

1950

William J. Farrell v. The Mennen Company, Smith-Faus Drug Company, Zions Co-operative Mercantile Institution, Walgreen Drug Company, and John Doe : Brief of Appellant

Utah Supreme Court

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Recommended Citation

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IN THE SUPREME COURT OF THE STATE OF UTAH

WILLIAM J. FARRELL,
Plaintiff and Appellant,

—vs.—

THE MENNEN COMPANY, a corporation,
SMITH-FAUS DRUG COMPANY, a corporation,
ZIONS CO-OPERATIVE MERCANTILE INSTITUTION, a corporation,
WALGREEN DRUG COMPANY, a corporation, and JOHN DOE,

Defendants and Respondents.

} Case No.
7461

Brief of Appellant

RAYMOND R. BRADY
JOHN HAYS O'DONNELL
Attorneys for Appellant.

FILED

MAY - 3 1950

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TABLE OF CONTENTS

	Page
STATEMENT OF FACTS	1
STATEMENT OF POINTS	9
ARGUMENT	9
POINT 1. The District Court is in error when it ruled that the plaintiff and appellant's complaint does not state facts sufficient to constitute a cause of action; and, thus, the District court is in error in sustaining the general demurrer of the defendants and respondents, Smith-Faus Drug Company, Zions Co-operative Mercantile Institution and Walgreen Drug Company	9
POINT 2. The District Court was in error when it rendered and entered its Order, Judgment and Decree hereis dismissing appellant's complaint	29
CONCLUSION	30

CASES CITED

Academy of Motion Picture Arts & Sciences vs. Benson, 104 Pac. (2nd) 650; 15 Cal. (2nd) 685	25, 26
Aluminum Cooking Utensil Co. vs. National Aluminum Works, 226 Fed. 815	21
Brown vs. Hook, 180 Pac. (2nd) 982; 79 Calif. App. (2nd) 781	15, 16
California Prune & Apricot Growers Ass'n. vs. H. R. Nicholson Co. 158 Pac. (2nd) 764; 69 Calif. App. (2nd) 207	25
Cleo Syrup Corp. vs. Coca-Cola Co., 139 Fed. (2nd) 416, 150 A. L. R. 1056	20
Dr. Williams' Medical Co. vs. Tothill, Cape Good Hope, 20 S. C. 483; 27 S. C. 589	21
Florence Mfg. Co. vs. J. C. Dowd & Co., 178 Fed. 73; 101 C. C. A. 7	21
Gaines & Co. vs. Leslie, 54 N. Y. Supp. 421	21
Hall vs. Holstrom, 287 Pac. 668; 106 Cal. App. 563	27
Holeproof Hosiery Co. vs. Fitts, 167 Fed. 378	21
Koebel vs. Chicago Landlords' Protective Bureau, 210 Ill. 176; 71 N.E. 362; 112 Ill. App. 21	20
Larson Co. vs. Lamont, Corliss & Co., 257 Fed. 270; C.C.A. 7	21
LeBlume Import Co., Inc. vs. Coty, 293 Fed. 344; 292 Fed. 264	13, 14, 15, 26
Mossler vs. Jacobs, 65 Ill. App. 571	21
Moxie Nerve Food Co. vs. Baumbach, 32 Fed. 205	20

TABLE OF CONTENTS

Page

National Folding Box & Paper Co. vs. National Folding Box Co., 43 W.R. 156	21
New Home Sewing Machine Co. vs. Bloomingdale, 59 Fed. 284	22
Potter-Wrightington, Inc., vs. Ward Baking Co., 288 Fed. 597-601	24
Rubber & Celluloid, H. T. Co. vs. F. W. DeVoe & C. T. Rey- nolds Co., 233 Fed. 150	21
Rubber & Celluloid, H. T. Co. vs. Rubberbound Brush Co., 81 N.J. Eq. 419; 88 Atl. 210	21
Samuels vs. Spitzer, 177 Mass. 226; 58 N.E. 693	22
Scriven Co. vs. Girard Co., 140 Fed. 794	22
Weinstock, Lubin & Co. vs. Marks, 42 Pac. 142; 109 Calif. 529; 30 L.R.A. 182	22
White Co. vs. Miller, 50 Fed. 277	20

AUTHORITIES CITED

American Law Reports, Vol. 40, page 433	18, 19
American Jurisprudence, Vol. 52, page 509	19
American Jurisprudence, Vol. 52, page 543	14
American Jurisprudence, Vol. 52, page 544	14, 15
American Jurisprudence, Vol. 52, page 545	16
American Jurisprudence, Vol. 52, pages 546-547	17
Corpus Juris, Vol. 63, page 345	13
Corpus Juris, Vol. 63, page 353	15
Funk & Wagnall's New Standard Dictionary Of The English Language, page 322	11, 12
Hopkin's "The Law Of Trademarks, Tradenames & Unfair Competition," Fourth Edition, page 376	24
Nims' "Unfair Competition & Tradenames" page 558	13
Oxford's New English Dictionary On Historical Principals, published 1888, page 1043	11
Pollard's "Digest Of Decisions Of Law & Practice In The Patent Office And The United States And State Courts In Patents, Trade-Marks, Copyrights & Labels," page 524	26
Restatement Of The Law, Torts, Division 3, section 717, page 562	15, 16, 28
Restatement Of The Law, Torts, Division 3, section 721, page 579	12
Restatement Of The Law, Torts, Division 3, section 721 (c), page 580	12, 13
Restatement Of The Law, Torts, Division 3, section 730, page 596	28

