

## Practice Update

# Supreme Court Holds That Trademark Tacking is an Issue for the Jury

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In trademark law, rights in a trademark are determined by the date of the mark's first use in commerce, and the party who first uses the mark in commerce has priority over other users. Under the doctrine of "tacking," under certain circumstances, a new mark may be given the priority position of a prior usage. In other words, a party may slightly modify a trademark but maintain priority based on the original first use date. Generally, tacking is available when the original mark and the new mark are "legal equivalents" in that they create the same, continuing commercial impression such that consumers consider both as the same mark (*i.e.*, whether a new mark is similar enough to an older version).

In *Hana Financial, Inc. v. Hana Bank et al.*, 574 U.S. \_\_\_, No. 13-1211 (2015), the Supreme Court addressed the question of whether a judge or a jury should decide whether two trademarks may be tacked for purposes of determining priority. Justice Sotomayor delivered the opinion for a unanimous Court, which affirmed the judgment of the Ninth Circuit and held that tacking is a jury issue, not an issue for the court in the first instance. Characterizing tacking as a mixed question of law and fact, the Court reasoned that the jury was the appropriate decision maker, since the commercial impression of a mark is

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determined from the perspective of an ordinary consumer. The Court did note, however, that where the facts so warrant, a judge may decide the tacking issue on a motion for summary judgment or for judgment as a matter of law.

The Court in *Hana* rejected each petitioner's arguments in support of its view that tacking is a question of law to be resolved by a judge. First, the Court explained that mixed questions of fact and law have typically been resolved by juries, and concerns that juries will not properly apply the relevant legal standard can be remedied by careful jury instructions. Second, the Court dismissed petitioner's argument that tacking determinations will "create new law...a task reserved for judges," noting that it was not clear how a tacking determination would "create new law" any more than a jury verdict does in a tort case, contract dispute, or criminal proceeding. In addition, the Court rejected the suggestion that concerns regarding predictability for the trademark system should be treated differently than the tort, contract, and criminal justice systems, where juries answer often-dispositive factual questions or make dispositive applications of legal standards to facts.

The *Hana* case is one of the very few Lanham Act cases to be decided by the Court in recent years. Tacking issues will now result in a new front for competing experts in such cases, making summary judgment more difficult. Further, the *Hana* decision will likely be argued to apply to other mixed questions of fact and law in Lanham Act cases, such as likelihood of confusion.

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