**10.3 Defenses to Claim of Infringement of a Trademark**

[Name of plaintiff] has shown a likelihood of confusion, but [name of defendant] claims that [name of defendant] is not liable to [name of plaintiff] for trademark infringement because one or more of the following defenses exist. [Name of defendant] has the burden of proving [a] defense[s] to trademark infringement by a preponderance of the evidence.

[The following instruction should be given in cases in which defendant claims that the use of plaintiff’s trademark is a nominative fair use:

Nominative fair use is a defense to a claim of trademark infringement. Under this defense, [name of defendant] may use [name of plaintiff]’s trademark to refer to [name of plaintiff]’s goods, but [name of defendant] may not use [name of plaintiff]’s trademark to refer to [name of defendant]’s own goods. You must find that [name of defendant]’s use of the trademark was not infringing if [name of defendant] proves by a preponderance of the evidence that [his/her/its] use of [name of plaintiff]’s trademark meets the following elements:

[Name of plaintiff]’s trademark is the only name, term, or symbol reasonably available to describe [name of defendant]’s goods;

[Name of defendant] does not attempt to capitalize on consumer confusion or to appropriate the prestige of [name of plaintiff]’s trademark; and

[Name of defendant]’s use of [name of plaintiff]’s trademark does not identify [name of plaintiff] as the source of [name of defendant]’s goods.]

[The following instruction should be given in cases in which defendant claims that [his/her/its] use of plaintiff’s trademark is descriptive fair use:

Descriptive fair use is a defense to a claim of trademark infringement. [Name of defendant] is not liable for infringement if [he/she/it] proves by a preponderance of the evidence that [his/her/its] use of [name of plaintiff]’s trademark is necessary to accurately describe a characteristic of [his/her/its] goods. To establish this defense, [name of defendant] must prove that [name of plaintiff]’s trademark is used:

Other than as a trademark;

In a descriptive sense; and

Fairly and in good faith – that is, [name of defendant] did not intend to trade on the goodwill of [name of plaintiff] by creating confusion as to the source of [name of defendant]’s goods.]

[The following instruction should be given in cases in which defendant claims that plaintiff abandoned [his/her/its] trademark:

Abandonment of a trademark is a defense to a claim of infringement. To prove abandonment, [name of defendant] must prove the following by a preponderance of the evidence:

[Name of plaintiff] discontinued the bona fide use of [name of plaintiff]’s trademark, and did so with the intent to not resume [his/her/its] use in the reasonably foreseeable future. If you find that [name of plaintiff] has not used the trademark for three consecutive years, you may presume that [name of plaintiff] did not intend to resume use of the trademark, but [name of plaintiff] can rebut that presumption by producing evidence that [he/she/it] intended to resume use; or

[Name of plaintiff] acted or failed to act, and as a result [name of plaintiff]’s trademark no longer identifies the source of [name of plaintiff]’s goods and has become a generic term for the associated goods.]

[The following instruction should be given in cases in which defendant claims to be the senior user of a mark under Section 15 of the Lanham Act, 15 U.S.C. § 1065 (2012), in an action brought by a plaintiff owning an incontestable federal registration on the Principal Register:

Prior use of a trademark in a particular geographic area is a defense to a claim of infringement. To prove prior use, [name of defendant] must prove the following by a preponderance of the evidence:

* [Name of defendant] began using its mark in a particular geographic area before [name of plaintiff] began using its mark in that area; and
* [Name of defendant]’s use of its mark in that geographic area has been continuous since that use began.]

[The following instruction should be given in cases in which a defendant claims to be an intermediate junior user of a mark under Section 33(b)(5) of the Lanham Act, 15 U.S.C. § 1115(b)(5) (2012), in an action brought by a plaintiff owning a federal registration on the Principal Register:

Prior use of a trademark in a remote geographic area before a plaintiff’s registration issued is a defense to a claim of infringement. To prove prior use, [name of defendant] must prove the following by a preponderance of the evidence:

* [Name of defendant] began using its mark in a particular geographic area before [name of plaintiff] received a federal registration of [name of plaintiff]’s mark;
* [Name of defendant] began using its mark without knowledge of the [name of plaintiff]’s prior use of its mark; and
* [Name of defendant] has used its mark continuously in its geographic area since before [name of plaintiff] received a federal registration of [name of plaintiff]’s mark.

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Defenses to Claim of Infringement of a Trademark

**Special Interrogatories to the Jury**

**Do you find by a preponderance of the evidence that:**

**[Use these special interrogatories if defendant is claiming that [his/her/its] use is nominative fair use:**

[Name of plaintiff]’s trademark is the only reasonable way to describe [name of defendant]’s goods?

Answer Yes or No \_\_\_\_\_\_\_\_\_\_\_\_\_

If your answer is “Yes,” then go to the next question. If your answer is “No,” then go to the special interrogatories on Remedies in either the jury charges for Infringement of Registered Trademark or Infringement of an Unregistered Trademark.

[Name of defendant]’s use of [name of plaintiff]’s trademark is not an attempt to capitalize on consumer confusion or to appropriate the prestige of [name of plaintiff]’s trademark?

Answer Yes or No \_\_\_\_\_\_\_\_\_\_\_\_\_

If your answer is “Yes,” then go to the next question. If your answer is “No,” then go to the special interrogatories on Remedies in either the jury charges for Infringement of Registered Trademark or Infringement of an Unregistered Trademark.

[Name of defendant]’s use of [name of plaintiff]’s trademark is not intended to identify [his/her/its] goods with the source of [name of plaintiff]’s goods?

