

**UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF WISCONSIN**

STATE BAR OF WISCONSIN,

Plaintiff,

v.

Civil Action No. 11-CV-586
Jury Trial Demanded

LEXISNEXIS
(a division of Reed Elsevier, Inc.),

Defendant.

COMPLAINT FOR TRADEMARK INFRINGEMENT

GODFREY & KAHN, S.C.

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The plaintiff, State Bar of Wisconsin, by and through its attorneys, Godfrey & Kahn, S.C., brings the following Complaint against the defendant, LexisNexis:

INTRODUCTION

1. This is an action for infringement of the State Bar's Pillar Icon trademark, shown below:



The State Bar adopted the Pillar Icon after a careful screening for conflicting marks, and it applied for and received federal registration of the Pillar Icon. The State Bar uses the Pillar Icon in connection with all its services, which are provided to lawyers and members of the public for the purpose of improving the justice system and legal profession, and to facilitate the delivery of legal services and information to the public. A copy of the certificate of registration for the Pillar Icon is attached as Exhibit A.

2. LexisNexis has recently adopted a mark strikingly similar to the Pillar Icon, shown below:



LexisNexis uses this mark in connection with its Lawyers.com website, which provides lawyer finding tools and legal resources to the public. LexisNexis has not sought or received registration of its infringing pillar mark. Upon information and belief, LexisNexis conducted no trademark screening before adopting its infringing pillar mark.

3. Consumer confusion is inevitable. If LexisNexis' infringement continues, members of the public and the legal profession will be confused into thinking—incorrectly—that

there is some affiliation or relationship between the Lawyers.com services and the services offered by the State Bar. To protect its own investment in the Pillar Icon, and to protect the public and the legal profession from this inevitable confusion, the State Bar seeks declaratory and injunctive relief preventing LexisNexis from the continued use of its infringing pillar mark.

THE PARTIES

4. The plaintiff State Bar of Wisconsin is a Wisconsin professional association, constituted by and operating under the auspices of the Wisconsin Supreme Court. The State Bar's offices are located at 5302 Eastpark Blvd., Madison, Wisconsin 53718.

5. The defendant LexisNexis provides legal and public records information databases, serving customers in more than 100 countries with more than 15,000 employees worldwide. The principal offices of LexisNexis are located at 9443 Springboro Pike, Miamisburg, Ohio 45342.

6. Upon information and belief, LexisNexis is a division of Reed Elsevier, Inc., which is a Delaware corporation, registered to do business in Wisconsin. The principal offices of Reed Elsevier, Inc. are located at 2 Newton Place, Suite 350, Newton, Massachusetts 02458.

JURISDICTION AND VENUE

7. This matter arises under the laws of the United States, specifically 15 U.S.C. §§ 1114 and 1125. This Court therefore has original jurisdiction over this action pursuant to 28 U.S.C. §§ 1331 and 1338. The Court has the authority to grant declaratory relief pursuant to 28 U.S.C. §§ 2201 and 2202.

8. This Court has supplemental jurisdiction over the State Bar's state law claim pursuant to 28 U.S.C. § 1367 because that claim is so related to the federal claims that they form part of the same case or controversy.

9. The Court has personal jurisdiction over LexisNexis pursuant to Wis. Stat. § 801.05(1) because LexisNexis is engaged in substantial and not isolated activities in this state and judicial district, including maintaining offices and employees here. Personal jurisdiction over LexisNexis is also proper under Wis. Stat. § 801.05(4) because the State Bar has suffered injury within this state and judicial district while LexisNexis has carried on solicitation and service activities here. This Court's exercise of personal jurisdiction over LexisNexis comports with the Due Process Clause of the United States Constitution.

10. Venue is proper in this judicial district pursuant to 28 U.S.C. § 1391(b) because the defendant LexisNexis is deemed to reside in this judicial district, and because a substantial part of the events giving rise to the State Bar's claims occurred in this judicial district.

FACTUAL BACKGROUND

The State Bar and Its Trademarks

11. The State Bar began as a voluntary association of Wisconsin lawyers in 1878. It currently operates under the auspices of the Wisconsin Supreme Court. The State Bar's 24,000 members include all attorneys licensed to practice law in Wisconsin. The State Bar's membership includes 7,600 non-resident attorneys located throughout the United States and beyond.

12. The mission of the State Bar, as established in Wisconsin Supreme Court Rule 10.02(2), includes aiding the courts in the administration of justice, fostering high ideals and skills within the profession, representing the professional interests of lawyers, and serving citizens by facilitating the delivery of legal services and providing education and informed discussion of the law.

