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LITIGATING THE MEANING OF “PRIMA FACIE EVIDENCE” UNDER THE LANHAM ACT: THE FOG AND ART OF WAR

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[T]he great uncertainty of all data in war is a peculiar difficulty, because all action must, to a certain extent, be planned in a mere twilight, which in addition not infrequently—like the effect of a fog or moonshine—gives to things exaggerated dimensions and an unnatural appearance.

– Carl von Clausewitz

The Skillful Warrior attacks so that the enemy cannot defend; he defends so that the enemy cannot attack.

– Sun Tzu

I. INTRODUCTION

Litigants seeking to benefit from prima facie evidence can find it difficult to implement Sun Tzu’s advice from The Art of War. This is because a litigant’s decision to “attack” or “defend” varies with the type of case and the forum in which an action is pending. In some jurisdictions and in some contexts, the introduction of prima facie evidence will discharge the proffering party’s obligation to establish its case and will shift the burden of proof to its adversary. In other jurisdictions and contexts, however, prima facie evidence merely shifts the burden of production, thereby creating a presumption that vanishes once the opposing party produces credible evidence inconsistent with the proffering party’s showing.

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The authors gratefully acknowledge the editorial contributions of Mary Kathryn Hagge, as well as the assistance of Louise Adams, Jennifer Elrod, Trevor Rosen, Kimberly Snoddy-George, and Christy Flagler in preparing this article for publication.


The proper significance of prima facie evidence is of particular concern to trademark litigants in the United States because the concept was codified in 1946 in a number of sections of the Lanham Act, and because courts interpreting those sections have reached fundamentally inconsistent conclusions on the issue of whether the establishment of a prima facie case under the Act results in a shift in the burden of proof or a shift in the burden of production: Indeed, this fog of doctrinally irreconcilable holdings has produced both inter- and intra-circuit conflicts that merit resolution either by the Supreme Court or through legislative action.

This article examines the rules of engagement and the battlefield for litigants seeking either to avail themselves of the various forms of prima facie evidence recognized by the Lanham Act, or, alternatively, to respond to the submission of prima facie evidence by their adversaries. Part II of this article briefly addresses the traditional distinction between the burden of proof and the burden of production. Part III surveys the split between and within federal courts on the issue of whether the submission of prima facie evidence under the Act allows the proffering party to play defense or whether that party must remain on the attack if its adversary merely produces some evidence to the contrary. Finally, Part IV addresses the proper meaning of prima facie evidence under the Act. It argues that the submission of prima facie evidence should result in a shift in the burden of proof (and not merely of production), because such a shift is mandated by the Act’s express text and by unmistakable congressional intent and because the Supreme Court’s decision in Microsoft Corp. v. i4i Ltd. Partnership precludes the contrary result.

II. THE RULES OF ENGAGEMENT

As a threshold matter, a brief word on the distinction between the concepts of “burden of proof” and “burden of production” is in order. As to the former, which is also referred to as the “burden of persuasion,” the default common-law rule is that “[t]he burdens of pleading and proof with regard to most facts have been and should be assigned to the plaintiff who generally seeks to change the present state of affairs and who therefore naturally should be expected to bear the risk of failure of proof or persuasion.” A party

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Consistent with the Supreme Court’s most recent treatment of the issue, see i4i, 131 S. Ct. at 2245 n.4, this Article uses “burden of proof” in its most commonly understood “burden of persuasion” sense unless otherwise noted.
assigned the burden of proof must establish the key elements of its case through its satisfaction of an underlying “standard” of proof:

The term “standard of proof”... refer[s] to the degree of certainty by which the factfinder must be persuaded of a factual conclusion to find in favor of the party bearing the burden of persuasion. In other words, the term “standard of proof” specifies how difficult it will be for the party bearing the burden of persuasion to convince the jury of the facts in its favor. Various standards of proof are familiar—beyond a reasonable doubt, by clear and convincing evidence, and by a preponderance of the evidence.6

Despite these straightforward propositions, the United States Supreme Court has labeled the burden of proof “one of ‘the slipperiest member[s] of the family of legal terms.’”7 This is in part because “[h]istorically, the term has encompassed two separate burdens: the ‘burden of persuasion’ (specifying which party loses if the evidence is balanced), as well as the ‘burden of production’ (specifying which party must come forward with evidence at various stages in the litigation).”8 The latter burden requires a party bearing it only to produce some credible evidence inconsistent with the case of the party with the burden of proof.9 If no such evidence is produced, judgment may be entered against the party obligated to produce it.10 If the burden of production is carried, however, the party with the burden of proof must then present its own case, and in doing so retains the ultimate obligation to persuade the finder of fact of the merits of that case.11

The relationship between the burden of proof and the burden of production can be complicated in particular cases by the application of rebuttable “presumptions” in favor of one litigant or the other.12 “Once the basic facts supporting [a] rebuttable

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6. Id. (citation omitted).
8. i4i, 131 S. Ct. at 2245 n.4.
10. As Professor James has explained in his excellent discussion of the burden of proof, the burden of production, and the nature of presumptions:

[T]he consequence of failure to produce evidence—or sufficient evidence—is loss of the case. This loss is brought about by means of the procedural device of nonsuit, directed verdict, or dismissal. Each of these is an order made by the court either on motion of a party or on its own motion after the proponent has rested its case, i.e., has indicated that he has put in all the evidence upon the issue which he intends to—which may of course be no evidence at all.

12. According to Professor James, presumptions are properly understood to involve relationships between a proven or admitted fact or group of facts and another fact or
presumption are established, the existence of the presumed fact will be assumed until the opposing party meets a specific burden to challenge the existence of the presumed fact.” Federal Rule of Evidence 301, adopted in 1975, explains the burden-shifting effect of this type of presumption in the following manner:

In all civil actions and proceedings not otherwise provided for by Act of Congress or by these rules, a presumption imposes on the party against whom it is directed the burden of going forward with evidence to rebut or meet the presumption, but does not shift to such party the burden of proof in the sense of the risk of nonpersuasion, which remains throughout the trial upon the party on whom it was originally cast.14

FRE 301’s treatment of presumptions as shifting only the burden of production has had increasing significance to the proper meaning of prima facie evidence under the Lanham Act in recent years. Nevertheless, as reflected in the rule’s express exclusion of “all civil actions and proceedings not otherwise provided for by Act of Congress or by these rules,” that treatment does not reflect the only possible view of presumptions,15 and, indeed, presumptions conclusion of fact which is sought to be proven. An example would be a presumption of receipt of a letter following proof that the letter was properly mailed. See James, supra note 10, at 63.

In addition to rebuttable presumptions, federal law also recognizes irrebuttable presumptions, which are per se true as legal matters because by definition no showing by adversely affected parties can overcome them. See generally Kenneth A. Klukowski, Severability Doctrine: How Much of a Statute Should Federal Courts Invalidate?, 16 Tex. Rev. L. & Pol. 1, 83-84 (2011). Unless otherwise noted, references to presumptions in this Article are to rebuttable presumptions.

14. Fed. R. Evid. 301 (“FRE 301”); see also A.C. Aukerman Co. v. R.L. Chaides Constr. Co., 960 F.2d 1020, 1037 (Fed. Cir. 1992) (noting that “presumption is not merely rebuttable but completely vanishes upon the introduction of evidence sufficient to support a finding of the nonexistence of the presumed fact”); Saratoga Vichy Spring Co. v. Lehman, 625 F.2d 1037, 1043 (2d Cir. 1980) (“[A] rebuttable presumption . . . disappears in the face of contrary evidence or permits the trier to infer intent to abandon, despite contrary evidence.”).
15. One commentator has accurately observed that “[p]resumptions, while ubiquitous in the law, vary widely in application. Indeed, the use of the term ‘presumption’ has been inexact in the law. No single rule is able to capture the entire universe of what courts and legislatures have dubbed ‘presumptions.’” Timothy R. Holbrook, Patents, Presumptions, and Public Notice, 86 Ind. L.J. 779, 815-16 (2011) (footnotes omitted); see also Kaitlin Niccum, Ethics and Presumptions: Lying to Burst the Bubble, 25 Geo. J. Legal Ethics 715, 716 (2012) (“The confusion surrounding presumptions is so profound that one scholar stated ‘every writer of sufficient intelligence to appreciate the difficulties of the subject-matter has approached the topic of presumptions with a sense of hopeless and has left it with a feeling of despair.’” (quoting Edmund M. Morgan, Presumptions, 12 Wash. L. Rev. 255, 255 (1937)); Jerome A. Hoffman, Thinking About Presumptions: The “Presumption” of Agency From Ownership as Study Specimen, 48 Ala. L. Rev. 885, 895-96 (1997) (“One wishes one could say that a presumption is a presumption, a mental operation of uniform and invariable characteristics. Unfortunately, the literature does not support an assertion of such elegant and manageable simplicity.”).
historically have meant “many different things.” \(^{16}\) Professor Thayer therefore cautioned even as early as 1890 that “[i]t must be firmly held in mind that rules of presumption are adopted for a variety of reasons; that they are not fixed merely with reference to litigation and procedure, but are a part of the machinery for the general administration of justice.” \(^{17}\) In particular, because “the policies underlying a particular presumption govern the measure of persuasion required to escape its effect,” \(^{18}\) some rebuttable presumptions have been held to shift the burden of proof, rather than production. \(^{19}\) For advocates of that view of presumptions, “[i]f a policy is strong enough to call a presumption into existence, it is hard to imagine it so weak as to be satisfied by the bare recital of words . . . or the reception in evidence of a writing.” \(^{20}\) It is therefore apparent that “one cannot discern much from the standard for rebuttal of presumptions by looking at the federal decisions

\(^{16}\) James, *supra* note 10, at 63. As of 1961, those “many different things” could consist of:

- the so-called orthodox view [under which a presumption shifts only the burden of production];
- a presumption puts on the opponent the burden of persuading the jury “to believe so much of the evidence against the presumed fact as would justify a reasonable jury in finding that fact.”
- (3) It disappears when opponent puts in evidence upon which the trier’s mind is in equipoise, if that evidence “is of the requisite quantity and quality to justify a reasonable jury in finding the nonexistence of the presumed fact.”
- (4) It puts on opponent “the burden of persuading the jury that the existence of the presumed fact is so doubtful that the jury cannot determine whether it exists.”
- (5) It puts on opponent “the burden of persuading the jury that the presumed fact does not exist.”
- (6) In addition to having one of the foregoing effects, the presumption is to be weighed by the jury together with the evidence in the case.
- (7) It may simplyallow an inference of \(B\) from \(A\) when the ordinary rules of proof would not allow it.
- (8) It may compel the finding of \(B\), unconditionally, if \(A\) is found (the conclusive presumption).

Id. at 69 n.99 (quoting Edmund M. Morgan, *Instructing the Jury Upon Presumptions and Burden of Proof*, 47 Harv. L. Rev. 59, 60-62 (1933)).

\(^{17}\) James B. Thayer, *The Burden of Proof*, 4 Harv. L. Rev. 45, 64-65 (1890).


\(^{19}\) See, e.g., Concrete Pipe & Prods. of Cal. Inc. v. Constr. Laborers Pension Trust, 508 U.S. 602, 621 (1993) (“It is clear that the presumption favoring determinations of the plan sponsor shifts a burden of proof or persuasion to the employer.”); Bi Xia Qu v. Holder, 618 F.3d 602, 606 (10th Cir. 2010) (“An applicant [for political asylum] who establishes that she has suffered past persecution is presumed to have a well-founded fear of future persecution. The government may rebut this presumption by showing, by a preponderance of the evidence, that conditions in the country have changed so fundamentally that the applicant no longer has a well-founded fear of future persecution.”); James v. River Parishes Co., 686 F.3d 1129, 1132-33 (5th Cir. 1982) (rejecting defendant’s reliance on FRE 301 in favor of application of burden-of-proof-shifting presumption).

holding the evidence sufficient or insufficient to rebut a presumption.”21 Litigants entering the battlefield therefore must either attack or defend their position according to their assigned burdens, keeping in mind the presumptions that may complicate their positions.

III. THE BATTLEFIELD

A. Establishing Protectable Rights Through Prima Facie Evidence

1. The Statutory Framework

A plaintiff seeking to protect a common-law mark not covered by a registration on the Principal Register of the United States Patent and Trademark Office (USPTO) bears the burden of proving the mark’s validity, as well as its ownership of the mark.22 As one court has explained, “[u]nregistered marks have no presumption of validity . . . . Thus, a plaintiff must prove that an unregistered mark is valid and protectable.”23 Moreover, the same is true if the plaintiff owns such a registration but fails to introduce it into evidence24 or if its registration is merely on the USPTO’s Supplemental Register.25

The Lanham Act nevertheless allows trademark claimants several opportunities to use prima facie evidence to establish the validity of their marks. For example, Section 2(f) applies in the registration context and codifies the proposition that the USPTO

21. Charles A. Wright, Presumptions in General in Civil Actions and Proceedings, in 21B Fed. Prac. & Proc. Evid. § 5126 (2d ed. 2011); see also James, supra note 10, at 51 (describing courts' reasoning on relationships between the burden of proof, the burden of persuasion, and presumptions as “hopelessly confused”).

22. See, e.g., Courtenay Commc’ns Corp. v. Hall, 334 F.3d 210, 217 (2d Cir. 2003) (“Because [the plaintiff’s] mark is unregistered . . . ‘the burden is on the plaintiff to prove the mark is . . . valid . . . .’” (third alteration in original) (quoting Reese Publ’g Co. v. Hampton Int’l Commc’ns Inc., 620 F.2d 7, 11 (2d Cir. 1980)); Emergency One, Inc. v. Am. Fire Eagle Engine Co., 332 F.3d 264, 272-72 (4th Cir. 2003) (“The plaintiff in an action for infringement of an unregistered mark must prove ‘the validity and its ownership of the mark as part of its larger burden in a trademark infringement action . . . .’ to prove that it has a valid, protectable trademark and that the defendant is infringing its mark.” (alteration in original) (quoting Am. Online, Inc. v. AT & T Corp., 243 F.3d 812, 819 (4th Cir. 2001)); A.J. Canfield Co. v. Honickman, 808 F.2d 291, 299 n.9 (3d Cir. 1986) (“[O]ne difference between registered and unregistered marks relevant to this case is that unregistered marks have no presumption of validity, so [the plaintiff] has the burden of proving its term protectable.”)).


24. See, e.g., Fleischer Studios, Inc. v. A.V.E.L.A., Inc., 654 F.3d 958, 966 (9th Cir. 2011) (holding that district court had not abused its discretion in declining to consider registration not in evidence).

25. See, e.g., ERBE Elektromedizin GmbH v. Canady Tech. LLC, 629 F.3d 1278, 1288 (Fed. Cir. 2010) (rejecting “the proposition that the Supplemental Register carries the same clout as the Principal Register”).
“may accept as prima facie evidence that [an applied-for] mark has become distinctive...proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made.”

Both Section 7(b) and Section 33(a) of the Act provide that a registration on the Principal Register that has not yet passed its fifth anniversary or has otherwise not become incontestable,27 “shall be prima facie evidence of the validity of the registered mark and of the registration of the mark, of the owner’s ownership of the mark, and of the owner’s exclusive right to use the registered mark in commerce on or in connection with the goods and services specified in the certificate.”

Finally, Section 10(a)(3) of the Act recites that “[a]cknowledgement [of recordation in the USPTO] shall be prima facie evidence of the execution of an assignment, and when the prescribed information reporting the assignment is recorded ..., the record shall be prima facie evidence of execution.”

Of these, the permissive nature of Section 2(f) renders the case law interpreting it of limited value in determining the burden-shifting effect of that statute.30 Likewise, Section 10(a)(3) has


28. Id. §§ 1057(b), 1115(a). Sections 7(b) and 33(a) currently differ from each other in that Section 33(a), but not Section 7(b), recites that the prima facie evidence represented by a nonincontestable registration “shall not preclude another person from proving any legal or equitable defense or defect, including those set forth in subsection (b) of this section, which might have been asserted if such mark had not been registered.” 15 U.S.C. § 1115(a).


