

No. 13-

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**In the Supreme Court of the United States**

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HANA FINANCIAL, INC.,

*Petitioner,*

v.

HANA BANK & HANA FINANCIAL GROUP,

*Respondents.*

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**On Petition for a Writ of Certiorari to  
the United States Court of Appeals  
for the Ninth Circuit**

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**PETITION FOR A WRIT OF CERTIORARI**

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## **QUESTION PRESENTED**

To own a trademark, one must be the first to use it; the first to use a mark has “priority.” The trademark “tacking” doctrine permits a party to “tack” the use of an older mark onto a new mark for purposes of determining priority, allowing one to make slight modifications to a mark over time without losing priority. Trademark tacking is available where the two marks are “legal equivalents.”

The question presented, which has divided the courts of appeals and determined the outcome in this case, is:

Whether the jury or the court determines whether use of an older mark may be tacked to a newer one?

**CORPORATE DISCLOSURE STATEMENT**

Hana Financial, Inc., has no parent company, and no publicly held company owns 10% or more of petitioner's stock.

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## PETITION FOR A WRIT OF CERTIORARI

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Petitioner, Hana Financial, Inc., respectfully petitions for a writ of certiorari to review the judgment of the United States Court of Appeals for the Ninth Circuit.

### OPINIONS BELOW

The opinion of the court of appeals (App., *infra*, 1a-20a) is reported at 735 F.3d 1158. The district court's memorandum opinion and order setting forth its factual findings (App., *infra*, 21a-32a) is unreported, as is its judgment (*id.* at 33a).

### JURISDICTION

The judgment of the court of appeals was entered on November 22, 2013. On February 7, 2014, Justice Kennedy extended the period for filing a petition for a writ of certiorari to and including April 7, 2014. This Court's jurisdiction rests on 28 U.S.C. § 1254(1).

### STATEMENT

This petition presents a significant and recurring question that has divided the circuits: whether the doctrine of trademark tacking is a question of law, to be resolved by a court, or a question of fact, to be resolved by the jury. The court below expressly noted that “[t]his is the subject of a circuit split.” App., *infra*, 12a n.5. Applying circuit precedent that holds tacking a question of fact, the court affirmed the jury verdict even while acknowledging that “other courts, which consider tacking a question of law, might reach a different conclusion on these facts.” *Id.* at 20a.

A party who owns a trademark may sue another who infringes that mark. To own a mark, a party

must be the first to actually use it; the party that first used a mark is said to have “priority” and the date of the mark’s first use is its “priority date.” In an infringement action, a defendant may defend the suit by claiming that the trademark is invalid; a showing that the putative trademark owner lacks priority is therefore a defense to an infringement claim.

Because entities sometimes wish to make minor changes to their trademarks, the trademark “tacking” doctrine was developed to permit a party to “tack” its earlier use of a trademark to the later mark. If tacking is permitted, the priority date of the *later* mark becomes the party’s first use of the *earlier* mark—which is to say, ownership of the revised mark runs from *first* use of the *initial* mark.

Tacking is permitted only in narrow circumstances where the marks are “legal equivalents.” *Van Dyne-Crotty, Inc. v. Wear-Guard Corp.*, 926 F.2d 1156, 1159 (Fed. Cir. 1991). In a seminal case, the mark “AMERICAN MOBILPHONE” with a star and stripe design was held not to be the legal equivalent of the mark “AMERICAN MOBILPHONE PAGING” with an identical star and stripe design. *Am. Paging, Inc. v. Am. Mobilphone, Inc.*, 13 U.S.P.Q.2d 2036 (T.T.A.B. 1989), *aff’d*, 923 F.2d 869 (Fed. Cir. 1990).

Here, petitioner, who owns the federally registered trademark “Hana Financial,” sued respondents, arguing that their use of “Hana Bank” infringed its rights. Although respondents began using the mark “Hana Bank” seven years after petitioner first used its mark “Hana Financial,” respondents claimed that they actually had priority. Their argument turns on *double* trademark tacking. Respondents argue that they can tack the mark “Hana Over-

seas Korean Club” to the later mark “Hana World Center,” and further that “Hana World Center” may be tacked to “Hana Bank.”

Following the Ninth Circuit’s precedent that trademark tacking is a question of fact, the district court submitted this contention to a jury, which returned a verdict in favor of respondents. The court of appeals affirmed. Although the court acknowledged that a circuit that views this as a question of law would likely reverse the jury’s determination here, it held that circuit precedent, which treats tacking as a question of fact, required affirmance.

Because the circuit courts are split on an important legal question, and because the court below erred in a way that controlled the outcome of this case, review by this Court is warranted.

#### **A. Legal Background.**

The Trademark Act of 1946, also known as the Lanham Act, permits the user of a mark to register it with the Patent and Trademark Office and subsequently claim exclusive use over it. See *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 117 (2004). Two principles of trademark law are at issue here: trademark infringement, and trademark priority.

