

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 THE INTERNATIONAL
TRADEMARK ASSOCIATION AS *AMICUS
CURIAE* IN SUPPORT OF RESPONDENTS**

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**STATEMENT OF INTEREST
OF THE *AMICUS CURIAE*¹**

Founded in 1878, the International Trademark Association (“INTA”) is a global organization dedicated to supporting trademarks and related intellectual property in order to protect consumers and to promote fair and effective commerce. INTA has more than 6,400 members in more than 190 countries. Its members include trademark and brand owners, as well as law firms and other professionals who regularly assist brand owners in the creation, registration, protection, and enforcement of their trademarks. All INTA members share the goal of promoting an understanding of the essential role that trademarks and goodwill play in fostering commerce, fair competition, and informed decision-making by consumers.

INTA was founded in part to encourage the enactment of federal trademark legislation after invalidation on constitutional grounds of the United States’ first trademark act. Since then, INTA has been instrumental in making recommendations and providing assistance to legislators in connection with major trademark and related legislation. INTA members are frequent participants in Lanham Act-related litigation as both plaintiffs and

1. In accordance with Supreme Court Rule 37.6, *amicus curiae* states that this brief was authored solely by INTA and its counsel, and no part of this brief was authored by counsel to a party. No party or counsel for a party made a monetary contribution intended to fund the preparation or submission of this brief. No person other than *amicus curiae*, its members, and its counsel made such a monetary contribution to its preparation or submission. Pursuant to Supreme Court Rule 37.2, *amicus curiae* has obtained the written consent of both parties, on file with the Clerk, to the filing of this brief.

defendants. INTA has also participated as *amicus curiae* in numerous cases involving significant Lanham Act issues in this Court and others.²

INTA and its members have a particular interest in the doctrine of trademark tacking. INTA recognizes that brand owners often make changes to the form or style of their trademarks. These changes are made for a variety of reasons, such as to modernize the overall look of a logo, reflect new marketing initiatives, or identify a broader array of goods or services offered within the class of goods or services covered by the mark. Where the changed mark creates the same overall commercial impression in the minds of consumers as the earlier mark, the trademark owner should be entitled to retain the benefits of its use of the earlier mark—including the original first-use date and the goodwill associated with the original mark—without a finding of abandonment of the original mark.

As addressed more fully below, INTA believes that the essential inquiry for tacking—namely, whether the original and modified marks create the same commercial

2. INTA has filed *amicus* briefs in this Court in the following matters, among others: *B & B Hardware, Inc. v. Hargis Indus., Inc.*, No. 13-352 (U.S. July 1, 2014) (petition for cert. granted); *Pom Wonderful LLC v. Coca-Cola Co.*, 134 S. Ct. 2228 (2014); *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 134 S. Ct. 1377 (2014); *Already, LLC v. Nike, Inc.*, 133 S. Ct. 721 (2013); *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111 (2004); *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003); *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418 (2003); *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23 (2001); *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205 (2000); *Fla. Prepaid Postsecondary Educ. Expense Bd. v. Coll. Sav. Bank*, 527 U.S. 627 (1999); *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159 (1995).

impression—is a question of fact, reviewable only for clear error. By its very definition, commercial impression requires consideration of evidence of how actual and potential consumers perceive the two marks at issue. This evidence, which often includes consumer surveys, is inherently factual in nature. Thus, brand owners should have such evidence of consumer perception evaluated by the fact finder rather than through a judicial comparison of the marks.

SUMMARY OF ARGUMENT

Justice Frankfurter concisely captured the root of trademark law when he wrote that “[t]he protection of trade-marks is the law’s recognition of the psychological function of symbols.” *Mishawaka Rubber & Wollen Mfg. Co. v. S. S. Kresge Co.*, 316 U.S. 203, 205 (1942). Consistent with Justice Frankfurter’s summary, the fundamental tenet of trademark law holds that trademark rights generally inure in the basic commercial impression created by a mark, not in any particular format or style. See 3 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 17:26 (4th ed. 2012). A trademark’s “commercial impression” is the meaning or idea it conveys or the mental reaction it evokes. *Spice Islands, Inc. v. Frank Tea & Spice Co.*, 505 F.2d 1293, 1296 (C.C.P.A. 1974). The central question in the present appeal asks whether this question is an issue of fact to be resolved by the fact finder, or an issue of law to be determined by the court.

While somewhat inconsistently articulated among courts, the test for establishing tacking is dependent on a singular inquiry: whether the original mark and the modified mark create the same commercial impression,

such that consumers generally regard the two marks as essentially the same mark. *See infra* parts I.A-B. As shown in part I.C below, this inquiry is an inherently factual one that requires consideration of evidence of consumer perception and consumers' impression of the marks as encountered in the marketplace; it should not be determined through judicial perception of the marks based upon a side-by-side visual or aural comparison of the marks. For that reason, tacking should be treated as a question of fact, not one of law.