As set forth in greater detail at infra notes 80-114, the Lanham Act does not recognize the use of prima facie evidence only for the purpose of establishing the validity and ownership of marks; rather, an additional section of the Act, Section 45, 15 U.S.C. § 1127, recognizes as prima facie evidence of the abandonment of rights that a mark has not been used in commerce for a period of three years.

30. For example, the Eighth Circuit has held in the infringement context that the use for five consecutive years of an unregistered trade dress may create a “presumption” of secondary meaning that must be considered in the inquiry into whether the trade dress is a distinctive indicator of origin. See, e.g., Stuart Hall Co. v. Ampad Corp., 51 F.3d 780, 789 (8th Cir. 1995) (relying on 15 U.S.C. § 1052(f) to hold in infringement context that plaintiff’s exclusive use of claimed trade dress for over five years may warrant presumption of secondary meaning). In contrast, the Trademark Trial and Appeal Board has held that “the language of the statute is permissive, and the weight to be accorded this kind of evidence depends on the facts and circumstances of the particular case.” In re Enoco Display Sys. Inc., 56 U.S.P.Q.2d 1279, 1286 (T.T.A.B. 2000); see also In re Udor U.S.A. Inc., 89 U.S.P.Q.2d 1978, 1986 (T.T.A.B. 2009) (concluding that, in light of widespread third-party use of similar designs, “a mere claim of five years of use is insufficient”).
rarely come into play at all. As a consequence, Sections 7(b) and 33(a) have triggered the most post-1946 jurisprudence concerning the proper meaning of prima facie evidence under the Act; that case law, however, has failed to produce a consensus on what burdens, if any, shift following the introduction of prima facie evidence.

2. Prima Facie Evidence of Mark Validity and Ownership Under Sections 7(b) and 33(a): Inter-Circuit, Intra-Circuit, and Intra-Opinion Confusion

As noted in the Introduction, the German military strategist Carl von Clausewitz is credited with coining the term “fog of war” to describe the considerable confusion that arises in the heat of battle. There are few areas of federal trademark law in which this phenomenon is more visible than in disputes over the evidentiary effect of Section 7(b)’s and Section 33(a)’s references to prima facie evidence of mark validity and ownership. Specifically, it is the rule in a majority of circuits that owners of marks covered by nonincontestable registrations on the Principal Register need not press the attack on the issues of mark validity and ownership during battle beyond introducing their registrations into evidence; this is because introduction of such a registration shifts the burden of proof regarding these issues to the other party. In contrast,
case law in a minority of circuits holds that a nonincontestable registration merely shifts the burden of production on these issues. Significantly, however, there are panel decisions adopting the majority approach even in circuits with case law following the minority rule. Indeed, the fog surrounding the evidentiary effect of a nonincontestable registration is such that it has produced confusion even within individual opinions.

That fog is exacerbated by the absence of a readily apparent doctrinal foundation for the majority approach, as courts applying a burden-of-proof-shifting rule typically do not rely on either a statutory or common-law definition of prima facie evidence, nor do they cite to the legislative history of the 1946 passage of the Lanham Act to support their position. The Second Circuit became the first regional circuit both to take the majority approach and to fail to explain it following the Lanham Act’s effective date. As early as 1953, that court held that a nonincontestable registration created “a strong presumption in favor of the validity of the mark,” and it elaborated on the nature of that presumption five years later with the following observation:

In the Lanham Act Congress made it clear that weight should be accorded to the actions of the Patent Office. The Act provided that “A certificate of registration of a mark . . . shall be prima facie evidence of the validity of the registration . . . .” We are of the opinion that this means not only that the burden of going forward is upon the contestant of the registration but that there is a strong presumption of validity so that the party claiming invalidity has the burden of proof and in order to prevail it must put something more into the scales than the registrant. In a case such as this, where it can be argued with equal force that a mark is descriptive and on the contrary that it is arbitrary and fanciful, the courts should not overrule the action of the Patent Office to whose care Congress has entrusted the preliminary determination as to whether a mark fulfills the requirements of the statute.

The same court held still later that:

A certificate of registration with the PTO is prima facie evidence that the mark is registered and valid (i.e., protectible), that the registrant owns the mark, and that the registrant has the exclusive right to use the mark in

34. For a rare reference to the legislative history of Section 7(b) in a federal appellate opinion applying the majority rule, see Cerveceria Centroamericana, S.A. v. Cerveceria India, Inc., 892 F.2d 1021, 1023 (Fed. Cir. 1989).


commerce. Registration by the PTO without proof of secondary meaning creates the presumption that the mark is more than merely descriptive, and, thus, that the mark is inherently distinctive. As a result, when a plaintiff sues for infringement of its registered mark, the defendant bears the burden to rebut the presumption of [the] mark’s protectibility by a preponderance of the evidence.37

This burden-of-proof-shifting approach also has been adopted without apparent internal disagreement by the First,38 Sixth,39 Eighth,40 Tenth,41 District of Columbia,42 and Federal

37. Lane Capital Mgmt., Inc. v. Lane Capital Mgmt., Inc., 192 F.3d 337, 345 (2d Cir. 1999) (citations omitted); accord Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc., 696 F.3d 206, 216 n.10 (2d Cir. 2012) (“In order to rebut the presumption of validity [attaching to a nonincontestable registration], the allegedly infringing party must show, by a preponderance of the evidence, that the mark is ineligible for protection.” (citation omitted)).

38. See Colt Def., LLC v. Bushmaster Firearms, Inc. 486 F.3d 701, 706 (1st Cir. 2007) (“Where, as here, the party claiming infringement has registered the term on the Principal Register, the registration establishes a rebuttable presumption that the term is not generic. This presumption may be overcome where the alleged infringer demonstrates genericness by a preponderance of the evidence.” (citations omitted); Borinquen Biscuit Corp. v. M.V. Trading Corp., 443 F.3d 112, 117 (1st Cir. 2006) (“[T]he effect of registration for a contestable mark is to shift the burden of proof from the plaintiff to the defendant . . . .” (alteration omitted) (internal quotation marks omitted)); Keebler Co. v. Rovira Biscuit Corp., 624 F.2d 366, 373 (1st Cir. 1980) (“The effect of registration under the Lanham Act, therefore, is to shift the burden of proof from the plaintiff, who in a common law infringement action would have to establish his right to exclusive use, to the defendant, who must introduce sufficient evidence to rebut the presumption of plaintiff’s right to such use. A defendant may satisfy this burden of proof with respect to the specific defect he alleges in plaintiff’s registration by a preponderance of the evidence.”).

39. See Leelanau Wine Cellars, Ltd. v. Black & Red, Inc., 502 F.3d 504, 514 (6th Cir. 2007) (“The effect of the statutory presumption contained in [Section 33(a)] is to shift the burden of proof to the alleged infringer . . . to prove the absence of secondary meaning.”); Burke-Parsons-Bowly Corp. v. Appalachian Log Homes, Inc., 871 F.2d 590, 593 (6th Cir. 1989) (“Receipt of a registered trademark automatically invokes a statutory presumption that the trademark is valid. The statutory presumption shifts the burden of proof to the party challenging the validity of the mark.” (citation omitted)).

40. See WSM, Inc. v. Hilton, 724 F.2d 1320, 1326 (8th Cir. 1984) (“The presumption created by the Lanham Act is a rebuttable one . . . which shifts the burden of proof to the one questioning the trademark. The statutory presumption may be overcome by establishing the generic nature of the mark.”); cf. Cmty. of Christ Copyright Corp. v. Devon Park Restoration Branch of Jesus Christ’s Church, 634 F.3d 1005, 1011 (8th Cir. 2011) (holding that incontestable and nonincontestable registrations at issue shifted burden of proof on the issue of mark validity without distinguishing between the two categories).

41. See Creative Gifts, Inc. v. UFO, 235 F.3d 540 (10th Cir. 2000) (“Because a trademark’s certificate of registration carries with it the presumption that the trademark is valid, a party seeking cancellation of a registration on the ground that the mark has become generic carries the burden of proving that fact by a preponderance of the evidence.” (citation omitted) (quoting Glover v. Ampak, Inc., 74 F.3d 57, 59 (4th Cir. 1996)).

42. See Aktieselskabet AF 21 November 2001 v. Fame Jeans, Inc., 525 F.3d 8, 14 (D.C. Cir. 2008) (“Unlike an ordinary agency, whose decisions we would review under the deferential standards of [5 U.S.C. §] 706, the PTO’s decision to register a trademark is subject to later collateral attack during which registration is only prima facie evidence of the mark’s validity, rebuttable by a preponderance of the evidence.”).
Circuits; it additionally may be reflected in controlling authority in the Eleventh Circuit. In applying this rule, the First Circuit has noted that, unlike the proponent of an unregistered mark, which must demonstrate affirmatively that the mark is either inherently distinctive or has acquired secondary meaning, the owner of a nonincontestable registered mark carries a “lighter burden” as a result of the prima facie evidence of validity represented by the registration. Although the validity of the mark may be challenged, the registration shifts the burden of proof from the registrant to the challenger to rebut the mark’s prima facie validity by “significantly probative evidence.” For emphasis, the court noted that:

Then—and only then—does the burden of proof shift back, so that the party seeking protection must take an alternative route and assume the devoir of persuasion on the issue of

43. See Cold War Museum, Inc. v. Cold War Air Museum, Inc., 586 F.3d 1352, 1358 (Fed. Cir. 2009) (“Due to this presumption of validity, the burden of persuasion in a cancellation proceeding rests on the party seeking to cancel the registration.”); Cerveceria Centroamericana, S.A. v. Cerveceria India, Inc., 892 F.2d 1021, 1023 (Fed. Cir. 1989) (“Because a trademark owner's certificate of registration is prima facie evidence of the validity of the registration and continued use of the registered mark, the burden of proof is placed upon those who seek cancellation. Accordingly, in a cancellation for abandonment, as for any other ground, the petitioner bears the burden of proof. Moreover, the petitioner's burden is to establish the case for cancellation by a preponderance of the evidence.” (citations omitted) (internal quotation marks omitted)). Prior to the formation of the Federal Circuit, its predecessor court, the Court of Customs and Patent Appeals, routinely applied the same rule. See, e.g., Dan Robbins & Assocs. v. Questor Corp., 599 F.2d 1009, 1013-14 (C.C.P.A. 1979) (“Under Section 7(b) of the Act, registrations are presumed valid. One seeking cancellation must rebut that presumption by a preponderance of evidence.” (footnote omitted) (citation omitted)).

44. The Eleventh Circuit has not squarely addressed the significance of the prima facie evidence attaching to a nonincontestable registration. It has, however, taken an owner of such a registration to task for “neglect[ing] to address before this court the ramifications that registration would have on [the] allocation of the burden of proof on the issues of protectability and strength of the marks.” Welding Servs., Inc. v. Forman, 509 F.3d 1351, 1357 (11th Cir. 2007). Likewise, in an opinion binding on Eleventh Circuit courts, see Bonner v. City of Prichard, 661 F.2d 1206, 1209-11 (11th Cir. 1981) (en banc), the former Fifth Circuit observed that “registration by itself does not enlarge a registrant's substantive rights in a mark. It does, however, confer procedural advantages which affect the burden of proof.” Am. Heritage Life Ins. v. Heritage Life Ins. Co., 494 F.2d 3, 10 (5th Cir. 1974); see also Soweco, Inc. v. Shell Oil Co., 617 F.2d 1178, 1184 (5th Cir. 1980) (“Once a mark has been registered, proof of registration is prima facie evidence of the registrant's right to use the mark, but it does not preclude one who is sued from proving 'any legal or equitable defense which might have been asserted if such mark had not been registered.'” (quoting 15 U.S.C. § 1115(a) (1976)); Vision Ctr. v. Opticks, Inc., 596 F.2d 111, 119 (5th Cir. 1979) (“Although a statutory presumption of validity is accorded to marks registered under the Lanham Act, this presumption is rebuttable and may be overcome by establishing the generic or descriptive nature of the mark.”); cf. Roto-Rooter Corp. v. O'Neal, 513 F.2d 44, 46 (5th Cir. 1975) (holding that “proof [of secondary meaning] was unnecessary with respect to the registered marks,” without describing registrations in question as incontestable or nonincontestable).


46. Id. at 117-18.
whether its mark has acquired secondary meaning. Simply alleging descriptiveness is insufficient . . . the putative infringer must prove descriptiveness by a preponderance of the evidence before the mix of issues changes and the burden of persuasion on the new issue (secondary meaning) reverts to the trademark holder.\footnote{Id. at 118.}

In jurisdictions following this rule, it is therefore apparent that the party challenging the validity of a nonincontestable registered mark “always bears the burden of persuasion . . . the ultimate burden of proving invalidity of the registration by a preponderance of the evidence.”\footnote{Cold War Museum, 586 F.3d at 1358.}

In contrast, mark owners in a minority of federal circuits may still be required to press the attack even after producing prima facie evidence of validity and ownership in the form of a nonincontestable registration. This is because, even if it is not reflected in an overall majority of opinions, the possible trend in those circuits is to hold that prima facie evidence under Sections 7(b) and 33(a) of the Lanham Act merely shifts the burden of production to a defendant.\footnote{As can be determined from the dates of the opinions discussed at infra notes 50-79 and accompanying text, recent (but not necessarily the most recent) opinions from the Fourth, Fifth, Seventh, and Ninth Circuits have tended to place only the burden of production on a litigant faced with a nonincontestable registration; in contrast, older opinions from those same courts display a tendency to hold that a challenger to the validity and ownership of a mark covered by a nonincontestable registration bears the burden of proof on those issues. To the extent that they explain their burden of production rationales, these courts expressly or implicitly rely on FRE 301 and its allocation of the “burden of proof” regarding presumptions. Under this rule, the ultimate burden of proving mark validity and ownership stays with the plaintiff in all phases of litigation.}

Nevertheless, that one panel of a particular circuit court of appeals may take this approach does not mean that all panels of that court will do the same, and indeed, there are no apparent circuits with case law uniformly adopting the minority rule. Specifically, there is strong authority from the Fourth, Fifth, Seventh, and Ninth Circuits holding that an incontestable registration has merely a burden-of-production-shifting effect. Nevertheless, other opinions from the same courts have unambiguously adopted a burden-of-proof-shifting rule, leaving the strength of those courts’ commitment to the minority rule open to question. Even within particular circuits, litigants’ “attack” or “defend” strategies therefore can be hampered by the considerable fog that has arisen from the inconsistent treatment of nonincontestable registrations.

