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## Practice Management Track – Session 1

# That Name is Taken: Trademark Issues for Law Firms

**Presented By:**

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# About the Presenter...

**Kevin Palmersheim** is a partner at Stafford Rosenbaum, LLP, with his practice concentrated in business law and litigation. He received his law degree and master's degree in business from the University of Wisconsin. His trial experience includes numerous jury trials in state and federal courts, and he has successfully argued cases in the Wisconsin Court of Appeals, Wisconsin Supreme Court and Seventh Circuit Court of Appeals. He also drafted the jury instruction for tradename infringement that was adopted as Wisconsin's standard civil jury instruction.

# That Name Is Taken: Trademark Issues for Law Firms
Kevin J. Palmersheim, Stafford Rosenbaum LLP

## I. Summary of Legal Issues Regarding Use of a Lawyer's (or other Person's) Name.

A. Invasion of Privacy under Wis. Stat. §995.50.
B. Federal Trademark Claim under Lanham Act, 15 U.S.C. Sec. 1114, if the name is registered with US Patent and Trademark Office.
C. Federal Anticybersquatting Consumer Protection Act 15 U.S.C. chapter 107, §8131 (name does NOT have to be registered).
D. State claim for infringement of a trademark under Wis. Stat. §132.01, if name is registered as a trademark with the Wisconsin Department of Financial Institutions.
E. State common law trademark infringement claim.
F. Ethical considerations based on SCR 20:7.1 & 20:7.5.

## II. Lawyers Rights to Control Use of Their Names, in light of *Cannon & Dunphy, S.C. v. William M. Cannon Trust*, 2025 WI App 54 (2025) [per curiam – NOT citable].

A. Summary: William Cannon did not want his name on the firm after his death if Patrick Dunphy and the firm were not willing to pay for it. Cannon had entered into a license agreement with his law firm, to continue using his after his death. Dunphy later told Cannon that minority partners would not honor the license, and Cannon considered removing his name, dissolving the firm, or naming a new board of directors. Dunphy thereafter reassured Cannon that the license agreement was enforceable and Dunphy was going to honor it. After Cannon's death, Cannon's Trust sought to enforce the license agreement and claimed Dunphy was breaching his fiduciary duty, and made misrepresentations, by not living up to his promise. Circuit Court dismissed, and Court of Appeals affirmed, finding there was no fiduciary duty owed, because even though Dunphy was a director and controlling shareholder, the agreement with Cannon was in Cannon's role as an employee. No fiduciary duty is owed to employees. Further found there were no misrepresentations, because Dunphy's statements were opinions.

B. Wisconsin Supreme Court declined a petition to review in June of 2026.

## III. Invasion of Privacy limits, after *Habush v. Cannon*, 2013 WI App 34, 346 Wis. 2d 709, 828 N.W.2d 876.

A. Summary: Cannon & Dunphy bid on search terms with Google and Yahoo! for the words "Habush" & "Rottier." Consequently, the Cannon & Dunphy firm popped up on a sponsored link above the "organic" link to the Habush website. Habush & Rottier sued under the right of privacy statute, § 995.50(2), and circuit court dismissed on summary judgment because the use of the names did not fit within the meaning of "use" in the statute: "invasion of privacy means any of the following: … the use, for advertising purposes or for purposes of trade, of the name, portrait or picture of any living person, without having first obtained the written consent of

the person…." Court of Appeals upheld dismissal, acknowledging that both parties' interpretation of "use" was reasonable and that it was a very close case, but holding it is more reasonable to exclude the non-visible use of the name as interpretation of legislative intent. Cannon & Dunphy's use was viewed similar to opening a location across the street, or placing a billboard ad next to a Habush and Rottier billboard.

B. Although I may have leaned the other way on the close call, I understand the appellate court's decision. However, I believe the lawyers hired by Habush missed good arguments for common law privacy and unfair competition claims as set forth in ***Hirsch v. S.C. Johnson & Son, Inc***., 90 Wis. 2d 379, 280 N.W.2d 129 (1979).