Courts that have held tacking to be a question of law have done so principally because the circuit in which the given court is situated holds the ultimate determination of likelihood of confusion in trademark infringement cases to be a matter of law. *See infra* part I.D. However, tacking and likelihood of confusion are based upon entirely different inquiries and analyses. As noted, tacking determinations focus principally on whether the original and modified mark create the same commercial impression such that the two marks are indistinguishable in the minds of consumers. In contrast, resolution of the issue of likelihood of confusion requires application of the multi-factor "digits of confusion" test. Such test is designed to evaluate whether an allegedly infringing mark misleads as to source, and includes factors such as strength of the mark, commonality of the goods or services offered under the mark, evidence of actual confusion, the sophistication of the buyers, and the defendant's good faith (or lack thereof) in adopting the mark. As shown below in part I.D, whether a court treats this multifactor confusion test as one of fact or law has no logical bearing on the narrow question of whether two marks used by the same party create the same commercial impression. Moreover, even courts that treat the consideration of the likelihood

of confusion factors to be a question of law nonetheless treat as a factual question the “similarity of the marks” factor that is a component thereof, further demonstrating why tacking should itself be treated as a factual question.

Of course, prior to a tacking analysis, a court, acting as gatekeeper, may determine as a matter of law issues such as whether the later mark and its predecessors are protectable trademarks capable of being tacked. This, however, should in no way change the conclusion that the ultimate question in tacking cases is one of fact, appropriately resolved by the fact-finder.

INTRODUCTION

A. The Origins and Importance of the Doctrine of Tacking

This Court appears to have first encountered what would become the doctrine of trademark tacking in the context of a 1900 case involving trademark abandonment. *See Saxlehner v. Eisner & Mendelson Co.*, 179 U.S. 19, 32 (1900) (dismissing abandonment claim that original use of “Hunyadi” mark differed from later registered “Hunyadi Janos” mark because “nothing in the[] facts tending to show an abandonment . . . in the name of Hunyadi or in the labels, unless it be the fact that the trademark registered in the United States in 1887 contained the words ‘Hunyadi Janos,’ which, it is insisted, was a waiver of a right thereafter to register the name ‘Hunyadi’ alone”). In 1927, in *Beech-Nut Packing Co. v. P. Lorillard Co.*, the Supreme Court again confronted a precursor to tacking. *See* 273 U.S. 629, 631-32 (1927) (deciding based on laches but taking no issue with fact that respondent, “in connection with an effort to get a new brand that would hit

the present taste,” changed “some of the adjuncts” of the original mark by, among other design changes, “putting a hyphen between Beech and Nut, framing its label with an oval and substituting a beechnut for a squirrel in the center”). The Court in *Beech-Nut* rooted its decision in the enduring commercial impression associated with trademarks:

A trade-mark is not only a symbol of an existing good will although it commonly is thought of only as that. Primarily it is a distinguishable token devised or picked out with the intent to appropriate it to a particular class of goods and with the hope that it will come to symbolize good will.

Id. at 632.

These earlier cases helped lay the foundation for the doctrine of “tacking.” Under that doctrine, a trademark owner may modify its mark while retaining the first-use date of the original mark as well as all of the former mark’s goodwill, provided the modified mark creates the same commercial impression as the original. *See generally* Gideon Mark & Jacob Jacoby, *Continuing Commercial Impression: Application and Measurement*, 10 Marq. Intell. Prop. L. Rev. 433, 437-38 (2006); 3 *McCarthy on Trademarks and Unfair Competition* § 17:28. As the Ninth Circuit observed:

Giving 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.

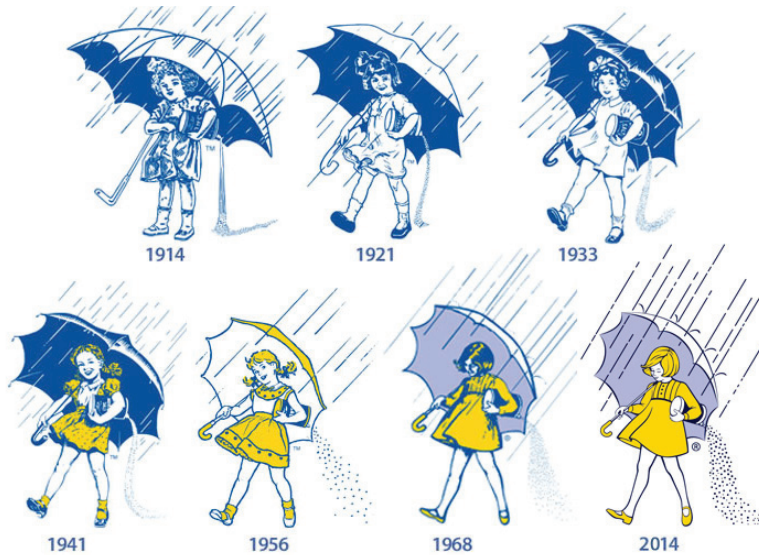
Without tacking, a trademark owner's priority in his mark would be reduced each time he made the slightest alteration to the mark, which would discourage him from altering the mark in response to changing consumer preferences, evolving aesthetic developments, or new advertising and marketing styles.