\footnote{Id. at 118.}

\footnote{Cold War Museum, 586 F.3d at 1358.}

\footnote{As can be determined from the dates of the opinions discussed at infra notes 50-79 and accompanying text, recent (but not necessarily the most recent) opinions from the Fourth, Fifth, Seventh, and Ninth Circuits have tended to place only the burden of production on a litigant faced with a nonincontestable registration; in contrast, older opinions from those same courts display a tendency to hold that a challenger to the validity and ownership of a mark covered by a nonincontestable registration bears the burden of proof on those issues.}
For example, ownership of a nonincontestable registration may do very little good when litigating before certain panels of the Seventh Circuit, which may require the registrant to remain on the attack even after introducing its registration into evidence. The Seventh Circuit’s current skepticism toward the evidentiary value of nonincontestable registrations first became apparent in 1986, when it affirmed the grant of a defense motion for summary judgment with the following observation:

Plaintiff argues that it has produced enough evidence to show that there is a genuine issue of fact. Plaintiff refers to its [nonincontestable] trademark registration. Defendant has, however, introduced enough evidence of the genericness of the [registered mark] to “burst” the presumption created by section [33(a)]. Thus plaintiff cannot rely on that presumption to defeat the motion for summary judgment. The presumption really serves only to shift the burden of production to the defendant.50

Although the court did not cite to any supporting authority or legislative history equating the prima facie evidence recognized by Section 33(a) with a presumption in the FRE 301 sense, its subsequent opinions have wholeheartedly adopted that approach. In another appeal, for example, after concluding that the plaintiff had failed to adduce sufficient evidence to create a factual dispute as to the distinctiveness of its mark, the court held that:

Nor can the plaintiff obtain any residual mileage from the registration of its trademark. The presumption of validity that federal registration confers evaporates as soon as evidence of invalidity is presented. Its only function is to incite such evidence, and when the function has been performed the presumption drops out of the case. The presumption [in this case] performed its function—[the defendant] presented evidence that the [registered mark] is generic, thus creating a conflict in evidence.51

Under this line of cases, the act of registration therefore “merely begins the process that leads to the presumption” of validity,52 and any resulting presumption is “easily rebuttable.”53

Nevertheless, although the Seventh Circuit’s most recent decisions have taken an uncompromising view of the limited value of nonincontestable registrations, that view has not always been so rigid. For example, a 1998 opinion from that court noted that “registration creates a presumption of validity, implying that the

50. Liquid Controls Corp. v. Liquid Control Corp., 802 F.2d 934, 938 (7th Cir. 1986).
52. Custom Vehicles Inc. v. Forest River, Inc., 476 F.3d 481, 485 (7th Cir. 2007).
53. Id. at 486.
defendant has the laboring oar on all issues relating to validity...”54 Likewise, another opinion during the same year cited to Sections 7(b) and 33(a) and held that “the presumption of validity can be rebutted. For this to occur, [the counterclaim defendant] must meet its burden by providing proof of genericness.”55

Unlike the Seventh Circuit, the Fourth Circuit has expressly invoked FRE 301 as the basis for restricting the effect of prima facie evidence under the Lanham Act.56 In Retail Services, Inc. v. Freebies Publishing,57 the latter court applied FRE 301’s burden-of-production-shifting approach to hold that:

Under the Lanham Act, the issuance of a certificate of registration arms the registrant with prima facie evidence of the validity of the registered mark and of the registration of the mark, of the registrant’s ownership of the mark, and of the registrant’s exclusive right to use the registered mark. . . . Without a certificate of registration, the owner would be required to establish that the disputed mark was sufficiently distinctive to warrant trademark protection in the first place. The effect of the presumption is to satisfy that burden in the absence of rebutting evidence.

The presumption of validity flowing from trademark registration, therefore, has a burden-shifting effect, requiring the party challenging a registered mark to produce sufficient evidence to establish that the mark is [invalid] by a preponderance of evidence. The burden shifted by the presumption is one of production rather than persuasion. If sufficient evidence of [invalidity] is produced to rebut the presumption, the presumption is neutralized and essentially drops from the case, although the evidence giving rise to the presumption remains.58

Beyond the possible significance of FRE 301 to the issue, another panel of the Fourth Circuit has identified aggressive advocacy in

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54. Publ’ns Int’l, Ltd. v. Landoll, Inc. 164 F.3d 337, 339-340 (7th Cir. 1998).
56. See, e.g., Am. Online, Inc. v. AT & T Corp., 243 F.3d 812, 818 (4th Cir. 2001) (expressly evaluating evidentiary value of nonincontestable registration under FRE 301 rubric); see also OBX-Stock, Inc. v. Bicast, Inc., 558 F.3d 334, 341-42 (4th Cir. 2009) (“It is true that a certificate of registration serves as prima facie evidence of the validity of the registered mark. But entry on the Principal Register does not shift the burden of persuasion on validity, merely the burden of production.” (citations omitted)).
57. 364 F.3d 535 (4th Cir. 2004).
58. Id. 542-43 (alteration omitted) (citations omitted) (internal quotation marks omitted).
the registration process as an additional basis for giving an incontestable registration this limited effect.\footnote{59. See \textit{OBX-Stock}, 558 F.3d at 342 ("[W]hatever support [the registrant] might be able to claim from the registrations is in this case undermined by the fact that the PTO only grudgingly issued the registrations after intervention by North Carolina’s congressional delegation. . . . Before then, the PTO examiners rejected [the registrant’s] application five times . . . .").}

As is true of the divided Seventh Circuit authority discussed above, the Fourth Circuit’s exhaustive burden-of-production analysis in \textit{Retail Services} and that case’s progeny is inconsistent with several other Fourth Circuit opinions. Nearly two decades before \textit{Retail Services}, a different panel of the court noted that a nonincontestable registration before it “shift[ed] the burden of proof from the plaintiff, who in a common law infringement action would have [had] to establish his right to exclusive use, to the defendant.”\footnote{60. Pizzeria Uno Corp. v. Temple, 747 F.2d 1522, 1529 (4th Cir. 1984).} A 1996 decision similarly opined that “[b]ecause a trademark’s certificate of registration carries with it the presumption that the mark is valid, a party seeking cancellation of a registration on the ground that the mark has become generic must carry the burden of proving that fact by a preponderance of the evidence.”\footnote{61. Glover v. Ampak, Inc., 74 F.3d 57, 60 (4th Cir. 1996) (citation omitted).} Likewise, less than a year before \textit{Retail Services}, in a case involving common-law rights in an unregistered mark, another panel held that the burden of establishing an exclusive right to an unregistered mark rested with the party asserting the infringement claim;\footnote{62. See \textit{Emergency One, Inc. v. Am. Fire Eagle Engine Co.}, 332 F.3d 264 (4th Cir. 2003).} in contrast, that panel noted, under Section 7(b), ownership of a nonincontestable registration “shift[s] the burden of proof from the plaintiff . . . to the defendant, who must introduce sufficient evidence to rebut the presumption of plaintiff’s right to . . . [exclusive use of the mark].”\footnote{63. Id. at 269 (quoting \textit{Pizzeria Uno}, 747 F.2d at 1529).} And, even five years after the decision in \textit{Retail Services}, still another Fourth Circuit panel cited both Sections 7(b) and 33(a) for the proposition that:

Of course, federal registration helps in this regard, as registration is \textit{prima facie} evidence that the registrant is the owner of the mark. Registration grants a presumption of ownership, dating ownership to the filing date of the federal registration application, and the party challenging the registrant’s ownership must overcome this presumption by a preponderance of the evidence.\footnote{64. George & Co. LLC v. Imagination Entm’t Ltd., 575 F.3d 383, 400 n.15 (4th Cir. 1999) (citations omitted).}
with the majority rule,\textsuperscript{65} that court’s most recent and most detailed treatment of the issue cited the Fourth Circuit’s view of FRE 301 favorably but took a different view of the rule’s significance.\textsuperscript{66} Reviewing a finding as a matter of law that a nonincontestable registered mark lacked distinctiveness, that panel of the Fifth Circuit initially suggested that the defendants bore the burden of proof on the issue: “This presumption of validity may be rebutted by [the defendants] establishing that the mark is not inherently distinctive.”\textsuperscript{67} By the end of its analysis, however, the court was citing favorably to Fourth Circuit authority holding that only a shift in the burden of production was appropriate; of this authority, it noted that “[t]he approach that the Fourth Circuit has taken regarding the presumption of validity is consistent with our precedent.”\textsuperscript{68} As to the effect of the particular factual showing by the defendants before it, the court concluded that “[the defendants’] introduction of evidence that the [plaintiff’s registered mark] is not distinctive has reduced the presumption of validity to evidence that the PTO is of the opinion that the [mark] is sufficiently distinctive to be legally protectable as a mark.”\textsuperscript{69} Under this approach, the introduction of rebuttal evidence, instead of resulting in a “vanishing” presumption, acts to reduce a nonincontestable registration to mere evidence of the PTO’s opinion on distinctiveness.\textsuperscript{70}

Even when it has applied the majority rule, the Fifth Circuit has displayed confusion over precisely how far the prima facie evidence of validity documented by a nonincontestable registration reaches. In a 1975 opinion in which the court addressed a finding

\textsuperscript{65} See, e.g., Test Masters Educ. Servs., Inc. v. Singh, 428 F.3d 559, 567 (5th Cir. 2005) (“Registration is prima facie proof that the registered mark is distinctive. However, this presumption can be overcome by showing that the mark is merely descriptive.” (citation omitted)); Soweco, Inc. v. Shell Oil Co., 617 F.2d 1178, 1184 (5th Cir. 1980) (“Once a mark has been registered, proof of registration is prima facie evidence of the registrant’s right to use the mark, but it does not preclude one who is sued from proving ‘any legal or equitable defense which might have been asserted if such mark had not been registered.’”) (quoting 15 U.S.C. § 1115(a) (1976)); Vision Ctr. v. Opticks, Inc., 596 F.2d 111, 119 (5th Cir. 1979) (“Although a statutory presumption of validity is accorded to marks registered under the Lanham Act, this presumption is rebuttable and may be overcome by establishing the generic or descriptive nature of the mark.”); cf. Roto-Rooter Corp. v. O’Neal, 513 F.2d 44, 46 (5th Cir. 1975) (holding that “proof [of secondary meaning] was unnecessary with respect to the registered marks,” without describing registrations in question as incontestable or nonincontestable).

\textsuperscript{66} See Amazing Spaces, Inc. v. Metro Mini Storage, 608 F.3d 225 (5th Cir. 2010).

\textsuperscript{67} Id. at 237.

\textsuperscript{68} Id. at 239.

\textsuperscript{69} Id.

\textsuperscript{70} Id.; see also Igloo Prods. Corp. v. Brantex, Inc., 202 F.3d 814, 819 (5th Cir. 2000) (“[E]ven if [the registrant] were entitled to the presumption of secondary meaning, the burden of persuasion on the question of secondary meaning would not have shifted to [the opposing party]; instead, merely a burden of production would have arisen in [the opposing party].”).
that the plaintiff’s claimed mark lacked distinctiveness, it held as an initial matter that:

[Under the Lanham Act, registration by itself does not enlarge a registrant’s substantive rights in a mark. It does, however, confer procedural advantages which affect the burden of proof. Under the Act, registration is prima facie evidence of the registrant’s ownership of the mark and of the registrant’s exclusive right to use the mark in commerce in connection with the services specified in the registration certificate. Thus registration is sufficient to establish prima facie (1) the required prior use (2) of a registrable mark (3) which is likely to be confused with another’s use of the same or a similar mark.]

Nevertheless, after declining to disturb the district court’s finding that the defendant had carried its burden of demonstrating that the plaintiff’s mark lacked inherent distinctiveness, the court took the opposite tact when rejecting the plaintiff’s claims of acquired distinctiveness. Specifically, because there was no record that the Patent and Trademark Office had ever made an express finding of acquired distinctiveness, the court concluded that “[o]n the issue of secondary meaning, the burden of proof is on [the plaintiff].” Under this approach, of course, a nonincontestable registration is of limited value at best to the protection of a mark found to be descriptive but not registered under Section 2(f).

The same inconsistent approaches can be found in decisions from the Ninth Circuit. The overwhelming weight of Ninth Circuit authority holds that prima facie evidence of mark ownership and validity will shift the burden of proof on those issues, but that

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72. Id. at 12 n.9.
73. See also 20th Century Wear, Inc. v. Sanmark-Stardust Inc., 747 F.2d 81, 88 n.8 (2d Cir. 1984) (“There [is] a question whether section 33(a) ... creates a rebuttable presumption that a descriptive mark that has been registered has secondary meaning. We hold, however, that in the absence of evidence that the Patent and Trademark Office registered the mark because of its secondary meaning, registration does not shift the burden of proving a lack of secondary meaning onto the defendant.” (citations omitted)).
74. See Zobmondo Entm’t, LLC v. Falls Media, LLC, 602 F.3d 1108, 1113 (9th Cir. 2010) (“Although the plaintiff in a trademark action bears the ultimate burden of proof that his or her mark is valid, federal registration provides prima facie evidence of the mark’s validity and entitles the plaintiff to a strong presumption that the mark is a protectable mark.... If the plaintiff establishes that a mark has been properly registered, the burden shifts to the defendant to show by a preponderance of the evidence that the mark is not protectable.” (citations omitted) (internal quotation marks omitted)); Yellow Cab Co. of Sacramento v. Yellow Cab of Elk Grove, Inc., 419 F.3d 925, 927 (9th Cir. 2005) (“When a plaintiff pursues a trademark action involving a properly registered mark ... the burden of proving that the mark is generic rests upon the defendant.”); Filipino Yellow Pages, Inc. v. Asian J. Publ’ns, Inc., 198 F.3d 1143, 1146 (9th Cir. 1999) (“In cases involving properly registered marks, a presumption of validity places the burden of proving genericness upon the defendant.”); Qualitex Co. v. Jacobson Prods. Co., 13 F.3d 1297, 1301 (9th Cir. 1994) (“A
court’s extensively thought-out opinion in Tie Tech Inc. v. Kinedyne Corp.\footnote{296 F.3d 778 (9th Cir. 2002).} takes a contrary view. In discussing the significance of prima facie evidence attaching to nonincontestable registered marks, the Tie Tech court noted the tendency of some opinions to use the terms “prima facie evidence” and a “presumption” interchangeably.\footnote{Id. at 782-83.} From an evidentiary view, the court held that prima facie evidence of validity merely created a presumption that the mark in question was valid. Registration therefore might “discharge[,] the plaintiff’s original common law burden of proving validity,” but that validity was subject to rebuttal.\footnote{Id. at 784.} In particular, the “presumptive advantage” attaching to the registration merely shifted the burden of production to the defendant to provide evidence of functionality.\footnote{Id. at 783 (emphasis added).} In arriving at this decision, the Tie Tech court acknowledged it was following the Fourth Circuit’s “decidedly different view” on the evidentiary significance of a nonincontestable registration.\footnote{Id. at 784 & n.4.}

Certificate of registration is prima facie evidence of the validity of the mark and relieves the holder . . . of the burden of proving nonfunctionality and secondary meaning. . . . It shifts the burden of proof to the contesting party, who must introduce sufficient evidence to rebut the presumption of the holder’s right to protected use.\footnote{Id. at 782-83.} (citations omitted), rev’d on other grounds, 514 U.S. 159 (1995); Americana Trading Inc. v. Russ Berrie & Co., 966 F.2d 1284, 1287 (9th Cir. 1992) (“As applied to a descriptive mark such as [the registrant’s], the registration carries a presumption of secondary meaning. . . . [The defendant] therefore had the burden to prove that secondary meaning had not attached if it wished to argue that [the] mark was weak.”); Vuitton et Fils S.A. v. J. Young Enters., 644 F.2d 769, 775-76 (9th Cir. 1981) (“[U]nder the Lanham Act, registration and entry of a trademark on the Principal Register of the United States Patent and Trademark Office shifts the burden of proof from the plaintiff, who would have to establish his right to exclusive use in a common law infringement action, to the defendant, who must introduce sufficient evidence to rebut the presumption of plaintiff’s right to such protected use. . . . [T]he burden of proof is . . . on the party asserting invalidity, in this case, [the defendant].”); Surgicenters of Am., Inc. v. Med. Dental Surgeries, Co., 601 F.2d 1011, 1020-21 (9th Cir. 1979) (“By statute, plaintiff’s certificate of registration is prima facie evidence of the mark’s validity. By case law, this means not only that the mark’s challenger has the burden of going forward, but also that registration carries with it a strong presumption of validity. Therefore, the burden of showing genericness rests squarely on defendants. Particularly where, as here, the allegedly infringing name is identical to the registered mark, and its use began after the mark’s registration, defendant carries the burden of explanation and persuasion.” (alteration omitted) (citations omitted) (internal quotation marks omitted)); Dymo Indus. v. Tapeprinter, Inc., 326 F.2d 141, 143 (9th Cir. 1964) (per curiam) (“Appellant points out that under [Section 7(b)] . . . of the Lanham Act, the registration of a trademark by the Patent Office is prima facie evidence of its validity . . . . [T]he statutory presumption of validity simply casts the burden of proof on the one who questions the validity of a registered trademark.”); cf. Advertise.com, Inc. v. AOL Adver., Inc., 616 F.3d 974, 977 (9th Cir. 2010) (holding that incontestable and nonincontestable registrations at issue shifted burden of proof on the issue of mark validity without distinguishing between the two categories).
however, the court did not expressly rely on FRE 301 in its analysis; it also failed to cite to any supporting legislative history.

