

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 Respondents

Utah Supreme Court

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Ray, Rawlins, Jones & Henderson; Attorneys for Respondents;

Davis, Hoxie & Faithfull; Of Counsel;

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In the  
**Supreme Court of the State of Utah**

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WILLIAM J. FARRELL,  
*Plaintiff and Appellant,*

vs.

THE MENNEN COMPANY, a corporation,  
SMITH-FAUS DRUG COMPANY, a corporation, ZIONS CO-  
OPERATIVE MERCANTILE IN-  
STITUTION, a corporation, WAL-  
GREEN DRUG COMPANY, a corporation, and JOHN DOE,  
*Defendants and Respondents.*

Case No.  
7461

**FILED**  
JUN 19 1950

Clerk, Supreme Court, Utah

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**BRIEF OF RESPONDENTS**

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RAY, RAWLINS, JONES & HENDERSON,  
*Attorneys for Respondents.*

DAVIS, HOXIE & FAITHFULL,  
*Of Counsel*

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7461

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## BRIEF OF RESPONDENTS

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### STATEMENT OF FACTS

This appeal is from a judgment (R. 9) of the District Court of the Third Judicial District in and for Salt Lake County, State of Utah, sustaining respondents' demurrer (R. 7) to the complaint (R. 1-6) as failing to state facts

sufficient to constitute a cause of action and dismissing the complaint.

Respondents, Smith-Faus Drug Co., Zions Co-Operative Mercantile Institution and Walgreen Drug Company, are charged with infringement of an alleged trade name "Brace For the Hair, A Real Bracer For The Hair," by selling a skin lotion under the mark "Skin Bracer." The complaint is based upon the annexed "Exhibit A," a certified copy of a trade-mark registration (R. 6) issued to appellant on August 31, 1925, by the Secretary of State of Utah. That registration is for a complete label comprising the words "BRACE FOR THE HAIR" over the phrase "A Real Bracer For The Hair" in a distinctive design and with the further legend "Alcohol 15%. Formulated and Produced by WM. FARRELL, HAIR SPECIALIST, Salt Lake City, State of Utah." The registration further states "Said Trade Mark to be used generally as follows: A Real Bracer for the hair."

We do not agree with the statement in appellant's brief (pp. 6, 7) of the points and arguments presented in support of the demurrer. Such statement was stricken from the record by the District Court's order of February 25, 1950. All points were fully argued and submitted in memoranda below, and we do not agree with appellant's conclusion (brief pp. 7-8): "Naturally, neither party knows which of the three arguments of respondents, if any, influenced the Court when it sustained the demurrer."

It is perfectly clear to us why the Court sustained the demurrer and appellant's contention to the contrary can serve only to cloud the issues decided below.

## STATEMENT OF POINT

Respondents rely upon the following point for affirmance of the judgment appealed from:

1. *The Complaint with annexed "Exhibit A" fails to state facts sufficient to constitute a cause of action.*

## ARGUMENT

*Appellant has not acquired exclusive rights in "Bracer."*

Respondents' demurrer admits the facts well pleaded but not, of course, their sufficiency. Here the facts pleaded clearly show that appellant has acquired no rights to the dictionary word "Bracer" by its use of the alleged trade-mark "Brace For The Hair, A Real Bracer For The Hair," the only use alleged.

Appellant, throughout his brief, assumes his alleged use of the word "bracer" constitutes a trade-mark use. Such is not the fact under the allegations of his complaint.

Appellant's alleged trade-mark is not the word "bracer" alone, as assumed in appellant's arguments, but is at the very least the combination of words "A Real Bracer For The Hair." As the word "bracer" is used by appellant, in that phrase, it is incapable of acquiring any trade-mark significance. This proposition rests upon the obviously sound principle that when a word is used, not in a trade-mark sense as the badge of the sponsor but only in a sense which is laudatory advertising of the product, it cannot become the exclusive mark of anyone who so uses it. We cite a few of the leading authorities applying this principle.