Brookfield Comm'cns, Inc. v. W. Coast Entm't Corp., 174 F.3d 1036, 1048 (9th Cir. 1999) (citations omitted; emphasis added); *see also* 3 *McCarthy on Trademarks and Unfair Competition* § 17:26.

B. Tacking: A Real World Example

The doctrine of tacking is perhaps understood best by example. The Morton Salt Umbrella Girl, which celebrates its 100th anniversary this year, is one of the most iconic trademarks in this country. As the following graphic illustrates, the trademark has not been static over its history; rather, it has been modified over time, typically to ensure the Umbrella Girl's look remains "contemporary." Yet each iteration of the mark includes the same essential image of a little girl holding an umbrella in one hand to protect from falling rain and, in the other hand, a package of salt under her arm with the spout open and salt running out, demonstrating that Morton Salt flows freely, even in the rain:³

3. *See* Morton Salt, *History of the Morton Salt Girl*, <http://www.mortonsalt.com/our-history/history-of-the-morton-salt-girl> (visited on Oct. 7, 2014).



Under the doctrine of tacking, if Morton can establish that each new iteration of its mark does in fact create the same commercial impression in the minds of consumers as does the prior mark, Morton's trademark rights attached to the original mark would be retained by each updated version. *See Louangel, Inc. v. Darden Rests., Inc.*, 106 U.S.P.Q.2d (BNA) 1809 (S.D. Tex. Mar. 22, 2013) (citation omitted) (noting that the Morton Salt Umbrella Girl mark is one of the “quintessential examples of successful modernizations that maintain the original trademark”). Conversely, without tacking, Morton's trademark rights would “reset” with a new first-use date each time Morton updated its logo, with the trademark rights and goodwill attached to the prior mark potentially lost. In such circumstances, another company in 2010 could, for example, adopt a trademark confusingly similar to the then-current (1968) version of Morton's trademark, yet

potentially avoid liability if Morton failed to discover and challenge the infringer until after Morton switched to the 2014 version of the trademark. Such a result runs counter to one of the fundamental trademark principles of according protection to a brand owner that accrues goodwill in its trademark.

ARGUMENT

I. THE TACKING ANALYSIS IS INHERENTLY FACTUAL

A. The Legal Standard for Establishing Tacking Is Focused Upon Consumer Perception

As stated by noted trademark scholar J. Thomas McCarthy, the test for tacking is “one of continuity.” That is:

[a] mark can be modified or changed without abandonment or loss of priority *if done in such a way that the continuing common element of the mark retains its impact and symbolizes a continuing commercial impression.*

3 *McCarthy on Trademarks and Unfair Competition* § 17:26 (emphasis added).

In the earliest tacking decisions, the United States Patent and Trademark Office (“PTO”), the Trademark Trial and Appeals Board (“TTAB”), and the Court of Customs and Patent Appeals (“CCPA”) each similarly agreed that tacking is predicated upon the same fundamental principle undergirding trademark law in

general, *i.e.*, the impression of the mark on the consumer.⁴ For example, in *Salem Commodities v. Miami Margarine Co.*, the CCPA refused to grant priority to “Nut Maid” based on the more current use of “Nu-Maid” because, although the marks differed “only by one letter and a hyphen,” they created entirely different commercial impressions: “the former indicating a nut product while the latter suggests a product which is either new or freshly made.” 244 F.2d 729, 731 (C.C.P.A. 1957).

For many years, the TTAB consistently held that continuing commercial impression formed the heart of the tacking analysis. *See, e.g., William Underwood Co. v. B. F. Trappey’s Sons, Inc.*, 134 U.S.P.Q. (BNA) 39, 41 (T.T.A.B. 1962) (noting that opposer continuously used as a trademark “a representation of a devil, and even though it has, from time to time, modernized its characterization thereof, the *commercial impression* created thereby remained basically the same”) (emphasis added); *Laura Scudder’s v. Pac. Gamble Robinson Co.*, 136 U.S.P.Q. (BNA) 418, 419 (T.T.A.B. 1962) (granting priority where later mark was sufficiently similar to the original mark to “create *substantially the same general impression . . .* and hence are believed to symbolize a single and continuing trademark right” (emphasis added); *Humble Oil & Refining Co. v. Sekisui Chem. Co. Ltd. of Japan*, 165 U.S.P.Q. (BNA) 597, 603 (T.T.A.B. 1970) (“The only requirement [for tacking] is that the mark

4. Consumer perception is, in many ways, at the core of trademark law and trademark rights. *See generally* The Lanham Act, 15 U.S.C. §§ 1051-1064 (focusing on the mind of the relevant consuming public); Jacob Jacoby, *The Psychological Foundations of Trademark Law: Secondary Meaning, Genericism, Fame, Confusion and Dilution*, 91 Trademark Rep., 1013 (2001).

be modified in such a fashion as to retain its trademark impact and symbolize a single and continuing commercial impression.”).

