

ARTICLE

THE TROUBLE WITH TACKING: A RECONSIDERATION OF TRADEMARK PRIORITY

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ABSTRACT

When trademarks cannot co-exist because they are confusingly similar, priority generally depends upon first use. However, through the practice known as “tacking,” the junior user can sometimes prevail based on its earlier adoption of a similar, but technically distinct trademark. The Supreme Court recently determined that tacking is a question of fact to be resolved by a jury, under the guidance of “careful jury instructions that make [the] standard clear.” Courts say the standard for tacking is “exceedingly strict,” and that tacking is allowed only when the earlier mark and the revised mark are so similar that they convey the “same commercial impression,” and consumers would regard both as “the same mark.” In practice, this standard is not “clear,” nor is it rooted in sound policy justifications. In fact, it could often hamper competition, deny consumers useful information, and lead to the very sorts of confusion that the trademark laws are intended to prevent. This Article proposes, as an alternative, a standard for tacking based on a comparison of the original and the revised trademarks to the intervening mark, the question being whether the changes did or did not contribute to the potential for confusion.

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I. INTRODUCTION

Generally speaking, when competing parties adopt the same or confusingly similar trademarks, the rights of the first party to use its mark in commerce are superior to those of the latecomer.¹ But in rare instances a party claiming seniority may rely on its earlier use of a similar trademark that is “technically distinct.”² When this is permitted, the party is said to “tack on” the period when it used the earlier mark, thereby establishing priority over the competing mark.³ For example, if A and B both use the mark AMERICAN

1. *Hana Fin., Inc. v. Hana Bank*, 135 S. Ct. 907, 909 (2015) (“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.”).

2. *Brookfield Commc’ns, Inc. v. W. Coast Entm’t Corp.*, 174 F.3d 1036, 1047 (9th Cir. 1999).

3. *See The Wet Seal, Inc. v. FD Mgmt., Inc.*, 82 U.S.P.Q.2d (BNA) 1629, 1635 (T.T.A.B. 2007) (using the “tack on” terminology). In *Hana*, the Supreme Court characterized tacking as “cloth[ing] a new mark with the priority position of an older mark.” *Hana*, 135 S. Ct. at 909.

SECURITY BANK,⁴ and B was first to use that mark in commerce, A might still prevail as the senior user, with the power to prevent B's use, if A had earlier used the words AMERICAN SECURITY alone.⁵ "Tacking" requires that the earlier and later versions of the senior party's mark be very similar.⁶

In 2015, the Supreme Court, resolving a circuit split, held that whether the earlier and later versions of a mark are similar enough to permit tacking is a question of fact "fall[ing] comfortably within the ken of a jury."⁷ This is so because the standard, which neither party questioned,⁸ is whether the earlier and later versions of the mark convey the "same, continuing commercial impression," such that consumers would consider them "the same mark."⁹ These are matters to be regarded "through the eyes of a consumer."¹⁰ Should anyone worry that a jury might apply the standard incorrectly, "the solution is to craft careful jury instructions that make that standard clear."¹¹

The time is ripe, therefore, to consider whether the prevailing tacking standard is sufficient to form the basis of those clear jury instructions and, more fundamentally, whether that standard actually achieves results consistent with sound trademark policy. The "commercial impression" and "same mark" language leaves room for ambiguity. If the standard is often not difficult to apply, that is only because courts tell us that it is to be so *rarely* applied. Courts have described tacking, almost universally, as subject to an "exceedingly strict" standard,¹² and tolerated only in "rare instances."¹³ Oddly, while tacking itself has been explained in

4. This Article adopts the convention of printing word marks and portions of word marks in all capital letters.

5. The source of this example is *Am. Sec. Bank v. Am. Sec. & Tr. Co.*, 571 F.2d 564, 567 (C.C.P.A. 1978), a case where tacking was permitted.

6. *Hana*, 135 S. Ct. at 910 ("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.")

7. *Id.* at 910–11.

8. *Id.* at 910 n.1.

9. *Id.* at 910 (quoting *Van Dyne-Crotty, Inc. v. Wear-Guard Corp.*, 926 F.2d 1156, 1159 (Fed. Cir. 1991)).

10. *Id.* (quoting *DuoProSS Meditech Corp. v. Enviro Med. Devices, Ltd.*, 695 F.3d 1247, 1253 (Fed. Cir. 2012)); *see also* 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 17:26 (4th ed. 2016) ("[L]ike most issues in trademark law, whether the same commercial impression is maintained is a question of fact to be determined from the perspective of the ordinary purchaser.")

11. *Hana*, 135 S. Ct. at 911–12.

12. *See, e.g.*, *Quicksilver, Inc. v. Kymsta Corp.*, 466 F.3d 749, 758 (9th Cir. 2006); *Brookfield Commc'ns, Inc. v. W. Coast Entm't Corp.*, 174 F.3d 1036, 1048–49 (9th Cir. 1999).

13. *See, e.g.*, *Van Dyne-Crotty*, 926 F.2d at 1160, *abrogated by Hana*, 135 S. Ct. 907.

terms of the interests of both trademark owners and consumers,¹⁴ the guiding principle of rarity has not been justified except by reliance on precedent. In fact, the strict standard currently applied may operate against the interests of both trademark owners and consumers.

A standard for tacking based on good trademark policy might look significantly different. This Article proposes that where two trademark owners are competing for priority, a jury should not simply compare the earlier and later versions of the altered mark to determine if the differences affect the commercial impression they convey. Instead, the jury should examine the alterations *in the context of the competing mark* to see if they did or did not contribute to any likelihood of confusion. In comparison to the current approach to tacking, this approach would give trademark owners more freedom to conform their trademark identities to the demands of the marketplace, allow trademark owners to supply additional and more accurate information to consumers through their trademarks, and minimize the potential for consumer confusion—the latter being the primary goal of trademark law in general.¹⁵

Part II of this Article describes the concept of tacking. It discusses instances in which trademark owners have altered their marks by additions, subtractions, or substitutions—sometimes in a manner subtle enough to permit tacking, but more often in ways that disrupt the continuity of the mark. Part II also discusses the variety of contexts in which courts have applied the tacking standard. Part III examines the exceedingly strict requirements of tacking based on a “continuing commercial impression.” It considers both the ambiguities latent in the prevailing standard and the absence of convincing policy justifications. Part IV suggests that tacking should be re-imagined when applied in the context of competing marks. Rather than simply comparing the earlier and revised versions of the altered mark, the fact-finder should determine whether the changes contributed to the potential for confusion. This approach would give trademark owners more freedom to update their brand identities, while providing consumers with better information and a marketplace less prone to confusion.

14. See *Quicksilver*, 466 F.3d at 758; *George & Co. LLC v. Imagination Entm’t Ltd.*, 575 F.3d 383, 392–93 (4th Cir. 2009).

15. See *E.S.S. Entm’t 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1100 (9th Cir. 2008) (referring to “the purpose of trademark law” as “to ‘avoid confusion in the marketplace by allowing a trademark owner to prevent others from duping consumers into buying a product they mistakenly believe is sponsored by the trademark owner’” (citation omitted)).

II. TACKING TRADEMARKS TO ESTABLISH PRIORITY

A. *Background*

A trademark is “any word, name, symbol, or device” used to identify the brand origin of goods and to distinguish them from the goods of others.¹⁶ A word or phrase (like NIKE or JUST DO IT) may serve as a trademark if it is not generic or merely descriptive.¹⁷ Designs and graphics (like Nike’s check-mark-resembling “swoosh” symbol) also qualify as trademarks if they indicate brand origin.¹⁸ Even the design of a product can serve as a trademark, if the design is non-functional and has acquired meaning as an indicator of source.¹⁹ Trademarks supply consumers with information about the origin of the goods and, often, their quality as well.²⁰

16. 15 U.S.C. § 1127 (2012). Technically, trademarks and service marks are distinct. Trademarks identify the origin of goods; service marks identify the origin of services. *See* *Chance v. Pac-Tel Teletrac Inc.*, 242 F.3d 1151, 1156 (9th Cir. 2001). For most purposes, and for the purposes of this Article, service marks may be treated as simply a species of trademark. *See id.* (“Service marks and trademarks are governed by identical standards.”).

17. Trademarks are categorized by their place on a spectrum of distinctiveness. *See* *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768–69 (1992); *Bos. Duck Tours, LP v. Super Duck Tours, LLC*, 531 F.3d 1, 12–14 (1st Cir. 2008); *Miller Brewing Co. v. G. Heileman Brewing Co.*, 561 F.2d 75, 79 (7th Cir. 1977). The strongest trademarks are fanciful (terms invented specifically to serve as trademarks, like KODAK), or arbitrary (terms not associated with the goods except as an indication of brand origin, like PENGUIN books). *See* 2 MCCARTHY, *supra* note 10, §§ 11:5, 11:11; *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 210–11 (2000) (providing examples of fanciful and arbitrary marks); *Miller*, 561 F.2d at 79 (“An arbitrary or fanciful term . . . is far enough removed from the merely descriptive not to be vulnerable to possible attack as being merely descriptive rather than suggestive.”). Suggestive marks refer indirectly to the qualities of the goods but require some imagination to make the connection (e.g., COPPERTONE sun tan lotion). *George*, 575 F.3d at 394. Fanciful, arbitrary and suggestive marks are all “inherently distinctive,” meaning that no evidence is required to establish that they indicate brand origin rather than other qualities of the goods with which they are associated. *Two Pesos*, 505 U.S. at 771; *Duraco Prods. v. Joy Plastic Enters.*, 40 F.3d 1431, 1440 (3d Cir. 1994). Descriptive marks (like CHUNKY SOUP) more literally reflect the qualities of the goods themselves. These can be reserved as trademarks only with evidence of “secondary meaning”—evidence, that is, that consumers have come to understand, through advertising or otherwise, that the terms are primarily indicators of brand origin. *See* 15 U.S.C. § 1052 (e)–(f); *Leelanau Wine Cellars v. Black & Red*, 502 F.3d 504, 513 (6th Cir. 2007). Generic terms refer to certain categories of goods (like “light beer”) and cannot be reserved as trademarks at all. *See Miller*, 561 F.2d at 79–80; *Genesee Brewing Co. v. Stroh Brewing Co.*, 124 F.3d 137, 143 (2d Cir. 1997). Although these categories have important legal consequences, their boundaries cannot be drawn with certainty. They “tend to blur at the edges and merge together.” *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 790 (5th Cir. 1983).

18. 1 MCCARTHY, *supra* note 10, § 7:24 (“Any picture, design or symbol may be capable of playing the role of a trademark . . .”). McCarthy uses the Chevrolet “bowtie” graphic as an example of a well-known design trademark. *Id.* § 7:25.

19. *See Wal-Mart*, 529 U.S. at 211–12, 216.

20. *See George*, 575 F.3d at 392 (“A trademark puts the purchasing public on notice

The owner of a trademark can prevent the use of a similar mark where such use is likely to cause confusion among consumers.²¹ Determining whether confusion is likely depends on consideration of a number of factors.²² Typically these include: (1) the strength and distinctiveness of the plaintiff's mark;²³ (2) the similarity of the marks in sight, sound and meaning;²⁴ (3) the similarity of the plaintiff's and defendant's goods; (4) any evidence of actual confusion, whether anecdotal or produced through consumer surveys;²⁵ (5) the defendant's intent; (6) the similarity of the trade channels through which the plaintiff's and defendant's goods are advertised and sold; and (7) the sophistication and attentiveness of the consumer.²⁶ In a particular case, some factors may be more important than others.²⁷

The avoidance of confusion protects consumers who might otherwise purchase unwanted goods, or who at the very least would be required to invest more time and resources to identify the goods they desire.²⁸ The avoidance of confusion also protects trademark owners, ensuring that their investments in good will

that all goods bearing the trademark: (1) originated from the same source; and (2) are of equal quality.”).

21. 15 U.S.C. § 1114(1)(a); *George*, 575 F.3d at 393.

22. For lists of some of the factors commonly considered, see, e.g., *Tana v. Dantanna's*, 611 F.3d 767, 774–75 (11th Cir. 2010); *George*, 575 F.3d at 393; *Kos Pharms., Inc. v. Andrx Corp.*, 369 F.3d 700, 709 (3d Cir. 2004); *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348–49 (9th Cir. 1979).

23. This depends both on the kind of mark at issue, *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992), and the fame and uniqueness of the trademark in the marketplace. See *Fisons Horticulture, Inc. v. Vigoro Indus., Inc.*, 30 F.3d 466, 479 (3d Cir. 1994) (“Distinctiveness on the scale of trademarks is one measure of a mark's strength. . . . Commercial strength, or marketplace recognition of the mark, is another.”). For further discussion of different types of marks, see note 17 *supra*.

24. See *Vail Assocs. v. Vend-Tel-Co., Ltd.*, 516 F.3d 853, 869 (10th Cir. 2008) (“The degree of similarity between marks turns upon sight, sound, and meaning.”).

25. In appropriate cases, the absence of any evidence of actual confusion may provide grounds for concluding that no confusion is likely to occur. See *Libman Co. v. Vining Indus., Inc.*, 69 F.3d 1360, 1363–64 (7th Cir. 1995).

26. Sophisticated consumers are supposed to detect more subtle differences between rival marks. See *Centaur Commc'ns, Ltd. v. A/S/M Commc'ns, Inc.*, 830 F.2d 1217, 1228 (2d Cir. 1987) (“Sophistication of consumers usually militates against a finding of a likelihood of confusion . . .”). Moreover, a consumer who is spending a large amount of money is more likely to be alert to minor differences than a consumer who is spending a small amount of money on an impulse purchase. See *Sally Beauty Co. v. Beautyco, Inc.*, 304 F.3d 964, 975 (10th Cir. 2002).

27. See *George*, 575 F.3d at 393.

28. See *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 163–64 (1995) (“In principle, trademark law, by preventing others from copying a source identifying mark, ‘reduce[s] the customer's costs of shopping and making purchasing decisions,’ for it quickly and easily assures a potential customer that this item—the item with this mark—is made by the same producer as other similarly marked items that he or she liked (or disliked) in the past.” (internal citation omitted) (quoting 1 MCCARTHY, *supra* note 10, § 2:3).

and brand identity will be returned in the form of purchases.²⁹ This too helps consumers, indirectly. If, because of trademark confusion, consumers pleased with their purchases would be uncertain whom to reward with future business, trademark owners would have less incentive to produce goods of high quality.³⁰

The Trademark Act, also known as the Lanham Act, provides causes of action for the infringement of registered and unregistered trademarks.³¹ In either case, the owner's rights stem from the use of the trademark in commerce to identify the source of the owner's goods.³² The rights continue as long as the use continues.³³ If the owner stops using the mark, with no intent to resume use in the foreseeable future, the mark may be abandoned.³⁴ A mark that has been abandoned "returns to the public domain," and may be freely adopted by others to identify the source of their goods.³⁵

In most respects, "[r]ights in a trademark are determined by the date of the mark's first use in commerce," and the party who can claim first use has "priority over other users."³⁶ A mark may be refused registration if it is the same or confusingly similar to a mark already in use,³⁷ and a registration may be cancelled on the same basis.³⁸ A defense available to a party accused of infringement is that it was actually the first to use the mark in commerce.³⁹ The priority of the first user has been called a "cardinal principle" of trademark law.⁴⁰ Nevertheless, under

29. *See id.* at 164 ("[T]he law helps assure a producer that it (and not an imitating competitor) will reap the financial, reputation-related rewards associated with a desirable product.").

30. *See id.* at 163–64.

31. 15 U.S.C. §§ 1114, 1125(a) (2012). Registration serves as prima facie evidence of the validity of the mark and of the right of the registrant to its exclusive use. 15 U.S.C. §§ 1057(b), 1115(a); *Brookfield Commc'ns, Inc. v. W. Coast Entm't Corp.*, 174 F.3d 1036, 1047 (9th Cir. 1999).

32. *ITC Ltd. v. Punchgini, Inc.*, 482 F.3d 135, 146–47 (2d Cir. 2005).

33. *Id.* at 147.

34. *See* 15 U.S.C. § 1127 (defining "abandoned"); *Silverman v. CBS, Inc.*, 870 F.2d 40, 46–47 (2d Cir. 1989).

35. *George & Co. LLC v. Imagination Entm't Ltd.*, 575 F.3d 383, 400 (4th Cir. 2009).

36. *Hana Fin., Inc. v. Hana Bank*, 135 S. Ct. 907, 909 (2015); *see also* *Quicksilver, Inc. v. Kymsta Corp.*, 466 F.3d 749, 756 (9th Cir. 2006) ("Trademark rights are acquired by the party that first uses a mark in connection with the sale of goods."); *Zasu Designs v. L'Oreal S.A.*, 979 F.2d 499, 503 (7th Cir. 1992) (referring to the "race to the marketplace to establish the exclusive right to a mark").

37. 15 U.S.C. § 1052(d).

38. 15 U.S.C. § 1064.

39. *See Haggar Int'l Corp. v. United Co. for Food Indus. Corp.*, 906 F. Supp. 2d 96, 130 (E.D.N.Y. 2012) (discussing the "prior use defense"); 15 U.S.C. § 1115(b)(5)–(6).

40. *One Indus., LLC v. Jim O'Neal Distrib., Inc.*, 578 F.3d 1154, 1158 (9th Cir. 2009);

limited circumstances, someone who first used a trademark different than the one currently in use may invoke the principle of tacking to claim the rights of a senior user.

As early as 1900, the Supreme Court endorsed the principle that rights in a trademark may go beyond the precise form in which it has been used and registered. In *Saxlehner v. Eisner & Mendelson Co.*,⁴¹ the plaintiff had registered the name “Hunyadi Janos” for bottled water which, according to the defendant, waived its rights to the term “Hunyadi” alone.⁴² The court held that the plaintiff’s rights were not limited by the prior registration, and also that infringement did not depend on the appropriation of every word of the registered mark.⁴³ “It is sufficient,” the court said, “that enough be taken to deceive the public in the purchase of a protected article.”⁴⁴ Because the “principle word” of the mark was “Hunyadi,” others were not free to use that portion of the mark under circumstances that would lead to confusion.⁴⁵

If a portion of a mark (like “Hunyadi” alone) may itself have significance as an indicator of brand origin, then continued use of that portion may justify uninterrupted trademark rights, even where other aspects of the mark have changed. In *Beech-Nut Packing Co. v. P. Lorillard Co.*,⁴⁶ another case of the early 20th century, the court found that Lorillard had not lost its status as the senior user of the mark BEECHNUT for tobacco, even though the graphic elements that accompanied the term on the product label had been replaced.⁴⁷ Lorillard had altered the formula, and that “justified a change in the decorative features of the package.”⁴⁸ The court observed that packaging for tobacco in general had “undergone many improvements,” and that depriving a trademark owner of the freedom to “redecorate or reornament, or, to use a somewhat inelegant phrase, polish it up would be . . . unreasonable.”⁴⁹

see also *Brookfield Comm’ns, Inc. v. W. Coast Entm’t Corp.*, 174 F.3d 1036, 1047 (9th Cir. 1999) (referring to the rights of the first user as a “fundamental tenet of trademark law”); *Sengoku Works Ltd. v. RMC Int’l, Ltd.*, 96 F.3d 1217, 1219 (9th Cir. 1996) (“It is axiomatic in trademark law that the standard test of ownership is priority of use.”).

