

**TRADE-MARKS:** Protection afforded trade-marks registered under state registration act.

8.30

August 29, 1935.



Hon. Dwight H. Brown,  
Secretary of State,  
Jefferson City, Missouri.

Dear Sir:

This department is in receipt of your request for an opinion under date of August 6, wherein you state as follows:

"This morning we have the following communication from Non-Allergic Products, St. Louis, Missouri:

"In May 1933 we made application to you through Mr. Ralph Kalish, Attorney of this city for registration of the Trade Mark "NON-ALLERGIC" to be applied to toilet articles and cosmetics. We received official notice from you dated May 11, 1933 of the registration of this trade-mark. Will you please inform us as to just what this registration means. Does it give us the exclusive right to use the name? Another firm in the East is applying for this same trade mark in Washington, D. C. and we would like to know where we stand in the matter. Find stamped return envelope enclosed. May we hear from you by return mail."

"We note Sec. 14329 R. S. Mo. states '....no trade-mark duly registered in the office of the commissioner of patents of the United States shall be registered under this section by any person other than the owner thereof.' We would like

to know, however, what protection is afforded a firm in a case such as above quoted, where the trade-mark is duly registered in the State of Missouri, but not registered in the U. S. Patent Office, and the trade-mark then applied for by another firm from the commissioner of patents. We are unable to find in our file of opinions from your office, where this point has been covered."

Section 14329, R. S. Mo. 1929, in setting out who may adopt a trade-mark, provides as follows:

"If any mechanic, manufacturer, association or union of workmen, or other persons shall wish to adopt any particular name, term, design or device as his or their trade-mark to designate, make known or distinguish any article or goods, wares or merchandise by him or them manufactured or prepared, or any union of workmen desire to designate or make known the place in which union labor is employed, he or they may write out a description of such name, term, design or device, describing the same accurately, and sign and acknowledge the same before some officer competent to take acknowledgment of deeds, and file same, together with a facsimile of the same, term, design or device for registration, in the office of the secretary of state; said secretary shall deliver to said mechanic, manufacturer, association or union of workmen, or other persons so filing the same, a duly attested certificate of the filing of the same, for which he shall receive a fee of one dollar; such certificate shall, in all suits and prosecutions under this article, be sufficient proof of the adoption of such label, trade-mark or form of advertisement, and of the right of such mechanic, manufacturer, association or union of workmen or (other) persons to adopt the same.

No label, trade-mark or form of advertisement shall be registered that in any way resembles or would probably be mistaken for a label or trade-mark already registered; and no trade-mark duly registered in the office of the commissioner of patents of the United States shall be registered under this section by (any) person other than the owner thereof."

Assuming that a firm has its trade-mark duly registered in the State of Missouri, but not in the United States Patent Office, and a firm in some other state appropriates same to its use without having same registered in the United States Patent Office, what protection would the laws of the State of Missouri afford the owner of the trade-mark registered in this state?

In 63 C. J. 471, in discussing the extraterritorial effect of a trade-mark registered under a state statute, states as follows:

"A state registration act has no extraterritorial effect, and so rights under state registration are not infringed by acts wholly done without the state."

In *Rehbein v. Weaver et al.*, 133 Fed. 607, the court in holding that a suit can not be maintained in the Federal Court to enforce rights under a statute relating to trade-marks, and providing for their registration, where the transactions complained of accrued outside of such state, said:

"This is a proceeding to enforce in this district (Circuit Court, N. D. Illinois) complainant's rights under the Missouri statute. In *Black on Interpretation of Laws*, edition of 1896, it is stated that 'it is not within the competency of the legislative power, upon grounds of public policy, to create personal liabilities, and impose them on persons and property out of the jurisdiction of the state, and on account of transactions occurring beyond its territorial limits.' The

bill seeks two remedies: (1) To restrain infringement of the Missouri registered trade-mark; (2) to restrain unfair competition. The record utterly fails to show a condition of facts which would warrant the relief prayed in the second case above set out. \* \* \* As to the registered trade-mark, there is no jurisdiction in this court to enforce the Missouri law in regard to registration of trade-marks in the case of transactions occurring outside that state." (Case cited in McIlhenny Co. v. Bulliard, 33 Fed. (2d) 978, 1. c. 980, to the same effect.)

