**ANNOTATIONS AND COMMENTS**

A registration on the Principal Register that is less than five years old may be cancelled on any ground or grounds that would have prevented the registration’s issuance in the first place, which are set forth in Sections 1, 2, and 14 of the Lanham Act. *See* 15 U.S.C. §§ 1051, 1052, 1064 (2012) and *Int’l Order of Job’s Daughters v. Lindeburg & Co.*, 727 F.2d 1087, 1091 (Fed. Cir. 1984). Immediately upon the registration’s fifth anniversary of issuance, however, it may be cancelled only on the limited grounds set forth in Section 14 of the Lanham Act, regardless of whether the plaintiff has filed a declaration or affidavit of incontestability for its registration. 15 U.S.C. § 1064. *See Imperial Tobacco Ltd. v. Philip Morris, Inc.*, 899 F.2d 1575, 1579 n.5 (Fed. Cir. 1990); *Wallpaper Mfrs., Ltd. v. Crown Wallcovering Corp.*, 680 F.2d 755, 761 n.6 (C.C.P.A. 1981). When discussing grounds for cancellation, the annotations and comments to these instructions therefore indicate if particular grounds are available if the registration in question has reached its fifth anniversary of issuance. Also, this instruction may be modified if the trademark at issue is a service mark, certification mark, or trade dress.

Certain grounds for cancellation correspond to the prerequisites for trademark validity in the first instance, and invalidation of a registration based on them necessarily invalidates any rights to the registered trademark as well. Some of these same grounds are also expressly recognized as affirmative defenses to the evidentiary presumption of validity attaching to a federal registration under Section 33 of the Lanham Act, but, if they result in the registration’s invalidation, there is no need to address them in that context. 15 U.S.C. § 1115.

In contrast, certain other grounds for cancellation, even if proven, will *not* result in the invalidation of the underlying trademark, and it is therefore possible for the plaintiff to prove that it has rights to the trademark independent of the registration. These instructions therefore contemplate that a jury invalidating the plaintiff’s registration on one of the grounds falling into this category will need to conduct the same inquiry into the validity of the plaintiff’s trademark as if the plaintiff never had a registration.

Finally, certain of what otherwise are grounds for cancellation will be trumped by the trademark’s acquisition of distinctiveness, or “secondary meaning,” prior to the registration’s issuance. These instructions therefore distinguish between grounds to which a showing of acquired distinctiveness is relevant and those to which it is not. Where the former are concerned, the factors set forth for consideration in the acquired distinctiveness inquiry are drawn from *Tartell v. S. Fla. Sinus & Allergy Ctr.*, 790 F.3d 1253, 1257 (11th Cir. 2015); *Knights Armament Co. v. Optical Sys. Tech., Inc.*, 654 F.3d 1179, 1189 (11th Cir. 2011); *Am. Television & Commc’ns Corp. v. Am. Commc’ns & Television, Inc.*, 810 F.2d 1546, 1549 (11th Cir. 1987); *Conagra, Inc. v. Singleton*, 743 F.2d 1508, 1513 (11th Cir. 1984); and *Brooks Shoe Mfg. Co. v. Suave Shoe Corp.*, 716 F.2d 854, 860 (11th Cir. 1983). Under Sections 1- of the Lanham Act, use in commerce is a prerequisite for the registration of a trademark owned by a United States domiciliary. 15 U.S.C. § 1051 - (2012). The statutory basis of this ground for cancellation is Section 14 of the Act. *Id*. § 1064. This ground for cancellation may not be asserted against a registration that has reached its fifth anniversary of issuance or against a registration that issued under Section 44 or Section 66 of the Act. *Id*. §§ 1064-, 1126, 1141. The existence or nonexistence of acquired distinctiveness, or “secondary meaning,” is irrelevant to this ground for cancellation. *See id*. § 1052. And a defendant pursuing cancellation therefore need not prove the absence of acquired distinctiveness to prevail.