B. The “Legal Equivalency” and “Material Difference” Factors Do Not Alter the Fundamental Character of the Tacking Analysis

Despite the long-standing, straightforward articulation of the test for tacking as requiring a showing that the original and modified marks create “one continuing commercial impression,” more recent federal cases and TTAB decisions have introduced concepts of “legal equivalence” and “material difference” to the tacking analysis. Although some courts appear to treat these elements as additional requirements, others appear to use “legal equivalence” and “continuing commercial impression” interchangeably. In any event, these new concepts do not in any way change the fundamental character of the tacking analysis.

The origins of the “legal equivalency” requirement date back at least to *Compania Insular Tabacalera, S.A. v. Camacho Cigars, Inc.*, 167 U.S.P.Q. (BNA) 299, 303 (T.T.A.B. 1970), a case involving whether a cigar manufacturer’s “SAN MARCO” mark could be tacked back to its earlier “DON MARCOS” mark. The TTAB stated: “It is a well established principle of trademark law that a party . . . can rely upon the prior and continuous use of another mark *which is, in essence, the legal equivalent of the mark in question or indistinguishable therefrom, and* would be considered by purchasers as the same mark.” *Id.* (emphasis added) (citing *Humble*

Oil, 165 U.S.P.Q. (BNA) 597 (T.T.A.B. 1970)). While the T.T.A.B. did little to explain “legal equivalence,” including whether or how it differed from “continuing commercial impression,” this new articulation became the common tacking formulation following its recitation in the heavily cited *Van Dyne-Crotty, Inc. v. Wear-Guard Corp.*, 926 F.2d 1156 (Fed. Cir. 1991).⁵

In *Van Dyne-Crotty*, the Federal Circuit incorporated the legal equivalence requirement into its tacking inquiry, while ostensibly introducing yet a third requirement—namely, that the new mark not materially differ from or alter the character of the original mark:

5. Nearly every tacking case since *Van Dyne-Crotty* has cited or quoted the decision. *See, e.g., Hana Fin., Inc. v. Hana Bank*, 735 F.3d 1158, 1164 (9th Cir. 2013), *cert. granted*, 134 S. Ct. 2842 (2014); *George & Co. LLC v. Imagination Entm’t Ltd.*, 575 F.3d 383, 402 (4th Cir. 2009); *In re Dial-A-Mattress Operating Corp.*, 240 F.2d 1341, 1347 (Fed. Cir. 2001); *Data Concepts, Inc. v. Digital Consulting, Inc.*, 150 F.3d 620, 623 (6th Cir. 1998); *Mfrs. Technical Insts., Inc. v. Pinnacle Coll., LLC*, No. 91195896, 2011 WL 4871873, at *2 (T.T.A.B. Sept. 22, 2011); *Paleteria La Michoacana, Inc. v. Productos Lacteos Tocumbo S.A. De C.V.*, No. 11-1623, 2014 WL 4759945, at *7 (D.D.C. Sept. 25, 2014); *Churchill Downs Inc. v. Commemorative Derby Promotions, Inc.*, No. 1:12-cv-517-JEC, 2014 WL 3908521, at *2 n.6 (N.D. Ga. Aug. 8, 2014); *Louangel, Inc. v. Darden Restaurants, Inc.*, 106 U.S.P.Q.2d (BNA) 1809 (S.D. Tex. Mar. 22, 2013); *Fifth Ave. of Long Island Realty Assocs. v. Caruso Mgmt. Co.*, 718 F. Supp. 2d 292, 307 (E.D.N.Y. 2010); *Colonial Elec. & Plumbing Supply of Hammonton, LLC v. Colonial Elec. Supply, Ltd.*, No. CIV. 05-5408NLH, 2007 WL 4571105, at *9 (D.N.J. Dec. 27, 2007); *Gaffrig Performance Indus., Inc. v. Livorsi Marine, Inc.*, No. 99 C 7778, 2001 WL 709483, at *8 (N.D. Ill. June 25, 2001); *Iowa Health Sys. v. Trinity Health Corp.*, 177 F. Supp. 2d 897, 920-21 (N.D. Iowa 2001).

The previously used mark must be the *legal equivalent* of the mark in question or indistinguishable therefrom, *and the consumer should consider both [marks] as the same mark*. However, for the purposes of “tacking,” even if the two marks are confusingly similar, they still may not be legal equivalents. Instead, the marks must create “the same, continuing commercial impression,” *and the later mark should not materially differ from or alter the character of the mark attempted to be “tacked.”*

Id. at 1159 (internal citations omitted; emphasis added).

