



OFFICE OF THE ATTORNEY GENERAL OF TEXAS  
AUSTIN

GROVER SELLERS  
ATTORNEY GENERAL

Honorable Claude Isbell  
Secretary of State  
Austin, Texas

Attention: Mr. J. L. McGarity

Dear Sir:

Opinion No. 0-6774  
Re: Filing of trademark,  
"SAFEMAY FOOD STORE" when  
trademark, "SAFEMAY--YOUR  
FRIENDLY GROCER", has been  
previously filed in the  
Office of the Secretary of  
State.

We are in receipt of your letter of recent date re-  
questing the opinion of this department on the above stated  
matter. We quote from your letter, as follows:

"On June 10, 1944, this office was presented  
for registration and did register a trademark,  
the name being "SAFEMAY--YOUR FRIENDLY GROCER",  
under the provisions of Article 851 et seq. of  
the Texas Revised Civil Statutes, 1925, on behalf  
of Safeway Stores, Incorporated, Oakland, Calif-  
ornia. When this said trademark was registered  
in this office we assigned it file number 61-11,107  
and issued the statutory certificate to the effect  
that the name had been so registered. We enclose  
herewith a photostatic copy of the application  
for such registration together with our certificate  
in that connection.

"We are now presented with an application to  
register the trademark "SAFEMAY FOOD STORE" on be-  
half of Safeway Food Store, a Partnership doing  
business in Lubbock, Texas, together with the  
statutory fee in the sum of one dollar. We enclose  
herewith a photostatic copy of this said applica-  
tion.

Hon. Claude Isbell, page 2

"This office has refused to file this junior application without the written consent of the senior registrant due to the firm conviction that the two marks are too similar to preclude being confusing to the public. The attorneys for the applicant, however, contend that the names are not so sufficiently similar as to be confusing to the public.

"Will you, therefore, please favor us with your opinion as to whether or not we should approve and file the latter application while we still have as an active registrant the former."

Article 851, Vernon's Annotated Civil Statutes, provides:

"Every person, association or union of workmen, incorporated or unincorporated, that has heretofore or shall hereafter adopt a label, trademark, design, device, imprint or form of advertisement, shall file the same in the office of the Secretary of State by leaving two fac simile copies, with the Secretary of State, and said Secretary shall return to such person, association or union so filing the same, one of said fac simile copies along with and attached to a duly attested certificate of the filing of same, for which he shall receive a fee of one dollar. Such certificate of filing shall in all suits and prosecutions under this chapter be sufficient proof of the adoption of such label, trade mark, design, device, imprint or form of advertisement, and of the right of such person, association or union to adopt the same. No label, trade mark, design, device, imprint or form of advertisement shall be filed as aforesaid that would probably be mistaken for a label, trade mark, design, device, imprint or form of advertisement already of record. No person, or association shall be permitted to register as a label, trade mark, design, device, imprint or form of advertisement any emblem, design or resemblance thereto that has been adopted or used by any charitable, benevolent or religious society or association, without their consent." (underscoring ours)

Hon. Claude Isbell, page 3

Under the language of the underlined portion of the above-quoted statute, the determination of the matter as to whether the Secretary of State should accept the filing of the trademark inquired about depends upon whether said trademark "would probably be mistaken" for a trademark already of record. In connection with this matter, we refer you to the case of Marshall Mfg. Co. v. Verhalen, (Civ. App.) 163 S. W. (2d) 665 (error refused). In this case, it was held that whether a registered trademark was infringed upon by a competitor's alleged use of a similar design was a question of fact. It was also held that whether the resemblance of the two designs was so great that the public would, or would be likely to, mistake one for the other was a question of fact. We quote from the court's opinion in the above-cited case, as follows:

"The trade-mark of appellant's baskets is one continuous red stave extending down one side of the baskets, under the bottom and up the directly opposite side; and the baskets manufactured by the defendants, which are claimed to be infringement upon and in unfair competition to plaintiff's specially designed baskets, bear two such continuous staves of the same type and distinctive red color, placed at right angles to each other, so that, in most positions, only one of the staves is visible to the casual observer. The red color in the staves is not functional in either of the baskets; they are merely ornamental and designed to designate the origin and source of the goods. Baskets manufactured by both the plaintiff and the defendants were presented in trial of the cause, and are here exhibited, which are clearly indicative of competitive rivalry by the manufacturers of the alleged similarly designed baskets, presenting, we think, issues as to whether they are calculated to create confusion and infringement and unfair competition among the manufacturing concerns; the decision of which rests solely with the fact-finding agency.

". . . .

". . . . So, in this case, it was the province of the jury to find upon every material issue raised by the evidence, and we think it is clear that the distinctive markings of plaintiff's baskets and that employed by the defendants raised the issues that the one continuous red stave so placed in the field of the natural color wood of the baskets by plaintiff,

Hon. Claude Isbell, page 4

was a technical trademark; and, further, if not, it had a secondary meaning, designating appellant's baskets through long and continuous use and advertisement; and that the defendants' baskets, with two continuous red staves crossing each other at right angles under the bottom of the baskets, were so similar as that any person would observe and mistake the one for the other and deal for one when he intended to deal for the other. Such findings would be upon controlling fact issues. Dallas Plumbing Co. v. Dallas County Plumbing Co., Tex. Civ. App., 253 S. W. 308; Dixiepig Corp. v. Pig Stand Co., Tex. Civ. App., 31 S. W. 2d 325; Plaza Co. v. White et al., Tex. Civ. App., 160 S. W. 2d 312; writ of error refused.

"In the last cited case, the Plaza Hotel sought to enjoin The White-Plaza Hotel from using the name 'White-Plaza,' designating its trade-name as an infringement on plaintiff's trade-name--'The Plaza Hotel.'" In the course of the opinion, the San Antonio Court of Civil Appeals held, quoting from Atlas Assurance Co. v. Atlas Insurance Co., 138 Iowa 228, 112 N. W. 232, 233, 114 N. W. 609, 15 L.R.A., N. S., §25, 128 Am. St. Rep. 189, that "\* \* \* what degree of resemblance between the names or devices is sufficient to warrant the interference of a court in cases of this kind is not capable of exact definition. It is, and must be, from the very nature of the case, mainly a question of fact to be determined by the circumstances appearing in each particular case." So, in the case here, the court below was not warranted to take the case from the jury and enter judgment in the absence of findings determinative of the ultimate issues of fact raised by the pleadings and the evidence, hence the judgment is reversed and the case remanded."

In view of the foregoing and in view of the language of Article 851, it is our opinion that the matter as to whether the trademark in question should be filed, involves a question of fact, and it is not the policy of this department to determine any question of fact. If the Secretary of State should find that the trademark, "SAVEWAY FOOD STORE," would probably be mistaken for the trademark, "SAFEWAY, YOUR FRIENDLY GROCER,"

Hon. Claude Isbell, page 5

it is our opinion that he would be legally justified in refusing the application for registration of same.

We trust that the foregoing satisfactorily answers your inquiry.

*Claude Isbell*

JAE:LJ

Yours very truly,

ATTORNEY GENERAL OF TEXAS

*J. A. Ellis*  
J. A. Ellis  
Assistant

By