C. Keep in mind that whether something is legal is different from whether it is ethical under professional standards. It is an ethical violation to make a false or misleading communication that compares the lawyer's services with other lawyers' services, unless the comparison can be factually substantiated. SCR 20:7.1.

D. Cannon & Dunphy are clearly trouble-makers when it comes to using other lawyers' names! [KIDDING. This is a joke! Parody. Fair use. I'm only using the Cannon & Dunphy name because it's the case captions. To all living and dead members of this prestigious law firm -- PLEASE don't sue me!]

## IV. Federal Statutory Rights.

A. Federal trademark claims under the Lanham Act exist for registered trademarks, but be wary of relying on remedies for these claims. Better relief may be available under Wisconsin statutory and common law, including that federal courts grant a recovery of attorney fees only in rare cases.

1. Advantages of claims under the Lanham Act for registered trademarks:

    a. Can use the federal court system, which may be preferrable depending on what state court you are in.
    b. Federal judges are generally more experienced with trademark issues.
    c. Developed case law.

2. Disadvantages of federal trademark claims (also see Section VII below).

    a. Have to be in federal court (if you file in state court, the case can be automatically removed by defendants based on a federal question).
    b. Wisconsin District Courts and Seventh Circuit RARELY award attorney fees, based on it being an exceptional case. Usually only for selling counterfeit products.
    c. Strict standards for proving damages. Must show infringer made profits, or that you lost profits.
    d. Even if you prove infringement, Wisconsin District Courts and the Seventh Circuit may not grant injunctive relief. They often only require

a disclaimer be provided by the infringer. See ***Fabick, Inc. v. JFTCO, Inc.,*** 944 F.3d 649 (Seventh Cir. 2019);

B. 15 USC Ch 107, §8131. Cyberpiracy protections for individuals.

1. Civil liability. Any person who registers a domain name that consists of the name of another living person, or a name substantially and confusingly similar thereto, without that person's consent, with the specific intent to profit from such name by selling the domain name for financial gain to that person or any third party, shall be liable in a civil action by such person.

2. Exception. A person who in good faith registers a domain name consisting of the name of another living person, or a name substantially and confusingly similar thereto, shall not be liable under this paragraph if such name is used in, affiliated with, or related to a work of authorship protected under title 17, including a work made for hire as defined in section 101 of title 17, and if the person registering the domain name is the copyright owner or licensee of the work, the person intends to sell the domain name in conjunction with the lawful exploitation of the work, and such registration is not prohibited by a contract between the registrant and the named person. The exception under this subparagraph shall apply only to a civil action brought under paragraph (1) and shall in no manner limit the protections afforded under the Trademark Act of 1946 (15 U.S.C. 1051 et seq.) or other provision of Federal or State law.

3. Remedies. In any civil action brought under paragraph (1), a court may award injunctive relief, including the forfeiture or cancellation of the domain name or the transfer of the domain name to the plaintiff. The court may also, in its discretion, award costs and attorneys fees to the prevailing party.

## V. Significant Factors Related to a Statutory Claim for trademark infringement under Wisconsin Law.

A. Wisconsin Registration of a Trademark. A person may register a trademark in Wisconsin, independent of any registration with the U.S. Patent and Trademark Office. See Wis. Stat. § 132.01(6)(a).

1. Registration is effective for 10 years, subject to the right of renewal.

2. The filing fee is $15.00, and must be done either online or in person (not by mail).

3. Although this registration is independent of a federal registration with the U.S. Patent and Trademark Office, it does not create superior rights to any federal registration. Federal registrations have precedence for purposes of interstate commerce; however, a state registration may establish first use under federal law to help carve out a continuous prior use defense or right.

