

## Can This Trademark Be Tacked? Ask the Jury

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“Trademark tacking” is an issue of fact that must be decided by a jury, the U.S. Supreme Court has unanimously ruled in *Hana Financial, Inc. v. Hana Bank, et al.*

“Trademark tacking” is the doctrine by which a trademark owner is allowed to slightly change or tweak a trademark, while keeping the original first-use date associated with the old mark, thereby maintaining the mark’s priority. The legal test to determine whether a trademark can be “tacked” is whether the two marks are so similar that consumers consider both as the same mark.

The decision settles a split among federal circuit courts, some of which considered tacking a question of fact for the jury, and others that considered it an issue of law for the judge to decide. In the case before the Court, Hana Overseas Korean Club adopted a new name and mark, Hana Bank, and was sued for infringement by Hana Financial. Justice Sonia Sotomayor, who authored the unanimous opinion, found that such a question “falls comfortably within the ken of a jury.”

In the wake of this decision, trademark attorneys are left to wonder how it will affect a more important, parallel issue in trademark law: likelihood of confusion analysis. Similar to the tacking issue, the circuits are split on whether “likelihood of confusion” is a factual question. The Court’s tacking decision in *Hana* may give creative attorneys a basis to claim that likelihood of confusion should be treated the same as trademark tacking – as a purely factual issue better left to the jury.

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