In *Burmel Handkerchief Corp. v. Cluett Peabody & Co.*, (CCPA) 127 F. 2d 318, at page 321, involving the slogan "Handkerchief of the Year," the court stated:

"In the final analysis such expressions as we are discussing with relation to objects of trade are a 'puffing of wares' and are intended to call attention to the superiority of the advertised goods. Such expressions are a condensed form of describing in detail the outstanding character or quality of the objects to which they are applied \* \* \*.

"\* \* \* We are further of opinion that the notation inherently cannot function as a trade-mark. Such a common expression which can indicate nothing but high quality surely would not be indicative of origin to the purchasing public."

In *Rosenberg v. Shakeproof* (D. C., Del.), 20 F. Supp. 959, it was held that the word "Self-Tapping", as there used by the plaintiff in its label, was incapable of acquiring trade-mark significance. The label is reproduced at p. 963 and includes, as here, the name of the maker of the goods. The court stated (pp. 963-4) :

"The inconspicuous words 'hardened,' 'self-tapping,' and 'sheet metal screws' are descriptive of the character, operation, and purpose of the product. Plaintiff's advertising matter in evidence contains many statements emphasizing the descriptive sense in which the plaintiffs have been using the word 'self-tapping.' The way in which plaintiffs have used the word 'self-tapping' precludes all possibility that the word has come to indicate to anyone the origin of the product. It is likewise established by the evidence that the word 'self-tapping' has never been used by the defendant in any other sense than



in a descriptive sense. It is clear that the word 'self-tapping' cannot be appropriated by plaintiffs as a valid trade-mark."

In the present case, the descriptive sense in which appellant has used the word "bracer" is "emphasized" in the phrase "A Real Bracer For The Hair."

In *Ex parte American Enka Corp.*, a Commissioner's Decision in June, 1949, 81 U. S. P. Q. 476, the facts were stated as follows (p. 476) :

"The mark sought to be registered consists of a vertical gray rectangle having a large black circle superimposed upon the center thereof. Above the circle appear the words 'THE FATE OF A FABRIC HANGS BY A THREAD,' and below it appear the words 'ENKA Rayon.' Within the circle appears the words 'Fashion APPROVED.' "

The similarity to appellant's label and alleged trade-mark is apparent. In holding this mark, and particularly the slogan, "THE FATE OF A FABRIC HANGS BY A THREAD" incapable of trade-mark significance, the opinion states (pp. 477-478) :

"The phrase 'THE FATE OF A FABRIC HANGS BY A THREAD' as presented and used appears to me obviously to be an advertising phrase indicating that the success or failure of a fabric depends upon the thread of which it is made and, as associated with other features of the mark presented, is clearly a laudatory or puffing expression indicating that the use of 'ENKA' thread in a fabric is desirable to insure against an unhappy fate. It would appear that any function or identification in the



mark presented results from the use of the name 'ENKA' in the label, and that, unless used with that word or with applicant's name, or otherwise associated with some other indication of a source or origin of the thread, the phrase in question would not serve as a means of identification of origin. As such it would not appear to distinguish the goods of applicant from the goods of others, and whether or not used in connection with 'ENKA' would simply stand as, and be recognized as, a truism, perhaps aptly stated, indicating the desirability that fabric be composed of good thread. Alone it would not distinguish or identify any particular thread and would seem merely an advertisement or advertising phrase with reference to a potential use of thread, the origin of which must be otherwise determined. While not controlling and perhaps amounting to an oversimplification, it seems extremely doubtful that anyone would order or call for 'THE FATE OF A FABRIC HANGS BY A THREAD' thread."

\* \* \* \* \*

"While, as indicated above, it has never been questioned but that a plurality of words might function as a trade mark, it must be noted that both historically and by common understanding, overlong phrases, sentences or clauses describing goods have been regarded as advertisements rather than trade marks. Somewhere between the few words ordinarily included in a trade mark and the number of words included in a historical novel a line must be drawn. Mere advertising language or features even if attached to goods or their containers, cannot be considered to be trade marks since they are or would be just as applicable to the similar products of any manufacturer and therefore cannot serve to identify the goods of one person or distinguish from those of others.

