**Opinion No. 32-393**

February 4, 1932

**BY:** E. K. Neumann, Attorney General

**TO:** Mrs. Marguerita P. Baca, Secretary of State, Santa Fe, New Mexico.

*{*145}* You have submitted to this office for our consideration the application of W. B. Hicks for registration of certain trademarks and a tradename.

In determining whether or not the particular words mentioned in Mr. Hicks' application are subject to registration as trademarks and a tradename, it is first necessary to interpret the provisions of Chapter 145 of the 1929 Compilation.

Section 145-101 provides that, "any person . . . who manufacture or deal in articles of a commercial nature and wish to retain the exclusive right to the use of a tradename, trademark or label, etc." This language seems to indicate that the Legislature intended this section to apply only to such tradenames and trademarks as under the general law are subject to the exclusive use by the person or persons entitled to such use. In our opinion it has reference only to such trademarks and tradenames as have long been recognized by the common law and in which the courts have generally recognized a property right.

In this connection, the following quotation is particularly applicable:

"The right to a trademark is a right of property, which the state may, in the exercise of its police power, protect by appropriate penal legislation. This right of property is, in the United States, treated as a common law right, and in no wise dependent upon statutory law for its inception." Hopkins on Trademarks, 3 Ed., page 18.

In view of our interpretation of this statute, we are also of the opinion that only such tradenames as are exclusive are governed by this section. There could be no object in requiring the registration of a tradename to which the owner or user did not have an exclusive right. Therefore, in determining whether or not a tradename is subject to registration under our laws, we will apply the same rules that govern trademarks.

"The same rules that govern trademarks are applied in determining what may be an exclusive tradename." St. Louis Independent Packing Co. vs. Houston (C. C. A. Mo.) 215 Fed. 553, 560.

In his application, Mr. Hicks applies for the registration of the following words as trademarks to be used upon bottles containing milk.

E. N. HICKS

HIX

HICKS DAIRY

He also applies for the registration of the following trademark to be used upon butter containers.

**Rio Grande Valley Creamery Butter Hicks the Better Butter**

He further applies for the registration of the tradename "HICKS DAIRY".

A trademark is defined as follows:

"A trademark is a **distinctive** name, word, mark, emblem, design, symbol or device, used in lawful commerce to indicate or authenticate the source from which has come, or through which has passed, the chattel upon or to which it is applied or affixed." Hopkins on Trademarks 3 Ed., pages 4 to 9.

We do not believe that the words which the applicant seeks to have registered are distinctive within the meaning of this definition.

There are also other limitations upon the right to the exclusive use of certain words as trademarks or exclusive tradenames which, in our opinion, would prevent the approval of Mr. Hicks application. A proper name is not, as a general rule, subject to be appropriated as a trademark.

"A name is in its very nature generic, and is properly applied to designate, not one individual in the world, but, it may be, many thousand, to all of whom it is equally appropriate." Sebastian on Trademarks 4th Ed., page 23.

The same rule may be applied to geographical names.

*{*146}* "In our further examination of the use of geographical names in trade, we will find that they are never properly sustained as technical tradenames, except where they are used by one who is the sole owner of the entire locality to which the name is applied." Hopkins on Trademarks, 3rd Ed., page 94.

With particular reference to the use of the words "HICKS THE BETTER BUTTER", we think the following statement by Mr. Hopkins in his work on Trademarks, page 97, is applicable.

"It is impossible to believe that ordinary laudatory epithets can by any amount of use acquire the quality of distinctiveness."

With respect to the use of the word "HIX", we do not believe that a person, merely by misspelling his name, can make it the subject of exclusive use as a trademark.

In view of all of the foregoing, we are, therefore, of the opinion that the application of Mr. Hicks should be denied.

By: Quincy D. Adams,

Asst. Attorney General