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Insights

Buying Another Lawyer's Name to Trigger Search Engine Ads – Illegal or Unethical?

By Travis Crabtree

Travis Crabtree, a member of Looper Reed & McGraw P.C. in Houston, brings a unique perspective to his internet marketing, online media, and commercial litigation practice. Travis graduated from the University of Missouri School of Journalism and spent several years in television news before taking on a law career. Travis explores the emerging legal issues and trends for internet marketing and online media on his blog, eMediaLaw.com.

Many lawyers work tirelessly to raise their profiles within their community to help generate business. Some have become so ''prominent'' or ''legendary'' that they need not advertise at all. For these fortunate practitioners, potential clients simply enter the lawyer's name into the blank Google search box. But what happens when an advertisement by another, perhaps not as prominent, lawyer appears on the top of the search engine results?

Businesses have been using competitors' trademarks as search engine keywords for some time, resulting in a long line of cases. *See, e.g., Network Automation, Inc. v. Advanced Systems Concepts, Inc.*, 638 F.3d 1137, 31 ILR 684 (9th Cir. March 8, 2011); *FragranceNet.com, Inc. v. Les Parfums, Inc.*, 672 F.Supp.2d 328, 28 ILR 548 (E.D.N.Y. 2009). For the most part, courts have held that use of a trademarked term is a ''use in commerce,'' which is the first element of a trademark infringement claim. ***See, e.g., Network Automation***, 638 F.3d 1137; *Rescuecom Corp. v. Google, Inc.*, 562 F.3d 123, 27 ILR 1 (2d Cir. 2009).

There are fewer examples as to what satisfies the second trademark infringement element — consumer confusion — because cases often settle or are very fact specific and are not appealed. The Ninth Circuit, however, articulated the consumer confusion factors most relevant to AdWord cases:

> [T]he most relevant factors to the analysis of the likelihood of confusion are: (1) the strength of the mark; (2) the evidence of actual confusion; (3) the type of goods and degree of care likely to be exercised by the purchaser; and (4) the labeling and appearance of the advertisements and the surrounding context on the screen displaying the results page.

Network Automation, Inc., 638 F.3d 1137.

Lawyers have not been as quick to embrace search engine marketing until recently. Not surprisingly, the first lawsuit on the issue was soon to follow. In June 2011, a Wisconsin state court addressed whether lawyers from one firm may bid on and use the names of lawyers from a competing firm in order to trigger a paid advertisement on search engines. *Habush v. Cannon*, 32 ILR 193 (Wis. Cir. Ct., 09-CV-18149, June 8, 2011).

Privacy Rights at Issue

Because ***Habush*** involved individual lawyers' names rather than trademarked terms, the case focused on the rights to publicity rather than trademark. Although marketers have tried to capitalize on the names of celebrities for years, this appears to be the first case (lawyer or not) about the right of an individual to prevent the use of his or her name to trigger paid advertisements. The court held that such use of the lawyers'

names was an invasion of privacy, but the invasion was not unreasonable, so no injunction was warranted.

Plaintiffs Habush and Rottier and defendants Cannon and Dunphy are, according to the opinion, high profile, successful Wisconsin personal injury lawyers. Defendants bid on the terms ''Habush'' and ''Rottier'' to trigger ads on the Google, Yahoo, and Bing search engines for their law firm. The advertisement for Cannon's firm usually appeared either at the top or on the side of the organic search results. The terms ''Habush'' and ''Rottier'' did not appear anywhere in the advertisement.

The plaintiffs sought an injunction to prevent the defendants from using their names. The plaintiffs sued under a right of publicity, which is codified in Wisconsin under the broader invasion of privacy statute.

Specifically, Wis. Stat. § 9950.50(2)(b) defines ''invasion of privacy,'' in part, as: ''The use, for advertising purposes or for the purpose of trade, of the name . . . of any living person, without having first obtained the written consent of the person . . . .'' Section 9950.50(1) adds: ''One whose privacy is unreasonably invaded is entitled to . . . [e]quitable relief to prevent and restrain such invasion.''

The court first found that each of the plaintiffs, ''[t]hrough excellence in advocacy, extensive and respectable advertising, and substantial charitable giving of time and money'' has a ''property interest in the publicity of value of [his] name.''

The court addressed the defendants' two affirmative defenses; namely, the First Amendment and unclean hands. The court quickly, and without citation to authority, dismissed the free speech affirmative defense, holding that the ''use of a computerized system to sequence search results is not speech.'' The court noted there was no issue with the actual content of the advertisement or the content of defendants' website. Therefore, First Amendment issues were not at play.