TABLE OF CONTENTS

Page

Restatement Of The Law, Torts, Division 3, section 730(b), page 599	23, 24
Restatement Of The Law, Torts, Division 3, section 731, page 600	27, 28, 29
Ruling Case Law, Vol. 26, Trademarks, Sec. 61, page 886	19
Webster's New International Dictionary Of The English Lan- guage, Second Edition, Unabridged, for 1949, page 322	11
Webster's New International Dictionary Of The English Lan- guage, Second Edition, Unabridged, for 1949, page 1461	11
Webster's New International Dictionary Of The English Lan- guage, Second Edition, Unabridged, for 1949, page 2665	11

STATUTES CITED

Compiled Laws of Utah for 1907, section 2721, page 927	26, 27
Compiled Laws of Utah for 1917, section 6146, page 1198	26, 27
Session Laws Of Utah for 1931, Chapter 16, page 17	27
Utah Code Annotated for 1943, Vol. 5, Title 95, Chapter 2, Section 95-2-1, page 372	27

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WALGREEN DRUG COMPANY, a corporation, and JOHN DOE,
Defendants and Respondents.

Case No.
7461

Brief of Appellant

STATEMENT OF FACTS

This is an action to enjoin and permanently restrain the above named defendants from selling any hair tonic or skin lotion or other toilet article in the State of Utah under any trade name using the word "Bracer" or otherwise infringing upon appellant's trade name. "Brace For The Hair, A Real Bracer For The Hair." On October 1,

1949 the appellant filed in the office of the Clerk of the District Court of the Third Judicial District in and for Salt Lake County, State of Utah a duly verified complaint (R. 1-6) against the above named defendants reading as follows:

"The above named plaintiff complains of the above named defendants and for a cause of action alleges:

"1. That defendant The Mennen Company is now, and was at all times herein mentioned, a corporation, duly organized and existing under and by virtue of the laws of the State of New Jersey; and that said defendant is now engaged in the manufacture of a certain skin lotion known as "Skin Bracer" and the distribution of the same in the State of Utah; and that said defendant is now doing business in the State of Utah.

"2. That defendants Smith-Faus Drug Company and Zions Co-operative Mercantile Institution are now, and were at all times herein mentioned, corporations, duly organized and existing under and by virtue of the laws of the State of Utah with their principal place of business located in Salt Lake County, State of Utah; and that both of said defendants are now engaged in operating wholesale drug companies in Salt Lake City, Utah, and that as such both of said defendants sell and distribute in the State of Utah the afore-mentioned skin lotion under the trade name of "Skin Bracer."

"3. That defendant Walgreen Drug Company is now, and was at all times herein mentioned, a corporation, duly organized and existing under and by virtue of the laws of the State of Utah; and that said defendant was and is engaged in operating re-

tail drug stores throughout the State of Utah, and that in the course of this said retail drug business said defendant has sold and is selling the afore-mentioned skin lotion under the trade name of "Skin Bracer."

"4. That defendant John Doe is the fictitious name of a defendant unknown who is now engaged in the wholesale drug business in the State of Utah and is selling said skin lotion under the trade name of "Skin Bracer" in the State of Utah, and that when his true name is discovered, plaintiff asks that this complaint may be amended by inserting such true name in the place and stead of such fictitious name.

"5. That plaintiff is now, and has been at all times herein mentioned, an actual and bona-fide resident of Salt Lake County, State of Utah, engaged in the extensive and profitable business of manufacturing and selling, wholesale and retail, a certain hair tonic and skin lotion in the State of Utah which is an original formula conceived by plaintiff; that in said business the plaintiff purchases the many and varied ingredients used in the manufacture of the said hair tonic and skin lotion and mixes them according to his said formula, and bottles and labels the product and sells the same to barbershops and customers throughout the State of Utah and uses the same in connection with a certain barbershop owned and operated by plaintiff in Salt Lake City, Utah, wherein said product is manufactured, under the trade name of "Brace For the Hair, A Real Bracer For The Hair"; that by reason of the competent and efficient manner in which plaintiff has always conducted and does conduct his said business, the said hair tonic and skin lotion has acquired and now commands an exten-

sive patronage in the State of Utah under the said trade name of "Brace For The Hair, A Real Bracer For the Hair," and plaintiff has acquired and now has a goodwill in said business under said trade name of great value.

"6. That in accordance with the laws and statutes of the State of Utah, then and now in effect, plaintiff did on, or about, the 31st day of August, 1925, file of record in the office of the Secretary of State of the State of Utah his registration of the said trade name, "Brace For The Hair, A Real Bracer For The Hair," and said registration is now, and has been at all times since said date of filing, of full legal force and effect; and that a copy of said registration, certified by the office of the Secretary of State of the State of Utah, is attached hereto, marked "Exhibit A," and by reference made a part of this complaint.

"7. That for sometime last past the defendant The Mennen Company has been manufacturing the aforesaid skin lotion under the said trade name of "Skin Bracer" and that all of the defendants, including The Mennen Company, have been selling and distributing the said skin lotion in the State of Utah under the trade name of "Skin Bracer." That by using a trade name so similar to that trade name long used by plaintiff for his skin lotion and hair tonic defendants have appropriated to their own use and benefit the goodwill of plaintiff's business and deluded the plaintiff's customers and the public in general into the belief that the product manufactured and sold by plaintiff and the product sold by defendants are one and the same article; and that if defendants continue to sell a skin lotion in the State of Utah with the word "Bracer" in the trade name, the customers and prospective custom-

ers of the plaintiff and the public in general will at all times be deceived, misled and defrauded into believing the article sold by defendants is the same article as that which is manufactured and sold by plaintiff.

