



ARE Trademark Law Alert: Supreme Court Finds Trademark Tacking to be a Factual Question for the Jury

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On January 21, 2015, the U.S. Supreme Court unanimously affirmed the Court of Appeals for the Ninth Circuit and held that trademark tacking is a question for the jury rather than the judge. *Hana Financial, Inc. v. Hana Bank et al.*, No. 13-1211, 574 U.S. ___ (2015) (“*Hana*”).

Trademark tacking allows a trademark owner to “tack” the date of the first use of the original mark onto a revised mark to establish priority where the two marks create the same commercial impression and are regarded as essentially the same by the consumer. The doctrine allows a trademark owner to modify its mark over time without losing priority and ownership.

In a unanimous decision penned by Justice Sotomayor, the Supreme Court held that “when a jury trial has been requested and when the facts do not warrant entry of summary judgment or judgment as a matter of law, the question whether tacking is warranted must be decided by a jury.” *Hana*, slip op. at 5. The Court reasoned that “when the relevant question is how an ordinary person or community would make an assessment, the jury is generally the decisionmaker that ought to provide the fact-intensive answer.” *Id.* at 4. However, there are circumstances where a judge would make that determination, *i.e.*, where there are no material facts at issue. *Id.* at 5.

We will continue to follow this development.

In the meantime, please feel free to [contact](#) our attorneys regarding issues raised by this case.

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