

## 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 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

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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