"8. That plaintiff has repeatedly made demand upon the defendant The Mennen Company to cease and desist from encroaching and infringing upon the duly registered trade name of the plaintiff in the State of Utah, and said defendant has refused and failed to heed said warnings. That unless restrained the defendants will continue and proceed to carry on their business of selling a skin lotion under the said trade name which encroaches upon the registered trade name of the plaintiff as afore-mentioned; that said acts of defendants have created and will continue to create much confusion in plaintiff's said business; and that plaintiff has no adequate remedy at law.

"WHEREFORE, plaintiff prays judgment that defendants, and each of them, be enjoined and restrained permanently from selling any hair tonic or skin lotion or other toilet article in the State of Utah under any trade name using the word "Bracer" or otherwise infringing upon plaintiff's afore-said trade name, and that plaintiff have such other and further relief as to the Court may seem proper, and that plaintiff have his costs incurred herein.

/s/ JOHN HAYS O'DONNELL

/s/ RAYMOND R. BRADY

Attorneys for Plaintiff."

A copy of the filed appellant's application for the mentioned trade name with a certificate from the Secretary of State's Office, for Utah, showing that the application

was a true, full and correct copy, was marked as "Exhibit A" and attached to the complaint (R. 5-6) and to each of the three copies of the complaint served upon each of the three respondents.

Only the respondents, Smith-Faus Drug Company, Zions Co-operative Mercantile Institution and Walgreen Drug Company, were ever served properly and legally with a copy of the summons and the above-mentioned complaint. The Mennen Company and John Doe were not served properly with summons herein and have made no general appearance before the said District Court or any other court. Consequently, we mean only Smith-Faus Drug Company, Zions Co-operative Mercantile Institution and Walgreen Drug Company when we refer to the "respondents."

On October 22nd, 1949, a demurrer (R. 7) was served upon appellant, through his counsel, and filed in Court, reading as follows:

"Come now the defendants, Smith-Faus Drug Company, Zion's Co-operative Mercantile Institution, and Walgreen Drug Company, and demur to plaintiff's complaint herein, upon the ground that said complaint does not state facts sufficient to constitute a cause of action."

The said demurrer came on regularly for hearing, upon appellant's motion, before the Court, Honorable Roald A. Hogenson presiding as Judge, upon November 8th, 1949. C. E. Henderson appeared and represented the three respondents at the hearing of the general demurrer. Mr. Henderson submitted three arguments

in support of his contention that the demur should be sustained, and these arguments were as follows:

1. Mr. Henderson's self-styled main point was to cite the old general rule that a word or combination of words which are merely descriptive of the subject to which it is applied is not usually a good trade name. Then Mr. Henderson quoted from dictionaries showing that in the eighteenth century the word "bracer" meant a tonic.

2. Mr. Henderson then argued that even though appellant's trade name was valid, appellant's registration of the same is only in connection with its use as a hair tonic and could not effect the respondents who are only in the skin lotion business.

3. Mr. Henderson then argued that because appellant's complaint had the afore-mentioned certificate marked "Exhibit A" (R. 5-6) attached to it and because of the allegations in paragraph six of the complaint (R. 2-3), the Court should not consider the doctrine of secondary meanings, and should only overrule the demur if the appellant's trade name is valid by reason of the same having been registered in accordance with law.

The Court ordered the parties to submit written memoranda of authorities in support of their respective positions on the aforesaid three arguments, and, thereafter, the memoranda were submitted by the respective parties in accordance with the wishes of the Court. Thereafter, on December 20, 1949, the District Court entered its Order sustaining the respondents' demurrer. Naturally, neither party knows which of the three arguments of re-

spondents, if any, influenced the Court when it sustained the demurrer.

The appellant has alleged all facts in his complaint that he can prove if granted a hearing or trial on questions of fact; consequently, the appellant cannot amend his complaint, and, thus, he elected in writing (R. 8) to stand on the said complaint. On January 9, 1950 the District Court entered its judgment (R. 9) herein reading as follows:

"In this action, the defendants, Smith-Faus Drug Company, Zions Co-operative Mercantile Institution and Walgreen Drug Company, having appeared and demurred to the plaintiff's complaint herein, and the issues of law thereto arising having been fully argued and duly submitted to the court, and the court being fully advised in the premises, having entered its order herein on the 20th day of December, 1949, sustaining said demurrer, and the plaintiff having elected to stand on his said complaint,

"Now, on motion of C. E. Henderson, one of the attorneys for said demurring defendants,

"IT IS ORDERED, ADJUDGED AND DECREED, that the complaint herein be, and the same is hereby dismissed.

"Entered this 9th day of January, 1950.

/s/ ROALD A. HOGENSON
District Judge."

The appellant has prosecuted this appeal from that judgment and order.

STATEMENT OF THE TWO POINTS UPON WHICH APPELLANT INTENDS TO REPLY FOR A REVERSAL OF THE ORDER OF THE DISTRICT COURT SUSTAINING RESPONDENTS' DEMURRER AND OF THE JUDGMENT HEREIN DISMISSING APPELLANT'S COMPLAINT.

1. THE DISTRICT COURT IS IN ERROR WHEN IT RULED THAT THE PLAINTIFF AND APPELLANT'S COMPLAINT DOES NOT STATE FACTS SUFFICIENT TO CONSTITUTE A CAUSE OF ACTION; AND, THUS, THE DISTRICT COURT IS IN ERROR IN SUSTAINING THE GENERAL DEMURRER OF THE DEFENDANTS AND RESPONDENTS, SMITH-FAUS DRUG COMPANY, ZIONS CO-OPERATIVE MERCANTILE INSTITUTION AND WALGREEN DRUG COMPANY.

