

Hana Financial, Inc. v. Hana Bank

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HANA FINANCIAL, INC. V. HANA BANK,

135 S. CT. 907 (2015)

I. INTRODUCTION

Petitioner Hana Financial first sued Respondent Hana Bank in the District Court for the Central District of California, alleging violations of its federally registered trademark.¹ Respondent denied infringement by claiming that it had priority to the mark under the tacking doctrine.² The District Court initially granted summary judgment to Petitioner on the infringement claim, however, the Court of Appeals for the Ninth Circuit reversed the decision, holding that there were genuine issues of material fact as to which party had priority to the trademark.³ On remand, the jury gave a verdict in favor of Respondent Hana Bank.⁴ The District Court denied Hana Financial's motion for judgment as a matter of law.⁵

The verdict was affirmed by the Court of Appeals for the Ninth Circuit, holding that tacking was an appropriate question of fact for the jury.⁶ Petitioner Hana Financial then appealed to the Supreme Court of the United States, which granted certiorari on the question of whether tacking should be decided by judges or juries.⁷

Justice Sonia Sotomayor, writing for the Supreme Court, concluded that whether two marks may be tacked for purposes of determining priority is a question for the jury.⁸ The Supreme Court affirmed the judgment for the respondent Hana Bank.⁹

¹ Hana Financial, Inc. v. Hana Bank, 135 S. Ct. 907 (2015).

² *Id.* at 910.

³ *Id.*

⁴ *Id.*

⁵ *Id.*

⁶ *Id.*

⁷ *Hana*, 135 S. Ct. at 911 (2015).

⁸ *Id.*

⁹ *Id.*

II. BACKGROUND

Respondent Hana Bank, a subsidiary of Hana Financial Group, was first established in 1971 in Korea under the name Korea Investment Finance Corporation.¹⁰ The company changed its name to “Hana Bank” in 1991 and began using that name in Korea¹¹. In 1994, Hana Bank began a service called “Hana Overseas Korean Club” to provide financial services for Korean expatriates and started to advertise that service in the United States.¹² The advertisements included the name “Hana Overseas Korean Club” in English and Korean and the name “Hana Bank” in Korean, along with the respondent’s “dancing man” logo.¹³ In 2000, the respondent changed the name of its expatriate financial services branch to “Hana World Center.”¹⁴ The respondent began operating under the name “Hana Bank” in 2002, in its first physical appearance in the United States.¹⁵

In 1994, Petitioner Hana Financial was established as a California corporation.¹⁶ Petitioner began using that name and an associated trademark in interstate commerce in 1995.¹⁷ In 1996, petitioner was granted a federal trademark registration for a pyramid logo with the name “Hana Financial” for use in connection with financial services.¹⁸

Petitioner sued respondent in 2007, alleging infringement of its “Hana Financial” trademark.¹⁹ Respondent Hana Bank denied infringement, invoking the tacking doctrine.²⁰ The District Court’s initial grant of summary judgment to respondent was reversed by the Ninth Circuit, which determined that there were

¹⁰ *Id.* at 909.

¹¹ *Id.*

¹² *Id.*

¹³ *Hana*, 135 S. Ct. at 909.

¹⁴ *Id.*

¹⁵ *Id.*

¹⁶ *Id.* at 910.

¹⁷ *Id.*

¹⁸ *Id.*

¹⁹ *Hana*, 135 S. Ct. at 910.

²⁰ *Id.*

genuine issues of material fact as to priority.²¹ On remand, a jury granted a verdict in favor of respondent Hana Bank.²² The petitioner's motion for judgment as a matter of law was denied.²³

The Court of Appeals for the Ninth Circuit affirmed, explaining that tacking "requires a highly fact-sensitive inquiry" that is "reserved for the jury."²⁴ The Ninth Circuit acknowledged that there is a circuit split on whether tacking should be decided by judges or juries, but noted that it was resolving the issue in this way because of the Ninth Circuit's similar view of likelihood of confusion as a question of fact.²⁵ At that time, the Sixth Circuit and the Federal Circuit, as well as the Trademark Trial and Appeal Board, had expressly held that tacking was a legal question.²⁶

Hana Financial, Inc. petitioned the Supreme Court for a writ of certiorari on April 7, 2014.²⁷ The Supreme Court granted certiorari on June 23, 2014.²⁸

III. LEGAL ANALYSIS

Justice Sonia Sotomayor, writing for the unanimous Supreme Court, quickly got to the point and stated that a determina-

²¹ *Id.*

²² *Id.* The jury was instructed:

A party may claim priority in a mark based on the first use date of a similar but technically distinct mark 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. This is called 'tacking.' 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.*

²³ *Id.*

²⁴ *Id.*

²⁵ *Hana Financial v. Hana Bank*, 735 F.3d 1158, 1164 n.5 (9th Cir. 2013) ("Although the other circuits have not decided the issue yet, the district court in circuits where likelihood of confusion is a question of fact also treat tacking as a question of fact").

