MASSACHUSETTS LAWYERS WEEKLY

Dentist Halts The Use Of A 'Similar' Trade Name

By: Eric T. Berkman | March 29, 1999

A dentist who practiced under the name "Boston Dental" for a number of years was entitled to an injunction to stop a group practice from using the name "Boston Dental Group," a U.S. District Court judge has ruled.

The dentist argued that — although "Boston Dental" was merely a "descriptive" term and not automatically entitled to trademark protection — the name had acquired a "secondary meaning" associating it with his practice.

Thus, maintained the dentist, the failure to issue an injunction would irreparably harm his practice and confuse consumers.

Judge Reginald C. Lindsay agreed, issuing a preliminary injunction against the group practice.

"[T]he relevant consideration [in granting an injunction] is the consumers' interest in not being deceived or confused about the products they purchase," wrote Lindsay, quoting the court's 1988 decision in *Calamari Fisheries, Inc. v. Village Catch, Inc.* "The plaintiff has demonstrated the likelihood of consumer confusion, and that showing is enough to place the weight of public interest concerns in favor of granting the injunction."

The 25-page decision is *Boustany v. Boston Dental Group, Inc.*, Lawyers Weekly No. 02-038-99.

Strong Message

Plaintiffs' counsel Robert R. Pierce of Boston stated that even though Lindsay only granted a preliminary injunction in this case, the decision sends a strong message that lawyers can bring perfectly viable claims to protect trademarks that are *not* inherently distinctive and therefore are *not* automatically entitled to protection.

"This decision, in my view, basically states that even if you have a *descriptive* mark, if you spend years promoting and advertising that mark and the mark becomes associated with the plaintiff's business, you can obtain protection for the mark," said Pierce. "So the moral of the story, I think, is that even if you have a weak mark, if you really push that mark it can obtain a secondary meaning."

But Pierce added that a secondary meaning will come only "over a period of time, and you have to spend a lot of money to do it. That's what my client did."

Additionally, Pierce pointed out, "with this ruling, the judge has determined that we're likely to succeed on the merits of the claim."

Counsel for the defendant could not be reached for comment prior to deadline.

On The Mark

In 1983, Dr. Paul Scola began using the service mark "Boston Dental" to describe his dental practice and offices in

Boston. He used the mark continuously until 1987, when plaintiff Fred G. Boustany purchased the practice, the right to use the mark and the goodwill associated with the mark.

When the plaintiff bought the practice, it had five full-time employees and 1,450 patients. As of the time of this action, the plaintiff had 21 employees and more than 15,000 patients.

The plaintiff had also used the mark "Boston Dental" on all advertising since 1987. The advertising appeared in the Boston Yellow Pages, the Boston Today coupon book, the Boston Business Journal and other publications.

According to the plaintiff, he'd spent at least $100,000 advertising and marketing his services under the mark.

Additionally, the plaintiff identified his practice in other ways by reference to the mark. For example, his employees uniformly referred to the practice as "Boston Dental." Similarly, all signs inside and outside the plaintiff's office, all correspondence sent to patients and vendors and all business and appointment cards given out identified the practice as "Boston Dental."

And while the plaintiff provided full-service dental care to patients at his single office in downtown Boston, some 1,700 of his patients lived in the Boston suburbs and at least 200 lived in or near suburbs where defendant Boston Dental Group, Inc. maintained offices.

New Group

In January 1998, the defendant began offering dental services under the name "Boston Dental Group." As of the time of this action, the defendant was operating offices in Wellesley, Concord, Watertown and Newburyport. The defendant also had related offices in Lexington and North Dartmouth. The defendant never opened an office in Boston.

After the defendant opened its offices, a number of the plaintiff's patients apparently inquired about appointments at one of the plaintiff's "suburban" offices. Since June 1998, such inquiries apparently averaged one each business day.

Additionally, at least one of the plaintiff's employees allegedly worked under the initial impression that the plaintiff was affiliated with the defendant when she interviewed with both practices.

The defendant, in an affidavit, claimed that none of its founders were aware of either the plaintiff or his practice. The founders claimed they chose the name in a brief meeting and did virtually no research to determine whether the mark was already in use.

Nonetheless, the plaintiff filed suit against the defendant in U.S. District Court alleging violations of the federal trademark law. The plaintiff also advanced several state-law and common-law claims.

Pending a trial on the merits, the plaintiff requested that the court issue a preliminary injunction prohibiting the defendant from using the name "Boston Dental Group" or any similar name in connection with dental services it provides in the commonwealth.

Likelihood Of Success

In order to grant an injunction based on the Lanham Act, the federal trademark statute, Lindsay noted that he had to find that the plaintiff would:

- suffer irreparable injury without an injunction;

- that the injury would outweigh any harm caused to the defendant;
- that the plaintiff was likely to succeed on the merits of his claim;
- and that the public interest would not be adversely affected by the injunction.

In cases involving trademark infringement, however, "'the key issue is the likelihood of success on the merits because the other decisions will flow from that ruling,'" the judge continued, quoting the 1st U.S. Circuit Court of Appeals 1986 decision in *Keds Corp. v. Renee Int'l Trading Corp.* "Thus the principal focus of this [decision] will be on whether it is likely that the plaintiff will succeed on his claims of trademark infringement under state and federal law."

Addressing this issue, Lindsay noted that the plaintiff's mark was a "descriptive" mark which was not entitled to automatic trademark protection.

Nonetheless, he added, "[d]escriptive marks … can acquire 'secondary meaning' and thus the distinctiveness that allows them to be protected under the Lanham Act."

Lindsay observed, however, that according to the defendant the mark was merely generic and thus *wholly* unprotected by the Lanham Act.

"[The defendant] argues that the mark is merely generic because it is 'composed of a geographic name and the word "dental,"'" said the judge.

However, Lindsay continued, "the fact that the plaintiff's mark contains a geographic term does not ineluctably lead to the conclusion that the mark is merely generic and thus unprotected by the Lanham Act."

Thus, the judge stated, the real issue is whether the mark is a descriptive mark that has acquired a secondary meaning.

Lindsay next determined that the plaintiff had demonstrated that it could likely show at trial that the mark *had* acquired a secondary meaning.

The judge cited "evidence that the mark 'Boston Dental' has achieved secondary meaning … [T]he record shows that a number of patients and at least one of the plaintiff's employees have confused the plaintiff's dental practice with that of [the defendant]."

Accordingly, the judge was persuaded that "the plaintiff is likely to succeed at trial in showing that the public has made the connection between the mark, 'Boston Dental,' and the services the plaintiff offers."

Lindsay further found that because the plaintiff had demonstrated a likelihood of success on the merits, irreparable harm in the absence of an injunction could be presumed.

LAWYERS WEEKLY NO. 02-038-99

Full-text opinions online