2. THE DISTRICT COURT WAS IN ERROR WHEN IT RENDERED AND ENTERED ITS ORDER, JUDGMENT AND DECREE HEREIN DISMISSING APPELLANT'S COMPLAINT.

ERROR NUMBER ONE

THE DISTRICT COURT IS IN ERROR WHEN IT RULED THAT THE PLAINTIFF AND APPELLANT'S COMPLAINT DOES NOT STATE FACTS SUFFICIENT TO CONSTITUTE A CAUSE OF ACTION; AND, THUS, THE DISTRICT COURT IS IN ERROR IN SUSTAINING THE GENERAL DEMURRER OF THE DEFENDANTS AND RESPONDENTS, SMITH-FAUS DRUG COMPANY, ZIONS

CO-OPERATIVE MERCANTILE INSTITUTION AND WALGREEN DRUG COMPANY.

ARGUMENT ON ERROR NUMBER ONE

It is the contention of the appellant that the District Court, when it rendered its decision on the hearing of the said demurrer, misapplied the general rule, which we agree is followed in most jurisdictions, that a word or combination of words which is merely a generic term or descriptive of an article, or trade, or its composition, characteristics, or qualities cannot *ordinarily* be appropriated as a trademark or trade name to the exclusion of its use by others, for the one and only reason that to permit such exclusion would deny competitors the right to describe their goods and wares to the public. As with most general rules, this rule has many exceptions and the word in controversy, "Bracer," comes within some of these exceptions. The District Court entered its Order sustaining respondents' demurrer, just eleven days before the new rules of civil procedure for Utah Courts became effective. These new rules permit no demurrers.

The respondents quoted to the District Court from a few dictionaries, which, in an attempt to impress their readers with the exhaustive scope of the work, had included among their definitions of the word "bracer," an old eighteenth century definition, to-wit: A "tonic." However, all such dictionaries are careful to designate the simile for the word, "bracer," as obsolete, and very few smaller dictionaries even bother to mention this antiquated and long-forgotten meaning. We, herewith, cite for the Court's information from the dictionaries that we found

using the aforesaid antiquated definition of the word, "Bracer."

Webster's New International Dictionary Of The English Language, Second Edition, Unabridged, for 1949, defines on page 322 as follows:

"Bracer. (1) That which braces, binds or makes firm; a brace. (2) One who braces, as in attaching uppers to soles or in boiler-works. (3a) *Obsolete*. A tonic or stimulant. (3b) Slang. A drink of liquor."

The same dictionary on page 2665 defines as follows:

"Tonic. Pertaining to or characterized by tension, esp. muscular tension; hence, producing or adapted to produce healthy muscular condition and reaction."

The same Dictionary on page 1461 defines as follows:

"Lotion. Act of washing, ablution. *Obsolete*. A liquid medicinal preparation for washing; a wash."

Volume 1 of the Oxford's New English Dictionary On Historical Principals, page 1043, published incidently in 1888, even classifies the "tonic" simile for the word bracer as obsolete at that time when it defines bracer as follows:

"3. That which braces (the nerves); hence, a tonic medicine. (a common sense in the 18th century, now obsolete)."

Funk & Wagnall's New Standard Dictionary of the English Language defines on page 322 as follows:

"Bracer (1) That which braces, binds, strengthens, steadies; a band. (2) Something to brace the nerves; a tonic; a common use in theory, 18th century, now slang for a morning drink.

Now that we have shown that "tonic" is only an obsolete meaning for the word, "bracer," we cite from the Restatement of the Law and certain cases and authorities applying the rule that in instances where a word or combination of words has only an obsolete generic or descriptive meaning, as it pertains to the disputed product, the afore-mentioned general rule does not apply, for the reason that the word is not in fact generic or descriptive. Restatement Of The Law, Torts, Division 3, page 580, sec. 721(c):

"(c). A designation is not generic or descriptive under the rule stated in this section,* if its generic or descriptive meaning is obsolete or is known only to philologists, lexicographers or persons acquainted with curiosities of antiquity. Since the meaning is not known in the market, one's use of the designation as a trade-mark does not interfere with the efforts of other merchants to describe their goods. The test is the meaning attached to the designation by prospective purchasers, rather than the scientific meaning."

*The rule mentioned in the above quotation is section 721 on page 579 of the same book reading as follows: "A designation cannot be a trade-mark for goods if it is likely to be regarded by prospective purchasers as a common name or generic name for such goods or as descriptive of them or their ingredients, quality, properties, functions or uses."

Using the test mentioned by the Restatement in section 721 (c) we are convinced that a customer in a department store would be referred to the State Liquor Store and not the shaving-needs, hair tonics and cosmetic counter when this customer told the floor walker that he needed a "bracer." We believe further that no one would recognize a product described only as a "bracer" as being a hair tonic or skin lotion; therefore, we argue that the appellant's competitors are not injured when the State refuses to permit them to use the word "bracer" in connection with their respective products. In short, the ordinary man does not today confuse tonics and bracers as being the *same article*.

We cite the following case and authorities which also apply the aforesaid exception to the said general rule:

"A word which has become obsolete, or which is not in general or common use, and is unintelligible and nondescriptive to the general public, though it may be known to linguists and scientists, may be regarded as arbitrary and fanciful, and capable of being used as a trademark or trade-name." *LeBlume Import Co., Inc., vs. Coty*, 293 F. 344.

"An obsolete word, or one unintelligible to the general public may be a trade-mark even though its technical meaning might otherwise forbid its use." 63 C.J. 345.

