

IP File

The IP File's mission is to scour the universe for compelling stories in intellectual property law. In the United States, there are four main types of intellectual property protection available: patents, copyrights, trademarks and trade secrets.

January 22, 2015

Who A-Tacks a Decision on Tacking? U.S. Supreme Court Rules That Tacking Trademarks to Gain Earlier First Use Is a Question Of Fact

It's a historic week for trademarks! On January 21, 2015, the U.S. Supreme Court issued a decision in the case of Hana Financial, Inc. v. Hana Bank, which marks the high court's first substantive ruling on trademarks in more than ten years. In its decision, the Supreme Court unanimously held that trademark tacking is a factual question, and thus, should be decided by juries.

TAGS: doctrine of tacking, factual question, hana bank, hana financial, hana financial inc. v. hana bank, judge, jury, justice sonia sotomayor, legal question, ninth circuit, supreme court, tacking trademarks, trademark & trade dress, trademarks, u.s. supreme court

January 14, 2015

Low Octane Levels? Octane Fitness' Impact in the Trademark and Trade Secret Realms

We have previously addressed the Supreme Court's decision in Octane Fitness, LLC v. Icon Health & Fitness, Inc., 12-1184, Slip Op. at 7 (2014), which relaxed the standard for awarding attorney's fees under Section 285 of the Patent Act ("§285") and ruled that decisions on §285 are entitled to deference on appeal. In the patent litigation realm, the Octane Fitness decision does not seem to have led to an overwhelming trend toward awarding fees. It does, however, beg the question: how has this impacted the standard for awarding attorney's fees in other types of intellectual property cases, such as trademarks and trade secrets?

TAGS: apple inc. v. samsung elecs. co., bmw of north america v. cudahar, fair wind sailing v. dempster, intellectual property, lanham act, monster daddy v. monster cable products, ninth circuit, octane fitness, octane fitness llc v. icon health & fitness inc., patent act, patent infringement, patent litigation, patent litigation, premium balloon accessories v. creative ballon mfg., sixth circuit, supreme court, third circuit court of appeals, tivo research, tns, tns media research v. tivo research, trade secret & unfair competition, trade secret statutes, trade secrets, trademark & trade dress, trademark attorney fees, trademarks, uniform trade secrets act, utsa

December 10, 2014

Hana Financial, Inc. v. Hana Bank: U.S. Supreme Court to Decide Whether Tacking Trademarks to Gain Earlier First Use is a Question for the Court or the Jury

By: Kollin J. Zimmermann

“Priority of use” is a key issue in any case involving a trademark ownership dispute. As the Ninth Circuit has explained, “To acquire ownership of a trademark it is not enough to have invented the mark first or even to have registered it first; the party claiming ownership must have been the first to actually use the mark in the sale of goods or services.” *Brookfield Commc'ns, Inc. v. W. Coast Entm't Corp.*, 174 F.3d 1036, 1047 (9th Cir. 1999).

TAGS: brookfield commc'ns inc. v. w. coast entm't corp., federal circuit, hana bank, hana financial, hana financial inc. v. hana bank, hana overseas korean club, ninth circuit, priority of use, sixth circuit, tacking doctrine, tacking trademarks, trademark & trade dress, u.s. supreme court