B. Challenging Protectable Rights Through Prima Facie Evidence

1. The Statutory Framework

Even if a putative mark owner has established its rights either through the prima facie evidence discussed above or through alternative showings, the Lanham Act recognizes the possibility of prima facie evidence being used to dispose of those rights. Specifically, Section 45 of the Act allows a challenger to the validity of a mark to rely upon “prima facie evidence of abandonment” consisting of the mark’s non-use.80 Prior to 1996, Section 45 provided that non-use for “2 consecutive years” would constitute prima facie evidence of abandonment.81 In that year, however, Congress extended this time period to “3 consecutive years” to comply with terms of the Uruguay Round Agreements Act.82

2. Prima Facie Evidence of Abandonment Under Section 45: The Apparent Consensus

In contrast to the split between, and within, circuits concerning the proper interpretation of Sections 7(b) and 33(a), courts interpreting Section 45 have for the most part consistently held that prima facie evidence of abandonment merely creates a rebuttable presumption that shifts only the burden of production to the trademark holder. These include the Second Circuit,83 the

83. See ITC Ltd. v. Punchgini, Inc., 482 F.3d 135, 148 (2d Cir. 2007) (“In short, upon defendants’ presentation of evidence establishing a prima facie case of abandonment under the Lanham Act, [the plaintiff] was required to come forward only with such contrary evidence as, when viewed in the light most favorable to [the plaintiff], would permit a reasonable jury to infer that it had not abandoned the mark. Specifically, it needed to adduce sufficient evidence to permit a reasonable jury to conclude that, in the three-year period of non-use[,] . . . [the plaintiff] nevertheless maintained an intent to resume use of its registered mark in the reasonably foreseeable future.”).
Fourth Circuit,\textsuperscript{84} the Seventh Circuit,\textsuperscript{85} the Eleventh Circuit,\textsuperscript{86} and the Federal Circuit,\textsuperscript{87} as well as one Ninth Circuit panel in dictum.\textsuperscript{88} Consequently, and with limited exceptions,\textsuperscript{89} the party seeking to invalidate a registration generally has been held to retain the overall burden of proof, so that that party must remain on the attack throughout the litigation.\textsuperscript{90}

Perhaps the most notable example of this rule in action appears in the Federal Circuit’s opinion in \textit{Cerveceria Centroamericana, S.A. v. Cerveceria India, Inc.}\textsuperscript{91} Presented with a nonincontestable registration, the court concluded from its past case law and the legislative history of Section 7(b) that “because a trademark owner’s certificate of registration is ‘prima facie evidence of the validity of the registration’ and continued use of the registered mark, the burden of proof is placed upon those who

\textsuperscript{84} See \textit{Emergency One, Inc. v. Am. Fire Eagle, Ltd.} 228 F.3d 531, 536 (4th Cir. 2000) (“Once the presumption is triggered, the legal owner of the mark has the burden of producing evidence of either actual use during the relevant period or intent to resume use. The ultimate burden of proof (by a preponderance of the evidence) remains always on the challenger.” (citations omitted)).

\textsuperscript{85} See \textit{Roulo v. Russ Berrie & Co.}, 886 F.2d 931, 938 (7th Cir. 1989) (“[T]he owner of the trademark need only produce evidence to rebut the presumption while the ultimate burden of persuasion rests on the defendant.”).

\textsuperscript{86} See \textit{Cumulus Media, Inc. v. Clear Channel Commc’ns}, 304 F.3d 1167, 1176 (11th Cir. 2002) (“[A] prima facie case of abandonment shifts only the burden of production, while leaving the ultimate burden of persuasion always with the defendant.”).

\textsuperscript{87} See \textit{On-Line Careline, Inc. v. Am. Online, Inc.}, 229 F.3d 1080, 1089 (Fed. Cir. 2000) (“Establishing a prima facie case eliminates the challenger’s burden to establish the intent element of abandonment as an initial part of his case, creating a rebuttable presumption that the trademark owner has abandoned the mark without intent to resume use. The burden then shifts to the trademark owner to produce evidence that he either used the mark during the statutory period or intended to resume use. The burden of persuasion, however, always remains with the petitioner to prove abandonment by a preponderance of the evidence.”) (alteration omitted) (citations omitted) (internal quotation marks omitted)).

\textsuperscript{88} In \textit{Abdul-Jabbar v. General Motors Corp.}, 75 F.3d 1391 (9th Cir. 1996), without citing to supporting case law, the court noted that “[i]n some circuits, a showing of nonuse shifts the burden of persuasion to the trademark owner to show intent to resume; in others, including the Ninth . . . , prima facie abandonment creates only a rebuttable presumption of abandonment.” \textit{Id.} at 1394 n.4.

\textsuperscript{89} See infra notes 104-14 and accompanying text.

\textsuperscript{90} Although the issue is beyond the scope of this article, the standard of proof for a party obligated to prove abandonment ranges from a preponderance of evidence, see, e.g., \textit{On-Line Careline, Inc. v. Am. Online, Inc.}, 229 F.3d 1080, 1087 (Fed. Cir. 2000), to “clear and convincing” of “strict” evidence. \textit{See, e.g., Cnty. of Christ Copyright Corp. v. Devon Park Restoration Branch of Jesus Christ’s Church}, 634 F.3d 1005, 1010 (8th Cir. 2011) (“[The defendant] has the burden of proving abandonment by clear and convincing evidence.”); \textit{see also U.S. Jaycees v. Philadelphia Jaycees}, 639 F.2d 134, 139 (3d Cir. 1981) (holding that abandonment of a trademark, being a forfeiture, must be strictly proved); \textit{Cumulus Media}, 304 F.3d at 1176-77 (“In short, the district court was correct to leave the ultimate burden of proof—and a ‘strict’ one at that, with [the trademark challenger].”); \textit{Saratoga Vichy Spring Co. v. Lehman}, 625 F.2d 1037, 1044 (2d Cir. 1980) “[A]bandonment, being a forfeiture of a property interest, should be strictly proved.”).

\textsuperscript{91} 892 F.2d 1021 (Fed. Cir. 1989).
seek cancellation.” The court’s view of the prima facie evidence of abandonment put forward by the challenger to the registration at issue was different, however.

As to that evidence—which consisted of more than two years’ worth of non-use under the then-extant version of Section 45—the court concluded that “although the legislative history of the Lanham Act is clear that a burden shifts to the trademark registrant once prima facie abandonment is shown, it is unclear what burden shifts—the burden of proof or the burden of production.” Despite that lack of clarity, the court seized upon a single sentence from a single hearing leading up to the Act’s passage and the perceived absence of contrary authority to hold that the weight of the prima facie evidence in the appellate record was governed by FRE 301:

Although Rule 301 was adopted subsequent to the Lanham Act, we accept the view that Congress did intend the rule to effect presumptions enunciated in prior as well as subsequent statutes except where Congress clearly expressed a contrary intent. Based on the legislative history of the Lanham Act, we cannot say that Congress unambiguously indicated that the burden of proof shifts to the registrant once prima facie abandonment is established. Accordingly, we conclude that Rule 301 applies to the Lanham Act’s abandonment provision, and therefore, only the burden of going forward (burden of production) shifts to the trademark registrant.

In *ITC Ltd. v. Punchgini, Inc.*, the Second Circuit similarly noted that the submission of prima facie evidence within the

92. Id. at 1023 (quoting 15 U.S.C. § 1057(b) (1988)).
94. *Cerveceria Centroamericana*, 892 F.2d at 1025 (footnote omitted).
95. That sentence was delivered by a proponent of the Act’s definition of abandonment in response to criticism by Professor Milton Handler that the definition was too difficult to satisfy:

I am quite sure that Professor Handler has given careful study to this draft but perhaps he has overlooked the point that in this draft nonuse for 2 years is presumptive abandonment, so that if [a mark owner] had not used [his mark] . . . for 2 years, he would be presumed to have abandoned it.

Hearings on H.R. 102, H.R. 5641, and S. 895 Before the Subcomm. on Trade-marks of the House Comm. on Patents, 77th Cong. 112 (1941) (statement of Wallace Martin, Chairman, American Bar Association Section of Patent, Trademark and Copyright Law Committee on Trademark Legislation), reprinted in 8 Anne Gilson LaLonde, et al., Gilson on Trademarks 33-29 (2007 ed.). The Federal Circuit concluded of this testimony that “[a]lthough ‘prima facie,’ the language at issue in this case, does not always mean a ‘presumption,’ the legislative history of the Lanham Act indicates that Congress was using the term in its presumption sense.” *Cerveceria Centroamericana*, 892 F.2d at 1026 n.6 (citation omitted) (internal quotation marks omitted).
96. Id. at 1026 (citation omitted).
97. 482 F.3d 135 (2d Cir. 2007).
meaning of Section 45 created a “rebuttable presumption of abandonment” of the registered mark at issue.98 The court then explained that the role created by the presumption was “best understood” by reference to FRE 301, which merely placed the burden of “going forward” on the trademark registrant, but did not shift the burden of proof.99 This, in turn, resulted in the “vanishing” presumption discussed in FRE 301, which essentially rendered the prima facie presumption meaningless once rebuttal evidence was presented.100 Regarding the showing necessary to rebut the presumption, the ITC Limited court required the trademark registrant to present sufficient evidence to permit a reasonable jury to conclude that the registrant intended to resume use during the three-year period.101 It specifically rejected the district court’s requirement of “objective, hard evidence of actual concrete plans to resume use” of the mark.102

Finally, Eleventh Circuit case law demonstrates both the underlying methodology of this approach and a glimpse of what might have been the contrary rule in that jurisdiction. Although perhaps not creating the sort of fog of war characteristic of interpretations of Sections 7(b) and 33(a),103 there are scattered appellate decisions referring to the obligation of mark owners to “establish” or “demonstrate” an intent to resume the use of their marks when confronted with prima facie evidence of abandonment.104 These include opinions from the Eleventh Circuit, which in 1982 noted in AmBrit, Inc. v. Kraft, Inc.105 that “[the defendant’s] nonuse [of its mark] establishes a prima facie case of abandonment, thereby placing the burden on [the defendant] to establish its intent to resume use.”106 That holding was followed

98. Id. at 147 (quoting Saratoga Vichy Spring Co. v. Lehman, 625 F.2d 1037, 1044 (2d Cir. 1980)).
99. Id. at 148.
100. See id. at 148-49.
101. Id. at 149.
102. Id. at 148-49.
103. See supra notes 32-79 and accompanying text.
104. See Gen. Healthcare Ltd. v. Qashat, 364 F.3d 332, 337 (1st Cir. 2004) (“To rebut a prima facie showing of abandonment, a purported trademark owner must demonstrate that it intends to resume use in the future.” (internal quotation marks omitted)); Exxon Corp. v. Humble Exploration Co., 695 F.2d 96, 99 (5th Cir. 1983) (“The burden of proof is on the party claiming abandonment, but when a prima facie case of trademark abandonment exists because of nonuse of the mark for over two consecutive years, the owner of the mark has the burden to demonstrate that circumstances do not justify the inference of intent not to resume use.”); Sterling Brewers, Inc. v. Schenley Indus., 441 F.2d 675, 679 (C.C.P.A. 1971) (“[T]here was non-use of the [appellant’s] mark for over two consecutive years. Such non-use constitutes prima facie abandonment under the statute. Appellant has the burden of demonstrating that the circumstances here do not justify an inference of intent not to resume use in order to overcome that prima facie case.”).
105. 812 F.2d 1531 (11th Cir. 1986).
106. Id. at 1550.
three years later by the court’s conclusion in *E. Remy Martin & Co. v. Shaw-Ross Int’l Imports, Inc.* that, based on the non-use of a disputed mark for six years, “[t]he burden of proof . . . shifted to [the putative mark owner] to demonstrate that that circumstances did not justify the inference of intent not to resume use.”

By 2002, however, the court was moving in the opposite direction. In *Cumulus Media, Inc. v. Clear Channel Communications*, it distinguished between the burdens of persuasion and production, in the process reaching a relatively rare modern holding that the burden of proof included both concepts. Clarifying its earlier authority, the court observed that “[o]ur choice of language in *E Remy Martin*—‘burden of proof . . . to demonstrate’—can be read as requiring either production or persuasion”; likewise, “in *AmBrit*, we held that a prima facie abandonment case shifts to a mark holder ‘the burden . . . to establish intent to resume use,’ but ‘establish no more clearly corresponds to ‘produce’ or ‘persuade’ than does ‘demonstrate.’” Based on its conclusion that “[e]very federal court that has considered the question . . . has determined that a prima facie case of abandonment shifts only the burden of production, while leaving the ultimate burden of persuasion always with the defendant,” it rejected the argument that prima facie evidence of abandonment shifted the burden of proving an intent to resume use to the mark owner. Rather, it held, “[w]e agree with the Federal Circuit that, given the lack of evidence of Congress’s clear intent to the contrary, this approach better comports with Rule 301 of the Federal Rules of evidence . . . .” As in other circuits following the FRE 301 vanishing-burden analysis, litigators representing mark owners in the Eleventh Circuit therefore need merely defend, rather than attack, in response to a proffer of prima facie evidence of abandonment.

**IV. RESOLVING THE SPLIT:**

**THE PROPER MEANING OF PRIMA FACIE EVIDENCE UNDER THE LANHAM ACT**

The varying meanings assigned to prima facie evidence as that phrase is used in the Lanham Act cannot be explained by the facts
of the cases producing them: On the contrary, they reflect irreconcilably conflicting views that can leave litigants without clear guidance even within individual circuits. The proper resolution of that conflict, however, can and should be informed by Section 33(a)’s express text, the historical meaning of prima facie evidence at the time of the Lanham Act’s passage, and the Supreme Court’s holding in Microsoft Corp. v. i4i Ltd. Partnership\(^{115}\) that FRE 301 does not and cannot alter the meaning of common-law terms codified prior to the rule’s adoption, even when those terms use the language of presumptions.

### A. Congressional Intent and the
**Historical Understanding of Prima Facie Evidence in Trademark Litigation**

Any inquiry into the meaning of prima facie evidence in the Lanham Act must necessarily start with the meaning of the same concept as it was codified in the Trademark Acts of 1881 and 1905. Section 7 of the 1881 Act provided that “registration of a trademark shall be prima facie evidence of ownership,”\(^{116}\) a concept that, as applied, swept in both ownership \textit{per se} and validity. The issue of what that language meant was not a subject of frequent litigation before the 1905 Act eclipsed its 1881 predecessor. Nevertheless, and although some opinions described prima facie evidence as creating a “presumption” without explaining the significance of that characterization,\(^{117}\) those courts squarely addressing the issue viewed the introduction of prima facie evidence in the form of a registration as shifting the burden of proof.\(^{118}\) Thus, for example, the District of Columbia Court of Appeals noted of one registration issued under the 1881 Act that “[t]he Trademark Statute...arms the registrant with the

\(^{115}\)\text{131 S. Ct. 2238 (2011).}\n
\(^{116}\)\text{Trade-Mark Act of 1881, ch. 138, § 7, 21 Stat. 502, 503.}\n
\(^{117}\)\text{See, e.g., Warner v. Searle & Hereth Co., 191 U.S. 195, 206 (1903) (referring to “presumption of continuing use” attaching to registration).}\n
\(^{118}\)\text{See, e.g., Hughes v. Alfred H. Smith Co., 209 F. 37, 39 (2d Cir. 1913) (“The certificate of the office is sufficient prima facie to indicate compliance with all its regulations; the burden of showing noncompliance is on the person asserting it.”); Dadirrian v. Yacubian, 98 F. 872, 873 (1st Cir. 1900) (noting that registration in the appellate record “conforms to the statute; so that, in accordance with the provisions of section 7 thereof, etc., the registration is prima facie evidence of the complainant’s ownership of the alleged trademark and therefore of whatever is necessary to establish its validity”); Eagle White Lead Co. v. Pflugh, 180 F. 579, 583 (C.C.D.N.J. 1910) (“It must be remembered that, in view of the satisfactorily established long continued use by the complainant and the subsequent official registration of such trade-marks, the burden of proof on the question of prior use is upon the defendants.”), rev’d on other grounds, 185 F. 769 (3d Cir. 1911); see also Brower v. Boulton, 58 F. 888, 890 (2d Cir. 1893) (“The statute makes the registry of a trademark prima facie evidence of title in the applicant. But the complainant’s title is overthrown by proof of an earlier title in others...”).}
presumption of ownership [and] relieves him of the burden of proof on that point.”