Respondents cited to the District Court, in reply to our argument, Vol. 1 of Nims' "Unfair Competition & Tradenames," page 558 wherein Mr. Nims disagrees with the *LeBlume Import Co. vs. Coty* (supra.) case and claims the case is not generally followed. However, the Restatement, *Corpus Juris* and *American Jurisprudence*, among

others, seem to disagree with Mr. Nims and the respondents. We maintain that the Restatement and the other authorities are right, because no one is denied or hampered in his right to describe his product to the public, by applying the LeBlume Import Co. vs. Coty case rule.

In order to prove that the word "bracer" is a proper subject for use as a trade name, we cite now various cases and authorities offering tests and guides as to what words can be restricted—we feel certain that the Court must apply each test favorable to the following question presented by this case: Is the word "bracer" as used in appellant's trade name, "Bracer For The Hair, A Real Bracer For The Hair," capable of being appropriated as a trade name for a combination hair tonic and skin lotion to the restriction of the use of the word by all appellant's competitors and potential competitors in connection with their competing or potentially competing products?

"A word or combination of words which is merely descriptive of an article of trade, or its composition, characteristic, or qualities, cannot be appropriated as a trademark to the exclusion of its use by others. This rule excluding descriptive terms has also been held to apply to tradenames. As to whether words employed fall within this prohibition, it is said that the true test is not whether they are exhaustively descriptive of the article designated, but whether in themselves, and as they are commonly used by those who understand their meaning, they are reasonably indicative and descriptive of the thing intended." Vol. 52, Am. Jur., page 543.

"It has been held that words which are merely suggestive or only indirectly or remotely descrip-

tive of the composition, quality or characteristics of the article, may be appropriate as a valid trade-mark." Vol. 52, American Jurisprudence, page 544.

Certainly the word "bracer" is only remotely descriptive of such products as skin lotions and hair tonics, in fact, under all modern meanings of the word, it is not descriptive at all of such products.

"Names or marks which merely to some extent suggest the character, quality or ingredients of an article, or some supposed advantage to be derived from using it, or some effect to be produced by its use, or the locality of its origin, have been ordinarily upheld as valid trade-marks. The validity of a trade-mark ends where suggestion ends and description begins." 63 Corpus Juris, page 353.

"While it is the general rule that a word which is merely descriptive of the article on which it is used, or of its ingredients or characteristics, cannot be a valid trademark. The rule does not necessarily exclude words which are suggestive of ingredients or quality." *LeBlume Import Co., Inc. vs. Coty*, (Supra).

"Generally, the courts will not enjoin the use of a name consisting solely of generic terms, but it may do so where its use would be confusing and misleading." *Brown vs. Hook*, (Calif.), 180 Pac. (2nd) 982; 79 Calif. App. (2nd) 781.

The Restatement of the Law, Torts, Division 3, section 717, page 562 analyzes the elements necessary to constitute a prima facie case of infringement of a trade name as follows:

“One infringes another’s trade name, if (a) without a privilege to do so, he uses in his business, in the manner of a trade-mark or trade name, a designation which is identical with or confusingly similar to the other’s trade name, though he does not use the designation for the purpose of deception, and (b) the other’s interest in his trade name is protected with reference to (i) the goods, services or business in connection with which the actor uses his designation, and (ii) the markets in which the actor uses his designation.

Paragraphs seven and eight of the complaint set forth heretofore and on file (R.3-4) herein allege that the name of the product being distributed by the respondents and the trade name of the appellant’s product are confusing the buying public and will continue to mislead appellant’s customers, and for the purposes of the demurrer the District Court must assume these allegations to be absolutely true. Therefore, applying the above rule of *Brown vs. Hook* (supra) the District Court should grant the injunction prayed for in the appellant’s complaint, upon appellant’s proving the facts alleged therein to the effect that the public is, and will be, misled.

“According to some authorities, there is a distinction between the use of a name which merely describes the business and its generic in its nature, and a name which, although descriptive of a business, nevertheless depends upon a figure of speech and association of ideas, and is not merely a literal description of a business. In the latter case, where the name is novel, unusual, or fanciful, it may be appropriated by a trader, even though it is descriptive of the business he carries on.” Vol. 52, *Am. Jur.*, page 545.

"Whether a name claimed as a trademark is subject to the objection of being descriptive, or whether it is an arbitrary or fancy name, must depend on the circumstances of each case as it arises." 52 Am. Jur., pages 546-547.

Applying the above universally followed rule, the District Court by sustaining the respondents' general demurrer, denied the appellant any opportunity to show any of the circumstances of this particular matter, since the complaint quite properly only alleged ultimate facts.

Assuming for the sake of argument that the word "bracer" is descriptive of the hair tonic or skin lotion business, which we most strenuously deny, the Court must next determine whether the appellant has obtained the right to enjoin competitors and potential competitors from confusing the public by the use of the word under the doctrine of "secondary meaning." By sustaining the demurrer, the Court refused appellant an opportunity to prove that the appellant's mentioned trade name had obtained sufficient significance in the public mind to come within the application of the aforesaid doctrine. As we have said, the Court on the hearing of a demurrer must deem each and every allegation of the complaint to be true for the purposes of ruling upon the demurrer. Therefore, there can be no argument, it is absolutely true and cannot be questioned, at this time, that the allegations from paragraphs five, seven and eight (R. 2-4) of the complaint are true. The allegations in these three paragraphs in words and effect show that from August 31, 1925 until now the appellant has been engaged in an extensive and profitable hair tonic and skin lotion manufacturing and selling business in Utah, that said hair tonic and skin lotion