1. The holder of a registered mark may bring “a civil action against anyone employing an imitation of it in commerce when ‘such use is likely to cause confusion, or to cause mistake, or to deceive.’” *KP Permanent Make-Up*, 543 U.S. at 117 (quoting 15 U.S.C. § 1114(1)(a)). Under this standard, a party may infringe the trademark of another by using a *similar* mark where there is a “the likelihood of confusion,” regardless of whether the infringer uses a mark that

is *identical* to the registered mark. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 769 (1992). Were the rule otherwise, trademark protection would be rendered hollow, as it would be limited to the literal terms of the mark and nothing more. See 4 McCarthy on Trademarks and Unfair Competition § 23:76 (4th ed. 2014).

2. To have a protected interest in a trademark, a party must be the first to actually use it. “The basic rule of trademark ownership in the United States is priority of use;” “[f]or inherently distinctive marks, ownership goes to the first entity to use the designation as a mark.” 2 McCarthy on Trademarks and Unfair Competition § 16:1 (4th ed. 2014). See also *United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90, 100 (1918) (“Undoubtedly, the general rule is that, as between conflicting claimants to the right to use the same mark, priority of appropriation determines the question.”).

Because the first use of a trademark is critical to ownership of it, courts have recognized a narrow doctrine—called trademark tacking—that permits the owner of a trademark to make minor changes to the mark without losing priority. See 1-3 Gilson on Trademarks § 3.03[g] (2013).

The test for trademark tacking is whether the old mark and the new one are “legal equivalents.” *Van Dyne-Crotty*, 926 F.2d at 1159. See also *George & Co. v. Imagination Entm’t Ltd.*, 575 F.3d 383, 402 (4th Cir. 2009); *Brookfield Commc’ns, Inc. v. W. Coast Entm’t Corp.*, 174 F.3d 1036, 1047-1048 (9th Cir. 1999); *Data Concepts, Inc. v. Digital Consulting, Inc.*, 150 F.3d 620, 623 (6th Cir. 1998). In addition, to take advantage of the tacking doctrine a party must demonstrate “continuity.” 3 McCarthy on Trade-

marks and Unfair Competition § 17:26 (4th ed. 2014). That is, “the marks must create the same, continuing commercial impression.” *Van Dyne-Crotty*, 926 F. 2d at 1159 (quotation omitted).

The tacking doctrine is a narrow one: “A consistent theme throughout the tacking cases is that the tacking doctrine should be sparingly applied and allowed only in ‘rare instances.’” 1-3 Gilson on Trademarks § 3.03[2][g]. Examples illustrate the narrowness of the doctrine. The mark “AMERICAN MOBILPHONE” with a star and stripe design was held not to be the legal equivalent of the mark “AMERICAN MOBILPHONE PAGING” with an identical star and stripe design:



*Am. Paging, Inc. v. Am. Mobilphone, Inc.*, 13 U.S.P.Q.2d 2036 (T.T.A.B. 1989), *aff'd*, 923 F.2d 869 (Fed. Cir. 1990). Likewise, the mark “CLOTHES THAT WORK. FOR THE WORK YOU DO” was held not to be the legal equivalent of, and thus was not permitted to achieve priority for, the mark “CLOTHES THAT WORK.” *Van Dyne-Crotty*, 926 F.2d at 1158-1159. And “dci” was not the legal equivalent of “DCI.com.” *Data Concepts*, 150 F.3d at 623-624. In contrast, one of “the few reported cases allowing tacking” (*One Indus., LLC v. Jim O’Neal Distrib., Inc.*, 578 F.3d 1154, 1161 (9th Cir. 2009)), permitted a company to tack the use of “Hess’s” onto “Hess.” See *Hess’s of Allentown, Inc. v. Nat’l Bellas Hess, Inc.*, 169 U.S.P.Q. 673, 674-675 (T.T.A.B. 1971).

In this way, the trademark tacking doctrine is different from and applied more narrowly than the

“likelihood of confusion” standard that governs the infringement inquiry. “Legal equivalence for tacking purposes does not exist simply because the two marks a party seeks to tack are ‘confusingly similar’” (*Data Concepts*, 150 F.3d at 623); instead, the tacking “standard is considerably higher than the standard for ‘likelihood of confusion.’” *Brookfield*, 174 F.3d at 1048. See also *Van Dyne-Crotty*, 926 F.2d at 1159 (“[F]or the purposes of ‘tacking,’ even if the two marks are confusingly similar, they still may not be legal equivalents.”).

### **B. Factual Background.**

Respondent is a Korean financial institution that was established in 1971 as the Korea Investment Finance Corporation. App., *infra*, 4a. It changed its name in 1991 to Hana Bank (“the Bank”); the word pronounced as “hana” means, in Korean, “number one,” “first,” “top,” or “unity.” *Ibid.*<sup>1</sup> At that time, the Bank had no operations in the United States. *Ibid.* Petitioner Hana Financial, Inc. (“HFI”) was incorporated in 1994 as a California corporation. *Ibid.*

The following events underlie this dispute:

- **May 1994:** the Bank establishes the “Hana Overseas Korean Club” to provide financial services to Korean expatriates residing in the United States. App., *infra*, 5a.
- **July 1994:** the Bank first advertises in the United States, using the English words “HANA Overseas Korean Club.” *Ibid.*
- **August 1994:** HFI incorporates. *Id.* at 4a.

