

NO. 35869-7-II  
IN THE COURT OF APPEALS OF THE STATE OF WASHINGTON  
DIVISION II

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CUSTOM AUTO INTERIORS, INC., dba  
Custom RV Interiors, Inc.,

Plaintiff/Respondent,

v.

CUSTOM RV INTERIORS, INC.; DAVID  
AST and JANE DOE AST, husband and wife  
and their marital community; and LARRY J.  
AST and ROBERTA ROE AST, husband and  
wife and their marital community,

Defendants/Appellants.

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COURT OF APPEALS  
DIVISION II  
STATE OF WASHINGTON  
BY [Signature]

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APPEAL FROM THE SUPERIOR COURT

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HONORABLE ROGER BENNETT

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BRIEF OF RESPONDENT

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## RESPONSE TO ASSIGNMENT OF ERROR

The trial court did not abuse its discretion by prohibiting Defendants to use the trade name "Dave & LJ's Custom RV Interiors, Inc." and requiring them to adopt a trade name that would distinguish theirs from that used by Plaintiff for over fifteen (15) years.

### ISSUES PRESENTED

1. Is the trade name "Custom RV Interiors" a generic name?
2. Did Plaintiff have a well-grounded fear of confusion between its business and that of Defendants?
3. Would Defendants appropriation of Plaintiff's trade name be expected to cause damage to Plaintiff?
4. Did the trial court properly exercise its discretion in fashioning injunctive relief?
5. Do Defendants' actions amount to a violation of the Consumer Protection Act?

### STATEMENT OF THE CASE

#### I. Facts.

Plaintiff Custom Auto Interiors, Inc., is in the business of providing interior remodeling and exterior modifications to recreational vehicles. Since at least the early 1990s, it has used the trade name "Custom RV Interiors, Inc." It is located at 9333 NE Highway 99,

Vancouver, Washington. The name "Custom RV Interiors, Inc.," has been on its building and faces Highway 99. (CP 14-15) Plaintiff caters to a broad geographical market. Its customers come from all areas of the United States. It also serves customers in Canada and other parts of the world. It has shipped its products as far away as Africa. It advertises in national publications directed to recreational vehicle consumers and other trade publications. It has also maintained a website on the Internet. (CP 15) Plaintiff's principal is Larry V. Ast (Dad).<sup>1</sup> David Ast and Larry J. Ast (Sons) are his adult children. Each worked for Plaintiff for 15-20 years. (CP 24, 46) David Ast became a director of the corporation in the early 1990s. Larry J. Ast was the corporation's general manager. (CP 15)

By 2005, Dad was interested in retiring. He decided to sell the business. He entered into negotiations with Sons to do so. (CP 15) Sons believed that Dad was asking too much for the business. Larry J. Ast believed that he already owned twenty percent (20%) of the business. (CP 26) Sons concluded that Dad was being intractable in the negotiations and was making an offer "so outrageous so we would never be able to

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<sup>1</sup> This case involves family members. Referring to them as "Mr." or "Ms." will invite confusion. Sometimes, the solution can be using first names. That will not help in this case because two of the participants have the same first name, "Larry." In his declaration, Larry J. Ast referred to his father, Larry D. Ast, as "Dad." On that basis, Plaintiff will adopt that designation for Larry V. Ast. His Sons, Larry J. Ast and David Ast, will be referred to collectively as "Sons."

purchase the company.” The discussions ended in June of 2006. (CP 27)

Nonetheless, Sons continued to work at Custom RV Interiors. (CP 15)

In July of 2006, Sons formed Custom RV Interiors, Inc. (CP 15)

In October of 2006, Dad sold his business to Robert (B.J.) Warner. Sons either left the business at that point or were terminated, depending upon which version is believed. (CP 15, 28, 52) Sons clearly did not take this development very well. (CP 52)

Sons then decided to begin their own competing business. In December of 2006, Defendants leased space in Woodland, Washington, for their operation. An article concerning this transaction was published in the *Vancouver Columbian* on December 18, 2006. (CP 19, 22) Shortly thereafter, a representative of Honeywell Security contacted Mr. Warner seeking to discuss the company’s security needs in light of its impending move to Woodland. Mr. Warner informed the representative that no move was forthcoming. (CP 19)

Plaintiff’s suppliers began inquiring about the new business. Mr. Warner talked to several. The suppliers expressed the belief that the two businesses were one in the same. They stated that each should have a different name to avoid confusion. Two suppliers went so far as to request that Plaintiff submit new credit applications. (CP 19) Flex Steel is one of

Plaintiff's major suppliers. It e-mailed to Plaintiff information concerning an order that had been made by Sons' new business. (CP 20, 23)

Several customers called Mr. Warner. They were confused as well. They expressed their belief that Larry J. Ast was an owner of Plaintiff. (CP 20)

*RV Life* is a well-recognized trade publication. Sons put an ad in the January 2007 issue for their new business. The ad announced the "Grand Opening!" of "Dave & LJ's Custom RV Interiors, Inc." In the ad, the term "Custom RV Interiors, Inc.," was prominent while the term "Dave & LJ's" was quite small. The ad also contained the verbiage, "personalizing RV's for over 20 years," thus giving the impression that Sons had a venerable business. Finally, it gave the web address of "[www.customrvint.com](http://www.customrvint.com)." (CP 18-21) Its web address is quite similar to [www.customrvinteriors.com](http://www.customrvinteriors.com).

In December of 2006 and January of 2007, Defendants' website was not operational. It stated:

**WELCOME TO CUSTOM RV  
INTERIORS!**

**Our website is under development and will be  
online soon**

**Dave and LJ Ast**

(CP 15-17)

II. Proceedings.

Plaintiff filed suit on December 7, 2006, alleging trade name infringement and violation of RCW 19.86. It immediately moved to preliminarily enjoin Defendants from using the name "Custom RV Interiors, Inc." and the Internet address they had chosen. (CP 1-4) Defendants opposed the motion. They adduced no evidence, however, of any financial impact of any injunction or that they had obtained any customers at all.