²⁶ Petition for Writ of Certiorari, *Hana* at 22, 135 S. Ct. 907 (No. 13-1211).

²⁷ *Hana*, 135 S. Ct. at 910.

²⁸ *Id.*

tion of whether tacking should be applied “falls comfortably within the ken of a jury.”²⁹ She then dismissed the petitioner’s four arguments for why tacking should be a question of law.³⁰ First, she determined that the application of a legal standard does not require resolution by a judge.³¹ Second, Sotomayor dismissed concerns about the precedential effect of tacking determinations by a jury.³² Third, it was determined that a lack of predictability of tacking decisions due to assignment to a jury was also not a good enough reason to make it a question of law.³³ Finally, Sotomayor concluded that the petitioner’s reliance on historical resolution of tacking disputes by judges was ill-placed on non-representative cases.³⁴

A. A Question for the Jury

The Court noted first that the general rule of tacking as adopted by lower courts has been that “two marks may be tacked when the original and revised marks are legal equivalents.”³⁵ Marks that are legally equivalent create “the same continuing commercial impression so that consumers consider both as the same mark.”³⁶

²⁹ *Id.* at 911.

³⁰ *Id.*

³¹ *Id.* at 911-912.

³² *Id.* at 912.

³³ *Id.*

³⁴ *Id.*

³⁵ *Hana*, 135 S. Ct. at 909. (internal quotation marks omitted).

³⁶ Brief for the Petitioner, *Hana*, 135 S. Ct. 907 (No. 13-1211), at 19. The petitioners expanded upon the rationale for this test in their initial brief, stating;

[I]f two marks are not so similar that consumers would regard them as essentially identical, tacking would impermissibly expand the trademark owner's rights. The rationale for this requirement mirrors the first: even if the marks look and sound alike, they will nonetheless create a different monopoly if they present different commercial impressions. Once again, if the preemptive scope of the marks differ, tacking is impermissible.

The Court concluded that the application of tacking, a test that is dependent upon an ordinary consumer's understanding, should generally be made by a jury.³⁷ In support, Sotomayor quoted *Railroad Co. v. Stout*, noting "it is assumed that twelve men know more of the common affairs of life than does one man, [and] that they can draw wiser and safer conclusions from admitted facts thus occurring than can a single judge."³⁸

The opinion did note that judges might determine whether two marks may be tacked in some instances, such as in a bench trial, on a motion for summary judgment, or for judgment as a matter of law.³⁹ The Court's conclusion on the overall issue was narrowly phrased, stating "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."⁴⁰

B. *The Petitioner's Arguments*

Next, Justice Sotomayor took apart the Petitioner's arguments that tacking should be decided as a question of law.⁴¹

The Petitioner first argued that the "legal equivalents" test involved the application of a legal standard.⁴² Though the Court conceded that this was true, it also pointed out that juries have typically resolved mixed questions of law and fact.⁴³ Sotomayor stated that any concerns about the jury improperly applying the relevant legal standard could be resolved by crafting careful jury

Id. (quoting *Van Dyne-Crotty v. Wear-Guard Corp.*, 926 F.2d 1156, 1159 and *Brookfield Communications, Inc v. West Coast Entertainment Corp.*, 174 F.3d 1036, 1045-48 (9th Cir. 1999), among others) (internal quotation marks omitted).

³⁷ *Hana*, 136 S. Ct. at 911.

³⁸ *Id.* (quoting *Railroad Co. v. Stout*, 17 Wall. 657, 664 (1874)).

