UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF LOUISIANA

MORRIS BART, LLC, ET AL.	CIVIL ACTION
VERSUS	NO: 21-1771
SLOCUMB LAW FIRM, LLC, ET AL.	SECTION: "A" (2)

ORDER AND REASONS

The following motion is before the Court: **Motion to Dismiss for Failure to State a Claim (Rec. Doc. 22)** filed by Defendant, Slocumb Law Firm, LLC (hereinafter "the Slocumb Firm"). The plaintiffs, Morris Bart, LLC and Morris Bart (hereinafter collectively "Bart"), oppose the motion. The motion, submitted for consideration on April 27, 2022, is before the Court on the briefs without oral argument. For the following reasons, the motion is GRANTED IN PART AND DENIED IN PART.

I. Background

Bart has brought this Lanham Act trademark infringement action, which includes related state law claims, against the Slocumb Firm and Michael Slocumb, individually.[1]

[1] Michael Slocumb, individually, is not a movant for purposes of the instant motion. Mr. Slocumb is alleged to be a citizen of Alabama and he has separately filed a motion to dismiss for lack of personal jurisdiction. (Rec. Doc. 23). In response to that motion, Bart filed a motion for leave to conduct jurisdictional discovery. (Rec. Doc. 27). On April 20, 2022, the Court sua sponte stayed both of those motions pending this ruling on the Slocumb Firm's motion to dismiss. (Rec. Doc. 33). The factual allegations in Bart's complaint do not differentiate between the two defendants so to the extent that the Slocumb Firm's motion to dismiss is granted for failure to state a claim, that ruling would necessarily inure to the benefit of Michael Slocumb, individually. If the motion to dismiss for failure to state a claim were granted in its entirety, then the remaining motions would be moot. As it turns out, the motion to dismiss for failure to state a claim is not being granted in its entirety. At the end of this ruling the Court provides instructions to the parties regarding the remaining motions.

Bart is one of the largest personal injury law firms in the gulf region, operating in cities throughout Louisiana, Mississippi, Alabama, and Arkansas. The Slocumb Firm is based in Auburn, Alabama, and it competes with Bart for personal injury clients, including in the New Orleans area where the Slocumb Firm maintains an office. Bart's complaint is that the Slocumb Firm is using Bart's registered trademarks to intentionally deceive and confuse potential clients who are searching specifically for Bart on the internet. The Slocumb Firm allegedly buys keyword advertising that incorporates Bart's registered marks. Then when a Google search is initiated by a user the results will include the Slocumb Firm's sponsored advertising of confusingly similar or generic legal services. For Google searches initiated by users on mobile devices, the Slocumb Firm's advertising returns a "click-to-call" ad such that the resultant link when clicked initiates a phone call to a predetermined number directed to the advertiser.[2]

Bart's Complaint includes counts under the Lanham Act, Louisiana and common law trademark infringement, the Louisiana Unfair Trade Practices Act, misappropriation of name or likeness, misappropriation of business opportunity, tortious inference with business opportunity, and unjust enrichment.

The Slocumb Firm moves to dismiss the complaint for failure to state a claim on which relief can be granted pursuant to Federal Rule of Civil Procedure Rule 12(b)(6). The Slocumb Firm argues that Bart's complaint fails because the Slocum Firm's advertising does not include Bart's marks, is not confusing as a matter of law, and

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[2] Bart's complaint is lengthy. The foregoing summary of the allegations is taken for the most part from paragraph 6 of the Complaint.

contains only generic advertising. The Slocumb Firm contends that Bart's complaint includes no factual support to suggest otherwise and therefore cannot state a claim for trademark infringement.

