Secretary of State—Trade Mark—Same For Different Classes of Goods—Filing—Secretary of State.

Where a word has been appropriated as a trade mark, the use of the same term for a different class of goods is not prohibited though confusion would result if the matter was left to the discretion of the Secretary of State.

May 15th, 1919.

Hon. C. T. Stewart,
Secretary of State,
Helena, Montana.

Dear Sir:

You have referred to me the petition of Flower State Baking Company to file a trade mark consisting of the word "Snowflake" printed on the label which is appropriated for bread, and as to whether the same should be filed, there being another trade mark on record which uses the word "Snowflake" for flour.

Section 4854 of the Revised Codes provides for the filing for record in the office of the Secretary of State of a label or trade mark by complying with the provisions thereof, and further provides that "no label shall be recorded that probably would be mistaken for a label already of record."

Ordinarily where the duty is ministerial by law to file papers upon payment of fees the act is a ministerial one and can be compelled by mandamus. 26 Cyc. 231-232; a discretionary power however will not be controlled, State vs. McGrath, 92 Mo. 355, where it was held that the Secretary of State must exercise his discretion in determining whether a company asking of him a certificate of incorporation has adopted a name that is the same as, or an imitation of, that of an existing corporation, so under the statute above quoted a discretion is reposed in the Secretary to decide whether a label offered for record might be mistaken for a label already recorded. The determination of this must be left to the recording officer. The fact that the word "snowflake" was used on the label offered for record where already recorded would not in my opinion preclude the registration of the label containing these words where it is offered for a different class of goods than for those formerly recorded. The right to the exclusive use of the trade mark is limited to the use on the particular class of goods upon which it has been actually used and other persons may use even the identical mark or name upon a different class of goods. 38 Cyc. 685. Goods are in the same class when the general and essential characteristics are the same so that the public would be likely to be misled if the same mark were used, so it has been held that flour is intended to be made into bread, but if a baker should stamp his bread with a mark of a particular brand of flour the maker of such bread, if having a trade mark therefor, could not claim that the baker had violated his trade mark, and so of any other raw material which enters as an ingredient into any other compound or manufactured article. Anonyme vs. Baxter, 14 Fed. Cases 8099.

Whether the word "snowflake" offered for registration in connection with bread would probably be mistaken for the label "snowflake" registered for flour, is a question to be determined by you in the exercise of the discretion reposed in you by law.

Respectfully,

S. C. FORD,

Attorney General.