**15.22 Defenses—Abandonment—Affirmative Defense—Defendant’s Burden of Proof
(15 U.S.C. § 1127)**

 The [owner] [assignee] [licensee] of a trademark cannot exclude others from using the trademark if it has been abandoned.

 The defendant contends that the trademark has become unenforceable because the [owner] [assignee] [licensee] abandoned it. The defendant has the burden of proving abandonment by [clear and convincing] [a preponderance of the] evidence.

 The [owner] [assignor] [licensor] of a trademark abandons the right to exclusive use of the trademark when the [owner] [assignor] [licensor] does any one of the following:

First, discontinues its [good faith] use in the ordinary course of trade, intending not to resume using it;

Second, [acts] [or] [fails to act] so that the trademark’s [primary significance] [primary meaning] [principal significance] [principal meaning] to prospective consumers has become the [good] itself and not the [producer of the good]; or

Third, fails to exercise adequate quality control over the [goods] sold under the trademark by a licensee.

**Comment**

 Abandonment is defined in 15 U.S.C. § 1127, paragraph 16. *See also* 3 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 17:18 (5th ed. 2019); *Electro Source, LLC v. Brandess-Kalt-Aetna Grp., Inc.*, 458 F.3d 931, 938 (9th Cir. 2006) (“[A]bandonment requires *complete* cessation or discontinuance of trademark use.”). Abandonment “is generally a factual issue.” *Id.* at 937. As to abandonment by uncontrolled or “naked” licensing, *see Barcamerica Int’l USA Trust v. Tyfield Imps., Inc.*, 289 F.3d 589, 595-96 (9th Cir. 2002).

 The defendant has the burden of proving abandonment. Evidence of non-use of the mark for three consecutive years is prima facie evidence of abandonment. *See* 15 U.S.C. § 1127; *Abdul-Jabbar v. Gen. Motors Corp*., 85 F.3d 407, 411-12 (9th Cir. 1996) (holding that prima facie showing of abandonment creates only a rebuttable presumption of abandonment). When the defendant proves the necessary consecutive years of non-use, the burden shifts to the plaintiff to go forward with evidence to prove that circumstances do not justify the inference of intent not to resume use. *Exxon Corp. v. Humble Expl. Co.*, 695 F.2d 96, 99 (5th Cir. 1983).

 No Ninth Circuit case establishes the standard of proof required to prove abandonment as between “clear and convincing” and “preponderance.” *See Electro Source, LLC*, 458 F.3d at 935 n.2 (noting that defendant, “as the party asserting abandonment, is required to ‘strictly prove’ its claim. . . . We do not need to flesh out the contours of the ‘strict proof’ standard because our resolution of this summary judgment appeal rests on the proper legal construction of § 1127.”) (collecting other “strict proof” cases); *Grocery Outlet, Inc. v. Albertson’s Inc.*, 497 F.3d 949, 951 (9th Cir. 2007) (stating that because appellant waived its challenge to clear and convincing standard, the Ninth Circuit “need not resolve the burden of proof issue”). Except for the Federal Circuit’s view that in inter-partes proceedings before the Trademark Trial and Appeal Board preponderance of the evidence is the standard of proof, “all” courts follow a clear and convincing standard of proof of abandonment. *See* McCarthy, *supra*, § 17:12.

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