II. Discussion

In the context of a motion to dismiss the Court must accept all factual allegations in the complaint as true and draw all reasonable inferences in the plaintiff's favor. *Lormand v. US Unwired, Inc.*, 565 F.3d 228, 232 (5th Cir. 2009) (citing *Tellabs, Inc. v. Makor Issues & Rights*, Ltd., 551 U.S. 308 (2007); *Scheuer v. Rhodes*, 416 U.S. 232, 236 (1974); *Lovick v. Ritemoney, Ltd.*, 378 F.3d 433, 437 (5th Cir. 2004)). However, the foregoing tenet is inapplicable to legal conclusions. *Ashcroft v. Iqbal*, 129 S. Ct. 1937, 1949 (2009). Thread-bare recitals of the elements of a cause of action, supported by mere conclusory statements, do not suffice. *Id.* (citing *Bell Atlantic Corp. v. Twombly*, 550, U.S. 544, 555 (2007)).

The central issue in a Rule 12(b)(6) motion to dismiss is whether, in the light most favorable to the plaintiff, the complaint states a valid claim for relief. *Gentilello v. Rege*, 627 F.3d 540, 544 (5th Cir. 2010) (quoting *Doe v. MySpace, Inc.*, 528 F.3d 413, 418 (5th Cir. 2008)). To avoid dismissal, a plaintiff must plead sufficient facts to "state a claim for relief that is plausible on its face." *Id.* (quoting *Iqbal*, 129 S. Ct. at 1949). "A claim has facial plausibility when the plaintiff pleads factual content that allows the court to draw the reasonable inference that the defendant is liable for the misconduct alleged." *Id.* The Court does not accept as true "conclusory allegations, unwarranted factual inferences, or legal conclusions." *Id.* (quoting *Plotkin v. IP Axess, Inc.*, 407 F.3d

690, 696 (5th Cir. 2005)). Legal conclusions must be supported by factual allegations. *Id.* (quoting *Iqbal*, 129 S. Ct. at 1950). Notwithstanding the foregoing, it remains that motions to dismiss under Rule 12(b)(6) are generally viewed with disfavor as a means of disposing with a case on the merits, and therefore are rarely granted. *Lowrey v. Texas A&M Univ. Sys.*, 117 F.3d 242, 247 (5th Cir. 1997) (citing *Kaiser Alum. & Chem. Sales v. Avondale Ships.*, 677 F.2d 1045, 1050 (5th Cir. 1982)).

Counts I and II of the Complaint are federal trademark infringement claims under the Lanham Act. Section 32 of the Act creates a cause of action for infringement of registered marks; Section 43 creates a cause of action for infringement of unregistered marks. 15 U.S.C. §§ 1114(1) & 1125(a). The same elements apply to both causes of action. *Adler v. McNeil Consultants, LLC*, 10 F.4th 422, 426 (5th Cir. 2021) (citing *Amazing Spaces, Inc. v. Metro Mini Storage*, 608 F.3d 225, 236 n.8 (5th Cir. 2010)). To plead a claim for trademark infringement in violation of the Lanham Act, a plaintiff must allege that 1) the plaintiff possesses a legally protectable trademark, and 2) the defendant's use of the trademark creates a "likelihood of confusion" as to source, affiliation, or sponsorship. *Id.* (quoting *Streamline Prod. Sys., Inc. v. Streamline Mfg., Inc.*, 851 F.3d 440, 450 (5th Cir. 2017)).

A likelihood of confusion is "the gravamen for any action of trademark infringement." *Adler,* 10 F.4th at 426-27 (quoting *Soc'y of Fin. Exam'rs v. Nat'l Ass'n of Certified Fraud Exam'rs, Inc.*, 41 F.3d223, 225 (5th Cir. 1995)). In this circuit courts use a non-exhaustive list of factors known as the "digits of confusion" to evaluate whether there is a likelihood of confusion. *Id.* at 427 (citing *Extreme Lashes, LLC v. Xtended*

Beauty, Inc., 576 F.3d 221, 227 (5th Cir. 2009)). The initially identified digits are (1) the type of trademark; (2) mark similarity; (3) product similarity; (4) outlet and purchaser identity; (5) advertising media identity; (6) defendant's intent; (7) actual confusion; and (8) care exercised by potential purchasers. *Id.* These digits are fact-specific and flexible, and serve merely as examples of what should be considered; and no digit is dispositive of the analysis.[3] *Id.*