41. *Saxlehner v. Eisner & Mendelson Co.*, 179 U.S. 19 (1900).

42. *Id.* at 32.

43. *Id.* at 32–33.

44. *Id.* at 33.

45. *Id.* at 32–33.

46. *Beech-Nut Packing Co. v. P. Lorillard Co.*, 299 F. 834 (D.N.J. 1924).

47. *Id.* at 851.

48. *Id.* at 850.

49. *Id.*

B. Distinguishing Trademarks from Their Display

The *Beech-Nut* situation may be an easy case. If the graphics, consisting of a squirrel and other design elements, were simply decorative, then they may have had no trademark significance in the first place.⁵⁰ If they did have such significance—perhaps customers recognized the squirrel as an indicator of the Lorillard product rather than the tobacco of a competitor—one could still regard the word “Beechnut” and the graphics as separate trademarks, much like the word “Nike” and the “swoosh” symbol that often accompanies it. Moreover, courts have often determined that word marks—like BEECHNUT—have meaning that transcends any particular manner in which they are shown.⁵¹ Accordingly, a trademark owner “may change the display of a [word] mark at any time because whatever rights he may possess in the mark reside in the term itself rather than in any particular form or arrangement thereof.”⁵²

A recent example can be found in *Paris Glove of Canada, Ltd. v. SBC/Sporto Corp.*,⁵³ where a “rectangular” version of the mark AQUA STOP for rain boots (one word printed above the other) had been replaced by a “semicircular” version (both words together and arranged on a curve, as though hugging the upper portion of a circle).⁵⁴ The Trademark Trial and Appeal Board observed that “[m]arks entirely comprised of words can sometimes be varied as to their style of lettering, size and other elements of form without resulting in a material alteration of the mark.”⁵⁵ In this case, the

50. See 1 MCCARTHY, *supra* note 10, § 7:24 (“[I]f a design is *solely* or *merely* ornamental and does not also identify and distinguish source, then it cannot be given the status of a valid trademark.”).

51. See *Drexel Enters., Inc. v. Richardson*, 312 F.2d 525, 527 (10th Cir. 1962) (explaining that a change from slanted script to block letters was immaterial because “[a] mere change in form of a mark is not itself an abandonment of the previous form or of a trademark”); *Adventis, Inc. v. Consol. Prop. Holdings, Inc.*, No. 7:02CV00611, 2006 U.S. Dist. LEXIS 22436, at *20 (W.D. Va. 2006) (“[A] word mark registration allows [the owner] to change the font style of the registered words without losing trademark protection.”); *Beech-Nut*, 299 F. at 850 (“The trademark consisted in the word simply, and the plaintiffs might have printed it on any form of label they might fancy, without losing the protection of the law.” (citation omitted)).

52. *Humble Oil & Ref. Co. v. Sekisui Chem. Co.*, 165 U.S.P.Q. (BNA) 597, 603 (T.T.A.B. 1970); see also *Ilco Corp. v. Ideal Sec. Hardware Corp.*, 527 F.2d 1221, 1224 (C.C.P.A. 1976); *Vacuum-Electric Corp. v. Elec. Eng’g Co.*, 150 U.S.P.Q. (BNA) 215, 216 (T.T.A.B. 1966).

53. *Paris Glove of Can., Ltd. v. SBC/Sporto Corp.*, 84 U.S.P.Q.2d (BNA) 1856 (T.T.A.B. 2007).

54. *Id.* at 1859–60.

55. *Id.* at 1861; see also *Jack Wolfskin GmbH & Co. v. New Millenium Sports, S.L.U.*, 116 U.S.P.Q.2d (BNA) 1129, 1133–34 (Fed. Cir. 2015) (discounting minor stylistic alterations to a mark featuring the word “Kelme” and a paw print design).

Board found that the change in form did not “change the essential nature of the . . . mark.”⁵⁶ The impression conveyed was “dependent upon the literal terms AQUA STOP,” rather than on the rectangular or semicircular arrangement.⁵⁷ Because the mark had not been materially altered, the owner could properly claim uninterrupted use.⁵⁸

Courts have also held that altering the “display” of a word mark by changes in background graphic elements does not constitute a legally significant change.⁵⁹ In *Jay-Zee, Inc. v. Hartfield-Zodys, Inc.*,⁶⁰ the Board held that a change in the shape of a border that originally surrounded the words THE IMAGE on clothing labels—from an ellipse to a rectangle—was “wholly immaterial.”⁶¹ These “common geometric shapes . . . merely separate the word feature from the non-trademark information on the label.”⁶² The Board found that “[s]uch banal outlines contribute little, if anything, to the origin-indicating utility of a mark.”⁶³ But here a word of caution is in order. Graphic or pictorial elements accompanying words are sometimes “integral” to the impression conveyed by mark as a whole.⁶⁴ In such cases, alteration of the graphics may constitute a significant break.

In *Louangel, Inc. v. Darden Restaurants, Inc.*,⁶⁵ the court warned that “when dealing with a composite mark involving an integrated design element, a change to that design element may well alter the commercial impression.”⁶⁶ The composite mark in *Louangel* consisted of the words LONG HORN STEAKS, in which

56. *Paris Glove*, 84 U.S.P.Q.2d at 1862.

57. *Id.*

58. *See id.* (granting summary judgment that the changes did not lead to the abandonment of the original mark).

59. *See Family Circle, Inc. v. Family Circle Assocs., Inc.*, 205 F. Supp. 940, 944 (D.N.J. 1962) (referring to a “liberal policy” for accepting evidence of the continued use of a trademark in cases where the “manner of display or background” differs from what was shown in the registration) (citation omitted).

60. *Jay-Zee, Inc. v. Hartfield-Zodys, Inc.*, 207 U.S.P.Q. (BNA) 269 (T.T.A.B. 1980).

61. *Id.* at 271.

62. *Id.*

63. *Id.*; *see also Vornado, Inc. v. Breuer Elec. Mfg. Co.*, 390 F.2d 724, 727 (C.C.P.A. 1968) (stating the likelihood of confusion between TORNADO and VORNADO marks was unaffected by the practice of representing the former in advertising with a “whirling funnel” design; because the display of a mark “may be changed at any time as may be dictated by the fancy of the . . . owner,” the owner’s rights should not be limited by its form of advertising).

64. *See Paris Glove of Can., Ltd. v. SBC/Sporto Corp.*, 84 U.S.P.Q.2d (BNA) 1856, 1862 (T.T.A.B. 2007) (finding no design feature of the rectangular form that was “integral” to the AQUA STOP trademark).

65. *Louangel, Inc. v. Darden Rests., Inc.*, 106 U.S.P.Q.2d (BNA) 1809 (S.D. Tex. 2013).

66. *Id.* at 1814.

the head of a cartoon-style baby-faced cow substituted for the “O” in LONG, and a cartoon-style t-bone steak substituted for the “T” in STEAKS.⁶⁷ When the owner changed to a “minimalist” design, with more restrained typography and a separate, stylized depiction of a steer’s head replacing the cartoon cow, this had the effect of introducing an entirely new mark, even though the only change in the words was the replacement of STEAKS with STEAKHOUSE.⁶⁸

Similarly, the Board denied the Optimist International Society their claimed priority date for the use of the initials “OI” due to changes in the composite mark in which the initials had been displayed.⁶⁹ For decades, the Society had always shown the initials within an octagon, accompanied by the words OPTIMIST INTERNATIONAL and a sunburst design.⁷⁰ The Society had not used the initials “OI” alone until years after the OnIzed club of Owens-Illinois had begun to do so.⁷¹ As the Board put it, the “collision occurred” when the Optimists removed the “OI” from the “protective orbit” of the octagon and other design elements.⁷² This meant, “for all practical purposes, creat[ing] a new mark”⁷³

A more subtle change occurred in *Adventis*, where the registered mark BIG LOTS had been altered by the addition of an exclamation point.⁷⁴ The court conceded that adding an exclamation point as punctuation normally would not change a word mark enough to affect the owner’s seniority.⁷⁵ Here, however, the exclamation point had been added *between* the words BIG and LOTS, and evidence suggested that the owner of the mark had featured the exclamation point by itself in advertising and signage.⁷⁶ The addition of the exclamation point as a graphic device could have changed the impression conveyed by the words alone.⁷⁷

67. *See id.* at 1811.

68. *See id.* at 1811, 1815.

69. *Owens-Illinois, Inc. v. Optimist Int’l*, 173 U.S.P.Q. (BNA) 120, 127 (T.T.A.B. 1972).

70. *Id.*

71. *Id.*

72. *Id.* at 125.

73. *Id.* at 127.

74. *Adventis, Inc. v. Consol. Prop. Holdings, Inc.*, No. 7:02CV00611, 2006 U.S. Dist. LEXIS 22436, at *20 (W.D. Va. 2006).

75. *Id.* at *21.

76. *Id.* at *22–23.

77. *Id.* at *23 (denying summary judgment).

C. Additions, Subtractions, and Substitutions

Many tacking cases involve word marks that have been altered by additions, subtractions, or substitutions. Sometimes these changes have deprived the trademark owner of the benefit of its earlier version of the mark, and sometimes they have not.

1. *Additions.* In *American Security Bank v. American Security & Trust Co.*, the firm that had first used and registered the mark AMERICAN SECURITY for banking services sought to register AMERICAN SECURITY BANK as well.⁷⁸ The registration was opposed by another firm already using the term.⁷⁹ The applicant argued that “the addition of the purely descriptive word ‘Bank’ is no change at all,”⁸⁰ entitling the applicant to the status of senior user of the mark. The Court of Customs and Patent Appeals (CCPA) agreed: “While AMERICAN SECURITY BANK is a distinguishable, three-word mark, the word ‘bank’ is purely descriptive and adds nothing to the origin-indicating significance of AMERICAN SECURITY.”⁸¹ Customers who did business with the applicant under the earlier name knew already that the applicant was a bank.⁸² The marks were legal equivalents⁸³ and the rights of the applicant were superior to those of the opposer and junior user of the mark.⁸⁴

In *American Security Bank*, the word “Bank” seems to have been, in a sense, an implicit component of the earlier version of the mark,⁸⁵ so that making it explicit effected no change at all.⁸⁶ The addition in *D&J Master Clean, Inc. v. Servicemaster Co.*,⁸⁷ seems more significant. The ServiceMASTER firm (SMC) adopted the name “ServiceMASTER Clean” to distinguish its cleaning services from the

78. *Am. Sec. Bank v. Am. Sec. & Tr. Co.*, 571 F.2d 564, 564–66 (C.C.P.A. 1978).

79. *See id.* at 565–66.

80. *Id.* at 567.

81. *Id.*

82. *See id.* (During the seventy-three years when applicant had used the shortened name, “[i]ts customers . . . always knew that the institution going by the nickname of or using the service mark AMERICAN SECURITY was a bank.”).

83. *Id.*

84. *Id.* at 568.

85. *See* *ICON Sols., Inc. v. IKON Office Sols., Inc.*, No. 97-4178, 1998 U.S. Dist. LEXIS 9101, at *21 (E.D. Pa. 1998) (remarking that in *American Security Bank* “the additional term ‘bank’ had always been implicit”).

86. *See also* *Colonial Elec. & Plumbing Supply of Hammonton, LLC v. Colonial Elec. Supply, Ltd.*, No. 05-5408, 2007 U.S. Dist. LEXIS 94417, at *30–31 (D.N.J. Dec. 27, 2007) (explaining that COLONIAL ELECTRIC SUPPLY is the legal equivalent of COLONIAL ELECTRIC because the names had been used synonymously and either business would “supply” electrical goods).

87. *D&J Master Clean, Inc. v. Servicemaster Co.*, 181 F. Supp. 2d 821 (S.D. Oh. 2002).

other services it offered, such as lawn care, food management, and home health care.⁸⁸ In a dispute involving potential confusion with another firm's "Master Clean" mark for cleaning services, ServiceMaster claimed to be the senior user by virtue of its prior use of "ServiceMASTER" alone.⁸⁹ The court allowed SMC the benefit of tacking, finding that the word "Clean" was "purely descriptive" and an addition that "add[ed] nothing of significance to the original mark."⁹⁰ The "ServiceMASTER" mark was "long-established, federally registered, and widely recognized . . ."⁹¹ The business now designated as "ServiceMASTER Clean" was, as a franchisee put it, "just . . . a branch of ServiceMASTER" that "happen[s] to clean."⁹² The court deemed SMC's decision "to modify slightly its mark" one that was "reasonable and lawful."⁹³

The addition of "Clean" told consumers something about the business that "ServiceMASTER" alone did not and, as intended, it differentiated the cleaning services from others provided by the same firm. On other occasions, courts have held that words adding comparable information were a significant change that barred the application of tacking. In *American Paging, Inc. v. American Mobilphone, Inc.*,⁹⁴ a firm using the mark AMERICAN PAGING sought cancellation of a registration for AMERICAN MOBILPHONE PAGING by a firm that had first used AMERICAN MOBILPHONE alone.⁹⁵ Although the registrant argued that PAGING was merely descriptive of the services it offered,⁹⁶ the court denied it the benefit of tacking. Calling it a "close question,"⁹⁷ the court relied on the registrant's provision of two types of service—mobile phone services and radio paging services. In contrast to *American Security Bank*,

88. *Id.* at 823–24.

89. *See id.* at 825.

90. *Id.*

91. *Id.*

92. *Id.*

93. *Id.* In *Neely v. Boland Mfg. Co.*, 274 F.2d 195, 202 (8th Cir. 1960), the court found insignificant the addition "by Neely" to the mark "Jiffy" for garment bags, regarding the terms "Jiffy" and "Jiffy by Neely" as being "in legal effect, identical." However, the court seemed to base its conclusion on the likelihood of confusion between garment bags bearing a "Jiffy" or "Jiffy by Neely" mark. *See id.* ("Surely, anyone using the word 'Jiffy' on garment bags would infringe the trade-mark 'Jiffy by Neely', and the use of the latter mark on such bags would infringe the trade-mark 'Jiffy.'"). In the tacking context, courts have often held that likelihood of confusion is not the proper standard by which to judge if marks are legally equivalent. *See Hana Fin., Inc. v. Hana Bank*, 735 F.3d 1158, 1164–65 (9th Cir. 2013), *aff'd* 135 S. Ct. 907 (2015).

94. *Am. Paging, Inc. v. Am. Mobilphone, Inc.*, 13 U.S.P.Q.2d (BNA) 2036 (T.T.A.B. 1989).

95. *Id.* at 2036–37.

96. *Id.* at 2037.

97. *Id.* at 2038.

customers of the mobile phone services “would not know they were dealing with a company that also rendered paging services.”⁹⁸ The two services were distinct enough to be separately listed in the yellow pages, using the different variants of the registrant’s marks.⁹⁹ Because it “convey[ed] more information to potential customers,”¹⁰⁰ the AMERICAN MOBILPHONE PAGING mark was a separate mark, entitled only to its own date of first use.¹⁰¹

Other cases support the rule that additions providing further information to consumers will deny a trademark owner the benefit of tacking. In *Fifth Ave. of Long Island Realty Assocs. v. Caruso Mgmt. Co.*,¹⁰² two shopping centers, one in Manhasset, New York and the other in Glendale, California, used the word AMERICANA in their names.¹⁰³ The New York firm, now using the name AMERICANA MANHASSET, claimed priority through its earlier use and registration of AMERICANA alone.¹⁰⁴ The California firm argued that AMERICANA had been abandoned through non-use.¹⁰⁵ The court found the change a significant one; the addition of MANHASSET “convey[ed] a specific location,” while AMERICANA alone “convey[ed] only an image of things culturally related to America.”¹⁰⁶ In *The Wet Seal, Inc. v. FD Management, Inc.*,¹⁰⁷ the Board held that priority in the mark ARDENBEAUTY could not be based on Elizabeth Arden’s earlier use of the mark ARDEN alone.¹⁰⁸ Although the word “beauty” is often used in the field of cosmetics, the word ARDEN by itself “generally refers to any person with that surname,” whereas “ARDENBEAUTY imparts additional information about that person [as] one possessing certain qualities or characteristics.”¹⁰⁹

98. *Id.* at 2039.

99. *Id.* at 2038.

100. *Id.* at 2039.

101. *Id.*

102. *Fifth Ave. of Long Island Realty Assocs. v. Caruso Mgmt. Co.*, 718 F. Supp. 2d 292 (E.D.N.Y. 2010).

103. *Id.* at 297.

104. *See id.* at 301–02.

105. *See id.* at 306.

106. *Id.* at 310. The court also noted that the additional word made the marks “aurally and visually dissimilar,” and that the two marks were displayed in different styles. *Id.* at 309.

107. *The Wet Seal, Inc. v. FD Mgmt., Inc.*, 82 U.S.P.Q.2d (BNA) 1629 (T.T.A.B. 2007).

108. *Id.* at 1637.

109. *Id.* Although the opinions do not discuss added information explicitly, one might put in this same category *Advance Stores Co. v. Refinishing Specialties, Inc.*, 948 F. Supp. 643, 653 (W.D. Ken. 1996) (holding that ADVANCE AUTO PARTS could not tack on their earlier use of ADVANCE alone) and *Super Value Stores, Inc. v. Exxon Corp.*, 11 U.S.P.Q.2d (BNA) 1539, 1541–42 (T.T.A.B. 1989) (denying Exxon priority in TIGER MART for retail convenience stores based on its earlier use of TIGER alone for petroleum products). While

2. *Subtractions.* Other cases consider the opposite question—whether a firm that removes words from its trademark sacrifices its ability to claim the priority date of the original version. In *Fifth Avenue*, the court concluded, after a review of precedent, that tacking is more likely to be permitted where words have been subtracted, rather than added or changed.¹¹⁰ Two examples of inconsequential subtraction come from the Seventh Circuit Court of Appeals. In *Forum Corp. v. Forum, Ltd.*, the plaintiff gradually changed its mark from THE FORUM CORPORATION OF NORTH AMERICA to THE FORUM CORPORATION, or just THE FORUM.¹¹¹ The abbreviation, the court found, made little difference. It was the defendant's responsibility to avoid confusion with an existing mark, and because "the salient and memorable feature" of plaintiff's name remained intact, the changes did not free the defendant of that responsibility.¹¹² In *Sands, Taylor & Wood Co. v. Quaker Oats Co.*, plaintiff STW owned a registration for THIRST-AID "FIRST AID FOR YOUR THIRST."¹¹³ Quaker, which used "Thirst Aid" in its advertising for Gatorade, argued that STW's rights were abandoned when it dropped the "FIRST AID FOR YOUR THIRST" portion of the slogan.¹¹⁴ The court disagreed, finding that the "key element" of the mark—the words THIRST-AID—had endured.¹¹⁵

A less plausible circumstance for tacking was presented in *National Bakers Services, Inc. v. Hain Pure Food Co., Inc.*¹¹⁶ The case involved an application for the mark HOLLYWOOD for mayonnaise, which was opposed by a firm using the same mark

the issue arose in an unusual context, one could add to the list *O-M Bread, Inc. v. U.S. Olympic Comm.*, 65 F.3d 933 (Fed. Cir. 1995). In *O-M Bread*, the Federal Circuit determined that the prior use of OLYMPIC for baked goods did not allow the applicant to register OLYMPIC KIDS. Because of special legislation concerning the Olympic Games, use of "Olympic" had to depend on grandfathered rights. The applicant was permitted to use OLYMPIC alone, but the addition of KIDS created a separate mark, even though "kids" was merely descriptive of the target market. *Id.* at 936–38.

