

No. 13-1211

IN THE
Supreme Court of the United States

HANA FINANCIAL, INC.,
Petitioner,

v.

HANA BANK, et al.,
Respondents.

On Writ of Certiorari
to the United States Court of Appeals
for the Ninth Circuit

**BRIEF OF AMICUS CURIAE THE AMERICAN
INTELLECTUAL PROPERTY LAW ASSOCIATION
IN SUPPORT OF NEITHER PARTY**

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STATEMENT OF INTEREST

The American Intellectual Property Law Association (“AIPLA”) is a national bar association with approximately 15,000 members who are lawyers in both private and corporate practice, judges, patent agents, academics, law students, and United States Patent and Trademark Office (“USPTO”) professionals. Our members practice in a wide and diverse spectrum of intellectual property fields, including patent, trademark, copyright, and unfair competition law, as well as other fields of law affecting intellectual property. They represent owners and users of intellectual property, as well as those who litigate and prosecute before patent and trademark offices.¹

AIPLA has no interest in any party to this litigation and has no stake in the outcome of this case, other than its interest in seeking a correct and

¹ In accordance with Supreme Court Rule 37.6, AIPLA states that this brief was not authored, in whole or in part, by counsel to a party, and that no monetary contribution to the preparation or submission of this brief was made by any person or entity other than AIPLA and its counsel. Specifically, after reasonable investigation, AIPLA believes that (i) no member of its Board or *Amicus* Committee who voted to file this brief, or any attorney in the law firm or corporation of such a member, represents a party to the litigation in this matter, (ii) no representative of any party to this litigation participated in the authorship of this brief, and (iii) no one other than AIPLA, or its members who authored this brief and their law firms or employers, made a monetary contribution to the preparation or submission of this brief.

consistent interpretation of the laws affecting intellectual property.²

SUMMARY OF ARGUMENT

One of the Lanham Act's fundamental functions is to protect consumers from deceit as to the sources of their purchases. It does so by allocating trademark rights among competitors with protectable trademark interests. This division of rights permits consumers reliably to identify the source of goods and services without confusion.

Where similar marks are involved, this allocation of rights is based, in part, on a priority system. Trademark priority rewards the earliest valid use of a trademark in commerce. Consumer impressions of trademarks play a crucial role in deciding priority as between similar trademarks.

In certain circumstances, courts allow trademark owners to tack on to their current period of use an earlier period of using a similar mark to claim an earlier date of first use. The trademark tacking doctrine requires a finder of fact to consider whether the current and former trademark uses are "legal equivalents" in the eyes of ordinary consumers. In other words, do the marks, in their respective iterations, create the same continuing consumer impression in the marketplace?

² AIPLA sought consent to file this brief from the counsel of record for all parties, pursuant to Supreme Court Rule 37.3(a). Counsel for Petitioner and Respondent informed AIPLA of their consent by emails which have been filed with this brief.

This determination can only be made by and through the eyes of the consuming public. Therefore, a jury, made up of consumers, is the best judge of whether the relevant facts support a finding of trademark tacking.

ARGUMENT

I. THE TEST FOR TACKING IS GROUNDED IN CONSUMER PERCEPTION.

Businesses struggling to stay top-of-mind with consumers often turn to re-branding as a way to appear fresh, innovative, and original. Sometimes this re-branding takes the form of an entirely new trademark, color scheme, or advertising campaign. Other times, businesses will transform or modernize an existing trademark to create a visual and aural connection with the past while still looking to the future.

When disputes between owners of similar trademarks arise, courts may need to determine the priority question by ascertaining the first user. And when an evolution or modernization of a trademark has occurred, a question often arises as to whether the trademark owner maintained continuous rights in its trademark after altering it. Put differently, can the trademark owner “tack” its rights in the original trademark, including the date of first use of the prior mark, to its rights in the newer version of the trademark?

If the old and new versions of the trademark create a continuing commercial impression on consumers and do not differ materially from one another, then the answer is yes. *Van Dyne-Crotty, Inc. v. Wear-Guard Corp.*, 926 F.2d 1156, 1159 (Fed. Cir. 1991). This test—as articulated by the Federal Circuit and adopted elsewhere³—necessarily depends on evidence about the perceptions of consumers in the relevant market. Despite this direct reliance on consumer perception in a tacking determination, the circuits have split on whether the analysis is a question of fact or a question of law. *Cf. Data Concepts, Inc. v. Digital Consulting, Inc.* 150 F.3d 620, 623 (6th Cir. 1998) (“[w]hether a later mark is the legal equivalent of an earlier one is a question of law”); *Quicksilver, Inc. v. Kymsta Corp.*, 466 F.3d 749, 759 (9th Cir. 2006) (“whether tacking applies should be analyzed as a question of fact.”). As explained below, because trademark tacking presents a question of consumer impression, it is a question for the jury.