While numerous subsequent tacking decisions purport to apply the *Van Dyne-Crotty* tacking standard, the approaches in these cases have hardly been uniform. Some courts treat “legal equivalency” *as synonymous* with “continuing commercial impression.” *See, e.g., In re Dial-A-Mattress Operating Corp.*, 240 F.2d 1341, 1347 (Fed. Cir. 2001) (“A mark is the legal equivalent of another if it creates the same, continuing commercial impression *such that* the consumer would consider them both the same mark.”) (emphasis added); *Data Concepts, Inc. v. Digital Consulting, Inc.*, 150 F.3d 620, 623 (6th Cir. 1998) (“The use of an earlier mark can be tacked onto the use of a subsequent mark only if the previously used mark is ‘the legal equivalent of the mark in question or indistinguishable therefrom’ *such that* consumers ‘consider both as the same mark.’”) (emphasis added; citation omitted). Other courts have treated “legal equivalency” and “continuing commercial impression” as separate legal inquiries, but without explaining how the concepts are distinct. *See, e.g., Brookfield Comm’cns*, 174 F.3d at 1047-48 (holding that tacking can occur “where

‘the previously used mark is “the legal equivalent of the mark in question *or* indistinguishable therefrom” such that consumers “consider both as the same mark.”’) (emphasis added; citations omitted).

To the extent that the “legal equivalency” or “material difference” tests are considered separate elements of the tacking analysis—and it is far from clear that they should be so considered—they do not change the factual nature of the tacking inquiry. Whether a change in a trademark is “material” for tacking purpose still turns on the same, long-standing tacking inquiry: does the change cause the trademark to create a different commercial impression such that the mark is viewed by consumers as a new mark? *See, e.g., Miyano Mach. USA, Inc. v. MiyanoHitec Mach., Inc.*, 576 F. Supp. 2d 868, 882 (N.D. Ill. 2008) (“A material alteration exists if the two marks do not ‘create the same general commercial impression.’”) (quoting *Paris Glove of Can. v. SBC/SPORTO Corp.*, 87 U.S.P.Q.2d (BNA) 1856 (T.T.A.B. 2007)). Likewise, courts that treat “legal equivalency” as synonymous with “continuing commercial impression” recognize that a modified trademark can only be the legal equivalent of the former mark if consumers “consider them both the same mark.” *Dial-A-Mattress*, 240 F.3d at 1347. Thus the inquiry, no matter how articulated, remains fundamentally focused on consumer perception.

Perhaps the most troubling result of the *Van Dyne-Crotty* court’s interpretation is its holding that tacking may be decided as a matter of law, reviewable *de novo*. The court observed that no evidence “concerning the legal equivalence” of the marks was necessary beyond the “visual or aural appearance of the marks themselves” because “[m]erely from review of the marks, it is clear that

they create different commercial impressions.” *Van Dyne-Crotty*, 926 F.2d at 1159. However, the Federal Circuit relied upon inapposite authority for this approach—*In re E. I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973)—which does not concern tacking, but rather likelihood of confusion. Evaluation of likelihood of confusion asks whether the marks are confusingly similar—a different question than whether they create a continuing commercial impression. *Id.* As a result, the *Van Dyne-Crotty* court cast aside its own multi-pronged test for legal equivalence and commercial impression when it stated: “We do not address, *nor need we, whether the marks here were legal equivalents* on the facts of this case. We only affirm the Board’s finding that *because the marks were not confusingly similar, they were not legal equivalents* for the purposes of tacking.” *Van Dyne-Crotty*, 926 F.2d at 1159 n.3 (emphasis added). As discussed below, this approach to tacking is wholly improper.

C. Determining Continuing Commercial Impression Requires a Factual Inquiry Into Consumer Perception That Is Not Readily Susceptible to a Legal Determination

Although this Court has “yet to arrive at ‘a rule or principle that will unerringly distinguish a factual finding from a legal conclusion,’” *Miller v. Fenton*, 474 U.S. 104, 113 (1985) (quoting *Pullman-Standard v. Swint*, 456 U.S. 273, 288 (1982)), it has nevertheless held that matters of state of mind are more appropriate for review as questions of fact, subject to the “clearly erroneous” standard under Rule 52 of the Federal Rules of Civil Procedure. *See Pullman-Standard*, 456 U.S. 273, at 288 (citing *Dayton Bd. of Educ. v. Brinkman*, 443 U.S. 526, 534 (1979); *Comm’r v. Duberstein*, 363 U.S. 278

(1960); *United States v. Yellow Cab Co.*, 338 U.S. 338, 341 (1949)). Because the principal focus of a tacking analysis is precisely a matter of state of mind—specifically, how consumers perceive the original and modified mark—tacking is an inherently factual inquiry.

As courts have recognized, the inquiry critical to a tacking analysis is whether the two marks are “so similar that consumers generally would regard them as essentially the same. Where such is the case, the new mark serves the same identificatory function as the old mark.” *Brookfield Commc’ns*, 174 F.3d at 1048; *see also id.* (stating that “tacking should be allowed if two marks are so similar that consumers generally would regard them as essentially the same”); *Van Dyne-Crotty*, 926 F.2d at 1159 (stating that a “consumer should consider both as the same mark”).