13. The activities of the State Bar are supported, in part, by dues paid by its members. The majority of the State Bar's budget, however, is provided by sales of a broad range of products and services, including its highly regarded books, seminars and publications.

14. The State Bar also provides a range of services to the public. Among the most significant of these services is the LegalExplorer website, available at www.legalexplorer.com. The State Bar's LegalExplorer website provides lawyer-finding tools, information on legal topics and other legal resources for the public. A copy of the home page of LegalExplorer is attached as Exhibit B.

15. The State Bar maintains a portfolio of trademarks that it uses to promote and distinguish its goods and services. The State Bar's currently used and federally registered or registration-pending marks include:

- STATE BAR OF WISCONSIN
U.S. Registration No. 4005002
- PINNACLE
U.S. Registration No. 4013233
- PILLAR ICON
U.S. Registration No. 3945835
- REACH NEW HEIGHTS IN YOUR PRACTICE
U.S. Registration No. 3952559
- YOUR PRACTICE. OUR PURPOSE.
U.S. Registration No. 4013234
- LEADERS IN THE LAW. ADVOCATES FOR JUSTICE.
U.S. Registration approved; issue of certificate pending
- WISBAR
U.S. Registration No. 3741623
- WISCONSIN LAWYERS EXPERT ADVISERS. SERVING YOU.
U.S. Registration No. 2764231

16. The Pillar Icon, at issue in this case, was selected and adopted by the State Bar as part of a the creation of a new brand image intended to facilitate the nationwide sales and distribution of the State Bar's goods and services. Before adopting the Pillar Icon, the State Bar conducted a search for potentially conflicting marks.

17. The State Bar applied for federal trademark registration of the Pillar Icon on February 18, 2010 on an "intent to use basis" pursuant to 15 U.S.C. § 1051(b). That application was duly examined and approved by the United States Trademark Office.

18. The State Bar began use of the Pillar Icon at least as early as June 1, 2010.

19. The State Bar submitted to the United States Trademark Office specimens demonstrating its use of the Pillar Icon on February 7, 2011. The United States Trademark Office issued the registration on April 12, 2011.

20. The State Bar's federal registration of the Pillar Icon is prima facie evidence of the validity of the mark and the State Bar's ownership of it, pursuant to 15 U.S.C. § 1115(a). The registration is also prima facie evidence that the State Bar has the nationwide exclusive right to use the Pillar Icon in connection with the goods and services specified in the registration, effective as of the date of its application, February 18, 2010.

21. The State Bar also has trademark rights under Wisconsin law, dating from the State Bar's first use of the Pillar Icon, which was at least as early as June 1, 2010.

LexisNexis and its Infringing Pillar Mark

22. The defendant LexisNexis provides databases of publications, legal documents and public records. It is well known in the legal profession for the Lexis on-line legal research service, used by attorneys throughout the United States and the world.

23. LexisNexis also owns and operates Lawyers.com, a website that provides information about lawyers and the law to the public. A copy of the home page of Lawyers.com is attached as Exhibit C.

24. Lawyers.com provides lawyer-finding tools which allow users to find lawyers by geographic region or by area of law. Upon information and belief, the lawyer-finding tools are of Lawyers.com are based on the data in the Martindale-Hubbell directory, which like LexisNexis, is also part of Reed Elsevier.

25. Lawyers.com also provides legal research resources, legal information by topic, and “do it yourself” legal forms.

26. LexisNexis has only recently began use of its infringing pillar mark on Lawyers.com. LexisNexis’ first use of the infringing pillar mark occurred well after the State Bar applied for registration of the Pillar Icon, well after the State Bar began using the Pillar Icon, and upon information and belief, well after the U.S. Trademark Office issued the registration for the Pillar Icon.

27. Upon information and belief, LexisNexis conducted no search for potentially conflicting marks before it adopted its infringing pillar mark.

Confusion Caused by LexisNexis’ Infringement

28. The services provide by LexisNexis through Lawyers.com are highly related to the services provide by the State Bar. Both LexisNexis and the State Bar direct many of their services to attorneys. Indeed, some of the services are identical to and competitive with those offered by the State Bar.

29. The services provided at Lawyers.com substantially overlap the services provided by the State Bar through LegalExplorer.

30. The lawyer-finding tools provided through Lawyers.com are highly related and potentially in competition with the Lawyer Referral and Information Service provided by the State Bar as a service to its members and the public.