On January 8, 2007, the trial court issued a ruling indicating that injunctive relief was warranted. Significantly, it found as follows:

Defendants, the Sons of Plaintiff/Owner, worked in that business and due to Plaintiff's decision to retire, have attempted, unsuccessfully, to purchase the business. Unable to reach an agreement, Defendants then elected to start a competing business using Plaintiff's trade name but appending the qualifier "Dave & LJ's Custom RV Interiors, Inc."

No other reasonable inference can be drawn, other than that the Defendants have elected to appropriate the trade name, and associated goodwill, of Plaintiff's business.

(CP 90) The trial court also indicated that the business' trade name described what the business did but also indicated that it held itself out as a business. (CP 90) The trial court made the following observation:

The evidence presented was sparse as to the financial effect of this injunction. In its fledgling existence, Defendants' business is not likely to be greatly harmed.

(CP 91) The Court then stated its order:

Defendants are preliminarily enjoined from using the phrase “Custom RV Interiors, Inc.,” *per se*. To avoid further litigation on the meaning of the court’s order for guidance, the Defendants may use a title such as “Dave & LJ’s Custom-Made RV Interiors of Woodland,” or some designation sufficiently unique to eliminate the risk of confusion clearly engendered and intended by the use of “Dave & LJ’s Custom RV Interiors, Inc.”

(CP 91) The Order for Preliminary Injunction was entered on January 12, 2007.

Defendants then sought review.

III. Subsequent Events.<sup>2</sup>

In response to the injunction, Defendants have opted to use the trade name “Dave & LJ’s RV Interior Design.”

ARGUMENT

I. Standard of Review.

A party seeking a preliminary injunction must demonstrate the presence of three (3) factors. These are:

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<sup>2</sup> The material in this section of the brief is not part of the record made before the trial court because it amounts to Defendants’ response to the trial court’s order. It is the subject of a motion made contemporaneously under RAP 9.11. The material comes from Defendants’ website. As such, it amounts to a fact “capable of immediate and accurate demonstration by resort to easily accessible sources of indisputable accuracy and verifiable certainty. *Clean v. State*, 130 Wn.2d 782, 809, 928 P.2d 1054 (1996) Therefore, it can be judicially noticed by the Court.

1. A clear legal or equitable right;
2. A well-grounded fear of immediate invasion of that right; and
3. That the acts complained of have or will result in actual and substantial injury.

*Tyler Pipe Industries, Inc., v. Department of Revenue*, 96 Wn.2d 785, 792 638 P.2d 1213 (1982). Furthermore, the granting or withholding of an injunction is addressed to the sound discretion of the trial court to be exercised according to the circumstances of each case. *Alderwood Associates v. Washington Environmental Counsel*, 96 Wn.2d 230, 233, 635 P.2d 108 (1981).

Since grant of a preliminary injunction is discretionary, the standard for review is abuse of that discretion. *American Federation of State Employees, Counsel 28, AFL-CIO v. State of Washington*, 99 Wn.2d 878, 887, 665 P.2d 1337 (1983); *Rabon v. City of Seattle*, 135 Wn.2d 278, 957 P.2d 621 (1998). Discretion is abused if the decision is based upon untenable grounds, or the decision is manifestly unreasonable or arbitrary.

Finally, an order granting a preliminary injunction requires findings of fact and conclusions of law. CR 52(a)(2)(A). The trial court found as follows:

1. Plaintiff had used its business name for approximately fifteen years at a location in Clark County. (CP 89)

2. Sons worked in the business for a number of years. (CP 90)
3. Sons were unsuccessful in the purchase of the business. (CP 90)
4. That Defendants elected to start a competing business using the name Dave and LJ's Custom RV Interiors. (CP 90)
5. Defendants elected to appropriate Plaintiff's trade name and its associated good will. (CP 90)
6. Defendants trade name engendered confusion between their business and that of Plaintiff's. (CP 91)
7. Defendants intended this confusion. (CP 91)
8. Plaintiff's trade name describes what it does. (CP 90)

Defendants have not assigned error to any of these findings. Therefore, they must be accepted as verities on appeal. *Cowiche Canyon Conservancy v. Bosley*, 118 Wn.2d 801, 808, 828 P.2d 549 (1992); *In re Estate of Jones*, 152 Wn.2d 1, 93 P.3d 147 (2004); *Lingvall v. Bartmess*, 97 Wn.App. 245, 982 P.2d 690 (1999).

Based upon these findings, the trial court ordered Defendants to make a minor change in the trade name used by their new business to avert any potential confusion between the two businesses. Its decision was well within its discretion.

II. Plaintiff Has a Clear Legal or Equitable Right to Avoid Infringement of Its Trade Name.

a. Basic Principles.

One business may not infringe on a distinctive feature of another business' trade name in a manner that tends to confuse the two businesses in the public mind. The following principles apply in this context:

1. The right to use a particular name as a trade name belongs to the one who first appropriates and uses it in connection with a particular business.
2. A person, whether individual or corporate, may not use any name, not even his or its own, which is has the distinctive feature of a trade name already in use by another, if such use by the one person tends to confuse, in the public mind, the business of such person with that of the other.
3. The prior user may be entitled to relief regardless of actual fraud or intent to deceive on the part of a subsequent appropriator.
4. To acquire the right to use a particular name, it is not necessary that the name be used for any considerable length of time. It is enough to show that one was in actual use of it before another began to use it.
5. A trade name, in order to be an infringement upon another, may not be exactly like it in form and sound. It is enough if the one so resembles another as to deceive or mislead persons of ordinary caution into the belief

that they are dealing with the one concern as if they were dealing with the other.

