

1982

Alex George et al v. H. S. Peterson et al : Brief of Respondent

Utah Supreme Court

Follow this and additional works at: https://digitalcommons.law.byu.edu/uofu_sc2

 Part of the [Law Commons](#)

Original Brief submitted to the Utah Supreme Court; funding for digitization provided by the Institute of Museum and Library Services through the Library Services and Technology Act, administered by the Utah State Library, and sponsored by the S.J. Quinney Law Library; machine-generated OCR, may contain errors.

Pete N. Vlanos; Vlahos, Perkins & Sharp; Attorneys for Plaintiff-Appellant;

Robert E. Phoerer; Attorneys for Defendant-Respondent;

Recommended Citation

Brief of Respondent, *George v. Peterson*, No. 18285 (Utah Supreme Court, 1982).

https://digitalcommons.law.byu.edu/uofu_sc2/2959

This Brief of Respondent is brought to you for free and open access by BYU Law Digital Commons. It has been accepted for inclusion in Utah Supreme Court Briefs (1965 –) by an authorized administrator of BYU Law Digital Commons. For more information, please contact hunterlawlibrary@byu.edu.

IN THE
 SUPREME COURT
 OF THE
 STATE OF UTAH

ALEX GEORGE, d/b/a
 HIGH COUNTRY CLUB,

Plaintiff and
 Appellant,

vs.

H. S. PETERSON, d/b/a
 HIGH COUNTRY INN RESTAURANT,
 d/b/a PETERSON REALTY COMPANY,

Defendant and
 Respondent.

)
)
)
)
)
)
)
)
)
)
)
)
)

Case No. 18285

BRIEF OF RESPONDENT

Appeal from the Judgment of the Second Judicial
 District Court of Weber County, Honorable Calvin
 Gould, Judge

ROBERT E. FROERER, Esq.
 536 24th Street
 Suite 2B
 Ogden, Utah 84401
 Attorney for
 Defendant and Respondent

PETE N. VLAHOS
 VLAHOS, PERKINS & SHARP
 Legal Forum Building
 2447 Kiesel Avenue
 Ogden, Utah 84401
 Attorney for
 Plaintiff and Appellant

FILED

JUL 12 1982

Clark, Supreme Court, Utah

TABLE OF CONTENTS

TABLE OF AUTHORITIES	ii
NATURE OF THE CASE	1
DISPOSITION IN LOWER COURT	1
NATURE OF RELIEF SOUGHT ON APPEAL	2
STATEMENT OF FACTS	2
ARGUMENT	
POINT ONE	5
A GEOGRAPHIC DESCRIPTIVE TERM IS NOT LEGALLY PROTECTABLE UNTIL ITS CLAIMED OWNER HAS ATTAINED A SECONDARY MEANING IN THE MARKET PLACE. SUCH SECONDARY MEANING CAN ONLY BE OBTAINED THROUGH EXTENSIVE USE AND ADVERTISING	
POINT TWO	11
BURDEN OF PROVING NAME HAD ATTAINED SECONDARY MEANING IS UPON THE ONE WHO SEEKS INJUNCTION TO RESTRAIN	
POINT THREE	14
FILING A D/B/A DOES NOT CONFER THE RIGHT TO A TRADE NAME OR TRADEMARK	
CONCLUSION	15
CERTIFICATE OF MAILING	17

TABLE OF AUTHORITIES

AUTHORITIES

74 Am. Jur. 2d, Sec. 59	5
74 Am. Jur. 2d 818 & 819, Sec. 168	11
74 Am. Jur. 2d 821, Sec. 172	13
<u>Trade Protection and Practice, Jerome Gilson,</u> Vol. II, Sec. 2.07 & 2.09	6

