



# Ohio Board of Professional Conduct

## OPINION 2020-12

Issued December 11, 2020

### Lawyer or Law Firm Use of Service Mark

**SYLLABUS:** A lawyer or law firm may register and use a service mark in communications and advertising. A service mark used by a lawyer or law firm cannot be false, misleading, or nonverifiable. A service mark that implies certain results, expediency, or a connection to a governmental, nonprofit, or charitable organization is inherently false or misleading. A lawyer may not use the terms “pros” or “pro” in a registered service mark regardless of whether the lawyer has been certified as a specialist in an area of law. A lawyer or law firm may register and use a service mark to convey a limitation or concentration in a particular field of law. A lawyer or law firm may only use a service mark in written or oral communications in conjunction with the formal legal name of the law firm.

This nonbinding advisory opinion is issued by the Ohio Board of Professional Conduct in response to a prospective or hypothetical question regarding the application of ethics rules applicable to Ohio judges and lawyers. The Ohio Board of Professional Conduct is solely responsible for the content of this advisory opinion, and the advice contained in this opinion does not reflect and should not be construed as reflecting the opinion of the Supreme Court of Ohio. Questions regarding this advisory opinion should be directed to the staff of the Ohio Board of Professional Conduct.



# Ohio Board of Professional Conduct

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### QUESTION PRESENTED:

- 1) Whether a lawyer or a law firm may use a service mark such as “The Residential Real Estate Pro” or “The Appeals Pro” in advertising and letterhead in conjunction with a firm name that complies with the Rules of Professional Conduct if the service mark is properly registered.
- 2) Whether a lawyer or law firm may use a service mark such as “The Residential Real Estate Pro,” “The Bankruptcy Pro” or the “The Federal Taxation Pro,” to communicate the fact that the lawyer concentrates his or her practice in a particular field of law when the lawyer has not been certified as a specialist in the area of law identified by the service mark.

- 3) Whether a lawyer is permitted to identify an area of the law for which the lawyer has been certified as a specialist by a service mark such as “The Residential Real Estate Pro,” “The Bankruptcy Pro” or “The Federal Taxation Pro,” in advertising material or on firm letterhead.

**APPLICABLE RULES:** Prof.Cond.R. 7.1, 7.2, 7.4, 7.5

**OPINION:** The Rules of Professional Conduct do not expressly reference the use by a lawyer or law firm of a service mark. A service mark is defined by R.C. §1329.54(B) as “any word, name, symbol, device, or combination of any word, name, symbol, or device, that is adopted and used by a person to identify and distinguish the services of that person, including a unique service, from the services of other persons and to indicate the source of the services, even if that source is unknown.” In contrast, and for purposes of the subsequent analysis, R.C. §1329.01(A)(1) defines a “trade name” as a “name used in business or trade to designate the business of the user and to which the user asserts a right to exclusive use.” In short, trade names identify businesses, and service marks identify the service or services a business provides. For example, a law firm decides to adopt the trade name “Guardian Law, LLC” and later registers the service mark “Protecting the Unprotected.”

#### *Permissible Use of Service Mark*

The use of a properly registered service mark by a lawyer or law firm in lawyer communications or advertising is generally permitted under the Rules of Professional Conduct. Because a “service mark,” by statutory definition, is different from a “trade name,” the Board advises that a service mark not be used as a substitution for a law firm name ordinarily permitted under Prof.Cond.R. 7.5 (permitting a lawyer or law firm to use a trade name or a name that includes the name or surname(s) of one or more lawyers in the firm.) In the previous example, it would be improper for the law firm “Guardian Law, LLC” to begin using the service mark “Protecting the Unprotected” in lieu of its formal law firm name. The Board further advises that a lawyer’s or law firm’s use of service mark must always be used in conjunction with the formal legal name of the law firm in written or oral communications in order to properly identify the lawyer or law firm making the communication. Prof.Cond.R. 7.2(c). For example, the name of the law firm “Guardian Law, LLC” must appear in any oral or written communications whenever the service mark “Protecting the Unprotected” is used.

