

IN RE: RIGHT OF ST. LOUIS DAIRY COMPANY TO REGISTER TRADE NAME
ON MILK AND ICE CREAM RECEPTACLES UNDER SECTIONS 13449
TO 13555 R. S. OF MO. 1929.

June 2, 1933



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

Dear Sir:

You have submitted to this Department the following facts and ask a legal opinion thereon as to your duty to officially accept or reject for filing the application of the South St. Louis Dairy Company to register a trade name under Section 13449 R. S. Mo. 1929 relating to name or mark on containers in which milk or cream or both are sold or offered for sale within this State:

On August 4, 1917, the "St. Louis Dairy Company" filed with the Secretary of State of the State of Missouri a statement alleging said company was engaged at 2000 Pine Street, St. Louis, Missouri, in bottling and selling liquids in vessels to-wit; bottles and cans with its name branded, engraved, blown or otherwise produced thereon and that the said company had filed the same statement with the Recorder of Deeds of St. Louis, Missouri, and each of said two statements contained a description of the name so used by it and branded, blown or engraved or otherwise produced on said vessels.

The application for registration in the Secretary of State's Office was accompanied by an affidavit showing publication four times in the "St. Louis Times" (then a daily St. Louis newspaper). This application was duly registered and filed in the office of the Secretary of State of Missouri and was evidently made under the provisions of R. S. of Mo. 1919, Sections 13281 to 13284 inclusive which are now Sections 14347 to 14351, R. S. of Mo. 1929, being Article 4 of Chapter 136 relating to registration of vessels used in bottling or selling liquids.

October 10, 1933, the "St. Louis Dairy Company" filed an application under Section 12449, R. S. of Mo. 1929,

in which it stated as follows:

"The undersigned has adopted for use a name, mark or device to identify and make known the ownership of cans, bottles and other vessels, owned and used by the undersigned in the manufacture, sale and distribution of milk, buttermilk and ice cream, and has had said name, mark or device printed, stamped, engraved, etched, blown, painted, or otherwise permanently fixed upon said cans, bottles and other vessels."

"A description of said name, mark or device is as follows:

ST. LOUIS

DAIRY CO.

"And you are respectfully requested to file and record the same in your office in accordance with the provisions of Section 12449, R. S. No. 1929."

This application it will be observed was for registering containers used in sale and distribution of milk, buttermilk and ice cream while the application of 1917 was for registration of vessels used in bottling or selling liquids.

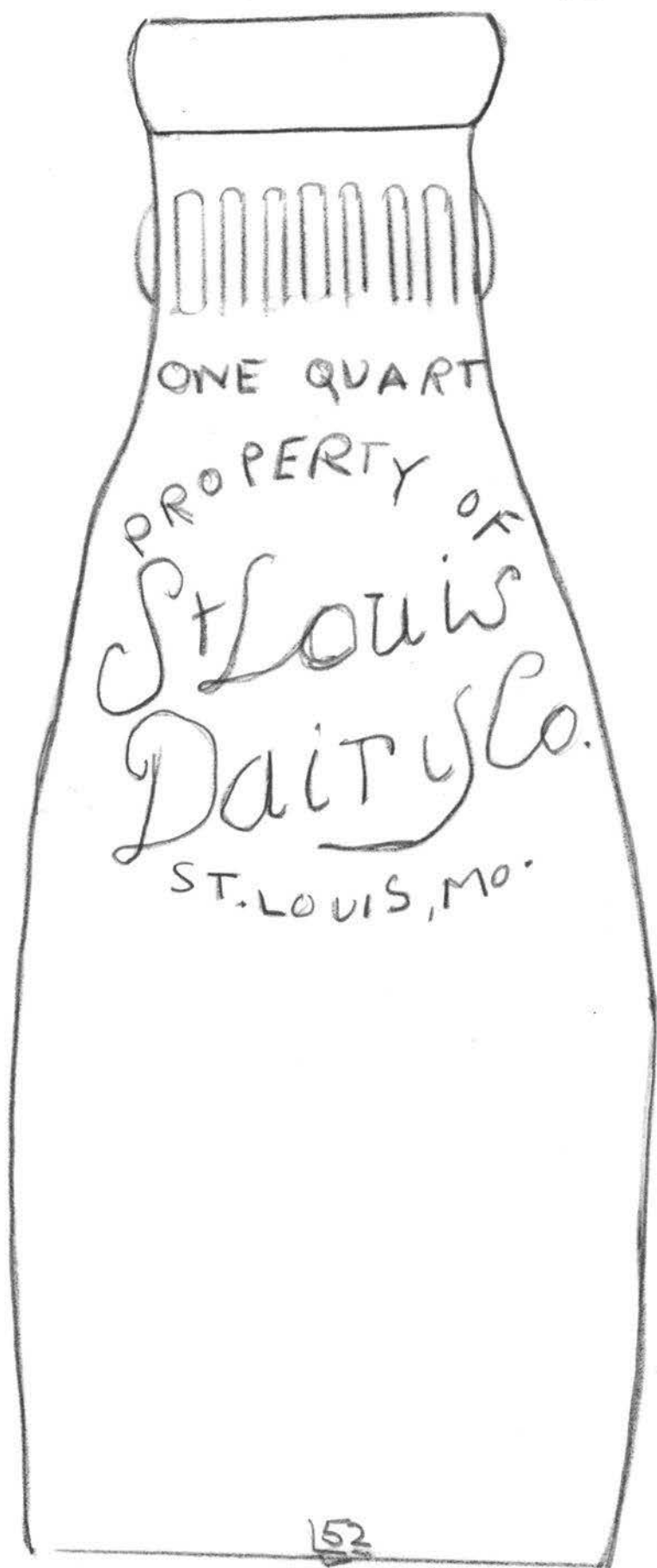
The first application covered containers for all liquids including milk, buttermilk and ice cream while the 1933 application is confined to the three liquids, milk buttermilk and ice cream. Each application is made under a separate statute.