II. CONSUMER PERCEPTION IS CENTRAL TO TRADEMARK JURISPRUDENCE.

The twin aims of the Lanham Act—to protect legitimate business and to protect consumers—turn on one issue: consumer perception. Congressman Frederick Garland Lanham, sponsor of the Lanham Act, stated: “The purpose of [the Act] is to protect

³ See *George & Co. v. Imagination Entm’t Ltd.*, 575 F.3d 383, 402 (4th Cir. 2009); *Brookfield Commc’ns, Inc. v. W. Coast Entm’t Corp.*, 174 F.3d 1036, 1047-48 (9th Cir. 1999); *Data Concepts, Inc. v. Digital Consulting, Inc.*, 150 F.3d 620, 623 (6th Cir. 1998).

legitimate business and the consumers of the country.” 92 Cong. Rec. 7524 (1946). In 1982, this Court stated that trademark infringement “inhibits competition and subverts both goals of the Lanham Act.” *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 854 n.14 (1982). An infringer not only deprives a trademark owner of the trademark’s goodwill, but also “deprives consumers of their ability to distinguish among the goods of competing manufacturers.” *Id.*, citing S.Rep. No. 1333, 79th Cong., 2d Sess., 3 (1946) and H.R.Rep. No. 944, 76th Cong., 1st Sess., 3 (1939).

With this backdrop, consumer perception has become the foundation on which various Lanham Act tests have been built. Protecting the goodwill in a trademark safeguards the consuming public’s perception of a product’s source⁴ identified by the trademark. Similarly, protecting consumers from misleading trademark use requires a determination of the purchasing public’s perception of such use. 15 U.S.C. § 1125(a). Trademarks, the goodwill they represent, and the competition fostered by their use simply would not be relevant absent the impressions made on consumers.

⁴ Trademarks identify the source of goods and services, rather than the goods and services themselves. 15 U.S.C. § 1127. Consistent and continuous use of a trademark, along with consistency in the nature and quality of goods and services associated with the trademark, allows consumers to trust the brand name and thus creates goodwill associated with the trademark.

III. BECAUSE LANHAM ACT TESTS ARE GROUNDED IN CONSUMER PERCEPTION, THEY ARE OVERWHELMINGLY TREATED AS QUESTIONS OF FACT.

Central to trademark law jurisprudence, consumer perception serves as the foundation for various tests under the Lanham Act. The courts overwhelmingly treat these tests as questions of fact.

For example, the initial determination of whether a trademark qualifies for protection under the Lanham Act considers whether the mark is strong enough to serve as a trademark. This strength is measured by finding the location of the trademark on the fanciful/arbitrary-suggestive-descriptive-generic continuum (sometimes referred to as the “spectrum of distinctiveness”⁵). 2 *McCarthy on Trademarks and Unfair Competition*, § 11.80 (4th ed. 2014). The Federal Circuit (along with the majority of circuits) treats this determination as a question of fact because “the perception of the relevant purchasing public sets the standard ...” *In re Nett Designs*, 236 F.3d 1339, 1341 (Fed. Cir. 2001). *See also* 2 *McCarthy on Trademarks and Unfair Competition*, § 11.3 (4th ed. 2014) (noting that the “vast majority” of courts consider the categorization of a term on the spectrum of distinctiveness a question of fact). Even though a

⁵ The difference between “distinctive” and “descriptive” is vital to the analysis, although the terms sometimes are confused by courts and commentators. However, as discussed *infra*, a mark that is “descriptive” under a trademark strength analysis can become “distinctive” by acquiring distinctiveness through use (acquired distinctiveness also is call “secondary meaning”).

determination of tacking arises out of the same consumer perception, the Federal Circuit inexplicably has treated tacking as a question of law. *Van Dyne-Crotty*, 926 F.2d at 1159. However, both tests require the finder of fact to see the case through the lens of the consuming public.

Likewise, trademarks that are found to be descriptive obtain trademark protection only if they are shown to be “distinctive.” 15 U.S.C. § 1052(f). A trademark acquires distinctiveness when the purchasing public associates the trademark with a single producer or source. Courts routinely have found this to be a fact inquiry as well.⁶