The parties agree that the relatively recent decision in *Adler v. McNeil Consultants, LLC*, *supra*, a case remarkably similar to this one, addresses the issues pertinent to the motion to dismiss Counts I and II of the Complaint.[4]

Adler was a Texas personal injury attorney with several trademarks that were consistently used by him and his law firm to market his services. The defendant McNeil operated a lawyer-referral website that solicited and referred personal injury cases to lawyers who had contracted with McNeil for that service. McNeil purchased Google keyword ads for Adler's marks, which ensured that an advertisement for McNeil's

[3] The Fifth Circuit clarified in *Adler* that the fact-dependent nature of the likelihood of confusion evaluation does not mean that it can never be decided on a motion to dismiss. *Adler*, 10 F.4th at 428. For instance, where the factual allegations regarding consumer confusion are implausible a motion to dismiss may be well-founded. *Id.* at 428-29.

[4] Again, Counts I and II of the Complaint are federal trademark infringement claims brought under the Lanham Act. Count III of the Complaint is trademark infringement brought under Louisiana law and something referred to as "the common law of the Gulf Coast states beyond the borders of the State of Louisiana in which the Plaintiffs do business." (Complaint ¶ 68). Bart has clarified in his opposition that he only intends to pursue claims under Louisiana law in conjunction with Count III. (Rec. Doc. 26, Opposition at 9 n.6). The parties agree that the same analysis for purposes of Rule 12(b)(6) applies to both the federal and state trademark infringement claims. Therefore, no separate analysis is necessary for Count III, as it will follow the same outcome as Counts I and II.

services would appear when a user would perform a Google search using an Adler mark as a search term. McNeil also purchased "click-to-call" ads such that if a user clicked on the resulting advertisement using a mobile phone, the user's phone would place a call to a number manned by McNeil's representatives. Adler sued McNeil for trademark infringement under the Lanham Act, and McNeil moved to dismiss the complaint for failure to state a claim. The district court granted the motion to dismiss, Adler appealed, and the Fifth Circuit reversed in Adler's favor. *Adler*, 10 F.4th at 425.

The *Adler* decision was the first opportunity that the Fifth Circuit had to analyze initial interest confusion—which is how the appellate court characterized Adler's allegations of likelihood of confusion—in the context of search engine advertising. "Initial interest confusion" is confusion that "creates initial consumer interest, even though no actual sale is finally completed as a result of the confusion." *Adler*, 10 F.4th at 427 (quoting *Elvis Presley Enters., Inc. v. Capece*, 141 F.3d 188, 204 (5th Cir. 1998)). The Fifth Circuit had previously held (outside the context of internet searches) that initial interest confusion is actionable under the Lanham Act. *Id.*

Importantly, the Fifth Circuit explained that distraction alone is insufficient to constitute consumer confusion, which is the critical issue for purposes of the Lanham Act. *Id.* at 428. Likewise, the mere purchase of trademarks as keywords for search-engine advertising is not by itself actionable as trademark infringement. *Id.* at 429. But perhaps even more important was the Fifth Circuit's conclusion that Adler's claims did not fail simply because McNeil's use of Adler's marks was behind the scenes and not visible to the consumer. *Id.* Whether an advertisement incorporates a trademark that is

visible to the consumer is a relevant but not dispositive factor in determining a likelihood of confusion in search-engine advertising cases. *Adler*, 10 F.4th at 430.

The Slocumb Firm argues in its motion to dismiss that merely purchasing keywords, including trademarked ones, and using them to display an advertisement that does not contain those marks does not constitute trademark infringement. The Slocumb Firm also argues that Bart cannot claim generic terms as protected marks. While the Slocum Firm is correct on both arguments—Bart does not dispute this—the Slocum Firm is reading Bart's complaint too narrowly because he is not alleging trademark infringement based upon the mere purchase of his marks (and use behind the scenes in keyword Google searches) nor is he claiming the rights to generic terms. What Bart claims is that the advertising that results from the use of his marks is purposely and intentionally deceptive and misleading *because of its generic nature*. (Complaint ¶ 34). Therefore, a potential client using the Bart mark to search for Bart will obtain a result that does not clearly indicate that it belongs to the Slocumb Firm and not to Bart. (*Id.*). This is the initial interest confusion that Bart alleges; whether it may ultimately prove to be a mere distraction and therefore fall short of being actionable is not an issue that the Court can resolve on the pleadings alone.