CASES

<u>Coalgate Abstract Co. v. Coal County Abstract</u> <u>Co. (1937), 67 P.2d</u>	10
<u>Cloverleaf Dairy Co. v. Van Gerven, 269 P. 1020,</u> 72 Utah, 290	12
<u>88¢ Stores, Inc. v. Martinez, 361 P.2d 809,</u> 227 Oregon 147	12
<u>First National Bank of Lander v. First</u> <u>Wyoming Savings and Loan Association,</u> 592 P.2d 697	12
<u>Frostig v. Saga Enterprises, Inc., 539 P.2d</u> 154, 272 Oregon 565	13
<u>Lift Truck Parts & Service, Inc. v. Bourne</u> (1963), 385 P.2d 735	9, 12
<u>MacPhail v. Stevens, Colo. App.,</u> 586 P.2d 1339	9, 15
<u>Wyoming Nat. Bank v. Security Bank & Trust Co.</u> (1977), Wyo., 572 P.2d 1120	9
<u>Zebra Distributing Co. v. Ace Fireworks, Inc.</u> (1969), 450 P.2d 962	10

STATUTES

42-2-5 Utah Code Annotated, 1953	14
42-2-6.5 Utah Code Annotated, 1953	3, 14
70-3-3 Utah Code Annotated, 1953	15

IN THE
SUPREME COURT
OF THE
STATE OF UTAH

ALEX GEORGE, d/b/a)	
HIGH COUNTRY CLUB,)	
)	
Plaintiff and)	
Appellant,)	DEFENDANT-RESPONDENT'S
)	
vs.)	Case No. 18285
)	
H. S. PETERSON, d/b/a/)	
HIGH COUNTRY INN RESTAURANT,)	
d/b/a PETERSON REALTY COMPANY,)	
)	
Defendant and)	
Respondent.)	

NATURE OF THE CASE

This is an action brought by plaintiff-appellant for an alleged infringement of trade name "High Country." Plaintiff-appellant claims registration of the name High Country Club and defendant-respondent claims registration of the name of High Country Inn and High Country Inn Restaurant.

DISPOSITION IN LOWER COURT

The District Court in and for the County of Weber, the Honorable Calvin Gould presiding, found in favor of the defendant-respondent and declared that the name "High Country" is a geographic name; that it is not entitled to protection as a trade name unless it has obtained a secondary

meaning and that the burden of proving a secondary meaning is on the party asserting such meaning; that the plaintiff-appellant neither asserted nor articulated a secondary meaning and it was not entitled to protection and dismissed plaintiff-appellant's suit, no cause of action.

NATURE OF RELIEF SOUGHT ON APPEAL

Defendant-respondent seeks an affirmation of the lower court's judgment.

STATEMENT OF FACTS

Plaintiff-appellant owned a building used for a lounge and other purposes located on Wall Avenue near 12th Street in Ogden, Utah. Some time in 1977 (R-85), plaintiff-appellant commenced operation of a lounge on said property under the name of "High Country Club" (R-98, R-103). Plaintiff-appellant filed this name under d/b/a with the Secretary of State in 1977 (Plaintiff's Exhibit M).

Defendant-respondent operated a motel in Heber Utah, in 1977 under the name of Stardust Inn and changed the name to "High Country Inn" in 1977. Defendant-respondent filed a d/b/a with the secretary of state in 1977, registering the name "High Country Inn" (Plaintiff's Exhibit L). In 1977, the Utah law permitted anyone to file a d/b/a using any name without regard to its use by other parties (R-114), 42-2-5, UCA, 1953. In 1979, the law was changed, giving the Secretary

of State the responsibility of monitoring the registration of names and determining whether or not the names were deceptively similar, 42-2-6.5, UCA, 1953.

Plaintiff-appellant operated his tavern under the "High Country Club" logo and limited his advertising to signs at place of business and in the yellow pages of the local telephone directories under the heading "Taverns" for the years 1977 through 1981 (R-98, 99, 100, 101). Not until 1981 (R-102) did plaintiff-appellant advertise in the yellow pages of the local telephone directory under "Restaurants" using the name High Country Inn Restaurant. Plaintiff-appellant did no other advertising (R-109, R-110).

Plaintiff-appellant was licensed with Ogden City to sell beer in this private club during the years 1977, 1978 and 1979. Not until the year 1980 did plaintiff-appellant expand this operation to a public restaurant (R-104, R-105).

