IN THE SUPREME COURT OF FLORIDA

TALLAHASSEE, FLORIDA

CASE NO: 80,414

GREAT SOUTHERN BANK,

Petitioner,

vs.

FIRST SOUTHERN BANK, a
Florida Banking Corp.,

Respondent.

On Certified Question from
the Fourth District Court of Appeal

PETITIONER'S REPLY BRIEF ON THE MERITS

DAVID BAKER and GEORGE ORD, of
ALLEY, MAASS, ROGERS & LINDSAY, P.A.
321 Royal Poinciana Plaza, South
P.O. Box 431
Palm Beach, FL 33480-0431
(407) 659-1770
and
LARRY KLEIN, of
KLEIN & WALSH, P.A.
Suite 503 - Flagler Center
501 South Flagler Drive
West Palm Beach, FL 33401
(407) 659-5455

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CERTIFIED QUESTION

IS THE NAME "FIRST SOUTHERN BANK" DESCRIPTIVE OR GENERIC, AND THEREFORE NOT ENTITLED TO PROTECTION IN THE ABSENCE OF PROOF THAT IT HAS ACQUIRED A SECONDARY MEANING?

Plaintiff apparently recognizes the weakness of its legal position, because plaintiff is attempting to make this case appear as if it involved factual issues. Plaintiff even goes so far as to refuse to state the certified question in its brief, in an effort to avoid having to forthrightly answer it.

The Fourth District correctly recognized in its opinion that neither the evidence nor the lower court's factual findings would have any relevance if the plaintiff's name were descriptive or generic. The court stated on page 3:

> Appellant [defendant] argues that we should ignore the trial court's factual findings concerning the likelihood of injury to the business reputation of appellee, the dilution of the distinctive quality of the trade name, "First Southern Bank," the confusing nature of the name and the likelihood of confusion among customers within the overlapping market areas. Appellant's argument would have merit if we were to conclude that appellee's name constituted a descriptive or generic name. Descriptive names can be protected only where the name has acquired a secondary meaning. A generic name receives no protection.

The trial court also recognized that if this name were descriptive, geographic or generic it is only protected where there

is proof of a secondary meaning. In the final judgment the court stated:

> (d) The name "First Southern Bank" is a fictitious, arbitrary, fanciful or suggestive name. It is not a descriptive, geographic or generic name, requiring by actual usage a secondary meaning. (R 245)

Plaintiff recognizes this on page 13 of its brief, where it admits that descriptive or geographic names are "protected only when a name has acquired a secondary meaning".

The facts set forth by plaintiff in its brief are totally irrelevant, because there has been no proof or finding that the plaintiff's name has acquired a secondary meaning. Plaintiff did not argue in the Fourth District that it had acquired a secondary meaning, nor does it make any argument in this court to that effect.

In addition to attempting to confuse the issue by arguing facts, plaintiff also argues that it proved a case for protection under Section 495.151, Florida Statutes. Plaintiff agreed, in the trial court, that the burden of proof was the same, regardless of whether it was seeking protection under the common law or the statute (R 193, fn. 11). The fact that there is no distinction between the common law and the statute is made clear by Gaeta Cromwell, Inc. v. Banyan Lakes Village, 523 So.2d 624 (Fla. 4th DCA), rev. denied, 531 So.2d 1353 (Fla. 1988).

It is difficult to understand why plaintiff argues the facts, since the plaintiff acknowledges, on page 13 of its brief, that descriptive or geographic names are only protected when they have acquired a secondary meaning, and generic names are not protected at all. Plaintiff then continues to argue on page 13 and thereafter that its name is arbitrary or fanciful. While we agree that arbitrary or fanciful names are protected, without acquiring a secondary meaning, plaintiff's argument that its name is arbitrary or fanciful is without any foundation in the law. Arbitrary or fanciful names, which are entitled to protection in the absence of secondary meaning, are names such as Kodak or Xerox. They are words which have been invented to identify a product or service. Freedom Sav. and Loan Ass'n v. Way, 757 F.2d 1176, 1186 (11th Cir.), cert. denied, 474 U.S. 845, 106 S.Ct. 134, 88 L.Ed.2d 110 (1985); Gaeta Cromwell, Inc. v. Banyan Lakes Village, supra.

Plaintiff recognizes on the bottom of page 13 that arbitrary or fanciful names do not describe the product being sold. Plaintiff goes on to argue on page 14 that the name "First Southern Bank", does not describe its product, which is an absurd argument, yet the only way plaintiff can prevail.

Generic names communicate information about the nature or class of an article or service (e.g. "shredded wheat", "light beer"). Kellogg Co. v. National Biscuit Co, 305 U.S. 111, 59 S.Ct. 109, 83 L.Ed. 73 (1938). On page 21, plaintiff attempts to

distinguish the Kellogg case by stating that it "simply holds that generic names are not protectible if they communicate information regarding the nature or class of the article or service." It is difficult to conceive of a name which would be more communicative of the service provided here than "First Southern Bank".

Plaintiff argues on page 19 that Gaeta Cromwell, Inc. v. Banyan Lakes Village, supra, supports the opinion of the Fourth District in the present case. In Gaeta the Fourth District held that the name "Congress Park" was arbitrary as used for an office building complex, because the word "Congress" has a meaning unrelated to office buildings. In the present case, the name "First Southern Bank" has no meaning unrelated to that which it is, a bank.