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<sup>1</sup> Hana Financial Group is the Bank’s holding company. App., *infra*, 4a n.1.



- **1995:** HFI begins using its trademark “Hana Financial” in commerce. *Id.* at 6a.
- **1996:** HFI obtains a federal trademark registration for a pyramid logo with the words “Hana Financial.” *Ibid.*
- **2000:** The Bank changes the name of the Hana Overseas Korean Club to “Hana World Center.” *Id.* at 6a-7a.
- **2001:** The Bank attempts to register its “Hana Bank” trademark, but is denied, in part, due to HFI’s “Hana Financial” mark. *Id.* at 7a.
- **2002:** Notwithstanding the failure to register its trademark, the Bank begins to operate in New York under the name “Hana Bank.” *Ibid.*

### C. Proceedings Below.

In 2007, after respondents announced their intention to begin operations in California, petitioner HFI initiated this proceeding, contending that respondents’ use of “Hana Bank” infringed its “Hana Financial” mark. App., *infra*, 7a.

Respondents defended the suit by claiming, in part, that their use of “Hana Bank” has priority over petitioner’s “Hana Financial” mark. App., *infra*, 7a. This claim turns on trademark tacking: although it is undisputed that petitioner first used “Hana Financial” in 1995, seven years prior to respondent’s use of “Hana Bank,” respondents claim that they can trace the use of “Hana Bank” to 1994. Respondents’ argument turns on *double* tacking: they seek to tack their use in 1994 of “Hana Overseas Financial Club” to their use in 2000 of “Hana World Center,” which they

in turn seek to tack to their 2001 use of “Hana Bank.”

1. Ultimately, petitioner’s infringement claim, along with respondents’ tacking-based priority defense, was submitted to a jury.<sup>2</sup> Following the close of respondents’ case, petitioner sought a directed verdict on the priority issue. App., *infra*, 8a. The court denied that motion (*id.* at 28a) and entered judgment in favor of respondents. *Id.* at 33a. Petitioner renewed its argument in a motion for judgment as a matter of law and motion for a new trial, which the district court also denied. *Id.* at 9a.

2. The Ninth Circuit affirmed. App., *infra*, 1a-20a. As the court explained, the critical issue here is whether “the Bank could ‘tack’ its use of its present ‘Hana Bank’ mark to its use of the [‘Hana Overseas Korean Club’] mark beginning in 1994.” *Id.* at 10a.

In reviewing the case, the court adhered to Ninth Circuit precedent that treats tacking as a question of fact. App., *infra*, 12a. The court expressly noted, however, that “[t]his is the subject of a circuit split.” *Id.* at 12a n.5.

The court’s treatment of the tacking as a question of fact, rather than a question of law, determined the outcome of this case. The court candidly noted that “the words ‘Hana Overseas Korean Club,’ ‘Hana World Center,’ and ‘Hana Bank’ seem aurally and visually distinguishable.” App., *infra*, 15a. It was not “clear from their names that these entities offer

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<sup>2</sup> On the issue of trademark priority, the district court initially granted summary judgment to respondent, but the court below reversed and remanded. App., *infra*, 7a. The jury trial followed.

the same services.” *Id.* at 15a-16a. Thus, in the court of appeals’ view, “other courts, which consider tacking a question of law, might reach a different conclusion on these facts.” *Id.* at 20a.

But because the court below considered this a question of *fact*, it was bound to affirm. App., *infra*, 20a. Thus, reviewing the record, the court concluded that “the jury could reasonably conclude that throughout the time period at issue, the ordinary purchasers of these services had the continuous impression that the advertised services were being offered by the Bank and that there were no material differences between the marks.” *Id.* at 18a. In the court of appeals’ view, that was enough to make the verdict a fairly debatable one and, under the highly deferential standard applied to review of jury verdicts, invulnerable to attack on appeal. Under this test, petitioner did not prevail below simply because it could not “show that its interpretation of the evidence is the *only* reasonable one.” *Id.* at 16a.

### **REASONS FOR GRANTING THE PETITION**

Whether trademark tacking is permissible—which turns on whether two marks are so similar that they qualify as “legal equivalents”—presents a legal question. Two courts of appeals, as well as the Trademark Trial and Appeal Board, the specialized trademark tribunal in the Patent & Trademark Office, have held so expressly.

The Ninth Circuit’s contrary conclusion, which admittedly puts it at odds with two other circuits, distorts the nature of the trademark tacking doctrine. It would seem apparent that an inquiry into the existence of “legal equivalents” is legal in character. At the same time, treating the tacking inquiry as

one of law gives a central place to the role of precedent in resolving trademark disputes and, thus, enhances the predictability of the tacking inquiry—a matter of considerable importance in setting the rules that govern allocations of intellectual property.

