

**TRADE-MARKS:
INFRINGEMENTS:**

The use of the word "Blind-Kraft" by Missouri residents not an infringement on the trade name "Blindcraft" adopted by residents of the State of California.

December 15, 1939

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Missouri Commission for the Blind
103 State Capitol
Jefferson City, Missouri

Attention: Miss Marie M. Finan,
Acting Executive Director

Gentlemen:

This is in reply to yours of recent date wherein you request an opinion from this department on the question of whether or not the use of the trade-mark "Blind-Kraft" by the assignee of the Missouri Commission for the Blind is an infringement on the trade-mark of the name "Blindcraft" used by the San Francisco Association for the Blind. You also state in your request that while the Missouri Commission for the Blind was using the trade-mark "Blind-Kraft" that on this trade-mark the great seal of Missouri was attached. You ask the question that since the Missouri Commission for the Blind has assigned this trade-mark to the Industrial Aid for the Blind, Inc., a St. Louis organization, would that organization be authorized to use the trade-mark with the great seal of the State of Missouri attached thereto.

It appears from your letter that the Missouri Commission for the Blind registered this trade-mark on February 25, 1937, in the Office of the Secretary of State of Missouri by virtue of the provisions of Chapter 136, Revised Statutes of Missouri 1929. The California trade-mark has not been registered in the State of Missouri, so the question involved here is one of interstate character. Your correspondence also indicates that the San Francisco Association for the Blind owns four registrations registered in the United States Patent Office, and that they have used

the trade-mark since 1916.

In connection with this opinion, we acknowledge receipt of the copy of the opinion of the Legal Department of the State of California.

One of the first questions to be considered in this matter is whether or not the Missouri Commission for the Blind can assign this trade-mark. We think the rule is stated in Volume 63 Corpus Juris, page 511, Section 212:

"Trade-marks and trade-names must always tell the truth and always tell the same truth, and from this it follows that they cannot be assigned except for use in the same sense as originally conveyed by the use of the name or mark. Unless use by the assignee will truthfully indicate the same origin or ownership of the same goods or business, the name or mark is not assignable."

Since the Missouri Commission's assignee is using the trade-mark in the same sense as it was originally intended, then we think that the Commission may properly assign its trade-mark.

Since the question involved here is a federal question, we must look to the federal statutes for the law that is applicable hereto. Title 15, Section 81, page 5 of the United States Code Annotated, provides 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 \$15, and otherwise complying with the requirements of this subdivision of this chapter and such regulations as may be prescribed by the Commissioner of Patents."

From your correspondence it appears that the Missouri Commission has not obtained the federal trade-mark as provided by the foregoing section but that the California Association has. Title 15, Section 85, page 35 of the United States Code Annotated, provides as follows:

"No mark by which the goods of the owner of the mark may be distinguished from other goods of the same class shall be refused registration as a trade-mark on account of the nature of such mark unless such mark--

* * * * *

"(b) Consists of or comprises the flag or coat of arms or other insignia of the United States or any simulation thereof, or of any State or municipality or of any foreign nation, * * * * "

It, therefore, appears from this section that the organization which now holds the Missouri trade-mark as assignee thereof would not be authorized to have this trade-mark registered in the United States Patent Office because it contains the great seal of this State. As to this particular part of your inquiry, we would, therefore, suggest that the trade-mark be deleted to the extent that the coat of arms of the State of Missouri be removed therefrom.

The term "Blind-Kraft" or "Blindcraft" has a definite meaning. These trade-mark names are made up from the words "blind" and "craft" and to the average person they mean articles made by the blind people. The word "blind" does not need any definition. It is known generally to all people who hear it. The word "craft" according to Webster's Dictionary, means skill or art; a manual art; a trade or occupation or employment requiring art or skill. It is also defined as a suffix denoting art, skill, trade. So the word "craft" added to the word "blind", according to the foregoing definitions would denote the skill or trade of the blind people indicating that such articles were made by the blind. In connection with this definition, we think the rule announced in Volume 63 Corpus Juris, page 364, Section 66, would be applicable here because we think that the words "Blind-Kraft" and "Blindcraft" are descriptive of the articles which are sold. The

rule in Corpus Juris is as follows:

"The generic name of an article is descriptive of such article, and therefore cannot be exclusively appropriated as a trade-mark. Even words which were not originally or of their own meaning descriptive terms, but which, by use, association, and acceptance, have come to be the generic name for a particular kind or class of goods, and indicate that only, and not origin or ownership, are not valid trade-marks. * * * * "

In the same Volume of Corpus Juris, Section 43, page 346, the rule is further announced:

"It is a fundamental rule that a term or mark merely descriptive of the subject to which it is applied cannot be a technical trade-mark or trade-name. 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 of the goods, or if it merely indicates the composition of the product or the ingredients therein, or the process of manufacture or method of production. * * * * * "

At Section 45, page 351 of the same Volume, the requirements of a valid trade-mark are stated as follows:

"An exclusive trade-mark must consist of some arbitrary or fanciful term, figure, or device, and words or phrases, to constitute a trade-mark, must be used in a purely

arbitrary or fanciful way as applied to the goods in question.
* * * * *

The only similarity of these two trade-marks is in the sound. It will be noted that the California trade-mark is composed of one word in one line, while the Missouri trade-mark is composed of the word "Blind" then under that word a dash and the word "Kraft." So as far as these two trade-marks appear to be similar in looks, they could not be said to be similar.