“Accepting, therefore, applicant’s contention that the question is not whether or not his mark is a slogan, but whether or not it is a trade mark, it must be found that the examiner was correct in finding that words do not function as a trade mark and cannot serve to indicate source or origin or identify the goods of one applicant and distinguish them from those of others.”

*Appellant’s alleged use of “bracer” is merely in a laudatory phrase.*

The function of a trade-mark is to indicate the origin of goods, and not merely to state their function or puff their merits. As stated by Nims in “Unfair Competition and Trade-Marks,” Vol. 1, at page 520:

“The important question of fact to be determined is whether the trade-mark name indicates the producer, not whether it indicates the nature of the goods. It may do both but it must, as its primary function, indicate the producer.”

Since appellant has long used the word “bracer” in a purely descriptive and laudatory sense, by combining it with all the other words in the label, and at least with “A Real Bracer For The Hair”, he can not now prevent others using the word “bracer” either to show that their hair preparations have the same qualities for bracing the hair or for any other purpose. It follows that any seller of skin lotions is free to claim that his product is a “bracer” for the skin so far as appellant is concerned. Such use of the word “bracer” merely puffs the quality of his product and has no significance as to origin in appellant. Therefore,

respondents' use of "bracer" alone or with "skin" cannot possibly confuse appellant's product with respondents' product.

We emphasize the respondents' position is based upon the particular *modus* in which "bracer" is and has been for 25 years used by appellant, as part of the phrase "A Real Bracer For The Hair," because appellant's arguments ignore this point. In commenting on an exception to the general rule that a word, generic or descriptive of the product, cannot be appropriated exclusively, appellant assumes that his alleged trade-mark is simply the word "bracer" and proceeds to cite authorities to show that such a word may become a valid trade-mark when through long and exclusive use *as a trade name or mark* it has acquired a secondary meaning, indicating to the public the source of the product. We do not dispute this exception to the general rule. Respondents did not below, and do not now contend that if appellant had used the word "bracer" by itself, in a trade-mark sense to denote the source rather than some claim of functional merit of the product, it could not have acquired a secondary meaning and thus become valid as a trade-mark or trade-name. But appellant elected to use "bracer" in a phrase and in such a manner that on the face of his alleged trade-mark "A Real Bracer For The Hair" the word "bracer" has only a descriptive meaning. Therein lies the basic distinction between the present case and those relied upon by appellant.

It also is beside the point to contend, as appellant does, that the word "bracer" has become obsolete in the sense of

denoting a "tonic" or "stimulant" and is therefore, not currently descriptive of appellant's hair preparation. Obviously, to characterize appellant's hair tonic as "A Real Bracer For The Hair" makes use of the word "bracer" descriptively, whether in the tonic or stimulant sense or in the sense of that which "binds or makes firm," "strengthens, steadies," which is equally applicable to a hair preparation and is admittedly a current sense according to definitions in appellant's brief (pp. 11-12). Appellant has chosen to use this word in a descriptive sense, because otherwise his advertising phrase would have no meaning or would be deceptive. Having regard to this manner in which "bracer" appears as a part of appellant's alleged trade-mark, it is curious to find appellant suggesting (Brief p. 13) that a customer would be referred to the State Liquor Store if he asked for a "bracer." It would seem more appropriate to consider whether the floor walker would have directed the customer to the liquor store if he had asked for "a real bracer for the hair."

