



Trademark Tacking: An Overview

July 13, 2015

On January 21, 2015, in the case *Hana Financial, Inc. v. Hana Bank*, the United States Supreme Court determined that, when there is a question as to whether two trademarks can be tacked for purposes of determining priority, that question should be decided by a jury. This, of course, raises the question: what is trademark tacking?

Generally, a trademark user may “tack” the date of the first use of an earlier mark onto a subsequent use of a similar mark if the marks are so similar that consumers would regard them as essentially the same. *Brookfield Commc'ns, Inc. v. W. Coast Entm't. Corp.*, 174 F.3d 1036, 1047 (9th Cir. 1999). Two marks may be tacked when they are considered to be “legal equivalents,” i.e., they “create the same, continuing commercial impression” when viewed through the eyes of a consumer. *Van Dyne-Crotty, Inc. v. Wear-Guard Corp.*, 926 F. 2d 1156, 1159. Tacking, however, is only applicable in exceptionally narrow circumstances.

A tacking analysis must consider the marks “in their entirety to determine whether each conveys the same commercial impression” such that they “possess the same connotation in context.” In essence, this means the mental reaction the mark produces in the consumer or ordinary purchaser. A commercial impression is determined using a wide variety of evidence, including visual or aural appearance and consumer survey evidence.

The concept of tacking is permitted because “[w]ithout tacking, a trademark owner’s priority in his mark would be reduced each time he made the slightest alteration to the mark, which would discourage him from altering the mark in response to changing consumer preferences, evolving aesthetic developments, or new advertising and marketing styles.” *Sengoku Works Ltd. v. RMC Int’l, Ltd.*, 96 F.3d 1217, 1219 (9th Cir. 1996). Additionally, “[g]iving the trademark owner the same rights in the new mark as he has in the old helps to protect source-identifying trademarks from appropriation by competitors and thus furthers the trademark law’s objective of reducing the costs that customers incur in shopping and making purchasing decisions.”

While tacking is an excellent method by which a trademark user can maintain its priority with respect to a mark, a trademark user should not assume that tacking is generally available since tacking is allowed only in exceptionally narrow circumstances and requires a detailed factual analysis if the tacked trademark is disputed or challenged.

If your institution has questions or concerns about this topic and you would like further information, please email Karen I. Levin at klevin@cullenllp.com.