Cancellation of a registration on this ground does not prevent the former registrant from establishing rights to its trademark independent of the registration. A jury finding a registration subject to cancellation on this ground therefore should evaluate whether the plaintiff otherwise has proven valid rights to its trademark and, if so, when those rights arose.

The definitions of use in commerce bearing on this ground for cancellation are drawn from the statutory definition of use in commerce found in Section 45 of the Lanham Act, as well as from the U.S. Patent and Trademark Office’s internal operating guidelines and, in the case of certification trademarks, the Restatement of Unfair Competition. *See* 15 U.S.C. § 1127; United States Patent & Trademark Office, *Trademark Manual of Examining Procedure* §§ 1303.01, 1306.01-.03, 1304.08-.09 (2010); Restatement (Third) of Unfair Competition §§ 10-11 (1995). Eleventh Circuit opinions addressing the issue have done so in the context of the extent of use in commerce necessary to create common-law rights, but the underlying principles are the same. *See, e.g.*, *Planetary Motion, Inc. v. Techplosian, Inc.*, 261 F.3d 1188, 1193-2000 (11th Cir. 2001) (applying statutory definition of use in commerce and holding that nonmonetary transactions can create protectable rights); *Leigh v. Warner Bros.*, 212 F.3d 1210, 1217 (11th Cir. 2000) (requiring claimed trademark to be used in a manner recognizable as a trademark); *Geovision, Inc. v. Geovision Corp.*, 928 F.2d 387, 388-89 (11th Cir. 1991) (“[A] mere contract of sale without a product or mark is not within the statutory meaning of a sale.”); *Blue Bell, Inc. v. Farah Mfg. Co.*, 508 F.2d 1260, 1267 (5th Cir. 1975) (shipments of goods made only to create or to preserve trademark rights do not qualify as bona-fide uses in commerce).

The definitions of use in commerce bearing on this ground for cancellation depart from the express statutory definition of use in commerce in connection with goods to the extent that that definition fails to require use in interstate commerce or in commerce with a foreign country. *See* 15 U.S.C. § 1127. That requirement is incorporated into the instruction to maintain consistency with the requirements of trademark use in connection with services.

Section 5 of the Lanham Act, 15 U.S.C. § 1055 (2012), expressly recognizes the ability of a plaintiff to qualify for registration through the properly licensed use of registered trademark, and this principle has long been recognized by the law of the Circuit as well. *See generally Turner v. H M H Publ’g Co.*, 380 F.2d 224, 229 (5th Cir. 1967) (affirming validity of licensed service mark); *see also Planetary Motion, Inc. v. Techspolsion, Inc.*, 261 F.3d 1188, 1198 (11th Cir. 2001) (same); *Mini Maid Servs. Co. v. Maid Brigade Sys., Inc.*, 967 F.2d 1516, 1519 (11th Cir. 1992) (same); *Prof’l Golfers Ass’n of Am. v. Bankers Life & Cas. Co.*, 514 F.2d 665, 688 (5th Cir. 1975) (affirming validity of licensed collective mark).

**The Plaintiff lacked a bona-fide intent to use its trademark in commerce at a time the Plaintiff represented to the U.S. Patent and Trademark Office it had such an intent:**

The statutory basis of this ground for cancellation is Section 1 of the federal Lanham Act. 15 U.S.C. § 1051 (2012). It may not be asserted against a registration that has reached its fifth anniversary of issuance. *See id*. § 1064-. The existence or nonexistence of acquired distinctiveness, or “secondary meaning,” is irrelevant to this ground for cancellation and a defendant pursuing it therefore need not prove the absence of acquired distinctiveness to prevail. *See id*. § 1052.

Cancellation of a registration on this ground does not prevent the former registrant from establishing rights to its trademark independent of the registration. A jury finding a registration subject to cancellation on this ground therefore should evaluate whether the plaintiff otherwise has proven valid rights to its trademark and, if so, when those rights arose.

