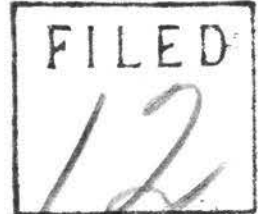


TRADE NAMES:

Secretary of State, Section 12449 may register brands on milk bottles or cans in the name of the assignee.

8-6
August 5, 1937.



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

Dear Sir:

This department is in receipt of your request for an opinion which reads as follows:

"The enclosed is a copy of a letter received by this department. Not knowing just how to proceed relative to change in registration, we ask that you please let us have your opinion in this matter."

The letter which accompanies the request, reads as follows:

"I wish, on receipt of this letter, you would be kind enough to send us forms for the registration of brands for bottles, cases, milk and cream cans, which are now registered in your state under the name of The Borden Company.

We have acquired their property and wish to change the registration on these to Frank Pilley and Sons, Inc."

Section 12449 R. S. Mo. 1929 provides as follows:

"RECEPTACLES FOR MILK, CREAM, ETC.-BRANDS - CERTIFICATES.-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 the right of the person named therein to adopt and use the same. (R.S.1919, Section 12020)."

The question presented in this request is whether the Secretary of State under Section 12449, supra, may re-register the brands on milk bottles and cans in the name of the assignee of such brands. While Section 12449 is not included in the Chapter 136 of the Revised Statutes of Missouri 1929 which deals with trade marks, names and emblems, still the registration of such names or symbols as provided for by Section 12449, partakes of a nature of a trade name and law applicable to trade names will apply to the Statute in question.

A similar question was presented in Ex-parte General Motors Corporation 347 O.B.1047, 1926 C.D.64 from which we quote at length because the question presented there is the same as the one in this case. The Commissioner held as follows:

"it would seem clear that Congress intended in the act to provide for but a single registration and that the Patent Office has exhausted its authority under the act when it follows the procedure laid down therein. It was stated that the alleged inconveniences arising from a transferee having to establish its title in certain cases were too trivial to outweigh the inconvenience to the public of having two coexisting registrations of the same mark.
* * * * *

The statute does not prohibit the re-registration of a trade-mark by the transferee, and there are certain advantages to the transferee in having the mark registered in his own name. For example, it will be much less expensive for him to obtain registration of the mark in the foreign countries, since it will not be necessary to file copies of the papers evidencing the transfer of title with the necessary legalizations thereof, and in the event

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of a suit against a later user the certificate of registration to the transferee will be prima facie evidence of his ownership, whereas if he has to sue on the registration granted to his transferor he will have to prove his title unless the defendant in the suit will stipulate it.
* * * * *

Under this policy it is not believed that registration should be refused to the transferee of a trade-mark unless such re-registration is specifically forbidden by the statute or follows as an obviously necessary inference from the statute.

No such prohibition being found in the statute it follows that the registration here sought should be granted."

The above case was approved by the Court of Customs and Patent Appeals in Panhard Oil Corporation vs Societe 39, Fed. (2nd) 496.

It is therefore the opinion of this department that the assignee of a name or symbol used on milk bottles or cans may register the same with the Secretary of State by following the procedure laid down in Section 12449 R.S.Mo.1929.

Yours very truly,

APPROVED:

AUBREY R. HAMMETT, Jr.
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J. E. TAYLOR
(Acting) Attorney General

AO'K:LB