³⁹ *Id.*

⁴⁰ *Id.*

⁴¹ *Id.*

⁴² *Id.*

⁴³ *Hana*, 135 S. Ct. at 911.

instructions, such as those that were agreed upon at the district court level in *Hana*.⁴⁴

Second, the petitioner argued that tacking determinations will “create new law that will guide future tacking disputes,” and that this is a task reserved for judges.⁴⁵ The Court pointed out, however, that the petitioner had not explained why a tacking determination in one case would create new law any more than a jury verdict in other types of cases.⁴⁶ Justice Sotomayor disagreed with the petitioner’s assertion that tacking questions “have to be” resolved by comparing two marks in a given case to those addressed in previous tacking cases, noting that there was no support for this argument.⁴⁷ She stated that judges may look to past cases in deciding summary judgment motions or bench trials, but that there was no explicit requirement.⁴⁸ She then pointed out that the cases the petitioner cited to prove its point relied on precedent only to define the relevant legal standard.⁴⁹

Third, the petitioner argued that if juries were to decide tacking questions, “the predictability required for a functioning trademark system” would be absent.⁵⁰ The Court dismissed this concern as well, noting that juries often make dispositive determinations in the area of tort, contract, and criminal law.⁵¹ “The fact that another jury, hearing the same case, might reach a different conclusion may make the system ‘unpredictable,’ but it has never stopped us from employing juries in these analogous contexts.”⁵² In this case, the Petitioner provided no reasoning for why trademark tacking should be treated differently than other cases.⁵³ Sotomayor also stated that as decision making in fact-intense disputes

⁴⁴ *Id.* at 912.

⁴⁵ *Id.*

⁴⁶ *Id.*

⁴⁷ *Id.*

⁴⁸ *Id.*

⁴⁹ *Id.*

⁵⁰ *Hana*, 135 S. Ct. at 912.

⁵¹ *Id.*

⁵² *Id.*

⁵³ *Id.*

necessarily required judgment calls, there was always some degree of uncertainty involved.⁵⁴

Finally, the petitioner argued that historically, judges have always resolved tacking disputes.⁵⁵ However, the Court noted that all of the cases the petitioner relied on for this argument were bench trials, at summary judgment, or similarly situated.⁵⁶ Judges undisputedly may resolve tacking disputes in those contexts.⁵⁷ But when the facts do not support summary judgment or judgment as a matter of the law, tacking is a question for the jury to decide.⁵⁸

IV. FUTURE IMPLICATIONS

The *Hana Financial v. Hana Bank* decision, the first substantive trademark decision by the Supreme Court in over a decade,⁵⁹ looks fairly straightforward at first glance. However, this decision actually has several layers to it that could affect trademark litigation in several ways.⁶⁰

First, the *Hana* decision may very well raise litigation costs in cases where tacking is an issue, as lawyers will want to include

⁵⁴ *Id.*

⁵⁵ *Id.*

⁵⁶ *Id.* at 913, (citing to *Drexel Enterprises, Inc. v. Richardson*, 312 F.2d 525, 526 (10th Cir. 1962) (“It was tried without a jury”); *Perfectform Corp. v. Perfect Brassiere Co.*, 256 F.2d 736, 738 (3rd Cir. 1958) (“The District court dismissed the complaint”; *John Morrell & Co. v. Hauser Packing Co.*, 20 F.2d 713 (9th Cir. 1927) (“In the court below, there was a dismissal of both the bill and of defendant’s counterclaim”); *Beech-Nut Packing Co. v. P. Lorillard Co.*, 299 F. 834, 835 (D.N.J. 1924) (equitable claims tried solely before a judge))

⁵⁷ *Id.*

⁵⁸ *Id.*

⁵⁹ The last substantive trademark case decided by the court was *KP Permanent Makeup, Inc. v. Lasting Impression, Inc.* (in which the Court determined that a party asserting a fair use defense to a trademark infringement claim did not need to negate any likelihood that the practice in question would confuse consumers about the origin of the goods.) *KP Permanent Makeup, Inc. v. Lasting Impression, Inc.*, 543 U.S. 111 (2004).

⁶⁰ It should be noted first that the parties in this suit were most concerned about the standard of review granted by an appellate court to a district court’s finding of tacking. Though there are clear advantages in trademark litigation to having a jury of twelve decide a consumer based test rather than a judge, this is less important in litigation than the ability to appeal.

more expert testimony for the jury.⁶¹ The resolution of tacking as a question of fact may also result in more disputes over priority at the trial stage, as opposed to being resolved on summary judgment.⁶² On the other hand, tacking may now be easier to prove.⁶³ As demonstrated in the *Hana* record, judges historically have been quite strict in tacking determinations and have often only applied it in very limited circumstances.⁶⁴ Now that juries relying on their own impressions will determine tacking, it is likely that jury's application of the test may be less strict.

