

TRADE-MARK: ABANDONMENT: Evidence not sufficient to constitute
abandonment of Trade-MARK.

11-24
October 23, 1934.



Mr. Harry C. Alberts
First National Bank Building
Chicago, Illinois

Re: Sunkist Pie Company -
Trademark "Sunkist Pies"

Dear Sir:

This department is in receipt of your letter
and enclosures of recent date.

Your enclosure received from Honorable
Dwight H. Brown, Secretary of State, dated September
27th, 1934, reads as follows:

"Referring to correspondence
relative to registration of
trade-mark Sunkist, we passed
this correspondence on to the
office of the Attorney-General
for an opinion, and are informed
today that abandonment of this
trade-mark by James Harry Long
and Chas. Geo. Smith must be
established in a court of law."

Your letter addressed to this department
reads in part as follows:

"This office has submitted to the
Secretary of State of Missouri an
application for trademark regis-
tration of the words "SUNKIST PIES"
for use in connection with baked
pies. We are advised by the Secre-
tary of State that the term "SUNKIST"
was registered by James Harry Long
and Chas. Geo. Smith who conducted

a bakery shop some years ago and have since gone out of business.

"Letters addressed to the last known address of James Harry Long and Chas. Geo. Smith have been returned by the postal authorities, unopened, as evidenced by the attached original specimen thereof. The envelope addressed to the last known address of these prior registrants is postmarked July 11, 1934, and was opened by the Secretary of State to whom this evidence was submitted for reconsideration of my client's application for trademark registration of "SUNKIST PIES" for prebaked dough pies.

"Also, a letter was sent to the last known address of Sarah M. Hawley who notarized the trademark application of James Harry Long and Chas. Geo. Smith, but this letter has also been returned by the postal authorities as evidenced by the attached original specimen. Duns and Bradstreets have been unable to ascertain the whereabouts of these individuals nor have they been able to give this office a report on any firm using their name in the state of Missouri or elsewhere, and who are commercially exploiting any bakery goods under the term "SUNKIST".

"Such evidence is construed by the Trademark Division of the United States Patent Office to be conclusive of abandonment of a trademark and will issue another registration to other applicants for the same trademark on the strength of the same evidence that has heretofore been submitted to the Secretary of State for the state of Missouri. In the last letter received from the Secretary of State, it was indicated that the matter was referred to your office for an opinion. Further, it was stated that your office rendered an opinion to the effect that the abandonment of the trademark "SUNKIST" by James Harry Long and Chas. Geo. Smith will have

to be established by a court action."

* * * * *

"It is hoped that you will reconsider your decision in this matter and all of the papers including the trade-mark application are being submitted to you for reconsideration with the request that the Secretary of State of the State of Missouri be instructed to grant a certificate of trade-mark registration covering the term "SUNKIST PIES" for the State of Missouri."

From an early date, the common law has recognized the right of the proprietor of a trade-mark to its exclusive use. The right has been, without interruption, recognized and protected by the courts of England and the United States, in the absence of statutes declaring the existence of such rights or providing regulations for its exercise and remedies for its deprivation.(26 R. C. L. 834, and cases cited in note thereto.)

Section 14329, R. S. Mo. 1929, provides who may adopt a trade-mark, the manner in which it may be adopted, and reads in part as follows:

***** No label, trade-mark or form of advertisement shall be registered that in any way resembles or would probably be mistaken for a label or trade-mark already registered; and no trade-mark duly registered in the office of the commissioner of patents of the United States shall be registered under this section by (any) person other than the owner thereof."

It is established that the trade-mark "SUNKIST" is already registered in the State of Missouri by James Harry Long and Chas. Geo. Smith under the above section. The latter parties have thereby acquired the exclusive use for such purpose, and unless it has abandoned that right or has lost it by its acquiescence in the use of it by others, it still has it.

The question then arises, whether the right to protection in the use of a trade-mark continues indefinitely

or whether a title to a trade-mark, acquired by adoption and user may be lost by an abandonment of such use?

The question of abandonment of a trade name or mark is a question of intent, and as stated by the court in the case of Hickman v. Link, 116 Mo. 123, l.c. 127, wherein it was said:

"Abandonment in law is defined to be 'the relinquishment or surrender of rights or property by one person to another. **** Abandonment includes both the intention to abandon and the external act by which the intention is carried into effect.' 'To constitute an abandonment there must be the concurrence of the intention to abandon and the actual relinquishment of the property, so that it may be appropriated by the next comer.' 1 American and English Encyclopedia of Law, page 1, and Note 5. "

In the case of Belden v. Zopher Mills, Inc., 34 F. (2d) 125, the court had before its consideration, whether cessation from business for a short time establishes the owner's abandonment of a registered trade-mark. The Court said:

"Cessation from business for a short time does not establish abandonment. Beechnut Packing Co., v. P. Lorillard Co., 273 U. S. 629, 632; 47 S.Ct. 481, 71 L. ed. 810."

As to the lapse of time that could justify an inference of abandonment, it has been judicially said, that no statute of limitations bars one from protection of his trade-mark. On this point are many decisions, alike in principle, although varied with circumstances. In one case, a lapse of twenty years was held to be no bar; in another case, ten years; and in another case, nine years. (See Gillott v. Esterbrook, 48 N. Y. 374; Wolfe v. Barnett, 24 La. Ann. 97; Lazenby v. White, 41 L. J. (N. S.) 354.

In Julian v. Hoosier Drill Co., 78 Ind. 413, the Court in its opinion said:

"The suspension (of the use of a trade-mark) must be presumptively at least, attributed to indisposition or inability, rather than an intention to abandon valuable rights", and "it is incumbent upon those alleging the defense of abandonment to show that the right had been relinquished to the public by clear and unmistakable evidence."

Browne on "Law of Trade-marks", Section 681, page 654, in discussing "abandonment", states in part as follows:

***** A person may temporarily lay aside his mark, and resume it, without having in the meantime lost his property in the right of user. Abandonment being in the nature of a forfeiture must be strictly proven.
**** We must examine the surroundings of each case of imputed surrender, to be enabled to settle such questions of deliberate yielding up. A defense of abandonment is abhorrent, even in an action at law, and the assertion of title on the ground of abandonment by the prior owner must be established by the strongest proof."

CONCLUSION.

From the foregoing, we are of the opinion that the question of abandonment of trade-mark or a trade-name is a question of intent that may be inferred from disuse, lapse of time and other circumstances evidencing the intention to discontinue the trade-mark.

The only evidence presented to us as evidencing an intention to abandon are letters addressed to the last known address of prior registrants, post-marked July 11, 1934 and returned by postal authorities unopened. The

cases dealing with the time element, decided as they are under varied circumstances, make them of little help insofar as the instant case is concerned. It is true that the question of intent to abandon may be inferred from lapse of time but it must be considered with other circumstances, which in this case is the fact that the prior registrants cannot be located.

The mere fact that the parties have apparently gone out of business and cannot be found is not sufficient evidence in itself to declare an abandonment without a judicial determination to that effect. As stated in Browne's work on "Law of Trade-Marks", supra, "A person may temporarily lay aside his mark and resume it without having in the meantime lost his property in the right of user. Abandonment being in the nature of a forfeiture must be strictly proven."

We are therefore of the continued opinion that the alleged abandonment of the trade-mark "SUNKIST" by James Harry Long and Chas. Geo. Smith must be established in a court of law.

Respectfully submitted,

OLLIVER W. NOLEN
Assistant Attorney-General.

APPROVED:

ROY MCKITTRICK
Attorney-General.

MW/afj