

What Does It Take to Trademark Your Name?

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Addressing the question of when a professional name can be protected as a trademark, the U.S. Court of Appeals for the Eleventh Circuit found that the plaintiff doctor's name had not acquired that distinction. *Tartell, M.D. v. South Florida Sinus and Allergy Center, Inc., et al.*, Case No. 14-13178 (11th Cir., June 23, 2014) (Pryor, J.).

This story started in 1998 when plaintiff Dr. Paul Tartell and defendant Dr. Lee Mandel practiced together as "Tartell & Mandel, M.D., LLC under the name South Florida Sinus and Allergy Center (SFSAC). In 2011, their joint practice ended and the doctors went their separate ways. After their separation, Dr. Mandel, without Dr. Tartell's knowledge, incorporated under the name of their old practice, obtained the domain name sfsac.com, registered six other domain names that used some variation of Dr. Tartell's name (ptartell.com, paultartellmd.net, paultartellmd.com, paultartell.net, paultartell.com, and tartell.net) and had those domain names forward users to sfsac.com. He also purchased Google AdWords so that the sfsac.com domain appeared as an advertisement whenever someone searched for "Paul Tartell" or "Paul Tartell, MD."

Dr. Tartell filed a complaint alleging federal cybersquatting, false designation of origin, unfair competition, false advertising and unauthorized publication of name and likeness under both federal and state law.

To prevail, Dr. Tartell had to prove that his "descriptive" mark (*i.e.*, his name) was either inherently distinctive or had acquired secondary meaning. For a name to acquire secondary meaning, it must denote to the consumer a single thing or product/service coming from a single producer or source, as opposed to the product or service itself. Evidence tending to prove secondary meaning includes direct evidence, such as consumer surveys or circumstantial evidence. For circumstantial evidence, courts consider the four *Conagra* factors, which include the length and nature of the name's use, the nature and extent of advertising and promotion of the name, the efforts of the proprietor to promote a conscious connection between the name and the business, and the degree of actual recognition by the public that the name designates the proprietor's product or service.

Having no consumer surveys, Dr. Tartell relied on circumstantial evidence, presenting evidence of his name appearing on advertisements, including ads when the two doctors still worked together; academic, community and charity activities; 39 lectures, 11 presentations and 10 medical journal articles; and patient testimonials and referrals. The district court found that Dr. Tartell's name acquired secondary meaning within South Florida based on the "length and prevalence of Dr.

Tartell's overall public use of his name in conjunction with his medical services." It entered judgment in Dr. Tartell's favor on all counts except false advertising and awarded him \$1,000 in statutory damages for each claim for cybersquatting for a total of \$6,000. SFSAC appealed.

The 11th Circuit reversed, concluding that decades-old evidence related to the use of Dr. Tartell's name in academic settings or his reputation among other medical professionals are not probative of whether his name acquired secondary meaning with the target audience: consumers of his medical services and potential patients. Significantly, the 11th Circuit found no substantial evidence relevant to the fourth *Conagra* factor (the degree of actual recognition by the public that the name designates the proprietor's product or service), especially in densely populated South Florida. Indeed, the 11th Circuit found no evidence showing Dr. Tartell's efforts "promote a conscious connection between [his] name and [his] services."

Practice Note: While your reputation among your professional peers is significant, it may not be sufficient proof of secondary meaning for trademark purposes. Thus, when building a professional practice, it is a good practice to insure that your advertising and marketing materials not only "sell" your business but also your name and that they promote a conscious connection between your name and your services in the minds of potential clients.

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