SECRETARY OF STATE: Trade-marks—whether the words "Off the Car" may be registered as a legal trade-mark.

February 7, 1941.

Hon. James M. Tucker,
Secretary of State,
State House,
Indianapolis, Indiana.

Dear Sir:

I have before me your letter stating, in part, as follows:

"On December 16, 1930, there was filed and registered in this office an advertising phrase of three words, being to-wit:

'Off the Car'

"This phrase in the application was applied to Class 1, being the classification relating to raw and partly prepared materials and was intended more specifically to be used in connection with the sale of all types of retail coals.

"On January 2, 1941, a petition was filed with this office by an attorney representing certain coal dealers, requesting this office to cancel the registration of said advertising phrase aforesaid. * * *

You request an official opinion as to whether the above described advertising phrase "Off the Car" when used in connection with all types of coal is such an advertising phrase or slogan as is provided for in Section 66-107, Burns' Indiana Statutes Annotated, 1933.

The Section above referred to is Section 1, Chapter 116 of the Acts of 1891 as the same was amended by Section 1 of Chapter 34 of the Acts of 1917. The title of Chapter 116, supra, is as follows:

"AN ACT providing for the filing and recording of trade-marks, labels, brands, stamps and wrappers, defining their use, granting remedies for their wrongful use, and providing a penalty for counterfeiting or imitating trade-marks, labels, brands, stamps and wrappers, and for having in possession, or for selling or offering for sale goods, wares, merchandise or other
articles upon which is placed a false or forged trade-mark, label, brand, stamp or wrapper in likeness of a registered trade-mark, label, brand, stamp or wrapper."


In harmony with this title Section 1 of the original Act refers only to the obtaining of protection for lawful trade-marks, labels, brands, stamps and wrappers. The amendment of 1917 includes along with the above and in addition thereto, "an original phrase or slogan."


There was, however, no amendment to the title of the 1891 Act as above quoted.

The question, therefore, first arises as to whether the provision for registering "an original advertising phrase or slogan" is within the title of the Act. I think it is obvious that the language "an original advertising phrase or slogan" may easily be so construed as to be beyond the scope of the title of the original Act. Clearly, as applied to a method of doing business it can hardly be said to be within the meaning of a trade-mark, a label, a brand, a stamp or a wrapper, all of which suggests some identifying mark or label not purely descriptive in character but which identifies the product to which they refer as the product of some certain individual, firm or corporation. I think, therefore, in harmony with the general rule that statutes should be so construed, if possible, as to give them effect, that this language "an original advertising phrase or slogan" must be held to apply only to such advertising phrases and slogans as have the qualities of trade-marks, labels, brands, stamps or wrappers. Otherwise, I would be obliged to hold this amendatory language of 1917 to be invalid and in violation of Section 19 of Article 4 of the Constitution of Indiana.

Thus limited in its meaning, and I am convinced that it must be thus limited in order to sustain it at all, the language "Off the Car" used as described in your letter does not constitute "an original phrase or slogan" as that language is used in the Indiana Act.

In the first place, it clearly does not have the qualities of a trade-mark. It does not define a brand. It is not to be used
either as a label, stamp or wrapper but rather is descriptive only of a method of doing business and that is a method which, in my opinion, cannot legally be exclusively appropriated by any one person, firm or corporation.

Upon the subject of purely descriptive marks or terms, I desire to refer you to two decisions by Federal Courts. Many others could be added. Note first the case of Franklin Knitting Mills, Inc. v. Fashionit Sweater Mills, Inc., where the Court held that the term “Fashionknit” was purely descriptive. (See 297 Fed. Rep. 247.)

Also see the case of: In re Minnesota Valley Canning Company, 49 Fed. Rep. (2d), p. 847. In this case the appellants sought to register the trade-mark “Off the Cob” to be used on canned corn. Objection was made to its registration on the ground that it was purely descriptive. The Court, after stating the familiar rule that a name which is merely descriptive of the ingredients, qualities or characteristics of an article of trade cannot be appropriated as a trade-mark, continued as follows:

"Applying this rule to the case at bar, we have no doubt that the designation ‘Off the Cob,’ as applied to canned corn, is merely descriptive of the qualities or characteristics of the corn. * * *"

In this last case quite a number of cases are referred to as illustrative of the principle involved.

For the reasons herein stated, I am of the opinion that the language “Off the Car” as applied to the situation described in your letter, is not eligible for registration under the Indiana Act.

STATE BOARD OF ACCOUNTS: Co-ordinative administration of poor relief through state and federal agencies.

February 7, 1941.

Honorable E. P. Brennan,
State Examiner,
Division of Accounts and Statistics,
Indianapolis, Indiana.

Dear Sir:

I have your letter of the 31st ultimo wherein you enclose letter from the Regional Director of the Surplus Marketing