In 63 Corpus Juris, page 373, Section 76, the rule on similarity of trade-marks, so as to cause deception, is stated as follows:

"Whether or not an imitation which is not an exact copy constitutes an infringement depends upon whether the resemblance is sufficiently close to deceive purchasers and so pass off the goods of one man as being those of another and, in considering the deceptive tendency of defendant's mark, the court is not restricted to a comparison of the registered marks, but must take into consideration all the surrounding circumstances. Where one mark could not reasonably be mistaken for the other, and deception is improbable or impossible, there is no infringement, even though the two trade-marks suggest similar qualities in the product. * * * * *

The standard of determining infringement on account of similarity is stated in the rule announced in said Corpus Juris, Section 77, page 376, as follows:

"In determining whether an alleged infringing trade-mark is sufficiently similar to plaintiff's trade-mark

to be deceptive, and therefore an infringement, ordinary purchasers, buying under the usual conditions prevailing in the trade, and giving such attention as such purchasers usually give in buying that class of goods, are the standard. If such a purchaser would probably be deceived into purchasing one article thinking it was the other, there is an infringement, otherwise not. * * * * *

In connection with the question of similarity of the trade-marks of the two associations, we have examined the labels which are used in connection with the Blind-Kraft goods. The label used by the Missouri Association is on an orange background with the trade-mark in white letters. The labels used by the California Association do not seem to have any standard of color. The distinguishing mark of the trade-mark label used by the California Association is that the word "Blindcraft" is in one line in white letters with a dark background and with a plant at each end of the label. So as far as the average observer is concerned, it can be determined at once that the trade-marks have not enough similarity in looks that they could be mistaken one for the other.

On the question of the name used in the trade-mark being descriptive, Mr. Justice McKenna in *Standard Paint Co. v. Trinidad Asphalt Mfg. Co.*, 55 L. Ed. at page 536, l. c. 540, stated the rule as follows:

" * * * A public right in rubberroid and a private monopoly of rubberroid cannot coexist.' The court expressed the determined and settled rule to be 'that no one can appropriate as a trademark a generic name or one descriptive of an article of trade, its qualities, ingredients, or characteristics, or any sign, word, or symbol which, from the nature of the fact it is used to signify, others may employ with equal truth.'

For this cases were cited and many illustrations were given, which we need not repeat. The definition of a trademark has been given by this court and the extent of its use described. It was said by the chief justice, speaking for the court, that 'the term (trademark) has been in use from a very early date; and, generally speaking, means a distinctive mark of authenticity, through which the products of particular manufacturers or the vendible commodities of particular merchants may be distinguished from those of others. It may consist in any symbol or in any form of words; but as its office is to point out distinctively the origin or ownership of the articles to which it is affixed, it follows that no sign or form of words can be appropriated as a valid trademark which, from the nature of the fact conveyed by its primary meaning, others may employ with equal truth, and with equal right, for the same purpose.' Elgin Nat. Watch Co v. Illinois Watch Case Co. 179 U. S. 665, 673, 45 L. ed. 365, 378, 21 Sup. Ct. Rep. 270. There is no doubt, therefore, of the rule. * * * * *

In Oakes v. Candy Co., 146 Mo. 391, 396, the Supreme Court, in discussing the requirements of a trademark, said:

"This court in Liggett & Meyers Tobacco Co. v. Sam Reid Tobacco Co., 104 Mo. loc. cit. 60, said: 'The general principles of law concerning trademarks 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.'

"The office of a trade-mark is to point out distinctly the origin or ownership of the article and unless it does so indicate the ownership or origin, neither the person who has adopted the mark or device can be injured by its appropriation by others, nor can the public be deceived. Canal Co. v. Clark, 13 Wall. 311.

* * * * *

"As well said by Judge DUER in Petridge v. Wells, 13 Howard's Prac. loc. cit. 387. 'When a new preparation or compound is offered for sale, a distinctive and specific name must necessarily be given to it. The name thus given to it, no matter when or by whom imposed, becomes by use its proper appellation and passes as such in our common language. Hence, all who have an equal right to manufacture and sell the article, have an equal right to designate and sell it by its appropriate name, the name by which it alone is distinguished and known, provided each person is careful to sell the article as prepared and manufactured by himself and not by another.

When this caution is used, there is no deception of which a rival manufacturer by whom the distinctive name was first invented or adopted can justly complain * * * In short, an exclusive right to use on a label or other trade-mark the appropriate name of a manufactured article exists only in those who have an exclusive property in the article itself."