It is broadly accepted that the mark “AMERICAN MOBILPHONE” is not the legal equivalent of “AMERICAN MOBILPHONE PAGING;” the mark “CLOTHES THAT WORK. FOR THE WORK YOU DO” is not the legal equivalent of “CLOTHES THAT WORK;” and the mark “dci” is not the equivalent of “DCI.com.” There are scores of other, similar cases.

Here, however, by placing the tacking decision in the hands of the jury, the Ninth Circuit found itself powerless to disturb the conclusion that “Hana Overseas Financial Club” is the legal equivalent of “Hana World Center,” which in turn is the legal equivalent of “Hana Bank.” As the Ninth Circuit appeared to acknowledge, the same result would not be tolerated in a circuit that treats tacking as a question of law. Looking to the substantial precedent construing the limits of tacking, those courts would plainly find tacking unavailable in these circumstances. The approach taken by the Ninth Circuit thus is both plainly wrong and irreconcilable in a meaningful way with the standard applied in other circuits.

And the question presented is of broad practical importance. Trademark tacking is litigated with frequency throughout the country, and whether the doctrine sounds in fact or law is a question that necessarily arises in every case. The existing split among the circuits enables substantial gamesmanship, as the Lanham Act provides litigants significant opportunity to steer cases to particular forums.

This Court, accordingly, should grant certiorari to resolve the disagreement among the circuits and thus restore uniformity to a question of great practical significance.

**A. The Circuits Are Divided On The Question Presented.**

The disagreement among the circuits is well-recognized and persistent. The court below expressly noted that the question presented “is the subject of a circuit split.” App., *infra*, 12a n.5. Likewise, district courts observe the divide with regularity; a court recently observed that “[i]t is no secret that there is a circuit split on the issue.” *Louangel, Inc. v. Darden Rests., Inc.*, 2013 WL 1223653, at \*1 (S.D. Tex. 2013). See also *Reynolds Consumer Prods., Inc. v. Handi-Foil Corp.*, 2014 WL 794277, at \*3 (E.D. Va. 2014) (“Courts hold opposing views as to whether tacking is a question of fact or law.”); *Colonial Elec. & Plumbing Supply of Hammonton, LLC v. Colonial Elec. Supply, Ltd.*, 2007 WL 4571105, at \*10 n.15 (D.N.J. 2007) (“There is a dispute among the circuits as to whether tacking is an issue of law or fact.”). The leading treatises also note the disagreement among the circuits. 3 McCarthy § 17:26; 1-3 Gilson on Trademarks § 3.03[2][g][i]. Such inconsistency on an important matter of federal law should be intolerable.

1. *The Sixth and Federal Circuits, as well as the Trademark Trial and Appeal Board, consider trademark tacking a question of law.*

To begin with, the Federal Circuit has long held that trademark tacking presents a question of law to be resolved by a court. In *Van Dyne-Crotty*, 926 F.2d

at 1159, the Federal Circuit concluded that whether two marks “constitute legal equivalents is a legal determination.” And the Federal Circuit continues to apply that rule. See, *e.g.*, *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1347 (Fed. Cir. 2001) (“[w]hether marks are legal equivalents is a question of law”).

The Sixth Circuit likewise holds that “[w]hether a later mark is the legal equivalent of an earlier one is a question of law.” *Data Concepts*, 150 F.3d at 623. This approach stems from the court’s recognition that the underlying test is a “determination of legal equivalence.” *Ibid.*

Finally the Trademark Trial and Appeal Board (TTAB)<sup>3</sup> also holds that “[t]acking is a question of law.” *The Wet Seal, Inc. v. FD Mgmt., Inc.*, 82 U.S.P.Q.2d 1629 (T.T.A.B. 2007). See also *Eyal Balle v. Children’s Apparel Network, Ltd.*, 2012 WL 6654113, at \*3 (T.T.A.B. 2012) (“Whether one mark is the legal equivalent of the other for tacking purposes is a legal determination rather than a factual one.”).

## 2. *The Ninth Circuit holds trademark tacking a question of fact.*

The Ninth Circuit, by contrast, treats tacking as a question of fact that is resolved by the jury. In *Quiksilver, Inc. v. Kymsta Corp.*, 466 F.3d 749, 759

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<sup>3</sup> The TTAB is an administrative court in the Patent & Trademark Office that hears certain adversary proceedings regarding trademarks and serves as an appellate court for denials of trademark registrations. As we explain below (see *infra*, pages 16-19), the TTAB’s rule means that the divergent approaches taken by the courts of appeals provide substantial opportunity for forum shopping and gamesmanship.

(9th Cir. 2006), the court noted that “[w]hether tacking is an issue of law or fact is a matter of first impression in this circuit,” and it further observed that “the Federal Circuit and the Sixth Circuit \* \* \* both consider tacking a legal question for the court.” The court, however, expressly rejected those holdings. *Ibid.*

In doing so, the court looked to “the analogous consideration of likelihood of confusion”—the standard that is used to determine trademark infringement. *Quiksilver*, 466 F.3d at 759. Because the Ninth Circuit has viewed this “as a factual question,” the court concluded that “whether tacking applies should also be analyzed as a question of fact.” *Ibid.*

The Ninth Circuit has continued to apply this approach. In *One Industries*, 578 F.3d at 1160, the court noted that “[t]acking is a question of fact,” and it proceeded to analyze the case accordingly.