Several courts have provided valuable guidance regarding the evidence necessary to establish tacking, and in so doing, made clear that the inquiry is factual in nature. For example, the district court in *Navistar International Transportation Corp. v. Freightliner Corp.*, No. 96 C 6922, 1998 WL 911776 (N.D. Ill. Dec. 28, 1998), focused on the importance of credible evidence of commercial impressions, rejecting self-serving testimony of the party asserting tacking. *See id.* at *6; *cf. Patterson v. World Wrestling Entm’t, Inc.*, No. 03-C-0374, 2006 WL 273527, at *18 (E.D. Wis. Jan. 31, 2006) (finding that, because tacking “is based on whether two marks make the same commercial impression on consumers,” an affidavit of the CEO of defendant’s business does not constitute competent evidence of continuing commercial impression as she is not a consumer of defendant’s products).

“Because the inquiry is how consumers perceive the marks, there must be some evidence demonstrating those perceptions.” *Navistar*, 1998 WL 911776, at *4. Survey evidence demonstrating consumer perception is often most illuminating in establishing commercial impression and thus, whether tacking should apply. *See* Mark & Jacoby, at 437-38; *see also In re Lawman Armor Corp.*, No. 75982984, 2005 WL 2451654, at *5 (T.T.A.B. Sept. 16, 2005) (discussing failure of survey evidence “to show, or even measure” commercial impression). Other evidence of consumer impression may include focus group studies or like evidence of impact on consumers.

Of course, consumer perception has consistently been held to be an issue of fact throughout trademark jurisprudence. *See, e.g., N. Coast Indus. v. Jason Maxwell, Inc.*, 972 F.2d 1031, 1034 (9th Cir. 1992) (noting that similarity of general ideas should be decided by the trier of fact because the question was based on “the response of the ordinary reasonable person” (internal quotation marks; citation omitted)); *In re Northland Aluminum Prods., Inc.*, 777 F.2d 1556, 1559 (Fed. Cir. 1985) (noting that because the descriptiveness of a term “is determined from the viewpoint of the relevant purchasing public,” the determination necessarily is one of fact). It is for this reason that a leading trademark commentator correctly concludes that the tacking inquiry unquestionably is one of fact, not law:

[W]hether 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 cannot be correct. “Commercial impression,” like most

issues in trademark law, should be determined from the perspective of the ordinary purchaser of these kinds of goods or services.

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For the same reason, it is wholly inappropriate for a court to substitute its subjective views of the two marks for those of the relevant consumers. An in-chambers review of two marks displayed on the pages of a court filing is, quite literally, taking marks out of their natural context. *See Beer Nuts, Inc. v. Clover Club Foods Co.*, 711 F.2d 934, 941 (10th Cir. 1983) (“[I]t is axiomatic in trademark law that ‘side-by-side’ comparison is not the test. The marks must be compared in the light of what occurs in the marketplace, not in the courtroom.” (internal quotation marks; citations omitted)). As one court recently observed, because the tacking inquiry—and indeed much of trademark law as a whole—is focused on consumers’ perception of the marks when encountered in the marketplace, “it is less than ideal for a court, sitting in relative isolation, to speculate about what consumers may think regarding the similarity of two marks” *Paleteria La Michoacana, Inc. v. Productos Lacteos Tocumbo S.A. De C.V.*, No. 11-1623, 2014 WL 4759945, at *8 (D.D.C. Sept. 25, 2014); *see also Adventis, Inc. v. Consol. Prop. Holdings, Inc.*, No. 7:02CV00611, 2006 WL 1134129, at *5 (W.D. Va. Apr. 24, 2006) (noting that in the tacking context, “[t]he opinion of a court sitting in its ivory tower sheds no light on an issue in which the everyday consumer is the more adept expert”).⁶

6. Although Petitioner suggests that treating tacking as an issue of fact will clog the otherwise efficient resolution of tacking claims, courts remain free to resolve factual matters as a matter

The potential consequences of treating tacking as a legal question are perhaps best demonstrated through the Morton Salt Umbrella Girl mark. Consider the changes from the 1921 to the 1933 logo:



1921



1933

of law where “reasonable minds cannot differ and the evidence permits only one conclusion.” *Quiksilver, Inc. v. Kymsta Corp.*, 466 F.3d 749, 759 (9th Cir. 2006). Indeed, tacking cases have been appropriately resolved based on the inescapable conclusion presented by the evidence, or lack thereof. *See, e.g., id.* (testimonial concessions that marks were distinct because reliance solely on new mark was likely to cause lack of brand recognition); *Brookfield Comm’cns*, 174 F.3d at 1049 (rejecting tacking claim where proponent failed “to make the slightest showing that consumers view these terms as identical”); *KeyCorp v. Key Bank & Trust*, 99 F. Supp. 2d 814, 820 (N.D. Ohio 2000) (denying tacking where proponent admitted that new mark was intended “to dissociate itself” from scandals associated with original mark).

