TRADE-MARKS: Must be affixed to a vendible commodity and does not apply to services.

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November 6, 1935.

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

Dear Sir:

This department wishes to acknowledge your letter of November 1, wherein you state as follows:

> "On October 26 we registered the trade-mark Liberty Radio Shop for J. S. Tarrants of Liberty, Missouri, covering radio service. Mr. Tarrants turned his registration papers over to Alan F. Wherritt of Liberty, Mo., and received the enclosed letter from him, in which Mr. Wherritt states he is of the opinion that Section 14329 of the Statutes does not apply to service only.
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> "We would like to have an opinion from you on this point. Mr. Tarrants has a competitor who is using the same name, and he is anxious to protect himself. We are enclosing our office copy of the trade-mark application for your information. Please return it with your reply."

Section 14329, R. S. Mo. 1929, provides who may adopt a trade mark, and how:

> "If any mechanic, manufacturer, association or union of workingmen, 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 workingmen 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 workingmen, 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 workingmen 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."

28 American & English Encyclopedia of Law (Second Edition), page 352, in holding that a trade-mark must be attached to the goods, states as follows:

> "It is essential to the validity of a trade-mark as such that there shall be some actual physical connection between the goods and the mark, so that the mark goes with the goods into the

> market. Words, marks, or symbols used in advertisements, circulars, and other similar ways, but not actually affixed to the goods, are not valid technical trade-marks. It is sufficient if the mark is affixed, either upon the goods themselves or upon the box or wrapper containing them, or is in some other way physically attached to the goods."

In the very early case of St. Louis Piano Mfg. Co. v. Merkel, 1 Mo. App. 305, l. c. 309, the court in holding that a trade-mark which is not in some manner put upon or affixed to the article indicated by it is almost a contradiction in terms, said:

> "From the best examination we are able to make of the subject, we are led to the conclusion that, so far as an article of merchandise is concerned, it can only be said to be distinguished by a trade-mark when that mark is connected with, annexed to, or stamped, printed, carved, or engraved upon the article as the same is offered for sale. The purchaser must be told that the particular thing he proposes to buy is of this or that character, by something connected with the thing itself. He must not be referred to some circular or advertisement for this assurance, nor can he receive it from the representations, by word of mouth, of the manufacturer or salesman. The impossibility of putting any restrictions upon the last may be a sufficient reason for not making the attempt; but the other branch of the proposition seems to be equally settled by judicial opinion. 'A symbol does not become a trade-mark until it is actually stamped upon, or otherwise affixed to, the goods to be sold,' is the language of Browne, in his treatise on Trade-Marks, section 311. This remark seems abundantly justified by the decisions of the courts which have adjudicated respecting trade-marks, besides being in harmony with what any

one of ordinary understanding would infer from the name itself.

"In 2 Brewster, 303 (Am. Trade-Mark Cases, 486-489), Judge Ludlow's attention was drawn to this point. Rowly v. Houghton. This conclusion was in conformity with a former decision that 'no right can be absolute in a name, as a name merely. It is only when that name is printed or stamped upon a particular label or jar, and thus becomes identified with a particular style and quality of goods, that it becomes a trade-mark.'

"In 54 Illinois, 439 (456, 457, for the passage cited), this point underwent a careful and accurate examination. The case was that of Candee, Swan & Co. v. Deere & Co. Mr. Justice Breese quotes the definition of the term trade-mark from Upton, and announces, as a conclusion which has his concurrence, that it is 'a symbol, or emblem, or mark which a tradesman puts upon, or wraps, or attaches in some way to the goods he manufactures; * * * the name, symbol, figure, letter, form, or device adopted or used by a manufacturer or merchant, in order to designate the goods he manufactures or sells, * * * to the end that they may be known in the market as his.'

"Without quoting more largely from this decision, we content ourselves with saying that we adopt the result of it, as far as the present question is concerned. We think that a trade-mark must be annexed to the article offered for sale; and that, if not so annexed, the article cannot be said to have a trade-mark."

In the case of Oakes v. Candy Co., 48 S. W. 467, 146 Mo. 391, l. c. 398, the court states as follows:

"A trade-mark which is not in some manner attached or affixed or stamped

> on the article indicated by it involves a contradiction in itself, the idea of some distinctive brand or mark being inherent in the expression itself.
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> "An article can only be said to be distinguished by a trade-mark when that mark is connected with, annexed to or stamped, printed, carved or engraved upon the article as it is offered for sale. St. Louis Piano Co. v. Merkel, 1 Mo. App. 305; Browne on Trade-Marks, sec. 311; Rowley v. Houghton, 2 Brewster, 303; Candee Swan & Co. v. Deere & Co., 54 Ill. 439; Lawrence Mfg. Co. v. Tenn. Mfg. Co., 138 U. S. 537."

Again in the case of Grocers Journal Co. v. Midland Pub. Co., 105 S. W. 310, 127 Mo. App. 356, l. c. 366, the court states:

> "And indeed it is the law that there is not and can be no exclusive ownership of the words or symbol which constitute a trademark apart from the use or application of such words or symbol to a vendible commodity and in order for one person to have that proprietary interest which is always incident to technical trademark, sufficient to support an action looking to the protection of this property right, the mark must be stamped or otherwise affixed to a vendible commodity or thing actually in the market for a sufficient length of time at least to have obtained currency, acceptance and reputation under and associated with the mark which points or otherwise identifies its origin, ownership, or manufacture. (McAndrews v. Bassett, 4 De Gex, J. & S. 380; Browne on Trademarks (2 Ed.), secs. 129, 130, 301, 302; McMahan Phar. Co. v. Denver Chem. Co., 51 Fed. 302."

63 C. J. 314 sets out what goods are subject to trade-mark and states as follows:

> "Strictly speaking, trade-marks are applicable only to articles of traffic, that is, such articles as are bought and sold in the market. Sometimes the term is loosely applied to names and marks used in a business, but not in connection with articles of traffic. This use of the term is inaccurate and probably means no more than that such names and marks will be protected under the doctrine of unfair competition. A valid technical trade-mark may be acquired for use in connection with any lawful vendible commodity, and it is immaterial whether such article be natural or artificial, so long as it is the subject of barter and sale in the market."

We wish it to be understood that we are only passing on the specific question raised, viz., whether Section 14329, supra, applies to services, and hence for the basis of this opinion it is not necessary, nor have we gone into the question of whether the use of the name or mark "Liberty Radio Shop" used in a business offering radio services will be protected under the doctrine of unfair competition.

CONCLUSION

From the foregoing cases and authorities and upon an examination of Section 14329, supra, we are of the opinion that the latter does not apply to services. A trade-mark owes its existence to the fact that it is actually affixed

to a vendible commodity, and it is apparent that, radio service being in its nature intangible, a trade-mark can not be actually stamped upon or otherwise affixed to it.

Respectfully submitted,

WM. ORR SAWYERS,
Assistant Attorney General.

APPROVED:

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

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