

INSIGHTS

Supreme Court Grants Cert on Trademark "Tacking"

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Last week, the Supreme Court of the United States granted a writ of certiorari in *Hana Financial, Inc. v Hana Bank*. The issue presented is whether trademark "tacking" is an issue of fact for a jury or an issue of law for the court. The United States Court of Appeals for the Ninth Circuit held that tacking is a factual question for a jury to determine. The petitioner argued that the Ninth Circuit's ruling conflicts with rulings of the Sixth and Federal Circuits as well as the Trademark Trial and Appeal Board.

The doctrine of trademark "tacking" exists to permit a trademark owner to make minor changes to a trademark such that the new and old versions are "legal equivalents" and thus allows a trademark owner to "tack" its earlier use to the later mark. This doctrine is used only in narrow circumstances and would allow a trademark owner to defend its trademark rights and maintain its earlier first use date when, for example, it updates or "refreshes" an older mark. This type of update or refresh is commonly done with packaging trade dress.

In the *Hana Financial* case, Hana Financial alleged that the defendants' use of "Hana Bank" was infringing its trademark rights. The defendants argued that it could tack "Hana Overseas Korean Club" to its later use of "Hana World Center" and that "Hana World Center" could then be tacked to "Hana Bank." Defendants argued, therefore, that they had priority over plaintiff and thus plaintiff's infringement claims should fail. The district court submitted the issue to the jury which ruled for the defendants. The Ninth Circuit affirmed acknowledging that the result might be different if tacking were considered a legal issue. The petition for certiorari followed. A briefing schedule has not yet been set.