⁶ See *Flynn v. AK Peters, Ltd.*, 377 F.3d 13, 19 (1st Cir. 2004) (“[T]he establishment of secondary meaning in a word is an issue of fact”); *Bristol-Myers Squibb Co. v. McNeil-P.P.C., Inc.*, 973 F.2d 1033, 1041 (2d Cir. 1992) (secondary meaning is an issue of fact and is not reversed unless clearly erroneous); *E.T. Browne Drug Co. v. Cococare Products, Inc.*, 538 F.3d 185, (3d Cir. 2008) (whether a designation is generic, descriptive or has acquired secondary meaning are questions of fact); *Dayton Progress Corp. v. Lane Punch Corp.*, 917 F.2d 836, 839 (4th Cir. 1990) (a finding of secondary meaning is reviewed under the clearly erroneous rule); *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 794 (5th Cir. 1983) (“[T]he existence of secondary meaning presents a question for the trier of fact, and a district court’s finding on the issue will not be disturbed unless clearly erroneous); *Platinum Home Mortg. Corp. v. Platinum Financial Group, Inc.*, 149 F.3d 722, 728 (7th Cir. 1998) (“[T]he district court’s determination of secondary meaning is a finding of fact that is reviewed for clear error.”); *Co-Rect Products, Inc. v. Marvy! Advertising Photography, Inc.*, 780 F.2d 1324, 1328 (8th Cir. 1985) (“[A]lthough the court listed as a conclusion of law its determination that the expression had acquired a secondary meaning, such a determination is considered a finding of fact”); *Levi Strauss & Co. v. Blue Bell, Inc.*, 778 F.2d 1352, 1355,

The same rule applies to trade dress, another form of trademark protection. Whether trade dress has secondary meaning is a question of fact. *Bristol-Myers Squibb Co.*, 973 F.2d at 1043 (“[T]he question of whether a mark or dress has acquired secondary meaning is a factual one ...”); *Sally Beauty Co., Inc. v. Beautyco, Inc.*, 304 F.3d 964, 978 (10th Cir. 2002) (“[w]hether a trade dress has acquired secondary meaning is a question of fact ...”); *Conagra, Inc. v. Singleton*, 743 F.2d 1508, 1513, (11th Cir. 1984) (“[t]he district court’s ruling, that the Singleton name had not acquired secondary meaning, is a finding of fact ...”).

Owners of distinctive trademarks afforded protection under the Lanham Act must enforce their rights or risk losing⁷ or weakening them. *See Wallpaper Mfrs. v. Crown Wallcovering Corp.*, 680 F.2d 755, 766 (C.C.P.A. 1982) (“[w]ithout question,

(9th Cir. 1985) (“[T]he question of secondary meaning is one of fact.”); *G.H. Mumm & Cie v. Desnoes & Geddes, Ltd.*, 917 F.2d 1292, 16 U.S.P.Q.2d 1635 (Fed. Cir. 1990) (whether a symbol has acquired secondary meaning is a question of fact reviewed under the clearly erroneous rule).

⁷ If a trademark owner fails to assert or enforce its rights against descriptive use by others, it is possible for a once-distinctive trademark to cease indicating to the consuming public that the associated goods and services originate with a single seller. *See, e.g., McKesson & Robbins, Inc. v. Charles H. Phillips Chemical Co.*, 53 F.2d 342, 345 (2d Cir. 1931), modified, 53 F.2d 1011 (2d Cir. 1931), cert. denied, 285 U.S. 552 (1932) (discussing loss of distinctiveness of the former trademark, MILK OF MAGNESIA).

distinctiveness can be lost by failing to take action against infringers. If there are numerous products in the marketplace bearing the alleged mark, purchasers may learn to ignore the ‘mark’ as a source identification. When that occurs, the conduct of the former owner, by failing to police its mark, can be said to have caused the mark to lose its significance as a mark”). Thus, trademark enforcement efforts also require the consideration of consumer perception. Indeed, consumer surveys often are collected both before and during trademark disputes to measure this perception, because parties know that consumer impressions serve as the keystone of the Lanham Act’s measure of trademark rights.

Where the Lanham Act prohibits using a mark that “is likely to cause confusion, or to cause mistake, or to deceive,” 15 U.S.C. § 1114(1)(a), this Court has made clear that it is “likelihood of *consumer* confusion” that “a plaintiff claiming infringement ... must show ... as part of the prima facie case.” *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 124, (2004) (emphasis added). Under this standard⁸, the majority of circuits—including the First, Third, Fourth, Fifth, Seventh,

⁸ AIPLA acknowledges that a circuit split exists as to whether likelihood of confusion is a question of fact, law, or mixed law and fact. However, even those courts who treat the question as mixed hold that the underlying findings (*e.g.* similarity of marks, similarity of products) as questions of fact. It is not necessary to resolve that split prior to deciding the narrow question currently before this Court, namely, whether tacking is a question of law for the court or fact for the jury.

