



Much Ado About Tacking

On Wednesday, the U.S. Supreme Court issued a rare trademark decision. In *Hana Financial, Inc. v. Hana Bank*, the Court held that whether an original trademark and revised trademark are “legal equivalents” and “create the same, continuing commercial impression” is a question for a jury. As a result, absent summary judgment, a trademark litigation party is entitled to a jury decision on whether the original trademark and revised trademark can be “tacked” for determining which party in the trademark dispute has priority.

In reaching its unanimous decision, the Court acknowledged that tacking requires a highly fact-sensitive inquiry and that “[a]pplication of a test that relies upon an ordinary consumer’s understanding of the impression that a mark conveys falls comfortably within the ken of a jury.” At the same time, the Court recognized that tacking is a mixed question of law and fact, leaving open the possibility of *de novo* review of jury tacking determinations on appeal. The Court also noted two common exceptions when a judge can decide the issue of tacking – on summary judgment and during bench trials.

In its decision, the Court also noted that tacking only applies in “exceptionally narrow circumstances.” This fact evokes two questions. First, why did the highest court entertain a case involving such an obscure trademark doctrine? Second, why should brand owners care about this ruling?

The U.S. Supreme Court’s decision helps demystify highly-technical trademark rules by emphasizing that most trademark disputes boil down to how an ordinary person or community would act. And juries are well equipped to serve the role of the ordinary person or community. Parties in trademark disputes are not entitled to any greater degree of predictability than parties in tort or contract disputes, or criminal defendants.

Even though tacking applies only in “exceptionally narrow circumstances,” brand owners update and modernize their trademarks regularly. And these brand owners often take for granted their ability to tack their revised trademarks to their original trademarks for trademark enforcement purposes. As a result,

trademark revisions should involve not only the marketing department, but also the legal department and outside brand management counsel, so they can together determine (1) whether priority is a critical topic for the particular trademark, and (2) if so, whether the proposed trademark revisions will jeopardize the brand owner's priority.

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