6. Prior right to the use of a name will be protected by injunction against others using it unfairly.

*Seattle Endeavors, Inc., v. Mastro*, 123 Wn.2d 339, 339, 346, 868 P.2d 120 (1994). When risk of confusion exists, some level of injunctive relief is appropriate. *Seattle Endeavors, Inc., v. Mastro, supra*; *Puget Sound Rendering, Inc., v. Puget Sound Bi-Products, Inc.*, 26 Wn.2d 724, 615 P.2d 504 (1980).

In this case, it is beyond dispute that Plaintiff had been using the name "Custom RV Interiors" since the early 1990s. It therefore had the right to that name and the good will associated with the name. Sons could not form a corporation called "Custom RV Interiors, Inc.," and thereby obtain the ability to use that name. Their placement of the term "Dave and LJ's" before "Custom RV Interiors" did not eliminate the confusion that was engendered as the trial court found. In any event, and as noted above, names need not be identical for an aggrieved business to obtain relief. This state of affairs gave Plaintiff a clear right to prevent infringement of its trade name.

b. Defendants Cannot Escape Injunctive Relief on the Basis that Plaintiff's Trade Name is Generic.

i. Introduction.

Trade names are categorized by their distinctiveness. Courts have developed a continuum along which names are graded from least distinctive to most distinctive. This continuum determines the scope of protection to which a name may be entitled. The categories, from least appropriable to most appropriable are (1) generic terms; (2) descriptive terms; (3) suggestive terms; and (4) arbitrary and fanciful terms. Suggestive and arbitrary and fanciful terms are considered “strong” because they are more distinctive. Generic and descriptive terms are considered “weak” because they are less distinctive. *Seattle Endeavors, Inc., v. Mastro, supra.*

Defendants claim that the trade name “Custom RV Interiors” is generic and therefore not subject to protection. They are mistaken. First of all, the name is not generic. Secondly, even generic trade names are subject to protection if a risk of public confusion exists.

ii. The Test For Whether a Name Is Generic.

Boiled down to its essentials, a name is generic if the public uses the name to describe certain types of goods or a certain type of service. On the other hand, if the name refers to the source of a

type of goods or services, it is not generic. This test originated in *Bayer Co. v. United Drug Co.*, 272 F. 505 (S.D.N.Y. 1921). In that case, the Court held that Defendants could use the word “aspirin” to describe the product it was producing although Plaintiff was the first to develop it. It based its hold on the fact that the word “aspirin” had come to be understood to be a type of product, not the product’s source. As the Court, per Judge Learned Hand, stated:

The single question, as I view it, in all these cases, is merely one of fact: What do the buyers understand by the word for whose use the parties are contending? If they understand by it only the kind of goods sold, then, I take it, it makes no difference whatever what efforts the Plaintiff has made to get them to understand more. He has failed, and he cannot say that, when the Defendants uses the word, he is taking away customers who wanted to deal with him, however closely disguised he may be allowed to keep his identity. So here the question is whether the buyers merely understood that the word ‘Aspirin’ meant this kind of drug, or whether it meant that and more than that; i.e., that it came from the same single, though, if one please anonymous, source from which they had got it before.

274 F. at 509. The language of this opinion has evolved into what is sometimes referred to as a “who are you/what are you” test. If the name describes the type of product or service (what are you), it is generic. If it

identifies a source of the product (who are you), it is not. *Yellow Cab of Sacramento v. Yellow Cab of Elk Grove, Inc.*, 419 F.3d 925 (9<sup>th</sup> Cir. 2005).

Another way of approaching the question is determining what the “genus” of a product or service might be. If the trade name is a “species” of the “genus,” the trade name is not generic. If it describes the genus, however, it is generic. *Park 'N Fly, Inc., v. Dollar Park and Fly, Inc.*, 469 U.S. 198, 105 S.Ct. 658, 83 L.Ed.2d 582 (1985).

The United States Courts of Appeal have stated a practical and functional test to ascertain whether a trade name is generic. It responds to the concern that a business should not be able to obtain a monopoly on a name that would preclude a competitor from describing his services for what they are. *CES Publishing Corp v. St. Regis Publications*, 531 F.2d 11 (2d Cir. 1975). If it is not “difficult to imagine another term of reasonable conciseness by which the public could refer” to Plaintiff’s services, its name is not generic. *Committee for Idaho’s High Desert, Inc., v. Yost*, 92 F.3d 814, 822 (9<sup>th</sup> Cir. 1996) The United States Court of Appeals for the Third Circuit set out this test in the following terms:

What is “generic” in trademark law is a word with so few alternatives (perhaps none) for describing the good to allow someone to monopolize the word would debilitate competitors. A descriptive trademark is one that weaves a larger but finite set of equivalent alternatives, and therefore can still be protected

(because there are adequate alternatives for competitors) but only if it has acquired a secondary meaning (so that it demonstrably functions as a source indicium).

*Duraco Products, Inc., v. Joy Plastics Enterprises, Ltd.*, 40 F.3d 1431, 1441 (1994).