The Eleventh Circuit has not addressed the issue of what is necessary for a bona fide intent to use an applied-for trademark, but the Trademark Trial and Appeal Board has held that the inquiry is an objective one that ordinarily requires the applicant to produce documentary evidence predating the application’s filing date. *See Spirits Int’l B.V. v. S.S. Taris Zeytin Ve Zeytinyagi Tarim satis Kooperatiferi Birligi*, 99 U.S.P.Q.2d 1545, 1549 (T.T.A.B. 2011); *SmithKline Beecham Corp. v. Omnisource DDS LLC*, 97 U.S.P.Q.2d 1300, 1305 (T.T.A.B. 2010); *see also* S. Rep. No. 100-515, at 23 (1988), *reprinted in* 1988 U.S.C.C.A.N. 5577, 5587 (“In connection with the [Lanham Act’s intent-to-use provisions], ‘bona fide’ should be read to mean a fair, objective determination of the applicant’s intent based on all the circumstances.”). Under the Board’s case law: the registrant bears an initial burden of producing contemporary documentary evidence of a bona fide intent to use its trademark in connection with the goods and services covered by the application; but, if the registrant satisfies its burden of production, the burden of proof reverts to the party challenging the validity of the registration. *See Boston Red Sox Baseball Club L.P. v. Sherman*, 88 U.S.P.Q.2d 1581, 1587-88 (T.T.A.B. 2008); *SmithKline Beecham Corp.*, 97 U.S.P.Q.2d at 1305.

**The registered trademark is a generic designation for the goods or services covered by the registration:**

The statutory basis of this ground for cancellation is Section 14 of the Lanham Act, which also contains the statutory definition of genericness found in the last paragraph of the instruction. 15 U.S.C. § 1064 (2012). It may be asserted against a registration that has reached the fifth anniversary of its issuance. *See* 15 U.S.C. § 1064(3). The existence or nonexistence of acquired distinctiveness, or “secondary meaning,” is irrelevant to this ground for cancellation, and a defendant pursuing it therefore need not prove the absence of acquired distinctiveness to prevail. *See id*. § 1052.

A finding that a registered trademark is generic means that the trademark cannot be protected *as* a trademark, and a jury finding a registration subject to cancellation on this ground therefore should not evaluate whether the plaintiff has proven valid rights to the claimed trademark independent of the registration. *See Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768, 112 S. Ct. 2753, 2757, 120 L. Ed. 2d 615 (1992). Under limited circumstances, however, a defendant’s use of a former trademark that has become generic can lead to liability for the tort of passing off. *See, e.g.*, *Kellogg Co. v. Nat’l Biscuit Co.*, 305 U.S. 111, 120, 59 S. Ct. 109, 114, 83 L. Ed. 2d. 73 (1938) (use of a generic designation by a defendant must “be done in a manner which reasonably distinguishes its product from that of a plaintiff”).

The examples of generic designations set forth in this instruction are drawn from *Welding Servs., Inc. v. Forman*, 509 F.3d 1351, 1358, 1359 n.4 (11th Cir. 2007); *Investacorp, Inc. v. Arabian Inv. Banking Corp. (Investcorp) E.C.*, 931 F.2d 1519, 1522 (11th Cir. 1991); and *Vision Ctr. v. Opticks, Inc.*, 596 F.2d 111, 115 (5th Cir. 1979).