31. The legal research resources available through Lawyers.com are similar to, and competitive with, the legal research resources provided by the State Bar.

32. The information on legal topics available through Lawyers.com is highly related, and may be competitive with, the legal publications of the State Bar.

33. LexisNexis' use of its infringing pillar mark on Lawyers.com will inevitably cause consumer confusion as to the source, affiliation or sponsorship of the services provided through Lawyers.com.

34. The Lawyers.com article on trademarks (available at <http://intellectual-property.lawyers.com/trademarks/Trademarks.html>) explains the damage caused by the unauthorized use of confusingly similar trademarks:

Trademarks also protect the investment the maker of a product has in the product. Part of this is goodwill. It's unfair for a rival or competing business to play off of the popularity of a particular product or service by using the same or similar mark. This rival or competitor could obtain business based on the quality or years you've spent building your brand name. What's more, your fine product's reputation could be damaged if consumers purchase an inferior product believing it to be yours because of a similar trademark. That's unfair, and trademark law makes it illegal.

35. The State Bar, its members, and the public have been damaged by LexisNexis' use of its infringing pillar mark, and the State Bar will be irreparably harmed unless LexisNexis' infringement is enjoined.

FIRST CAUSE OF ACTION
Trademark Infringement
15 U.S.C. § 1114

36. Paragraphs 1 through 35 of this Complaint are incorporated here by reference.

37. The Pillar Icon is a valid, federally registered trademark owned by the State Bar.

38. LexisNexis uses in commerce a reproduction, counterfeit, copy, or colorable imitation of the Pillar Icon

39. LexisNexis uses the reproduction, counterfeit, copy, or colorable imitation of the Pillar Icon in connection with the goods and services that are the same or closely related to those specified in the State Bar's registration.

40. LexisNexis' use of its reproduction, counterfeit, copy, or colorable imitation of the Pillar Icon is likely to cause confusion, to cause mistake, or to deceive.

41. LexisNexis use of its reproduction, counterfeit, copy, or colorable imitation of the Pillar Icon is without the State Bar's consent.

42. LexisNexis use of its reproduction, counterfeit, copy, or colorable imitation of the Pillar Icon will cause damage and irreparable harm to the State Bar.

43. LexisNexis has violated 15 U.S.C. § 1114, entitling the State Bar to judgment so declaring and an injunction prohibiting LexisNexis from using its infringing pillar mark.

SECOND CAUSE OF ACTION
False Designation of Origin
15 U.S.C. § 1125

44. Paragraphs 1 through 43 of this Complaint are incorporated here by reference.

45. LexisNexis uses in commerce a symbol that is likely to cause confusion, to cause mistake, or to deceive as to the origin, sponsorship or approval of its services.

46. The State Bar is likely to be damaged by LexisNexis use of the symbol and the confusion that results.

47. LexisNexis has violated 15 U.S.C. § 1125, entitling the State Bar to judgment so declaring and an injunction prohibiting LexisNexis from using its infringing pillar mark.

THIRD CAUSE OF ACTION
Common Law Trademark Infringement

48. Paragraphs 1 through 47 of this Complaint are incorporated here by reference.

49. The Pillar Icon is distinctive trademark that identifies goods and services provided by the State Bar.

50. LexisNexis uses in connection with its own goods and services a pillar mark that is striking similar to the State Bar's Pillar Icon.

51. LexisNexis' use of its pillar mark is likely to cause confusion, to cause mistake, or to deceive as to the origin, sponsorship or approval of its services.

52. LexisNexis' use of its pillar mark will cause damage and irreparable harm to the State Bar.

53. LexisNexis has violated the State Bar's rights under the common law of Wisconsin, entitling the State Bar to judgment so declaring and an injunction prohibiting LexisNexis from using its infringing pillar mark.

WHEREFORE, Plaintiff State Bar of Wisconsin requests the following:

1. A declaration that LexisNexis' pillar mark infringes the rights of the State Bar;
2. An injunction prohibiting LexisNexis from any further use of its infringing pillar mark, or any other mark that is confusingly similar to the Pillar Icon;
3. Judgment against LexisNexis in favor of the State Bar for the costs of this action;
4. Judgment against LexisNexis in favor of the State Bar for the State Bar's reasonable actual attorney fees pursuant to 15 U.S.C. § 1117(a); and,

5. Any further relief to the State Bar as this Court may deem appropriate.

The State Bar of Wisconsin demands a jury on all issues so triable.

Dated: August 19, 2011.

Respectfully submitted,

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