

SUPREME COURT OF THE UNITED STATES

Hana Financial, Inc. v. Hana Bank

135 S. Ct. 907 (2015) · No. No. 13-1211 · Decided January 21, 2015

SUMMARY

The Supreme Court held that whether two trademarks may be tacked for purposes of determining priority is generally a question for the jury when a jury trial is requested and the facts do not warrant summary judgment or judgment as a matter of law. The Court affirmed the Ninth Circuit, explaining that tacking involves a fact-intensive inquiry into whether the marks create the same continuing commercial impression from the perspective of an ordinary consumer.

CASE DETAILS

COURT	Supreme Court of the United States
WRITING FOR THE COURT	Justice Sotomayor
JURISDICTION	Federal
DECIDED	January 21, 2015
DOCKET	No. 13-1211
DISPOSITION	affirmed
PROCEDURAL POSTURE	Hana Financial sued Hana Bank for trademark infringement. After the Ninth Circuit reversed summary judgment for Hana Bank because genuine issues of material fact existed as to priority, the infringement claim was tried to a jury. The jury found for Hana Bank, the district court denied Hana Financial's motion for judgment as a matter of law, and the Ninth Circuit affirmed. The Supreme Court granted certiorari to decide whether trademark tacking is determined by a judge or jury.
STANDARD OF REVIEW	The Court reviewed the legal allocation of the trademark-tacking determination between judge and jury; it also recognized that a judge may resolve tacking on summary judgment or judgment as a matter of law when the facts warrant it.
PRECEDENTIAL VALUE	binding
PARTIES	Hana Financial, Inc. v. Hana Bank, Hana Financial Group

TOPICS

trademark law

trademark infringement

civil procedure

summary judgment

PRACTICE AREAS

Trademark

Civil procedure

Intellectual property

QUESTIONS PRESENTED

1. Whether the question whether two trademarks may be tacked for purposes of determining priority is for a judge or a jury when a jury trial has been requested and the facts do not warrant summary judgment or judgment as a matter of law.

HOLDINGS

1. When a jury trial has been requested and the facts do not warrant summary judgment or judgment as a matter of law, whether two marks may be tacked for purposes of determining trademark priority must be decided by a jury.

KEY QUOTATIONS

“Because the tacking inquiry operates from the perspective of an ordinary purchaser or consumer, we hold that a jury should make this determination.” (at 4)

“We hold only 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.” (at 8)

FACTUAL BACKGROUND

Hana Bank used variations of the Hana name and related marks in connection with financial services, including advertising in the United States beginning in 1994 and operating a United States bank under the name Hana Bank beginning in 2002. Hana Financial began using its name and associated trademark in 1995 and obtained a federal registration for a pyramid logo bearing the name Hana Financial in 1996. After Hana Financial sued for infringement, Hana Bank invoked the tacking doctrine to claim priority based on its earlier use of related marks.

PROCEDURAL HISTORY

The district court initially granted summary judgment to Hana Bank on the infringement claim. The Ninth Circuit reversed and remanded based on genuine issues of material fact concerning priority. After a jury verdict for Hana Bank and denial of judgment as a matter of law, the Ninth Circuit affirmed, holding that tacking is a fact-sensitive inquiry reserved for the jury. The Supreme Court affirmed the Ninth Circuit.

DISPOSITION

affirmed

CASES CITED

- United States v. Detroit Timber & Lumber Co., 200 U.S. 321, 337 (1906)
- Van Dyne-Crotty, Inc. v. Wear-Guard Corp., 926 F.2d 1156, 1159 (C.A. Fed. 1991)
- DuoProSS Meditech Corp. v. Inviro Medical Devices, Ltd., 695 F.3d 1247, 1253 (C.A. Fed. 2012)
- United States v. Gaudin, 515 U.S. 506, 512, 514 (1995)
- TSC Industries, Inc. v. Northway, Inc., 426 U.S. 438, 450 (1976)
- Hamling v. United States, 418 U.S. 87, 104-105 (1974)
- Railroad Co. v. Stout, 17 Wall. 657, 664 (1874)
- George & Co., LLC v. Imagination Entertainment Ltd., 575 F.3d 383, 402 (C.A. 4 2009)
- Brookfield Communications, Inc. v. West Coast Entertainment Corp., 174 F.3d 1036, 1047-1048 (C.A. 9 1999)
- Data Concepts, Inc. v. Digital Consulting, Inc., 150 F.3d 620, 623 (C.A. 6 1998)
- One Industries, LLC v. Jim O'Neal Distributing, Inc., 578 F.3d 1154, 1160 (C.A. 9 2009)
- Miller v. Fenton, 474 U.S. 104, 113 (1985)
- Specht v. Google Inc., 758 F. Supp. 2d 570, 583-585 (N.D. Ill. 2010), aff'd, 747 F.3d 929 (C.A. 7 2014)
- Children's Legal Services PLLC v. Kresch-*2 (E.D. Mich. Apr. 25, 2008), aff'd sub nom. Children's Legal Servs., P. L. L. C. v. Saiontz, Kirk & Miles, P. A. (C.A. 6 June 18, 2009)
- Markman v. Westview Instruments, Inc., 517 U.S. 370 (1996)
- Teva Pharmaceuticals USA, Inc. v. Sandoz, Inc., 574 U.S. 318 (2015)
- Drexel Enterprises, Inc. v. Richardson, 312 F.2d 525, 526 (C.A. 10 1962)
- Perfectform Corp. v. Perfect Brassiere Co., 256 F.2d 736, 738 (C.A. 3 1958)
- John Morrell & Co. v. Hauser Packing Co., 20 F.2d 713 (C.A. 9 1927)
- Beech-Nut Packing Co. v. P. Lorillard Co., 299 F. 834, 835 (D.N.J. 1924)