*The L'Origan case is not in point.*

Since appellant's brief makes repeated reference to *LeBlume Import Co. v. Coty*, 293 Fed. 344, we point out that in that case the trade-mark "L'Origan" had been used by itself and not as part of a composite mark or laudatory

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<sup>1</sup>The following standard dictionaries show that the use of "bracer" in this sense is not obsolete: Webster's Collegiate Dictionary, 3rd Edition of Merriam Series, 1929; Webster's Universities Dictionary, World Publishing Co., 1940; The New Century Dictionary, The Century Co., 1929; Everyman's English Dictionary, E. P. Dutton, 1926; Macmillan's Modern Dictionary, Macmillan Co., 1943; Wyld-Universal Dictionary of English Language, G. Rautledge & Sons, 1932.

phrase which showed on its face that the word "origan" had only a descriptive meaning. The trade-mark owner had used the word in a trade-mark sense, so that it was at least capable of acquiring a secondary meaning, whether or not it was obsolete. Moreover, it appeared that the trade-mark owner had originated the term as applied in a trade-mark sense to perfume. In distinguishing the case, the court in *United Shoe Machinery Corp. v. Compo Shoe Machinery Corp.*, (C. C. P. A.), 56 F. 2d 292, stated (p. 294) :

"The controlling facts of the case at bar are very different from those in the case of *LeBlume Import Co. v. Coty* (C. C. A.) 293 F. 344 (chiefly relied upon by appellee), where the word 'Lorigan' was held to be registerable as a trade-mark for perfume. 'Lorigan' and 'Origan' meant the same. 'Origan' was the name of a rare plant. The principal base of Coty's perfume was not the essence from the origan plant, although it was claimed to be the principal basis of other perfumes. The court pointed out the equities of Coty who, unlike the appellee in the case at bar, was the originator of the term as applied to perfume, and also called attention to the suggestive rather than descriptive character of the term, and applied the doctrine of secondary meaning.

\* \* \* \* \*

"One of appellee's witnesses claimed to have 'originated' the term 'Compo.' Upon this record it can hardly be said that he 'originated' it; at most he only brought it into more extensive use. If appellee's position in this case is correct, a manufacturer of women's wearing apparel could 'originate' the term 'bustle' and get a monopoly upon the term, since bustles, as far as we know, are no longer used and have not been in use nor have they been often referred to in literature or conversation during the

greater portion of the last half century. If appellee's contentions with respect to a trade-mark right in the word which it claims to be obsolete were approved by the courts, the problems of the Patent Office and the courts in determining what words were 'obsolete and forgotten' would increase in frequency and perplexity. A trade-mark, as was held by the United States Supreme Court in *Bourjois & Co. v. Katzel*, 260 U. S. 689, 692, 43 S. Ct. 244, 67 L. Ed. 464, 26 A. L. R. 567, carries with it a monopoly, as far as it goes, no less complete than does a patent. Such monopolistic rights must rest on foundations more secure than those upon which appellee relies."

In sum, appellant does not allege that "Bracer" is original with him, or even a trade-mark use of that well-known word.

*Registration created no substantive rights in appellant.*

Apparently appellant does not now contend that his registration in 1925 under the statute quoted (brief p. 27) was more than a mere "record" of "his claim," as stated in the Utah statutes to the present time. His reliance on the statutes is merely for constructive notice of that purported claim.

It is the universal rule that registration statutes are merely in affirmance of the common law and do not create or confer any substantive rights in trade-marks registered thereunder, see generally, 52 *American Jurisprudence*, Sec. 44, p. 534, and 63 *Corpus Juris*, Sec. 142, p. 470, *Trade-Mark Cases* 100 U. S. 82, and *Armstrong Paint & Varnish Works vs. Nu-Enamel Corp.*, 305 U. S. 315.



*“Skin Bracer” or “Bracer” on skin lotion is not an infringement of appellant’s composite mark.*

Assuming, however erroneously, that “Brace For The Hair, A Real Bracer For The Hair” is capable of being or becoming a valid trade-mark for hair tonic, it is clearly not infringed by respondents’ use of “bracer” alone or with the word “skin” for the well-known and long-established Mennen product.

As pointed out by Nims in *“Unfair Competition and Trade-Marks*, (4th Ed.) Vol. 1, p. 361:

“The cardinal rule upon the subject is that no one shall, by imitation or any unfair device, induce the public to believe that the goods he offers for sale are the goods of another and thereby appropriate to himself the value of the reputation which the other has acquired for his own products or merchandise.”