**If the registered trademark is a conventional trademark, the trademark is descriptive of the goods or services covered by the registration, and lacked acquired distinctiveness as of the registration date:**

The statutory basis of this ground for cancellation is Section 2 of the Lanham Act, 15 U.S.C. § 1052 (2012). It may not be asserted against a registration that has reached the fifth anniversary of its issuance. *See id*. § 1064-. Because descriptive trademarks may be registered with a showing of acquired distinctiveness, or “secondary meaning,” a defendant pursuing this ground for cancellation bears the burden of demonstrating by a preponderance of the evidence and testimony that the registered trademark did not enjoy acquired distinctiveness as of that date. *See id*. § 1052. The fact that another person has copied another’s mark, in and of itself, does not satisfy a party’s burden of proof and automatically establish that such mark has acquired a secondary meaning. In affirming a finding of no secondary meaning, one panel of the Eleventh Circuit has held that “[a]lthough we believe that proof of intentional copying is probative evidence on the secondary meaning issue, we cannot agree with [the plaintiff] that proof of intentional copying conclusively establishes that [plaintiff’s] trademark or tradedress has acquired secondary meaning.” *Brooks Shoe Mfg. Co. v. Suave Shoe Corp.*, 716 F.2d 854, 860 (11th Cir. 1983); *see also CPG Prods. Corp. v. Pegasus Luggage, Inc.*, 776 F.2d 1007, 1012 (Fed. Cir. 1985) (concluding, in application of Eleventh Circuit law, that “[e]vidence of intentional copying in this case, also supports a finding of secondary meaning.”). Because neither the Eleventh Circuit nor the Federal Circuit has addressed the precise role played by intentional copying in the secondary meaning inquiry, these instructions adopt the four-factor test most commonly applied by the courts.

Cancellation of a registration on this ground does not prevent the former registrant from establishing rights to its trademark independent of the registration. A jury finding a registration subject to cancellation on this ground therefore should evaluate whether the plaintiff otherwise has proven valid rights to its trademark and, if so, when those rights arose.

The examples of descriptive trademarks set forth in the instruction bearing on this ground for cancellation are drawn from *Knights Armament Co. v. Optical Sys. Tech., Inc.*, 654 F.3d 1179, 1188 (11th Cir. 2011); *Investacorp, Inc. v. Arabian Inv. Banking Corp.*, 931 F.2d 1519, 1522-24 (11th Cir. 1990); *Am. Television & Commc’ns Corp. v. Am. Commc’ns & Television, Inc.*, 810 F.2d 1546, 1549 (11th Cir. 1987); and *Beneficial Indus. Loan Corp. v. Allenstein*, 173 F.2d 38, 40 (5th Cir. 1949).

**If the registered trademark is a trade dress, the trademark is not an inherently distinctive indicator of the origin of the goods or services covered by the registration and lacked acquired distinctiveness as of the registration date:**

The statutory basis of this ground for cancellation is Section 2 of the Lanham Act, 15 U.S.C. § 1052 (2012). It may not be asserted against a registration that has reached the fifth anniversary of its issuance. *See id*. § 1064-. Because noninherently distinctive trademarks may be registered with a showing of acquired distinctiveness, or “secondary meaning,” a defendant pursuing this ground for cancellation bears the burden of demonstrating by a preponderance of the evidence and testimony that the registered trademark did not enjoy acquired distinctiveness as of that date. *See id*. § 1052.

Cancellation of a registration on this ground does not prevent the former registrant from establishing rights to its trademark independent of the registration. A jury finding a registration subject to cancellation on this ground therefore should evaluate whether the plaintiff otherwise has proven valid rights to its trademark and, if so, when those rights arose.

The test for distinguishing between inherently distinctive and noninherently distinctive trademarks in the instruction bearing on this ground for cancellation is taken from *Brooks Shoe Mfg. Co. v. Suave Shoe Corp.*, 716 F.2d 854, 857-58 (11th Cir. 1983), and has its origin in *Seabrook Foods, Inc. v. Bar-Well Foods, Ltd.*, 568 F.2d 1342, 1344 (C.C.P.A. 1977). In *AmBrit, Inc. v. Kraft, Inc.*, 812 F.2d 1531 (11th Cir. 1986), the court declined to disturb the district court’s reliance on the *Seabrook* factors in finding a claimed trade dress to be inherently distinctive, although the court also invoked the four-tiered spectrum of distinctiveness this instruction proposes for conventional trademarks, service marks, collective marks, and certification marks. *See id*. at 1347; *see also Univ. of Fla. v. KPB, Inc.*, 89 F.3d 773, 776 n.4 (11th Cir. 1996) (noting use of both tests in prior case law). Because there is no necessary inconsistency between the two tests, this instruction is not intended to foreclose application of the spectrum-of-distinctiveness test in actions to protect claimed trade dresses.