is manufactured under the trade name of "Brace For The Hair, A Real Bracer For the Hair," that by reason of the manner in which appellant has conducted his business it has acquired and now commands an extensive patronage and has goodwill in the state under the said trade name, that the trade name of the product, "Skin Bracer," sold and distributed in Utah by respondents is so similar to the said trade name long used by appellant for his product that they have appropriated to their own use and benefit the said goodwill of appellant's business and have deluded the appellant's customers and the public in general into the belief that the two products of the respective parties are one and the same product, that to continue to allow respondents to sell a skin lotion in Utah with the word "bracer" in the trade name will deceive, mislead and defraud the appellant's customers and prospective customers into believing the article sold by respondents is the same article as that which is manufactured and sold by plaintiff, that unless restrained respondents will continue and proceed to carry on the business of selling a skin lotion under a trade name which has and will create much confusion in appellant's business, and that appellant has no adequate remedy at law. Each and every one of the foregoing facts must be deemed to be true by the Court, and the District Court has held that it cannot grant appellant equitable relief in spite of the unquestioned truth of the same. No other allegation is necessary to apply the doctrine of "secondary meaning." To show that other courts and authorities have disagreed with the District Court and granted relief, under the doctrine of "secondary meaning," we cite the following authorities and case:

"It is settled law that words to which no right of exclusive use may be acquired, such as generic

terms, descriptive words, and geographical of proper names, may become so associated in the public mind with the goods or business of some one person as to acquire a secondary meaning; in which case no other person may use them without clearly indicating that his goods or business are not the same as those to which such terms have become associated." 40 A.L.R. 433.

"The term 'tradename' is used in various senses. Thus, it has sometimes been used to indicate a mark affixed to goods where such mark is not originally susceptible of exclusive appropriation, but has acquired a secondary meaning." 52 Am. Jur. page 509.

"A protectible right in the use for trade purposes of a word in common use may be acquired under the doctrine of secondary meaning." 52 Am. Jur., page 509.

"Even though a word or combination of words is incapable of becoming a valid trademark, yet, if it has by a sufficiently long and exclusive use acquired such a secondary meaning as to indicate in the trade that the goods to which it is applied are made by a particular manufacturer, or are put on the market by a particular vendor, its use by another or similar goods in such a way as to be likely to deceive purchasers will be restrained as unfair competition; and its use, even in its primary meaning, will be so limited as to prevent the working of a probable deception by passing off the goods of one maker as those of another. And some cases even have referred to a name which has acquired such a meaning as in the case of a geographical name, as a valid trademark." 26 R. C. L., Trademarks, Sec. 61, page 886.

"The trademark 'Coca-Cola' has become so identified with the product of a particular company as to have acquired a secondary meaning, which will be protected in the courts despite any weakness there may be in the name as a technical trademark. Whether the name 'Cleo-Cola' is, as used by defendant so similar to the trademark 'Coca-Cola' that the former will probably deceive purchasers and cause them to buy the former product in the belief that it is the latter is a question of fact." *Cleo Syrup Corp. vs. Coca-Cola Co.* 139 Fed. (2nd) 416; 150 A.L.R. 1056.

We submit that even though the word "bracer" were a descriptive of generic word as it pertains to appellant's business, which it is not under modern usage, the appellant's complaint alleges facts showing such an old, well-established, publicly known, constant, extensive and profitable business under his trade name that he has alleged every element necessary to show a right to relief under the doctrine of "secondary meaning."

The following are some examples of words which are adjectives which the courts have upheld as valid trade names:

"Landlords' Protective Bureau" infringed by "Landlords' Protective Department," *Koebel vs. Chicago Landlords' Protective Bureau*, 210 Ill. 176; 71 N.E. 362; 112 Ill. App. 21.

"Little Shop" infringed by "Little Antique Shop," *C. C. White Co. vs. Miller*, 50 Fed. 277.

"Moxie Nerve Food" infringed by "Standard Nerve Food," *Moxie Nerve Food Co. vs. Baumbach*, 32 Fed. 205.

"National Folding Box & Paper Co." infringed by "National Folding Box Co." National Folding Box & Paper Co. vs. National Folding Box Co., 43 W.R. 156.

"Old Crow" infringed by "White Crow," W. A. Gaines & Co. vs. Leslie, 54 N. Y. Supp. 421.

"Rubberset" infringed by "Rubberbound," Rubber & Celluloid, H. T. Co. vs. Rubberbound Brush Co., 81 N. J. Eq. 419; 88 Atl. 210.

"Dr. Williams' Pink Pills For Pale People," infringed by "Dr. Wilson's Pink Pills For Anaemic People," Dr. Williams' Medical Company vs. Tottill, Cape Good Hope, 20. S. C. 483; 21 S. C. 589.

"Holeproof" infringed by "No-Hole," Holeproof Hosiery Co. vs. Fitts, 167 Fed. 378.

"Keepclean" infringed by "Sta-Kleen," Florence Mfg. Co. vs. J. C. Dowd & Co., 178 Fed. 73, 101 C.C.A. 7.

"Pep-O-Mint" infringed by "Peptomint," L. P. Larson, Jr. Co. vs. Lamont, Corliss & Co., 257 Fed. 270; C.C.A. 7.

"Rubberset" infringed by "Set In Rubber," Rubber & Celluloid, H. T. Co. vs. F. W. De Voe & C. T. Reynolds Co., 233 Fed. 150.

"Six Little Taylors" infringed by "Six Big Taylors," Mossler vs. Jacobs, 65 Ill. App. 571.

"Wearever" infringed by "Everlasting," Aluminum Cooking Utensil Co. vs. National Aluminum Works, 226 Fed. 815.