Plaintiff's reliance on American Bank of Merritt Island v. First American Bank and Trust, 455 So.2d 443 (Fla. 5th DCA), rev. denied, 461 So.2d 114 (Fla. 1984), is also misplaced. Although the Fifth District held that the complaint stated a cause of action in that case, it acknowledged in footnote 8 that there is a split of authority on whether the word "American" is protectible in the absence of secondary meaning. The Eleventh Circuit, in a Florida case, held that the name "American Television and Communications Corporation" is not protectible in the absence of secondary meaning. American Television and Communications Corp. v. American Communications and Television, Inc., 810 F.2d 1546 (11th Cir.

1987). Likewise, the name American Heritage Life Insurance Company is generic or descriptive, and not protectible unless it has acquired a secondary meaning. American Heritage Life Ins. Co. v. Heritage Life Ins. Co., 494 F.2d 3 (5th Cir. 1974).

A number of the very cases cited by plaintiff actually compel the conclusion that the plaintiff's name is descriptive or generic, and not protectible in the absence of proof of secondary meaning. Plaintiff has cited Vision Center v. Opticks, Inc., 596 F.2d 111 (5th Cir. 1979), cert. denied, 444 U.S. 1016, 100 S.Ct. 668, 62 L.Ed.2d 646 (1980), on pages 8 and 14 of its brief; however, that case stands for the proposition that "Vision Center", if used to describe a place which sells glasses, is a descriptive name. If "Vision Center" is descriptive, there can be no other conclusion but that "First Southern Bank" is descriptive.

On page 17, plaintiff cites Bastrop Nat. Bank v. First Nat. Bank of Bastrop, 222 U.S.P.Q. 524, No. Civ. A. 83-2064 (W.D. LA Oct. 21, 1983) (1983 W.L. 442). In that case Bastrop National Bank had been founded in 1892, and had continually used the name "Bastrop National Bank" since 1950. The reason that Bastrop National Bank was granted an injunction was because the trial court concluded, based on evidence, that the name had acquired a secondary meaning. In Bastrop, the court stated:

> The general rule is that geographic names such as 'Bastrop' (and as we will soon explain, generic words like 'first') are not protected trade names by themselves. First Southern

> Federal Savings v. First Southern Savings, 614 F.2d 71, 74 (5th Cir. 1980); First National Bank in Sioux Falls v. National Bank of South Dakota, 667 F.2d 708, 714 (8th Cir. 1981); Dixie Oil Co. v. Picayune '66' Oil Co., 245 So.2d 839, 841 (Miss. 1971); Staple Cotton Coop. Assn. v. Federal Staple Cotton Co-op Assn., 162 So.2d 867, 869 (Miss. 1964).
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> * * *
>
> We find that plaintiff has proven that the words 'First National Bank of Bastrop', when used together, have acquired a secondary meaning... . (Emphasis added).

It is thus clear from the Bastrop case, on which plaintiff relies, that the name "Bastrop National Bank" is descriptive, geographic and/or generic, and would not be protected except where there was proof of secondary meaning.

It is clear from the final judgment entered in the present case that the trial court did not find a secondary meaning. It is clear from the opinion of the Fourth District Court of Appeal that it did not find a secondary meaning. Unlike the factual situation in Bastrop, in which the bank had been in business for almost a century, and had been using the name Bastrop National Bank for over 30 years, the plaintiff alleged in its complaint in this case that it opened for business on September 14, 1987, and that the defendant had adopted its name in November of 1988 (R 140).

Plaintiff cites Union Nat. Bank of Texas, Laredo, Tex. v. Union Nat. Bank of Texas, Austin, Tex., 909 F.2d 839 (5th Cir.

1990), on page 18 of its brief. In that case the Fifth Circuit stated on page 845:

> Geographical terms such as "Texas," "Midwest," "Madison Avenue," or "Philadelphia" are also considered descriptive terms when they describe where the products or services are offered or manufactured.

It is clear from the briefs that both plaintiff and defendant agree that if a name is descriptive, geographical or generic, it is not protectible in the absence of proof of a secondary meaning. It is also clear that there was no proof, nor any conclusion by a court, that plaintiff had acquired a secondary meaning. The only issue, therefore, is that posed by the Fourth District as the certified question, which is whether plaintiff's name is descriptive or generic. Plaintiff has attempted to confuse the issue by citing cases which hold that findings of fact will not be disturbed unless clearly erroneous. If this case involved a factual issue, the Fourth District would not have certified the question. Whether or not plaintiff's name is descriptive, geographic, or generic, is a question of law.

Since it is undisputed that the plaintiff did not acquire a secondary meaning in the present case, and since the name First Southern Bank is descriptive, geographical or generic as a matter of law, the certified question should be answered in the affirmative.

CONCLUSION

The opinion of the Fourth District should be reversed.

DAVID BAKER and GEORGE ORD, of
ALLEY, MAASS, ROGERS & LINDSAY, P.A.
321 Royal Poinciana Plaza S.
P.O. Box 431
Palm Beach, FL 33480-0431
(407) 659-1770
and
LARRY KLEIN, of
KLEIN & WALSH, P.A.
Suite 503 - Flagler Center
501 South Flagler Drive
West Palm Beach, FL 33401
(407) 659-5455

By: _____
LARRY KLEIN
Florida Bar No. 043381

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that a copy of the foregoing has been furnished, by mail, this 10th day of November, 1992, to: Mr. Lawrence S. Gordon, Caruana and Gordon, P.A., 1000 Courthouse Tower, 44 West Flagler Street, Miami, FL 33130.

By: _____
LARRY KLEIN
Florida Bar No. 043381