

TRADE MARKS: Words in common use can not be trade-marked.

April 22, 1936.



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

Dear Sir:

We are in receipt of your request for an opinion under date of April 18, 1936, as follows:

"Will you please note attached application to register trade-mark 'Cod Liver Oil Fortified with Percemorph Liver Oil' by Head Johnson & Company, Evansville, Indiana, and correspondence relating thereto, and advise us whether in your opinion, this name is subject to registration under the trade-mark law."

In the case of Trask Fish Co. v. Wooster, 28 Mo. App. 408, l. c. 419, the court in holding that ordinary English words in common use can not be exclusively appropriated as a trade-mark by one dealing in such articles, said:

"A trademark, to create a proprietary right, must be, not a word or phrase which has become the common property of all mankind in their use of language to identify the thing intended, but must be a name or symbol arbitrarily chosen by the proprietor to distinguish his particular product or commodity from those of all other producers or dealers. By these means only can the commodity be exclusively associated, in the minds of the public, with the proprietor of the trademark."

See, also McGrew Coal Co. v. Menefee, 162 Mo. App. 209, l. c. 216.

In the case of Schmidt v. Brieg, 22 L. R. A. 790, the California Supreme Court (In Banc) in holding that the words "Sarsaparilla and Iron" could not be claimed as a trademark, said:

"Words in common use are the common property of the people, and no one can acquire an exclusive right to such words by adopting them as his trademark, unless they be used out of their ordinary acceptation, and as a fancy name. The general rule is opposed to the use of mere words as a trademark; but if all of the words be used under a new combination in the way of a fancy name or designation, they may constitute a valid trade-mark, if they do in fact indicate origin or ownership. Lawrence Mfg. Co. v. Tennessee Mfg. Co., 138 U. S. 546, 34 L. ed. 1003. We think the words 'Sarsaparilla and Iron' are generic terms, and were used for the purpose of indicating, not so much the origin, manufacture, or ownership of the beverage, as the quality of the article itself."

And in the case of Alff & Co. v. Radam, 77 Tex. 530, 1. c. 540, 541, the court said:

"Words in common use are common property of the people, and no exclusive right to the use of such words can be acquired by adopting them as a trade mark, unless they be used in an arbitrary or fanciful sense and not in their ordinary signification. Browne on Trade Marks, sec. 161; Filley v. Fassett, 100 Am. Dec., 279.

"On the trial the plaintiff testified that the words 'Microbe Killer' mean 'fungus' destroyer; that the word 'microbe' was intended to signify fungus; that in using the name 'Microbe Killer' he intended to convey the meaning that it kills those things, and that the name 'Microbe Killer' means destroyer of microbes.

"That the words are English words in common use, of known signification and fixed meaning, we think there can be no doubt, and that they were employed by the plaintiff in their

ordinary and not in any arbitrary or fanciful sense is shown beyond question by the testimony of the plaintiff himself. Under the authorities, supra, we think it quite clear that the words 'Microbe Killer' as used by the plaintiff did not constitute a trade mark."

An examination of the above authorities indicates that we must first determine whether the words sought to be trade-marked are in common use, and we know of no better test than to examine a good English dictionary.

Webster's New International Dictionary defines the term "cod" thus:

"A soft-finned fish (*Gadus callarias*) of the colder parts of the North Atlantic, one of the most important food fishes of the world."

"Percomorphi" is defined therein as:

"An extensive suborder or order of fishes comprising the perches, basses, and mackerels and their allies, thus including a majority of the spiny-finned fishes."

"Fortify" is defined therein as:

"To make strong; to strengthen * * *."

The product sought to be trade-marked and obtain exclusive use therefor advises the hearer or reader that the composition of the product is oil from the liver of a cod, strengthened from oil from the livers of perches, basses, and mackerels and their allies.

The words are English words in common use, of known signification and fixed meaning, and they are, beyond question, employed in their ordinary and not in any arbitrary or fanciful sense.

The court in the case of *Caswell v. Davis*, 58 N. Y. 233, 1. c.234, said:

"It is the result of all the decisions, that known words and phrases indicative of quality and composition are the common property of all mankind. They may not be appropriated by one to mark an article of his manufacture, when they may be used

truthfully by another to inform the public of the ingredients which make up an article made by him. Even when the sole purpose of the one who first uses them is to form of them a trade mark for himself, expressive only of origin with himself, if they do in fact show forth the quality and composition of the article sold by him, he may not be protected in the exclusive use of them. Still less, then, when joined to the fact that they do thus show forth the quality and composition, there is a purpose that they should do so. It is a right which every one has, and from the exercise of which he may not be debarred, to make an article of the same ingredients, of the same composition and of as good quality as that made by another, when that other has no exclusive privilege of manufacture conferred by law. Having this right to make, he has also the right to indicate the ingredients, the composition and quality of that which he has made, by any usual words or phrases apt therefor. Hence, when he adopts usual phrases which do no more than this, he but takes from a stock common to all mankind, and does not infringe upon any exclusive right of another, who has, before that, used the same or like words or phrases. Nor can the first user avoid this result, by coupling with his purpose to indicate quality and characteristics, a purpose also to indicate origin. Though he have that purpose also, and the form of words used by him have also that effect, inasmuch as he cannot be given the exclusive use, without impairing the right of another, the exclusive use will be denied. The general rule is against appropriating mere words as a trade mark. * * *

* * * * Nor is the question, whether the name used as a trade mark will convey an exact notion of how to compound an article, so that one reading it may be able to make a like article. If the necessary effect is to inform the reader or hearer of the general characteristics and composition of the thing, it is a name which may be used, with equal truth, by any one who has made and offers for sale a thing compounded of the same ingredients, and who desires to express to the public the same facts. Nor does the coupling

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together, in a new combination, of words which before that had been used apart, and had entered into the common or scientific vocabulary, give a right to the exclusive use of such combination, where it is indicative not of origin, maker, use and ownership alone, but also of quality and other characteristics. As it does appear from the testimony in this case, that the phrase claimed by the plaintiff is formed of words in use before the adoption thereof by them; that they were then and are now indicative, not of origin, use and ownership alone, but also of characteristics, quality and composition, the plaintiffs may not be protected in the exclusive use of it as a trade mark."

To permit the words "Cod Liver Oil Fortified with Percomorph Liver Oil" to be trade-marked would deprive persons offering for sale a thing compounded of the same ingredients and expressing the same facts to the public. We are, therefore, of the opinion that the words quoted may not be protected in the exclusive use of it as a trade-mark.

Respectfully submitted,

WM. ORR SAWYERS,
Assistant Attorney General.

APPROVED:

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

MW:HR