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2002 Survey of Rhode Island Law: Cases: Intellectual Property

Amy Hughes

Roger Williams University School of Law

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Intellectual Property. *National Lumber & Building Materials Co. v. Langevin*, 798 A.2d 429 (R.I. 2002). Injunctive relief will be granted to a plaintiff who shows that the fictitious business name of a defendant is deceptively similar to that of the plaintiff, causing public confusion and, thus, irreparable harm to the plaintiff's business.

FACTS AND TRAVEL

Plaintiff has operated a lumber business in Rhode Island for approximately forty years.¹ In 1979, plaintiff filed a fictitious business name statement with the Secretary of State indicating that it would conduct business under the name "National Lumber Company."² Plaintiff failed to renew its fictitious business name statement in 1984, despite the fact that it continued to use this name.³ Defendant is a Massachusetts corporation that has sold building materials in Rhode Island for more than thirty years.⁴ In 1997, defendant filed a fictitious business name statement with the Rhode Island Secretary of State and the office approved defendant's use of the fictitious business name "National Lumber Company of Massachusetts."⁵ Plaintiff filed this action seeking injunctive relief to prevent defendant from using this name because it was deceptively similar to plaintiff's fictitious business name of "National Lumber Company."⁶ Plaintiff alleged that the similarity in names created confusion and caused irreparable harm to plaintiff's business.⁷

The trial justice held that defendant's fictitious business name was deceptively similar to that of the plaintiff's, causing a great likelihood of confusion between the two companies.⁸ Because of this, the court permanently enjoined defendant from using the name "National Lumber Company of Massachusetts" while doing

1. *Nat'l Lumber & Bldg. Materials Co. v. Langevin*, 798 A.2d 429, 431 (R.I. 2002).

2. *Id.*

3. *Id.*

4. *Id.*

5. *Id.* The Secretary of State initially rejected defendant's use of the name "National Lumber Company" because of its similarity to plaintiff's business. *Id.*

6. *Id.*

7. *Id.*

8. *Id.*

business in Rhode Island.⁹ The trial justice also found that plaintiff had a right to use the name "National Lumber Company" even though it failed to renew its fictitious business name with the Secretary of State.¹⁰ Ultimately, plaintiff possessed the exclusive right to use the name in Rhode Island because it was first in time to use and register the name in the state, and plaintiff maintained continuous use thereafter.¹¹

ANALYSIS AND HOLDING

The Rhode Island Supreme Court found that the name "National Lumber Company of Massachusetts" was deceptively similar to the name "National Lumber Company."¹² The court reasoned that although the words "national" and "lumber" are generic words and not inherently distinctive, plaintiff established that the name "National Lumber Company" had acquired a secondary meaning.¹³ Plaintiff used the name in advertising to the public continuously for more than forty years and the name appeared on publicly distributed documents.¹⁴ Plaintiff's president testified unquestionably that customers knew the business as "National Lumber" and that customers had confused plaintiff and defendant.¹⁵ Therefore, the court concluded defendant's fictitious business name interfered with the plaintiff's business and constituted unfair competition.¹⁶

In affirming the permanent injunction against the defendant, the court reaffirmed that in an unfair competition case the plaintiff does not need to show actual confusion in order to obtain an injunction.¹⁷ The plaintiff only needs to show that public confusion is likely to occur from the use of similar fictitious business names and that the confusion will result in irreparable harm.¹⁸ The court

9. *Id.* at 431-32.

10. *Id.*

11. *Id.* at 432.

12. *Id.* at 433.

13. *Id.*

14. *Id.*

15. *Id.* at 433-34.

16. *Id.* at 434.

17. *Id.* (citing *Fund for Cmty. Progress v. United Way of S.E. New England*, 645 A.2d 517, 521-22 (R.I. 1997)).

18. *Id.* at 434 (citing *Fund for Cmty. Progress*, 695 A.2d at 521-22). The plaintiff does not need to show monetary damages to be entitled to injunctive relief, mere confusion will suffice. *Id.* (citing *Fund for Cmty. Progress*, 695 A.2d at 523).

held that in this case confusion was likely to occur and that irreparable harm would occur if injunctive relief was not granted.¹⁹

CONCLUSION

Injunctive relief will be granted in an unfair competition case if the plaintiff shows that the defendant's fictitious business name is deceptively similar to plaintiff's and, therefore, public confusion is likely to occur, causing irreparable harm to plaintiff's business. If the fictitious business name is generic, plaintiff must show that the name has established a secondary meaning as to the plaintiff. In showing public confusion, the plaintiff does not need to show actual confusion, only that confusion is likely to occur.

Amy Hughes

19. *Id.*