110. See *Caruso Mgmt. Co.*, 718 F. Supp. at 309 ("Upon analysis of the cases, the court notes that there is a difference between the deletion of words from a registered mark, and adding to, or changing words of that mark. While it may be easier to find a continuing commercial impression where words are deleted, courts are less likely to conclude that two marks convey the same impression when words are changed or added.")

111. *Forum Corp. v. Forum, Ltd.*, 903 F.2d 434, 441 (7th Cir. 1990).

112. *Id.*

113. *Sands, Taylor & Wood Co. v. Quaker Oats Co.*, 978 F.2d 947, 955 (7th Cir. 1992).

114. See *id.*

115. *Id.*; see also *Puritan Sportswear Corp. v. Shure*, 307 F. Supp. 377, 389 (W.D. Penn. 1969) (explaining that elimination of every word but PURITAN from the registered mark PURITAN SPORTSWEAR, THE CHOICE OF ALL AMERICANS did not mean abandonment).

116. *Nat'l Bakers Servs., Inc. v. Hain Pure Food Co.*, 207 U.S.P.Q. (BNA) 701 (T.T.A.B. 1980).

for bread. The applicant relied, in part, on its ownership of the previously registered mark HOLLYWOOD HEALTH FOODS.¹¹⁷ The court found that the additional term “health foods” was “highly descriptive and generic” and “merely designate[d] a general type of food.”¹¹⁸ Its omission did not change the “dominant portion” of the mark.¹¹⁹ Purchasers “would perceive both marks as ‘HOLLYWOOD’ and would not be deterred from this perception by the descriptive words ‘health foods.’”¹²⁰ In this case the conclusion seems dubious. Particularly in the context of mayonnaise (not generally perceived as a health food), the additional words might have conveyed a very different impression.

Instead of looking for the key element, salient feature, or dominant portion of the original form, in some cases one could treat the original as *more than one* mark, where discontinued use of one mark would not affect ongoing rights in the other. In *Proxite Prods., Inc. v. Bonnie Brite Prods. Corp.*, the plaintiff, after using the mark BONNIE BLUE for laundry bluing, had used and registered the mark PROX BONNIE BLUE.¹²¹ Eventually it dropped PROX, returning to BONNIE BLUE alone.¹²² PROX had been added following a corporate merger, “and perhaps to identify the origin of the bluing with the previous corporation.”¹²³ The court found that dropping PROX later did not abandon plaintiff’s rights in the registered mark, and that, even if it had, plaintiff might claim common law rights in BONNIE alone due to its continuous use of that term to identify its product.¹²⁴ More recently, in *Jimlar Corp. v. The Army and Air Force Exchange Service*, the Board found tacking appropriate even though the mark A CLUB for footwear had originally been coupled with BY AMERICAN EAGLE in a composite mark.¹²⁵ The Board found that on the original label A CLUB had been “so conspicuously used as to create a separate and distinct commercial impression;” hence the words A CLUB alone had “separately functioned as a mark.”¹²⁶

117. *Id.* at 703.

118. *Id.* at 707.

119. *Id.*

120. *Id.*

121. *Proxite Prods., Inc. v. Bonnie Brite Prods. Corp.*, 206 F. Supp. 511 (S.D.N.Y. 1962).

122. *Id.* at 513.

123. *Id.* at 514.

124. *Id.*

125. *Jimlar Corp. v. The Army and Air Force Exch. Serv.*, 24 U.S.P.Q.2d (BNA) 1216, 1221 (T.T.A.B. 1992).

126. *Id.* The Board noted that A CLUB had always been displayed with the same distinctive style, with the word CLUB superimposed over a capital letter “A.” *Id.* In *Family Circle, Inc. v. Family Circle Associates, Inc.*, 205 F. Supp. 940, 943 (D.N.J. 1962), the court

In other cases, courts have found that omitting terms previously used had the effect of creating an entirely new mark. The easiest cases may be those where the omission led to a different meaning. In *Viviane Woodward Corp. v. Roberts*,¹²⁷ a cologne manufacturer sought to register the mark EGO, relying on its prior use of ALTER EGO.¹²⁸ The Board held that the two marks were not legal equivalents.¹²⁹ Similarly, in *Corporate Fitness Programs, Inc. v. Weider Health & Fitness, Inc.*,¹³⁰ the applicant claimed rights in the mark SHAPE for a fitness magazine, relying on prior use of SHAPE-UP.¹³¹ The Board held that SHAPE and SHAPE-UP are “obviously different designations which have different meanings and create different commercial impressions.”¹³² The Board pointed to dictionary definitions defining the former as a geometric form and the latter as a process of improvement.¹³³

In other cases of omission, attempts to tack on the use of a previous mark have come up against a reluctance to permit the impermissible “broadening” of trademark rights.¹³⁴ Potential broadening is easiest to perceive in cases where a trademark owner claims rights to, in effect, a “family” of trademarks linked

referred to expert testimony that “it is a normal event for two marks to be combined into one composite mark.” If the parts of a composite form a “unitary meaning” (e.g., YANKEE CLIPPER), then use of those parts together would not demonstrate the use of any of them separately. *Id.* In *Family Circle*, however, the name FAMILY CIRCLE had appeared much more prominently than the word EVERYWOMAN’S that had at one point preceded it in a composite mark. *Id.* at 944. Hence, use of the composite did amount to use of FAMILY CIRCLE itself as a trademark. *Id.* In contrast, the Ninth Circuit in *Quicksilver* found that the use of QUICKSILVER ROXY may have been insufficient to establish rights in ROXY alone. *Quicksilver, Inc. v. Kymsta Corp.*, 466 F.3d 749, 763 (9th Cir. 2006). The court observed that “[a] product mark like “ROXY,” even if always displayed with a house mark like “QUICKSILVER,” may acquire independent trademark significance.” *Id.* at 757. But here the ROXY name may not have acquired that significance. *Id.* at 758. In fact, ROXY had always been displayed with the “house mark” QUICKSILVER due to concerns that otherwise “no one would have known what “Roxy” was.” *Id.* at 759.

127. *Viviane Woodward Corp. v. Roberts*, 181 U.S.P.Q. (BNA) 840 (T.T.A.B. 1974).

128. *Id.* at 841.

129. *Id.*

130. *Corp. Fitness Programs, Inc. v. Weider Health & Fitness, Inc.*, 2 U.S.P.Q. (BNA) 1682 (T.T.A.B. 1987).

131. *Id.* at 1683.

132. *Id.* at 1687.

133. *See id.* In *Polo Fashions, Inc. v. Extra Special Prods., Inc.*, 451 F. Supp. 555, 562–63 (S.D.N.Y. 1978), the defendant could not tack prior use of the mark MARCO POLO for clothing to its current use of POLO alone. This is another instance where the omission of a single word creates a mark with an entirely different connotation. *Id.*

134. *See Brookfield Commc'ns, Inc. v. W. Coast Entm't Corp.*, 174 F.3d 1036, 1049 (9th Cir. 1999); *Van Dyne-Crotty, Inc. v. Wear-Guard Corp.*, 926 F.2d 1156, 1160 (Fed. Cir. 1991), *abrogated by Hana Fin., Inc. v. Hana Bank*, 135 S. Ct. 907 (2015).

by a single element used before in one or more composite marks.¹³⁵ In *Feed Flavors Inc. v. Kemin Indus., Inc.*,¹³⁶ Kemin claimed prior rights to the mark AROME applied to animal feed additives, based on its sales of BAN AROME C, COVER-AROME, and PINE AROME.¹³⁷ In the Board's view, none of these were "substantially the same as AROME, per se;" in each instance, "the addition of a distinctive prefix . . . render[ed] these marks not only totally different from each other but also from the registered mark 'AROME.'"¹³⁸ Similarly, in *John Morrell & Co. v. Hauser Packing Co.*,¹³⁹ the plaintiff had used the word PRIDE in its trademarks for cured meats, but only in combination with other words—e.g., MORRELL'S PRIDE, MORRELL'S IOWA PRIDE, and MORRELL'S DAKOTA PRIDE.¹⁴⁰ Now it accused the defendant of trademark infringement through its use of HAUSER'S PRIDE for bacon and ham.¹⁴¹ Because PRIDE had not been registered as a trademark, and the words with which it had been used were equally prominent, the court found that Morrell had no rights in PRIDE alone.¹⁴² In either of these cases, ignoring portions of the marks actually used could well have "broadened" the owner's rights beyond what could be justified.

Yet the strongest language against broadening appears in *Van Dyne-Crotty, Inc. v. Wear-Guard Corp.*,¹⁴³ a case presenting facts reminiscent of those in *Sands, Taylor & Wood*. Here the Federal Circuit affirmed the decision of the Board that a clothing business using the trademark CLOTHES THAT WORK could not secure priority via the previously-used mark CLOTHES THAT WORK. FOR THE WORK YOU DO.¹⁴⁴ The court observed that "[s]imply because a mark is a portion of an earlier mark, [the] analysis should not stop there."¹⁴⁵ Rather, the tacking inquiry "must focus on both marks in their entirety to determine whether

135. See *McDonald's Corp. v. Druck & Gerner, DDS., P.C.*, 814 F. Supp. 1127, 1133 (N.D.N.Y. 1993) (observing that "numerous courts have held that [McDonald's] possesses a family of marks using the "Mc" formative entitled to trademark protection").

136. *Feed Flavors Inc. v. Kemin Indus., Inc.*, 214 U.S.P.Q. (BNA) 360 (T.T.A.B. 1982).

137. *Id.* at 362–63.

138. *Id.* at 363.

139. *John Morrell & Co. v. Hauser Packing Co.*, 20 F.2d 713 (9th Cir. 1927).

140. *Id.*

141. *Id.*

142. *Id.* at 714.

143. *Van Dyne-Crotty, Inc. v. Wear-Guard Corp.*, 926 F.2d 1156 (Fed. Cir. 1991), *abrogated by* *Hana Fin., Inc. v. Hana Bank*, 135 S. Ct. 907 (2015).

144. *Id.* at 1160. In this case, rights to the earlier mark were purchased from another firm, apparently for the express purpose of securing senior-user status for the later mark. See *id.* at 1158.

145. *Id.* at 1160.

each conveys the same commercial impression.”¹⁴⁶ Comparing the marks themselves, the court could not disagree with the Board’s conclusion that the marks conveyed different commercial impressions.¹⁴⁷

The court also warned that “it would be clearly contrary to well-established principles of trademark law to sanction the tacking of a mark with a narrow commercial impression onto one with a broader commercial impression.”¹⁴⁸ The reference to “a broader commercial impression” is cryptic. Although the earlier mark included something (additional words) that the later mark did not, the court does not explain how a commercial impression can be either “broad” or “narrow.” The court cites three cases in support of its assertion—*Corporate Fitness*, *Viviane Woodward*, and *Polo Fashions*—but these are each cases where an omission *changed* the meaning of the mark (from “shape up” to “shape,” from “alter ego” to “ego,” and from “Marco Polo” to “polo,” respectively) without making the mark, in any obvious sense, *broader*.¹⁴⁹ Nevertheless, the court’s admonition that broadening is contrary to “well-established principles of trademark law” has been repeated by other courts,¹⁵⁰ and it seems to apply most clearly in instances of subtraction.

The proposition that marks must be compared “in their entirety” for purposes of tacking could also be deemed a well-established principle.¹⁵¹ If tacking depends on a continuous commercial impression, then it can be judged only by comparing the marks as a whole.¹⁵² Hence, one cannot, as the Federal Circuit said, rely simply on the continued use of a portion of the earlier mark. However, it is worth remembering in this context the

146. *Id.*

147. *Id.* at 1159–60.

148. *Id.* at 1160.

149. *Id.* (citing *Polo Fashions, Inc. v. Extra Special Prods., Inc.*, 451 F. Supp. 555, 562–63 (S.D.N.Y. 1978); *Corp. Fitness Programs Inc. v. Weider Health and Fitness Inc.*, 2 U.S.P.Q.2d (BNA) 1682, 1685 (P.T.A.B. 1987); *Viviane Woodard Corp. v. Roberts*, 181 U.S.P.Q. (BNA) 840, 840 (P.T.A.B. 1974)).

150. *See, e.g.*, *Quicksilver, Inc. v. Kymsta Corp.*, 466 F.3d 749, 760 (9th Cir. 2006); *Brookfield Commc’ns, Inc. v. W. Coast Entm’t Corp.*, 174 F.3d 1036, 1049 (9th Cir. 1999); *Navistar Int’l Transp. Corp. v. Freightliner Corp.*, 52 U.S.P.Q.2d (BNA) 1074, 1079 (N.D. Ill. 1998).

151. *See O-M Bread, Inc. v. U.S. Olympic Comm.*, 65 F.3d 933, 937 (Fed. Cir. 1995) (“No part of the mark can be ignored in comparing the marks as a whole.”); *KeyCorp. v. Key Bank & Tr.*, 99 F. Supp. 2d 814, 820 (N.D. Oh. 2000) (“[C]ourts may not split marks into their component parts in determining whether they may be tacked, but rather must evaluate the impression which the mark as a whole creates.”).

152. *See Estate of P.D. Beckwith, Inc. v. Comm’r of Patents*, 252 U.S. 538, 545–46 (1920) (“The commercial impression of a trade-mark is derived from it as a whole, not from its elements separated and considered in detail.”).

Supreme Court's observation in *Saxlehner* that the public may be deceived by appropriation of something less than the whole: "if a thing contained twenty-five parts, and only one was taken, such imitation would be sufficient to contribute to a deception, and the law would hold those responsible who had contributed to the fraud."¹⁵³ If that is the case, then a portion of the whole may have significance as an indicator of source, and the continuous use of that portion may justify some continuity of rights.

3. *Substitutions.* Courts seem most reluctant to permit tacking in instances where the trademark owner seeks to overcome *changes* to the mark, rather than additions or subtractions. Success has generally been achieved only in cases where the substitutions were exceedingly minor. In *Hess's of Allentown, Inc. v. National Bellas Hess, Inc.*,¹⁵⁴ the plaintiff claimed senior rights in the term HESS'S as applied to its department store, by virtue of its prior use of HESS.¹⁵⁵ The court found that "no distinction for legal or practical purposes can be made between a name and the possessive form thereof, and the record indicates that petitioner adopted the term HESS'S to reflect the manner in which the purchasing public had come to refer to and identify its store and operations."¹⁵⁶ Because the public would regard HESS and HESS'S as "one and the same designation,"¹⁵⁷ tacking was permitted.¹⁵⁸ In *Humble Oil & Refining Co. v. Sekisui Chemical Co.*,¹⁵⁹ the Board recognized Sekisui's rights as the senior user, even though it had modified its trademark S-LON to the phonetic equivalent ESLON.¹⁶⁰ The marks "differ[ed] essentially only by one letter and a hyphen;" they "convey[ed] exactly the same significance" and would have been "recognized as the same mark."¹⁶¹ In *In re Dial-A-Mattress Operating Corp.*,¹⁶² the

153. *Saxlehner v. Eisner & Mendelson Co.*, 179 U.S. 19, 33 (1900).

154. *Hess's of Allentown, Inc. v. Nat'l Bellas Hess, Inc.*, 169 U.S.P.Q. (BNA) 673 (T.T.A.B. 1971).

155. *Id.* at 677.

156. *Id.*

157. *Id.*; see also *Miami Credit Bureau, Inc. v. Credit Bureau, Inc.*, 276 F.2d 565, 568 (5th Cir. 1960) ("'Miami Credit Bureau' and 'Credit Bureau of Greater Miami,' if not the grammatical equivalent of each other, are so obviously synonymous as to be self-refutation of the contention that the appellee abandoned the former trade name when it began to use the latter . . .").

158. *Hess's*, 169 U.S.P.Q. at 677.

159. *Humble Oil & Ref. Co. v. Sekisui Chem. Co.*, 165 U.S.P.Q. (BNA) 597 (T.T.A.B. 1970).

160. *Id.* at 604.

161. *Id.*

162. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341 (Fed. Cir. 2001).

Federal Circuit found the mark 1-888-MATRESS to be the legal equivalent of the previously-registered mark 1-212-MATTRES, in spite of the misspelling in the latter and the different area code.¹⁶³

A more significant substitution did not stand in the way of tacking in *Hana Financial*. A firm known as HANA BANK in Korea advertised services in the United States as HANA OVERSEAS KOREAN CLUB.¹⁶⁴ Later it used the name HANA WORLD CENTER.¹⁶⁵ Ultimately it adopted the name HANA BANK, but by that time another firm was using the name HANA FINANCIAL in the United States for similar services.¹⁶⁶ The user of HANA BANK claimed the rights of the senior user via tacking, and it received a favorable verdict after a jury trial.¹⁶⁷ The Ninth Circuit affirmed,¹⁶⁸ because reasonable minds could conclude that the marks HANA OVERSEAS KOREAN CLUB, HANA WORLD CENTER, and HANA BANK were not “materially different.”¹⁶⁹ The court noted that in advertising HANA BANK had appeared in Korean next to the original name, as had the firm’s “distinctive dancing man logo,” and that “ordinary purchasers of the Bank’s services were likely aware of the Bank and its services from their experiences in Korea.”¹⁷⁰ Under these circumstances, the names could have conveyed a “continuous commercial impression of the services the Bank offered and their origin.”¹⁷¹

Very few cases permit tacking where the substitution is as significant as it was in *Hana Financial*. One example is *John Winkler’s Sons, Inc. v. American Express Co.*,¹⁷² where a delivery company using the mark CAREFREE CRUISE was permitted to tack on its prior use of THE CAREFREE PLAN in order to achieve priority over American Express’s CAREFREE mark for travel

163. *Id.* at 1348. Here the context was whether the trademark owner could rely on registration of the earlier version of the mark to establish the acquired distinctiveness of the later version. In *Children’s Legal Services PLLC v. Kresch*, 87 U.S.P.Q.2d (BNA) 1765, 1766 (E.D. Mich. 2008), the court allowed tacking where it found the substitution of 1-800-MYCHILD for 1-888-4MYCHILD to be “only a trivial alteration that would not have disrupted the overall commercial impression that observers gleaned from the mark.” In *Viking Boat Co., Inc. v. Viking Camper Supply, Inc.*, 191 U.S.P.Q. (BNA) 297, 302 (T.T.A.B. 1976), the Board overlooked the omission of a hyphen, changing VI-KING to VIKING.