And, of course, the court below expressly applied that rule to resolve this case: “tacking presents a question of fact.” App., *infra*, 12a n.5. The court recognized that the relevant marks “seem aurally and visually distinguishable.” *Id.* at 15a. While this would have resolved the matter in the Sixth and Federal Circuits, as well as in the TTAB, the Ninth Circuit, viewing the matter as one of fact, considered a broad variety of other material in holding that the jury verdict could not be overturned. *Id.* at 15a-19a.

There accordingly is no prospect for resolution of this conflict absent intervention by this Court.<sup>4</sup>

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<sup>4</sup> District courts outside these three circuits have similarly divided. Some hold tacking is a question of law. See, *e.g.*, *Reynolds Consumer Prods.*, 2014 WL 794277, at \*3; *Gaffrig*

### **B. The Question Presented Is Important.**

The question presented requires resolution. It is undeniable that trademark tacking is litigated with frequency throughout the Nation. Moreover, because the Lanham Act often allows litigants to elect their forum, disparity in the approach taken to the question presented permits parties to engage in significant gamesmanship. Certiorari is warranted to restore national uniformity to litigation under the Lanham Act.

1. Trademark tacking is often litigated throughout the United States, and in every case in which it arises a court must decide, either expressly or implicitly, whether the issue is a question of fact or of law. As we have shown, the lower courts often address the question presented. See *supra*, 13 n.4.

And questions of trademark tacking have been presented in scores of other cases, too; the frequency with which the issue arises thus warrants definitive resolution of the question presented by this Court. See, e.g., *Sunstar, Inc. v. Alberto-Culver Co.*, 586 F.3d 487, 496 (7th Cir. 2009); *George & Co.*, 575 F.3d

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*Performance Indus., Inc. v. Livorsi Marine, Inc.*, 2001 WL 709483, at \*8 (N.D. Ill. 2001); *ICON Solutions, Inc. v. IKON Office Solutions, Inc.*, 1998 WL 314672 (E.D. Pa. 1998); *Advance Stores Co. v. Refinishing Specialties, Inc.*, 948 F. Supp. 643 (W.D. Ky. 1996), *aff'd*, 188 F.3d 408 (6th Cir. 1999).

Others, however, treat it as a question of fact. See, e.g., *Louangel*, 2013 WL 1223653, at \*2; *Specht v. Google Inc.*, 758 F. Supp. 2d 570, 583 (N.D. Ill. 2010); *Adventis, Inc. v. Consol. Prop. Holdings, Inc.*, 2006 WL 1134129, at \*4 (W.D. Va. 2006); *Patterson v. World Wrestling Entm't, Inc.*, 2006 WL 273527, at \*17 (E.D. Wis. 2006); *Navistar Int'l Trans. Corp. v. Freightliner Corp.*, 49 U.S.P.Q.2d 1116 (N.D. Ill. 1998).



at 402; *Fifth Ave. of Long Island Realty Assocs. v. Caruso Mgmt. Co.*, 718 F. Supp. 2d 292, 307-308 (E.D.N.Y. 2010); *Hansen Beverage Co. v. Cytosport, Inc.*, 2009 WL 5104260, at \*5 (C.D. Cal. 2009); *Miyano Mach. USA, Inc. v. MiyanoHitec Mach., Inc.*, 576 F. Supp. 2d 868, 882 (N.D. Ill. 2008); *Children's Legal Servs. PLLC v. Kresch*, 2008 WL 1901245, at \*1 (E.D. Mich. 2008), *aff'd*, 2009 WL 1868809 (6th Cir. 2009); *AB Electrolux v. Bermil Indus. Corp.*, 481 F. Supp. 2d 325, 331 n.19, 332 (S.D.N.Y. 2007); *Colonial Elec. & Plumbing Supply*, 2007 WL 4571105, at \*9; *Patterson v. World Wrestling Entm't, Inc.*, 2006 WL 273527, at \*18 (E.D. Wis. 2006).

In addition to litigation in district courts, trademark tacking is frequently at issue in the Trademark Trial and Appeal Board. See, e.g., *Wolverine Outdoors, Inc. v. Marker Volkl (Int'l) GMBH*, 2013 WL 5655832, at \*10 (T.T.A.B. 2013); *Eyal Balle*, 2012 WL 6654113; *Mfrs. Tech. Insts., Inc. v. Pinnacle Coll., LLC*, 2011 WL 4871873, at \*2 (T.T.A.B. 2011); *Cake Divas v. Jones*, 2011 WL 810224, at \*6 (T.T.A.B. 2011); *Anthony's Pizza & Pasta Int'l, Inc. v. Anthony's Pizza Holding Co.*, 95 U.S.P.Q.2d 1271 (T.T.A.B. 2009), *aff'd*, 415 F. App'x 222 (Fed. Cir. 2010) (*per curiam*); *Univ. of Southern Carolina v. Univ. of South Carolina*, 2008 WL 3333839, at \*26 (T.T.A.B. 2008), *aff'd*, 367 F. App'x 129 (Fed. Cir. 2010); *Prairie Island Indian Cmty. v. Treasure Island Corp.*, 2008 WL 2385969 (T.T.A.B. 2008); *Target Brands, Inc. v. Gottlieb*, 2008 WL 2385978 (T.T.A.B. 2008); *Tantra One LLC v. Titas Inc.*, 2008 WL 1963600 (T.T.A.B. 2008); *Wrangler Apparel Corp. v. Quicksilver, Inc.*, 2008 WL 853836 (T.T.A.B. 2008); *Innovative Fitness Consultants Inc. v. Rickett*, 2007 WL 2344670 (T.T.A.B. 2007); *The Wet Seal*, 82 U.S.P.Q.2d 1629;