Second, it is important to point out that though the court decided the standard of review for trademark tacking, it never expressly upheld the tacking doctrine itself or stated whether its test is valid.⁶⁵ In fact, Justice Sotomayor went out of her way to avoid voicing any sort of support for the doctrine, describing the doctrine and its test in terms of what "lower courts have provided" and in what situations "lower courts have found" tacking rather than using any language affirming the doctrine.⁶⁶ The case itself was resolved by looking at cases from "a variety of doctrinal contexts" rather than trademark cases.⁶⁷

⁶¹ Steve Borgman, *Lawyers Weigh In On High Court Trademark Tacking Ruling*, Law360, <http://www.law360.com/articles/613629/lawyers-weigh-in-on-high-court-trademark-tacking-ruling> (January 21, 2015 7:34 pm).

⁶² *Id.*

⁶³ Ross A. Dannenberg, *Lawyers Weigh In On High Court Trademark Tacking Ruling*, Law360, <http://www.law360.com/articles/613629/lawyers-weigh-in-on-high-court-trademark-tacking-ruling> (January 21, 2015 7:34 pm).

⁶⁴ Brief for the Petitioner, *supra* note 36, at 35. The Petitioner's initial brief pointed to several cases in which tacking was disallowed by the Trademark Trial and Appeal Board where the marks seemed almost exactly the same. In *Am. Paging, Inc. v. Am. Mobilphone, Inc.*, the TTAB refused to grant tacking between AMERICAN MOBILPHONE and AMERICAN MOBILPHONE PAGING, even though those two marks had an identical stars and stripes design. *Am. Paging, Inc. v. Am. Mobilphone, Inc.*, 13 U.S.P.Q.2D 2036, 2037-2938 (T.T.A.B. 1989), *aff'd*, 923 F.2d 869 (Fed. Cir. 1990). In *Pro-Cuts v. Schilz-Price Enters., Inc.*, the TTAB disallowed tacking between PRO-CUTS and PRO-KUT. *Pro-Cuts v. Schilz-Price Enters., Inc.*, 27 U.S.P.Q.D.2d 1224, 1227 (T.T.A.B. 1993).

⁶⁵ *See Hana*, 135 S. Ct. at 913.

⁶⁶ *Id.* at 907

⁶⁷ *Id.*

This avoidance may be due to the fact that neither party argued against the validity of the tacking doctrine itself.⁶⁸ Such careful evasion, however, indicates that the Court may still have qualms about the doctrine and the test itself.

Third, the Court used *Hana* to once again implicitly deny IP exceptionalism.⁶⁹ IP exceptionalism has been defined as “the widely held belief that IP cases are immune from the influence of judicial ideology.”⁷⁰ The Court referenced trademark cases only in defining the standard and test set out by the lower court.⁷¹ The actual holding of the case⁷² was derived from decisions hailing from real estate law,⁷³ obscenity,⁷⁴ and tort law.⁷⁵ The Court further refuted IP exceptionalism by noting that, “Petitioner has offered no reason why trademark tacking ought to be treated differently [than the tort, contract, and criminal justice systems]” in regards to concerns about unpredictable systems of law.⁷⁶

The *Hana* holding falls in line with several recent Supreme Court holdings in intellectual property cases. Just a day before the *Hana* ruling came down, the Court held in *Teva Pharmaceuticals v. Sandoz* that the Federal Circuit should review factual findings

⁶⁸ *Id.* at 910 n.1.

⁶⁹ Matther Sag, Tonja Jacobi & Maxim Sytch, *Ideology and Exceptionalism in Intellectual Property: An Empirical Study*, 97 CALIF. L. REV., 801 (2009) (The article further describes this viewpoint by noting that “it is certainly the dominant view among intellectual property (IP) scholars that copyright, patent, and trademark cases hinge on doctrinal rules and policy issues specific to IP.”).

⁷⁰ *Id.*

⁷¹ *Hana*, 135 S. Ct. at 907.

⁷² *Id.* (“[W]hen the relevant question is how an ordinary person or community would make an assessment, the jury is generally the decisionmaker that ought to provide the fact-intensive answer. . . .”).

⁷³ *Id.* (citing *United States v. Gaudin*, 515 U.S. 506, 512 (1995), holding that the defendant was entitled to jury determination of the “materiality” of the false statements at issue on federal loan documents under the due process clause and the constitutional right to a jury trial).

⁷⁴ *Id.* (citing *Hamling v. United States*, 418 U.S. 87, 104-05 (1974), holding that the brochures at issue were obscene).

⁷⁵ *Id.* (citing *Railroad Co v. Stout*, 17 Wall. 657, 664 (1874), holding that a landowner could be liable for the injuries of a child trespasser).