**The registered trademark is primarily geographically descriptive of the goods or services covered by the registration and lacked acquired distinctiveness as of the registration date**

The statutory basis of this ground for cancellation is Section 2 of the Lanham Act, 15 U.S.C. § 1052 (2012). It may not be asserted against a registration that has reached the fifth anniversary of its issuance. *See id*. § 1064-. Because primarily geographically descriptive trademarks may be registered with a showing of acquired distinctiveness, or “secondary meaning,” a defendant pursuing this ground for cancellation bears the burden of demonstrating by a preponderance of the evidence and testimony that the registered trademark did not enjoy acquired distinctiveness as of that date. *See id*. § 1052.

Cancellation of a registration on this ground does not prevent the former registrant from establishing rights to its trademark independent of the registration. A jury finding a registration subject to cancellation on this ground therefore should evaluate whether the plaintiff otherwise has proven valid rights to its trademark and, if so, when those rights arose.

The examples of primarily geographically descriptive marks set forth in this instruction are drawn from *Elgin Nat’l Watch Co. v. Ill. Watch Case Co.*, 179 U.S. 665, 21 S. Ct. 270, 45 L. Ed. 365 (1901); *Canal Co. v. Clark*, 80 U.S. (13 Wall.) 311, 20 L. Ed. 581 (1872); and *Int’l Breweries, Inc. v. Anheuser-Busch, Inc.*, 364 F.2d 262, 262-63 (5th Cir. 1966). The example of a trademark that is not primarily geographically descriptive is drawn from *World Carpets, Inc. v. Dick Littrell’s New World Carpets*, 438 F.2d 482, 485 (5th Cir. 1971).

**The registered trademark is primarily merely a surname and lacked secondary meaning as of the registration date:**

The statutory basis of this ground for cancellation is Section 2 of the Lanham Act, 15 U.S.C. § 1052 (2012). It may not be asserted against a registration that has reached its fifth anniversary of issuance. *See id*. § 1064-. Because surnames may be registered with a showing of acquired distinctiveness, or “secondary meaning,” a defendant pursuing this ground for cancellation bears the burden of demonstrating by a preponderance of the evidence and testimony that the registered trademark did not enjoy acquired distinctiveness as of that date. *See id*. § 1052.

Cancellation of a registration on this ground does not prevent the former registrant from establishing rights to its trademark independent of the registration. A jury finding a registration subject to cancellation on this ground therefore should evaluate whether the plaintiff otherwise has proven valid rights to its trademark and, if so, when those rights arose.

The examples of surnames in the instruction bearing on this ground for cancellation are drawn from *Conagra, Inc. v. Singleton*, 743 F.2d 1508, 1513 (11th Cir. 1984); and *Investacorp, Inc. v. Arabian Inv. Banking Corp. (Investcorp) E.C.*, 931 F.2d 1519, 1522 (11th Cir. 1991)

**The registered trademark comprises matter that, as a whole, is functional:**

The statutory basis of this ground for cancellation are Sections 2 and 14 of the Lanham Act, 15 U.S.C. §§ 1052 & 1064 (2012). It may be asserted against a registration that has reached the fifth anniversary of its issuance. *See* 15 U.S.C. § 1064. The existence or nonexistence of acquired distinctiveness, or “secondary meaning,” is irrelevant to this ground for cancellation, and a defendant pursuing it therefore need not prove the absence of acquired distinctiveness to prevail. *See id*. § 1052.