*Diners Club Int'l Ltd. v. Rosenbluth Int'l, Inc.*, 2004 WL 2619571 (T.T.A.B. 2004).

The frequent recurrence of trademark tacking litigation thus justifies this Court's intervention. That is particularly so because, so far as we are aware, this Court has never addressed the tacking doctrine. This case provides a vehicle for the Court to squarely resolve the question presented, and in so doing to provide significant guidance to the lower courts as to the contours of trademark tacking doctrine.

2. Not only is the question presented one of frequent occurrence, but the disagreement among the circuits permits substantial opportunity for gamesmanship in Lanham Act litigation. Resolving this case will eliminate the ability of parties to exploit differing approaches to this question for tactical advantage.

*First*, the disagreement between the circuits enables forum shopping. The venue provision of 28 U.S.C. § 1391, which controls trademark disputes under the Lanham Act, is broadly permissive. Courts often view the reach of allowable venue in a trademark dispute as coextensive with personal jurisdiction over the defendant. See, *e.g.*, *Telebrands Corp. v. martFIVE, LLC*, 2013 WL 4675558 (D.N.J. 2013).

A party that has a weak argument for tacking will typically prefer a forum that treats the issue as a question of fact. As this case illustrates, when trademark tacking is submitted to a jury, a weak case—one that no court would approve as a matter of law—may nonetheless prove successful. And, if it is considered a question of fact, that decision will be difficult to reverse on appeal. The split in the cir-

cuits, accordingly, permits parties to choose forum for tactical advantage.

*Second*, the existence of this circuit split enables additional, significant opportunity for gamesmanship given the intersection between administrative remedies before the Patent and Trademark Office (PTO) and federal court litigation.

The PTO registers marks for protection under the Lanham Act. If the PTO determines that a mark is entitled to registration, a third party may bring an “opposition” proceeding to challenge the registration before it issues. 15 U.S.C. § 1063. Alternatively, after a mark has been registered, a third party may pursue a “cancellation” action. *Id.* § 1064. Both kinds of proceeding are heard by the TTAB. See Trademark Trial and Appeal Board Manual of Procedure § 102.02 (3d ed. 2013). Additionally, the TTAB has jurisdiction over *ex parte* appeals involving the PTO’s denial of an application to register a mark. *Ibid.*

But a proceeding before the TTAB is not the exclusive mechanism for a party to challenge the validity of a mark; a party may alternatively seek relief in district court. Under 15 U.S.C. § 1119, “district courts have concurrent jurisdiction with the United States Patent and Trademark Office to order the cancellation of federal trademark registrations.” *Monster Daddy, LLC v. Monster Cable Prods., Inc.*, 2013 WL 5467854, at \*13 (D.S.C. 2013).

A cancellation claim, accordingly, often may be pursued in either the TTAB or district court. See *Ditri v. Coldwell Banker Residential Affiliates, Inc.*, 954 F.2d 869, 873 (3d Cir. 1992). Litigants may thus exploit for tactical advantage the different approaches taken to the question presented: If a litigant initi-

ates an opposition or a cancellation proceeding in the TTAB, tacking will be adjudicated as a matter of law (see *supra*, page 12); a cancellation claim (or counterclaim) brought in some district courts (including every court in the Ninth Circuit) will, by contrast, be submitted to a jury as a question of fact. The disagreement as to the question presented, accordingly, presents substantial opportunity to manipulate outcomes by strategic choice of forum.

And there is yet an additional mechanism by which parties may use the circuit split to game the system: a losing party before a TTAB proceeding may appeal to *either* the Federal Circuit *or* a district court. See 15 U.S.C. § 1071(a) (permitting appeal of TTAB decision to the Federal Circuit); *id.* § 1071(b) (permitting appeal of TTAB decision to a district court). If an aggrieved party elects to pursue an appeal in the Federal Circuit, an adverse party may nonetheless require the appeal to be brought in a district court. *Id.* § 1071(a)(1). In short, an appeal may proceed in the Federal Circuit only by “mutual consent.” 3 McCarthy on Trademarks and Unfair Competition § 21:20 (4th ed. 2014).

