

TRADEMARKS: Descriptive terms in English or foreign language are not subject to registration under the trade-mark law.

January 30, 1936.

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

Dear Sir:

This department is in receipt of your recent request for an opinion wherein you state as follows:

"Under date of July 15 we had a letter from the St. Louis Products Company inquiring if the following was available as a trade-mark:

"Bestmade brand, handmadelong filler, Panetella cigar.

"We advised them that descriptive terms of an article are not subject to registration under the trade-mark law. They later advised that their Bestmade malt is a nationally registered brand, i. e., registered in the U. S. Patent Office, and requested that we submit the enclosed label to your office for a decision."

I.

63 C. J., page 350, lays down the following rule in determining whether a descriptive term is subject to being trade-marked:

"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."

The question arises whether the term "BESTMADE" is a word indicating superior excellence so as to come within the rule prohibiting its being trade-marked.

63 C. J., page 351, lays down the following test in determining whether a term is descriptive or merely suggestive and arbitrary and fanciful:

"It is a question arising in each case whether the words or marks, as used, are descriptive or whether they are merely suggestive and arbitrary and fanciful. In order to be descriptive, within the condemnation of the rule, it is sufficient if information is afforded as to the general nature or character of the article, and it is not necessary that the words or marks used shall comprise a clear, complete, and accurate description. The true test in determining whether a particular name or phrase is descriptive is whether, as it is commonly used, it is reasonably indicative and descriptive of the thing intended. The meaning which should be given is the impression and signification which is conveyed to the public."

We are of the opinion that the term "BESTMADE" as commonly used conveys the impression to the public that it is a product of superior excellence and hence comes within the rule prohibiting its being trade-marked.

Attention is directed to the case of New York Mackintosh Co. v. Flam, 198 Fed. 571, wherein the word "Bestyette" was held sufficiently distinctive to constitute a valid trade-mark for waterproof capes and cloaks. The court in its opinion said:

"The defendants claim, in the first place, that the complainant's trade-mark, 'Bestyette,' is invalid, because the word is simply descriptive of the character or quality of the goods. Undoubtedly, if the complainant had attached to its goods the sentence, 'These rain capes are the best yet made,' or some contracted form of such sentence, as, for instance, 'Best Rain Capes Yet Made,' or 'Best Yet Made,' or 'Best Yet,' the statement would be simply descriptive, and the usual commendation of a vendor, and could not be a valid trade-mark. 'Bestyette,' when spoken, sounds the same as 'Best Yet,' and undoubtedly the claim that it is merely a descriptive word has much weight. But, in trade-marks, the impression produced on the sight of the buyer is the main thing; and, upon the whole, I think that the compounded and fantastically spelled word 'Bestyette' is sufficiently distinctive to be a trade-mark. Moreover, the evidence shows that it was used exclusively by the complainant more than 10 years before registration, and therefore the provisions of section 5 of the Trade-Mark Act of 1905 (Act Feb. 20, 1905, c. 592, 33 Stat. 724 (U. S. Comp. St. Supp. 1911, p. 1459)) apply, that, in such a case, the fact that the term was originally descriptive does not prevent registration.

"The defendants also claim that, assuming that the word 'Bestyette' can be a valid trade-mark, their use of the word 'Veribest' for their trade-mark does not infringe it. I think it clear that no dealer can be prevented from asserting, by an advertisement printed on the goods, or in any other manner, that his goods are the best, or the best yet, or the very best. If the word 'best' is included in a queer compound word oddly spelled, used as a trade-mark, that does not prevent other dealers from using the same word in the same way, so long as the word first created is not imitated too closely."

The court points out that if an application had been made to trade-mark the words "'Best Yet', the statement would be simply descriptive, and the usual commendation of a vendor, and could not be a valid trade-mark." The court lays emphasis on the fact that "the impression produced on the sight of the buyer is the main thing," and that the term "Bestyette" was sufficiently "compounded and fantastically" spelled to make it distinctive as a trade-mark.

In the case at hand, we are of the opinion that the word "best" is not "included in a queer compound word oddly spelled" so as to make it a distinctive trade-mark, nor is there such an impression produced on the sight of the buyer. The words "best" and "made" are correctly spelled and the fact that they are joined together does not make it sufficiently distinctive as eligible for a valid trade-mark.

It must be pointed out in the Flam case, supra, that there was evidence showing that the term "Bestyette" had been used exclusively by the complainant for more than ten years before the Trade-Mark Act of 1905, and hence under Section 5 of that Act "the fact that the term was originally descriptive does not prevent registration."

63 C. J., page 351, declares the reason for prohibiting descriptive terms as trade-marks in the following language:

"Reason for prohibiting descriptive terms as trade-marks is that everyone should have the right to truly describe his goods and business and should be able to use the terms necessary or appropriate for that purpose."

The Supreme Court of Missouri in the case of Nicholson v. Wm. A. Stickney Cigar Co., 59 S. W. 121, 1. c. 122, made the following observation with respect to the use of a word as a trade-mark for the simple purpose of describing the quality of the goods:

"In Liggett & Myers Tobacco Co. v. Sam Reid Tobacco Co., 104 Mo. loc. cit. 60, 15 S. W. 844, Black, J., said: 'The general principles of the law concerning trade-marks are well settled. A person has a right to the exclusive use of marks, forms, or symbols appropriated by him for the purpose of

pointing out the true origin or ownership of the article manufactured by him. The limitation upon this right is that such designs or words may not be used for the simple purpose of naming or describing the quality of the goods; for to permit that would be to foster a monopoly, while the great purpose of the law of trade-marks is to protect the owner in the exclusive use of his device which distinguishes his product from other similar articles, and to protect the public against fraud and deception."