Likewise, a federal district court declined to overturn the Patent Office’s refusal to register a mark with the observation that:

I can readily see that damage would result to the defendant if the plaintiff were permitted to register this trade-mark, because in any suit hereafter brought against the defendant for infringement thereof the burden of disproving the plaintiff’s title to the trade-mark as against the defendant would be cast upon the latter.

Examining another 1881 Act registration, the First Circuit reached the same conclusion in the infringement context: “Under the Act of 1881 the burden is not upon the party to whom registration is granted to prove ownership, for the registration of a mark under that Act is prima facie evidence of ownership. The burden is on the defendant to disprove ownership.”

As did opinions bearing on the issue under the 1881 Act, those interpreting Section 16 of the 1905 Act left little doubt as to the significance of prima facie evidence under that statute. Section 16 provided that “the registration of a trademark under the provisions of this act shall be prima facie evidence of ownership.” That language, the Commissioner of Patents held, meant that any registration in evidence “must be regarded as legal and effective until the contrary shall be proven.”

121. Grove Labs. v. Brewer & Co., 103 F.2d 175, 183 (1st Cir. 1939).
123. Some contemporary opinions fail to identify under which statute, the 1881 Act or the 1905 Act, the registrations in question issued. One falling into this category is Deitsch v. George R. Gibson Co., 155 F. 383 (C.C.S.D.N.Y. 1907), in which the court held:

[T]he grant of a registered trade-mark to the complainants makes them prima facie owners thereof, which is but one way of saying that the burden is on any one [else], asserting the right to use the same collocation of words and figures, to prove that right.

... I have given unusual opportunity for the production of affidavits on both sides. This was done because the grant of a registered trade-mark in effect puts the burden of proof on a defendant—an inversion of the ordinary proceeding—and therefore I thought considerable care in preparation of defendant’s case was required.

Id. at 384-85 (emphasis added); see also Glenn Coal Co. v. Dickinson Fuel Co., 72 F.2d 885, 890 (4th Cir. 1934) (rejecting claim that registration of undisclosed age was fraudulently procured in part on the ground that “[i]t is true that the mere registration of the mark is not itself conclusive, but the presumption is of validity and regularity in the registration until it is overcome by proof to the contrary”).

exception, this conclusion was consistent with other holdings in the registration context, including that of the Court of Customs and Patent Appeals that:

Registration of a trade-mark under . . . the Trade-Mark Act of February 20, 1905, makes a prima facie case of ownership, and the registrant is entitled to be protected in its use of such mark. In a proceeding for the cancellation of such registered mark, the petitioner has the burden of proof.

The same rule applied in infringement actions, with one court explaining that “Section 16 of the trade-mark act of 1905 [gives a]

(Comm’r Pats. 1930) (“As the registration of a trade mark is prima facie evidence of ownership, as provided in section 16 of the Trade Mark Act of Feb. 20, 1905, the [registrant] must be held to be the owner of the trade mark . . . in the absence of proof to the contrary.”); Eugene J. Murphy Co. v. McFarland, 1 U.S.P.Q. 255, 255 (Comm’r Pats. 1929) (“The [registrants] . . . having come into legal possession of said trade-mark registration, and as the registration of said mark is prima facie evidence of ownership . . ., and as abandonment of the mark may not be presumed, it must be held in the absence of proof to the contrary, that the rights of [the registrants] continued under said registration during the life thereof . . .”).

A rare example of a court applying what is arguably a burden-of-production-shifting analysis can be found in McKesson & Robbins, Inc. v. Charles H. Phillips Chemical Co., 41 F.2d 785 (D. Conn. 1930), modified, 53 F.3d 342 (2d Cir. 1931). That opinion, however, is grounded in the court’s apparent failure to distinguish between existing registrations, on the one hand, and applications for them, on the other. Specifically, although the plaintiff before the court sought the cancellation of two registrations owned by the defendant, the court found in the plaintiff’s favor on the ground that:

The application of defendant for the registration of the trade-mark being regular in form, entitled it, prima facie, to the right to registration, but upon the introduction of plaintiff’s testimony the prima facie evidence has been overcome. It was then incumbent upon the defendant to establish its right to registration by a fair preponderance of testimony. In other words, it was incumbent upon the defendant to satisfy the court that the testimony thus introduced on behalf of plaintiff was not true. This the defendant has failed to do.

Id. at 788.

The effect of the registration . . . is simply to provide a rule of evidence which, under section 16 . . ., casts upon him who would attack the right of the registrant to the mark the burden of establishing his claim in an infringement, unfair competition, or other proper proceeding.”), rev’d on other grounds, 265 U.S. 168 (1924); Rice-Stix Dry Goods Co. v. Schwarzenbach-Huber Co., 47 App. D.C. 249, 250 (1918) (holding that “registration of the mark establishes prima facie ownership, and places the burden upon [the nonregistrant]” to prove prior use); cf. Patton Paint Co. v. Sunset Paint Co., 290 F. 326, 327-28 (C.C.P.A. 1923) (“The word ‘Sunset’ may be so used in connection with a representation of the sun as to constitute unfair competition; but in that event the opposer has an adequate remedy, which opposition to registration does not afford, accomplishing, as it does, if successful, nothing more than the shifting of the burden of proof.”).

“The trade-mark of appellant, having been registered prior to the application of the appellee, the burden of proof is upon the [appellee] and any doubts will be resolved against him.”); Robertson v. United States ex rel. Baldwin Co., 287 F. 942, 947 (C.C.P.A. 1923) (“Patton Paint Co. v. Sunset Paint Co., 290 F. 326, 327-28 (C.C.P.A. 1923) (“The word ‘Sunset’ may be so used in connection with a representation of the sun as to constitute unfair competition; but in that event the opposer has an adequate remedy, which opposition to registration does not afford, accomplishing, as it does, if successful, nothing more than the shifting of the burden of proof.”).

Rev’d on other grounds, 265 U.S. 168 (1924); Rice-Stix Dry Goods Co. v. Schwarzenbach-Huber Co., 47 App. D.C. 249, 250 (1918) (holding that “registration of the mark establishes prima facie ownership, and places the burden upon [the nonregistrant]” to prove prior use); cf. Patton Paint Co. v. Sunset Paint Co., 290 F. 326, 327-28 (C.C.P.A. 1923) (“The word ‘Sunset’ may be so used in connection with a representation of the sun as to constitute unfair competition; but in that event the opposer has an adequate remedy, which opposition to registration does not afford, accomplishing, as it does, if successful, nothing more than the shifting of the burden of proof.”).

See, e.g., Bisceglia Bros. v. Fruit Indus., 20 F. Supp. 564, 571 (E.D. Pa. 1937) (“Registration of the trade mark is prima facie evidence of its adoption and ownership, and
registration prima facie evidence of ownership, and thereby imposes upon the defendants the burden of disproving such ownership.”

Indeed, this result held even when the prima facie evidence of ownership attaching to a 1905 Act registration was equated to a “presumption.”

Although the sole provision of the 1905 Act to refer to prima facie evidence in so many words, Section 16 was not the only part of that statute with relevance to the historical meaning of the phrase. Another was Section 10, which, as does Section 10(a)(3) of the Lanham Act, governed assignments of registered marks.

Unlike its successor statute, Section 10 of the 1905 Act did not recite that a duly recorded assignment was prima facie evidence of the assignment’s execution. That omission, however, did not stop the burden of proving abandonment, laches, or acquiescence in the use by others is upon the [nonregistrant].

aff’d, 101 F.2d 275 (3d Cir. 1939); see also Rossmann v. Garnier, 211 F. 401, 405-06 (8th Cir. 1914) (Van Valkenburg, J., concurring) (“[T]he certificate [of registration] issued; this makes a prima facie case of ownership which it was incumbent upon [defendant] to overcome by satisfactory proof. . . . [A] prima facie case was made. The burden then shifted to defendant.”).


131. An example of this phenomenon appears in American Lead Pencil Co. v. L. Gottlieb & Sons, 181 F. 178 (C.C.S.D.N.Y. 1910):

Were there proof in this case that the [descriptive mark at issue] had obtained that secondary meaning, the complainant’s case would be complete. I think that proof is prima facie supplied by the registration of the mark and that that was the intention of Congress. . . .

Registration is made only prima facie proof under the statute in any case, and it would have been consistent with its general import for Congress to establish what should be prima facie proof of secondary meaning. I think by this section it intended to provide a period of time during which if an applicant himself made exclusive use of even a descriptive phrase as a trade-mark, it should be assumed to have acquired a secondary meaning. Any other person could, of course, meet that presumption by proof that it had in fact never acquired any such secondary meaning, but until he does, the mark is good under the act.

Id. at 181-82 (emphasis added); see also Plough, Inc. v. Intercity Oil Co., 26 F. Supp. 978, 982 (E.D. Pa. 1939) (“The Commissioner of Patents has granted registration of the [plaintiff’s mark] in many forms and for numerous commodities, and the approval of the term by the patent office experts creates a strong presumption of its validity as a proper trade mark . . . . To justify a finding that the words are descriptive and the registration invalid it must be shown that they apply especially to some ingredient, quality or characteristic of the [goods sold under the mark].”); Robertson v. United States ex rel. Baldwin Co., 52 App. D.C. 368, 371 (1923) (“The only effect of the registration is to raise a rebuttable presumption in favor of the registrant’s ownership. . . . If, in a contest between a registrant and one who is using the same mark upon the same class of goods, the latter can establish that he is the owner of the mark, the registration of it will avail the other party nothing.”), rev’d on other grounds, 265 U.S. 168 (1924).

As was the case in interpretations of Section 16 of the 1881 Act, see supra note 117, some courts holding that the prima facie evidence recognized by Section 16 of the 1905 Act created a presumption of validity did so without expressly explaining the burden-shifting effect of that presumption. See Chapin-Sacks Mfg. Co. v. Hendler Creamery Co., 254 F. 553, 556 (4th Cir. 1918) (“We think all presumptions from the action of the Patent Office [in registering the marks at issue] are overcome by the great weight of the evidence . . . .”).

the Court of Customs and Appeals from giving Section 10 such an effect. As that court held:

Where a trade-mark has been registered and assigned, the assignment having been acknowledged before a proper officer in accordance with the statute and placed of record agreeable to the provisions of the statute, such an assignment should be regarded as prima facie evidence of the assignee’s ownership of the mark. If such an instrument is introduced in evidence, in our opinion it is sufficient proof upon which to base a claim of ownership and use of a mark in a [cancellation] proceeding such as at bar.

Section 5(b) of the 1905 Act is equally significant, not because it expressly referred to prima facie evidence but instead because of its status as the predecessor statute to Section 2(f) of the Lanham Act. Specifically, Section 5(b) qualified the 1905 Act’s prohibitions on registration by providing that “nothing herein shall prevent the registration of any mark used by the applicant or his predecessors, . . . which was in actual and exclusive use as a trademark of the applicant . . . for ten years next preceding the passage of this act.” Addressing this language in 1914, the Supreme Court rejected the proposition that an applicant able to make the required ten-year showing might not be entitled to registration or to protect its mark:

[T]he complainant was entitled to register its mark. We need not stop to discuss the contention that the complainant’s use had not been exclusive, or that the mark had not been used in interstate commerce, or the further defense that the complainant should be denied relief because it had deceived the public. It is enough to say that these contentions were without adequate support in the evidence and were properly overruled by the circuit court.

Having the right to register its mark, the complainant was entitled to its protection as a valid trademark under the statute. . . . It was not the intention of Congress thus to provide for a barren notice of an ineffectual claim, but to confer definite rights. The applicant who, by virtue of actual and exclusive use, is entitled to register his mark under this clause, becomes on due registration the “owner” of a

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133. See Rosengart v. Ostrex Co., 136 F.2d 249, 252 (C.C.P.A. 1943) (“It seems to us that where a mark has been duly registered and assigned and the assignment is acknowledged before a proper officer and recorded in the manner and place provided for by the statute, it properly shows a transfer of title and makes a prima facie case that the mark, on and after the date of the assignment, is owned by the assignee . . . .”).

134. Id. at 252-53 (emphasis added).


“trademark” within the meaning of the act, and he is entitled to be protected in its use as such.\textsuperscript{137}

In contrast to its 1881 and 1905 predecessors, the 1920 Trademark Act did not similarly provide that registrations issued under it served as prima facie evidence of the registrant’s rights.\textsuperscript{138} In 1924, however, Congress began consideration of a series of bills that would return federal law to the prima facie evidence standard of the 1881 and 1905 Acts. The first such bill recited both that “[r]egistration of a trade-mark . . . shall be prima facie evidence of ownership,”\textsuperscript{139} and, additionally, that “[s]ubstantially exclusive use as a trade-mark for five years preceding application [for registration] shall be prima facie evidence of secondary meaning.”\textsuperscript{140} Addressing identical language in a later bill,\textsuperscript{141} a House Report explained that the latter provision was “somewhat comparable to [Section 5(b) of] the act of 1905, which provides that anyone who had 10 years’ exclusive use prior to the passage of the act should be permitted registration”;\textsuperscript{142} thus, to the extent that ten years’ worth of use necessarily established protectable rights under the 1905 Act,\textsuperscript{143} the same would apparently have been true

\textsuperscript{137} Thaddeus Davids Co. v. Davids, 233 U.S. 461, 469 (1914).

\textsuperscript{138} Because of this omission, most courts confronted with registrations issued under the 1920 Act concluded that they had no evidentiary value. See, e.g., Slaymaker Lock Co. v. Reese, 24 F. Supp. 69, 72 (E.D. Pa. 1938) (“[R]egistration under the Act of 1920 supplies no evidence of title, nor any prima facie proof of validity.” (citation omitted)). The Sixth Circuit, however, noted the following with respect to a registration issued in 1921:

The statutory registration of appellant’s trade-mark is not res judicata, but is merely prima facie evidence of ownership. But while the question of priority is still open . . . , in view of the weight which justly attaches to the decisions of the Patent Office, they are accepted by the courts as controlling upon the question of priority in any subsequent suit between the parties, unless the contrary is established by testimony which in character and amount carries thorough conviction.

Nieman v. Plough Chem. Co., 22 F.2d 73, 75 n.4 (6th Cir. 1927) (citations omitted); see also Johns-Manville Corp. v. Keasbey & Mattison Co., 35 U.S.P.Q. 99, 100 (Comm’r Pats. 1937) (holding that burden of challenger to mark registered under 1920 Act could not be sustained “by evidence which merely create[ed] a doubt” as to the mark’s validity).

\textsuperscript{139} S. 2679, 68th Cong. § 2(g) (1924).

\textsuperscript{140} Id. § 2(f).

\textsuperscript{141} See H.R. 13486, 69th Cong. § 2(f) (1926).

\textsuperscript{142} H.R. Rep. 69-2203, at 4 (1927); see also Hearings on S. 2679 Before the Joint Comm. on Patents, 68th Cong. 31 (statement of Edward S. Rogers, American Bar Association Section of Patent, Trademark and Copyright Law, reprinted in 7 Anne Gilson LaLonde, et al., Gilson on Trademarks 2-4 (2007 ed.) (“Section 2 is substantially the present law, except subdivision (e), and subsection (f), . . . which is the present law to some extent.”).