"Elastic Seam" infringed by "Stretchiseam," J. A. Scriven Co. vs. Girard Co., 140 Fed. 794.

"Home" infringed by "Home Delight," New Home Sewing Machine Co. vs. Bloomington, 59 Fed. 284.

"Manufacturers' Outlet Co." infringed by "Taunton Outlet Co.," Samuels vs. Spitzer, 177 Mass. 226; 58 N.E. 693.

"Mechanics' Store" infringed by "Mechanical Store," Weinstock, Lubin & Co. vs. Marks, 42 Pac. 142; 109 Calif. 529; 30 L. R. A. 182.

There can be no argument, admittedly, that the manufacturer of steel braces for bridges could not prevent his competitors from using the word "brace" or "bracer" to describe their business or products because the word is descriptive of their product and the competitors would be denied the important right of describing their respective products to customers and the public if the word were thus restricted. Nor do we maintain, that the law would restrict persons manufacturing or selling hairdressing from the use of the word "tonic" to describe their product, because a competitor registered the word. However, we do maintain that the appellant's competitors have lost no right to describe their products, though it be a hair tonic, skin lotion or cosmetic, merely because the appellant has restricted them from using the word "bracer," since the word "bracer," as it pertains to the appellant's business and the respondents' businesses and their competitors' businesses is not descriptive of such businesses—the word is fanciful and arbitrary under modern meanings when used in the manner the appellant has registered it.

The respondents, at the hearing of their demurrer, also half-heartedly argued that the appellant and respondents are not in fact competitors, and for that reason the appellant is not entitled to the relief demanded by him in the prayer of his said complaint. The complaint in paragraph seven (R. 3), and elsewhere in the said pleading, has alleged that all parties herein are in the competitive business of selling and distributing skin lotions, and respondents must deny this allegation, if they could, by answer and not by demurrer. The Court must assume the allegations to be true, while determining the demurrer, that the parties both sell products designed for the same use in the same territory—not that the parties need, however, to be in immediate competition before the courts can restrain one from the use of the others valid trade name. The Restatement of the Law, Torts, Division 3, page 599, section 730 (b) gives the best digest of the law on the subject of who can be restrained from use of a trade name as follows:

“While the class of goods, services or business with reference to which the interest in a trade mark or trade name is protected has been greatly expanded, the class is nevertheless limited. The interest is not protected against the use of a similar designation for any goods, service or business. It is protected only within the limits fixed by the likelihood of confusion of prospective purchasers. The issue of each case is whether goods, services or businesses of the actor and of the other are sufficiently related so that the alleged infringement would subject the good-will and reputation of the other’s trademark or trade name to the hazards of the actor’s business. If pancake syrup is marketed under a designation confusingly similar to a trademark for pancake flour, it is clear that the market

reputation of the flour is subject to the hazards of the market reputation of the syrup since both products are bought by substantially the same purchasers for use together. But, if lipsticks are marketed under a designation confusingly similar to a trade-mark for steam shovels, it is not likely that the market reputation of the steam shovels would thereby share in the market vicissitudes of the lipsticks. The test here, as on the issue of confusing similarity, is the probable reaction of prospective purchasers.”

Applying the test set forth in the above quote, and even assuming that appellant manufactured only a hair tonic and respondents sold only an after-shave lotion, would not both of these products be sold at the men’s cosmetic counter, would the public be surprised if one manufacturer made two such products, would not many of the same customers use both products, and are not both products apt to be retailed from many of the same outlets? James Love Hopkins in his treatise entitled, “The Law Of Trademarks, Tradenames & Unfair Competition, Fourth Edition,” seems to agree with the Restatement’s rule and says on page 376 as follows:

“In determining whether unfair competition exists, it is necessary to determine whether the parties are competitors in business. In considering the defense that the parties were not engaged in competition in business, where plaintiff was a miller and flour dealer and the defendant a baker, Judge Anderson (in *Potter-Wrightington, Inc. vs. Ward Baking Co.*, 288 Fed. 597-601) disposed of the defense accurately and tersely as follows: ‘But both are seeking to enlarge their markets by attracting the ultimate consumer of wheat, mainly eaters of bread.’ ”

In the case before the Court, if the matter had been allowed to go to trial, the trial court would have the duty to determine whether, as a question of fact, the trade name, "Brace For The Hair, A Real Bracer For The Hair" and the trade name, "Skin Bracer" are sufficiently similar to cause possible confusion in the mind of a potential purchaser of the former product. Actual confusion is not necessary as shown in the following quote:

"In order to establish trade-mark infringement or unfair competition, it was not necessary that plaintiff should prove *actual* confusion of goods." California Prune & Apricot Growers Ass'n. vs. H. R. Nicholson Co., 158 Pac. (2nd) 764; 69 Calif. App. (2nd) 207.

"To entitle a party to injunctive relief against the deceptive and injurious use of its tradename which has allegedly acquired a secondary meaning, it is not necessary that the parties be in competitive business or that the injury has already occurred, but it is sufficient if the names, although not identical, are sufficiently similar to cause confusion and injury." Academy of Motion Picture Arts & Sciences vs. Benson, 104 Pac. (2nd) 650; 15 Cal. (2nd) 685.

However, the appellant in paragraphs seven and eight (R. 3-4) of his complaint has alleged that there has been and will be confusion upon the part of appellant's customers and upon the part of the public itself. Only after hearing the appellant's evidence can a court determine fairly whether the names are so similar as to there being a possibility of confusion. In support of this contention we cite the following cases and authorities:

"It is a mere matter of judgment whether or not the word-symbol and the representation would convey to the mind of the ordinary purchaser the same thing." Digest of Decision of Law & Practice in the Patent Office and The United States and State Courts in Patents, Trade-Marks, Copy-rights & Labels by W. L. Pollard, page 524.