Defendant-respondent filed a d/b/a "High Country Inn" in 1977 doing business in Heber City, Utah, in the business of motel and restaurant (Plaintiff's Exhibit L). Subsequently, defendant-respondent planned and ultimately constructed the motel and restaurant on 12th Street in Ogden, Utah, near the freeway entrance and exit; signs announcing the construction of the motel were placed on the property in 1978 and the motel and the restaurant were opened for business in 1979 (motel) and 1980 (restaurant) (R-136, R-144). Defendant-respondent filed a d/b/a with the secretary of state to add the name "Restaurant" to "High Country Inn" in 1980 (R-117; Defendant's Exhibit 30).

Defendant-respondent leased the restaurant part of the Inn, and it operates under the name "Moore's High Country Inn Restaurant" (R-105, R-159, R-161).

Plaintiff-appellant was aware that the motel was to be built, because of the preconstruction advertising in 1978 (R-172, R-136) indicating the name and location of the motel.

Defendant-respondent has done considerable advertising in trade journals and highway signs since 1978 (R-136, R-164, R-165, R-166).

The evidence is conflicting concerning what confusion has resulted from the similarity of the names, if any (R-153). Witnesses for the defendant-respondent indicate that there have been no calls made to the restaurant operated under the name of "Moore's High Country Inn Restaurant" (R-153, R-167); however, there had been calls made to the motel asking for different individuals by name indicating that such individuals were in the back room or in the pool room (R-166, R-167). Plaintiff-appellant indicates that on one or two occasions banquet sized groups appeared at his establishment for supposed reservations. Defendant-respondent witnesses indicated that it is not uncommon for a banquet to be reserved and no one show up (R-159).

Although plaintiff-appellant claims confusion in the names, he advertised in the yellow pages under the name "High Country Restaurant" in the telephone directory in "1981" and under the categories "Restaurants and Taverns" rather than the name "High Country Club" under "Taverns" only as in previous years (1980 and prior) (R-103, R-110).

The witness from the secretary of state's office called by plaintiff-appellant testified that the name of "High Country" is a geographic name that is not entitled to protection per se, the name "club" designates a private rather than public operation and the name "restaurant" and "inn" are not deceptively similar to the word "club" attached to such term as High Country (R-118, R-119, R-121). There are some 22 businesses that have registered with the secretary of state's office in Utah (R-118, Defendant's Exhibit 28) with the name "High Country" as a prefix to their logo. Plaintiff-appellant claims ownership to the geographical term "high country" without having to be attached to any other term (R-103).

ARGUMENT

POINT ONE

A GEOGRAPHIC DESCRIPTIVE TERM IS NOT LEGALLY PROTECTABLE UNTIL ITS CLAIMED OWNER HAS ATTAINED A SECONDARY MEANING IN THE MARKET PLACE. SUCH SECONDARY MEANING CAN ONLY BE OBTAINED THROUGH EXTENSIVE USE AND ADVERTISING.

Geographic terms consist of the names of topographical features, mountains, lakes, rivers, streams, waterfalls, and forests.

Geographic names are common property and are not subject to ownership unless the name has acquired special meaning in the public to the product or service to which it is attached. In 74 Am. Jur. 2d, Trademarks and Tradenames, Section 59, it states:

"Mere geographical names are ordinarily regarded as common property, and it is a general rule, subject to certain qualifications and exceptions hereinafter

noted, that such a name cannot be appropriated as the subject of an exclusive trademark or tradename... although when so used as to acquire a secondary meaning, the user may be entitled to protection against unfair use..."

In Trade Protection and Practice, Jerome Gilson, Vol.

II, Sec. 2.07, it states:

"Section 2 of the Lanham Act recognizes the principle that geographically descriptive terms which attain secondary meaning are entitled to legal protection and federal registration. The section denies registration to a mark which, 'when applied to the goods of the applicant is primarily geographically descriptive or deceptively misdescriptive of them,' unless it 'has become distinctive of the applicant's goods in commerce.' The statutory rule as to registrability corresponds in general to the attitude of the courts in infringement or unfair competition cases. Thus, judicial relief is ordinarily granted where the geographically descriptive term has attained secondary meaning through extensive use and advertising. Here, the public has come to regard the term as identifying the source of the product or service and as distinguishing it from those of others, and relief is forthcoming in order to prevent confusion and deception....