In connection with your question, we are enclosing copy of an opinion dated January 30, 1936, written to the Honorable Dwight H. Brown, Secretary of State, by Honorable William Orr Sawyers, holding that descriptive terms in English or foreign languages are not subject to registration under a trade-mark law. We are also enclosing three other opinions touching on trade-mark law by Mr. Sawyers to the Secretary of State, dated April 22, September 24 and October 1, 1936, respectively.

In United States Code Annotated, Title 15, page 94, Section 85, Note 137, it is stated:

"It is the settled rule that no one can appropriate as a trade-mark a generic name, or one descriptive of an article of trade, its qualities, ingredients, or characteristics, or any sign, word, or symbol which, from the nature of the fact it is used to signify, others may employ with equal truth."
citing cases

The rule is further announced in Drive It Yourself Co. v. North, 148 Md. 609, as follows:

"The true test in determining whether a particular name or phrase is descriptive is not whether words are exhaustively descriptive of article designated, but whether in themselves, and, as they are commonly used by

those who understand their meaning,
they are reasonably indicative and
descriptive of thing intended."

In said Title 15, United States Code Annotated, pages 96 and 97, a number of cases are given in which it was held that words were descriptive and were not subject to be appropriated in trade-marks. Some of these words were: "Air brush," "Air-cell," "Ball bearing," "Be Sure and Work the Horse," "Borax Soap," "Breathing Back," "Certified-Perfect Diamonds," "Chicken of the Sea," "Desiccated Codfish," "Dry Ice," etc.

In *Franklin Knitting Mills, Inc. v. Fashionit Sweater Mills, Inc.*, 297 F. at 247, the word "Fashionit," as applied to knitted articles of clothing was held descriptive and not a valid trade-mark, as it only means "knit in fashion" or "fashionably knit."

In the case of *In re Federal Cement Tile Co.*, 58 F. (2d) 457, the word "featherweight" as a trademark for use on concrete roof slabs was held descriptive and not registerable.

There seems to be an exception to the rule of the use of descriptive words in a trade-mark and that is announced in *Barton v. Rex-Oil Co.*, 2 F. (2d) 402, and cited in 40 A. L. R. at 424, 1. c. 429, which rule is as follows:

"But a descriptive name, though not originally capable of exclusive appropriation, may, by use and association with a commodity, obtain a secondary signification denoting that goods bearing it come from one source, and thus a superior right to its use may be acquired by the person who first adopted it. * * * *"

Then on page 431, on the question of whether or not the words used in a trade-mark have required a secondary meaning, the court said:

"* * * This is a rule of experience rather than a rule of law for in most of the cases reported, and in all cited by the respondent, the time in acquiring a secondary meaning figured largely and in some cases exclusively in determining whether such meaning had been acquired. Time is the usual standard because a natural one but it is not the exclusive standard. The test of secondary meaning is whether the trade-mark has become broadly known to the public as denoting a product of certain origin. Therefore, in looking for a secondary meaning this court is controlled by the fact that such a meaning has been acquired in the mind of the public rather than by the time it has taken for that fact to become established. * * * "

In connection with the trade name of the California Association for the Blind, even though they have had the trade-mark since 1916, we have not enough information before us to say that the product has become so nationally known that the "secondary meaning" rule would apply. That would depend solely on the facts which are offered in each particular case. In the annotation in the *Barton v. Rex-Oil Co.* case, supra, page 433 of 40 A. L. R., the rule on "secondary meaning" as it is announced in 26 R. C. L. under title of "Trademarks," section 61, page 886, is as follows:

"Even though a word or a combination of words is incapable of becoming a valid trade-mark, yet if it has by a sufficiently long and exclusive use acquired such a secondary meaning as to indicate in the trade that the goods to which it is applied are made by a particular manufacturer, or are put on the market by a particular

vendor, its use by another on similar goods in such a way as to be likely to deceive purchasers will be restrained as unfair competition; and its use, even in its primary meaning, will be so limited as to prevent the working of a probable deception by passing off the goods of one maker as those of another. And some cases even have referred to a name which has acquired such a meaning, as in the case of a geographical name, as a valid trade-mark."

CONCLUSION.

From the foregoing it is the opinion of this department that the use of the trade-mark "Blind-Kraft" by the Missouri Association is not an infringement on the registered trade-mark "Blindcraft" owned by the San Francisco Association for the Blind because the words "Blind-Kraft" and "Blindcraft" are descriptive words and are not words which may be used and monopolized by any individual or association.

We are further of the opinion that the Industrial Aid for the Blind Inc., in St. Louis, if it continues to use the label which the Missouri Commission for the Blind has assigned to them, which purports to be a trade-mark, should delete the trade-mark to the extent of removing from it the great seal of the State of Missouri.

Respectfully submitted,

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APPROVED:

W. J. BURKE
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