Morton Salt might have had ample, credible evidence that both of these marks create a single commercial impression in the minds of consumers: that of a young girl shielding herself from the rain, spilling Morton Salt freely despite the wet conditions around her. If Morton Salt were to assert a tacking claim as to these marks, it should be entitled to present such factual evidence (just as the party opposing tacking should have the opportunity to present any contrary factual evidence).⁷ But what if, instead, a court substitutes its own views of what consumers think for the actual evidence of how consumers view the marks? The court may conclude that the change from white umbrella to black or the slight changes in the Girl's hairstyle, ribbon, or dress, create an entirely new commercial impression, regardless of whether the actual evidence of consumer perception supports this conclusion. Thus, brand owners could be divested of their trademark rights based only on the personal view of one court rather than on the view of the actual purchasing public, whose impressions are considered the chief touchstone of trademark law. To avoid such a result, tacking should be treated as a factual issue and not as a matter of law.

7. See *Adventis, Inc.*, 2006 WL 1134129 (treating tacking as a factual issue). In *Adventis*, both parties sought to tack updated marks to prior iterations. Addressing the defendant's addition of an exclamation point to its prior registered mark, the court noted that the addition could be viewed by consumers as more than a mere punctuation mark, but rather "a new design feature [that] could impart a differing commercial impression." *Id.*, 2006 WL 1134129, at *6. Thus, the court held that the tacking issue should not be resolved by the court through summary judgment but instead should be presented to the fact-finder for determination.

D. Tacking and Likelihood of Confusion Analysis Differ Fundamentally and Thus Require Independent Treatment

As noted by the Ninth Circuit’s decision below, a circuit split exists with respect to whether tacking and likelihood of confusion are questions of law or fact. *See Hana Fin., Inc. v. Hana Bank*, 735 F.3d 1158, 1164 n.5 (9th Cir. 2013); *see also Adventis*, 2006 WL 1134129, at *4 (summarizing circuit split). Courts deciding whether to treat tacking as a question of law or one of fact typically have followed their respective circuit’s treatment of the likelihood of confusion analysis, which is treated as an issue of fact reviewable for clear error in some circuits, and as a matter of law reviewable *de novo* in others. *See, e.g., Quiksilver, Inc. v. Kymsta Corp.*, 466 F.3d 749, 759 (9th Cir. 2006) (“[B]ecause we have analyzed the analogous consideration of likelihood of confusion as a factual question, whether tacking applies should also be analyzed as a question of fact.”); *see also Van Dyne-Crotty*, 926 F.2d at 1159. This approach is misguided for several reasons.

First, the underlying tests for the two inquiries are qualitatively different: tacking requires proof that two marks actually create the same commercial impression, whereas likelihood of confusion is met by showing that a competitor’s mark is *likely* to lead consumers to think two marks are affiliated with the same company—an inquiry resolved through application of a multi-factor, digits of confusion test. *See George & Co.*, 575 F.3d at 393 (“A likelihood of confusion exists if ‘the defendant’s actual practice is likely to produce confusion in the minds of consumers about the origin of the goods or services in question.’”) (citation omitted); *see also Navistar*, 1998 WL 911776, at *4.

Second, although the circuits may disagree over whether likelihood of confusion and tacking are more appropriately treated as questions of law or fact, the circuits agree that the “similarity of the marks” digits of confusion factor—which is perhaps most analogous to the tacking inquiry—presents a question of fact. *Cf. Adventis*, 2006 WL 1134129, at *5 (“Both analyses are inherently factual because they depend on the unique facts and circumstances of each case, and the factfinder must ultimately weigh the merits of the issue when the facts are disputed.”). Indeed, the few circuits holding that likelihood of confusion is a matter of law do so with an understanding that each of the individual underlying factors considered during likelihood of confusion analysis are issues of fact. *See Bose Corp. v. QSC Audio Prods., Inc.*, 293 F.3d 1367, 1370 (Fed. Cir. 2002); *Induct-O-Matic Corp. v. Inductotherm Corp.*, 747 F.2d 358, 361 (6th Cir. 1984); *Plus Prods. v. Plus Discount Foods, Inc.*, 722 F.2d 999, 1004-05 (2d Cir. 1983). Since tacking presents an equally (and perhaps greater) fact-intensive inquiry as the similarity of marks factor, it follows, *a fortiori*, that tacking must present an issue of fact.

Although sole reliance on a judicial side-by-side comparison is improper in a likelihood of confusion analysis, courts such as *Van Dyne-Crotty* have sanctioned tacking analysis based on that very approach, *see Van Dyne-Crotty*, 926 F.2d at 1159, inviting subsequent courts to substitute judicial impression for commercial impression. For example, the Federal Circuit has stated that because “[n]o evidence need be entertained other than the visual or aural appearance of the marks themselves,” tacking is a question of law. *Dial-A-Mattress*, 240 F.3d at 1347. Tacking, however, requires more than

a theoretical inquiry, as it concerns how consumers actually perceive the marks as those marks are used in the marketplace. Analyzing nothing more than the visual and aural appearance of the marks completely eliminates the marketplace realities, and results in no more than a subjective and, often, seemingly arbitrary, tallying of the similarities and differences of the marks.