Answer Yes or No \_\_\_\_\_\_\_\_\_\_\_\_\_

If your answer is “Yes,” then your foreperson should sign and date the last page of this verdict form. If your answer is “No,” then go to the special interrogatories on Remedies in either the jury charges for Infringement of Registered Trademark or Infringement of an Unregistered Trademark.]

**[Use these special interrogatories if defendant is claiming that [his/her/its] use is descriptive fair use:**

[Name of defendant] used [name of plaintiff]’s trademark in a way other than as a trademark.

Answer Yes or No \_\_\_\_\_\_\_\_\_\_\_\_\_

If your answer is “Yes,” then go to the next question. If your answer is “No,” then go to the special interrogatories on Remedies in either the jury charges for Infringement of Registered Trademark or Infringement of an Unregistered Trademark.

[Name of defendant] used [name of plaintiff]’s trademark in a descriptive sense.

Answer Yes or No \_\_\_\_\_\_\_\_\_\_\_\_\_

If your answer is “Yes,” then go to the next question. If your answer is “No,” then go to the special interrogatories on Remedies in either the jury charges for Infringement of Registered Trademark or Infringement of an Unregistered Trademark.

[Name of defendant] used [name of plaintiff]’s trademark in good faith.

Answer Yes or No \_\_\_\_\_\_\_\_\_\_\_\_\_

If your answer is “Yes,” then your foreperson should sign and date the last page of this verdict form. If your answer is “No,” then go to the special interrogatories on Remedies in either the jury charges for Infringement of Registered Trademark or Infringement of an Unregistered Trademark.]

**[Use these special interrogatories if defendant asserts that plaintiff has abandoned [his/her/its] trademark through nonuse:**

[Name of plaintiff] has ceased using the trademark with the intent to not resume [his/her/its] use in the reasonably foreseeable future?

Answer Yes or No \_\_\_\_\_\_\_\_\_\_\_\_\_

If your answer is “Yes,” then your foreperson should sign and date the last page of this verdict form. If your answer is “No,” then go to the special interrogatories on Remedies in either the jury charges for Infringement of Registered Trademark or Infringement of an Unregistered Trademark.]

**[Use these special interrogatories if defendant asserts that plaintiff has abandoned [his/her/its] trademark through acts or omissions causing the mark to lose its significance as a mark:**

Because of [name of plaintiff]’s acts or omissions, the trademark no longer identifies the source of the goods but rather identifies the goods themselves?

Answer Yes or No \_\_\_\_\_\_\_\_\_\_\_\_\_

If your answer is “Yes,” then your foreperson should sign and date the last page of this verdict form. If your answer is “No,” then go to the special interrogatories on Remedies in either the jury charges for Infringement of Registered Trademark or Infringement of an Unregistered Trademark.]

**[Use these special interrogatories if defendant has asserted a counterclaim for cancellation of plaintiff’s registered trademark registration on the basis that plaintiff abandoned the trademark:**

[Name of plaintiff] has abandoned [his/her/its] trademark?

Answer Yes or No \_\_\_\_\_\_\_\_\_\_\_\_\_

If your answer is “Yes,” then your foreperson should sign and date the last page of this verdict form. If your answer is “No,” then go to the special interrogatories on Remedies in either the jury charges for Infringement of Registered Trademark or Infringement of an Unregistered Trademark.]

**[Use these special interrogatories if defendant asserts prior use under 15 U.S.C. § 1065 and plaintiff owns an incontestable registration:**

10. [Name of defendant] has used its mark in a particular geographic area since prior to the [name of plaintiff]’s use of its mark?

Answer Yes or No \_\_\_\_\_\_\_\_\_\_\_\_\_

If your answer is “Yes,” then go to the next question. If your answer is “No,” then go to the special interrogatories on Remedies in either the jury charges for Infringement of Registered Trademark or Infringement of an Unregistered Trademark.

11. [Name of defendant]’s use of its mark has been continuous in that geographic area?

Answer Yes or No \_\_\_\_\_\_\_\_\_\_\_\_\_

If your answer is “Yes,” your foreperson should sign and date the last page of this verdict form. If your answer is “No,” then go to the special interrogatories on Remedies in either the jury charges for Infringement of Registered Trademark or Infringement of an Unregistered Trademark.]

**[Use these special interrogatories if defendant asserts prior use under 15 U.S.C. § 1115(b)(5):**

12. [Name of defendant] has used its mark in a particular geographic area since prior to the [name of plaintiff]’s registration of its mark?

Answer Yes or No \_\_\_\_\_\_\_\_\_\_\_\_\_

If your answer is “Yes,” then go to the next question. If your answer is “No,” then go to the special interrogatories on Remedies in either the jury charges for Infringement of Registered Trademark or Infringement of an Unregistered Trademark.

13. [Name of defendant]’s use of its mark has been continuous in that that geographic area?

Answer Yes or No \_\_\_\_\_\_\_\_\_\_\_\_\_

If your answer is “Yes,” then go to the next question. If your answer is “No,” then go to the special interrogatories on Remedies in either the jury charges for Infringement of Registered Trademark or Infringement of an Unregistered Trademark.

14. [Name of defendant] adopted its mark without knowledge of [name of plaintiff]’s use of its mark?

Answer Yes or No \_\_\_\_\_\_\_\_\_\_\_\_\_

If your answer is “Yes,” your foreperson should sign and date the last page of this verdict form. If your answer is “No,” then go to the special interrogatories on Remedies in either the jury charges for Infringement of Registered Trademark or Infringement of an Unregistered Trademark.]

So Say We All.

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Foreperson’s Signature

Date: \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_