

October 1, 1936. 10-1

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 September 24th, as follows:

"Will you please note attached application to register trade-mark together with correspondence with Mr. Richard C. Southall of Kansas City.

"We rejected registration of the trade-mark Professional Uniform in accordance with an opinion given us by your office under date of April 12, 1934, signed by Mr. Franklin E. Reagan, in which he states that mere descriptive terms of an article are not subject to registration under the trade-mark law.

"Inasmuch as Mr. Southall has requested that the matter be referred to you, we should like to have your opinion in the matter."

The attached letter requesting that you reconsider rejection of the application for trade-mark is as follows:

"I am returning the application to register a trade mark returned in your letter of the 23rd and request that the same be registered as provided by Section 14,329, which provides that any 'particular name, term, design or device' may be registered. I call your at-

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tention to the fact that this is a 'device or design' and not a mere name or words of description. You will note the special arrangement of the design which begins with a large 'P' and ends with a small 'L'. The fact that it spells 'Professional' is incidental so long as the arrangement of the letters is distinctive.

"As an example I call your attention to a well known patent medicine manufactured by the 'Black and White Products Co.' of Memphis, Tenn. Their trade mark (registered in Washington) are the words 'Black and White' on a background of a square half black and half white. The words alone would not be subject to registration but when placed on a black and white background it makes them distinctive. So our special arrangement of the letters composing the words 'Professional'.

"If there is still doubt in your mind I would like to have the instant application, together with this explanation submitted to the attorney general. As a matter of fact I do not find that the statute or the courts give the attorney general authority to pass on applications, the statute designating what may and may not be registered and the only inhibition being words already in use.

"I believe that after further consideration and study of this design you will issue the certificate. If not please advise."

The application sets out that the essential feature of the mark is the arrangement of the letters, which begins with a large "P" and ends with a small "L" in staggered formation.

United States Code Annotated, Title 15, Section 85, page 25, sets out what trade-marks may be registered, in part, as follows:

"Provided, That no mark which consists merely in the name of an individual, firm, corporation, or association not written, printed, impressed, or woven in some particular or distinctive manner * * * shall be registered under the terms of this subdivision of this chapter."

Nims on Unfair Competition and Trade-Marks, Section 229, subsection (a), page 628, in discussing the above portion of the statute, quotes from Ex parte Polar Knitting Mills, reported in 154 Off. Gaz. 251, and states that:

"If a mark is written or printed in a distinctive style, it may be registered. 'It is believed that the controlling principle underlying the requirement of the statute that a mere name unless written or printed in a distinctive manner may not be registered, is that the distinctive manner in which the name is displayed must be of a character as to give such a distinctive impression to the eye of the ordinary observer as to outweigh the significance of the mere name.'"

Ex parte The Craig Tractor Company, decided by the Commissioner of Patents and reported in 263 Off. Gaz. 329, held that the words "Craig Tractor" in staggered relation, with a heavy black line over the word "Craig" and a heavy black line under the first three letters thereof, the bottom black line forming the top of the first letter of the word "Tractor", was registrable as being distinctively displayed.

The only thing about the arrangement of the word "Professional" that is herein claimed to make it distinctive is its staggered formation. In the above case the words were also staggered, but, as pointed out, there were additional characteristics that made the arrangement distinctive, and we are of the opinion that the above decision is not authority for the instant case.

In the case of Pittsburgh Brewing Co. v. Ruben, 3 Fed. (2d) 342, 1. c. 344, the court in holding that the trade-mark "Tech" printed in white script letters across plaid background was not violative of the statute, the plaid background being a bona fide and substantial part of the mark, said:

"We agree with the Commissioner that the mark which the applicant applies for does not fall within the prohibitions of section 5 of the Trade-Mark Act (Comp. St. sec. 9490), to-wit, that no mark shall be registered which 'consists merely in the name of an individual, firm, corporation, or association not written, printed, impressed, or woven in some particular or distinctive manner,' since the plaid background upon which the name appears is a bona fide and substantial part of the mark, and is not 'a mere device or contrivance to evade the law and secure the registration of nonregistrable words.'

The distinguishing characteristics of this case from the one at hand are again self-apparent.

In the case of National Cigar Stands Co. v. Frishmuth Bro. & Co., 297 Fed. 348, l. c. 350, the court in discussing whether the word "Nationals" which was in staggered formation, as in the instant case, but with the addition of a heavy black line under the word, was so distinctive as to comply with the statute, said:

"Had this word been a distinctive feature of appellee's corporate name, which had been selected for no ulterior purpose, a different case would have been presented; but, even then, it could not have been said that the manner in which appellee printed its mark constituted compliance with the statute. We have said that the controlling principle underlying the requirement of the statute is that a mere name may not be registered, unless so displayed as to give such a distinct impression to the eye of the ordinary observer that the significance of the mere name is outweighed. In re Artesian Mfg. Co., 37 App. D. C. 113."

Again in the case of In re Nisley Shoe Co., 58 Fed. (2d) 426, l. c. 427, the court in holding that the arrangement of the letters forming the word "Nisley's", which was written in distorted block type, was violative of the statute, said:

"With reference to appellant's third contention, we cannot hold that the word

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'Nisley's,' as used by appellant, is written or displayed in a particular or distinctive manner within the meaning of said section 5. The Examiner of Trade-Marks in his decision, as heretofore noted, stated that the distorted block type used by appellant was such as may be found in many signs and advertisements. He further stated that 'it is not believed that the public would see in it anything unique or distinctive.' We agree with this conclusion of the Examiner, which was affirmed by the Commissioner. We may take judicial notice of the fact that it is not uncommon in signs and advertisements to use type of the character employed by appellant in the formation of the word 'Nisley's.' We are of the opinion that the proper construction of the words 'particular or distinctive manner' in the proviso of section 5 referred to is that the word or words constituting the mark shall be written, printed, impressed, or woven in such a manner as to form a distinct impression upon the eye of the observer, to the extent that he will remember such particular or distinctive form and rely upon it, in part at least, in ascribing origin of the goods to which the mark is applied."

See, also, In re American Steel & Wire Company of New Jersey, 81 Fed. (2d) 397, l. c. 398, to the same effect.

From the foregoing, we are of the opinion that the public will not see anything in the word "Professional", as used by applicant in the instant case, as being unique or distinctive, and that to permit same to be trade-marked would be violative of the above statute requiring that the word or words constituting the mark be written, printed, impressed or woven in some particular or distinctive manner.

Respectfully submitted,

WM. ORR SAWYERS,
Assistant Attorney General.

APPROVED:

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

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