Third, the judicial side-by-side trademark comparison that has occurred in some tacking cases has been deemed improper in the somewhat analogous “similarity of the marks” prong of the digits of confusion analysis. *See, e.g., Sabinsa Corp. v. Creative Compounds, LLC*, 609 F.3d 175, 183 (3d Cir. 2010) (“The proper test is not a side-by-side comparison but, rather, whether the labels create the same overall impression when viewed separately.” (internal quotation marks; citation omitted)); *Hornady Mfg. Co. v. Doubletap, Inc.*, 746 F.3d 995, 1002 (10th Cir. 2014) (“[I]n its comparison of the marks, the court is not free to focus solely on name similarity. The court must consider the effect of marketplace presentation, including lettering styles, logos and coloring schemes.” (internal quotation marks; citations omitted)); *Peoples Fed. Sav. Bank v. People’s United Bank*, 672 F.3d 1, 13 (1st Cir. 2012) (“[S]imilarity is determined on the basis of the total effect of the designation, rather than a comparison of the individual features.” (internal quotation marks; citation omitted)).

E. Courts May Continue to Serve a Gatekeeper Function by Resolving Threshold Tacking Issues As a Matter of Law

Although resolution of a tacking claim is factual, a court may perform a “gatekeeping function” to determine whether tacking may even be considered. Courts must screen for the existence of any legal barrier that would preclude an altered mark from being tacked to its predecessor mark(s).

While trademark law is largely centered around the factual inquiry of consumer impression, several facets of trademark law fall within a court’s domain. As relevant here, a court may analyze the alleged mark(s) to evaluate potential legal bars to such marks’ ability to function as protectable trademarks. If either the original or the altered mark is unprotectable or if the only feature resulting in continuity between the two marks is legally unable to be accorded any trademark significance, the tacking claim must necessarily fail as a matter of law.⁸

For example, a mark may be altered in such a way as to render it invalid as a trademark, such as through the addition of a protected word, initial, or symbol. *See, e.g.*, 36 U.S.C. § 21705 (precluding use of the name “American

8. Only a minority of tacking cases will present a dispositive threshold issue that would bar the trier of fact from deciding whether the altered mark and its original incarnation create an enduring and identical impression in the eyes of the consumer. *See, e.g., Dial-A-Mattress*, 240 F.3d at 1348; *Hess’s of Allentown, Inc. v. Nat’l Bellas Hess, Inc.*, 169 U.S.P.Q. (BNA) 673, 677 (T.T.A.B. 1971); *Pro-Cuts v. Schilz-Price Enters., Inc.*, 27 U.S.P.Q.2d (BNA) 1224, 1226-27 (T.T.A.B. 1993).

Legion”); 36 U.S.C. § 30106 (precluding use of variations of “Big Brothers” and “Big Sisters”); 18 U.S.C. § 707 (precluding use of the name “4-H Club” and green four-leaf clover insignia); 36 U.S.C. § 220506 (precluding use of Olympic names and symbols); 22 U.S.C. § 2518 (precluding use of the name “Peace Corps”); 18 U.S.C. § 706 (precluding use of Red Cross name and emblem). Similarly, it is an established principle of trademark law that the addition of “.com” to an otherwise generic domain name does not alter the character of the name, and repetition of a generic name does not render such name non-generic. *In re Hotels.com*, 573 F.3d 1300, 1304 (Fed. Cir. 2009) (holding that “the generic term ‘hotels’ did not lose its generic character by placement in the domain name HOTELS.COM”); *In re Lighthouse, Inc.*, 82 U.S.P.Q.2d (BNA) 1471, (T.T.A.B. 2007) (holding that repetition of a descriptive term did not render the mark non-descriptive).

Likewise, where a mark’s only asserted linking element is alleged to be functional, the court should rule on the functionality issue before addressing tacking. While a trier of fact could find, for instance, that a party’s prior use of a certain color creates a continuing commercial impression between a later mark and its predecessor mark, such color combination could be deemed functional as a matter of law based on the evidentiary record and therefore precluded from being accorded any trademark significance. *See, e.g., Warner Lambert Co. v. McCrory’s Corp.*, 718 F. Supp. 389, 396 (D.N.J. 1989) (explaining functionality doctrine and holding amber color of mouthwash likely functional).

In sum, the role of the court in tacking cases is to determine whether the marks to be tacked are capable of continuous trademark protection in light of applicable trademark legal principles. If no legal bar to such protection exists, the question of tacking should be presented to the finder of fact to determine whether the marks create the same commercial impression.

CONCLUSION

For the foregoing reasons, the decision of the United States Court of Appeals for the Ninth Circuit should be affirmed.

Respectfully submitted,

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