164. *Hana Fin., Inc. v. Hana Bank*, 135 S. Ct. 907, 909 (2015).

165. *Id.*

166. *Id.* at 909–10.

167. *Id.* at 910.

168. *Hana Fin., Inc. v. Hana Bank*, 735 F.3d 1158 (9th Cir. 2013), *aff’d* 135 S. Ct. 907 (2015).

169. *Id.* at 1166.

170. *Id.*

171. *Id.* at 1166–67.

172. *John Winkler’s Sons, Inc. v. Am. Express Co.*, 175 U.S.P.Q. (BNA) 442 (T.T.A.B. 1972).

tours.¹⁷³ The Board relied on “a natural transition in the use of the term CAREFREE which did not change the essential nature of this mark or term.”¹⁷⁴ Perhaps the most liberal example can be found in *Laura Scudder’s v. Pacific Gamble Robinson Co.*¹⁷⁵ Here the change from BLUE BIRD for fresh vegetables to BLUE ROBIN (each with an accompanying bird design) did not deprive the applicant of its rights as senior user.¹⁷⁶ Even though “blue bird” describes a number of common bird species and “blue robin” (at least on this continent) does not,¹⁷⁷ the Board found the substitution “of no particular consequence insofar as applicant’s rights . . . are concerned.”¹⁷⁸ The two marks “creat[ed] substantially the same general impression, namely, that of a blue-colored bird.”¹⁷⁹

Far more common are cases where minor substitutions denied the trademark owner the benefits of tacking. In *Data Concepts, Inc. v. Digital Consulting, Inc.*,¹⁸⁰ the Sixth Circuit held that the stylized lower-case letters “dci” used as a trademark by Data Concepts looked too dissimilar to the upper-case “DCI” later used in Data Concept’s internet address.¹⁸¹ In *Pro-Cuts v. Schilz-Price Enterprises, Inc.*,¹⁸² the Board found that the substitution of PRO-CUTS in stylized lettering for PRO-KUT, with different stylized lettering and a palm tree design, was enough to alter the commercial impression of the mark, even though the two versions were confusingly similar.¹⁸³ In *Lone Star Steakhouse & Saloon, Inc. v. Longhorn Steaks, Inc.*,¹⁸⁴ the owner of the mark LONE* STEAKHOUSE AND SALOON could not claim seniority over LONE* STEAKS by tacking on its prior use of LONE* CAFÉ.¹⁸⁵ In *KeyCorp. v. Key Bank & Trust*,¹⁸⁶ the defendant changed its

173. *Id.* at 444.

174. *Id.*

175. *Laura Scudder’s v. Pac. Gamble Robinson Co.*, 136 U.S.P.Q. (BNA) 418 (T.T.A.B. 1962).

176. *Id.* at 419.

177. David Michael Bird’s *The Bird Almanac: The Ultimate Guide to Essential Facts and Figures of the World’s Birds* includes listings for an Indian Blue Robin and Siberian Blue Robin. DAVID MICHAEL BIRD, *THE BIRD ALMANAC: THE ULTIMATE GUIDE TO ESSENTIAL FACTS AND FIGURES OF THE WORLD’S BIRDS* 144 (1999).

178. *Laura Scudder’s*, 136 U.S.P.Q. at 419.

179. *Id.*

180. *Data Concepts, Inc. v. Dig. Consulting, Inc.*, 150 F.3d 620 (6th Cir. 1998).

181. *Id.* at 623–24.

182. *Pro-Cuts v. Schilz-Price Enters., Inc.*, 27 U.S.P.Q.2d (BNA) 1224 (T.T.A.B. 1993).

183. *Id.* at 1227.

184. *Lone Star Steakhouse & Saloon, Inc. v. Longhorn Steaks, Inc.*, 106 F.3d 355 (11th Cir. 1997), modified by *Lone Star Steakhouse & Saloon, Inc. v. Longhorn Steaks, Inc.*, 122 F.3d 1379 (11th Cir. 1997).

185. *Id.* at 362.

186. *KeyCorp. v. Key Bank & Tr.*, 99 F. Supp. 2d 814 (N.D. Oh. 2000).

mark from KEY FEDERAL SAVINGS & LOAN to KEY FEDERAL SAVINGS BANK, then KEY BANK & TRUST.¹⁸⁷ The first change had been so that the defendant could distance itself from Maryland's savings and loan crisis, and the second because the institution had converted to a state-chartered bank.¹⁸⁸ The court found that the marks did not convey, and were not meant to convey, the same commercial impression.¹⁸⁹

Courts have often denied tacking where substitutions altered the *literal* meaning of the mark, as opposed to its meaning as a signifier of brand origin. For example, in *Ilco Corp. v. Ideal Security Hardware Corp.*,¹⁹⁰ the change from HOME PROTECTION HARDWARE to HOME PROTECTION CENTER, each referring to a store display of various locks and latches, was enough to alter the mark's commercial impression and deny the user priority.¹⁹¹ The latter term "signifie[d] a unitary aggregation of goods related to home protection, the one place in the hardware store to go for home protection needs."¹⁹² The former term "refer[red] to the hardware itself and not to its collection in one place on the display rack."¹⁹³ In *Compania Insular Tabacalera, S.A. v. Camacho Cigars, Inc.*, the mark DON MARCO for cigars and the previously registered mark SAN MARCOS were too different to permit tacking, in part because "San" connotes a saint and "Don" a Spanish gentleman.¹⁹⁴ In *Salem Commodities, Inc. v. Miami Margarine Co.*, the court held that the change from NUT MAID to NU-MAID for margarine and other products, although involving only "one letter and a hyphen," had made "the significance . . . entirely different"—the first version "indicating a nut product" and the second "a product which is either new or freshly made."¹⁹⁵

187. *Id.* at 816.

188. *Id.*

189. *Id.* at 820. The court deemed "KBT's claim that its name changes were not noticeable to customers . . . somewhat disingenuous given that at least its first name change was made in the hope that its customers would distinguish its former name from its new one." *Id.*

190. *Ilco Corp. v. Ideal Sec. Hardware Corp.*, 527 F.2d 1221 (C.C.P.A. 1976).

191. *Id.* at 1224–25.

192. *Id.* at 1224.

193. *Id.* at 1225; *see also* *ICON Sols. v. IKON Office Sols.*, No. 97-4178, 1998 U.S. Dist. LEXIS 9101, at *22 (E.D. Pa. June 12, 1998) (finding that IKON and IKON OFFICE SOLUTIONS have "very different connotation[s] . . . the former suggest[ing] a high-tech company . . . [and] the latter . . . a whole range of office-related technical products and services.").

194. *Compania Insular Tabacalera, S.A. v. Camacho Cigars, Inc.*, 167 U.S.P.Q. (BNA) 299, 304 (T.T.A.B. 1970).

195. *Salem Commodities, Inc. v. Miami Margarine Co.*, 244 F.2d 729, 731 (C.C.P.A. 1957).

In *Specht v. Google Inc.*, the plaintiff could not tack on to ANDROID'S DUNGEON its earlier use of ANDROID DATA.¹⁹⁶ The Court rejected comparisons to *Sands, Taylor & Wood*, where the trademark owner had retained the "dominant" portion of the mark (THIRST-AID), while dropping the slogan that had accompanied it.¹⁹⁷ Here the plaintiff had made the "dominant portion" ANDROID possessive, and it had *replaced* DATA with DUNGEON.¹⁹⁸ DATA suggests "information" and DUNGEON a "a dark usu[ally] underground prison or vault;" hence, the substitution changed a mark associated with computer services to one "with allusions to robotic prisons, futuristic vaults, or a number of other meanings about which the Court will not speculate."¹⁹⁹ If the plaintiff had switched to using ANDROID alone, or if it had replaced DATA with "a word or phrase with a similar meaning or impression," then comparisons to *Sands, Taylor & Wood* might have been justified.²⁰⁰

Even a change in emphasis may be enough to forbid tacking. In *General Mills, Inc. v. Frito-Lay, Inc.*, General Mills changed its trademark for an onion-flavored snack from UNYUMS to ONYUMS.²⁰¹ Although the marks are phonetic equivalents (like S-LON and ESLON), the Board found that "the emphasis and connotation of 'UNYUMS' is dictated by the 'YUMS' or 'yummy' portion with the emphasis in 'ONYUMS' being with the term 'onions.'"²⁰² Along with the visual disparities in the two words, the difference in emphasis was enough to deny General Mills its claimed date of first use.²⁰³

D. Altered Designs

Tacking cases occasionally involve marks that are entirely or predominantly visual in nature. The results in such cases are mixed. The most liberal example of visual continuity may be found in *Dreyfus Fund, Inc. v. Royal Bank of Canada*. The Royal Bank introduced an advertising campaign featuring a lion in a variety of incongruous settings, including a wheat field and an oil rig.²⁰⁴

196. *Specht v. Google Inc.*, 758 F. Supp. 2d 570, 585 (N.D. Ill. 2010).

197. *See id.* at 584.

198. *Id.*

199. *Id.* (internal citations omitted).

200. *Id.* at 585.

201. *General Mills, Inc. v. Frito-Lay, Inc.*, 176 U.S.P.Q. (BNA) 148, 150 (T.T.A.B. 1972).

202. *Id.* at 152–53.

203. *Id.*

204. *Dreyfus Fund, Inc. v. Royal Bank of Can.*, 525 F. Supp. 1108, 1111 (S.D.N.Y. 1981).

Previously, Dreyfus had adopted a realistic lion as its symbol, and had run a celebrated series of television advertisements similar to those of the Royal Bank, including one featuring a lion on Wall Street.²⁰⁵ More recently, Dreyfus had employed a stylized drawing of a lion, in part because a realistic lion could not be reproduced effectively in the newspaper advertisements on which Dreyfus now relied.²⁰⁶ Although Dreyfus had discontinued its television advertisements, it “continued to use lions consistently with continued recognition and strength.”²⁰⁷ Even the stylized lion in the print advertisements was closely based on the realistic lion seen in the television campaign, and the resemblance “may well [have] suffice[d] to remind readers, even subliminally, of the association with Dreyfus.”²⁰⁸ The changes happened “only because investment patterns have changed, mandating changes in the type and scale of advertising.”²⁰⁹ Citing *Ilco*, the court observed that mere changes in the “form” of a mark do not deny the owner the benefit of its earlier use.²¹⁰

Other cases have dealt with more specific visual designs. In *In re Flex-O-Glass, Inc.*, the applicant sought to register a mark featuring a yellow rectangle inside a red circle.²¹¹ The Board held that the applicant could establish its distinctiveness by “tack[ing] on” its previous use of a similar mark, even though in the prior mark a portion of the rectangle was not colored yellow.²¹² The difference did not “distinguish them in any material way” or “mask the prominence in each of the yellow rectangle and red circle.”²¹³ Someone familiar with the earlier version would likely have accepted the later “as the same mark or as an inconsequential modification or modernization thereof.”²¹⁴ In *Fotomat Corp. v. Cochran*, the court disregarded minor changes in the design of the Fotomat building—a design consistently promoted as a symbol of

205. *Id.* at 1111–13.

206. *Id.* at 1113.

207. *Id.* at 1115.

208. *Id.*

209. *Id.*

210. *Id.* It is difficult to determine precisely what the court held with respect to Dreyfus’s status as the senior user. This is because Dreyfus never completely discontinued the use of realistic lions, and because Dreyfus’s current form of advertising, which seems to have begun before the disputed Royal Bank campaign, may have been close enough itself to threaten confusion. *See id.* at 1117. The court seemed generally persuaded by Dreyfus’s “heavy dose of lion imagery.” *Id.*

211. *In re Flex-O-Glass Inc.*, 194 U.S.P.Q. (BNA) 203, 204 (T.T.A.B. 1977).

212. *Id.* at 205.

213. *Id.*

214. *Id.*

the business²¹⁵—that did not alter its distinctive characteristics.²¹⁶ In *Reynolds Consumer Products, Inc. v. Handi-Foil Corp.*, Reynolds sufficiently demonstrated its ongoing use of a distinctive packaging design for Reynolds Wrap aluminum foil, incorporating a “familiar blue, silver, and pink color-pattern,” in spite of minor changes such as the introduction of curved silver lines separating the blue and pink areas.²¹⁷ In *Veryfine Products, Inc. v. Colon Bros., Inc.*, the court discounted “trivial” changes in packaging design for a beverage, including “a slightly different position of the pineapple behind the orange in the pineapple orange design, and minor color changes in part of an orange section and pineapple rind.”²¹⁸ The differences would be “apparent only upon a painstakingly careful comparison of the forms of the marks.”²¹⁹

In contrast, the Ninth Circuit in *One Industries, LLC v. Jim O’Neal Distributing, Inc.*, found that changes to a stylized “O” design on motocross apparel disrupted the commercial impression sufficiently to prevent tacking.²²⁰ O’Neal had replaced a “thicker, boxier O’ mark with rounded corners” with “an angular approach.”²²¹ Although the Ninth Circuit called it a “close case,” it agreed with the district court that, as a matter of law, the change from the “[r]ounded” mark to the “[a]ngular” mark denied O’Neal the status of senior user of the latter mark.²²² Each mark consisted of an “O” and an apostrophe, but in the first version the apostrophe was separated from the “O,” and in the second the apostrophe (which now resembled a triangle) was connected.²²³ In addition, some lines on the later mark were thicker, and the “O” looked more like a lemon.²²⁴ These differences established that the marks were not “indistinguishable.”²²⁵

215. *Fotomat Corp. v. Cochran*, 437 F. Supp. 1231, 1235 (D. Kan. 1977).

216. *Id.* at 1245. The change occurred “when the word ‘FOTOMAT’ was moved from the ends to the sides of the kiosks, and the size of the letters was increased from about 7 inches to about 11 inches.” *Id.* at 1236.

217. *Reynolds Consumer Prods. v. Handi-Foil Corp.*, No. 13-cv-214, 2014 U.S. Dist. LEXIS 26932, at *3–4 (E.D. Va. Feb. 27, 2014). If the designs did not create “a continuing commercial impression,” the court could not “imagine any two non-identical marks that would.” *Id.* at *11.

218. *Veryfine Prods., Inc. v. Colon Bros., Inc.*, 799 F. Supp. 240, 255 (D.P.R. 1992).

219. *Id.*

220. *One Indus., LLC v. Jim O’Neal Distrib., Inc.*, 578 F.3d 1154, 1161 (9th Cir. 2009).

221. *Id.* at 1156–57.

222. *Id.* at 1161, 1166.

223. *Id.* at 1161.

224. *Id.*

225. *Id.* (citation omitted); *c.f.*, *Miyano Mach. USA, Inc. v. Mianohitec Mach., Inc.*, 576 F. Supp. 2d 868, 882 (N.D. Ill. 2008) (holding that adoption of a “stylized ‘winged M’ logo” did not mean abandonment of a “block ‘winged M’ logo,” because the transition involved only “a small stylistic change in font”).

E. Product Changes

The discussion so far has centered on cases where a trademark changed, but the products associated with the mark did not. Sometimes changes to the trademark and the product go hand in hand. When that occurs, changes to the product may be a consideration in determining whether the trademark owner has lost its rights as the senior user.

Courts have long held that minor changes to a product, such as a change in formula, do not affect the rights of a trademark owner. In *Royal Milling Co. v. J.F. Imbs Milling Co.*, the court held that the rights of the senior user to the trademark “REX” for flour were uninterrupted, even though the source of the flour had changed from soft wheat to hard winter wheat.²²⁶ The mark continued to be used on “good flour,” of the same grade as before.²²⁷ The change was no more material than a change in the process for making the flour would have been.²²⁸ As expressed in another case of similar vintage:

[T]he modern concept of a trade-mark is not so rigid as to forbid slight variations necessitated by trade discoveries, newer and more economical methods of making the same product, or changed manufacturing conditions, even in a secret formula to which the trade-mark is appurtenant. A consideration of the continual changes, advertised and not advertised, which are made in familiar trade-marked products, clearly indicates that any other principle would hinder rather than protect manufacturing proprietors of trade-marked goods and make exceedingly tenuous the protection which the law affords the mark symbolizing an established and/or potential good will.²²⁹

In *Beech-Nut Packing Co. v. P. Lorillard Co.*, the court acknowledged Lorillard’s right to modify its tobacco blend without

226. *Royal Milling Co. v. J.F. Imbs Milling Co.*, 44 App. D.C. 207, 208–09 (C.A.D.C. 1915).

227. *Id.* at 208.

228. *Id.*; see *Fast Chem. Prods. Corp. v. Pillsbury Co.*, 132 U.S.P.Q. (BNA) 561, 562 (T.T.A.B. 1962) (“[T]he mere fact that the formulae or primary use of the product may have been changed through the years does not constitute an abandonment of the mark.”).

229. *Mulhens & Kropff, Inc. v. Ferd Muehlens, Inc.* 38 F.2d 287, 295 (S.D.N.Y. 1929); *rev’d in part*, 43 F.2d 937, 939 (2d Cir. 1930) (finding that the mark implied that the cologne was still made by the original formula, when it was not); see *Marlyn Neutraceuticals, Inc. v. Mucos Pharma GmbH & Co.*, 571 F.3d 873, 878 (9th Cir. 2009) (“Trademark owners are permitted to make small changes to their products without abandoning their marks . . .”); see also *E.I. du Pont de Nemours & Co. v. G.C. Murphy Co.*, 199 U.S.P.Q. (BNA) 807, 813 (T.T.A.B. 1978) (change from a premium paint to a budget-priced paint sold under the name EASY CARE would not affect the trademark owner’s rights); *E.I. du Pont de Nemours & Co. v. Big Bear Stores, Inc.*, 161 U.S.P.Q. (BNA) 50, 51–52 (T.T.A.B. 1969) (holding that a change in type of finish marketed under the name “SUPER SHIELD” would not mean abandonment of the trademark).

sacrificing its trademark.²³⁰ Lorillard could “revive” the moribund Beechnut brand by “improv[ing] the tobacco in any way which would make it marketable.”²³¹ The change in formula, in turn, “justified a change in the decorative features of the package which was to contain this new blend or mixture.”²³² Hence the changes in the blend and the label together did not deprive Lorillard of its status as the senior user of the BEECHNUT mark.²³³

On the other hand, if a change in formula leads to a product that is greatly inferior, and the existing trademark is used merely to deceive the public into believing that it is the same product as before, then the rights of the trademark owner may well be affected.²³⁴ By the same token, a *material change* in a product formula, whether it is better or worse, may amount to the introduction of an entirely different product. In *Independent Baking Powder Co. v. Boorman*, the brand name SOLAR was originally used for a baking powder made with alum.²³⁵ The assignee who purchased the mark adopted a formula made with phosphate.²³⁶ Baking powder manufacturers hotly disputed the superiority of alum, phosphate, or cream of tartar as the acidic agent,²³⁷ and they made “much ado” of the ingredient featured in their products.²³⁸ Whether phosphate was an inferior ingredient was not the issue. Here the “substitution of one important ingredient for another” meant forfeiture of the rights the assignee might have had based on earlier use of the SOLAR mark.²³⁹

230. *Beech-Nut Packing Co. v. P. Lorillard Co.*, 299 F. 834, 849 (D.N.J. 1924) (“Change of formula has never indicated abandonment.”).