\textsuperscript{143} See, e.g., Manitou Springs Mineral Water Co. v. Schueler, 239 F. 593, 602 (8th Cir. 1917) (“We deem it unnecessary to decide whether the facts alleged bring the case within the ten-year proviso of the fifth section of the Trade-Mark Act of 1905. It is proper to say, however, that if, upon sound pleading, complainant can show an actual and exclusive use of this word as a trade-mark of itself or its predecessors, from whom it derived title, for ten years next preceding the passage of the act of 1905, it will be entitled to protection . . . .” (emphasis added)); Planten v. Gedney, 224 F. 382, 385 (2d Cir. 1915) (“If the applicant satisfied the Patent Office that the conditions required in section 5 existed—10 years’
with respect to the proto-Section 2(f) so long as it included the word “shall.”

The presence of that word in successive bills sparked considerable debate grounded in a consensus that a demonstration of five years’ exclusive use would prove the distinctiveness of an applied-for mark for registration purposes and that the prima facie evidence represented by any resulting registration would shift the burden of proof as to the validity of the registered mark. These twin propositions led to the following dialogue between a member of the Joint Committee on Patents and a representative of the New York Patent Law Association in 1925:

Mr. FRASER. That would treat marks which are registered because they have acquired secondary meaning on the same basis as other marks. That is to say, there would be no difference in the prima facie effect of registration between marks that were perfectly legitimate trade-marks and those which originally were not, but practically had acquired the status of trade-marks by reason of such long use as to give them secondary meaning.

In other words, the effect of the registration of such mark under this act will be to enable the registrant, in suing for an infringement, to simply offer his registration in evidence, and that registration of itself shall have that effect, and it will be unnecessary for him to go through the very elaborate and expensive course of evidence which is now necessary in suing at common law on a mark that is alleged by the plaintiff to have secondary meaning. So that the registrant has the advantage in a mark of secondary meaning that he would have in a normal trade-mark, of being relieved of the necessity of elaborately proving his prima facie case.

Representative REID of Illinois. If I put a trade-mark on the record it does not mean it is necessarily valid, does it?

Mr. FRASER. Yes; it is approximately that.

exclusive use—he should get his registration, even though the mark were descriptive; and registration made his trade-mark a valid one, although at common law its descriptiveness might make it invalid.”); Nashville Syrup Co. v. Coca Cola Co., 215 F. 527, 530 (6th Cir. 1914) (“Since it appears that plaintiff had enjoyed the exclusive use of the name ‘Coca Cola’ for more than 10 years before 1905, and that there was due registration under the act of 1905, it follows that plaintiff’s exclusive rights as a trademark owner . . . are established.”).

144. As one witness noted, “[w]e feel that is particularly dangerous, because after the five years the commissioner has no discretion whatsoever. He has to take as a matter of fact that there has been secondary meaning acquired.” Hearings on S. 4811 Before the Senate Comm. on Patents, 69th Cong. 27 (1927) (statement of Wallace Greene, United States Trademark Association), reprinted in 7 LaLonde, supra note 142, at 2-65 to 2-66.
There are quite a number of advantages of registration. One is that when a registrant comes into court he proves his prima facie case by producing his certificate of registration and then proving merely that the defendant has infringed. *He does not have to prove his right to the trade-mark.*

Testifying at the same hearing, Edward S. Rogers confirmed this meaning of the proposed legislation:

Representative Reid of Illinois. [Is] the unfair competition . . . forestalled by this method?

Mr. Rogers. In short, no. A man is enabled to make his proof before the Patent Office and get a certificate that this [the registered mark] does mean his goods. And then when he starts in with his case he does not have to go through the very expensive and elaborate burden of proving that it is his goods.

Indeed, it was precisely this issue that drove opposition to the bill from Arthur W. Barber of the United States Trademark Association:

Mr. Barber. Of course, this certificate of registration is only prima facie evidence. The defendant may rebut that by proving affirmatively that the plaintiff's mark has not acquired a secondary meaning. *But there you are shifting the burden of proof from the plaintiff, whose business is to prove his right, and should prove it according to the principles of common law evidence, that his mark has acquired a secondary meaning, and you are putting upon the defendant the burden of proving a negative—in other words, proving that the plaintiff has no mark which has acquired a secondary meaning.*

Hearings the following year demonstrated a continued awareness among all participants that the submission of prima facie evidence would shift the burden of proof from the proffering party to its adversary. Distinguishing the terms of the 1920 Act, a

145. *Hearings on S. 2679 Before the Joint Comm. on Patents, 68th Cong. 59, 66 (1925)*
(statements of Arthur C. Fraser, New York Patent Law Association, and Rep. Frank R. Reid), *reprinted in 7 LaLonde, supra note 142, at 2-7 to 2-8 & 8 LaLonde, supra note 95, at 33-4 (emphasis added); see also id.* at 97 (statement of New York Patent Law Association), *reprinted in 7 LaLonde, supra note 142, at 2-22 (“If the mark is one which would not be valid at common law it is not make [sic] valid by registration, and the sole effect of registration is to shift the burden of proof and create a rebuttal presumption.”)).


147. *Id.* at 122 (statement of Arthur W. Barber, United States Trademark Association), *reprinted in 7 LaLonde, supra note 142, at 2-25 (emphasis added).
critic of this approach made the following point to Rep. Albert Vestal, the Chair of the House Committee on Patents:

Mr. LYMAN. On the basis of the act of 1905 registration makes a prima facie case in court of ownership of the mark. You go into court for a mark registered under the 1905 act, and you have made out a prima facie case by simply showing a certificate of registration of the United States Government that you are entitled to the mark, and show that the defendant is copying it and rest. Then it is up to the defendant to prove that that registration was not properly issued, that you were not the first to use your mark. But that prima facie case is important in court proceedings, as it releases the plaintiff of the heavy burden of proof.

. . . .

The CHAIRMAN. Does it repeal the 1905 act or the 1920 act . . . or does this add something to them.

Mr. LYMAN. It adds something more to them. . . .

. . . .

. . . [A] certificate of registration in the 1920 Act gives no standing whatever in court. This bill puts it with the commissioner to determine whether there is any such secondary meaning, on the basis of affidavits made to him to the effect, namely, that it was used so long, and it has come to have that meaning with him. Then upon the basis of that showing the commissioner may grant that registration and the registration is going to have the same effect in court.

The CHAIRMAN. As prima facie evidence in court.

Mr. LYMAN. A man who has got such a name registered goes into court with his case made out for him, and it is up to the defendant to disprove it if he can . . . . It is a terrible burden put upon the defendant in such cases by giving the plaintiff prima facie title to such descriptive or geographic name; simply on the basis of affidavits filed in the Patent Office he has been able to get the commissioner to issue that to him. In our opinion that ought not to be done.148

The following colloquy between Chairman Vestal and Arthur W. Barber at the same hearing is further confirmation that Congress was well aware of the historical meaning of prima facie evidence as shifting the burden of proof when writing those words into the Lanham Act:

Mr. BARBER. Take the other side of it. Here is a man . . . [who] has a certificate that is prima facie evidence of his right to the use of that mark throughout the United States. What does that mean? That means that . . . this man . . . can come into a court of equity armed with a certificate of registration that under the law is prima facie evidence of his right to an injunction against my client, against your client, and he can put upon my client and your client the burden of proving a negative; that is, of proving, if disputing, and disproving a fact, the evidence of which is in his possession, not mine; the burden of breaking down that certificate by proving affirmatively that he has not had the exclusive right to that mark in the United States during that period to such an extent that it has become evidence of secondary meaning.

The CHAIRMAN. It simply means a shifting in the burden of proof. That is exactly what this section means.

Mr. BARBER. It means that, yes. And that, Mr. Chairman, is a very serious burden. 149

149. Id. at 118 (statements of Arthur W. Barber, United States Trademark Association, and Rep. Albert H. Vestal), reprinted in 7 LaLonde, supra note 142, at 2-46 (emphasis added).

Barber’s proposed solution—one not adopted by Congress then or at any later time—was to have the registrant retain the burden of proof on the issue of mark validity. His explanation of this proposal reflected his full recognition that the “prima facie evidence” language ultimately incorporated into Sections 7(b) and 33(a) would not produce such a result:

Mr. BARBER. The amendment proposes to insert . . . these words . . . :

But when in a suit such right of the registrant is put in issue by the adverse party, the courts shall require the registrant to prove affirmatively that the mark has, in fact, acquired a secondary meaning according to paragraph (f) and within what territory such secondary meaning has been acquired.

It seems to me, Mr. Chairman, that that goes a long way to remove the objection which I have made to the shifting of the burden of proof.

Id. at 119, reprinted in 7 LaLonde, supra note 142, at 2-47 to 2-48.

Responding to concerns such as those articulated by Barber, a supporter of the bill did nothing to dispute their underlying premise, namely that reaffirmation of the prima facie evidence rule would retain a shift in the burden of proof from registrants to defendants:

Mr. PAUL. I think if a man has satisfied the Commissioner of Patents that his mark has acquired a secondary meaning, he is entitled to a certificate that would be prima facie evidence if he brought suit. Now, it is said that the defendant has got to prove this [registered] mark has not acquired a secondary meaning; he has got to prove a negative. Well, how do you prove a negative in many cases; how would you prove it here, if I am the defendant? I would come in and I would prove affirmatively, that I had used that mark during that period myself and, consequently, the court would have to hold that this mark could not have acquired a secondary meaning, because you prove that other people have used that mark and, therefore, this one could not have acquired a secondary meaning by which it meant only the goods of this manufacturer. In proving the negative, you are proving the affirmative of the defense, which you would have to prove if the suit were one that was brought without any certificate of registration . . . .
This issue, which continued to make appearances in the debate over the reaffirmation of the prima facie evidence standard,\textsuperscript{150} came to a head in 1939. During that year, the House Subcommittee on Trademarks took up a bill providing in relevant part that “the certificates of registration of a trade-mark upon the principal register provided for by this act shall be presumptive evidence of the validity of the trade-mark and of [the] registrant’s exclusive right to use the same in commerce.”\textsuperscript{151} That language triggered the amendment described in the following exchange between Sylvester J. Liddy, representing the New York Patent Law Association, Edward S. Rogers of the American Bar Association, and Rep. Fritz Lanham:

Mr. LIDDY. The New York Patent Law Association made a recommendation as to subsection 7 (b), that the word “presumptive” evidence be changed to “prima facie” evidence. Our reason for that is that . . . “prima facie” has a perfectly definite meaning in the law. It is in the law now and it is a well-understood legal term. Prima facie evidence means, as you no doubt know, that it shifts the burden of proof to the other

\textsuperscript{150} In 1927, Wallace Greene, representing the United States Trademark Association, offered the following warning to the House Committee on Patents:

\textit{Hearings on H.R. 13486 Before the House Comm. on Patents, 69th Cong. 42 (1927) (statement of Wallace Greene, United States Trademark Association), reprinted in 7 LaLonde, supra note 142, at 2-60; see also id. at 81 (statement of H. McClure Johnson), reprinted in 7 LaLonde, supra note 142, at 2-64 (“Why should the Patent Office be called upon to determine when a descriptive or geographical word has reached a ‘secondary meaning’ and so give such a registrant a prima facie case without further proof in the event he goes to court with it?”). Greene repeated his objection to the Senate Committee on Patents the same year:

\textit{Hearings on S. 4811 Before the Senate Comm. on Patents, 69th Cong. 27 (1927) (statement of Wallace Greene, United States Trademark Association), reprinted in 7 LaLonde, supra note 142, at 2-65.}

\textsuperscript{151} H.R. 4744, 76th Cong. § 7(b) (1939).
side. Now, presumptive evidence is very indefinite, the same as conclusions. Some are rebuttable, and some are not, and some are in certain ways, and it is very important there not to change the legal effect of registration. If you use . . . “prima facie” here that is perfectly definite and well understood. It is a legal term much clearer than presumptive.

Mr. ROGERS. I think that is a good suggestion.

Mr. LANHAM. That the word “presumptive” . . . be changed to “prima facie” evidence.152

Congress therefore not only was advised (and warned) of the burden-of-proof-shifting effect that its adoption of the phrase “prima facie evidence” in Sections 7(b) and 33(a) would have, it affirmatively rejected the competing “presumptive evidence” alternative offered by opponents of that rule.153

Moreover, an additional action taken by Congress in the same year demonstrated its understanding that “prima facie evidence” as used in what eventually became Section 2(f) had the same meaning as in the future Sections 7(a) and 33(b). So long as the proto-Section 2(f) provided that the “Commissioner shall” accept five years’ worth of use as prima facie evidence of distinctiveness, the mandatory nature of that language continued to spark opposition on the ground that such a showing would prove the distinctiveness of the mark in question.154 In 1939, Congress responded by entertaining for the first time a bill that substituted “may” for “shall,”155 a change that was reflected in the final version


153. Indeed, with the issue having been resolved, all bills leading up to the passage of the Lanham Act to address the issue adopted the prima facie evidence rule without further objection or debate. See, e.g., H.R. 1654, 79th Cong. §§ 7(b), 33(a) (1945); H.R. 82, 78th Cong. §§ 7(b), 33(a) (1943); H.R. 5461, 77th Cong. § 7(b) (1941); S. 895, 77th Cong. §§ 7(b), 33(a) (1941).

154. As it had been earlier, see supra note 144, this point was made to the House Subcommittee on Trademarks in 1938:

Mr. LYMAN. [I]t would give the man making such claim under [Section 2(f)] a prima facie case in court against anyone else who attempted to trespass upon his domain, because if there is any one thing which is clear in justice it is that no man should be allowed to monopolize a proper name or a geographical name or a descriptive term on his goods, unless he can prove, and prove to the court as a matter of positive proof, that it has become identified with him. The burden should not be on the defendant to prove that it has become identified with him. The burden should always be on [the] claimant and to require him to prove that he has got real rights by use in that descriptive, or geographical term or proper name.


155. See H.R. 6618, 76th Cong. § 2(f) (1939).
of Section 2(f) and remains in that section today. The permissive nature of Section 2(f) is therefore due to the 1939 amendment and not to the appearance of “prima facie evidence” in the same statute; indeed, if that language were understood as obligating the USPTO merely to produce responsive evidence that an applied-for mark lacked distinctiveness before refusing to register it, there would have been no apparent need for the amendment.

In any case, the clearest possible evidence of congressional intent lies in the text of Section 33(a), which, then and now, expressly ties the prima facie evidence represented by a nonincontestable registration to a shift in the burden of proof. As enacted by Congress in 1946, Section 33(a) provided that:

Any registration issued under the Act of March 3, 1881, or the Act of February 20, 1905, or a mark registered on the principal register . . . shall be admissible in evidence and shall be prima facie evidence of [the] registrant’s exclusive right to use the registered mark in commerce on the goods and services specified in the certificate subject to any conditions of limitations stated therein, but shall not preclude an opposing party from proving any legal or equitable defense or defect which might have been asserted if such mark had not been registered.156

Because this conception of prima facie evidence already was well-established in contemporary law,157 it is hardly surprising that Rep. Lanham noted that “Section 33(a) of this act reenacts the prima facie evidence rule which is applicable from and after the date of registration of a mark under the act of March 3, 1881, the act of February 20, 1905, and under this bill”158 when summarizing the conference report on the bill that became the Lanham Act.159

156. 15 U.S.C. § 1115(a) (1982) (emphasis added). As amended by the Trademark Law Revision Act of 1988, see Pub. L. 100-667, § 129, 102 Stat. 3935, 3944, the current version of Section 33(a) retains the same structure:

Any registration issued under the Act of March 3, 1881, or the Act of February 20, 1905, or of a mark registered on the principal register provided by this Act and owned by a party to an action shall be admissible in evidence and shall be prima facie evidence of the validity of the registered mark and of the registration of the mark, of the registrant’s ownership of the mark, and of the registrant’s exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the registration subject to any conditions of limitations stated therein, but shall not preclude another person from proving any legal or equitable defense or defect, including those set forth in subsection (b), which might have been asserted if such mark had not been registered.


