

**IN RE: FERRY-HANLY ADVERTISING COMPANY'S ELIBIBILITY AS TO
REGISTRATION OF TRADE-MARK OF THE WORDS " JUST A STEP
AHEAD ON PETTICOAT LANE."**

Letter back to Secy of State

14329 RS Mo 1929

August 31, 1933. *g/r*

FILED
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Hon. Dwight R. Brown
Secretary of State
Jefferson City, Missouri

Dear Sir:

You have requested this department to furnish an opinion based upon a letter which you received from the Ferry-Hanly Advertising Company of Kansas City, Missouri, relative to a proposed trade-mark, which is described in their letter of August 23 and which is illustrated in an attached advertisement.

Ferry-Hanly Advertising Company's letter of August 19, describing the proposed trade-mark reads in part as follows:

"Our client, the John Taylor Dry Goods Company, wishes to register the slogan, "Just a Step Ahead on Petticoat Lane," which has been appearing continuously in their advertising for some time. The use of this slogan is illustrated in the advertisement attached."

Further, in a later letter, on August 23, the following information and questions are set forth:

"In section 14329, it is stated that a trade-mark 'to designate, make known or distinguish any article or goods, wares or merchandise by him or them manufactured or prepared' may be registered with your office and fully protected by such registrations; however, it is not clear as to whether an advertising phrase or slogan may be registered if not intended for use on the merchandise itself.

"In the present case, the John Taylor Dry Goods Company desires to register and have protected the advertising phrase, "Just a Step Ahead on Petticoat Lane" for use in their newspaper

and other advertising and not particularly for the purpose of placing it on any labels or wrappers of any of their merchandise,

"Will you kindly inform whether this slogan can be registered for the purpose indicated and whether or not it is necessary to use the words "trademark registered" or any similar designation with the registered slogan to indicate to and notify the public that the advertising phrase or slogan is protected under the Missouri trademark laws.

"Furthermore, if such a slogan is registerable, will it be necessary to have it always appear in any unique type of lettering or can it always be type set as it appears in the sample advertisement sent you with our previous letter?"

The phrase in question is,

"Just A Step Ahead on Petticoat Lane."

If the above phrase appears below the signature "John Taylor Dry Goods Company" in advertisements and on goods sold by the John Taylor Dry Goods Company, the phrase "Just A Step Ahead on Petticoat Lane" is legally eligible for registration as a valid trade-mark under the laws of Missouri.

It is a fundamental rule that a term or mark or phrase merely descriptive of the subject to which it is applied cannot be a technical trade-mark. (Saxlehner v. Eisner & Mendelson Co., 179 U. S. 19). Thus, no word or combination of words can be exclusively appropriated if it is merely descriptive of the particular business, or of the quality, style, character, grade, or class or make of the goods, or if it is merely to indicate the composition of the product or the ingredients therein, or the process of manufacture or method of production. The same rule applies to words or marks descriptive of the effect produced by the use of the goods, or of the purpose or use to which the article is to be put. A term descriptive of the type of goods or the class of trade to which the product applies likewise cannot be the subject of a trade-mark. No trade-mark rights may be acquired in laudatory or commendatory expressions, or in words or marks merely indicating superior excellence, popularity, or universality in use, such as "best," "standard," "favorite," etc., but similar words such as "perfection" and "ideal" have been upheld. A description of the appearance of the goods or of the package in which the goods are sold is not a valid trade-mark. (63. C. J. Sec. 43 - Title, Trade-

Marks, Trade-Names, pp. 348-351.) On the other hand, an arbitrary or fanciful term, figure or device and words and phrases used in a purely arbitrary or fanciful way, as applied to the goods in question, constitutes a valid trade-mark. (*Novelty Company v. Leonard*, 119 F. 937. - 63 C. J. Sec. 48, Title—Trade-marks, pp. 351-352.) Likewise, names or marks which merely suggest, to some extent, 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. (*Menendez v. Holt*, 9 S.Ct. 143; 128 U. S. 514; 63 C. J. Sec. 48, Title - Trade-Marks, p. 353.)

The phrase "Just A Step Ahead on Petticoat Lane, when used in connection with a well-known Department Store in a city, suggests the character, quality or ingredients of goods and articles which ladies and women purchase for their own and for their family's use, and such as are usually sold in large department stores.

It is the opinion of this department that this phrase "Just A Step Ahead on Petticoat Lane" is eligible for legal registration as a trade-mark under the laws of Missouri and will be, when so registered, a valid trade-mark.

In order that it may be a trade-mark, however, it must be attached or fixed or stamped on the article indicated by it and must be, therefore, so used by the person or firm desiring to claim a legal right to the phrase or emblem as a trade-mark.

In the case of *Cakes v. Candy Co.*, 148 Mo. page 398, the Supreme Court said:

"A trade-mark which is not in some manner attached or affixed or stamped on the article indicated by it involves a contradiction in itself, the idea of some distinctive brand or mark being inherent in the expression itself.

"An article can only be said to be distinguished by a trade-mark when that mark is connected with, annexed to or stamped, printed, carved or engraved upon the article as it is offered for sale."

St. Louis Piano Co. v. Merkel, 1 Mo. App. 305;

Browne on Trade-Marks, sec. 311;

Rowley v. Houghton, 2 Brewster, 303;

Gandee, Swan & Co. v. Deere & Co., 54 Ill. 439;

Lawrence Mfg. Co. v. Tenn. Mfg. Co., 138 U. S. 537.

The goods with the mark thereon must be placed upon the market. *Grocers Journal Co. v. Midland Pub. Co.*, 137 Mo. App. 356. *Westminster Laundry Co. v. Envelope Co.*, 174 Mo. App. 238.

This department has been unable to find any statutes that require the one using a registered trade-mark to use the words "trade-mark registered" in connection with a registered trade-mark to indicate that the phrase or emblem is protected under the Missouri Trade-Mark Laws.

Section 14323, Revised Statutes of Missouri, provides that the Secretary of State shall deliver to the person or association or corporation registering a trade-mark a duly attested certificate of filing of the same for which he shall receive a fee of one dollar, and this certificate shall, in all suits and prosecutions under this article, for violation of the trade-mark law, be sufficient proof of the adoption of such label, trade-mark or form of advertisement.

This department is of the opinion that the above mentioned phrase "Just a Step Ahead on Petticoat Lane," if properly filed and registered as a trade-mark under the laws of Missouri, can be used not only on the article sold but in the advertisement of the John Taylor Dry Goods Company, as well.

It is the opinion of this department that the registered trade-mark in advertisement or on articles sold or on the packages containing the articles, or in other places, used by the John Taylor Dry Goods Company, should always be in the same type of lettering so as to correspond in form and character and appearance with the kind of type registered in the Secretary of State's office.

Very respectfully yours,

APPROVED:

ROY MORITTRICK
Attorney-General.

EDWARD C. CROW
Assistant Attorney General.