231. *Id.*

232. *Id.* at 850.

233. *Id.* at 850–51.

234. *See* *Mulhens & Kropff, Inc.* at 295 (“[A] variation in formula resulting in a highly inferior or wholly different product which is palmed off on the public in place of that upon which the good will has been established would not justify the continued protection of the trade-mark.”).

235. *Indep. Baking Powder Co. v. Boorman*, 175 F. 448, 450 (D.N.J. 1910).

236. *Id.* at 454.

237. *Id.* at 455.

238. *Id.* at 454. Although each ingredient had the same function, the court found that the choice “gives both character and name to [the] product.” *Id.*

239. *Id.* at 455. In *Hy-Cross Hatchery, Inc. v. Osborne*, the court held that changing the type of chick sold under the HY-CROSS name did not diminish the rights of the assignee of the trademark. 303 F.2d 947, 950 (C.C.P.A. 1962). The court noted that no deception was involved, and that the assignor himself “was not under any obligation to the public not to change the breed of chicks he sold under the mark from time to time.” *Id.* Similarly, the court in *General Tire & Rubber Co. v. Greenwald* found that the substitution of polyether-based for polyester-based polyurethane foam, both marketed as POLYFOAM, did not abandon trademark rights obtained by assignment. 127 U.S.P.Q. (BNA) 240, 243 (S.D. Cal. 1960). Although the products were chemically different, they looked the same and only a discerning observer could distinguish them by feel. *Id.* at 242.

Generally speaking, a trademark owner who completely changed the type of goods sold under the mark would be in the same position as one who had never used the mark before. That is because trademark rights arise from the use of the mark to sell a particular type of goods.²⁴⁰ A firm that had used BEECHNUT to sell tobacco would not, by virtue of that use, have superior rights to the use of BEECHNUT to sell umbrellas.²⁴¹ Therefore, changes in a product that amount to more than a change of formula may be important to the application of tacking.

In *Big Blue Products, Inc. v. IBM Corp.*, IBM's application for the trademark BIG BLUE for typewriter ribbons was opposed by another firm that had used the same name for a variety of office equipment.²⁴² IBM did not persuade the court, on its motion for summary judgment, that it was the senior user, even though it claimed to have been generally known as "Big Blue" for some time.²⁴³ IBM had not sold typewriter ribbons under the BIG BLUE name until after the opposer had adopted the same term.²⁴⁴ The court acknowledged that IBM, because of its earlier use of BIG BLUE, might have the power to prevent the sale of related goods—goods, that is, that are different but close enough to be a source of confusion.²⁴⁵ However, its own right to registration depended on its first use of the mark to sell "substantially identical" goods.²⁴⁶

240. See 1 MCCARTHY, *supra* note 10, § 24:11 (stating that trademark rights do not prevent the use of the same mark on goods sufficiently different that there is no likelihood of confusion).

241. McCarthy's list of marks that can "peacefully co-exist" due to differences in the goods includes UNITED airlines and UNITED van lines, DELTA airlines and DELTA faucets, and ACE hardware and ACE bandages. *Id.* §§ 24–37. If the goods sold by another firm are too different to compete, but close enough that use of a similar trademark is likely to cause confusion as to source or sponsorship, then the senior user of the mark may act to prevent such confusion. *Id.* §§ 24:1–24:2. The owner of a famous mark may prevent its use even on entirely unrelated goods under theories of trademark dilution. 15 U.S.C. § 1125(c) (2012).

242. *Big Blue Prods., Inc. v. IBM Corp.*, 19 U.S.P.Q.2d (BNA) 1072, 1073 (T.T.A.B. 1991).

243. *Id.*

244. *Id.* at 1074–75.

245. See *id.* at 1075 n.4. Even if they were different products, goods within the trademark owner's "natural expansion of business" could still be confusing to consumers if they were sold under a similar mark. See *id.*

246. See *id.* The standard of "substantially identical" goods has been repeated in a number of cases. See, e.g., *C.P. Interests, Inc. v. Cal. Pools, Inc.*, 283 F.3d 690, 700–01 (5th Cir. 2001) ("substantially identical" goods, not "substantially related" goods, is the "dominant terminology" for tacking, but the court left open whether the former is "a proper or improper approximation to the standard term"); *Navistar Int'l Transp. Corp. v. Freightliner Corp.*, 52 U.S.P.Q.2d (BNA) 1074, 1078–79 (N.D. Ill. 1998) (noting that one of the questions to ask in tacking cases is whether "the marks [are] being used on the same or substantially similar goods or services"); *DC Comics, Inc. v. Scholastic Magazines, Inc.*, 210 U.S.P.Q. (BNA) 299, 301 (T.T.A.B. 1980) (referring to the use of a prior registration to

A change in the nature of the product was an important factor in *Super Value Stores, Inc. v. Exxon Corp.*²⁴⁷ Exxon's application to register TIGER MART for retail convenience stores was opposed by a firm using the name TIGER DISCOUNTER.²⁴⁸ While the opposer had used its name before Exxon had used TIGER MART, Exxon had previously used TIGER alone to sell petroleum products.²⁴⁹ The Board found that even overlooking the dissimilarities in the names, the "clear difference" in the products offered by Exxon would not permit tacking.²⁵⁰ Although the product distinction was less obvious in *General Mills*, the Board did not allow Frito-Lay to tack on its prior use of ONION FUNIONS to its current use of FUNYUNS, in part because of the difference between the crackers associated with the former term and the onion-flavored snacks associated with the latter.²⁵¹ In *Adventis*, the court noted that adding ".com" to a business name normally would preserve the commercial impression and allow tacking to occur, but that the case might be different if a traditional retailer were simultaneously converting to internet-only sales.²⁵² Hence, when a trademark changes courts will likely require a continuity of products as an independent criterion for tacking.

F. Contexts for the Application of Tacking

Tacking is most clearly an issue where two parties compete for trademark rights, and one claims priority based on its prior use

defend a later registration, where the marks and the goods are both "substantially identical"); *Tillamook Country Smoker, Inc. v. Tillamook Cty. Creamery Ass'n*, 333 F. Supp. 2d 975, 986 (D. Or. 2004) (same).

247. *Super Valu Stores v. Exxon Corp.*, 11 U.S.P.Q.2d (BNA) 1539, 1542 (T.T.A.B. 1989).

248. *Id.* at 1540.

249. *Id.* at 1541-42.

250. *Id.* at 1542; see *Hansen Beverage Co. v. Cytosport, Inc.*, No. CV 09-0031-VBF(AGR), 2009 U.S. Dist. LEXIS 120508, at *15 n. 11 (C.D. Cal. Nov. 4, 2009) (rejecting bid to tack MONSTER MILK to MONSTER FOOD, and noting that the former referred to a ready-to-drink beverage and the latter a whey protein powder); see also *Viking Boat Co., Inc. v. Viking Camper Supply, Inc.*, 191 U.S.P.Q. (BNA) 297, 301 (T.T.A.B. 1975) (refusing to grant superior rights in VIKING for recreational vehicles based on prior use for boat trailers; a boat trailer, "even through the stretch of opposer's imagination does [not] fall within the concept of a recreational vehicle currently maintained by the average purchaser").

251. *General Mills, Inc. v. Frito-Lay, Inc.*, 176 U.S.P.Q. (BNA) 148, 152 (T.T.A.B. 1972); but *c.f.*, *Jimlar Corp. v. The Army and Air Force Exch. Serv.*, 24 U.S.P.Q.2d (BNA) 1216, 1221 (T.T.A.B. 1992) (finding that boots and sneakers are, for purposes of tacking, "substantially identical" goods).

252. *Adventis, Inc. v. Consol. Prop. Holdings, Inc.*, No. 7:02CV00611, 2006 U.S. Dist. LEXIS 22436, at *19 n.11 (W.D. Va. Apr. 24, 2006).

in commerce of a slightly different mark. This situation may be represented on a timeline as follows:

MARK(A) → MARK(B) → MARK(C) →

MARK(A) and MARK(C) are the marks of the firm that relies on tacking, and that firm will achieve priority over the intervening firm, using MARK(B), if MARK(A) and MARK(C) are sufficiently similar.²⁵³ That was precisely the situation in many of the cases discussed so far.²⁵⁴ But tacking also arises in other contexts.

In some cases, the issue is framed in terms of whether the first version of the mark has been lost through abandonment.²⁵⁵ When marks are linked by tacking, continued use of the later mark can prevent the earlier mark, itself no longer in use, from falling into the public domain.²⁵⁶ However, abandonment is not always at stake.²⁵⁷ The trademark owner may use *both* versions of the mark.²⁵⁸ Here resolution of the tacking question would simply determine which version of the mark the plaintiff must rely upon to demonstrate a likelihood of confusion.²⁵⁹

253. See *Hansen Beverage Co.*, 2009 U.S. Dist. LEXIS 120508, at *13 (outlining the classic situation for tacking in a similar manner).

254. See, e.g., *Hana Fin., Inc. v. Hana Bank*, 135 S. Ct. 907, 909–10 (2015); *One Indus., LLC v. Jim O’Neal Distrib., Inc.*, 578 F.3d 1154, 1156 (9th Cir. 2009); *Quicksilver, Inc. v. Kymsta Corp.*, 466 F.3d 749, 753 (9th Cir. 2006); *Forum Corp. v. Forum, Ltd.*, 903 F.2d 434, 441 (7th Cir. 1990). In some cases, the user of MARK(C) acquired MARK(A) by assignment in an attempt to trump the user of the intervening MARK(B). See, e.g., *Van Dyne-Crotty, Inc. v. Wear-Guard Corp.*, 926 F.2d 1156, 1158 (Fed. Cir. 1991). In *ICON Solutions*, the court noted that success is very rarely achieved in such cases. *ICON Sols. v. IKON Office Sols.*, No. 97-4178, 1998 U.S. Dist. LEXIS 9101, at *16 n.5 (E.D. Pa. June 12, 1998).

255. See *Jack Wolfskin GmbH & Co. v. New Millennium Sports, S.L.U.*, 116 U.S.P.Q.2d (BNA) 1129, 1132–33 (Fed. Cir. 2015) (applying the tacking standard in the context of abandonment).

256. See, e.g., *George & Co. LLC v. Imagination Entm’t Ltd.*, 575 F.3d 383, 402 (4th Cir. 2009) (proof that LEFT CENTER RIGHT mark for a game was not abandoned depended on plaintiff’s ability to “tack” later use of LCR); *Specht v. Google, Inc.*, 758 F. Supp. 2d 570, 583 (N.D. Ill. 2010) (“[I]f the new mark [ANDROID’S DUNGEON] is the legal equivalent of the old mark [ANDROID DATA] . . . use of the new mark does not abandon the old mark.”); *McCabe-Powers Auto Body Co. v. Am. Truck Equip. Co.*, 150 F. Supp. 194, 198–99 (D. Or. 1957) (common law rights in AMERICAN mark were not abandoned by change to POWERS-AMERICAN to promote identity of acquiring corporation).

257. See *Iowa Health Sys. v. Trinity Health Corp.*, 177 F. Supp. 2d 897, 922 (C.D. Iowa 2001) (“[I]mproper tacking” may, but does not necessarily, lead to the conclusion that a prior mark has been abandoned.).

258. In *Navistar*, the plaintiff argued that tacking should be permitted only where the earlier version of the mark is no longer in use. *Navistar Int’l Trans. Corp. v. Freightliner Corp.*, 52 U.S.P.Q.2d (BNA) 1074, 1077 (N.D. Ill. 1998). The court found scant authority to support or to contradict that assertion, but ultimately saw “no reason why defendants should not be allowed to claim priority by tacking onto the older mark even if they are still using it.” *Id.*

259. See *Specht*, 758 F. Supp. 2d at 583–85. In *Specht*, the plaintiff’s failure to successfully tack meant *both* the abandonment of the ANDROID DATA mark and failure

Another frequent context for a tacking analysis is where a trademark applicant argues that its prior registration of a similar mark prevents opposition to the current application.²⁶⁰ Sometimes the opposer is said to be barred by acquiescence.²⁶¹ At other times, courts simply say that the opposer cannot be damaged by what amounts to a duplicative registration.²⁶² In any event, the question is whether the mark already registered is substantially identical to the mark that is the subject of the current application.²⁶³

Tacking also arises where the prior registration of a similar mark is said to demonstrate the acquired distinctiveness of a subsequent mark,²⁶⁴ and it can determine whether a trademark registrant has met its obligation to demonstrate continuing use.²⁶⁵ Tacking analysis has been used to determine if an OLYMPIC mark is barred by the Amateur Sports Act or “grandfathered” in,²⁶⁶ and it has shed light on the interpretation of a license governing the use of the VO5 shampoo trademark in Asia.²⁶⁷ Essentially, whenever courts have considered whether two marks, though technically different, are alike enough to be treated as the same, they have called upon the tacking doctrine explicitly, or the

to establish the necessary priority for the currently-used ANDROID’S DUNGEON mark.
Id.

260. See, e.g., *Morehouse Mfg. Corp. v. J Strickland & Co.*, 407 F.2d 881, 884 (C.C.P.A. 1969); *S & L Acquisition Co. v. Helene Arpels, Inc.*, 9 U.S.P.Q.2d (BNA) 1221, 1225 (T.T.A.B. 1987); *DC Comics, Inc. v. Scholastic Magazines, Inc.*, 210 U.S.P.Q. (BNA) 299, 301 (T.T.A.B. 1980).

261. See *Tillamook Country Smoker, Inc. v. Tillamook Cty. Creamery Ass’n*, 333 F. Supp. 2d 975, 986 n.7 (D. Or. 2004) (“[T]he prior-registration doctrine is considered one in the nature of laches or acquiescence.”).

262. See, e.g., *Morehouse*, 407 F.2d at 884; *Place for Vision, Inc. v. Pearle Vision Ctr., Inc.*, 218 U.S.P.Q. (BNA) 1022, 1023 (T.T.A.B. 1983); *DC Comics*, 210 U.S.P.Q. at 301.

263. See *S & L Acquisition*, 9 U.S.P.Q.2d at 1225 (The defense requires a prior registration “for the same or substantially identical mark and for the same or substantially identical goods and/or services.”); *DC Comics*, 210 U.S.P.Q. at 301 (same). A similar circumstance is where res judicata threatens to bar litigation with respect to a mark that is legally indistinguishable from a mark previously challenged (or defended) by the same party. See *Old Grantian Co. v. William Grant & Sons, Ltd.* 361 F.2d 1018, 1019 (C.C.P.A. 1966); *Polaroid Corp. v. C & E Vision Servs., Inc.*, 52 U.S.P.Q.2d (BNA) 1954, 1955–56 (T.T.A.B. 1999); *Institut National Des Appellations d’Origine v. Brown-Forman Corp.*, 47 U.S.P.Q.2d (BNA) 1875, 1894 (T.T.A.B. 1998).

264. See, e.g., *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1347 (Fed. Cir. 2001); *In re Flex-O-Glass Inc.*, 194 U.S.P.Q. (BNA) 203, 205–06 (T.T.A.B. 1977); 37 C.F.R. § 2.41(b) (2015) (“In appropriate cases, ownership of one or more active prior registrations on the Principal Register or under the Act of 1905 of the same mark may be accepted as prima facie evidence of distinctiveness.”).

265. See *Reynolds Consumer Prods., Inc. v. Handi-Foil Corp.*, No. 13-cv-214, 2014 U.S. Dist. LEXIS 26932, at *7 (E.D. Va. Feb. 27, 2014); *Family Circle, Inc. v. Family Circle Assocs., Inc.*, 205 F. Supp. 940, 942 (D.N.J. 1962).

266. *O-M Bread, Inc. v. U.S. Olympic Comm.*, 65 F.3d 933, 937–38 (Fed. Cir. 1995).

267. *Sunstar, Inc. v. Alberto-Culver Co.*, 586 F.3d 487, 496 (7th Cir. 2009) (“[T]acking on’ becomes a guide to interpretation of the license.”).

standard of similarity developed in tacking cases. That standard, its ambiguities, and its rationale are discussed in Part III. Although courts have treated the tacking standard as applicable in all of these contexts, I will argue later that its universal application may be a mistake.²⁶⁸

III. THE “EXCEEDINGLY STRICT” STANDARD OF TACKING.

The clearest thing one can say about tacking is that it is seldom allowed. This is a theme repeated in countless tacking cases—even those that permit the uncommon exception. Tacking is said to be condoned “only in rare instances,”²⁶⁹ or under “‘exceptionally narrow’ circumstances,”²⁷⁰ because the standard for tacking is “exceedingly strict.”²⁷¹ Nevertheless, as the Ninth Circuit observed in *Hana*, “the fact that the [tacking] doctrine rarely applies does not mean that it never will.”²⁷² The Supreme Court reassures us that any concern regarding the improper application of the tacking standard can be resolved through “careful jury instructions that make [the] standard clear.”²⁷³ It is worth considering; therefore, whether the courts have told us enough to make the “exceedingly strict” standard of tacking clear to the jury that will apply it.

A. “Continuing Commercial Impression”

In *Navistar*, the court called the tacking test “relatively simple.”²⁷⁴ The test is simple in the sense that courts tend to

268. See *infra* Part III.C.

269. See *George & Co. LLC v. Imagination Entm’t Ltd.*, 575 F.3d 383, 402 (4th Cir. 2009) (quoting *Van Dyne-Crotty, Inc. v. Wear-Guard Corp.*, 926 F.2d 1156, 1160 (Fed. Cir. 1991)); *The Wet Seal, Inc. v. FD Mgmt., Inc.*, 82 U.S.P.Q.2d (BNA) 1629, 1635 (T.T.A.B. 2007); *Big Blue Prods., Inc. v. IBM Corp.*, 19 U.S.P.Q.2d (BNA) 1072, 1075 (T.T.A.B. 1991); see also *Data Concepts, Inc. v. Dig. Consulting, Inc.*, 150 F.3d 620, 623 (6th Cir. 1998) (“[T]acking should be permitted ‘only in rare circumstances.’” (internal citation omitted)).

270. *Hana Fin., Inc. v. Hana Bank*, 735 F.3d 1158, 1160 (9th Cir. 2013) (quoting *Brookfield Commc’ns, Inc. v. W. Coast Entm’t Corp.*, 174 F.3d 1036, 1047 (9th Cir. 1999)); see also *One Indus., LLC v. Jim O’Neal Distrib., Inc.*, 578 F.3d 1154, 1160 (9th Cir. 2009); *Adventis, Inc. v. Consol. Prop. Holdings, Inc.*, No. 7:02CV00611, 2006 U.S. Dist. LEXIS 22436, at *13 (W.D. Va. Apr. 24, 2006); *Levi Strauss & Co. v. GTFM, Inc.*, 196 F. Supp. 2d 971, 983 (N.D. Cal. 2002).