There follows a collection of representative cases where infringement of various labels, slogans and trade-marks was decided. In none was relief granted where there was as little likelihood of confusion as is here the case, and in many where the respective marks were much closer was relief denied.

Respondents use only “bracer,” one of the ten words in appellant’s composite mark or phrase. Could the public possibly be “induced” thereby to believe that Mennen’s “Skin Bracer” was the product of William Farrell—Hair Specialist? A member of the public in Utah, buying the widely-known “Skin Bracer” lotion, even if he had great



familiarity with only part of appellant's phrase "A Real Bracer For The Hair," would not associate the lotion of Mennen with the tonic of Farrell or with Farrell himself. Something more than the one common word "bracer" would be necessary for such association. If appellant wanted the public, via his phrase, to associate a skin lotion with him or his tonic, he would undoubtedly use the full phrase, substituting "skin" for "hair." The mere use of "bracer" would obviously not be enough to insure this desired public association.

Actually "Skin Bracer" and "Brace For The Hair, A Real Bracer For The Hair" are so different in sound, meaning and appearance there is no infringement of one by the other.

*Even if appellant had been right as to validity and infringement the Complaint is still fatally defective.*

It is interesting to note that, while the complaint, para. 7 (R. 3), alleges that "Skin Bracer" has been used by Mennen and by respondents "for sometime last past," it fails to allege that appellant adopted or used his alleged trade-mark prior to respondents or to Mennen. This seems a *fatal omission* to a cause of action for trade-mark infringement and for the injunctive relief prayed for by appellant (R. 4) because priority of adoption and use is necessary to appellant's affirmative case. Under the statute, *Utah Code Annotated 1943*, Sec. 95-1-6, it is the "person who has first adopted and used a trade-mark, trade-name or device" who is the "owner" and entitled to an injunction and damages

for its infringement. The same is true at common law, *Nims* (supra). Sec. 217, pp. 628-9.

*The District Court did not err in entering the judgment from which appellant appeals.*

Appellant as an afterthought, (brief pp. 29-30), contends that because the District Court did not have or obtain jurisdiction over The Mennen Company and an unidentified other party defendant, John Doe, it should not have dismissed the complaint as to them, but only as to the three respondents who alone demurred.

This seems extremely technical when it is considered that appellant elected to stand on his complaint because he has alleged all facts that he can prove, (brief p. 8), and the complaint fails to state facts sufficient to constitute a cause of action against The Mennen Company and the unidentified defendant for the same reasons that it was held insufficient by the Court below as against the respondents. One attempted service on The Mennen Company in New Jersey has already been vacated below on Mennen's motion because as stated by appellant, (brief p. 29), the District Court had no jurisdiction over The Mennen Company and John Doe. What useful purpose could be accomplished by appellant hereafter obtaining a valid service on defendants over which the Court now has no jurisdiction, if the complaint upon which service is issued alleges all that can be proved but does not state a claim upon which relief can be granted against such defendants.

We submit, however, that the judgment entered by the District Court, in substance and legal effect, dismisses this action as to the respondents only. If, in view of appellant's contentions there should be any doubt in this respect, this Court, of course, may clarify the legal effect of the District Court's judgment by a simple modification thereof to the effect that the action herein is dismissed only as to the respondents, Smith-Faus Drug Company, Zions Co-operative Mercantile Institution and Walgreen Drug Company, and as so modified, affirm the same.

### CONCLUSION

So it appears that the District Court had clear reason to sustain the demurrer for failure to state a cause of action. It could serve no useful purpose to put respondents to the trouble and expense of trial on such a complaint.

The judgment appealed from should be affirmed, with costs to respondents.

Respectfully submitted,

RAY, RAWLINS, JONES & HENDERSON,

*Attorneys for Respondents.*  
1011 Walker Bank Building  
Salt Lake City, Utah

DAVIS, HOXIE & FAITHFULL,

*Of Counsel*

20 Pine Street

New York, New York