Based on these considerations, a number of names have held not to be generic although they clearly describe the type of product that is being produced. For example, the name “STEEL BUILDING” was held not to be generic because it identified the source of pre-engineered metal buildings and roofing systems. *In re Steelbuilding.com*, 415 F.3d 1293 (Fed.Cir. 2005). The term “steak and brew” would tend to define the kind of meal a person could have at a given restaurant. However, a restaurant chain known as “Steak & Brew” was able to obtain an injunction against another restaurant having a sign reading “Snug Harbor Inn Steak & Brew” at a location close to one of its franchisees. *Longchamps, Inc., v. Eig*, 315 F.Supp. 456 (S.D.N.Y. 1970). The term was held to be descriptive of the type of meal one could have, not generic. One might also think that “honey baked ham” would be a synonym for ham baked with a honey glaze and therefore generic. The Court did not agree in *Schmidt v. Quigg*, 609 F.Supp. 227 (E.D.Mich. 1985). Finally, the term “rental guide” was found not to be generic

because it could deal with the amount to be paid for rent, a list of tenants, the act of renting, or property that might be available for renting. *In re Holmes & Land Publishing Corp*, 24 U.S.P.Q.2d 1717 (1992).

iii. A Combination of Generic Terms Taken Together May Not Be Generic as a Whole.

Defendants claim that the words “custom,” “RV,” and “interiors,” are generic in nature. From this, they reason that the name “Custom RV Interiors,” as a combination of generic terms, must itself be generic. This, argument has been soundly rejected.

As early as 1920, the Supreme Court noted that the commercial impression of a trademark must be considered as a whole, and not from its elements separated and considered in detail. *Estate of P. D. Beckwith, Inc., v. Commissioner of Patents*, 252 U.S. 538, 545-6, 40 S.Ct. 414, 64 L.Ed. 705 (1920). Later decisions confirm that the distinctiveness of a trade name must be viewed as a whole rather than by looking at its constituent parts. *California Cooler, Inc., v. Loretto Winery, Ltd.*, 774 F.2d 1451 (9<sup>th</sup> Cir. 1985); *Committee for Idaho's High Desert, Inc., v. Yost*, *supra*.

///

iv. Plaintiff's Trade Name Is Not Generic Under These Tests.

The name "Custom RV Interiors" is not generic. This is seen by utilization of any of the tests set out above.

First of all, the name "Custom RV Interiors" is the source of a certain service, not the service itself. The service is recreational vehicle remodeling. The source, or one provider of the service, is Plaintiff under its trade name of "Custom RV Interiors."

Plaintiff's trade name is not generic under the "who are you/what are you" test. That can be seen from the following statement: "Custom RV Interiors" is a remodeler of recreational vehicles. The "who are you" is "Custom RV Interiors." The "what are you" is "recreational vehicle remodeler." Since the two are not identical, the trade name is not generic.

Plaintiff's trade name is also not generic under the functional test. There are a great many other names available for providers of the service Plaintiff renders, recreational vehicle remodeling. The trial court's opinion provides one example — "Dave & LJ's Custom Made RV Interiors of Woodland." Defendants chose another name, "Dave & LJ'S RV Interior Design." What is clear, however, is that Plaintiff's

trade name, “Custom RV Interiors,” does not monopolize the field of names for recreational vehicle remodelers.

c. A Trade Name Containing Generic Terms Is Subject to Protection to Avoid Confusion.

i. The Supreme Court Has So Held.

In *Electric Supply Co. v. Hess*, 139 Wash. 20, 245 P, 27 (1926), the Supreme Court held that the Plaintiff could enjoin the Defendants from using the trade name “Electric Service Company” even though the two trade names contained generic terms. It based its decision on the need to eliminate confusion in the public mind. A more detailed discussion of the opinion is set out below.

Electric Supply Company had been in business in Wenatchee, Washington, for eight years when Defendants began operations under the name Electric Service Company. The two businesses were in the same general location in Wenatchee. Both engaged in electrical wiring and the sale of electrical supplies, merchandise, fixtures, apparatus, and appliances. Mail and phone calls directed toward one find their way to the other. Goods shipped to one were misrouted to the other.

Electric Supply Company sued to enjoin the Defendants from using its trade name. The trial court denied it any relief. It appealed.

The Supreme Court reversed and remanded, directing that judgment be entered in favor of Electric Supply Company. It noted that injunctive relief was warranted to avoid confusion in the future. It conceded that the trade name "Electric Supply Company" consisted of generic terms. It recognized, however, that Plaintiff had used this name for a number of years. It then stated:

That combination of words in that locality means the business conducted by the appellant corporation. The words employed for that purpose are common ones, and in a way may be said to belong to the general public. They are, as the writer says, publici juris, descriptive, generic words in the use of which appellant is not entitled to protection primarily, but only in the event that by the use of them they have acquired a secondary meaning as that term is known in this branch of the law, discussed by respective counsel in this case. . . . "Secondary meaning is association, nothing more." That is, that the words though primarily belonging to the public, have been associated with one's business in such a way and for such length of time as they are generally understood by the public as referring to that one's business.

(Emphasis added.) 139 Wash. at 24-5.

In short, if a generic term has acquired secondary meaning by the public associating it with a certain business, the trade name is still subject to protection.

The Supreme Court reaffirmed the vitality of *Electric Supply Co. v. Hess, supra*, in *Union Trust Co. of Spokane v. Quigley*, 145 Wash. 176, 259 P. 28 (1927). That case parallels ours. Plaintiff's decedent had operated a business known as "Physicians' & Surgeons' Supply Company" in Spokane. Defendants had a competing business known as "Spokane Surgical Supply Company." Defendants incorporated under the name "Physicians' & Surgeons' Supply Company." Plaintiff sued to enjoin defendants' use of that trade name. Defendants prevailed at trial. The Supreme Court reversed. It cryptically noted that "the case comes squarely within the rules laid down" in *Electric Supply Co. v. Hess*, 145 Wash. At 178.

ii. *Electric Supply Company v. Hess* Is Good Authority.

Defendants give a number of reasons the decision in *Electric Supply Company v. Hess, supra*, should be ignored. None of them have any merit. Each will be addressed in turn.