"What similarity is sufficient for a party to benefit himself by the good name of another must be determined in each case by its own circumstances, and generally a similarity which would be likely to deceive or mislead an ordinary unsuspecting customer is obnoxious to the law." Academy of Motion Picture Arts & Sciences vs. Benson (supra).

"To entitle the owner of a trade-mark or trade-name to an injunction, it is not essential that the mark or name used be the same, if it be so similar that purchasers would be liable to be misled." LeBlume Import Co., Inc. vs. Coty et al., 293 Fed. 344; 292 Fed. 264.

The appellant's complaint has certainly alleged facts sufficient to show that he conformed with all acts necessary in the year 1925 in order to register his trade name, by the allegations in paragraph five (R. 2) and the certified copy of the application for registration (R. 5-6) designated as "Exhibit A" and attached to and by reference (R. 3) made a part of said complaint. The statute controlling the registration of trademarks in the year 1925 is cited in the Compiled Laws of Utah for 1907 as section 2721, page 927 and in the Compiled Laws of Utah for 1917 as section 6146, page 1198, and reads as follows:

“Any person, association or union may record his or its claim to the same, and a copy or description of such trademark or name, with his affidavit attached thereto, certified by any officer authorized to take acknowledgments of conveyance, setting forth that he, or the firm, corporation, association, or union of which he is a member, is the exclusive owner, or agent of the owner, of such trade mark or name.”

The above statute remained in effect until March 6, 1931, when the Nineteenth Regular Session of the Utah State Legislature passed House Bill number 57 (Chapter 16 on page 17 of the Session Laws of Utah for 1931). The present statute in effect, Title 95, Chapter 2, Section 95-2-1, of the Utah Code Annotated for 1943 is almost identical to the above section (in fact, the editor of the said Code erroneously states in the annotations that the sections are identical) in words and effect, but the present statute requires publication of the intended registered trade name.

The respondents need not have had actual knowledge of the fact that appellant had appropriated the trade name that, as aforesaid, he now does business under. In support of this statement we cite from the following case:

“Actual knowledge of plaintiff’s prior appropriation of the trade name and design is immaterial in an action to restrain infringement; registration being constructive notice.” *Hall vs. Holstrom*. 287 Pac. 668; 106 Cal. App. 563.

The Restatement of the Law, Torts, Division 3, section 731 sets forth certain tests which the Court should apply to appellant’s complaint to determine whether appellant has alleged sufficient facts to allege a course of action. Section 731, page 600, reads as follows:

"In determining whether one's interest in a trade-mark or tradename is protected, under the rules stated in section 717 (supra) and section 730* with reference to the goods, services or business in connection with which the actor uses his designation, the following facts are important:

"(a) the likelihood that the actor's goods, services or business will be mistaken for those of the other;

"(b) the likelihood that the other may expand his business so as to compete with the actor;

"(c) the extent to which the goods or services of the actor and those of the other have common purchasers or users;

"(d) the extent to which the goods or services of the actor and those of the other are marketed through the same channels;

"(e) the relation between the functions of the goods or services of the actor and those of the other;

"(f) the degree of distinctiveness of the trade-mark or trade name;

"(g) the degree of attention usually given to the trade symbols in the purchase of goods or services of the actor and those of the other;

*Section 730 (page 596). "The interest in a trade-mark or tradename is protected under the rule stated in §717 with reference only to (a) competing goods, services in business and (b) other goods, services or business which in view of the designation are used by the actor, likely to be regarded by prospective purchasers as associated with the source identified by the trade mark or trade name."

“(h) the length of time during which the actor has used the designation;

“(i) the intent of the actor in adopting and using the designation.”

Every one of the nine above tests can be applied to the appellant's complaint to show his right to have the infringement of his trade name restrained, but since we have heretofore shown in this brief wherein each test applies favorably to appellant, we shall not be tedious by repeating our stand again.

ERROR NUMBER TWO

THE DISTRICT COURT WAS IN ERROR WHEN IT RENDERED AND ENTERED ITS ORDER, JUDGMENT AND DECREE HEREIN DISMISSING APPELLANT'S COMPLAINT.

Naturally, as we have stated heretofore, we are convinced that the District Court was in error when it sustained the demurrer of the respondents. Consequently, if the complaint states facts sufficient to state a good cause of action, the court was in error in dismissing the complaint without the consent of appellant until the matter had been tried. The above statements are too obvious to press further.

The District Court also was in error in dismissing the complaint as to the two parties-defendant not before the Court. The District Court had no jurisdiction over defendants, The Mennen Company and John Doe; consequently the District Court had no authority to dismiss the complaint as against all defendants. The appellant

should still within the time prescribed by statute be permitted to serve said two defendants, or either of them, with a copy of a summons to which a true copy of said complaint on file herein has been attached and proceed against said two defendants, or either of them. However, the District Court dismissed the complaint as against all defendants by not naming the respondents (R. 9) so appellant has been denied his legal right to proceed against the said two defendants, The Mennen Company and John Doe, upon finding them in the State of Utah, without appellant assuming the additional work and expense of commencing a new action and filing a new complaint. The District Court had no jurisdiction to dismiss the complaint as the same effected the said two defendants until each of the said two defendants made an appearance before the Court and requested such action of the District Court by some proper motion or demurrer or pleading.

CONCLUSION

We, therefore, respectfully conclude that the judgment (R. 9) and order of the District Court should be reversed.

Respectfully submitted,

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