157. See supra notes 116-37 and accompanying text.


Any suggestion that the bill was intended to redefine “proving” as “producing evidence of” was wholly absent from his remarks.

Of course, Sections 2(f), 7(b), 10(a)(3), and 33(a) are not the only ones in which the concept of prima facie evidence appears, and, previously noted, the Federal Circuit has accorded dispositive significance to certain legislative history of Section 45’s definition of abandonment “indicating that Congress was using the term [prima facie evidence] in its presumptive sense.” Leaving aside Congress’s express rejection of the term “presumptive” in the nonincontestable registration context, as well as its tacit rejection of the term in the remainder of the Act, the legislative history in question consists of a single sentence by a single witness in which the words “presumptive” and “presumption” are used. There is no indication in either that testimony or any other in the hearing in which it was delivered that the witness (much less Congress) proposed to convert the well-understood definition of prima facie evidence into a “presumption” within the meaning of FRE 301— not surprisingly, as FRE 301’s adoption lay nearly three decades in the future.

More to the point, there is evidence even in the legislative history of Section 45 that prima facie evidence of abandonment was meant to shift the burden of proof from defendants to claimed mark owners. Thus, for example, in comments more directly on point than the testimony relied upon by the Federal Circuit in Cerveceria Centroamericana, the National Confectioners’ Association observed in a 1927 comment to the House Committee on Patents that:

Section 13(b), page 17 [of H.R. 134806, 69th Cong.], relative to “cancellation,” contains the following sentence: “Nonuse by the registrant for more than two years shall be prima facie evidence of abandonment.”

Abandonment is a question of fact and intent which should not be established by prima facie evidence. Therefore, in my opinion, it will be a mistake to include such a provision in the bill.

Once again, Congress included the prima facie evidence standard, rather than any alternatives that may have been available, notwithstanding its having been warned about that standard’s
possible effect. Contemporary recognition that a proffering party’s burden of proof could be discharged through the submission of prima facie evidence therefore extended to the abandonment context as well.\textsuperscript{163}

The most recent congressional action bearing on the issue came in 1999, during which Congress itself used the word “presumption” in connection with the evidentiary value of registrations for the first time. In passing the Trademark Amendments Act,\textsuperscript{164} Congress codified Section 43(a)(3) of the Lanham Act, which provides that “[i]n a civil action for trade dress infringement under this chapter for trade dress not registered on the principal register, the person who asserts trade dress protection has the burden of proving that the matter sought to be protected is not functional.”\textsuperscript{165} The accompanying House report explained of the new Section 43(a)(3) that:

[W]here the matter sought to be protected is not registered with the U.S. Patent and Trademark Office, the plaintiff has the burden of proving that the trade dress is not functional. . . . If a mark is registered, there is a presumption that it is not functional. However, for plaintiffs of unregistered marks to be given the same presumption would not promote fair competition or registration. . . . Therefore, it should be incumbent on the plaintiff suing for the infringement of an unregistered mark to prove that the mark is not functional.\textsuperscript{166}

This juxtaposition of “presumption” with “burden of proving” is therefore further documentation of congressional understanding that federal registration shifts the burden of proof on the issue of mark validity, even if that shift is characterized as a presumption.

\textbf{B. Microsoft Corp. v. i4i Ltd. Partnership and the Significance of Common-Law “Clusters of Ideas”}

Prior to 2011, courts might well have treated (and some obviously did treat) the legislative history and pre-1946 case law discussed above as having been trumped by the 1975 adoption of FRE 301 and that rule’s mandate that statutory presumptions

\begin{footnotesize}
\textsuperscript{163} Other legislative history consisting of the testimony of a future Assistant Commissioner for Trademarks does not identify the burden that would be shifted by non-use of a mark for the statutory period: “The bill provides that discontinuance of use for more than 2 consecutive years shall be prima facie abandonment. It would shift the burden to the registrant.” \textit{Hearings on H.R. 82 Before a Subcomm. of the Senate Comm. on Patents}, 78th Cong. 24 (1944) (statement of Daphne Robert), reprinted in 9 LaLonde, supra note 158, at 45-30. Once again, however, there is nothing to suggest that the referenced shift would be of the burden of production, rather than the usual shift in the burden of proof effected by the submission of prima facie evidence under the 1881 and 1905 Acts.


\end{footnotesize}
ordinarily will shift only the burden of production. In that year, the Supreme Court addressed the burden-shifting effect of Section 282 of the Patent Act of 1952, which codifies two propositions. On the one hand, Section 282 provides that “[a] patent shall be presumed valid”; on the other hand, the same statute also recites that “[t]he burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting such invalidity.”

The precise burden under Section 282 faced by a challenger to a patent reached the Court in Microsoft Corp. v. i4i Ltd. Partnership, a case in which the petitioner had been found liable for infringement of a patent, the validity of which the petitioner had unsuccessfully attacked at trial. Objecting to a jury instruction that “[the petitioner] has the burden of proving invalidity by clear and convincing evidence,” the petitioner argued to the Court that, especially because it allegedly had presented evidence of invalidity not considered by the U.S. Patent and Trademark Office, it need only have shown invalidity by a mere preponderance of the evidence. In affirming, the Court held this argument wanting for a variety of reasons, including several that are directly relevant to the burden properly imposed on a litigant faced with prima facie evidence under the Lanham Act.

Because the petitioner did not dispute that it bore the burden of proof on the issue of validity, the precise issue before the Court was what standard of proof applied in the petitioner’s attack on the respondents’ patent. The Court began its analysis of that issue by noting that “[w]here Congress has prescribed the governing standard of proof, its choice controls absent ‘countervailing constitutional constraints.’” Nevertheless, this observation did not resolve the matter. Rather, “by its express terms, § 282 establishes a presumption of validity, and it provides that a challenger must overcome that presumption to prevail on an invalidity defense. But, while the statute explicitly specifies the burden of proof, it includes no express articulation of the standard of proof.”

168. Id.
170. Quoted in id. at 2244.
171. Id. (quoting Steadman v. SEC, 450 U.S. 95 (1981)).
172. Id. at 2245.

The Court’s holding that the presence of the word “establishing” in Section 282 defines the burden of proof in the burden-of-persuasion sense under that statute obviously disposes of the Eleventh Circuit’s holding in Cumulus Media, Inc. v. Clear Channel Communications, Inc., 304 F.3d 1167, 1176 (11th Cir. 2002), that “establish’ no more clearly corresponds to ‘produce’ or ‘persuade’ than does ‘demonstrate.’” See supra note 112 and accompanying text. It also is consistent with pre- and post-Lanham Act trademark jurisprudence using “establish” in the same manner. See, e.g., Cerveceria Centroamericana, S.A. v. Cerveceria India, Inc., 892 F.2d 1021, 1023 (Fed. Cir. 1989) (“Because a trademark
This led the Court to examine the nature of the presumption of validity provided for by Section 282:

We begin, of course, with the “assumption that the ordinary meaning of the language” chosen by Congress “accurately expresses the legislative purpose.” But where Congress uses a common-law term in a statute, we assume the “term . . . comes with a common law meaning, absent anything pointing another way.” Here, by stating that a patent is “presumed valid,” Congress used a term with a settled meaning in the common law.173

How, then, to determine that settled meaning? According to the Court, the answer lay in its 1934 decision in Radio Corp. of America v. Radio Engineering Laboratories,174 which predated Section 282’s enactment by eighteen years. After reviewing the then-extant case law on the showing necessary to invalidate a patent, the RCA Court had concluded that “one . . . who assails the validity of a patent fair upon its face bears a heavy burden of persuasion and fails unless his evidence has more than a dubious preponderance.”175 The i4i Court’s observations on RCA merit reproduction at length:

The common-law presumption [of validity], in other words, reflected the universal understanding that a preponderance standard of proof was too “dubious” a basis to deem a patent invalid.

Thus, by the time Congress enacted § 282 and declared that a patent is “presumed valid,” the presumption of patent validity had long been a fixture of the common law. According

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174. 293 U.S. 1 (1934) (“RCA”).

175. Id. at 8.
to its settled meaning, a defendant raising an invalidity defense bore “a heavy burden of persuasion,” requiring proof of the defense by clear and convincing evidence. That is, the presumption encompassed not only an allocation of the burden of proof but also an imposition of a heightened standard of proof. Under the general rule that a common-law term comes with its common-law meaning, we cannot conclude that Congress intended to “drop” the heightened standard of proof from the presumption simply because § 282 fails to reiterate it expressly. On the contrary, we must presume that Congress intended to incorporate the heightened standard of proof, unless the statute otherwise dictates.176

With respect to Section 282’s use of the phrase “presumed valid,” the Court acknowledged that “it may be unusual to treat a presumption as alone establishing the governing standard of proof.”177 Nevertheless:

[G]iven how judges . . . repeatedly understood and explained the presumption of patent validity, we cannot accept [the] argument that Congress used the words “presumed valid” to adopt only a procedural device for shifting the burden of production or for shifting the burden of production and the burden of persuasion. Whatever the significance of a presumption in the abstract, basic principles of statutory construction require us to assume that Congress meant to incorporate the cluster of ideas attached to the common-law term it adopted. And RCA leaves no doubt that attached to the common-law presumption of patent validity was an expression as to its “force”—that is, the standard of proof required to overcome it.178

The Court then turned its attention to the significance of FRE 301. It was unconvinced by the petitioner’s argument that a clear and convincing evidence standard of proof would “conflict[ ] with the usual understanding of presumptions” as expressed in the rule.179 Instead, the Court held:

That Rule . . . postdates the 1952 [Patent] Act by nearly 30 years, and it is not dispositive of how Congress in 1952 understood presumptions generally, much less the presumption of patent validity. In any case, the word “presumption” has often been used when another term might be more accurate.180

176. i4i, 131 S. Ct. at 2246 (citations omitted) (internal quotation marks omitted).
177. Id.
178. Id. at 2246-47.
179. Quoted in id. at 2247 n.6.
180. Id.
Consequently, because “the presumption of patent validity had an established meaning traceable to the mid-19th century . . . the language Congress selected reveals its intent not only to specify that the defendant bears the burden of proving invalidity but also that the evidence in support of the defense must be clear and convincing.”

Two aspects of the Court’s methodology establish that, properly interpreted, prima facie evidence under the Lanham Act shifts the burden of proof from the proffering party to its adversary. The first is the Court’s conclusion that, because it recites that “[t]he burden of establishing invalidity of a patent . . . shall rest on the party asserting such invalidity,” \(^{182}\) Section 282 “explicitly specifies the burden of proof.” \(^{183}\) Although Sections 2(f), 7(b), 10(a)(3), and 45 of the Lanham Act do not expressly address the issue of what showing is necessary to overcome the prima facie evidence recognized under them, Section 33(a) does do so. Specifically, it provides that the prima facie evidence of validity and ownership attaching to a nonincontestable registration “shall not preclude another person from proving any legal or equitable defense or defect . . . which might have been asserted if such mark had not been registered.” \(^{184}\) If \(i4i\) is correct that “[w]here Congress has prescribed the governing standard of proof, its choice controls absent countervailing constitutional constraints,” \(^{185}\) the same necessarily must be true in the context of statutorily mandated burdens of proof. Indeed, the Court itself appears to have taken the word “proving” in the pre-1988 version of Section 33(a) at face value:

Before a mark achieves incontestable status, registration provides prima facie evidence of the registrant’s exclusive right to use the mark in commerce. The Lanham Act expressly provides that before a mark becomes incontestable an opposing party may prove any legal or equitable defense which might have asserted if the mark had not been registered. \(^{186}\)

The second aspect of \(i4i\) with direct relevance to the meaning of prima facie evidence under the Lanham Act is the Court’s rejection of the argument that the ex post adoption of FRE 301 can

\(^{181}\) Id. at 2248 n.7.
\(^{182}\) Id. at 2248.
\(^{183}\) Id. at 2245.
\(^{184}\) 15 U.S.C. § 1115(a) (2012). The language “proving any legal or equitable defense or defect” also appeared in the original version of Section 33(a), which provided that a certificate or registration was prima facie evidence of the registrant’s exclusive right to use the registered mark in connection with the goods or services recited in the certificate. See supra note 156 and accompanying text.
\(^{185}\) \(i4i\), 131 S. Ct. at 2444 (emphasis added) (internal quotation marks omitted).
trump the “cluster of ideas attached to [a] common-law term” adopted by Congress. On this issue, it is significant that the statute at issue in i4i incorporated the word “presumed,” yet that express reference to a presumption did not bring the statute’s operation within the operation of FRE 301. In contrast, the word “presumed” appears nowhere in the Lanham Act, and, indeed, the legislative history of at least Section 7(b) establishes that Congress deliberately and unambiguously chose to reject a presumptive evidence rule in favor of the prima facie evidence language appearing throughout the Act. The practice in some jurisdictions of second-guessing that choice does violence to the principle that interpretations of the Lanham Act “must begin with the language employed by Congress.”

To borrow the i4i Court’s language, the common-law “cluster of ideas” underlying the Lanham Act’s references to prima facie evidence also is significant. Because of the dual nature of the burden of proof, Section 33(a)’s express text and the flood of references to shifts in the burden of proof in the case law and in the Lanham Act’s legislative history could conceivably be explained away as inartfully worded allocations of the burden of production, not persuasion. Even outside of trademark law, however, the specter of courts using the word “proof” when referring to the burden of production historically has been more a topic of academic discussion than an actual phenomenon in judicial opinions. Indeed, as early as 1923, the Supreme Court noted in

187. See i4i, 131 S. Ct. at 2247 (internal quotation marks omitted).

188. Indeed, despite invoking FRE 301, even the petitioner in i4i did not argue that it was obligated only to produce evidence of the invalidity of the respondents’ patent. Instead, it acknowledged that it bore the burden of proving invalidity; the issue presented for the Court’s consideration therefore was only what the standard of proof should be.

189. See supra notes 151-53 and accompanying text.

190. Park ’N Fly, 469 U.S. at 194.

191. i4i, 131 S. Ct. at 2247 (citation omitted).

192. On this issue, it is telling that the primary authorities cited in support of the view that the burden of proof properly can consist of either the burden of persuasion or the burden of production are inevitably works of legal scholarship, often by Professor Thayer, rather than precedential opinions from U.S. courts. See, e.g., Fleming James, Jr. et al., Civil Procedure § 7.12, at 414 (5th ed. 2001); Louis Kaplow, Burden of Proof, 121 Yale L.J. 738, 743 n.5 (2012); Laurens Walker, The Other Rules of Civil Procedure, 25 Rev. Litig. 79, 88-89 (2006); The Evidence Project: Proposed Revisions to the Federal Rules of Evidence With Supporting Commentary, 171 F.R.D. 330, 429 n.9 (1997); Alex Stein, Allocating the Burden of Proof in Sales Litigation: The Law, Its Rationale, A New Theory, and Its Failure, 50 U. Miami L. Rev. 335, 336 (1996); Kenneth F. Berg, The Bail Reform Act of 1984, 34 Emory L.J. 685, 726 n.177 (1985); James, supra note 10, at 51; John T. McNaughton, Burden of Production: Evidence: A Function of a Burden of Persuasion, 68 Harv. L. Rev. 1382, 1382 (1955); Edmund M. Morgan, The Future of the Law of Evidence, 29 Tex. L. Rev. 587, 589 (1951). In light of Professor Thayer’s contributions to, and continued stature in, the field, this is an understandable practice that this article neither intends nor presumes to criticize. That practice does, however, suggest that recognition of the dual conception of the burden of proof is, and always has been, more honored in theory than in reality.
that “it will not be necessary to repeat the distinction . . . between the burden of proof and the necessity of producing evidence to meet that already produced. The distinction is now very generally accepted, although often blurred by careless speech.” And, in interpreting the Administrative Procedure Act (APA)—passed in the same year as the Lanham Act by the same

Indeed, although also invoking English and Scottish law, one of Thayer’s more commonly cited works identifies only a single opinion from a U.S. court, Powers v. Russell, 30 Mass. (13 Pick.) 69 (1832), for the proposition that competing theories are covered by the umbrella of the burden of proof. See Thayer, supra note 17, at 60-62. Contrary to Thayer’s suggestion, however, the Supreme Judicial Court of Massachusetts did not unambiguously hold in Powers that the burden of proof and the burden of production were synonymous. Instead, that proposition was true only “[i]n a certain sense”:

It may be useful to say a word upon the subject of the burden of proof. It was stated here, that the plaintiff had made out a prima facie case, and, therefore, the burden of proof was shifted and placed upon the defendant. In a certain sense this is true. Where the party having the burden of proof establishes a prima facie case, and no proof to the contrary is offered, he will prevail. Therefore the other party, if he would avoid the effect of such prima facie case, must produce evidence, of equal or greater weight, to balance and control it, or he will fail. Still the proof upon both sides applies to the affirmative or negative of one and the same issue, or proposition of fact; and the party whose case requires the proof of that fact, has all along the burden of proof. It does not shift, though the weight in either scale may at times preponderate.

