TRADE-MARKS: Rules to be followed in trade-marking slogans.

September 24, 1936. 9-24

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

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Dear Sir:

This department acknowledges your letter of September 21st wherein you state as follows:

> "We have been asked to register the label on the enclosed application as a trade-mark by Moerschel Products Company, and are in some doubt about it. Will you please advise us if in your opinion it can be registered. "

The application states that the essential words sought to be trade-marked are "Dealers in Temperature", and that the slogan has been used by Moerschel's in connection with their ice and coal business prior to the year 1926.

Hopkins on Trademarks, 4th Ed., p. 15, makes the following statement with reference to trade slogans:

> "The catch-phrases, advertising phrases or slogans used in trade are governed by precisely the same legal doctrines as tradenames. 'No distinction in fact or principle can be found between a trade-name and a trade slogan.'"

The legal principles involved in determining whether the words in issue may be trade-marked are fully set out in the case of Iowa Auto Market v. Auto Market & Exchange, 197 N. W. 321, l. c. 323, wherein the court said:

> "Words that are generic, or which in their primary meaning are merely descriptive of the goods or business to which they are applied, or are in common use for that purpose, or which convey facts applicable with equal truth and right to others, cannot be exclusively appropriated as a trade-mark. It has been frequently said that no one can secure a monopoly upon the adjectives of the language. 38 Cyc. 696, 708, 722; Koehler v. Sanders, 122 N. Y. 65, 25 N. E. 235, 9 L. R. A. 576; Choynski v. Cohen, 39 Cal. 501, 2 Am. Rep. 476; Clinton Metalic Paint Co. v. Metalic Paint Co., 23 Misc. Rep. 66, 50 N. Y. Supp. 437; Royal Baking Powder Co. v. Sherrell, 93 N. Y. 331, 45 Am. Rep. 229; Lawrence Manufacturing Co. v. Manufacturing Co., supra; Bolander v. Peterson, supra.
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> "But descriptive terms, or such as others might also truthfully use, may, by long use in connection with the goods or business of a particular dealer, come to be understood in a secondary sense as designating the goods or business of such dealer, and in such case their deceptive use by another will be restrained as unfair competition. 38 Cyc. 764, 769; O. K. Bus & B. Co. v. O. K. Transfer Co., 63 Okl. 311, 165 Pac. 136, L. R. A. 1918A, 956, and cases cited in note; Sartor v. Schaden, 125 Iowa, 696, 101 N. W. 511; Dennison Mfg. Co. v. Thomas (C.C.) 94 Fed. 651."

In determining that the words 'Auto Market' were generic and could not be appropriated as a trade-mark or trade-name, the above court further said:

> "The words 'Auto Market' are merely descriptive of the thing sold and the place where sold. Taken either singly or in combination they are generic. They are merely descriptive of the business there carried on. They are no more distinctive of the article sold by appellant or its place of business than would be the words 'shoe store' or 'meat

> market.' They cannot constitute a trade-mark or trade-name, the right to the exclusive use of which will be secured to one in preference to others engaged in the same business. Bolander v. Peterson, supra, Choynski v. Cohen, supra; Koehler v. Sanders, supra."

In the case of Groceteria Stores Co. v. Tibbett, 162 Pac. 54, l. c. 55, the court in holding that the word "groceteria" was a proper trade-name and entitled to protection from infringement, said:

> "Respondent's second assertion is based on the ground that the word 'groceteria' is descriptive of the grocery business, and therefore is not such a word as could become the subject of a trade-mark. It would seem that the statute above quoted would be controlling here, and answer this argument contrary to respondent's contention; but, in any event, we think this argument without merit, since neither the word 'groceteria,' nor any syllable, nor any successive syllables thereof, constitutes any word in the English language, and it is admitted that appellant was the first to use this word. It is therefore a fictitious or fanciful and original name, and appropriate for a trade-mark label so far as this contention is concerned, and respondent has pirated that word. Paul on Trade-Marks, Sec. 49; Sebastian on Trade-Marks, pages 55-64."

And in the case of Furniture Hospital v. Dorfman, 166 S. W. 861, 179 Mo. App. 302, l. c. 307, the court in holding that the name "Furniture Hospital" was capable of being appropriated as a trade-mark with a secondary meaning, said:

> "Of course this rule is qualified by the further rule that names which are mere descriptive terms of the business and generic in their nature are not capable of being appropriated by any one. Hence if the name sought to be protected and claimed to be infringed upon and unfairly

> used is one which may be used by every one in an honestly descriptive and non-deceptive manner, the court may declare, as matter of law, that there can be no unfair competition in the use of such terms. For instance, no one could appropriate the name of 'Swedish Snuff Store' or 'Felt Hat Store,' 'Law Book Store,' 'Divinity Book Store' or any such name as would simply notify the public that a particular class of business or merchandise was carried on or kept there."

And on page 310 of the opinion the above court said:

> "So that upon the question of whether a demurrer to the petition should have been sustained, the case comes down to the inquiry whether or not the name 'Furniture Hospital' is one that in law is capable of being appropriated as a trade name with a secondary meaning.
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> "In our opinion it is, or at least it is not such a name so purely descriptive of the business as to be wholly publici juris, and to be declared such as a matter of law. In the first place, it is shorter, more euphonious, and striking than the prosy words 'repair shop' suggestive of dust and dingy, battered old articles of uncertain age, and still more uncertain, doubtful origin and history. There is a novel, figurative suggestion and association of ideas in the name 'Furniture Hospital' bringing to the mind not only the idea of a homely broken article being merely mended and repaired, but also of its being tenderly cared for with a loving appreciation of its innate beauty and the possibility of restoring it to its former finish and perfection. A lover of restored antique furniture, much in vogue now-a-days, would be much more quickly attracted to the name 'Furniture Hospital' and more apt to take his ancient mohogany there for restoration, than he would to an ordinary 'repair shop.' He would remember the name longer too."

If the words sought to be trade-named were "Dealers in Ice and Coal", such words would simply notify the public of the particular class of business or merchandise that was carried on or kept by Moerschel Products Company, and under the authorities cited could not be exclusively appropriated as a trade-mark or trade-name. The words here sought to be trade-marked, however, bring to mind not only the idea that ice and coal are being sold, but that means are offered of controlling sensations of heat and cold, a subject very common in every day expression. This is a figurative suggestion and more likely to be remembered than ice and coal.

From the foregoing, we are of the opinion that the words "Dealers in Temperature" as sought in the above application are the proper subject of a trade-mark or trade-name.

Respectfully submitted,

WM. ORR SAWYERS,
Assistant Attorney General.

APPROVED:

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

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