Opinion No. 44-4545

July 18, 1944

BY: C. C. McCULLOH, Attorney General

TO: Mrs. Cecilia Tafoya Cleveland, Secretary of State, Santa Fe, New Mexico

We are in receipt of your letter of July 8, 1944, in which you ask our opinion as to whether or not you are authorized to accept for registration a trade-mark of the same description as one already on file if the new trade-mark is used to identify something dissimilar.

Section 51-1201 of the 1941 Compilation provides, in part, as follows:

"Any person or persons, firm, corporation or association who manufacture or deal in articles of a commercial nature and wish to retain the exclusive right to the use of a trade-name, trade-mark or label shall make a description of the same in writing, accompanied by a facsimile of such trade-name, trade-mark or label, **which description and application must set forth the class or classes of merchandise to be covered by such trade-name, trade-mark or label,** together with a statement that the applicant claims by priority of adoption and employment of the same, exclusive right to the use thereof. * * * The secretary shall keep a record of each trade-name, trade-mark, or label, and it shall be unlawful for any other person, firm, corporation or association to adopt a trade-name, trade-mark or label identical with or similar to one previously registered. **A copy of such description of any trade-name, trade-mark or label, certified under the great seal of the state of New Mexico, shall be prima facie evidence of the facts therein stated."**

The right of property in a trade-mark is not created by a statute of this kind, but is a common law right which has long existed, and been protected by the courts. The purpose of statutes, such as is cited above, is to protect the owner of a valid trade-mark and the public through a system of registration and classification. (63 C. J. 468). Such statutes have held to be in affirmance of the common law, and only prima facie evidence of a valid ownership of a registered trade-mark. (63 C. J. 471) That this is the sole purpose of our statute is made clear by the language "a copy of such description of any trade-name, trade-mark, or label certified under the great seal of the State of New Mexico."

Thus, if it is the common law right in a trade-mark that is protected, it is necessary to determine what that common law right is. As to this the author in 63 C. J. 317 says:

"The right to the exclusive use of a trade-mark is not unlimited. Its use on one or more commodities does not give the right to use it on all, for the right to the exclusive use of a trade mark is limited to a use on the particular class of goods on which it has been

actually used, and other persons may use even the identical mark or name in connection with a different class of goods."

That our Legislature intended to protect trademarks only insofar as they identified a particular class of goods is borne out by the language:

"which * * * application must set forth the class or classes of merchandise to be covered by such trade-name, trade-mark, or label."

In view of the foregoing, it is my opinion that you may accept for registration a trade-mark already in use if the new applicant seeks to have the trade-mark registered to identify a class of goods different than that identified by the previously registered trade-mark. It is further my opinion that in determining whether the goods covered by the new trade-mark is different, reference must be had to the "class or classes of merchandise to be covered," as shown by the application for the two trade-marks.

As you asked only for an opinion with respect to trade-marks, I have not gone into the question of trade-names. Yet, as a matter of precaution, I thought it best to call your attention to the fact that a different result might be reached with respect to trade-names, since a trade name is used to identify the products of a particular business, and is an incident to such business. Thus, a trade-name extends in its application to all goods coming within the scope of the activities of the business whether or not the goods are the same class. Here, again, it appears to me that in determining the protected scope of a trade-name reference must be had to the information contained in the application for trade names.

Trusting that the foregoing sufficiently answers your inquiry, I am

By ROBERT W. WARD,

Asst. Atty. General