4. State registration is also beneficial to establish rights to a d/b/a name.

   a. A lawyer shall not make a false or misleading communication about the lawyer or the lawyer's services. SCR 20:7.1 (including creating an unjustified expectation about results).
   b. "A lawyer shall not use a firm name, letterhead or other professional designation that violates SCR 20:7.1. A trade name may be used by a lawyer in private practice if it does not imply a connection with a government agency or with a public or charitable legal services organization and is not otherwise in violation of SCR 20:7.1." SCR 20:7.5

B. A claim under Ch. 132 requires that the registered mark and infringing mark be "identical to or substantially identical to" each other. Section 132.001(1). This "means that the challenged designation must be an exact copy of the registered mark or substantially indistinguishable from it." ***Madison Reprographics, Inc. v. Cook's Reprographics, Inc.***, 203 Wis. 2d at 249.

C. Enforcing Statutory Rights.

1. A trademark owner under a state registration may obtain injunctive relief. Wis. Stat. § 132.033(1).

2. A prevailing trademark owner may recover actual damages, or an amount up to three times the defendant's profits directly resulting from the wrongful manufacture, use, display or sale of goods and services using the counterfeit mark. Wis. Stat. § 132.033(2)(b).

3. A willful violation requires the court to award the greater of actual damages or three times the defendant's profits. Wis. Stat. § 132.033(2)(c).

4. A prevailing trademark owner may be awarded all costs, including reasonable investigator and attorney fees. Wis. Stat. § 132.033(2)(d).

## VI. Common Law Rights for Trademark Infringement.

***Madison Reprographics*** indicates that the adoption of Ch. 132 did not abrogate common law trademark rights in Wisconsin. *See* ***Madison Reprographics***, 203 Wis.2d at 233.

A. Common Law Trademark rights do not require identical or substantially identical marks in order to constitute infringement. Similar to the standards under federal law, infringement may be found by establishing a likelihood of confusion. ***D.L. Anderson's Lakeside Leisure Co., Inc. v. Anderson***, 2008 WI 126, 314 Wis. 2d 560, 588, 757 N.W.2d 803. Under Wisconsin terminology, likelihood of confusion is also described as proving "confusing similarity." ***Madison Reprographics***, 203 Wis. 2d at 236.

B. The initial standard for a protectable common law trademark or tradename is that the mark is either inherently distinctive, or has acquired secondary meaning. ***Madison Reprographics***, 203 Wis. 2d at 235.

C. The damages remedies under Wisconsin common law trademarks are somewhat broader and more flexible than under federal claims pursuant to the Lanham Act. Under Wisconsin law, for example, a prevailing trademark owner may recover actual damages based on the inherent value of the trademark itself rather than establishing plaintiff's lost profits or profits by the infringing defendant. This damage recovery may be supported based on a determination of the value of the trademark as testified to by the owner prior to infringement, and the value of the trademark according to the owner following the infringement. *See* ***D.L. Anderson's Lakeside Leisure Co., Inc.,*** 314 Wis. 2d at 592.

D. Likelihood of confusion and confusing similarity are questions of fact. ***Madison Reprographics,*** 203 Wis. 2d at 238.

E. Wisconsin has strong case law on use of someone's personal name – in a business context, the name is synonymous with the goodwill of the business.

1. ***Hirsch v. S.C. Johnson & Son, Inc***., 90 Wis. 2d 379, 280 N.W.2d 129 (1979). Famous Badger and NFL player, Elroy "Crazylegs" Hirsch, held to have rights for damage claim against company manufacturing shaving gel for women called "Crazylegs." (for purely entertainment purposes, see the article at the end of this outline).

2. ***Koepsell's Olde Popcorn Wagons, Inc. v. Koepsell's Festival Popcorn Wagons***, 2004 WI App 129, 275 Wis. 2d 397, 685 N.W.2d 853 (2004). There is generally no distinction between the goodwill of a business and the tradename. However, when the seller of a business has claimed he retained the right to continue using his personal name after the sale of his business, the court will look at the sale contract to determine if the name was an asset that the seller retained.