A finding that a registered trademark is functional means that the trademark cannot be protected *as* a trademark, and a jury finding a registration subject to cancellation on this ground therefore should not evaluate whether the plaintiff has proven valid rights to the claimed trademark independent of the registration. *See Dippin’ Dots, Inc. v. Frosty Bites Distrib., LLC*, 369 F.3d 1197, 1206-07 (11th Cir. 2004). Under limited circumstances, however, a defendant’s use of a functional designation can lead to liability for the tort of passing off. *See, e.g.*, *Kellogg Co. v. Nat’l Biscuit Co.*, 305 U.S. 111, 120, 59 S. Ct. 109, 120, 83 L. Ed. 2d 73 (1938).

The functionality doctrine prevents trademark law, which seeks to promote competition, from instead inhibiting legitimate competition. *See TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 32-33, 121 S. Ct. 1255, 1261-62 149 L. Ed. 2d 164 (2001); *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 164, 115 S. Ct. 1300, 1304, 131 L. Ed. 2d 248 (1995); *Dippin’ Dots*, 369 F.3d at 1202-03; *Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571, 1579-80 (Fed. Cir. 1995) (applying Eleventh Circuit law); *AmBrit, Inc. v. Kraft, Inc.*, 812 F.2d 1531, 1538 (11th Cir. 1986). The requirement that a trademark be nonfunctional in the utilitarian sense is often regarded as necessary to maintain the distinction between possibly perpetual trademark protection and the temporally limited protection available under federal utility patent law. *See TrafFix Devices*, 532 U.S. at 34, 121 S. Ct. at 1262, 149 L. Ed. 2d 164 (“The Lanham Act does not exist to reward manufacturers for their innovation in creating a particular device; that is the purpose of the patent law and its period of exclusivity.”).

At least some Circuit case law, however, suggests that the requirement has constitutional dimensions. *See, e.g.*, *Wilhelm Pudenz GmbH v. Littlefuse, Inc.*, 177 F.3d 1204, 1208 (11th Cir. 1999) (“[W]hen the operation of the Lanham Act would upset the balance struck by the Patent Act, the Lanham Act must yield. The functionality doctrine serves this purpose by eliminating the possibility of a perpetual exclusive right to the utilitarian features of a product under trademark law, which would be impossible (as well as unconstitutional) under the Patent Act.”); *cf. B.H. Bunn Co. v. AAA Replacement Parts Co.*, 451 F.2d, 1254, 1254, 1258-59 (5th Cir. 1971) (“It runs counter to federal purposes, and perhaps borders on the unconstitutional, for a state to prolong or to create any trade monopoly, to an originator [of a useful article] by forbidding the production of copies under the rubric of unfair competition.”).

This instruction bearing on this ground for cancellation contemplates two different tests for functionality. The first test is most commonly applied when the claim of functionality or nonfunctionality bears on the utilitarian characteristics of the trademark sought to be protected. It has its origins in the Court of Customs and Patent Appeals’ decision in *In re Morton-Norwich Prods.*, 671 F.2d 1332, 1336 (C.C.P.A. 1982), and is consistent with the approach taken by such decisions as *Dippin’ Dots*, 369 F.3d at 1203, *Elmer*, 67 F.3d at 1579-80 (applying Eleventh Circuit law), and *J.R. Clark Co. v. Murray Metal Prods. Co.*, 219 F.2d 313, 320 (5th Cir. 1955). The second test is most commonly applied when the claim of functionality or nonfunctionality bears on the aesthetic characteristics of the trademark sought to be protected. *See Dippin’ Dots*, 369 F.3d at 1203 (“[T]he second test… is commonly called the competitive necessity test and generally applied in cases of aesthetic functionality…”). It has its origins in *Qualitex*, 514 U.S. at 164, 115 S. Ct. at 1304, 131 L. Ed. 2d 248. The two are not mutually exclusive, and, indeed, some courts have applied both in the same litigation. *See, e.g.*, *Dippin’ Dots*, 369 F.3d at 1203-04, 1206-07.