271. *Quicksilver, Inc. v. Kymsta Corp.*, 466 F.3d 749, 758 (9th Cir. 2006) (quoting *Brookfield*, 174 F.3d at 1048); see *One Indus.*, 578 F.3d at 1160; see also *Specht v. Google, Inc.*, 758 F. Supp. 2d 570, 583 (N.D. Ill. 2010) (“A stringent standard exists for a mark owner to prove tacking, and a court should rarely grant it.”); *ICON Sols. v. IKON Office Sols.*, No. 97-4178, 1998 U.S. Dist. LEXIS 9101, at *16 (E.D. Pa. June 12, 1998) (describing the tacking standard as “very rigorous”).

272. *Hana*, 735 F.3d at 1168.

273. *Hana Fin., Inc. v. Hana Bank*, 135 S. Ct. 907, 912 (2015).

274. *Navistar Int’l Trans. Corp. v. Freightliner Corp.*, 52 U.S.P.Q.2d (BNA) 1074, 1078

describe it consistently and in relatively few words. In its influential *Van Dyne-Crotty* decision, the Federal Circuit said that “[t]he previously used mark must be the legal equivalent of the mark in question or indistinguishable therefrom, and the consumer should consider both as the same mark.”²⁷⁵ Further, “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”²⁷⁶ Although one can find a few cases speaking of “key” or “dominant” features shared by the marks in question,²⁷⁷ the Federal Circuit’s language is in the ascendant. Nearly all cases demand that the marks to be tacked convey the same “commercial impression,”²⁷⁸ and a great many suggest that this condition is met only when consumers regard them as “the same mark.”²⁷⁹ The jury instruction given in *Hana* and reproduced by the Supreme Court without criticism, closely mirrors the *Van-Dyne Crotty* vocabulary.²⁸⁰

(N.D. Ill. 1998).

275. *Van Dyne-Crotty, Inc. v. Wear-Guard Corp.*, 926 F.2d 1156, 1159 (Fed. Cir. 1991).

276. *Id.* (internal citation omitted).

277. *See, e.g., Sands, Taylor & Wood Co. v. Quaker Oats Co.*, 978 F.2d 947, 955 (7th Cir. 1992) (“So long as the owner continues use of the ‘key element’ of the registered mark, courts generally will not find abandonment.”); *Miyano Mach. USA, Inc. v. Mianohitec Mach., Inc.*, 576 F. Supp. 2d 868, 882 (N.D. Ill. 2008) (finding no abandonment where “key elements of the mark remain”); *Tillamook Country Smoker, Inc. v. Tillamook Cty. Creamery Ass’n*, 333 F. Supp. 2d 975, 987 (D. Or. 2004) (referring to “dominant feature[s]” in the context of a prior registration defense); *Family Circle, Inc. v. Family Circle Assocs., Inc.*, 205 F. Supp. 940, 944 (D.N.J. 1962) (“[T]he essential features of the trademark . . . were still in use”); *Fotomat Corp. v. Cochran*, 437 F. Supp. 1231, 1245 (D. Kan. 1977) (“A change in a mark that does not affect the distinctive characteristics of the mark represents a continuity of the prior mark.”).

278. *See, e.g., Hana*, 135 S. Ct. at 910; *George & Co. LLC v. Imagination Entm’t Ltd.*, 575 F.3d 383, 402 (4th Cir. 2009); *Data Concepts, Inc. v. Dig. Consulting, Inc.*, 150 F.3d 620, 623 (6th Cir. 1998); *Quicksilver, Inc. v. Kymsta Corp.*, 466 F.3d 749, 758 (9th Cir. 2006). In *Navistar*, the court identified the “fundamental inquiry” as whether a change affects the commercial impression conveyed by the mark, not whether in some other respect it “alters the character” of the mark. *Navistar*, 52 U.S.P.Q.2d at 1078 n.5. Any change at all would, in some manner, alter the character of the mark, so a literal prohibition would make any change impermissible. *Id.* The court also found a material difference approach problematic or unnecessary because a difference could be “material” only if it altered the mark’s commercial impression. *Id.* The jury instruction given in *Hana* did state that the later mark should not “materially differ from or alter the character of the mark attempted to be tacked,” and the Supreme Court reproduced this language without criticism. *Hana*, 135 S. Ct. at 910.

279. *See, e.g., Hana*, 135 S. Ct. at 910; *George*, 575 F.3d at 402; *Data Concepts*, 150 F.3d at 623; *Brookfield Commc’ns, Inc. v. W. Coast Entm’t Corp.*, 174 F.3d 1036, 1047–48 (9th Cir. 1999).

280. “In the jury instructions, the district court explained:

‘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

Whether the altered mark still conveys the same commercial impression must be judged from the perspective of consumers.²⁸¹ The marks must be viewed as a whole,²⁸² and no portion may be ignored.²⁸³ The standard for tacking is not the familiar likelihood-of-confusion test²⁸⁴ used to evaluate potential trademark infringement.²⁸⁵ The first version of a mark and the altered version may be similar enough that consumers would confuse them, yet not so similar that they convey the same commercial impression.²⁸⁶ On the other hand, if the two marks are different enough that they are *not* likely to be confused, then they are necessarily different enough to fall short of tacking's more demanding standard.²⁸⁷

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.”

Hana, 735 F.3d at 1163.

281. *Hana*, 135 S. Ct. at 910; *Navistar*, 52 U.S.P.Q.2d at 1079 (“As for whose impression matters, it is the impression of consumers for the product at issue that matters.”); *Nat'l Bakers Servs., Inc. v. Hain Pure Food Co.*, 207 U.S.P.Q. (BNA) 701, 707 (T.T.A.B. 1980) (referring to the perspective of the “purchasing public”). As the court stated in *Adventis*, the consumer's perspective is important “because it is the consumer's conclusion that is material.” *Adventis, Inc. v. Consol. Prop. Holdings, Inc.*, No. 7:02CV00611, 2006 U.S. Dist. LEXIS 22436, at *17 (W.D. Va. Apr. 24, 2006).

282. *Lone Star Steakhouse & Saloon, Inc. v. Longhorn Steaks, Inc.*, 106 F.3d 355, 362 (11th Cir. 1997), *modified by Lone Star Steakhouse & Saloon, Inc. v. Longhorn Steaks, Inc.*, 122 F.3d 1379 (11th Cir. 1997); *Van Dyne-Crotty, Inc. v. Wear-Guard Corp.*, 926 F.2d 1156, 1160 (Fed. Cir. 1991) (“[O]ur inquiry must focus on both marks in their entirety”); *The Wet Seal, Inc. v. FD Mgmt., Inc.*, 82 U.S.P.Q.2d (BNA) 1629, 1637 (T.T.A.B. 2007); *KeyCorp. v. Key Bank & Tr.*, 99 F. Supp. 2d 814, 820 (N.D. Oh. 2000) (“[C]ourts may not split marks into their component parts in determining whether they may be tacked, but rather must evaluate the impression which the mark as a whole creates.”); *Owens-Illinois, Inc. v. Optimist Int'l*, 173 U.S.P.Q. (BNA) 120, 127 (T.T.A.B. 1972) (The commercial impression of a mark is “engendered by the sum total of its parts rather than by any single element thereof.”).

283. *O-M Bread, Inc. v. U.S. Olympic Comm.*, 65 F.3d 933, 937 (Fed. Cir. 1995).

284. *See supra* Part II.A.

285. *George & Co. LLC v. Imagination Entm't Ltd.*, 575 F.3d 383, 402 (4th Cir. 2009) (“Legal equivalence for tacking purposes does not exist simply because the two marks a party seeks to tack are ‘confusingly similar.’”); *Brookfield Commc'ns, Inc. v. W. Coast Entm't Corp.*, 174 F.3d 1036, 1048 (9th Cir. 1999) (The tacking standard “is considerably higher than the standard for ‘likelihood of confusion.’”); *Data Concepts, Inc. v. Dig. Consulting, Inc.*, 150 F.3d 620, 623 (6th Cir. 1998); *Pro-Cuts v. Schilz-Price Enters., Inc.*, 27 U.S.P.Q.2d (BNA) 1224, 1227 (T.T.A.B. 1993).

286. *Lincoln Logs Ltd. v. Lincoln Pre-Cut Log Homes, Inc.* 971 F.2d 732, 735 (Fed. Cir. 1992) (“[F]or the purposes of ‘tacking,’ even if the two marks are confusingly similar, they still may not be legal equivalents.” (quoting *Van Dyne-Crotty*, 926 F.2d at 1159)); *Am. Paging, Inc. v. Am. Mobilphone, Inc.*, 13 U.S.P.Q.2d (BNA) 2036, 2038 (T.T.A.B. 1989). As stated in *Hansen*, the standard of similarity for tacking is “different and more stringent” than the standard of similarity for infringement. 2009 U.S. Dist. LEXIS 120508 at *16.

287. *See Van Dyne-Crotty*, 926 F.2d at 1159 n.3 (“We . . . affirm the Board's finding that because the marks were not confusingly similar, they were not legal equivalents for the purposes of tacking.”).

The burden of proof rests with the party that claims the benefit of tacking.²⁸⁸ Sometimes the decision requires no more than a comparison of the original and the altered versions of the mark.²⁸⁹ A court may take into account both the visual effects of the change and, in the case of word marks, changes in pronunciation.²⁹⁰ However, a court should not speculate about the effect of a change on consumer impressions,²⁹¹ particularly after the Supreme Court has determined that commercial impression is an issue of fact.²⁹² Consumer impressions may be shown directly through anecdotal evidence, or through surveys designed for the purpose.²⁹³ A court may also consider the intentions of the trademark owner; if the owner revised the mark in order to change consumer impressions, the objective was likely achieved.²⁹⁴ It might be argued that well known trademarks are more immune to changes in commercial impression because the impression is

288. *Adventis, Inc. v. Consol. Prop. Holdings, Inc.*, No. 7:02CV00611, 2006 U.S. Dist. LEXIS 22436, at *18 n.10 (W.D. Va. Apr. 24, 2006).

289. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1347 (Fed. Cir. 2001) (“No evidence need be entertained other than the visual or aural appearance of the marks themselves.”); *Van Dyne-Crotty*, 926 F.2d at 1159.

290. *See Hana Fin., Inc. v. Hana Bank*, 735 F.3d 1158, 1164 (9th Cir. 2013) (“In determining whether the marks have the same commercial impression, the visual or aural appearance may be instructive.”); *Data Concepts*, 150 F.3d at 623; *Fifth Ave. of Long Island Realty Assocs. v. Caruso Mgmt. Co.*, 718 F. Supp. 2d 292, 309 (E.D.N.Y. 2010) (finding that marks were “aurally and visually dissimilar because of the addition of a new word”).

291. *See Louangel, Inc. v. Darden Rests., Inc.*, 106 U.S.P.Q.2d (BNA) 1809, 1812 (S.D. Tex. 2013); *see also Navistar Int’l Trans. Corp. v. Freightliner Corp.*, 52 U.S.P.Q.2d (BNA) 1074, 1079 (N.D. Ill. 1998) (“Because the inquiry is how consumers perceive the marks, there must be some evidence demonstrating those perceptions.”).

292. *Hana Fin., Inc. v. Hana Bank*, 135 S. Ct. 907, 911 (2015). As was said in *Adventis*, “[t]he opinion of a court sitting in its ivory tower sheds no light on an issue in which the everyday consumer is the more adept expert.” *Adventis*, 2006 U.S. Dist. LEXIS 22436, at *17.

293. *See Hana*, 735 F.3d at 1164 (“Commercial impression . . . should be resolved by considering a range of evidence, ideally including consumer survey evidence.”); *Adventis*, 2006 U.S. Dist. LEXIS 22436, at *18 n.10 (stating that probative evidence includes “[a]necdotal or more broad-based evidence of consumer perception”); *Reynolds Consumer Prods., Inc. v. Handi-Foil Corp.*, No. 13-cv-214, 2014 U.S. Dist. LEXIS 26932, at *12 n.5 (E.D. Va. Feb. 27, 2014) (referring to a study showing that “the vast majority of target buyers fail to recognize that Reynolds packaging has been modified”). In *Louangel*, the court warned that “an “eyeball” comparison, alone, does not end the inquiry as “the similarity of marks depends on evidence about the perceptions of consumers in the relevant market—considerations which an aural and visual comparison does not necessarily reveal to the full extent necessary.” *Louangel*, 106 U.S.P.Q. at 1813 (internal citation omitted).

294. *See Adventis*, 2006 U.S. Dist. LEXIS 22436, at *18 n.10 (listing the “[i]ntent or purpose of the mark holder” among the varieties of probative evidence). In *Keycorp*, the defendant intended to distance itself from unsavory associations with the savings and loan crisis. This was a significant factor in the court’s determination that dropping SAVINGS & LOAN from the mark *did* change its commercial impression. *KeyCorp. v. Key Bank & Tr.*, 99 F. Supp. 2d 814, 820 (N.D. Oh. 2000); *see also Louangel*, 106 U.S.P.Q.2d at 1814 (finding that the owner of the mark intended changes to communicate a more upscale image).

already firmly established.²⁹⁵ However, it is not clear that the fame of the mark is a factor at all.²⁹⁶

B. *Meaning and Potential Ambiguities*

A jury asked to determine whether a change affected the commercial impression of a mark, or whether, after the change, consumers would regard it as “the same mark,” might well ask for clarification. “Commercial impression,” though a key term, has been only loosely defined. This may be why courts applying the same standard have sometimes reached “apparently inconsistent decisions.”²⁹⁷

As expressed by the Ninth Circuit in *Hana*, “[t]he ‘commercial impression’ of a trademark is the meaning or idea it conveys or the mental reaction it evokes.”²⁹⁸ It can include information about the products with which the mark is associated,²⁹⁹ and ideas unrelated to those products—an example being the connotations evoked by the addition of DUNGEON to the ANDROID trademark in *Specht*.³⁰⁰ Many cases further associate the commercial impression of a mark with its “impact,” apparently referring to the mark’s psychological effects.³⁰¹ The commercial impression of a mark

295. See *Specht v. Google Inc.*, 758 F. Supp. 2d 570, 584 (N.D. Ill. 2010) (“Plaintiffs justifiably do not argue that ANDROID DATA qualifies as a famous mark for which more substantial alterations could possibly maintain a similar commercial impression.”).

296. See *The Wet Seal, Inc. v. FD Mgmt., Inc.*, 82 U.S.P.Q.2d (BNA) 1629, 1636 (T.T.A.B. 2007) (“[T]he fame of ELIZABETH ARDEN, even if proven, would not be a factor in our determination.”).

297. *Fifth Ave. of Long Island Realty Assocs. v. Caruso Mgmt. Co.*, 718 F. Supp. 2d 292, 308 (E.D.N.Y. 2010) (citation omitted).

298. *Hana*, 735 F.3d at 1164 (quoting Gideon Mark & Jacob Jacoby, *Continuing Commercial Impression: Applications and Measurement*, 10 MARQ. INTELL. PROP. L. REV. 433, 434 (2006)); see also *Navistar Int’l Transp. Corp. v. Freightliner Corp.*, 52 U.S.P.Q.2d (BNA) 1074, 1078 n.5 (N.D. Ill. 1998). Curiously, this definition of “commercial impression” as used in tacking cases can be traced back to *Spice Islands, Inc. v. Frank Tea & Spice Co.*, 505 F.2d 1293, 1296 (C.C.P.A. 1974), a case that used “commercial impression” only in the context of deciding whether two competing marks were likely to be confused. See *id.* at 1295–96 (“Of paramount interest is not the descriptive nature of SPICE, but the overall commercial impression derived by viewing the marks in their entirety in determining whether a likelihood of confusion exists.” (footnote omitted)).

299. See *ICON Sols. v. IKON Office Sols.*, No. 97-4178, 1998 U.S. Dist. LEXIS 9101, at *22 (E.D. Pa. June 12, 1998) (suggesting that a trademark’s commercial impression will change if it “provide[s] potential customers with new and different information about the [mark owner’s] products and services.”).

300. See 758 F. Supp. 2d 570, 584 (N.D. Ill. 2010).

301. See *Ilco Corp. v. Ideal Sec. Hardware Corp.*, 527 F.2d 1221, 1224 (C.C.P.A. 1976) (altered mark must “retain its trademark impact and symbolize a single and continuing commercial impression”); *Corp. Fitness Programs, Inc. v. Weider Health and Fitness Inc.*, 2 U.S.P.Q.2d (BNA) 1682, 1687 (P.T.A.B. 1987); *Humble Oil & Ref. Co. v. Sekisui Chem. Co.*, 165 U.S.P.Q. (BNA) 597, 603 (T.T.A.B. 1970); *Jay-Zee, Inc. v. Hartfield-Zodys, Inc.*, 207 U.S.P.Q. (BNA) 269, 271–72 (T.T.A.B. 1980) (finding that the change from THE IMAGE to

includes the “image” it projects,³⁰² and the “emphasis” it conveys.³⁰³ Perhaps even subliminal associations of the kind discussed in *Dreyfus* play a role.³⁰⁴ If so, the nuances of commercial impression may be limitless in their subtlety.

It is reasonable to assume that a trademark owner seldom alters a mark unless it is to change something about its “image” or “impact,” or the information it conveys. Otherwise, why bother? So it comes as no surprise that tacking is allowed “only in rare instances.”³⁰⁵ A few cases introduce some flexibility through qualifying words, saying that what is important for tacking is continuity of the trademark’s “basic, overall commercial impression.”³⁰⁶ Others suggest that very little flexibility is contemplated, and that tacking is permitted only where the original and the altered marks are “virtually identical.”³⁰⁷ *Some* change must be permitted; otherwise there would be no room for tacking at all. What, then, does it mean to change a mark, but in such a way that consumers still consider it the “same mark,” with the same commercial impression?

One answer is to say that tacking is reserved for situations where a consumer would not have noticed the change. This could certainly have been the case in *American Security*, where few customers were likely to remember whether the word BANK had always been a part of the AMERICAN SECURITY BANK

simply IMAGE did not change the “psychological and marketing impact” of the trademark).

302. See *S & L Acquisition Co. v. Helene Arpels, Inc.*, 9 U.S.P.Q.2d (BNA) 1221, 1226 (T.T.A.B. 1987) (tacking requires that an altered mark “project the same image”); *Nat’l Bakers Servs., Inc. v. Hain Pure Food Co.*, 207 U.S.P.Q. (BNA) 701, 707 (T.T.A.B. 1980).