⁷⁶ *Id.* at 912.

made in patent claim construction under a clear error standard.⁷⁷ In that case, Justice Breyer, writing for the Court, noted, “even if exceptions to [Federal Rule of Civil Procedure 52(a)(6)] were permissible, we cannot find any convincing ground for creating an exception to that Rule here.”⁷⁸ *Teva* itself was seen as the next step in several cases rejecting “patent only” doctrines devised by the Federal Circuit.⁷⁹ These cases include *eBay v. MercExchange*⁸⁰ and *Gunn v. Minton*.⁸¹

Finally, the *Hana* decision may have its largest impact on the way that questions of likelihood of confusion are resolved in the future. In reality, tacking is not often an issue in litigation. This may be because smart trademark owners often simply register alterations made to their marks as new marks. Alternatively, alert attorneys with a potential claim would likely file suit before there was ever an alteration or attempt to tack to the former mark. The biggest impact that the *Hana* decision may actually have in the future may be seen in its effect on likelihood of confusion cases.

The resolution of tacking as a question of fact strongly implies that the circuit split on the standard of review for likelihood

⁷⁷ *Teva Pharm. v. Sandoz*, 135 S. Ct. 831, 833 (2015).

⁷⁸ *Id.*

⁷⁹ Ronald Mann, *Opinion Analysis: Court moves to rein in Federal Circuit control over district court claim construction*, SCOTUSBLOG <http://www.scotusblog.com/2015/01/opinion-analysis-court-moves-to-rein-in-federal-circuit-control-over-district-court-claim-construction> (Jan. 20, 2015, 1:51 PM).

⁸⁰ *eBay v. MercExchange*, 547 U.S. 388, 390-92 (2006) (overturning the Federal Circuit’s general rule that “courts will issue permanent injunctions against patent infringement absent exceptional circumstances,” holding that the traditional four-factor permanent injunction test applied also in patent cases. As this Court has long recognized, a major departure from the long tradition of equity practice should not be lightly implied. Nothing in the Patent Act indicates that Congress intended such a departure.) (internal quotation marks omitted).

⁸¹ *Gunn v. Minton*, 133 S. Ct. 1059, 1065 (2013) (holding that a legal malpractice claim arising from a patent infringement case did not arise under federal patent law and could not be brought in federal court. The court also concluded that state legal malpractice claims based on underlying patent matters would rarely, if ever, arise under federal patent law for the purpose of bringing it into federal court).

of confusion should be resolved the same way.⁸² By the Petitioner's own admission, the standard for tacking is much higher than that for a likelihood of confusion analysis.⁸³ Logically, once it has been resolved that tacking is a question of fact for the jury, it is clear that likelihood of confusion cannot be a question of law.

The implication of *Hana* on the likelihood of confusion test was always an "elephant in the room" for the petitioners (as Justice Kennedy referred to it in oral arguments).⁸⁴ The only two circuits (the Federal and the Sixth Circuit) currently treating likelihood of confusion as a matter of law were also the only two treating tacking as a matter of law prior to the *Hana* holding.⁸⁵

The counsel for the United States as [*amicus curiae*] in the case pointed out that though there's a circuit split on whether likelihood of confusion is a question of law or a question of fact (affecting its review on appeal), every circuit treats it as a question for the jury.⁸⁶ She pointed out that in the Second Circuit, jury determinations on likelihood of confusion were reviewed by the appeals court as a question of law, without giving much deference to the jury's ultimate determination.⁸⁷ The justices' own questions during oral argument on the subject indicate how little sense this system makes.⁸⁸ In light of the *Hana* decision, it's almost assured that any future likelihood of confusion case granted certiorari by the court would be resolved in the same way.

V. CONCLUSION

After analyzing the Petitioner's claim, the Supreme Court of the United States found that whether two trademarks may be tacked for purposes of determining priority is a question for the ju-

⁸² Transcript of Oral Argument at 29, *Hana*, 135 S. Ct. 907.

⁸³ Brief for the Petitioner, *supra* note 36, at 6 ("[T]he tacking standard is considerably higher than the standard for likelihood of confusion") (internal quotation marks omitted) (quoting *Brookfield Communs. V. W. Coast Entm't Corp.*, 174 F.3d 1036, 1048 (9th Cir. 1999)).

⁸⁴ Transcript of Oral Argument, *supra* note 82.

⁸⁵ *Id.*

⁸⁶ *Id.* at 40-41.

⁸⁷ *Id.* at 41-42.

⁸⁸ *Id.* at 42.

ry.⁸⁹ Therefore, it held that the District Court did not err in presenting the tacking question to the jury and affirmed the judgment of the Ninth Circuit.⁹⁰

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⁸⁹ *Hana*, 135 S. Ct. at 913.

⁹⁰ *Id.*

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