Eighth, Ninth, Tenth, Eleventh, and D.C. circuits—treat likelihood of confusion as an issue of fact.⁹

IV. TRADEMARK TACKING LIKEWISE SHOULD BE TREATED AS QUESTION OF FACT.

As with the many other Lanham Act inquiries discussed, tacking requires an analysis of consumer perceptions; one cannot consider whether the trademarks at issue have made a continuing consumer impression on the public and therefore constitute legal equivalents without seeing the facts from the perspective of the consumer. 3 *McCarthy on Trademarks and Unfair Competition*, § 17:26 (4th ed. 2014). According to Professor McCarthy:

Whether two marks present the same commercial impression to allow tacking should be an issue of fact, not an issue of law. Statements in some cases that the “legal equivalents” question is one of law

⁹ See *De Costa v. Columbia Broad. Sys., Inc.*, 520 F.2d 499 (1st Cir. 1975), *cert. denied*, 423 U.S. 1073 (1976); *Opticians Ass’n of Am. v. Indep. Opticians of Am.*, 920 F.2d 187 (3rd Cir. 1990); *Marcon, Ltd. v. Helena Rubenstein, Inc.*, 694 F.2d 953 (4th Cir. 1982), *aff’d*, 225 U.S.P.Q. 895 (4th Cir. 1985), *cert. denied*, 474 U.S. 825 (1985); *Union Nat’l Bank v. Union Nat’l Bank*, 909 F.2d 839, n.21 (5th Cir. 1990); *Munters Corp. v. Matsui Am., Inc.*, 909 F.2d 250, 252 (7th Cir. 1990), *cert. denied*, 498 U.S. 1016 (1990); *ConAgra, Inc. v. George A. Hormel & Co.*, 990 F.2d 368 (8th Cir. 1993); *Nutri/System, Inc. v. Con-Stan Indus., Inc.*, 809 F.2d 601 (9th Cir. 1987); *Amoco Oil Co. v. Rainbow Snow, Inc.*, 809 F.2d 656 (10th Cir. 1987); *Bauer Lamp Co., Inc. v. Shaffer*, 941 F.2d 1164 (11th Cir. 1991); *Reader’s Digest Ass’n v. Conservative Digest, Inc.*, 821 F.2d 800, 804 (D.C. Cir 1987).

cannot be correct. ‘Commercial impression,’ should, like other Lanham Act inquiries, be determined from the perspective of the ordinary purchaser of these kinds of goods or services.”

Id. (internal citation omitted). Because consumers are in the best position to judge the impression trademarks make upon them, tacking should be a question for the jury.¹⁰ *Id.*

¹⁰ Furthermore, the Seventh Amendment to the United States Constitution guarantees a right of a jury trial in civil cases, with few and narrow exceptions: maritime law, suits against the government, and certain patent claims. U.S. CONST. amend VII, This Court’s 1962 decision in *Dairy Queen v. Wood* held that trademark cases should be tried to a jury. *Dairy Queen v. Wood*, 369 U.S. 469 (1962). Much has been written concerning this holding and the distinctions between the legal and equitable remedies available to trademark plaintiffs. *See, e.g.*, Thurmon, Mark A., *Ending the Seventh Amendment Confusion: A Critical Analysis of the Right to a Jury Trial in Trademark Cases*, Texas Intellectual Property Law Journal (Fall 2002) (discussing the aftermath of *Dairy Queen*); Welkowitz, David S., *Who Should Decide? Judges and Juries in Trademark Dilution Actions*, Mercer Law Review (vol. 63) (2011). While the discussion is focused on the distinction between cases heard at law versus equity (and not trademark tacking), it is important to remember that removing a case from the ambit of the jury should not be done lightly. “Maintenance of the jury as a fact-finding body is of such importance and occupies so firm a place in our history and jurisprudence that any seeming curtailment of the right to a jury trial should be scrutinized with the utmost care.” *Dimick v. Schiedt*, 293 U. S. 474, 486 (1935). Trademark tacking does not present such a case. While trademark cases may present mixed questions of law and fact, because trademark tacking fundamentally turns on a consideration of consumer impression, it is a question for the jury.

A tacking analysis requires a determination of whether the trademarks are legal equivalents. *Van Dyne-Crotty, Inc.*, 926 F.2d at 1159. Legal equivalence is a narrow finding, meaning that the trademarks being compared, while not identical, are nearly so. “Legal equivalence for tacking purposes does not exist simply because the two marks a party seeks to tack are ‘confusingly similar.’” *Data Concepts*, 150 F.3d at 623. Instead, the tacking standard “is considerably higher than the standard for ‘likelihood of confusion.’” *Brookfield*, 174 F.3d at 1048. Legal equivalence is not a formulaic test, but heavily fact-based. Accordingly, the question of legal equivalence should be answered by the jury.

Legal equivalence turns on the specific facts of each case. Whether two trademarks have created a continuing consumer impression over a span of time sufficient to be considered one trademark for purposes of trademark priority of use can only be understood by and through the eyes of the consuming public. Accordingly, whether the relevant facts support a finding of trademark tacking should be entrusted to the jury.

CONCLUSION

For the foregoing reasons, *amicus curiae* respectfully request that the Court hold that trademark tacking is a question of fact for the jury.

Respectfully submitted,

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