"...Primarily geographic associations may be dispelled by combining the geographic term with other words to form a composite trademark, so that the mark in its entirety carries primarily non-geographic associations."

Arbitrary or fanciful names such as KODAK, EXXON, and ZUBAN are inherently distinctive and are eligible for legal protection without a showing of secondary meaning. One reason such names are almost immediately protectable is because they convey instant trademark meaning to the public.

Less distinctive names, however, do not convey such meaning to the public and must obtain a secondary meaning through use. In Trade Protection and Practice cited above, in Sec. 2.09 it states:

"...Among these are descriptive terms, geographically descriptive terms, personal names, grade or quality designations, slogans, literary titles, trade dress or packaging collocations, and non-functional product and container configurations. With few exceptions these designations and matter ordinarily do not, at least initially, perform the critical trademark function of identifying to the public the source of products and distinguishing them from the products of others. In their primary sense they may give the consumer various kinds of information about the product, how it operates, or where it was made, or they may be simply decorative in nature. These meanings are not generally regarded as trademark meanings, and hence they usually do not qualify the particular term or designation for legal protection. In time, however, through extensive use and advertising, such terms may take on a new, or secondary meaning, becoming regarded by the public as designating the source of the products and distinguishing them from the products of others. When and if this shift of meaning occurs in the marketplace, trademark protection is available.

"...Secondary meaning has been defined as 'association, nothing more.' It is the association in the public mind between a product and its source which occurs when an inherently nondistinctive designation attains secondary meaning, or changes from being non-distinctive to being distinctive of the particular product. Section 2(f) of the Act expresses the same concept by providing for principal register trademark registration when a non-distinctive designation has 'become distinctive of the applicant's goods in commerce.' Thus, 'secondary meaning' and 'distinctiveness' are frequently employed synonymously, to express the same concept. So too is the term 'special significance', which is used in the Restatement. Commenting on the secondary meaning doctrine, one court has said:

"...Whether or not an inherently non-distinctive designation has attained secondary meaning is a question of fact in each case. The court typically evaluates all of the facts which tend to prove or disprove a shift of meaning from nontrademark to trademark, doing so in the context of the applicable burden of proof. The burden of proving secondary meaning is on the party asserting it, whether he is the plaintiff in an infringement action or the applicant for federal trademark registration. The burden is ordinarily considered a heavy one, since one result may be to deprive the public of the free use of the

particular term in relation to certain products or services. In one case the burden was characterized as 'substantial' where the term indicated a principal product ingredient which the public desired, and in other cases courts have found that a plaintiff seeking to establish secondary meaning must satisfy 'rigorous evidentiary requirements.' In general, the greater the degree of descriptiveness the term has, the heavier the burden to prove it has attained secondary meaning.

"...Proof of secondary meaning is often difficult, inasmuch as there are no precise guidelines and no single factor which is determinative.... The factors and the types of proof the courts consider are the following:

"1. The Purchasing Public and Direct Consumer Testimony. Testimony of members of the purchasing public is probably the most relevant type of testimony on the issue of whether a particular non-distinctive term has attained secondary meaning....

"2. Consumer Surveys. A properly conducted survey of the relevant purchasing public may be the best direct evidence on the question of secondary meaning....

"3. Advertising and Sales. The degree and manner of advertising under the claimed trademark, and the volume of sales of products bearing it, are relevant proof on the issue of secondary meaning....

"4. Length and Manner of Use. In addition to the extent of advertising and promotion under the claimed trademark, the length and manner of its use bear directly on the issue of secondary meaning. The longer the claimed mark has been used, the greater the likelihood secondary meaning will attach....

