

**OPINION
67-320**

March 3, 1967 (OPINION)

Mr. Ray H. Mattison

Superintendent

State Historical Society

RE: Trademarks - State Historical Society - Sakakawea

This is in reply to your letter with regard to use of a picture of possibly a statute of possibly Sakakawea on your letterhead. You enclose a copy of a letter from the General Counsel and Senior Vice President of an insurance company mentioning that they have registered a picture of Sakakawea as their trademark. You also enclose a sample of your letterhead and a letter sent out by you on such letterhead "advertising" what we presume to be the society's quarterly entitled, "North Dakota History."

We enclose herewith verifax copy of trademark and registration of same as registered in the office of the North Dakota Secretary of State. We note that the trademark includes both an outline picture and printing used therewith as well as the outline picture separately.

The basic statute, section 47-22-11 of the North Dakota Century Code, provides:

"INFRINGEMENT. Subject to the provisions of section 47-22-13 any person who shall

1. Use, without the consent of the registrant, any reproduction, counterfeit, copy, or colorable imitation of a trademark registered under this chapter in connection with the sale, offering for sale, or advertising of any goods on or in connection with which such use is likely to cause confusion or mistake or to deceive as to the source of origin of such goods; or
2. Reproduce, counterfeit, copy or colorably imitate any such trademark and apply such reproduction, counterfeit, copy or colorable imitation to labels, signs, prints, packages, wrappers, receptacles, or advertisements intended to be used upon or in connection with the sale or other distribution in this state of such goods;

shall be liable to a civil action by the owner of such registered trademark for any or all of the remedies provided in section 47-22-12, except that under subsection 2 of this section the registrant shall not be entitled to recover profits or damages unless the acts have been committed with knowledge that such trademark is intended to be used to cause confusion or mistake or to deceive."

You might also consider section 47-22-09 of the North Dakota Century Code which provides insofar as here applicable:

"CLASSIFICATION. The following general classes of goods are established for convenience of administration of this chapter, but not to limit or extend the applicant's or registrant's rights, and a single application for registration of a trade-mark may include any or all goods upon which the trademark is actually being used comprised in a single class, but in no event shall a single application include goods upon which the trademark is being used which fall within different classes of goods.

* * *

38. Prints and publications

* * *. "

We are not suggesting that all pictures of the statute, if same is a picture of a statute, could be copyrighted preventing literary use of such figure in other historical materials, however, a trademark differs from a copyright. We note the following at 52 Am. Jur. 548, Trademarks, Tradenames, etc., section 65:

"HISTORICAL, MYTHOLOGICAL, FAMOUS OR FICTITIOUS NAMES. Subject to the qualifications respecting the use of names generally, the law permits the adoption as a trademark of the name of a person who has achieved fame and distinction and also of mythological and fictitious characters. Such a name, in the case of a person long since dead, has been spoken of as an arbitrary or fanciful one. But the name of a person, although a celebrity, may become generic and descriptive of a particular article, or have acquired a geographical signification, as the name of the place where such article is procured or produced, or have been previously appropriated by others as a trademark for the same class of articles, in which cases no exclusive right can be acquired.

* * *. "

We recognize, of course, that the trademark here concerned is a picture rather than a name, and we note the suggestion that the picture is of a statue of the historical person rather than the historical person herself. However, basically the same principles are applicable.

There are several difficulties with application of the statutes to the instant circumstances. From materials at hand it would appear that the picture used by the Historical Society is probably of more careful workmanship than that used by the insurance company, rather than being a reproduction, counterfeit, copy or colorable imitation of the registered trademark. Also, it would appear that generally the Historical Society is not in the business of selling, offering for sale or advertising any goods, though the letter you forward seems to indicate that in this instance the letterhead was used to "advertise" a publication of the Historical Society. Likewise, it

seems difficult to assume that the trademark is generally used by the insurance company in question as a distinctive mark on the rights which it sells. It might well be that said trademark does appear on its printed contracts, though again there would appear to be some difficulty as to whether such contracts are "prints and publications." Also, there would appear to be a great deal of difficulty in finding that the Historical Society of the sovereign State of North Dakota was able to, or intended to gain any benefit from imitation of trademarks of private commercial corporations.

In view of the problems concomitant with use of this particular type of emblem of the State Historical Society's letterhead, it is difficult to advise that use of same is definitely either in violation of law or not in violation of law in all possible cases. However, it would be advisable to avoid using this particular letterhead in letters giving information as to availability of material objects from State Historical Society where the Society is to be reimbursed by the person receiving such material objects in future. We see no legal difficulty in use of such letterhead in other correspondence of the State Historical Society.

HELGI JOHANNESON

Attorney General