**ANNOTATIONS AND COMMENTS**

**Nominative and Descriptive Fair Use**

Descriptive fair use by the defendant of either the plaintiff’s trademark or the words making up the plaintiff’s trademark may be justified under either of two theories. First, Section 33 of the Lanham Act recognizes as a defense to the conclusive evidentiary presumption attaching to an incontestably registered trademark that a defendant is using a personal name “in his own business” or other words “fairly and in good faith only to describe the [associated] goods or services… or their geographic origin.” 15 U.S.C. § 1115 (2012). Second, the common law preserves defendants’ ability to use personal names and descriptive terms in their primary descriptive sense. *See generally KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 125 S. Ct. 542, 160 L. Ed. 2d 440 (2004); *Pure Foods, Inc. v. Minute Maid Corp.*, 214 F.2d 792 (5th Cir. 1954); *Creamette Co. v. Conlin*, 191 F.2d 108 (5th Cir. 1951).

Where infringement and unfair competition causes of action are concerned, nominative fair use is an extrastatutory doctrine recognized by the Eleventh Circuit and other courts. *See Univ. of Fla. v. KPB, Inc.*, 89 F.3d 773, 777 n.9 (11th Cir. 1996). In contrast, Section 43(c)(3) of the Lanham Act, 15 U.S.C. § 1125(c)(3) (2012), expressly recognizes nominative fair use as an “exclusion” from liability under the federal likelihood-of-dilution cause of action.

The Eleventh Circuit has not addressed the proper allocation of the parties’ respective burdens under the nominative fair use doctrine, and there is a split among other circuits on the issue. *Compare Century 21 Real Estate Corp. v. Lendingtree, Inc.*, 425 F.3d 211, 222-31 (3d Cir. 2005) (treating nominative fair use as affirmative defense), *and Rosetta Stone Ltd. v. Google, Inc.*, 676 F.3d 144, 169 (4th Cir. 2012) (same), *with Int’l Info. Sys. Sec. Certification Consortium, Inc. v. Sec. Univ., LLC*, 823 F.3d 153, 165 (2d Cir. 2016) (requiring plaintiff to demonstrate inapplicability of nominative fair use as part of its prima facie case), *and Toyota Motor Sales, U.S.A., Inc. v. Tabari,* 610 F.3d 1171, 1182-83 (9th Cir. 2010) (same). In the absence of Circuit law on the issue, the instructions treat nominative fair use as an affirmative defense to be proven by the defendant once liability has been demonstrated by the plaintiff. They do so because Section 43(c)(3) of the Lanham Act treats descriptive fair use and nominative fair use in identical fashion, and Section 33(b)(4) of the Act unambiguously identifies descriptive fair use as an affirmative defense to be proven by the defendant. *Cf.* *Wachovia Bank v. Schmidt*, 546 U.S. 303, 315-16 (2006) (“[S]tatutes addressing the same subject matter generally should be read ‘as if they were one law.’”) (quoting *Erlenbaugh v. United States*, 409 U.S. 239, 243 (1972)); *De Forest v. Lawrence*, 54 U.S. 274, 278 (1852) (“Where there are different statutes in *pari materia*, though made at different times, or even expired, and not referring to each other, they shall be taken and construed together as one system, and as explanatory of each other.”). This approach also is taken by American Bar Association Section of Litigation, *Model Jury Instructions: Copyright, Trademark and Trade Dress Litigation* (2008). In the absence of controlling circuit authority, however, these instructions do not purport to resolve the issue of the nature of the nominative fair use doctrine; rather, it is intended to provide guidance to the extent the doctrine is referred to a jury as an affirmative defense.

Again in the absence of Circuit case law, the required three showings by a defendant attempting to avail itself of nominative fair use are taken from *Int’l Info. Sys. Sec. Certification Consortium*, 823 F.3d at 168, *Toyota Motor Sales*,610 F.3d at 1175, and *Century 21 Real Estate Corp.*, 425 F.3d at 222.

**Prior Use**

The test for the prior use defense under Section 15 of the Lanham Act is taken from the statutory text, 15 U.S.C. § 1065 (2012) (“[E]xcept to the extent, if any, to which the use of a mark registered on the principal register infringes a valid right acquired under the law of any State or Territory by use of a mark or trade name continuing from a date prior to the date of registration under this chapter of such registered mark, the right of the owner to use such registered mark in commerce for the goods or services on or in connection with which such registered mark has been in continuous use for five consecutive years subsequent to the date of such registration and is still in use in commerce, shall be incontestable . . . .”). The test for the prior use defense under Section 33(b)(5) of the Lanham Act is taken from the statutory text, 15 U.S.C. § 1115(b)(5) (2012) (“[The] conclusive evidence of the right to use [a] registered mark [covered by an incontestable registration] . . . shall be subject to the . . . defense[] or defect[] . . . [t]hat the mark whose use by a party is charged as an infringement was adopted without knowledge of the registrant’s prior use and has been continuously used by such party or those in privity with him from a date prior to (A) the date of constructive use of the mark established pursuant to section 1057(c) of this title, (B) the registration of the mark under this chapter if the application for registration is filed before the effective date of the Trademark Law Revision Act of 1988, or (C) publication of the registered mark under subsection (c) of section 1062 of this title: Provided, however, That this defense or defect shall apply only for the area in which such continuous prior use is proved . . . .”)

**Abandonment**

The statutory basis of this defense is Section 33 of the Lanham Act, 15 U.S.C. § 1115 (2012). A finding that a trademark has been abandoned means that the plaintiff no longer has valid rights as of the date of abandonment. Nevertheless, because the plaintiff may have acquired new rights to its trademark by resuming the use of its trademark after the initial abandonment took place, a jury finding that a registration is subject to cancellation on this ground is not dispositive of the plaintiff’s rights, and the jury therefore evaluates whether the plaintiff has proven valid rights to the claimed trademark independent of the registration. The plaintiff’s resumption of a trademark’s use after abandonment will not allow the plaintiff to claim valid rights that date back to its original use; rather, the new rights will date only from the resumed use. *See generally AmBrit, Inc. v. Kraft, Inc.*, 812 F.2d 1531, 1549-50 (11th Cir. 1986).

Eleventh Circuit case law suggests that a defendant alleging that a plaintiff has abandoned its trademark faces a high burden: “[T]he burden a defendant bears on the affirmative defense of abandonment is, in fact, ‘strict.’ Because a finding of abandonment works an involuntary forfeiture of rights, federal courts uniformly agree that defendants asserting an abandonment defense face a ‘stringent,’ ‘heavy,’ or ‘strict burden of proof.’” *Cumulus Media, Inc. v. Clear Channel Commc’ns, Inc.*, 304 F.3d 1167, 1174 (11th Cir. 2002) (citation omitted) (footnote omitted); *see also Conagra, Inc. v. Singleton*, 743 F.2d 1508, 1516 (11th Cir. 1984) (“The defense of abandonment is one for which we require strict proof.”); *Citibank, N.A. v. Citibanc Grp.*, 724 F.2d 1540, 1545 (11th Cir. 1984) (affirming finding that defendants had failed to carry the “strict burden of proof applicable to abandonment claims”). The court has not, however, expressly held that abandonment must be shown by clear and convincing evidence.