"5. Exclusivity of Use. Whether or not plaintiff's use of the claimed trademark has been exclusive is also material on the issue of secondary meaning. To the extent that third parties are using the claimed mark in association with the same or related goods or services, its impact on the public consciousness is likely to be less and the public is less likely to associate it with a single source of products. This is especially true if a third party began using the term before the plaintiff. Here, secondary meaning will not be likely to attach."

In the present case, plaintiff-appellant presented no testing of consumer surveys, admitted that little or no advertising had been done, and acknowledged that the name "High Country Restaurant" had not been used by him until after suit had been filed. Further, undisputed testimony indicated that defendant-respondent had used and advertised the name "High Country Inn," "High Country Restaurant," and "Moore's High Country Inn Restaurant" from 1978, prior to plaintiff-appellant's claimed use.

Courts have long required the usage of a name in time and locality to be entitled to injunctive protection. Some of the more recent cases are:

In Lift Truck Parts & Service, Inc. v. Bourne (1963), 385 P.2d 735, the Supreme Court of Oregon, said:

"...Despite the defendants' contentions to the contrary, an arrangement of purely generic or descriptive words can acquire secondary meaning and thereby create protectible interest in a trade name.... However, where the name question is one primarily composed of generic or descriptive words, it is much more difficult to prove a secondary meaning than in cases where the words used in the trade name have some distinctive or identifying character of their own... ...the burden of proof of secondary meaning is upon the party claiming the exclusive right to the generic or descriptive words as a trade name."

In Wyoming Nat. Bank v. Security Bank & Trust Co. (1977), Wyo., 572 P.2d 1120, the Wyoming Supreme Court said:

"...Unless a trade name is confusing and deceptive on its face, those seeking such protection must take the burden of proving that they have given to their trade names a secondary meaning through years of usage. ...Use of a name for a long period of time alone is evidence of the association between that name and particular goods and services."

The Supreme Court of Colorado in MacPhail v. Stevens, Colo. App., 586 P.2d 1339, stated:

"And, contrary to MacPhail's assertions, the name "Denver Magazine" is not so "inherently distinctive" as to be exclusively appropriable as a trademark immediately upon use, without regard to whether it has acquired a secondary meaning. Rather, "Denver" is a geographic designation, and "Magazine" is a generic or descriptive term, and neither singularly nor in combination are these words entitled to trademark protection without a showing that a secondary meaning has attached to them."

The Supreme Court of Washington in Zebra Distributing Co. v. Ace Fireworks, Inc. (1969), 450 P.2d 962, affirmed the Trial Court's dissolving injunction where lower court concluded that plaintiff-appellant in that case had not proved name had acquired a secondary meaning. The Washington court stated:

"The essence of such an action is unfair competition and the existence of such competition is always a question of fact. The factual controversy in this case was resolved by the trial court's conclusion that plaintiff-appellant had not shown that its marks had acquired a secondary meaning..."

The trial in this case found that the name claimed by plaintiff-appellant had not acquired a secondary meaning.

The Supreme Court of Oklahoma in Coalgate Abstract Co. v. Coal County Abstract Co. (1937), 67 P.2d, in commenting on the use of geographic names and acquiring secondary meaning, stated:

"Geographical names, terms, and words, as well as descriptive words, may not be exclusively appropriated. This is the unequivocal rule of the common law and is statutory in this state.

The Oklahoma court went on to comment concerning the degree of similarity required to justify an injunction, as follows:

"The rule is well stated in the case of Hilton v. Hilton, 89 N.J.Eq. 472, 106 A. 193, 140, as follows: 'The rule of course, is that the similitude must be sufficient to confuse an ordinarily prudent

man, but the test as to the care or prudence is, are the precautions which a reasonably prudent man would take when investing money or what not, but the precautions which he would take ordinarily in determining, in buying a suit of clothes, that he was in the store he thought he was in."

In the present case, the plaintiff-appellant operated and advertised a tavern and private club from 1977 to 1980. Not until after he filed suit did he advertise as a restaurant. The defendant-respondent's use of the name "High Country Inn" is for a motel. Defendant-respondent's restaurant is leased out and operated under the name "Moore's High Country Inn Restaurant." A careful and prudent person would find little or no confusion between the names and business that are operated under them.