Similarly, with the click-to-call ads, Bart alleges that the Slocum Firm's representatives are trained to answer the calls with generic, non-identifying greetings such as "did you have an accident," or "tell me about your accident," hoping to keep the confused consumer on the line long enough to build a rapport and convince them to engage the Slocumb Firm instead of Bart. (Complaint ¶ 42). Again, whether this may

ultimately prove to be a mere distraction and therefore fall short of being actionable is not an issue that the Court can resolve on the pleadings alone.

In sum, the Court is persuaded that Bart's allegations in support of Counts I and II are certainly plausible insofar as they allege initial interest confusion. Following the *Adler* decision, the Court denies the Slocumb Firm's motion to dismiss Counts I and II under the Lanham Act. The motion to dismiss is likewise denied as to Count III, state law trademark infringement.[5] *See* footnote 4, supra.

Count IV of the Complaint seeks recovery for unfair and deceptive trade practices in violation of Louisiana's Unfair Trade Practices and Consumer Protection Law ("LUTPA"), La. R.S. § 51:1401, *et seq.* The Slocumb Firm argues that the Complaint fails to allege the kind of fraudulent conduct covered by the Act, and it contains no factual allegations to suggest anything substantially injurious to consumers.

In LUTPA, the legislature declared it to be unlawful to engage in "unfair methods of competition and unfair or deceptive acts or practices in the conduct of any trade or commerce." *Quality Env't Processes, Inc. v. I.P. Petroleum Co.*, 144 So. 3d 1011, 1025 (La. 2014) (quoting La. R.S. § 51:1405). Because of the "broad sweep" of this language, courts use a case-by-case approach to determine whether the conduct alleged potentially falls under the LUTPA. *See id.* But the Louisiana Supreme Court has consistently held that a LUTPA plaintiff must show that "the alleged conduct offends established public policy and is immoral, unethical, oppressive, unscrupulous, or

[5] While the Slocumb Firm reads the Complaint too narrowly, the firm rightly complains about the nature of the factual allegations. It appears that Bart used the *Adler* decision as a roadmap for pleading his case which does make some of the allegations appear conclusory.

substantially injurious." *Id.* (quoting *Cheramie Services, Inc. v. Shell Deepwater Prod.,* 35 So.3d 1053, 1059 (La. 2010)). As such, the range of conduct that supports a claim under LUTPA is "extremely narrow," and must involve fraud, misrepresentation, or similar conduct; not mere negligence. *Quality Env't Processes,* 144 So. 3d at 1025 (citing *Cheramie Servs.*, 35 So. 3d at 1059; Keith E. Andrews, Comment, *Louisiana Unfair Trade Practices Act: Broad Language and Generous Remedies Supplemented by a Confusing Body of Case Law,* 41 Loy. L. Rev. 759, 763 (1996)).

Again, the Slocum Firm reads Bart's Complaint too narrowly by focusing on the purchase of the marks, which in and of itself is not actionable. The Court is persuaded that the motion to dismiss the Count IV LUTPA claim must be denied based on the same reasoning applicable to the trademark infringement claim.[6]

The Court agrees with the Slocum Firm's contention that Bart fails to allege a claim under Louisiana law for misappropriation of name or likeness in Count V.