The possibility for gamesmanship, given the persisting circuit split, is manifest. The TTAB’s decision is subject to review pursuant to the standards of the Administrative Procedure Act: questions of law are reviewed *de novo*, while questions of fact are subject to substantial evidence review. See *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1085 (Fed. Cir. 2000); *ZAO Odessky Konjatschnyi Zawod v. SIA Baltmark Invest*, 2013 WL 5945677, at \*4 (E.D. Va.

2013); 3 McCarthy on Trademarks and Unfair Competition § 21:21 (4th ed. 2014).<sup>5</sup>

Thus, if an appeal is taken to the Federal Circuit, the question of trademark tacking is a question of law subject to *de novo* review and “is not entitled to the same deference as a factual finding on review.” *Van Dyne-Crotty*, 926 F.2d at 1159. So, too, if an appeal is taken to a district court (such as any court in the Sixth Circuit) that views the question as one of law.<sup>6</sup> If, however, an appeal is pursued in a district court that views this as a factual question (such as any court in the Ninth Circuit), the TTAB’s decision with respect to tacking will merit considerable deference.

Whether or not a party seeks affirmance or reversal of the TTAB’s tacking decision will, accordingly, significantly affect where it seeks judicial review. Resolving the question presented here will eliminate this kind of forum shopping.

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<sup>5</sup> The issue is yet more complicated insofar as some courts hold that, in reviewing a TTAB’s factual determinations, a party may have a right to a jury trial in the district court. See *Material Supply Int’l, Inc. v. Sunmatch Indus. Co.*, 146 F.3d 983, 988 (D.C. Cir. 1998). If, as we contend, tacking is a question of law, that would obviate any jury requirement in these circumstances.

<sup>6</sup> Regional circuit law, not law of the Federal Circuit, controls proceedings in a district court under Section 1071(b). See *Swatch, S.A. v. Beehive Wholesale, L.L.C.*, 888 F. Supp. 2d 738, 745 n.4 (E.D. Va. 2012), *aff’d*, 739 F.3d 150 (4th Cir. 2014); 4A Callmann on Unfair Competition, Trademarks and Monopolies § 26:100 (4th ed. 2012).

### C. The Decision Below Is Wrong.

A clear division of authority among the courts of appeals with respect to a frequently recurring question is reason enough to warrant a grant of certiorari. But the need for review is particularly acute here because the result reached below is incorrect.

Trademark tacking inherently requires application of a legal test, making it a matter for a court—not the jury—to resolve. As this case demonstrates, this is not a semantic distinction: when trademark tacking is viewed as a question of fact, the practical dynamics of submitting the issue to the jury will make the doctrine grow enormously in breadth. A jury permitted tacking in this case, but it is most unlikely that the same result would be reached in a circuit that views trademark tacking as a question of law. Certiorari is thus necessary to establish a sound and nationally uniform tacking rule.

1. Whether a party may tack the use of an earlier mark to a later one for purposes of determining the priority date is, ultimately, a question of law. The issue, accordingly, must be resolved by a court, not a jury. To be sure, as is often the case, “the issue falls somewhere between a pristine legal standard and a simple historical fact.” *Miller v. Fenton*, 474 U.S. 104, 114 (1985). In such circumstances, “the fact/law distinction at times has turned on a determination that, as a matter of the sound administration of justice, one judicial actor is better positioned than another to decide the issue in question” (*ibid.*) and “functional considerations” become paramount. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 388 (1996). For several reasons, these considerations compel the conclusion that tacking is an issue for the judge.

*First*, the trademark tacking inquiry—itsself a common law doctrine—is necessarily dependent on the development of precedent. There can be no dispute that the ultimate inquiry for tacking is whether the two marks are “legal equivalent[s].” *Van Dyne-Crotty*, 926 F.2d at 1159 (Fed. Cir.). Following the Federal Circuit, three other circuits, including the court below, have adopted this standard. See App., *infra*, 12a (quoting *Brookfield*, 174 F.3d at 1047-1048); *George & Co.*, 575 F.3d at 402 (4th Cir.); *Data Concepts*, 150 F.3d at 623 (6th Cir.). At bottom, “tacking will be allowed only if the marks are virtually identical.” *One Indus.*, 578 F.3d at 1161. In making this inquiry, subsequent cases draw analogies from prior decisions, creating a robust body of law that lends predictability to these intellectual property interests. This is thus a situation where “the content of the rule \* \* \* is given meaning through the evolutionary process of common-law adjudication.” *Bose Corp. v. Consumers Union of U.S., Inc.*, 466 U.S. 485, 502 (1984).

If, however, tacking is viewed as a question of *fact*, then predictability—essential in intellectual property markets—is wholly gutted. Parties will be deprived of the binding guidance of precedent, left to the unpredictability of a jury’s case-by-case determination. Cf. *Ornelas v. United States*, 517 U.S. 690, 697 (1996) (“Such varied results would be inconsistent with the idea of a unitary system of law. This, if a matter-of-course, would be unacceptable.”). In this way, the “stakes” with respect to the “impact on future cases and future conduct” “are too great to entrust \* \* \* finally to the judgment of the trier of fact.” *Bose Corp.*, 466 U.S. at 501 n.17. Because tacking is often determinative of a trademark right, as it is here, the question is one of law.