Defendants' first claim that *Electric Supply Company v. Hess, supra*, is inconsistent with the Supreme Court's decision in *John Vittucci Co. v. Merline*, 130 Wash. 483, 228 P. 292 (1924). Interestingly, four of the five justices involved in the decision of that case also decided *Electric Supply Company v. Hess, supra*. *John Vittucci Co. v.*

*Merline, supra*, was a dispute between two companies who sold olive oil. The containers of each had labels showing maps of Italy and surrounding areas and referring to “virgin olive oil.” The colors and verbiage were different, however. The Court held that a map of Italy could not be appropriated since it was in the public domain and that “virgin olive oil” was a generic term. To be sure, the Court quoted with favor language from another court opinion to the effect that a generic term is not subject to protection. This statement must be taken as dictum in light of the following statement, which appears to be the primary basis for the Court’s decision:

In the first place, it does not appear that there is such obvious similarity in the labels as to cause deception.

130 Wash. at 487. In other words, the Court found that the labels were sufficiently dissimilar as to eliminate any confusion. It also declined to find any secondary meaning associated with the Plaintiff’s labeling and any confusion in the public mind. For these reasons, it is totally distinguishable from *Electric Supply Company v. Hess*.

Defendants then contend that the holding in *Electric Supply Company v. Hess, supra*, is obviated by the Court’s discussion in *Seattle Endeavors, Inc., v. Mastro, supra*. There simply is nothing in the Court’s opinion in *Seattle Endeavors, Inc., v. Mastro, supra*, that states

that a trade name consisting of generic terms is not subject to protection where the trade names present a risk of confusion. In that case, the Court dealt with the names of two apartment complexes located within close proximity and a trade name they found to be “arbitrary” on the continuum defining the strength of trade names. In other words, the trade name in that case was found not to be generic.

Defendants then state that RCW 19.77.930 requires Washington courts to be governed by interpretations federal courts give the Lanham Act, 15 U.S.C. §1051 *et seq.* They then argue that federal courts would not protect Plaintiff’s trade name. That argument is not well taken.

First of all, RCW 19.77.930 is contained within RCW 19.77. That chapter deals with registration of trademarks. A trademark is a combination of words, names, or symbols used to identify goods. RCW 19.77.010(10). By contrast, a trade name is a combination of words used to identify a person’s business. RCW 19.77.010(12); RCW 19.80.005(1). We are concerned here with trade names, not trademarks. And trade names are not subject to registration and the provisions of RCW 19.77. *Tradewell Stores, Inc., v. T.B. & M, Inc.*, 7 Wn.App. 424, 432-3, 500 P.2d 1290 (1972). Therefore, a statute within the section of the

Revised Code of Washington dealing with trademarks has no applicability to our situation.

The holding that a generic trade name is subject to protection is not unique to Washington or an outdated rule. No less a personage than Mr. Justice Souter, when he sat on the Supreme Court of New Hampshire, authored an opinion that held that a trade name was subject to protection even though it consisted of generic terms in *Auto Body Specialists, Inc., v. Vallee*, 127 N.H. 382, 500 A.2d 372 (1985). In that case, the Plaintiff had operated an auto repair business in Manchester, New Hampshire, for over ten years. The Defendants opened another auto repair shop in Manchester approximately two miles from Plaintiff's place of business under the name "Vallee's Auto Body Specialists." Plaintiff ultimately sued to enjoin infringement of its trade name. The Defendants claimed that the phrase "auto body specialists" was generic and descriptive and could not be protected even if Plaintiff's business had acquired secondary meaning. The Court did not agree. It noted that even generic terms can be invested with secondary meaning over time. It affirmed the grant of injunctive relief.

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iii. The Name “Custom RV Interiors” Is Descriptive, Not Generic.

A name is “descriptive” if it directly and immediately conveys some knowledge of the characteristics of a product or service. 2 McCarthy on Trademarks and Unfair Competition §11.16. Clearly and obviously, the name “Custom RV Interiors” provides information about the nature of Plaintiff’s business. Anyone could conclude that Plaintiff provides services to the interior of recreational vehicles. It should also be clear that Plaintiff attempts to individualize the service it provides to each customer.

Descriptive names are categorized as “weak” because they are not thought to be inherently distinctive. They are considered “less strong” than terms that are “suggestive” or “arbitrary and fanciful.” Nonetheless, descriptive terms are entitled to some protection when there is risk of confusion or the name has achieved secondary meaning. The nature of the protection, however, may be narrow. *Seattle Endeavors, Inc., v. Mastro, supra*, 123 Wn.2d at 344-5.

iv. Potential for Confusion Exists.

Secondary meaning is best demonstrated by evidence of actual confusion. *Electric Supply Company v. Hess, supra*. That is obviously present here. A security firm contacted Plaintiff

believing that it, not Defendants, was setting up shop in Woodland. Communication from suppliers meant for Defendants was routed to Plaintiff. In fact, suppliers specifically noted that the similarity in the two names was causing confusion and suggested that a change would be in order. Finally, customers expressed confusion between the two businesses.<sup>3</sup>

This evidence is sufficient to make out potential for confusion or secondary meaning. In *Electric Supply Co. v. Hess, supra*, the vendors confused the two businesses. In *Bishop v. Hanenburg*, 39 Wn.App. 734, 738, 695 P.2d 607 (1985), the Court specifically stated that misrouted communication from suppliers or vendors is sufficient evidence of confusion in Washington. This is so because suppliers are members of the public. Furthermore, if suppliers are confused, consumers are likely to be similarly confused. See also, *Puget Sound Rendering, Inc. v. Puget Sound By-Products, supra*.

The best evidence that the name "Custom RV Interiors" is invested with secondary meaning is the simple fact that Defendants chose those words to name their business. This concept has

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<sup>3</sup> Defendants claim that this confusion could have been caused by issues with e-mail or Plaintiff's failure to update its website as promptly as it might have. This is nothing more than speculation. The trial court found that the similarity of the names clearly engendered confusion between the two businesses.

been adopted in trademark infringement cases under the Lanham Act. As has been stated:

When the alleged (trademark) infringer knowingly adopts a mark similar to another's, reviewing courts presume that the Defendants can accomplish his purpose: that is, that the public will be deceived.

