

## BLOGS

Post-Termination Injunctions: Trademarks

# Wisconsin Federal Court Grants Preliminary Injunction Prohibiting Former Franchisee's Use of Similar Trademark

A federal district court in Wisconsin has granted a franchisor's motion for a preliminary injunction against a former franchisee who continued to use a variation of the franchisor's trademark after entering into a Franchise Termination Agreement. *Dent Doctor, Inc. v. Dent Clinic, Inc.*, 2014 WL 7139831 (E.D. Wis. Dec. 12, 2014). Dent Clinic operated a Dent Doctor franchise from 1993 to 2012 until the parties entered into the termination agreement. The agreement required Dent Clinic to cease using the trademark DENT DOCTOR. In response, it replaced the mark DENT DOCTOR with DENT DR. on their trucks, business cards, and website. Dent Doctor sought a preliminary injunction against Dent Clinic to enjoin the use of DENT DR. Dent Clinic argued that it obtained retroactive licensing rights to use the mark DENT DOCTOR and DENT DR. from nearby Dent Doctor Auto Specialists, a third-party company in Augusta, Wisconsin, that has used the mark DENT DOCTOR since 1984. Dent Clinic argued that Auto Specialists had superior rights in the geographical area where it operated.

The Wisconsin court held that Dent Doctor was likely to demonstrate a likelihood of success on the merits, which required it to show that it owned a protectable mark and that a "likelihood of confusion" existed between the marks or products of the parties. Despite the retroactive licensing agreement, the court found Dent Doctor was likely to show that Auto Specialists' superior rights did not extend to Dent Clinic's geographic location. The court further held that Dent Doctor was likely to succeed in showing a likelihood of confusion because DENT DR. is an abbreviated version of DENT DOCTOR. In addition, the court found confusion was particularly likely in this case because Dent Clinic used to be affiliated with Dent Doctor as a franchisee, and customers may not realize they are no longer affiliated. The termination agreement served as important evidence in the court's finding.

## Related People

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