The statute under which the later application was made is found under the chapter dealing with "Dairies" while the statute under which the registration occurred in 1917, is in chapter of R. S. of Mo. 1919, dealing with trade marks. Both statutes, under which registration was made, carry provisions making it unlawful for anyone other than the registered owner of the vessels so branded to use said vessels without permission of said person or corporation so registering same, the object being of course to give the owner of said branded and registered vessels the exclusive right to the use of the trade name branded thereon.

The registration by the St. Louis Dairy Company in 1933 was accompanied by the following drawing of a bottle with words engraved, etched or branded on the bottle as same appears in the drawing herein marked "A" and inserted herein at this point.

"A"

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Accompanying this application was the necessary affidavit showing proper publication of the required legal notice. The application was properly and promptly filed and registration accepted by the Secretary of State.

In March 1933, the "South St. Louis Dairy Company" filed an application under section 12449 R. S. Mo. 1929, to register a name, mark and device to be used on cans, bottles and other vessels used in the sale and distribution of milk, buttermilk and ice cream in which the company stated as follows:

"The undersigned has adopted for use a name, mark or device to identify and make known the ownership of cans, bottles and other vessels, owned and used by the undersigned in the manufacture, sale and distribution of milk, buttermilk and ice cream, and has had said name, mark or device printed, stamped, engraved, etched, blown, painted or otherwise permanently fixed upon said cans, bottles and other vessels.

"A description of said name, mark or device is as follows:

SOUTH ST. LOUIS

DAIRY CO.

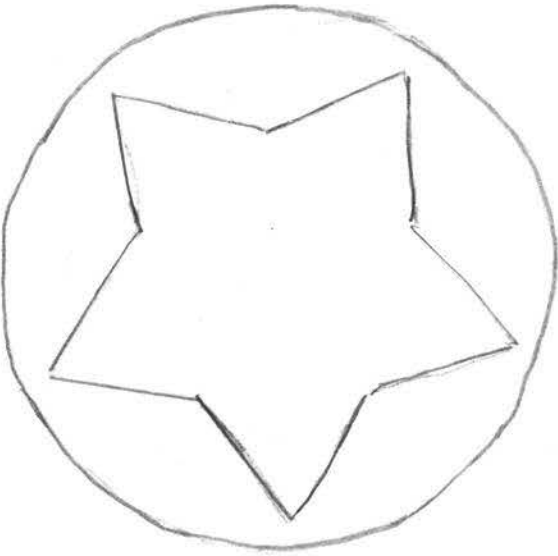
"And you are respectfully requested to file and record the same in your office in accordance with the provisions of Section 12449, R. S. Mo., 1929."

This application was accompanied by an affidavit showing required notice in such matters had been published.

The application had attached a drawing called a "Milk Bottle Sketch" which we reproduce herein at this point together with the words thereon as same appears in the sketch attached to the application.

MILK BOTTLE SKETCH

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was Best Milk
1 QT.

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MILK BOTTLE SKETCH FOR
SOUTH ST. LOUIS DAIRY CO.
SCALE FULL SIZE 1-2-33

LIBERTY GLASS CO.
SAPULPA, OKLAHOMA.
SALES REPRESENTATIVE
WEBER DAIRY SUPPLY CO.
ST LOUIS, MISSOURI.

TO BE SOLD

Section 13449 R. S. of Mo., 1929, under which both St. Louis Dairy Companies filed the last two hereinabove mentioned applications, reads as follows:

"Sec. 13449. RECEPTACLES FOR MILK, CREAM, ETC. -- BRANDS -- CERTIFICATE. Any person engaged in manufacturing, bottling, or selling milk, buttermilk, cream or ice cream in any kind of receptacle, having the name of such person or other mark or device printed, stamped, engraved, etched, blown, painted or otherwise permanently fixed upon the same, may file in the office of the Secretary of State, for record a description of the name, mark or device so used; and cause such description to be printed once each week for three successive weeks in a newspaper published in the county in which the principal place of business of such person is located, or if the principal place of business of such person is located in another state, then in the county wherein the principal office or depot of such person within the State of Missouri is located. It shall be the duty of the Secretary of State to issue to the person so filing for record a description of such name, mark or device in his office, to duly attest a certificate of the record of the same, for which he shall receive the fee prescribed by statute for the issuance of certificates. In all prosecutions under this article such certificate shall be prima facie evidence of the adoption and ownership of such name, mark or device and of the right of the person named therein to adopt and use the same."