Id. at 76. Thus, even under Powers, a party confronted with its opponent’s prima facie case could not escape liability merely by producing some cognizable evidence supporting its position: On the contrary, it was required to rebut that case by “evidence[ ] of equal or greater weight,” a burden consistent with the modern-day burden of proof, not of production.

An opinion cited approvingly by another of Thayer’s works, see James B. Thayer, A Preliminary Treatise on Evidence at the Common Law 355 (1898), is Central Bridge Corp. v. Butler, 68 Mass. (2 Gray) 130 (1854), but that also clearly distinguishes between the burden of proof, which remained with the plaintiff, and the defendant’s production of evidence in response to the plaintiff’s allegations of liability:

The burden of proof and the weight of evidence are two very different things. The former remains on the party affirming a fact in support of his case, and does not change in any aspect of the cause; the latter shifts from side to side in the progress of a trial, according to the nature and strength of the proofs offered in support or denial of the main fact to be established. In the case at bar, the averment which the plaintiff was bound to maintain was, that the defendant was legally liable for the payment of tolls. In answer to this, the defendant did not aver any new and distinct fact; such as payment, accord and satisfaction, or release; but offered evidence to rebut this alleged legal liability. By so doing, he did not assume the burden of proof, which still rested on the plaintiffs; but only sought to rebut the prima facie case which the plaintiffs had proved against him. The ruling of the court on this point was therefore right.

Id. at 132. Like Powers, Central Bridge Corp. therefore does not support the argument that U.S. courts were routinely referring to the burden of production as the burden of proof. Even taking into account the economy of citations characteristic of nineteenth-century legal scholarship, whether the extensive discussions of the issue that have arisen since then have been built upon solid moorings is open to question. Cf. Kaplan, supra, at 741-42 (commenting on the “greater attention . . . devoted to the production burden” compared to that given to the burden of persuasion).

194. Id. at 594.
Congress that codified the word “proving” in Section 33(a)—the Court held in 1994 that:

The emerging consensus on a definition of burden of proof was reflected in the evidence treatises of the 1930’s and 1940’s. “The burden of proof is the obligation which rests on one of the parties to an action to persuade the trier of the facts, generally the jury, of the truth of a proposition which he has affirmatively asserted by the pleadings.”

We interpret Congress’ use of the term “burden of proof” in light of this history, and presume Congress intended the phrase to have the meaning generally accepted in the legal community at the time of enactment. These principles lead us to conclude that the drafters of the APA used the term “burden of proof” to mean the burden of persuasion. As we have explained, though the term had once been ambiguous, that ambiguity had largely been eliminated by the early 20th century. After Hill, courts and commentators almost unanimously agreed that the definition was settled. And Congress indicated that it shared this settled understanding, when in the Communications Act of 1934 it explicitly distinguished between the burden of proof and the burden of production. Accordingly, we conclude that as of 1946 the ordinary meaning of burden of proof was burden of persuasion, and we understand the APA’s unadorned reference to “burden of proof” to refer to the burden of persuasion.196

The circa-1946 “settled understanding” referred to by the Court is borne out in the history of the Lanham Act’s references to prima facie evidence. Well before 1946, judicial interpretations of Section 7 of the 1881 Act and of Section 16 of the 1905 Act had established that the introduction of prima facie evidence, 197 even when courts referred to such a showing as creating a “presumption.”

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197. See supra notes 116-31 and accompanying text.

198. See, e.g., Glenn Coal Co. v. Dickinson Fuel Co., 72 F.2d 885, 890 (4th Cir. 1934) (“It is true that the mere registration of the mark is not itself conclusive, but the presumption is of validity and regularity in the registration until it is overcome by proof to the contrary.” (emphasis added)); Am. Lead Pencil Co. v. L. Gottlieb & Sons, 181 F. 178, 182 (C.C.S.D.N.Y. 1910) (“Registration is made only prima facie proof under the statute . . . and it would have been consistent with its general import for Congress to establish what should be prima facie proof of secondary meaning. . . . Any other person could, of course, meet that presumption by proof that [the registered mark] had in fact never acquired any such secondary meaning, but until he does, the mark is good under the act.” (emphasis added)); Robertson v. United States ex rel. Baldwin Co., 52 App. D.C. 368, 371 (1923) (“The only effect of the registration is to raise a rebuttable presumption in favor of the registrant’s ownership. . . . If, in a contest between a registrant and one who is using the same mark upon the same class of goods, the latter can establish that he is the owner of the mark, the registration of it will
In codifying references to prima facie evidence in the Lanham Act, Congress therefore did not undertake a leap in the dark: On the contrary, it took the action it did precisely because “prima facie is perfectly definite and well understood.” And what was the “perfectly definite and well understood” meaning of that phrase? In the words of Chairman Vestal, “[i]t simply means a shifting in the burden of proof. That is exactly what [it] means.” If, as the Court concluded, FRE 301 cannot change the circa-1952 meaning of Section 282, that prohibition should apply with equal force to the Lanham Act, the relevant language of which was passed and took effect even earlier than Section 282. Moreover, at least where Section 33(a) is concerned, that relevant language has the additional effect of qualifying the Lanham Act as a “civil action[ ] and proceeding[ ] . . . otherwise provided for by Act of Congress” to which FRE 301 on its face does not apply.

This obviously does not resolve the question of whether the stray references to “presumptions” in the legislative history of Section 43(a)(3), which was enacted after the adoption of FRE 301 as part of the Trademark Amendments Act of 1999, can have such an ex post effect, but the Supreme Court’s sole interpretation of that statute precludes such a result. In TrafFix Devices, Inc. v. Marketing Displays, Inc., the Court confronted a claim of trade dress protection to a product configuration, which, in addition to being unregistered, was addressed by the disclosure of two utility patents secured by the respondent’s predecessor. The Court reversed a holding in the respondent’s favor by noting of the burden-shifting effect of Section 43(a)(3) that:

[Section 43(a)(3)] provides: “In a civil action for trade dress infringement under this chapter for trade dress not registered on the principal register, the person who asserts rights trade dress protection has the burden of proving that the matter sought to be protected is not functional.” This burden of proof

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201. *Cf. NLRB v. Amax Coal Co., 453 U.S. 322, 329 (1981) (“Where Congress uses terms that have accumulated settled meaning under either equity or the common law, a court must infer, unless the statute otherwise dictates, that Congress means to incorporate the established meaning of these terms.”).


203. *See supra notes 164-66 and accompanying text.

gives force to the well-established rule that trade dress protection may not be claimed for product features that are functional. . . .

The principal question in this case is the effect of an expired patent on a claim of trade dress infringement. A prior patent, we conclude, has vital significance in resolving the trade dress claim. A utility patent is strong evidence that the features therein claimed are functional. If trade dress protection is sought for those features the strong evidence of functionality based on the previous patent adds great weight to the statutory presumption that features are deemed functional until proved otherwise by the party seeking trade dress protection. Where the expired patent claimed the features in question, one who seeks to establish trade dress protection must carry the heavy burden of showing that the feature is not functional, for instance by showing that it is merely an ornamental, incidental, or arbitrary aspect of the device.205

The Court’s opinion is devoid of any suggestion that Section 43(a)(3)’s unambiguous language means anything but what it says;206 likewise, any discussion of a possible shift in the burden of production is conspicuously absent. TrafFix’s interchangeable use of “burden of proof” and “statutory presumption” demonstrates that there would be no inconsistency between the two concepts even if the latter words actually appeared in Section 43(a)(3) or anywhere else in the Lanham Act.

It is, of course, true that the pre-1946 judicial interpretations of prima facie evidence cited in this article bear on the mark validity and ownership inquiries rather than the abandonment-related issues addressed by Section 45. This is hardly surprising in light of the absence of any predecessor to that statute in the 1881 and 1905 Acts, but it does raise the question of whether prima facie evidence has a different meaning under Section 45 than it does under the remainder of the Lanham Act. If so, there would be no incongruity between the seemingly inconsistent holdings by the Federal Circuit in particular that prima facie evidence of mark validity must be overcome by a preponderance of the evidence but that prima facie evidence of abandonment mandates only the production of responsive evidence.207


206. See also TrafFix, 532 U.S. at 32 (“As we have noted, even if there was no previous utility patent the party asserting trade dress protection has the burden to establish the nonfunctionality of the alleged trade dress features.”).

207. See supra notes 91-96 and accompanying text.
The Act’s legislative history, however, is devoid of suggestions that Congress envisioned the competing definitions of prima facie evidence recognized by the *Cerveceria Centroamericana* court—indeed, there is no direct evidence that Congress contemplated shifts in the burden of production at all, even when references to “presumptions” drifted into the debate. Of equal importance, such an approach violates the *in pari materia* canon of statutory construction long applied by the Supreme Court, under which “statutes addressing the same subject matter generally should be read ‘as if they were one law.’” This canon does not depend on the statutes in question having been enacted simultaneously, but “the rule’s application certainly makes the most sense when the statutes were enacted by the same legislative body at the same time.”

This is a circumstance that certainly is the case where Sections 2(f), 7(b), 10(a)(3), 33(a), and 45 are concerned, and, indeed, courts and the Trademark Trial and Appeal Board alike have recognized in other contexts that the various provisions of the Lanham Act should be interpreted *in pari materia*. Those courts include the Federal Circuit, which, contrary to its approach to Section 45 in *Cerveceria Centroamericana*, has held that “Section 2(d) should be construed *in pari materia* with the rest of the Act and the historical policies known to underlie it.” Those courts also include district courts which have held, inter alia, that “Sections 1113, 1112, 1063, 1062 of Title 15, U.S.C. are to be construed in

208. *See, e.g.*, *Hearings on S. 2679 Before the Joint Comm. on Patents, 68th Cong. 61, 97 (1925)* (statement of New York Patent Law Association), reprinted in *7 LaLonde*, *supra* note 142, at 2-22 (“If the mark is one which would not be valid at common law it is not make [sic] valid by registration, and the sole effect of registration is to shift the burden of proof and create a rebuttal presumption.”).

209. *Wachovia Bank v. Schmidt*, 546 U.S. 303, 315-316 (2006) (quoting *Erlenbaugh v. United States*, 409 U.S. 239, 243 (1972)); *see also* *IBP, Inc. v. Alvarez*, 546 U.S. 21, 34 (2005) (referring to “normal rule of statutory interpretation that identical words used in different parts of the same statute are generally presumed to have the same meaning”); *Black’s Law Dictionary* 862 (9th ed. 2009) (“It is a canon of construction that statutes that are in pari materia may be construed together, so that inconsistencies in one statute may be resolved by looking at another statute on the same subject.”).

210. *See, e.g.*, *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.”).


212. *See, e.g.*, *Selfway, Inc. v. Travelers Petroleum, Inc.*, 579 F.2d 75, 80 (C.C.P.A. 1978) (“In order to determine which remedies are available in [cancellation proceedings, interferences, and opposition] proceedings, it is necessary to resort to §§ 2(d), 14, 16, 17, and 18 of the Lanham Act (15 U.S.C. §§ 1052(d), 1064, 1066, 1067, and 1068, respectively) dealing with the substance and procedure of these inter partes contests. Statutes in pari materia are to be construed together.”).

213. *Bongrain Int’l (Am.) Corp. v. Delice de France, Inc.*, 811 F.2d 1479, 1485 (Fed. Cir. 1987)).
pari materia”214 and that “Section 38 [of the Lanham Act] should be read in pari materia with sections 14(c) and 33(b)(1) . . . .”215 There is no apparent reason why Section 45 should be treated any differently;216 rather, as the Board has noted in an application of another of Section 45’s definitions, “[t]he ‘normal rule of statutory construction’ is ‘that identical words used in different parts of the [Lanham Act] are intended to have the same meaning.’”217

This principle renders moot the respective conclusions of the Eleventh Circuit and the Federal Circuit that the legislative history of Section 45 is “equivocal,”218 and “ambivalent, or at least ambiguous.”219 Because the same is not true of the treatment of that phrase by the legislative history of the Act as a whole, the better approach from both a doctrinal and a normative perspective is one recognizing that the 79th Congress meant one thing and one thing only when it codified the phrase “prima facie evidence” in those statutes. And, as set forth above, what Congress meant was that the submission of prima facie evidence would result in a shift in the burden of proof, not production.

V. CONCLUSION

A significant difference exists between evidence that shifts the burden of proof to the nonproffering party, on the one hand, and evidence that merely creates a presumption that “vanishes” upon a showing of any contrary evidence, on the other. Indeed, the Supreme Court has noted that “[w]here the burden of proof lies on a given issue is, of course, rarely without consequence and frequently may be dispositive to the outcome of the litigation . . . .”220 The varying treatments of prima facie evidence under the Lanham Act have produced a fog of inter- and intra-circuit conflicts that may have just such a dispositive effect in a number of cases. At best, they deprive litigants of clear rules defining when a proffer of prima facie evidence obligates the nonproffering party to attack or defend; at worst, they provide an

216. Cf. In re Silenus Wines, Inc., 557 F.2d 806, 812 (C.C.P.A. 1977) (“We see no basis for the meaning of commerce in the registration context to be different from the meaning in the infringement context, particularly since the meanings both derive from the same definition in [Section 45].”).
218. See Cumulus Media, Inc. v. Clear Channel Commc’ns, Inc., 304 F.2d 1167, 1176 (11th Cir. 2002).
opportunity for forum shopping in cases in which mark validity and ownership depend in part on that evidence.

Whether considered separately or together, the express text of Section 33(a) of the Act, the Act’s legislative history, and judicial interpretations of the Act’s predecessors establish that the introduction of prima facie evidence under the Act should shift the burden of proof in the burden-of-persuasion sense. Congress’s 1946 codification of “prima facie evidence” in Sections 2(f), 7(b), 10(b)(3), and 33(a) of the Act did not contemplate a mere shift in the burden of production, and the absence of unambiguous legislative history concerning Section 45’s definition of abandonment does not warrant a reading of that statute at odds with the remainder of the Act. Of equal importance, the Supreme Court’s holding in *i4i* prevents FRE 301 from retroactively changing a meaning of “prima facie evidence” established by pre-1946 judicial opinions and clearly understood by the Act’s drafters and opponents alike. To paraphrase the *i4i* Court, “[s]quint as we may,”221 the authors fail to see that FRE 301’s presumption analysis has any place in the interpretation or application of prima facie evidence under the Lanham Act. Should it have the occasion to resolve the current confusion among the lower courts on this issue, the Supreme Court therefore should bring the case law into conformity with clear congressional intent and the Court’s own holding in *i4i*.

221. *See i4i*, 131 S. Ct. at 2247.