303. See *General Mills, Inc. v. Frito-Lay, Inc.*, 176 U.S.P.Q. (BNA) 148, 153 (T.T.A.B. 1972).

304. See *Dreyfus Fund, Inc. v. Royal Bank of Can.*, 525 F. Supp. 1108, 1115 (S.D.N.Y. 1981).

305. See *supra* note 13 and accompanying text.

306. See, e.g., *Sands, Taylor & Wood Co. v. Quaker Oats Co.*, 978 F.2d 947, 955 (7th Cir. 1992); *Veryfine Prods., Inc. v. Colon Bros., Inc.*, 799 F. Supp. 240, 255 (D.P.R. 1992). In *Laura Scudder’s*, the court found that the BLUE BIRD and BLUE ROBIN marks conveyed “substantially the same general impression.” *Laura Scudder’s v. Pac. Gamble Robinson Co.*, 136 U.S.P.Q. (BNA) 418, 419 (T.T.A.B. 1962). Other cases have introduced similar qualifying language with respect to whether the mark, after the change, was still “the same mark.” See, e.g., *Hana Fin., Inc. v. Hana Bank*, 735 F.3d 1158, 1160 (9th Cir. 2013) (tacking is allowed “where the two marks are so similar that consumers would *generally* regard them as being the same” (emphasis added)); *Brookfield Commc’ns, Inc. v. W. Coast Entm’t Corp.*, 174 F.3d 1036, 1048 (9th Cir. 1999). (tacking is allowed where consumers would regard the marks as “*essentially* the same” (emphasis added)).

307. *One Indus., LLC v. Jim O’Neal Distrib., Inc.*, 578 F.3d 1154, 1161 (9th Cir. 2009); *ICON Sols. v. IKON Office Sols.*, No. 97-4178, 1998 U.S. Dist. LEXIS 9101, at *20 (E.D. Pa. June 12, 1998); *Louangel, Inc. v. Darden Rests., Inc.*, 106 U.S.P.Q.2d (BNA) 1809, 1813 (S.D. Tex. 2013).

trademark,³⁰⁸ or *Hess's*, where consumers may not have noticed that HESS had assumed the possessive form.³⁰⁹ A change that no one notices cannot alter the trademark's meaning or impact, unless the effect is indeed subliminal. A number of tacking cases have discussed whether a change would have been perceived. In *KeyCorp*, the court rejected as "somewhat disingenuous" the claim that consumers would not have noticed the replacement of SAVINGS & LOAN.³¹⁰ In *Reynolds*, the survey evidence showed that "the vast majority of target buyers" would not have realized that designs on the aluminum foil packaging had changed.³¹¹

The smallest alteration in a trademark could, of course, be made plain to a juror. The question is whether a consumer in the marketplace, who likely would not see the marks side-by-side for comparison, would have noticed a difference amid the usual distractions of life. Moreover, just as likelihood of confusion cannot rest solely on the perceptions of "the careful and scrupulous shopper,"³¹² but instead must consider the "ordinary consumer using ordinary care under ordinary buying conditions,"³¹³ tacking should rely on the perspective of the more casual observer.³¹⁴ As the court observed in *Dreyfus*: "advertising and trademarks rely on impressions. The consumer does not memorize the mark. He has a feeling about it from past exposure."³¹⁵ A change that would be revealed only by "careful inspection,"³¹⁶ or through a "painstakingly careful comparison,"³¹⁷ should not, and does not, stand in the way of tacking.

One objection to *unnoticeability* as the standard for tacking is that courts must have something else in mind or they would not have missed so many opportunities to make the standard clearer than it is. Another is that even if unnoticeable changes allow tacking, it does not follow that every noticeable change forbids it. In other words, it is possible that a change *would* be noticed, but that it would not alter the commercial impression of the mark or

308. See *Am. Sec. Bank v. Am. Sec. Co.*, 190 U.S.P.Q. (BNA) 271, 272 (T.T.A.B. 1976).

309. See *Hess's of Allentown, Inc. v. Nat'l Bellas Hess, Inc.*, 169 U.S.P.Q. (BNA) 673, 677 (T.T.A.B. 1971).

310. *KeyCorp. v. Key Bank & Tr.*, 99 F. Supp. 2d 814, 820 (N.D. Oh. 2000).

311. *Reynolds Consumer Prods., Inc. v. Handi-Foil Corp.*, No. 13-cv-214, 2014 U.S. Dist. LEXIS 26932, at *12 n.5 (E.D. Va. Feb. 27, 2014).

312. *Fotomat Corp. v. Cochran*, 437 F. Supp. 1231, 1244 (D. Kan. 1977).

313. *Id.*

314. See *Morehouse Mfg. Corp. v. J Strickland & Co.*, 407 F.2d 881, 887 (C.C.P.A. 1969) ("[A] casual observer might well say it was the identical mark.").

315. *Dreyfus Fund, Inc. v. Royal Bank of Can.*, 525 F. Supp. 1108, 1123 (S.D.N.Y. 1981).

316. *Morehouse*, 407 F.2d at 884.

317. *Veryfine Prods., Inc. v. Colon Bros., Inc.*, 799 F. Supp. 240, 255 (D.P.R. 1992).

prevent consumers from continuing to regard the mark as the same.³¹⁸ If “commercial impression” includes every one of the subtle mental reactions stimulated by a trademark, this situation may be an impossibility. On the other hand, tacking is likely to happen often if one looks only at changes to the mark that affect consumer impressions about *source or product characteristics*. For example, a previously black-and-white logo could be replaced by an otherwise identical but brightly-colored logo. The change could well be noticed, and it could even affect the “impact” of the mark in a general sense, but it would not likely alter consumer perceptions of brand origin or communicate any new information about the product.

Whether such a limited focus is proper is uncertain. *Brookfield* refers to preserving the “identificatory function”³¹⁹ of the mark, suggesting an emphasis on continuity of information about brand origin or product characteristics. In *Hana*, the Ninth Circuit speculated that the terms OVERSEAS KOREAN CLUB and WORLD CENTER would have told consumers nothing they did not already know about the source of the banking services or their nature.³²⁰ In *American Security*, the court noted that the addition of BANK added nothing to the origin-indicating significance of mark,³²¹ and many tacking cases refer to continuity of the “distinctive character” of the mark, suggesting that one is interested in the attributes that help to distinguish one brand or type of product from another.³²² However, the court in *Spice*

318. Some cases suggest that tacking is permitted where the original mark and the altered mark “would be recognized as one and the same.” See, e.g., *Gulf States Paper Corp. v. E-Z Por Corp.*, 171 U.S.P.Q. (BNA) 566, 569 (T.T.A.B. 1971); *Hess’s of Allentown, Inc. v. Nat’l Bellas Hess, Inc.*, 169 U.S.P.Q. (BNA) 673, 677 (T.T.A.B. 1971). This language does not suggest that the change would be unnoticed, but rather that continuity would be perceived in spite of the change.

319. *Brookfield Commc’ns, Inc. v. W. Coast Entm’t Corp.*, 174 F.3d 1036, 1048 (9th Cir. 1999).

320. *Hana Fin., Inc. v. Hana Bank*, 735 F.3d 1158, 1167 (9th Cir. 2013).

321. See *Am. Sec. Bank v. Am. Sec. and Tr. Co.*, 571 F.2d 564, 567 (C.C.P.A. 1978) (“[T]he word ‘bank’ is purely descriptive and adds nothing to the origin-indicating significance of AMERICAN SECURITY.”).

322. See, e.g., *Ilco Corp. v. Ideal Sec. Hardware Corp.*, 527 F.2d 1221, 1224 (C.C.P.A. 1976) (“[A] change which does not alter [the mark’s] distinctive characteristics represents a continuity of trademark rights.” (quoting *Humble Oil & Ref. Co. v. Sekisui Chem. Co.*, 165 U.S.P.Q. (BNA) 597, 603 (T.T.A.B. 1970))); *Louangel, Inc. v. Darden Rests., Inc.*, 106 U.S.P.Q.2d (BNA) 1809, 1815 (S.D. Tex. 2013); *Corp. Fitness Programs, Inc. v. Weider Health and Fitness, Inc.*, 2 U.S.P.Q.2d (BNA) 1682, 1687 (P.T.A.B. 1987); *Feed Flavors, Inc. v. Kemin Indus., Inc.*, 214 U.S.P.Q. (BNA) 360, 363 (T.T.A.B. 1982). In *Jay-Zee, Inc. v. Hartfield-Zody’s, Inc.*, 207 U.S.P.Q. (BNA) 269, 271 (T.T.A.B. 1980), the Board noted that the changed outline “contribute[d] little, if anything, to the origin-indicating utility of [the] mark,” and the change “[did] not affect the continuity of commercial impression of the distinctive elements of [the] mark.” In an unpublished opinion, the Ninth Circuit remarked

Islands warned that “[a]rguments to the effect that one portion of a mark possesses no trademark significance leading to direct comparison between only what remains is an erroneous approach.”³²³ In *Wet Seal*, the court observed that a word like BEAUTY, which has little trademark significance on its own in the field of cosmetics, “nonetheless contributes to the overall commercial impression”³²⁴ Moreover, many cases find marks too dissimilar for tacking where the differences seem to have nothing to do with identifying brand origin or product characteristics. Examples include the design alterations discussed in *One Indus.*,³²⁵ and the shortening of the slogan in *Van Dyne-Crotty*.³²⁶

C. A Policy Perspective

If there is ambiguity in the current standard, it may be helpful to consider the policies that account for the existence of the tacking doctrine. In *Hana*, the Ninth Circuit called the reasons for tacking “compelling.”³²⁷ Courts have observed that trademarks may need to change to keep up with marketing innovations and evolving tastes.³²⁸ Trademark owners would hesitate to make such changes if it meant putting their investments in jeopardy. Because of the tacking doctrine, a trademark owner can make a small change in the mark without risking giving up seniority, and the rights that come with it, to a junior user.³²⁹ This should lead to

that “courts have upheld tacking claims where additional words in one mark do not help identify the origin of the goods.” *HGI Mktg. Servs. v. PepsiCo, Inc.*, Nos. 93-55968, 93-56370, 1995 U.S. App. LEXIS 4532, at *5 (9th Cir. 1995).

323. *Spice Islands, Inc. v. Frank Tea & Spice Co.*, 505 F.2d 1293, 1295 (C.C.P.A. 1974).

324. *The Wet Seal, Inc. v. FD Mgmt., Inc.*, 82 U.S.P.Q.2d (BNA) 1629, 1636 (T.T.A.B. 2007).

325. *See One Indus., LLC v. Jim O’Neal Distrib., Inc.*, 578 F.3d 1154, 1162 (9th Cir. 2009).

326. *See Van Dyne-Crotty, Inc. v. Wear-Guard Corp.*, 926 F.2d 1156, 1160 (Fed. Cir. 1991).

327. *Hana Fin., Inc. v. Hana Bank*, 735 F.3d 1158, 1168 (9th Cir. 2013).

328. The court in *VeryFine* refers to “the dynamic, changing nature of trademarks in commerce” *Veryfine Prods., Inc. v. Colon Bros., Inc.*, 799 F. Supp. 240, 255 (D.P.R. 1992). Trademarks, the court observed, “do not exist in a static environment;” they are “constantly affected by changing social conditions” *Id.* A website calling itself Brand New documents countless updates, large and small, in the trademarks used by a wide variety of firms. BRANDNEW, <http://www.underconsideration.com/brandnew> [https://perma.cc/U4YF-MXPW].

329. *See Hana*, 735 F.3d at 1164 (“[W]ithout tacking, a trademark owner’s priority in his mark would be reduced each time he made the slightest alteration to the mark, which would discourage him from altering the mark in response to changing consumer preferences, evolving aesthetic developments, or new advertising and marketing styles.” (quoting *Brookfield Commc’ns, Inc. v. W. Coast Entm’t Corp.*, 174 F.3d 1036, 1048 (9th Cir. 1999))); *Levi Strauss & Co. v. GTFM, Inc.*, 196 F. Supp. 2d 971, 984 (N.D. Cal. 2002). As the court said in *Adventis, Inc. v. Consol. Prop. Holdings, Inc.*, “the tacking doctrine should

more vigorous competition among businesses and brands better suited to the times.

In *Sunstar*, Judge Posner recognized the need for trademark owners to conform their marketing to “unpredictable fluctuations in consumer response.”³³⁰ He imagined a hypothetically trademarked phrase “First Aid for His Thirst,” adopted when male pronouns were used indiscriminately to refer to both genders.³³¹ “As language conventions evolved,” the user of the trademark might think it “essential” to substitute “First Aid for *Your* Thirst.”³³² He noted that “stubbornly clinging to a dowdy, old-fashioned, ‘un-modernized’ original mark” might pose an “acute danger” of devaluing the brand.³³³ Yet without the protections of tacking, modifying a mark to keep up with changing needs would pose acute dangers of its own, particularly if the trademark owner could not be sure whether there were intervening users of similar marks who could now claim priority.

Louangel provides an actual example of an evolving brand identity. The Longhorn Steaks restaurant chain remodeled their facilities to replace their “roadhouse styling” with something offering “a more upscale image.”³³⁴ They installed “warmer, golden-toned lighting” in place of neon, they substituted “earth-tone fabrics” for red vinyl tablecloths, and they removed examples of the taxidermist’s art.³³⁵ They “reimaged” the menu, the china, and the uniforms worn by the staff.³³⁶ It was all part of an effort to “evol[ve] the brand” and “keep it competitive” by appealing to a broad range of customers “from high chairs to wheel chairs.”³³⁷ Replacing the old logo and its cartoon cow “Bongo” with a classier “minimalist” logo was a part of that evolution.³³⁸ In this case, the court found that the changes to the logo went too far to permit tacking.³³⁹

The Longhorn Steaks transformation recalls well-publicized changes to the Ruby Tuesday restaurant chain.³⁴⁰ In a similar

be allowed so that a trademark holder’s rights are not thwarted by every minuscule change or variation in a mark that continues to convey the same impression.” 2006 U.S. Dist. LEXIS 22436, at *13.

330. *Sunstar, Inc. v. Alberto-Culver Co.*, 586 F.3d 487, 496 (7th Cir. 2009).

331. *Id.*

332. *Id.*

333. *Id.* at 497.

334. *Louangel, Inc. v. Darden Rests., Inc.*, 106 U.S.P.Q.2d (BNA) 1809, 1814 (S.D. Tex. 2013).

335. *Id.*

336. *Id.*

337. *Id.*

338. *Id.*

339. *Id.* at 1815.

340. See David Segal, *At Ruby Tuesday, Casual Dining Dons a Blazer*, N.Y. TIMES

effort to go upscale, the owners upgraded their menu, their staff uniforms, and their décor (formerly dominated by “rummage-sale bric-a-brac”).³⁴¹ As observed in a New York Times article, “[t]he trick [was] for the company to elevate its image without alienating those customers who actually liked the dowdier original.”³⁴² The owners dropped “Bar and Grill” from the Ruby Tuesday name,³⁴³ and they adopted a new logo.³⁴⁴ The new version retains the Ruby Tuesday name and the “Ruby” portion appears in the same shade of burgundy red. But now “Ruby” and “Tuesday” appear together on one line (without a separating space), “Tuesday” is black instead of red, “Simple Fresh American Cuisine” has been added in small type, and the font is sleeker and more modern, omitting the gaudy “bric-a-brac” embellishments of the original.

Up to a point, the tacking doctrine allows firms to modify their trademarks to reflect changes in their businesses. The altered mark itself may contribute something to the consumer’s experience;³⁴⁵ at the very least, it provides a more accurate impression of what the consumer should expect. It would have sent mixed signals indeed for Ruby Tuesday to have transformed its restaurants but retained its garish logo. To the extent that it means better information for customers and makes businesses more responsive to market demands, the tacking doctrine is a boon to consumers. It also helps consumers in the manner of trademark laws in general—by reducing the likelihood of confusion and the costs of deciding what to purchase.³⁴⁶ If a trademark carried an established reputation but a slight modification meant the loss of rights to a junior user, consumers could easily be misled.³⁴⁷

(Nov. 7, 2009), http://www.nytimes.com/2009/11/08/business/08ruby.html?rref=collection%2Ftimestopic%2FRuby%20Tuesday%20Inc.&action=click&contentCollection=business®ion=stream&module=stream_unit&version=latest&contentPlacement=2&pgtype=collection [<https://perma.cc/L9PS-V4QQ>].

341. *Id.*

342. *Id.*

343. *Id.*

344. For reproduction of the logos, see the *Brand New* website archive. *A Fresh Identity Tue Impress*, BRAND NEW (Nov. 12, 2007), http://www.underconsideration.com/brandnew/archives/a_fresh_identity_tue_impress.php [<https://perma.cc/M8C4-4YNW>].

345. See Alan L. Durham, *Trademarks and the Landscape of Imagination*, 79 TEMP. L. REV. 1181, 1208–18 (2006) (discussing the effect of associative marketing and evocative trademarks on the value of consumer goods).

346. See *Hana Fin., Inc. v. Hana Bank*, 735 F.3d 1158, 1164 (9th Cir. 2013) (“Giving the trademark owner the same rights in the new mark as he has in the old helps to protect source-identifying trademarks from appropriation by competitors and thus furthers the trademark law’s objective of reducing the costs that customers incur in shopping and making purchasing decisions.” (quoting *Brookfield Commc’ns, Inc. v. W. Coast Entm’t Corp.*, 174 F.3d 1036, 1048 (9th Cir. 1999))).

347. See *id.* at 1168 (tacking exists “to protect consumers from being misled about the source of products and facilitate their purchasing decisions”).

Imagine what might have happened if a restaurant calling itself Ruby Thursday had opened just before the Ruby Tuesday transformation and a court did not allow tacking.

The reasons for tacking do seem compelling and courts have acknowledged them often, so one must ask why tacking is allowed only under “exceptionally narrow’ circumstances.”³⁴⁸ What are the dangers to be feared from too liberal an application of the tacking doctrine? Here courts are silent. While they often say that tacking is rarely permitted,³⁴⁹ this conclusion is supported by recitations of precedent, not by discussions of policy. It may be that tacking is severely limited because it is a departure from the “cardinal principle” of trademark law that rights must go to the senior user of the mark.³⁵⁰ Courts may also see disadvantages in allowing trademarks to be changeable “moving targets” that could hinder the actions of potential competitors. Firms adopting new trademarks are said to have a responsibility to avoid confusion with existing marks³⁵¹—a responsibility enforced by resolving issues of confusion against the junior user. That responsibility would be difficult to fulfill if the commercial impressions of existing trademarks could change in unpredictable ways.

Nevertheless, if courts are motivated by the interests of consumers, the restrictive manner in which they currently apply the tacking doctrine seems deeply flawed, and not merely by discouraging businesses from keeping up with changing demand. Consumers benefit from trademarks, and trademark laws, when they facilitate the flow of useful information about products and their source. However, when a trademark owner alters a mark to provide consumers with more information than before, or more accurate information, that in itself changes the commercial impression of the mark and leaves the owner vulnerable to the loss

348. *Hana*, 735 F.3d at 1160 (quoting *Brookfield*, 174 F.3d at 1047).