ARGUMENT

POINT TWO

BURDEN OF PROVING NAME HAD ATTAINED SECONDARY MEANING IS UPON THE ONE WHO SEEKS INJUNCTION TO RESTRAIN.

The burden of proof in an action for infringement or unfair competition relating to trademarks is on the plaintiff. In 74 Am. Jur. 2d 818 (Trademarks and Tradenames), Sec. 168, it states:

"Questions as to burden of proof and presumptions in actions for trademark infringement and unfair competition are governed in the main by the general rules which are applied in other actions of a similar character. Thus, the burden rests upon the plaintiff to establish a prima facie case."

It is further stated in 74 Am. Jur. 2d, p. 819, concerning the doctrine of secondary meaning, as follows:

"The question whether a word or symbog has acquired a secondary, special, or trade meaning is one of fact. The burden of establishing the existence of such meaning ordinarily rests with the plaintiff. Thus, one claiming that a trademark consisting of descriptive terms has acquired a secondary meaning so as to be entitled to protection bears the burden of proving that the terms have come to represent, in the mind of the public, the producer rather than the product. Since generic marks are the actual names of the product, it is necessary for the producer to show that he actually succeeded in associating the term with the source in the public's mind. However, when the term is not generic but merely descriptive, an inference of secondary meaning, properly supported, seems to be enough.

Utah has followed the requirement of putting the burden upon the one seeking to establish a secondary meaning upon the plaintiff. In Cloverleaf Dairy Co. v. Van Gerven, 269 P. 1020, 72 Utah, 290, the Utah court held that the plaintiffs seeking the restraining order had the burden of proving their case.

Other courts, including the Oregon court in 88¢ Stores, Inc. v. Martinez, 361 P.2d 809, 227 Oregon 147, held that the plaintiff, who seeks injunction to restrain defendant from using plaintiff's business name, on the ground that it acquired a secondary meaning, had the burden of proving the facts of a secondary meaning in confusion of source.

The Oregon Court (1963), in Lift Truck Parts cited above, placed the burden of proof of secondary meaning of generic name upon the party claiming exclusive right to its use.

The Wyoming Court (1979), in First National Bank of Lander v. First Wyoming Savings and Loan Association, 592 P.2d 697, placed the burden upon those seeking protection to establish that their name had acquired a secondary meaning.

In the present case, appellant has indicated that on one or two occasions, he received calls for what may have been High Country Inn placing banquet orders and that the people placing the order subsequently failed to show. Evidence presented by defendant-respondent indicates that this is not infrequent in the banquet business. In 74 Am. Jur. 2d, Vol. 74, p. 821, Sec. 172, it states:

"Mere advertising or other evidence of supposed secondary meaning cannot convert something unregistrable by reason of its being the common descriptive name or generic name for the goods, into a registrable mark. In order to prove a secondary meaning, the individual members of the purchasing public, or retailers or salesmen, are frequently called as witnesses and questioned as to their mental reactions. In general, the view taken by the general public, rather than by dealers or their buyers, is controlling as to whether a term or design alleged to have acquired the secondary meaning signifies origin or source, and it is not sufficient to show that wholesale dealers identify the source or origin of a product by the term or design in dispute."

Plaintiff-appellant testified that there is some confusion in the initial deliveries of goods to defendant/respondents' business location by tradesmen servicing local businesses. However, in Frostig v. Saga Enterprises, Inc., 539 P.2d 154, 272 Oregon 565, the Oregon Court (1975) indicated that confusion on the part of persons who are not restaurant customers, such as taxi drivers, creditors, prospective employees of defendants, telephone operators, is not the type of confusion against which common law had traditionally offered tradename protection, and that such evidence will only serve circumstantial evidence of confusion.

ARGUMENT

POINT THREE

FILING A D/B/A DOES NOT CONFER THE RIGHT TO A TRADE NAME OR TRADEMARK.