**The registered trademark has been abandoned through non-use or failure to police:**

The statutory basis of this ground for cancellation is Section 14 of the Lanham Act, 15 U.S.C. § 1064 (2012). It may be asserted against a registration that has reached the fifth anniversary of its issuance. *See id*. § 1064. The existence or nonexistence of acquired distinctiveness, or “secondary meaning,” is irrelevant to this ground for cancellation, *see id*. § 1052, and a defendant pursuing it therefore need not prove the absence of acquired distinctiveness to prevail.

A finding that a registered trademark has been abandoned means that the registration is subject to cancellation and 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 evaluate 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.

**The registered trademark has been abandoned through uncontrolled, or “naked,” licensing:**

The statutory basis of this ground for cancellation is Section 14 of the Lanham Act, 15 U.S.C. § 1064 (2012). It may be asserted against a registration that has reached the fifth anniversary of its issuance. *See id*. Cancellation of a registration on this ground prevents the former registrant from establishing valid rights to its mark as of the date of abandonment but does not prevent the plaintiff from potentially cultivating new rights dating from its resumption of the mark’s use.

Few courts have addressed the issue of abandonment through uncontrolled licensing in the registration context. Outside of that context, however, the invalidation of rights under this theory requires a showing that the trademark owner failed to exercise control over the nature and quality of the goods provided by the licensee under the licensor’s mark. *See generally Eva’s Bridal Ltd. v. Halanick Enters.*, 639 F.3d 788 (7th Cir. 2011); *FreecycleSunnyvale v. Freecycle Network*, 626 F.3d 509 (9th Cir. 2010). Thus, for example, in *Crystal Entm’t & Filmworks, Inc. v. Jurado*, 643 F.3d 1313 (11th Cir. 2011), although not referring to the naked license doctrine by name, the court affirmed a finding that the defendants, although once licensees of the plaintiff, had become the owners of the service mark covered by the license because they, rather than the licensor, controlled the quality of the services provided under it. *See id*. at 1323.

This ground for cancellation may not be available in cases in which the licensee is the party asserting it, unless the conduct underlying the assertion of the ground occurred after the expiration of the license. *See generally Prof’l Golfers Ass’n v. Bankers Life & Cas. Co.*, 514 F.2d 665, 671 (5th Cir. 1975).

**The registration of the trademark was procured or maintained fraudulently:**

The statutory basis of this ground for cancellation is Section 14 of the Lanham Act, 15 U.S.C. § 1064 (2012); although that statute expressly authorizes the cancellation “at any time” only of registrations that were “obtained fraudulently,” interpretations of it have held that it reaches the maintenance of registrations through fraudulent filings. *See, e.g., Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 48 (Fed. Cir. 1986) (upholding cancellation of fraudulently renewed, rather than fraudulently obtained, registration on ground that “[f]raud in obtaining renewal of a registration amounts to fraud in obtaining a registration within the meaning of [15 U.S.C. § 1064].”). This ground for cancellation may be asserted against a registration that has reached the fifth anniversary of its issuance. *See* 15 U.S.C. § 1064. The existence or nonexistence of acquired distinctiveness, or “secondary meaning,” is irrelevant to this ground for cancellation, and a defendant pursuing it therefore need not prove the absence of acquired distinctiveness to prevail. *See id*. § 1052.

Cancellation of a registration on this ground does not prevent the former registrant from establishing rights to its trademark independent of the registration. A jury finding a registration subject to cancellation on this ground therefore should evaluate whether the plaintiff otherwise has proven valid rights to its trademark and, if so, when those rights arose.

The test set forth in this instruction is drawn from *Angel Flight of Ga., Inc. v. Angel Flight Am., Inc.*, 522 F.3d 1200, 1210 (11th Cir. 2008) and *Citibank, N.A. v. Citibanc Grp.*, 724 F.2d 1540, 1544-45 (11th Cir. 1984).