ticket Clinic." This report confirms a meeting with Mr. Alain Dominguez, who provided a written statement of facts regarding his experience with the described false advertisement.

DETAILS:

On Tuesday October 27th, 2015 at approximately 5:00 PM, Investigator Paez met with Mr. Alain Dominguez at Molina's Ranch Restaurant located at 4090 E 8 Ave. Hialeah FL 31013. Mr. Dominguez had spoken to Inv. Paez previously and was willing to provide a sworn statement regarding his negative experience with the Google advertisement.

After proper identification was obtained and verified, Mr. Dominguez chose to write the attached notarized statement.

Investigation continues.

PRECISE PROTECTIVE RESEARCH, INC.
7270 SW 48th St., Miami, FL 33155

305-374-8943 • 305-456-6193 www.precise411.com

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10/27/15
to whom it may concern,

In searching of Alex Hanna on my mobile phone, it directed me to the ticket clinic. I did the payments thinking it was Alex Hanna. I soon noticed it wasn't when I called them to find out information on my case and they stated they did not have my case. I was under the impression I had hired Alex Hanna because that is the name that I searched for and who I wanted to work with.

Alcin Dominguez

10/27/15

WIT. ELADIO M. PAEZ

Sworn to (or affirmed) and subscribed 10/27/15
before me this 27 day of October 2015.



Briseida Sosa

COMMISSION #FF222457
EXPIRES: April 20, 2019
WWW.AARONNOTARY.COM

Produced Identification: D552-000-93-448-0

Type of Identification Produced: Driver's License

004

Memorandum

DATE: October 22nd, 2015
TO: CLIENT
FROM: PRECISE PROTECTIVE RESEARCH, INC.
RE: MOBIL APP FALSE ADVERTISEMENT

SINOPSIS:

Precise Protective Research was retained to investigate an apparent false advertisement campaign perpetrated by a "The Ticket Clinic." The false advertisement scheme directly affects The Law Offices of Alex Hanna as a number of clients have been diverted to The Ticket Clinic and multiple complaints have been received from clients regarding this issue.

DETAILS:

On Tuesday October 20th, 2015 Investigator Paez learned that several complaints were received at the Law Offices of Alex Hanna from clients that thought the offices of Alex Hanna was representing them, when in fact it was The Ticket Clinic. The clients expressed they were under the impression they had retained Alex Hanna however, the court files indicated that Ted Hollander who works directly for The Ticket Clinic was the attorney of record. Most of these clients had summoned the assistance of Alex Hanna through a mobile phone search engine.

Upon conducting a search for Alex Hanna on Google via mobile phone search engine, an advertisement stating "Alex Hanna from \$49 – Solution for Traffic, DUI and Speeding Tickets" appears. Directly below a caption "Ad" shows the web page: www.theticketclinic.com and the phone number 877 – CITATION which is the Ticket Clinic's direct business line. This advertisement is and continues to create confusion among clients that utilize this method to contact the offices of Alex Hanna. There are multiple clients that have received representation by the Ticket Clinic while being under the impression that the law offices of Alex Hanna was representing them.

The investigation revealed multiple clients up to date who have been affected by the Google add. Client Alain Dominguez was under the impression that he had retained Alex Hanna's Law Firm and only realized he was being represented by the Ticket Clinic when

Memorandum

he called Alex Hanna's Law Firm to check on the status of his case. On Thursday, October 22, 2015, Investigator Paez confirmed Mr. Dominguez account. On Friday October 23, 2015 Investigator Paez contacted Bryan Rodriguez who had also suffered a similar confusion. Mr. Rodriguez stated that through his phone he contacted the offices of Alex Hanna at least that's who he thought he had hired. He found out that he had hired The Ticket Clinic when he called the offices of Alex Hanna. In reviewing court records the attorney of record is Ted Hollander for both Mr. Dominguez and Rodriguez cases.

Inv. Paez also contacted Karla Hufford, Jakhia R. Lawrence and Orlando Paz, these clients expressed that they were confused by the add and found themselves having great difficulty in reaching Alex Hanna's office through the mobile search engine. These clients believed that they were calling Alex Hanna due to his specialization in traffic tickets and that Alex Hanna was only charging \$49.00 for his services.

The clients interviewed are under the impression and it appears according to the advertisement that The Ticket Clinic is impersonating Alex Hanna by using his name in The Ticket Clinic's Google advertisement. By pretending to be Alex Hanna, the clients called the ticket clinic thinking they were calling Alex Hanna.

The Clients agreed to pay money to the ticket clinic thinking that they were paying Alex Hanna to represent them.

The advertisement in question is misleading, confusing and specifically puzzling to those clients who are not proficient in the English language.

Investigation continues.