The defendants next argued that the plaintiffs had unclean hands and therefore should not be entitled to equitable injunctive relief. The defendants pointed to plaintiffs' own advertisements on 411.yellowpages-.com and AnyWho.com, where plaintiffs' advertisements appeared anytime a Milwaukee personal injury attorney was searched. The court distinguished these ads, noting that they were offered by the websites as free ''throw ins'' for the purchase of the back cover of the printed Yellow Pages. The websites did not sell placement based on specific names. Instead, they only sold placement based on subject, and the websites, rather than the plaintiffs, were the ones that equated specific attorney names with the broader subject placement. Moreover, plaintiffs asked the AnyWho-.com and Yellowpages.com sites to stop the practice once it was brought to their attention. Therefore, defendants' unclean hands defense failed.

For the plaintiffs to prevail on their claims, they needed to establish two elements: (1) an invasion of privacy; (2) that was unreasonable. To prove an invasion of privacy, the Wisconsin statute requires four elements: (1) the use; (2) for advertising purposes or for purposes of trade; (3) of the name . . . of any living person; (4) without having first obtained the written consent of the person.

The court considered whether paying money for ''Habush'' or ''Rottier'' to trigger search engine ads was a ''use'' of their names, given that the consumer would otherwise never see the names in the copy of the ads. The Wisconsin court first noted that ''the plain English meaning of the word 'use' certainly includes the purchase of a name to trigger results from a computer algorithm.'' Deftly foreshadowing the ultimate outcome, the court wrote that the failure of the names to actually appear in the ad did not mean the names were not ''used,'' but could weigh on whether the use of the names was unreasonable.

Regarding the second element — ''for advertising purposes'' — the defendants argued that plaintiffs' names must actually appear in the advertisement, with the implication that plaintiffs endorsed defendants' services. The court disagreed. Nothing in the statute (or apparently the case law, given the lack of citations) requires the actual display of plaintiffs' names on the defendants' ad to establish an invasion of privacy. Nor is there a requirement of an apparent endorsement to establish use for advertising purposes. Instead, the court held that the advertisements were just that — advertisements. The court again noted that the lack of any implied endorsement might speak to reasonableness, but not whether the names were being used for advertising purposes.

With regard to the ''name of any living person'' requirement, the court obviously found that plaintiffs were, in fact, alive. The court noted, however, that the secondary meaning of the two plaintiffs' names as a law firm may, again, speak to the reasonableness issue.

As for ''written consent,'' the defendants creatively argued that by signing up for their own paid search campaign, the plaintiffs granted a license for the search engines to use their names in this manner. The court held that while that may be true, it does not mean that plaintiffs gave written consent for ***defendants*** to use their names to trigger competing ads.

Accordingly, the court found that the defendants invaded plaintiffs' right to privacy by taking advantage of plaintiffs' right to publicity. For the plaintiffs to prevail, however, the invasion had to be ***unreasonable***. As already indicated, the court found no unreasonable invasion based on the individual and particular circumstances of the case.

Specifically, the court noted that the defendants could have engaged in any number of historically acceptable competitive marketing practices that would have had the same effect. For example, defendants could have: (1) opened their office right next door to plaintiffs; (2) put a billboard right outside their office; (3) paid more to the Yellow Pages to be more prominent; or (4) placed television or radio ads right before or after plaintiffs' ads. Without citation to authority, the court concluded that bidding on terms to make ads appear near the competitor is the same tactic in a new frontier.

The court also queried whether a computer user who enters in ''Habush'' is looking for the individual or the successful law firm. Because, the court wrote, plaintiffs cannot handle all of the inquiries they receive individually, they are forced to rely on and promote the firm and therefore ''intertwine their own names in the firm.'' The plaintiffs' advertisements promote the firm more than the individuals, therefore ''diminishing their ability to control the use of their names.'' The firm is not a living person and therefore cannot bring an invasion of privacy claim. ''Any unreasonableness in using [Habush and Rottier] is reduced by the dual meanings they carry.''

Next, the court noted there was no evidence of consumer confusion. Moreover, to the extent there was any confusion, it would be quickly diminished because a user who clicks on defendants' paid advertisement would soon realize that he did not land at plaintiffs' website. The court also concluded that consumers are skeptical of search results and expect to see a wide range of relevant offerings to their search terms.

The court further noted that internet marketing is evolving too fast for there to be an effective injunction. In fact, Google already offers ''Pages similar'' and ''Something different'' features, which may serve up defendants' ad even if defendants did not bid on the plaintiffs' names.

Finally, the court looked at the ethics of it all. The plaintiffs apparently presented scholarly opinions that defendants' conduct was questionable, but the court failed to find any decision from any regulatory or adjudicatory body supporting that view. Until then, the court was not going to consider ethics in the reasonableness balancing test that ultimately came down in favor of the defendants.

