

Opinion No. 58-81

April 10, 1958

BY: OPINION OF FRED M. STANDLEY, Attorney General Hilton A. Dickson, Jr.,
Assistant Attorney General

TO: Mrs. Natalie Smith Buck, Secretary of State, Santa Fe, New Mexico

QUESTION

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"While there seems to be no specific statute of limitation on the matter, within what period of time should this office be duly notified after ownership of a trademark registered with this department has changed hands?"

CONCLUSION

No definite period, but there is no protection until such notice is given.

OPINION

ANALYSIS

Section 49-4-1, N.M.S.A., 1953, provides, in part, that:

"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."

A search of the remaining sections of this article does not reveal a duration period for which infringement protection is afforded by filing one's trade-mark with the Secretary of State. Under the federal statutes, 15 U.S.C.A. §§ 91 et seq., "A certificate of registration shall remain in force for twenty years, . . ." No comparable term is found in our state law.

Generally speaking, trade-marks are subject to assignment or transfer except when such are identifiable as personal to an individual, exempligratia, an artist's mark or signature. Thus, to enjoy the protection afforded under our registration laws, it would only be necessary that the fact of such assignment be made known to the specific recorder (Secretary of State) by filing written and substantiated notice thereof. As is fundamental to all recordation laws, a change of status or ownership of any property is legally effective only between the immediate parties concerned, or those having actual knowledge of the transaction where no recording is made. Thus, returning to the immediate question put, there is no requirement that trade-mark transfers be recorded within a given period. However, it must also be concluded that, until there has been a recordation, protection in one's use of a specific trade-mark remains only in himself, last shown by certificate to have been the owner of such mark.

And finally, giving thought to the law generally governing duration and termination of trade-mark right, we find at 52 Am. Jur. 524 the following:

"Rights in respect of a trademark or tradename may be terminated by abandonment. Abandonment must, however be strictly proved where a forfeiture is claimed on that ground. The temporary disuse of a trade-mark or trade-name, or even the temporary use of an additional trade-name in connection with it, is not sufficient. It is necessary to show not only acts indicating a practical abandonment, but an actual intent to abandon, since acts which, unexplained, would be sufficient to establish an abandonment may be answered by showing that there never was an intention to give up and relinquish the right claimed."

Accordingly, it is our opinion that no period of time is provided for in which the assignee of trade-mark right must record or otherwise give public notice of the fact of transfer, but also, that a failure to effect such notice leaves the assignee without protection of the law as would otherwise be provided.