To permit the term "BESTMADE" to be registered would not only be fostering a monopoly for applicant's malt, but, as stated by the court in Iowa Auto Market v. Auto Market & Exchange, 197 N. W. 321, l. c. 323, citing many cases,

"It has been frequently said that no one can secure a monopoly upon the adjectives of the language."

The fact that the word "BESTMADE" has been registered in the United States Patent Office is not conclusive proof to this state, nor does it amount to an adjudication of the fact that the term is not descriptive. The courts have held from an early date that the rights and remedies concerning trade-marks generally depend upon the laws of the state, and in the case of Luyties, et al. v. Hollender, et al., 21 Fed. 281, we find the following language:

"Rights and remedies pertaining to trade-marks generally depend upon the laws of the state, common and statutory, and not upon the laws of the United States. Trade-mark Cases, 100 U. S. 82."

In view of the foregoing, we are of the opinion that the word "BESTMADE" is not sufficiently distinctive to make it eligible for a valid trade-mark under the laws of the State of Missouri.

II.

63 C. J., page 346, declares the following rule in determining whether a descriptive term is subject to being trade-marked:

"Thus no word or combination of words can be exclusively appropriated if it * * * merely indicates * * * the process of manufacture or method of production."

In the case of Sun-Maid Raisin Growers v. Mosesian, 258 Pac. 632, the court said:

"It is true that the use of terms, which are merely descriptive of the manner or process by which, or the ingredients with which, an article is made, is not subject to registration and will not be protected against infringement, particularly where the process is open to the use of the general public. L. R. A. 1916E, 633. * * *

"It is also true that language which is merely descriptive of the process of manufacturing is not susceptible of exclusive appropriation. L. R. A. 1916E, 633. This rule has been applied to the following language: Hot forged hammer point nails; shredded whole wheat; Oriental Rug Renovating Company; lamb-knit; compressed yeast; flaked oatmeal; prime leaf lard."

Our court adopted the same rule in the case of McGrew Coal Co. v. Menefee, 162 Mo. App. 209, 144 S. W. 868, 1. c. 871, wherein it said:

"Bituminous coal is a commodity of general use in this state. It is as much a staple article of consumption as sugar and coffee. It is a matter of common knowledge that the ordinary consumer prefers to buy the coal that comes in the largest lumps and is most free of slack and dust. The word

'lump,' therefore, refers to quality and certainly no dealer should be allowed the exclusive use of that word. The word 'Electric' has a general, well-understood meaning, i. e., that the coal was mined by electric machines and, therefore, is cleaner and in larger lumps than coal mined in the old way. Used as an adjective to the noun lump the term thus formed is descriptive of quality only. The claim of plaintiff that it has an exclusive right to the use of that term in practical effect is the assertion of a right to monopolize the sale of coal mined by the new and now general method since the enjoyment of the exclusive right to advertise coal of such quality would amount to a monopoly of the sale of such coal.

"Thus it appears that plaintiff is founding its cause of action, not upon its own skill, genius and industry, but upon its voluntary appropriation of a term that in all equity and good conscience should be regarded as common property which any dealer in coal mined by electricity may use in advertising his business. Plaintiff acquired no property right in the name 'Electric Lump' and the learned trial judge took a proper view of the case in dismissing the bill."

To permit the term "handmadelong filler" to be trademarked would give the applicant exclusive right to monopolize the sale and advertisement of cigars by an old and established method of production. We are of the opinion that the mere fact that three commonly used and correctly spelled words in the tobacco trade, hand-made-long, are joined together is not sufficient to take it out of the rule which declares that a combination of words which merely indicates the process of manufacture or method of production is not the subject of a valid trade-mark.

III.

Webster's New International Dictionary defines the term "panetela" thus:

"(Sp.) A long, thin cigar, cylindrical in shape, except for the finished mouth end."

The question arises whether a Spanish or foreign descriptive word may be trade-marked.

63 C. J., page 361, states that

" * * * a foreign descriptive word or phrase * * * is not a good trade-mark."

In the case of *In re Bradford Dyeing Association*, 46 Appeal Cases, Dist. of Columbia, page 512, the court adopted the above rule and said:

"This appeal (by the Bradford Dyeing Association) is from the refusal of the Commissioner of Patents to register the word 'E'clatant' as a trade-mark for cotton piece goods.

"A sample of the goods with the appellant's mark thereon is included in the record. The goods have a satin finish, and are described as 'Satin E'clatant.' The word sought to be registered is a French word meaning brilliant, shining, glittering, etc. Registration was denied on the ground that the mark is descriptive of the character and quality of the goods.

"Descriptive words and phrases in a foreign language are not registerable. *Re Hercules Powder Co.* ante, 52; 38 Cyc. 731. The reason for bringing descriptive foreign words and phrases within the limitations of the statute is apparent. Not only would the meaning soon become known to the public, but the user of the mark would appreciate the advantage of disseminating such information by advertisement or otherwise. Indeed, there would be nothing to prevent the printing of a translation of

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the word or phrase in direct connection with the use of the mark. The policy which dictates this inhibition is not affected by *Rossman v. Garnier*, 128 C. C. A. 73, 211 Fed. 401, chiefly relied upon by counsel for appellant. That was an infringement suit in which a mark consisted of a French word. The court expressly found that it had been registered under the ten-year clause of the Trademark Act of 1905, and that it was, therefore, unnecessary to pass upon the question of whether or not it was descriptive of the quality or character of the goods upon which it was used."

The Spanish word "panetela" is well known to the cigar-smoking public as indicating a cigar of a particular shape, and, being a descriptive term, we are of the opinion that the fact that an extra letter is added to the word does not make it so distinctive as, when taken together with the term "cigar", will make it the subject of a valid trade-mark.

Respectfully submitted,

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APPROVED:

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