*Entrepreneur Media, Inc., v. Smith*, 279 F.3d 1135, 1148 (9<sup>th</sup> Cir. 2002); *AU-Tomotive Gold, Inc., v. Volkswagen America, Inc.*, 457 F.3d 1062, 1076 (9<sup>th</sup> Cir. 2006).

Other courts have noted that deliberate copying of a name was persuasive evidence that the name in fact has secondary meaning. *Foremost Corp of America v. Berdge*, 638 F.Supp. 496, 500 (D.N.M. 1986); *Time Inc. Magazine Co. v. Globe Communications Corp*, 712 F.Supp. 1103, 1110 (S.D.N.Y. 1989); *Black & Decker Corp v. International Sales and Marketing*, 36 U.S.P.Q.2d 1851 (C.D.Cal. 1995); *McNeil-PPC, Inc., v. Guardian Drug Co. Inc.*, 984 F.Supp. 1066, 1069 (E.D.Mich. 1997). This rule makes sense. The only reason for one person to use another's trade name is to obtain the good will that the other's trade name might have. Doing so thus becomes an admission that the name does, in fact, have secondary meaning.

The trial court found that Defendants' use of the name "Custom RV Interiors" was designed to appropriate Plaintiff's

goodwill. Inherent in this finding is the conclusion that the name “Custom RV Interiors” has sufficient secondary meaning to implicate Plaintiff’s goodwill.

Since the name “Custom RV Interiors” has secondary meaning and its use by Defendants engenders confusion as the trial court found and as the facts show, it is subject to protection.

III. The Other Elements Are Satisfied.

After a party establishes a clear legal or equitable right, that party must also demonstrate the well-grounded fear of immediate invasion of that right and that the acts complained of have or will result in actual and substantial injury. Both of those elements are clearly satisfied here. Defendants’ selection of a trade name infringed upon Plaintiff’s right to use its trade name. This clearly can be expected to cause damage to Plaintiff. As the trial court noted, the infringement could be expected to interfere with the goodwill of Plaintiff’s business. This element is clearly met here.

IV. The Trial Court’s Grant of Injunctive Relief Was Proper.

The object of a preliminary injunction is the preservation of the “status quo” pending trial. The “status quo” is defined as the last peaceable, non-contested condition that preceded the pending controversy.

*State ex rel. Payless Drugs, Inc., v. Sutton*, 2 Wn.2d 523, 528-9, 98 P.2d 680 (1940). In the context of infringement, the “status quo” is the situation before the infringement began. *Goto.com v. Walt Disney Co.*, 202 F.3d 1199, 1210 (9<sup>th</sup> Cir. 2000). In our case, that would be the time before Defendants began their efforts to use “Dave and L.J.’s Custom RV Interiors” as their trade name. Clearly, the preliminary injunction the trial court issued served the purpose of preserving the “status quo.” It restrained the precise infringement that was threatened. For that reason, it was hardly an abuse of the trial court’s discretion.

Several factors must be considered to frame injunctive relief in this context. These are the following:

1. Whether the trade name was vaguely descriptive or clearly non-descriptive, the “appropriability” of the name;
2. The originality of the name;
3. Whether the Defendants acted in good faith; and
4. The extent of competition between the two businesses.

*Seattle Endeavors, Inc., v. Mastro*, *supra*, 123 Wn.2d at 126; *Tradewell Stores, Inc., v. T.B. & M, Inc.*, *supra*, 7 Wn.App. at 428-30; *Puget Sound Rendering, Inc., v. Puget Sound By-Products, Inc.*, *supra*.

The trial court’s ruling shows that it was quite concerned with the third factor. It found that the Defendants did not act in good faith and

intended to use their trade name to appropriate Plaintiff's good will. This finding obviously implicated the potential for competition between the two businesses. This conclusion was justified. Plaintiff serves a national and even an international market. The two businesses are both located in southwest Washington, less than twenty miles from each other. In this context, similarity of names of business that are geographically close to each other was and continues to be a recipe for further confusion that the trial court wanted to mitigate.

The trial court did not adopt a very radical solution. It did not preclude Defendants from using any particular words in their trade name. All that was required was "some designation sufficiently unique to eliminate the risk of confusion clearly engendered and intended by the use of Dave & LJ's Custom RV Interiors, Inc." (CP 91)

The trial court's ruling obviously struck a balance. The name "Custom RV Interiors" is perceptibly less original and a "weaker" trade name than, for example, "TSA RV Remodeling."<sup>4</sup> Balanced against the strength of the trade name, was Defendants' intention to engender confusion and appropriate Plaintiff's trade name as the trial court found.

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<sup>4</sup> The use of the designation "TSA" would be considered "fanciful" because it is a term unknown or not used in common parlance. *Seattle Endeavors, Inc., v. Mastro, supra*, 123 Wn.2d at 344, *fn* 3. "TSA" is an anagram of "Ast," the surname of Dad and Sons.

Furthermore, the two businesses are in competition in national and international markets.

V. Adding "Dave & LJ's" to the Name "Custom RV Interiors" Does Not Solve the Problem.

Defendants may argue that simply putting the name "Dave & LJ's" before the terms "Custom RV Interiors" in their trade name was sufficient to distinguish their business from Plaintiff's. Their argument might be based on *Tradewell Stores, Inc., v. T.B. & M, Inc., supra*. That case must be limited to its facts as should all cases in this area.