At the time of filing of the d/b/a by both parties (1977), 42-2-5 UCA, 1953, provided as follows:

"Every person or persons who shall carry on, conduct or transact business in this state under an assumed name, whether such business be carried on, conducted or transacted as an individual, association, partnership, corporation or otherwise, shall file in the office of the secretary of state a certificate setting forth the name under which such business is, or is to be carried on, conducted or transacted, and the future name, or names, of the person or persons owning, and the person or persons carrying on, conducting or transacting such business, the location of the principal place of business and the post-office address, or addresses, of such person or persons. Such certificate shall be executed by the person or persons owning, and the person or persons carrying on, conducting or transacting such business, and shall be filed not later than thirty days after the time of commencing to carry on, conduct or transact said business.

In 1979, additional responsibility was placed on the secretary of state for filing of assumed names. 42-2-6.5 UCA 1953 provides as follows:

"(1) The secretary of state shall not accept a certificate for filing if the assumed name therein is the same as, or deceptively similar to, the name of any corporation authorized to do business in this state, a name which is reserved or registered in this state pursuant to statute, the name of a trademark or service mark registered with the secretary, or an assumed name which is filed and on the active list.

"(2) The secretary shall accept a certificate for filing although the assumed name therein is deceptively similar to a name, trademark or service mark mentioned in subsection (1), if the person or corporation en-

titled to use the name, trademark or service mark, has filed a written consent to the similarity with the secretary.

"(3) The secretary shall have the discretion to determine what names are deceptively similar.

The above statute requires the filing when doing business under an assumed name to afford the public knowledge concerning persons doing business under an assumed name.

To register a name for a trade name or trademark, separate provisions are provided.

70-3-3 UCA, 1953, provides registration requirements to file a trade name or trademark.

Neither plaintiff-appellant or defendant-respondent filed for a trademark or trade name under the provisions of the Utah law. In MacPhail v. Stevens cited above, the Colorado Court of Appeal in distinguishing between similar statutes in Colorado stated:

"(1) At the outset, we agree with the trial court that MacPhail's filing a certificate of assumed or trade name did not confer on him the right to use "Denver Magazine" as a trademark. Such registration is intended only to afford the public a means of ascertaining the identities of persons or entities doing business under an assumed name..."

CONCLUSION

Both plaintiff and defendant in this case filed a Certificate of Doing Business Under An Assumed Name. Plaintiff's Certificate was filed on January 7, 1977 where he indicated he was doing business under the assumed name of "High Country Club."

Defendant filed a Certificate on August 29, 1977 indicating he was doing business under the assumed name of "High Country Inn" and that the nature of the business was motel, restaurant, and a lounge. That particular business filing was for a motel, restaurant, and lounge in Heber City, Utah. Subsequently, defendant filed a Certificate of Doing Business Under An Assumed Name "High Country Inn" for a business located on 12th Street in Ogden, Utah on December 11, 1980. He filed a consent receipt and was issued a Certificate Doing Business Under the name of "High Country Inn Restaurant" from the Secretary of State on April 28, 1980.

High Country Inn (1977) and High Country Inn Restaurant (1980) names were both registered by defendant-respondent with the secretary of state, and such registration is determinative that the secretary of state did not consider the names deceptively similar to High Country Club.

The name "High Country" is a geographic name not entitled to protection without being part of an additional term.

Plaintiff-appellant fails to present sufficient evidence of a secondary meaning of the name "High Country Restaurant."

The name of defendant-respondent's leased restaurant, "Moore's High Country Restaurant," is neither deceptive nor confusing to plaintiff-appellant's name of "High Country Club."


Respectfully submitted,
this 8 day of July, 1982



ROBERT E. FROERER
Attorney for Defendant-Respondent
536 24th Street, Suite 2B
Ogden, Utah 84401

CERTIFICATE OF MAILING

I hereby certify that I mailed a true and correct copy
of the above Appeal Brief to PETE N. VLAHOS, attorney for
Plaintiff-Appellant, 2447 Kiesel Avenue, Ogden, Utah 84401,
postage prepaid, this 8 day of July, 1982.


Secretary