Treating tacking as a question of law also furthers nationwide uniformity in trademarks. This was a substantial consideration in *Markman*, which held that claim construction in patent cases is a duty of the judge—“we see the importance of uniformity in the treatment of a given patent as an independent reason to allocate all issues of construction to the court.” 517 U.S. at 390. Those concerns also are implicated here; by considering tacking a question of law, courts ensure uniform interpretation of the same trademark, not subject to the whims of varying juries. Cf. *Salve Regina Coll. v. Russell*, 499 U.S. 225, 234 (1991).

*Second*, the test itself—whether two marks are “legal equivalents”—is inherently a legal determination. There is generally no question of historical fact at issue. This standard thus “crosses” “into the realm of a legal rule upon which the reviewing court must exercise its own independent judgment.” *Bose Corp.*, 466 U.S. at 501 n.17.

*Third*, comparing the relative similarities between marks for purposes of tacking has historically been a judicial function. See, e.g., *Ilco Corp. v. Ideal Sec. Hardware Corp.*, 527 F.2d 1221, 1224 (C.C.P.A. 1976); *Humble Oil & Ref. Co. v. Sekisui Chem. Co.*, 1970 WL 9925 (T.T.A.B. 1970). There is thus a “common-law heritage” that “assigns an especially broad role to the judge in applying” the tacking rule “to specific factual situations.” *Bose Corp.*, 466 U.S. at 502. This is “one of those things that judges often do and are likely to do better than jurors.” *Markman*, 517 U.S. at 388. Both the historical practice and functional expertise strongly support characterizing this issue as one of law for a judge. *Id.* at 388-390.



2. This case itself demonstrates why assigning the tacking decision to judges for them to make as a matter of law, subject to close appellate review, is the sounder approach. Here, viewing the issue as one of fact, the jury accepted respondents' theory, which tacks the mark "Hana Overseas Korean Club" to "Hana World Center," and then tacking "Hana World Center" to "Hana Bank." App., *infra*, 15a. Although the Ninth Circuit showed clear discomfort with this conclusion, it applied the deferential standard of review that applies to jury determinations of fact and believed itself unable to set aside the verdict, even though it recognized that "other courts, which consider tacking a question of law, might reach a different conclusion on these facts." *Id.* at 20a.

And in that respect, at least, the decision below was correct: the court expressly noted that the marks at issue here "seem aurally and visually distinguishable." App., *infra*, at 15a. In courts that view this a question of law, however, "no more [is] necessary" to reject a tacking theory. *Van Dyne-Crotty*, 926 F.2d at 1159. *See also The Wet Seal*, 82 U.S.P.Q.2d 1629 ("No evidence need be entertained other than the visual or aural appearance of the marks themselves.") (quotation omitted).

Indeed, a comparison to the circumstances where courts, viewing the question as one of law, have *rejected* tacking demonstrates that neither step in respondents' two-part tacking theory is sustainable under the proper standard. Courts, for example, have held:

- "AMERICAN MOBILPHONE" is not the legal equivalent of "AMERICAN MOBILE PHONE PAGING." *Am. Mobilphone*, 1990 WL 177458, at \*1-2.

- “CLOTHES THAT WORK. FOR THE WORK YOU DO” is not the legal equivalent of “CLOTHES THAT WORK.” *Van Dyne-Crotty*, 926 F.2d at 1158-1159.
- “dci” is not the legal equivalent of “DCI.com.” *Data Concepts*, 150 F.3d at 623-624.

In each of these cases, the court concluded that the subsequent mark differed too greatly from the prior mark for them to qualify as “legal equivalents,” and thus to permit tacking from one mark to the other.

The differences between the marks at issue here are far greater, and thus the case for tacking is far weaker. Although respondents’ three marks each contain the term “Hana,” the marks “Hana Overseas Korean Club,” “Hana World Center,” and “Hana Bank” differ enormously. Only the last mark, “Hana Bank” even indicates that the mark relates to the provision of financial services.

If trademark tacking were treated as a legal issue—decided by courts on the basis of precedent—the result here thus would have been different at either the trial or appellate level. Accordingly, the court should grant certiorari and hold that trademark tacking is a question of law.<sup>7</sup>

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<sup>7</sup> Although the district court also rejected HFI’s infringement claim on grounds of laches and unclean hands (App., *infra*, 9a), the court below expressly declined to reach these issues, resting its holding solely on the question of trademark tacking. *Id.* at 19a. Moreover, the tacking issue has independent significance, as that holding determines whether HFI may prospectively seek a protected interest in its “Hana Financial” mark. This is why HFI requested—and Ninth Circuit agreed—to resolve the issue of trademark tacking first. *Id.* at 20a n.11. In any event, as HFI explained below,

**CONCLUSION**

The petition for a writ of certiorari should be granted.

Respectfully submitted.

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there are substantial reasons to think that the district court's decision with respect to laches and unclean hands is incorrect, which is an issue to be addressed on remand. 9th Cir. Dkt. No. 9, at 19-27.

## **APPENDICES**