Section 13457 makes it unlawful and a misdemeanor for others than the one named in the certificate of the Secretary of State without the written consent of the person named in such certificate, to fill any receptacle bearing the name, mark or device recorded as hereinabove provided with milk, buttermilk, cream or ice cream or any other substance or erase, remove, conceal or obliterate such name, mark or device on such receptacle or to buy, sell, give away, traffic in, or destroy any receptacle having such name, mark or device.

Section 13451, provides any person having in possession or under control any receptacle bearing any name, mark or device recorded as hereinabove provided in Section 13449 and not holding a written transfer or bill of sale thereof

from the person named in the Secretary of State's certificate provided for in Section 13449, shall on demand deliver such receptacles to the person named in the Secretary of State's certificate or to the authorized agent of such person and on failure to so do, the person so failing to deliver said receptacles shall be guilty of a misdemeanor. Other sections of the Act provide for a search warrant in case of unlawful use of said branded receptacles.

This department is of the opinion it may be doubtful whether the courts will hold either the St. Louis Dairy Company or the South St. Louis Dairy Company can legally register either of their respective names and brands under Section 13449, R. S. of Mo. 1929, for the reason, the words "St. Louis" and "South St. Louis" are geographical only and the word "Dairy" is an ordinary English word and descriptive of a particular thing and none of these words can be exclusively appropriated as a trade name.

Trask Co. v. Wooster, 28 M. A. 408;
Reach v. Simons Hardware Co., 155 M. A. 413.

But if it be contended and conceded the "Names" of each company are not ineligible for registration under Section 13449 R. S. of Mo. 1929, because the words used are geographical and descriptive only; still for another legal reason, the "South St. Louis Dairy Company" is not entitled to registration under said Section 13449. It is true the South St. Louis Dairy Company has some words and features, in its name, brand and device, not found in the name and brand and device of the St. Louis Dairy Company but that alone is not sufficient to render the name and brand eligible to registration under existing conditions.

The rule of law is, if the resemblance between the two trade names is sufficiently close to raise the probability the public might mistake one company's product for the other, in such event the latter applicant for registration is not entitled to register his or its trade name, mark or device as the case may be. The name "St. Louis Dairy Company" and "South St. Louis Dairy Company" and the wording on the bottles of the two companies and so far as we can see by the drawings, the shape and size of the bottles of the two companies are so similar and the resemblance between the two trade names and the bottles and the words thereon is sufficiently close in the opinion of this Department to raise a probability of the public mistaking one company's product for that of the other and therefore it is our opinion, as the St. Louis Dairy Company was

registered in October, 1932, and received a certificate of registration from the Secretary of State, that the South St. Louis Dairy Company can not now legally register bottles and the words thereon under Section 13449.

Sanders v. Utt, 16 M. A. 322;
Sanders v. Jacobs, 20 M. A. l.e. 98;
McCartney v. Garnhart, 45 Mo. 592;
Gamble v. Stevenson, 10 M. A. 561.

The question suggests itself whether if registration under Section 13449 was intended only to protect the owner of receptacles having his name or brand thereon from loss of the containers, prior registration of another dealer's name and containers and words thereon so closely resembling applicant's name, receptacle and lettering thereon as to probably cause the public to mistake one brand of milk for the other would legally bar applicant's registration it seeks herein.

We have made diligent search and fail to find in our own or other states a court decision construing a similar statute on this exact question; such decisions may exist but if so we have been unable to find same.

In declaring a similar statute unconstitutional our Supreme Court seems to treat the act then under consideration as registration of a "Trade Mark" and in State v. Baskowitz, 250 Mo. l.e. 94 and 95, used the following language:

"It selects those whose particular manufacture or stock consists of certain varieties of drink. No other person who manufactures any product or sells it in casks, barrels, kegs, bottles or boxes can avail himself of the privilege of registering his trade-mark or of the consequent protection, but the act denies to him the privileges afforded to those named in the act. The grocer, farmer, fruit dealer, merchant, druggist or other dealer or manufacturer cannot avail himself of the privileges of remedy afforded by this act to protect himself against the loss of his property under the same circumstances."

It occurs to this department that a general law could be enacted that would include persons selling Milk, Buttermilk, Cream, Ice Cream and all other liquids; and

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such an act would, as our court says in State v. Baskowitz, 250 Mo. 1.c. 100, be in harmony with Section 53 Article IV of our Constitution which provides that,

"Where a general law can be made applicable, no local law shall be enacted."

We return you herewith the files of each of the above named companies which you forwarded to this department.

Very respectfully,

EDWARD G. CROW

APPROVED:

ROY McKITTRICK
Attorney General

ECC/AJ