3. ***Ritter v. Farrow***, 2021 WI 14, 395 Wis. 2d 787, 955 N.W.2d 122. Bibs Resort is a northern Wisconsin lakefront resort with 11 rental units, a home and a bar. It was owned by the Ritters in 1998, when they converted ownership of the property to condominiums owned by the Ritters. They named the condominium Bibs Resort Condominiums, and the condo declarations specifically excluded the management business that continued to market and rent the units using the trademarks. Some of the condominiums were sold to third parties, and the Ritters' management association entered into contracts to market and rent these units. Each condominium included reference to the Bibs Resort name, and the red Bibs logo. In 2006 the Ritters sold the business to the Farrows, and the sale documents specifically transferred all intangible property, including tradenames. Disputes arose

between the sellers and buyers, and the Ritters and the condominium owners recommended marketing the condos using the Bibs Resort name and logo. The Farrows sued for common law trademark infringement. The condominium association intervened, and the circuit court found that because the condominium association had been granted the right to use the tradename in 1998, the Farrows could not establish an exclusive right to use the tradename as a matter of law and therefore no infringement could have occurred. The Court of Appeals affirmed on other grounds, holding that the tradename and logo were transferred to the condominium association in 1998 under a theory of "implied transfer." The Supreme Court reversed the Court of Appeals in a 4-3 decision (Justices Roggensack, Anne Walsh Bradley and Ziegler dissenting). The Supreme Court held that a trademark is synonymous with the goodwill of a business, the only business at issue was the management company that had utilized the marks, and no transfer was made to the nonbusiness-oriented condominium association. Consequently, when the Ritters sold the management business to the Farrows, the Farrows obtained trademark rights. The Supreme Court remanded to the circuit court to determine whether the trademark rights were infringed.

## VII. Possible Advantages of Pursuing a State Common Law Trademark in Addition to or in Lieu of a Federal Law Claim.

A. The 7th Circuit is generally strict on the recovery of damages under various theories, and it is virtually impossible to recover damages without the use of expert witnesses and the establishment of lost profits or other high standards, such as the determination of a reasonable royalty covering the period of infringement.

B. Attorney fees under the Lanham Act are awarded to prevailing plaintiffs only in exceptional cases. The 7th Circuit, in particular the Western and Eastern Districts of Wisconsin, rarely find a case to be exceptional absent intentional counterfeiting of products (for example, selling knock-off Hard Rock Café t-shirts). Meanwhile, the Wisconsin statute allows for recovery of attorney's fees for a registered trademark claim without establishing exceptional circumstances. However, those claims do require the marks to be virtually identical.

C. Wisconsin trademark registration costs far less than pursuing a federal registration with the U.S. Patent and Trademark Office. In the long run, the cost of a federal registration is minimal compared to litigation, but for many small law firms, and other client businesses starting out, costs can be a significant factor.

D. The jury instructions for Wisconsin common law trademark claims are much more favorable to plaintiffs on the issue of likelihood of confusion. For example, Wisconsin jury instructions indicate that any actual confusion is entitled to substantial weight in determining likelihood of confusion, while in the federal system the weighing and balancing of the various factors is up to the jury. See WI

Civil JI 2790; 7th Circuit Standard Jury Instruction 13.1.2.3. *See also* ***Fabick, Inc. v. JFTCO, Inc.***, 3:16-cv-00172-wmc, Dckt. # 363.

E. A state law claim may be filed in addition to the federal claim. Most likely this will result in the claim being in federal court (either the initial filing, or by removal). However, the multiple claims can accomplish two purposes: either the federal Lanham Act claim or the Wisconsin claim may garner more weight or remedies with the judge or jury, or a jury could evaluate multiple claims and deny relief on one of the claims while still granting recovery on the other. It is human nature for jurors to often want to give something to each side and, moreover, it is a practical result of juror negotiations to do some horse trading in order to reach a verdict. All of this becomes more beneficial to a plaintiff if there are multiple claims pending.