*False, Misleading, or Nonverifiable Service Marks*

The advertising of a lawyer's services is specifically permitted by Prof.Cond.R. 7.2. Prof.Cond.R. 7.2 permits public dissemination of information by a lawyer that might invite the attention of those seeking legal assistance. *Id.*, cmt. [2]. Information that may be publicly disseminated through advertising includes, but is not limited to a lawyer's name, firm name, address, email address, website, and the kinds of services the lawyer will undertake. *Id.* A service mark is a type of information about the kinds of services a lawyer may provide to a prospective client. Phrases such as "The Legal Edge" or "The Legal Advantage" are examples of permissible service marks that could be registered with the state as long as they comply with Prof.Cond.R. 7.1.

When using a registered service mark, a lawyer must avoid communications about the lawyer, the law firm, or his or her legal services, that are false, misleading, or nonverifiable. Prof.Cond.R.7.1. False or misleading communications by lawyers through advertising are not constitutionally protected. *Zauderer v. Office of Disciplinary Counsel*, 471 U.S. 626, 105 S.Ct. 2265 (1985). Because a service mark may contain one word, a combination of words, a symbol, or device, it may be considered misleading if it contains a material misrepresentation of fact or omits a fact necessary to make the service mark, considered as a whole, not materially misleading. Prof.Cond.R. 7.1, cmt. [2]. A service mark may also be considered misleading if a substantial likelihood exists that it will lead a prospective client to formulate a specific conclusion about the lawyer or the lawyer's services for which there is no reasonable factual foundation. *Id.* For example, a service mark that implies results, such as "We Never Lose" or "Insuring Your Victory," would be considered misleading because it could lead a reasonable person or a prospective client to form an unjustified expectation that certain results can be obtained from the lawyer or firm. *Id.*, cmt.[3]. In addition, service marks that imply a connection to a governmental agency, expediency, or a connection to an existing nonprofit or charitable organization, are inherently false or misleading and implicate Prof.Cond.R. 7.1.

*Communicating Lawyer Specialization Through a Service Mark*

A lawyer may not imply or state a specialization in an area of law unless the lawyer is certified as a specialist in a field of law recognized by the Supreme Court Commission on Certification of Attorneys as Specialists. Prof.Cond.R. 7.4. In Adv. Op. 2005-06, the

Board concluded that it was improper under former DR- 2-105 for lawyers to use the term “expert” in lawyer advertising, even if the lawyer seeking to use the term qualified under the exception in the former rule to communicate a recognized specialization in an area of the law. Analyzing the former rule, the Board concluded that lawyers certified as specialists were “not authorized to make claims that they are ‘experts.’”

Prof.Cond.R. 7.4(e) expressly permits a lawyer certified as a specialist to state that he or she is a “specialist,” but is silent as to the use of other similar terms. Because Prof.Cond.R. 7.4 substantially conforms to former DR 2-105, the Board sees no reason to deviate from its prior holding concerning the use of the term “expert” and concludes that the use of the term “pros” or “pro” by a lawyer or law firm through the use service mark implies that the lawyer or firm specializes in an area of law and is prohibited by Prof.Cond.R. 7.4(e). In addition, the use of the terms “pros” or “pro” may also be misleading or nonverifiable. Prof.Cond.R. 7.1. Consequently, the Board concludes that a lawyer or law firm may not use the term “pros” or “pro” in a service mark even in instances where the lawyer has been certified as a specialist. A lawyer may, however, register and use a service mark to convey that his or her practice consists in large part or is limited to a field or fields of law, *e.g.*, “The Home Buyer’s Lawyer” or “Columbus Probate Lawyers.” *See* Prof.Cond.R. 7.4(a).

**CONCLUSION:** Registered service marks may be used by lawyers or law firms, but cannot be used in the place of a law firm name otherwise permitted by Prof.Cond.R. 7.5. Service marks constitute a form of communication or advertisement by a lawyer that cannot be false, misleading, or nonverifiable. Service marks that imply results, expediency, or a connection to a government agency, nonprofit, or charitable organization are inherently misleading and implicate Prof.Cond.R. 7.1. A service mark should only be used in conjunction with the formal legal name of a law firm. A lawyer or law firm may not use a service mark that uses the terms “pros” or “pro,” even in instances where a lawyer is certified as a specialist by the Supreme Court Commission on Certification of Attorneys as Specialists. A lawyer or law firm may register and use a service mark to convey a limitation or concentration in a particular field of law