A claim for misappropriation of name or likeness is part of the tort of invasion of privacy recognized in Louisiana. *See Tatum v. New Orleans Aviation Bd.*, 102 So. 3d 144, 146 (La. App. 4th Cir. 2012). The right of privacy embraces four different interests, each of which may be invaded in a distinct fashion: (1) the appropriation of an individual's name or likeness for the use or benefit of the defendant; (2) an

[6] To be clear, the Court is not suggesting that a meritorious trademark infringement claim *ipso facto* leads to the conclusion that the LUTPA has been violated. Given the narrow reach of the LUTPA and the particularly egregious nature of the conduct that it applies to, there may be situations where trademark infringement alone is not enough to make out a LUTPA claim. For now, the Court determines only that the claim cannot be rejected on the pleadings.

unreasonable intrusion by the defendant upon the plaintiff's physical solitude or seclusion; (3) publicity that unreasonably places the plaintiff in a false light before the public; and (4) unreasonable public disclosure of embarrassing private facts. *Slocum v. Sears Roebuck & Co.*, 542 So. 2d 777, 778 (La. App. 3d Cir. 1989) (citing *Jaubert v. Crowley Post–Signal, Inc.,* 375 So. 2d 1386 (La.1979)).

The Court is persuaded that none of Bart's allegations satisfy the elements of this cause of action. In fact, Bart's allegations are contrary to this cause of action because the basis of the complained of conduct is that the advertisements that result—which do not include either Bart's marks, name, or likeness—are generic in nature leading to confusion. The motion to dismiss is granted as to Count V.

The motion to dismiss is denied as to the Count VI misappropriation of business opportunity claim. The only case cited by the Slocumb Firm for the proposition that misappropriation of business opportunity is included under "unfair competition" is a Texas case that was decided under Texas law. (Rec. Doc. 22-1, Memo in Support at 8 n. 2). As explained above the LUTPA is narrow in application and therefore not likely as broad as Texas' unfair competition "umbrella." *Seatrax, Inc. v. Sonbeck Intern., Inc.*, 200 F.3d 358, 367 (5th Cir. 2000).

Count VII of the Complaint is for tortious interference with a business opportunity. The Slocumb Firm argues that Bart's allegations do not support this claim because there is no allegation of malice and the allegations support no other inference than the Slocumb Firm's actions were motived by profit alone, which is not actionable.

Louisiana courts have recognized a cause of action for tortious interference with

business relations. *Bogues v. Louisiana Energy Consul., Inc.*, 71 So. 3d 1128, 1134 (La. App. 2d Cir. 2011) (citing *Junior Money Bags, Ltd. v. Segal,* 970 F.2d 1 (5th Cir.1992); *Dussouy v. Gulf Coast Inv. Corp.,* 660 F.2d 594 (5th Cir.1981)). Tortious interference is based on the principle that the right to influence others not to enter into business relationships with others is not absolute. *Id.* The cause of action, while recognized, is not favored. *St. Landry Homestead Fed. Sav. Bank v. Vidrine*, 118 So. 3d 470, 490 (La. App. 3d Cir. 2013) (citing *Bogues*, 71 So. 3d at 1134-35). Therefore, Louisiana courts have limited the scope of this cause of action by imposing the element of "actual malice." *Id.*

Even if the allegations are construed to suggest that the Slocum Firm improperly influenced others not to deal with Bart, that is not sufficient to state a claim for tortious interference with business relations under Louisiana law. Actual malice is not pleaded, and none of the factual allegations under their broadest construction imply malice. The motion to dismiss is granted as to the Count VII tortious interference claim.

Bart has withdrawn the Count VIII unjust enrichment claim. (Rec. Doc. 26, Opposition at 13). The motion to dismiss is therefore moot as to this claim.

Accordingly;

IT IS ORDERED that the **Motion to Dismiss for Failure to State a Claim (Rec. Doc. 22)** filed by Defendant, Slocumb Law Firm, LLC, is **GRANTED IN PART AND DENIED IN PART** as explained above.

IT IS FURTHER ORDERED that the stay previously entered as to the **Motion to Dismiss for Lack of Personal Jurisdiction (Rec. Doc. 23)** filed by Michael Slocumb

and the **Motion to Conduct Jurisdictional Discovery (Rec. Doc. 27)** filed by Bart is **VACATED**. These motions are reset for submission on **June 22, 2022**, on the briefs. Responses are due in accordance with the Local Rules of this district.

May 25, 2022

JAY C. ZAINEY
UNITED STATES DISTRICT JUDGE