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## Why Can't I Have "Crazylegs"?
**By Kevin J. Palmersheim**

I read with nostalgia the accounts of former Wisconsin Badger football star and athletic director Elroy "Crazylegs" Hirsch after his recent death. Sure, I'm a big sports fan and my family claims I would buy tickets to watch the Badgers play tiddly winks (an exaggeration, although I would gladly watch them defeat the Minnesota or Marquette tiddly winks squads). However, my fond memories of Hirsch are due more to his participation in *Hirsch v. S.C. Johnson & Son, Inc*., one of my favorite cases wherein Hirsch was able to block the defendant from using the "Crazylegs" nickname for a shaving gel.[i]

"Crazylegs" was not my case, and that is one of my big regrets. It makes me wonder why I get stuck with main stream business disputes while some lucky attorneys get to fight over the likelihood of confusion between a former gridiron all-star and a moisturizing shaving gel for women. Just once, I would love to argue facts that induce smiles, not drowsiness.

I came across the "Crazylegs" case while fighting a trademark battle over the names "Madison Repro" and "Repro Plus" in connection with the less wild and crazy reprographics market. So, instead of coming up with some witty voir dire questions about whether prospective jurors had ever imagined sprinting down a ball field with freshly shaved (and moisturized) legs, I spent my time explaining that "Madison Repro" did not employ anyone named Guido to tow cars away in the middle of the night due to late loan payments. In hindsight, perhaps my client would have been better off with a little more witty "Repro" banter on my part.

My desire for cool case names and fun facts started in law school. I remember my first year torts professor describing a real car accident case where the driver believed he was Batman and he mistakenly believed his "Batmobile" could fly. I argued on the final exam that the insurance company should have retained a comic book expert to testify that the real Batmobile could not fly, so the driver's belief was unreasonable. In spite of my argument, I later managed to graduate and be admitted to bar.

Since I began practicing law, I have longed for the creative case. Sure, I have represented some eccentric clients (a multi-millionaire who wore ratty sneakers to trial, for example), but not one has ever professed to possess superhero powers other than the ability to second-guess my trial strategy. Perhaps, this is the nature of business law and I should be pleased that most cases are boring (and clients sane).

In commercial litigation, there is rarely a "smoking gun" case. But this is Wisconsin where I would be happy with a smoked gouda. I thought I found it when I represented a brewery attempting to exercise its security interest in 6,000 cases of Cheesehead Beer. I found it grating when several un-fun banking types possessed a superior lien and the case and cases were carted away before I could even sniff the foam.

Even if the facts of a case do not bring a grin to my face, a humorous case name could make it worthwhile. The very first Supreme Court case in Wisconsin, for example, concerned a mundane $10.00 debt for boarding horses. But the name of the horse dispute – *Winne [pronounced "whinny"] v. Nickerson* – makes the case one for the fun list.[ii] I have never come within a hair of a horse case, although I have had quite a few dogs.

Getting an entertaining case seems to be a stroke of luck. Luck, however, was not with the hapless gamblers who managed to invigorate an otherwise ordinary UCC case.[iii] The two Texans deposited a $2 million check and 30 minutes later had the bank issue a $900,000 bank draft to Binion's Horseshoe Casino in Las Vegas. The gamblers called up the Horseshoe and the casino sent a jet to retrieve the bettors and their money. Betting $80,000 per hand at blackjack, they lost all the dough in less than four hours.

The casino gave them $5,000 "walking around money," and found the two a couple temporary girlfriends before flying them home. Upon return, the losers told the bank their $2 million check was drawn on insufficient funds and the bank stopped payment on its check to the casino. The casino sued the bank and the court ruled that the bank was stupid and had to honor the check (I may be paraphrasing).

I have participated in cases where I thought the bank exhibited below-average intelligence, but not once did the court echo those sentiments. Instead, the court typically issued a matter-of-fact ruling to another run-of-the-mill case.

I guess I should be satisfied with the knowledge that I enjoy practicing law and my cases provide me with enough walking around money. But, it would be nice to occasionally shake things up a bit. The death of Elroy Hirsch was simply a reminder of that wish. At least every once in a while, I would sure like to have "Crazylegs."

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[i] 90 Wis. 2d 379, 280 N.W.2d 129 (1979)
[ii] 1 Wis. 1 (1853)
[iii] *Guaranty Federal Savings & Loan Assoc. v. Horseshoe Operating Co.*, 748 S.W.2d 519 (Tex. App. 1988)