From the foregoing we are of the opinion that no protection is afforded an owner of a trade-mark duly registered under the laws of this state, where the infringement of the trade-mark is without the State of Missouri, since our state registration act has no extraterritorial effect.

Assuming again that a firm has its trade-mark duly registered in the State of Missouri, but not in the United States Patent Office, and another firm applies for the same trade-mark in the latter office, has it granted, and attempts to use the same in the State of Missouri, what protection will the laws of Missouri afford the owner of the mark registered in this state?

Section 81 of Chapter 3 of the Laws of the United States of America, as amended April 11, 1930, which is substantially the same as the Trade-mark Act of 1905, sets out the general provisions for the registration of a trade-mark in the United States Patent Office as follows:

"The owner of a trade-mark used in commerce with foreign nations, or among the several States, or with Indian tribes, provided such owner shall be domiciled within the territory of the United States, or resides in or is located in any foreign country which, by treaty, convention, or law, affords similar privileges to the citizens of the United States, may

obtain registration for such trade-mark by complying with the following requirements: First, by filing in the Patent Office an application therefor, in writing, addressed to the Commissioner of Patents, signed by the applicant, specifying his name, domicile, location, and citizenship; the class of merchandise and the particular description of goods comprised in such class to which the trade-mark is appropriated; a statement of the mode in which the same is applied and affixed to goods, and the length of time during which the trade mark has been used; a description of the trade-mark itself shall be included, if desired by the applicant or required by the commissioner, provided such description is of a character to meet the approval of the commissioner. With this statement shall be filed a drawing of the trade-mark, signed by the applicant or his attorney, and such number of specimens of the trade-mark as actually used as may be required by the Commissioner of Patents. Second, by paying into the Treasury of the United States the sum of \$10, and otherwise complying with the requirements of this subdivision of this chapter and such regulations as may be prescribed by the Commissioner of Patents."

The court in the case of United States Printing & Lithograph Co. v. Griggs, Cooper & Co., (1929) 49 Sup. Ct. 267, 279 U. S. 156, 1. c. 158, 73 L. Ed. 650, reversing (1928) 162 N. E. 425, 119 Ohio St. 151, which affirmed (1926) 161 N. E. 789, 28 Ohio App. 1, in construing the above section said:

"The Act of 1905 goes a little farther and gives remedies against reproduction, etc., of the registered trade mark 'in commerce among the several states' as well as in commerce with foreign nations, etc., Sec. 16, supra. A remedy for such infringement was given in Thaddeus Davids Co. v. Davids

August 29, 1935.

Manufacturing Co., 233 U. S. 461, see also American Steel Foundries v. Robertson, 262 U. S. 209. Baldwin Co. v. Robertson, 265 U. S. 168. But neither authority nor the plain words of the Act allow a remedy upon it for infringing a trade mark registered under it, within the limits of a State and not affecting the commerce named."

Again, in holding that Congress has no power to enact a law affecting trade-marks or property rights in marks, except such as are used in interstate commerce, the court in the case of Macaulay v. Malt-Diastase Co., 4 Fed. (2d) 944, 1. c. 945, 55 App. D. C. 277, said:

"Registration is merely a method of recording, devised by Congress, for the protection of the public and the owners of trade-marks, and Congress can only exercise this authority over trade-marks used on goods sold in interstate commerce. It has not power to enact a registration law that will affect marks, or property rights in marks, used only in intrastate commerce. Trade-Mark Cases, supra."

From the foregoing we are of the opinion that if a firm has its trade-mark duly registered in the State of Missouri, our law will afford it protection from all intrastate infringements of its trade-mark, since Congress has no power to enact a law affecting trade-marks or property rights in marks, except such as are used in interstate commerce.

Respectfully submitted,

Wm. Orr Sawyers,  
Assistant Attorney General.

APPROVED:

---

JOHN W. HOFFMAN, Jr.,  
(Acting) Attorney General.

MW:HR