349. *See, e.g., Van Dyne-Crotty, Inc. v. Wear Guard Corp.*, 926 F.2d 1156, 1160 (Fed. Cir. 1991).

350. *One Indus., LLC v. Jim O’Neal Distrib., Inc.*, 578 F.3d 1154, 1158 (9th Cir. 2009).

351. *See D&J Master Clean, Inc. v. Servicemaster Co.*, 181 F. Supp. 2d 821, 826 (S.D. Oh. 2002) (“It is the second user’s responsibility to avoid confusion in its choice of a trademark . . .”); *Polo Fashions, Inc. v. Extra Special Prods., Inc.*, 451 F. Supp. 555, 562 (S.D.N.Y. 1978) (“Much of the foregoing would be irrelevant but for defendants’ status as a ‘second comer’ to the market with its consequent responsibility to avoid confusion.”); *Fotomat Corp. v. Cochran*, 437 F. Supp. 1231, 1242–43 (D. Kan. 1977) (finding that a defendant who adopted a confusingly similar design proceeded “at his own peril”). On the other hand, while a firm adopting a new trademark can search for previously-used marks that might be confusingly similar, it can never be certain that such marks will not eventually come to light. *See Hana*, 735 F.3d at 1167.

of its trademark rights.³⁵² It is difficult to see how this benefits trademark owner or consumers.

Consider the situation in *American Paging*. A company that had used the name AMERICAN MOBILPHONE introduced a new mark, AMERICAN MOBILPHONE PAGING, to convey to consumers that it offered both mobile phone and paging services.³⁵³ Consistent design elements, as well as the words AMERICAN MOBILPHONE, would have told customers of the mobile phone services that paging services were offered by the same firm.³⁵⁴ Such information could be valuable to the public. However, because the addition of PAGING “conveyed more information to potential customers,” the marks carried different commercial impressions and could not be tacked.³⁵⁵ A mark that is “more informative” is, in relation to the tacking doctrine, “legally different.”³⁵⁶

The consequences in *American Paging* may have been limited because the trademark owner continued to use its former mark.³⁵⁷ But one can easily imagine a situation where a company changes its product to meet new demand, adds something to its trademark to convey useful information about the change, retains elements of the original mark to convey continuity of source, and otherwise abandons its use of the now outdated original. Let us imagine, for example, that a restaurant using the trademark TEXAS CHUCKWAGON adopted a purely vegetarian menu to accommodate changing tastes, it

352. See *The Wet Seal, Inc. v. FD Mgmt., Inc.*, 82 U.S.P.Q.2d (BNA) 1629, 1637 (T.T.A.B. 2007) (A mark that “imparts additional information” does not convey the same commercial impression.); *ICON Sols. v. IKON Office Sols.*, No. 97-4178, 1998 U.S. Dist. LEXIS 9101, at *21 (E.D. Pa. June 12, 1998) (“[D]ecisions have . . . limited [tacking] to situations where the additional term adds no new information for potential consumers.”); *Fifth Ave. of Long Island Realty Assocs. v. Caruso Mgmt. Co.*, 718 F. Supp. 2d 292, 310 (E.D.N.Y. 2010) (explaining that the addition of a specific geographic identifier “necessarily creates a new impression”). Some cases have allowed tacking because the changes to the mark *did not* alter the information provided to consumers. See, e.g., *Hana*, 735 F.3d at 1167 (finding that altered portions of the mark “merely conveyed what the ordinary purchasers would already have surmised”); *Am. Sec. Bank v. Am. Sec. and Tr. Co.*, 571 F.2d 564, 567 (C.C.P.A. 1978) (indicating that the addition of BANK did not prevent tacking where customers already knew they were dealing with a bank).

353. See 13 U.S.P.Q.2d (BNA) 2036, 2038 (T.T.A.B. 1989). “Customers who simply saw the mark AMERICAN MOBILPHONE and design and who simply utilized registrant’s mobile phone services, would not know they were dealing with a company that also rendered paging services.” *Id.* at 2039.

354. The court “recognize[d] that visually registrant’s two marks are quite similar.” *Id.* at 2039. Both marks were “dominated by the word AMERICAN and the same star and double bar design,” and in each case “[t]he words MOBILPHONE and MOBILPHONE PAGING [were] . . . depicted in subordinate fashion.” *Id.*

355. *Id.*

356. *Id.*

357. *Id.* at 2038.

substituted the more informative mark TEXAS CHUCKWAGON FRESH/VEGAN, and it abandoned TEXAS CHUCKWAGON alone because it no longer conveyed an accurate impression. Adding FRESH/VEGAN provides new and useful information, while retaining TEXAS CHUCKWAGON accurately conveys continuity of source. Further imagine that shortly before the change, another restaurant opened calling itself TEX'S CHUCKWAGON. If the first restaurant had an established reputation, consumers who patronized the second might do so under a false impression. Nevertheless, the first restaurant could be vulnerable in a suit for trademark infringement, simply because it had adapted its mark to be "more in accord with the facts and the times."³⁵⁸

IV. AN ALTERNATIVE APPROACH

The likelihood of confusion standard that governs infringement has an obvious connection to the paramount goal of trademark law—to prevent such confusion. The same commercial impression standard of tacking has no obvious connection to any policy objective. Courts often say that the standard for tacking is not likelihood of confusion,³⁵⁹ and it is plain that it should not be if tacking merely involves the comparison of an original mark to a revised mark. Whether consumers would "confuse" those marks is a non sequitur. But if one were devising a standard for tacking based on the interests of consumers, the potential for confusing either mark *with the intervening mark* could play a role.

For the moment, let us limit ourselves to the paradigmatic three-mark situation. A firm replaces MARK(A) with MARK(C), and in the meantime another firm begins using MARK(B). MARK(B) and MARK(C) cannot co-exist due to a likelihood of confusion. The first firm sues the second for trademark infringement. Both firms assert priority—the defendant because it used MARK(B) before MARK(C), the plaintiff because it claims it can tack on its earlier use of MARK(A). A court would ask a jury to determine whether MARK(A) and MARK(C) convey the same commercial impression, so that consumers would consider them "the same mark." Perhaps a court should, instead, ask the jury to compare both MARK(A) and MARK(C) to MARK(B), and determine whether the confusion that now exists was or was not caused by the change.³⁶⁰ The jury instruction might be expressed as follows:

358. *Beech-Nut Packing Co. v. P. Lorillard Co.*, 299 F. 834, 838 (D.N.J. 1924).

359. *See supra* notes 21–27 and accompanying text.

360. In *Brookfield*, the Ninth Circuit seemed close to adopting this approach, even though the opinion includes the "same commercial impression" tacking standard found in most cases. *Brookfield Commc'ns, Inc. v. W. Coast Entm't Corp.*, 174 F.3d 1036, 1048 (9th

Changes to plaintiff's mark that occurred after defendant's adoption of the mark accused of infringement shall not affect plaintiff's status as the senior user, unless the likelihood of confusion between the marks would not otherwise have occurred.

If we return to the TEXAS CHUCKWAGON FRESH/VEGAN hypothetical, it is obvious that any confusion between this mark and TEX'S CHUCKWAGON is not because of the addition of the term FRESH/VEGAN to the former. The confusion arose when TEX'S CHUCKWAGON began doing business under that mark. If it had been sued immediately, it would have lost. The outcome should not be different because, fortuitously, the original TEXAS CHUCKWAGON updated its mark to give consumers information about its revised menu—information that may change the commercial impression of the mark but that is unrelated to the confusion. On the other hand, if the defendant used the name TEXAS KITCHEN FRESH/VEGAN the outcome would likely be different. TEXAS KITCHEN FRESH/VEGAN might be confused with TEXAS CHUCKWAGON FRESH/VEGAN, but *not* with the original TEXAS CHUCKWAGON alone. If that is the case, the change itself is the source of the confusion. Here it would be the original restaurant that failed in its responsibility to avoid choosing a (revised) mark that would cause confusion with other marks already in use.³⁶¹ The injury to consumers is traceable to its actions, not to those of the intervener.³⁶²

Cir. 1999). The court referred to *J. Wiss & Sons v. W.E. Basset & Co.*, 462 F.2d 567 (C.C.P.A. 1972), a case involving a “three-competing-trademark situation.” *Brookfield*, 174 F.3d at 1049. One company switched from QUICK-TRIM to TRIMLINE, and the other company, in the meantime, adopted TRIM alone. TRIM was confusingly similar to TRIMLINE, but not to the earlier QUICK-TRIM. *Id.* The court awarded priority to the intervening mark, concluding that “priority depended on which of the two confusingly similar marks was used first—disregarding the first use date of the earlier used mark since it was not confusingly similar with the others.” *Id.* The Ninth Circuit faced a similar situation in *Brookfield* and also awarded priority to the intervening mark. *Id.* The language quoted above suggests that if the intervening mark *had* been confusingly similar to the first mark, priority would have been decided differently because *the changes did not cause the confusion*. The catch is that the earlier marks in *J. Wiss* and in *Brookfield* were still in use, so a case of infringement based on the earlier mark would not have required tacking. The proposal offered here would permit tacking where the earlier version of the mark had been abandoned.

361. See *supra* note 351 and accompanying text.

362. There may be cases where confusion would also have existed before the mark was revised, but for different reasons. Suppose that a firm used the trademark FLYING MONKEY for its hot sauce, then replaced it with WILD HORSE. In the meantime, another hot sauce manufacturer adopted the name FLYING HORSE. FLYING HORSE might have been confused with FLYING MONKEY, and FLYING HORSE might now be confused with WILD HORSE, but the current confusion, based on the common term HORSE, is unrelated to the former confusion, based on the common term FLYING. Although each firm is guilty of causing confusion, the source of the current problem is the firm that most recently began using HORSE. In such a case, tacking would not be permitted. See *id.*

One objection to this approach is that the question of confusion must be addressed before, or in conjunction with, the question of seniority, meaning that cases could not be disposed of quickly by considering only the latter. The likelihood of confusion test does require consideration of a variety of factors and, potentially, a wide range of evidence.³⁶³ One response is that if the “same commercial impression” is a question of fact for the jury, as the Supreme Court has determined that it is,³⁶⁴ it also demands consideration of a broad range of evidence.³⁶⁵ In fact, consumer surveys may be even more necessary here than they are to determine a likelihood of confusion.³⁶⁶ Another response is that in many cases courts already address confusion in addition to seniority.³⁶⁷ A more serious objection to this approach is that it requires the fact finder to consider a hypothetical situation—whether confusion would still have been likely if the mark had not changed. Survey evidence might be needed to supply the answer.

A variation would be to ask not whether confusion would have occurred if the mark had not changed, but whether the change actually contributed to the confusion. A jury instruction for this version might be expressed as follows:

Changes to plaintiff's trademark that occurred after defendant's adoption of the mark accused of infringement shall not affect plaintiff's status as the senior user unless the changes contributed to the likelihood of confusion between the marks.

Here tacking would not be permitted if the change made the marks more similar, even if they might have been similar enough already to cause confusion. Suppose we revise the events in the earlier hypothetical so that a restaurant originally calling itself

363. See *supra* notes 21–27 and accompanying text.

364. *Hana Fin., Inc. v. Hana Bank*, 135 S. Ct. 907, 911 (2015).

365. See *Hana Fin., Inc. v. Hana Bank*, 735 F.3d 1158, 1164 (9th Cir. 2013) (“Commercial impression . . . should be resolved by considering a range of evidence, ideally including consumer survey evidence.”).

366. See *Navistar Int'l Trans. Corp. v. Freightliner Corp.*, 52 U.S.P.Q.2d (BNA) 1074, 1079–80 (N.D. Ill. 1998) (“[I]t is irrelevant that the ‘likelihood of confusion’ test for infringement does not require consumer perception evidence.” The “same commercial impression” standard of tacking, being a “far higher” standard, can “require a more substantial evidentiary showing than infringement.”).

367. See, e.g., *Nat'l Bakers Servs., Inc. v. Hain Pure Food Co.*, 207 U.S.P.Q. (BNA) 701, 707 (T.T.A.B. 1980); *Permatex Co. v. Cal. Tube Prods.*, 175 U.S.P.Q. (BNA) 764, 767 (T.T.A.B. 1972); *John Winkler's Sons, Inc. v. Am. Express Co.*, 175 U.S.P.Q. (BNA) 442, 445 (T.T.A.B. 1972); *Gulf States Paper Corp. v. E-Z Por Corp.*, 171 U.S.P.Q. (BNA) 566, 569, 579 (T.T.A.B. 1971); *Hess's of Allentown, Inc. v. Nat'l Bellas Hess, Inc.*, 169 U.S.P.Q. (BNA) 673, 677–78 (T.T.A.B. 1971); *Humble Oil & Ref. Co. v. Sekisui Chem. Co.*, 165 U.S.P.Q. (BNA) 597, 606 (T.T.A.B. 1970); *Laura Scudder's v. Pac. Gamble Robinson Co.*, 136 U.S.P.Q. (BNA) 418, 420 (T.T.A.B. 1962).

TEXAS CHUCKWAGON BUFFET changed its name to TEXAS CHUCKWAGON CAFÉ in a move to go more upscale. Prior to the change, another restaurant adopted the name TEXAS COVERED WAGON CAFÉ. This trademark might be confusingly similar to TEXAS CHUCKWAGON BUFFET or TEXAS CHUCKWAGON CAFÉ, but it is *more* confusingly similar to the latter. When the first restaurant changed its name, it created a greater potential for confusion than already existed, perhaps failing in its responsibilities as much as the other restaurant did when it started using its name. On the other hand, if the change had been the reverse—from TEXAS CHUCKWAGON CAFÉ to TEXAS CHUCKWAGON BUFFET—then tacking would be allowed (whether the “commercial impression” had changed or not), because the marks were even closer before. This approach has the advantage of being relatively easy to apply. In many cases, a court could determine, as a matter of law and merely by comparing the marks themselves, that the change in the trademark made it more or less similar to that of the intervener.

Either variant would be firmly linked to the avoidance of confusion—the concern that animates trademark law as a whole. Neither would penalize firms simply for providing better information to consumers, and neither would allow latecomers to take advantage of trademark changes that have nothing to do with the confusion for which they alone are responsible.

If tacking were based on a continuity of confusion rather than a continuity of commercial impression, many cases would have the same outcome. An alteration that does nothing to change the commercial impression of the mark cannot contribute to its potential to be confused with another mark. Hence, wherever tacking has been permitted applying the current standard it should also be permitted applying the proposed standard.³⁶⁸ In many cases where tacking was *not* permitted because alterations to the mark changed its commercial impression, the same alterations are likely to have contributed to confusion with the intervening mark. In *ICON Solutions*, for example, the change from IKON CORPORATION to IKON OFFICE SOLUTIONS not only meant a “very different connotation,”³⁶⁹ it also meant a much

368. *D&J Master Clean, Inc. v. Servicemaster Co.*, 181 F. Supp. 2d 821 (S.D. Oh. 2002), may be a case where tacking should not have been permitted under either standard. The change from “ServiceMASTER” to “ServiceMASTER Clean” provided additional information about the services offered, and therefore, according to the usual standards, altered the commercial impression of the mark. *See* 181 F. Supp. 2d at 825. It also made the mark more likely to be confused with the intervening mark, “Master Clean.” *Id.*

369. *ICON Sols. v. IKON Office Sols.*, No. 97-4178, 1998 U.S. Dist. LEXIS 9101, at *22 (E.D. Pa. June 12, 1998).

greater likelihood of confusion with the intervening mark, ICON SOLUTIONS. In *American Paging* as well, the change from AMERICAN MOBILPHONE to AMERICAN MOBILPHONE PAGING increased the potential for confusion with the rival AMERICAN PAGING mark.³⁷⁰ But in some cases tacking might have been permitted under the proposed standard when it was not permitted under the prevailing standard. In *KeyCorp*, for example, the change from KEY FEDERAL SAVINGS BANK to KEY BANK & TRUST may have contributed nothing to the potential for confusion with KEYBANK.³⁷¹ In *Van Dyne-Crotty*, the marks CLOTHES THAT WORK and CLOTHES THAT WORK FOR THE WORK YOU DO may (or may not) have been equally likely to be confused with CLOTHES THAT WORK HARD.³⁷²

As discussed in Part II.F, the same tacking standard is currently applied in a wide variety of contexts. In some of these, there is no intervening mark with which to compare the earlier and later versions of the altered mark. Here the exacting “same commercial impression” standard may be desirable because the changes in the mark must be considered in the abstract, not in the context of any particular contest for priority. For example, if the issue is whether a prior registration is sufficient to demonstrate whether a similar mark has acquired secondary meaning,³⁷³ it is sensible to compare the two marks and see whether the message contributed by the registered mark (brand origin) would be the same message communicated by the revised mark. The impulse to apply the same tacking standard in all contexts may be partly responsible for missed opportunities in the three-trademark situation, where one can examine the impact of the revisions in terms of their contribution to any potential confusion.

370. See *Am. Paging, Inc. v. Am. Mobilphone, Inc.*, 13 U.S.P.Q.2d (BNA) 2036, 2037 (T.T.A.B. 1989). The standard proposed here would not have changed the tacking permitted in *Laura Scudder’s*, but it would have made the result more defensible. BLUE BIRD and BLUE ROBIN seem to have very different commercial impressions. Judge Rich might have called the latter an “irritating” trademark – one that stands out because consumers do not expect robins to come in blue. See *Vornado, Inc. v. Breuer Elec. Mfg. Co.*, 390 F.2d 724, 862 n.1 (C.C.P.A. 1968) (Rich, J., dissenting) (calling VORNADO an “irritating” mark because it is similar, but not identical to, the commonly-encountered word “tornado”). On the other hand, the earlier BLUE BIRD mark was closer than BLUE ROBIN to the intervening BLUE BIRD mark, so if there was confusion after the change it would have been even worse had no changes occurred. The change to BLUE ROBIN, in other words, was not responsible for the confusion.

371. See *KeyCorp. v. Key Bank & Tr.*, 99 F. Supp. 2d 814, 816 (N.D. Oh. 2000).

372. See 926 F.2d 1156, 1156.

373. See *supra* note 264 and accompanying text.

IV. CONCLUSION

Momentum is undoubtedly on the side of the current approach to tacking. The “same commercial impression” standard has been repeated countless times without criticism, and courts seem to look for new ways to express how infrequently tacking should be permitted. On the other hand, the current standard has no basis in the Trademark Act or in Supreme Court precedent.³⁷⁴ Perhaps, following *Hana*, the Supreme Court could be persuaded to take a closer look at the substance of tacking, and not merely the mechanism for applying it. If it were to consider the fundamental goals of trademark law—assuring accurate and useful information for consumers, and protecting the investments of trademark owners in their brands—the court might find the standard of tacking to be due for reconsideration, with an expanded role for the impact of trademark revisions on the potential for confusion.

³⁷⁴. In *Hana* the parties did not dispute the applicability of the “same commercial impression” standard. *Hana Fin., Inc. v. Hana Bank*, 135 S. Ct. 907, 910 n.1 (2015).