

15.14 Infringement—Elements—Ownership—Priority Through Tacking

Rights in a trademark are determined by the date of the mark's first use in commerce. The party who first uses a mark in commerce is said to have priority over other users, and the [plaintiff [name]] [defendant [name]] asserts that [his] [her] [other pronoun] mark has priority through the doctrine of “tacking.” Tacking recognizes that trademark users ought to be permitted to make certain modifications to their marks over time without losing priority.

Tacking is available when the original and revised marks are “legal equivalents” in that they create the same, continuing commercial impression without material differences between them so that consumers would consider them the same mark. In other words, viewing the marks in context and in their entirety, an ordinary purchaser could perceive them as conveying the same idea or meaning.

Comment

The standard for tacking is exceedingly strict and applies only in “exceptionally narrow” circumstances. *Hana Fin., Inc. v. Hana Bank*, 735 F.3d 1158, 1164 (9th Cir. 2013), *aff'd*, 574 U.S. 418 (2015). A trademark user may tack the date of the user's first use of an earlier mark onto a subsequent mark only when “two marks are so similar that consumers generally would regard them as essentially the same.” *Id.* (quoting *Brookfield Commc'ns, Inc. v. W. Coast Ent. Corp.*, 174 F.3d 1036, 1048 (9th Cir. 1999)). The standard for tacking is considerably higher than the standard for likelihood of confusion. *Id.* at 1164-65. For examples of types of marks that have been properly and improperly tacked, see 3 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* §§ 17:26-28 (5th ed. 2019).

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