In March of 1970, Tradewell Stores, Inc., opened a discount food operation in Shelton under the name "Family Market." In June of 1970, T.B. & M, Inc., began a similar store in Bremerton, approximately thirty-five miles away, under the name "Family Mark-It." The trial court found that Shelton and Bremerton each had their own trading areas. It also found that there was a middle ground between the two communities that was not heavily populated and was primarily devoted to forestry, recreational, and residential use. The trial court ruled that the use of "Family Mark-It" by T.B. & M, Inc., infringed upon Tradewell's use of the name "Family Market." It concluded that the confusion would be eliminated by adding a geographical or personal prefix or suffix to the name. Defendants chose to satisfy the injunction by calling the store "Al's

Family Mark-It.” Tradewell Stores, Inc., appealed on the basis that the ruling was not sufficient to protect its interest in its trade name.

The Court of Appeals affirmed the trial court. It noted that the name “Family Market” was not significantly original or unusual. However, the trial court was convinced of the good faith of T.B. & M, Inc. It had noted that the Defendants had not tried to “cash in on some else’s advertising program-promotional efforts to pass off Defendants’ products as Plaintiff’s or in anyway to ride on the coattails of the Plaintiff.” 7 Wn.App. at 429. Furthermore, the Court of Appeals noted that any competition between the two businesses was minimal given the nature of the products that each sold and the fact that they were in different communities separated by thirty-five miles.

Our case is completely different. The two businesses are competing for the exact same customers. Secondly, and as the trial court found, Defendants intentionally appropriated Plaintiff’s trade name for the purpose of appropriating its goodwill.

In short, *Tradewell Stores, Inc., v. T.B. & M, Inc., supra*, was decided on its facts and the findings made by the trial court. It simply cannot be read for the proposition that the insertion of a personal prefix before a trade name is sufficient in all instances to eliminate any risk of confusion.

VI. Defendants Have Raised Points of No Significance.

a. Introduction.

Defendants have raised certain points that do not affect the merits of this matter in any significant way. Each of these will be addressed in turn.

b. Trade Name Registration.

Defendants express concern as the following statement in the trial court's Ruling on Plaintiff's Request for Preliminary Injunction:

The facts are undisputed. Plaintiff has used (the name Custom RV Interiors, Inc.) as a registered trade name for approximately 15 years, at a business location in Clark County.

(CP 89) First of all, there is no doubt that Plaintiff had used the trade name "Custom RV Interiors" for approximately 15 years prior to suit being filed. It is also clear that this name was registered in compliance with RCW 19.80 during the fall of 2006. Finally, the only reason that the trial court was interested in trade name registration was its desire to determine whether Plaintiff had standing to sue. (RP 42) This one issue can have no bearing on the propriety of the Court's decision.

The legislature has required trade name registration to assure the disclosure of the real name of each person conducting a business. RCW 19.80.001. A person carrying on business under a trade

name is not allowed to sue until registration has been accomplished.  
RCW 19.80.040.

The Supreme Court made it clear in *Union Trust Co. of Spokane v. Quigley, supra*, that the trade name registration statute has nothing to do with actions for trade name infringement. It stated that registering the trade name goes “only to the capacity of a party to sue and do(es) not in any way go to the merits of the action.” 145 Wash. at 177.

Defendants cannot argue that Plaintiff somehow precipitated the problem that led to this litigation by not registering its trade name until it did. That precise argument was made in *Tradewell Stores, Inc., v. T.B. & M, Inc., supra*. The Court gave that argument short shrift. It noted that only trademarks — and not trade names — can be registered in Washington under RCW 19.77. It went on to state that since a trade name cannot be registered as a trademark, that the Plaintiff could not be held to precipitated trouble by failing to register its trade name as a trademark.

c. “Inc.” As Part of A Trade Name.

Defendants argued to the trial court — as they have here — that the individual words “custom,” “RV,” and “interiors” are generic in nature and that a combination of three generic names must be considered

generic. The trial court rejected that argument holding that the trade name “exceeds the sum of its constituent parts.” In the course of doing so, it made reference to the designation “Inc.” in the trade name that Plaintiff has been using.

The trial court’s point was the rejection of the argument that Defendants were making, not any exaltation of the “Inc.” as it might be in Plaintiff’s trade name.

This case will rise or fall on whether “Custom RV Interiors” is a protected trade name and whether Plaintiff has met the requirements for issuance of a preliminary injunction. Plaintiff contends that the trial court’s ruling was proper for all the reasons set out above. The trial court’s reference to “Inc.” does not detract from that conclusion. Furthermore, a trial court ruling maybe affirmed on any grounds supported by the record. *Ertman v. Olympia*, 95 Wn.2d 105, 108, 621 P.2d 727 (1980); *Niven v. E.J. Bartells Co.*, 97 Wn.App. 507, 983 P.2d 1193 (1999).

d. Significance of Sons’ Frustration With Their Inability to Purchase Dad’s Business.

Defendants claim that Sons’ attempt to purchase the business from Dad does not mean that Plaintiff’s trade name can be protected. Their objection is difficult to understand. It was they who gave

the detailed discussion of their attempts to purchase the business. (CP 25-7; CP 49-52)

Sons' frustration with Dad over their inability to purchase the business does provide a basis to find intentional appropriation of Plaintiff's trade name. As indicated above, is excellent evidence of secondary meaning and confusion. (Brief of Respondent, pps.24-6) It is also one of the factors that a Court must consider when it fashions injunctive relief. (Brief of Respondent, p. )

VII. Plaintiff Is Entitled to Relief Under the Consumer Protection Act.

Plaintiff has claimed for trade name infringement. This is also a violation the Consumer Protection Act (CPA), in RCW 19.86. Defendants' argument to the contrary lacks merit.