Analysis

Although ***Habush*** appears to be the first to consider the use of an individual's name as a trigger for an ad campaign, it is, after all, merely a trial court opinion that could be overturned on appeal. Given the lack of legal precedent and citation to authority or empirical studies, the trial court's decision is not on a strong foundation. Moreover, this case was specific to the Wisconsin statute and would have apparently gone the other way but for the unreasonableness requirement.

The blanket rejection of First Amendment protections to the use of search engine keywords could have some interesting unforeseen consequences if this case has any staying power. The court simply stated that ''a computerized system to sequence search results is not speech.'' Google and Yahoo may have cringed at that one line in the 26-page opinion.

The plaintiffs have already stated their intent to appeal, so there will likely be a more authoritative decision from the appellate court in Wisconsin in the near future. It will be interesting to see how much, if any, of the trial court's focus on public policy the appellate court adopts.

It will also be interesting to see how the regulatory bodies act. Just a few weeks after ***Habush***, the ABA

Commission on Ethics 20/20 published its initial report on attorney advertising. The report made clear that advertising through Google or Yahoo is perfectly permissible ''as long as the marketing method does not involve conduct that is inconsistent with the lawyer's professional obligations (e.g., misleading communications . . .).'' Report, ABA Commission on Ethics 20/20 Initial Draft Proposal — Technology and Advertising, June 29, 2011, p.5 (available at http://www.americanbar.org/groups/professional_responsibility/aba_commission_on_ethics_20_20.html).

The bar associations of various states have rules that prohibit misleading consumers as to affiliations and the use of names in firms. For example, Rule 7.01(a) of the Texas Disciplinary Rules of Professional Conduct states: ''A lawyer in private practice shall not practice under a trade name, ***a name that is misleading as to the identity of the lawyer*** or lawyers practicing under such name, or a firm name containing names other than those of one or more of the lawyers in the firm . . .'' (Emphasis added.) Similarly, Rule 7.02 prevents ''false or misleading communications.''

ABA Model Rule 7.1 states:

> A lawyer shall not make a false or misleading communication about the lawyer or the lawyer's services. A communication is false or misleading if it contains a material misrepresentation of fact or law, or omits a fact necessary to make the statement considered as a whole not materially misleading.

The comments to the Model Rule add: ''A truthful statement is also misleading if there is a substantial likelihood that it will lead a reasonable person to formulate a specific conclusion about the lawyer or the lawyer's services for which there is no reasonable factual foundation.'' ABA Model Rule 7.1 c. 2.

The ethical analysis would appear to mirror the Lanham Act's likelihood of consumer confusion test or ***Habush***'s reasonableness test, where the outcome may hinge on whether consumers would likely be confused as to whether there was some type of association between the searched lawyer and the attorney whose ad appears in the search results. Of course, the obvious defense to any ethical charge is that the use of a keyword is a not a ''statement'' or ''communication'' made by the advertising lawyer, but rather by the search engine. The follow-up defense would focus on the fact that the ad itself does not contain any false or misleading information.

The Wisconsin court made it appear that the adversarial parties in ***Habush*** were equals in prominence and abilities. Had a lawyer fresh out of school done the same, would the outcome be different? The comments to the Texas Disciplinary Rules of Professional Conduct describe misleading statements as any that would be ''likely to create an unjustified expectation about results the lawyer can achieve.'' Again, the outcome would likely turn on whether use of another attorney's name as a search engine keyword constitutes a ''statement'' by the advertising lawyer.

Unless there are changes to the Rules of Professional Conduct or more specific guidance in the commentary to address pay-per-click advertising, it would appear that bidding on a competitor's name would not be a violation of the strict letter of the ethical rules. It would be hard to justify any type of penal action against a lawyer for engaging in this behavior with so much uncertainty.

The strict letter of the law may be a defense for some businesses, but the legal profession, it seems, would dictate a higher standard. The Preamble to the Model Rules explains that the rules often address the floor of behavior and not what should be expected. ''Many of a lawyer's professional responsibilities are prescribed in the Rules of Professional Conduct, as well as substantive and procedural law. However, a lawyer is also guided by personal conscience and the approbation of professional peers. A lawyer should strive to attain the highest level of skill, to improve the law and the legal profession and to exemplify the legal profession's ideals of public service.'' ABA Model Rules Preamble (7).

Because no state bar association specifically addresses bidding on competitor's names, offended practitioners will have at least two options. One is to encourage the regulatory bodies to provide more guidance in the rules or in the commentary. Another is to follow the lead of private industry and register trademarks in their firm names in order to secure protection under the Lanham Act. The top ten of the AmLaw 100 have all registered their firm names. If bidding on lawyer names becomes the norm, then lawyers and firms of

all sizes will have to strive to do the same, assuming the lawyer can show that his or her name has taken on a secondary meaning. ***See*** 15 U.S.C. § 1052(e).

Ideally, however, it shouldn't come to this, especially if it is done only to protect lawyers from other lawyers.