The CPA proscribes unfair methods of competition and unfair or deceptive acts or practices in the conduct of any trade or commerce. RCW 19.86.020. Furthermore, any person aggrieved by a violation of RCW 19.86.020 may seek injunctive relief. RCW 19.86.090.

Five elements must be established to demonstrate a CPA violation as follows:

1. An unfair or deceptive act or practice;
2. In the conduct of trade or commerce;

3. Injury to Plaintiff's business or property;
4. A casual link between the unfair acts and injury suffered;  
and
5. Sufficient showing of public interest.

*Hangman Ridge Training Stables, Inc., v. Safeco Title Insurance Company*, 105 Wn.2d 778, 719 P.2d 531 (1986). Each of these requirements is met here. At this point, there can be no doubt that trade name infringement is an unfair or deceptive act for the purposes of the CPA. At least two cases have so held. *Nordstrom, Inc., v. Tampourlos*, 107 Wn.2d 735, 733 P.2d 208 (1987); *Tradewell Stores, Inc., v. T.B. & M, Inc., supra*.

The second, third, and fourth elements are satisfied as well. Clearly, Defendants' appropriation of Plaintiff's trade name occurred in the course of their business. As the trial court found, the appropriation of a trade name can be expected to cause damage to Plaintiff for the loss of goodwill. No showing of monetary damages is necessary to sustain findings that these elements are present. *Nordstrom, Inc., v. Tampourlos, supra*.

The final element is the public interest requirement. In *Nordstrom, Inc., v. Tampourlos, supra*, the Court held that this requirement was met under the facts of that case. It noted that the public interest was involved

because the infringement deceived persons into believing that they were dealing with one concern when in fact they are dealing with the other.

On its face, the holding of *Nordstrom, Inc., v. Tampourlos, supra*, suggests that the public interest requirement is met in any trade name infringement case that could lead to confusion of the public. Such a conclusion would also follow from the holding of *Tradewell Stores, Inc., v. T.B. & M, Inc., supra*. In *Seattle Endeavors, Inc., v. Mastro, supra*, the Court limited the holding in *Nordstrom, Inc., v. Tampourlos, supra*. It stated:

We therefore hold that the *inadvertent* infringement of a *weak* mark is not sufficient to qualify as a public interest for the purpose of awarding attorney's fees under the Consumer Protection Act.

123 Wn.2d at 350.

The general rule, therefore, is that the public interest requirement is met when one business infringes upon the trade name of another. However, when the trade name is "weak" and the appropriation is inadvertent, the public interest requirement is not met.

In this case, the appropriation of Plaintiff's trade name was intentional. The trial court so found. Regardless of what Defendants may argue concerning the strength of the trade name "Custom RV Interiors,"

their intentional appropriation of the trade name entitles Plaintiff to remedies under the CPA.

VIII. Defendants Should Not Be Awarded Attorney's Fees.

Defendants claim that they are entitled to an award of attorney's fees if they are successful in dissolving the preliminary injunction. At the outset, the trial court's order should be affirmed. This, of course, would mean that Defendants would not recover any attorney's fees.

In any event, a court is not required to award attorney's fees to a party who successfully dissolves an injunction. The award of attorney's fees in such a circumstance is discretionary. *Trummel v. Mitchell*, 156 Wn.2d 653, 677, 131 P.3d 305 (2006); *Cornell Pump Co. v. City of Bellingham*, 123 Wn.App. 226, 98 P.3d 84 (2004). If the Court determines that Defendants' arguments have merit, the Court should exercise its discretion to deny an award of attorney's fees on the facts presented here.

In this case, and as the trial court found, the Defendants chose their trade name for the express purpose of appropriating Plaintiff's goodwill. This conduct should not be rewarded. Secondly, the Defendants have moved on. They have chosen a different trade name and are presumably doing business under that trade name. In other words, they have now done what they should have done initially—they have selected a trade name that

hopefully will diminish confusion with Plaintiff's business. They should not be awarded attorney's fees for litigation, which under the circumstances is totally unnecessary.

Plaintiff sued under the Consumer Protection Act. A successful Defendant is not entitled to an award of attorney's fees. *Sato v. Century 21 Ocean Shores Real Estate*, 101 Wn.2d 599, 681 P.2d 242 (1984). Awarding Defendants their attorney's fees here would violate that rule.

IX. Plaintiff Is Entitled to an Award of Attorney's Fees.

This section of the brief is designed to satisfy the requirements of RAP 18.1(a). As indicated above, Defendants' conduct violated the CPA. Plaintiff is therefore entitled to attorney's fees on appeal pursuant to RCW 19.86.090. *Sherwood v. Bellevue Dodge, Inc.*, 35 Wn.App. 741, 669 P.2d 1258 (1983); *Sign-O-Lite Signs, Inc. v. Delaurentis Florists, Inc.*, 64 Wn.App. 553, 825 P.2d 114 (1992).

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CONCLUSION

The trial court's decision was proper and should be affirmed.  
Plaintiff should also be awarded attorney's fees.

DATED this 11 day of Sept., 2007.

  
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BEN SHAFTON, WSB #6280  
Of Attorneys for Plaintiff

NO. 35869-7-II  
IN THE COURT OF APPEALS OF THE STATE OF WASHINGTON  
DIVISION II

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CUSTOM RV INTERIORS, INC.; DAVID  
AST and JANE DOE AST, husband and wife  
and their marital community; and LARRY J.  
AST and ROBERTA ROE AST, husband and  
wife and their marital community,

Defendants/Petitioners,

v.

CUSTOM AUTO INTERIORS, INC., dba  
Custom RV Interiors, Inc.,

Plaintiff/Respondent,

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APPEAL FROM THE SUPERIOR COURT

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HONORABLE ROGER BENNETT

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AFFIDAVIT OF MAILING

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FILED  
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STATE OF WASHINGTON  
BY DEPUTY

