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**LOST IN TRANSLATION:
A CRITICAL EXAMINATION OF CONFLICTING
DECISIONS APPLYING THE DOCTRINE OF
FOREIGN EQUIVALENTS***

*By Elizabeth J. Rest***

I. INTRODUCTION

The doctrine of foreign equivalents provides a guideline under which trademarks and service marks are analyzed when they contain a foreign word or words.¹ The policy behind the doctrine is one of international comity. Because United States companies would be crippled in international trade if foreign countries granted trademark protection to generic or merely descriptive English words, the United States reciprocates and refuses trademark protection to words that, once translated into English, are generic or merely descriptive of the goods to which they apply.² However, as the doctrine is only a guideline, and not a stringent rule, courts in different jurisdictions, including the former United States Court of Customs and Patent Appeals (CCPA),³ have reached irreconcilable holdings when deciding cases by applying the doctrine. Even a leading case from the U.S. Court of Appeals for the Federal Circuit has noted that the Trademark Trial and Appeals Board (TTAB)⁴ is "inconsistent in its application of the

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1. See, e.g., *In re Pan Tex Hotel Corp.*, 190 U.S.P.Q. 109 (T.T.A.B. 1976); *In re Organon Teknika Corp.*, 1216 U.S.P.Q. 935, at *3 (T.T.A.B. 1983); 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 11:35, at 11-69 (4th ed. 2004).

2. *Enrique Bernat F, S.A. v. Guadalajara, Inc.*, 210 F.3d 439, 443 (5th Cir. 2000), *reh'g and reh'g en banc denied*, 218 F.3d 745 (5th Cir. 2000); see *In re Le Sorbet, Inc.*, 228 U.S.P.Q. 27, 31 (T.T.A.B. 1985).

3. The U.S. Court of Customs and Patent Appeals was abolished in 1982 when its judges and its jurisdiction were transferred to the new U.S. Court of Appeals for the Federal Circuit.

4. The Trademark Trial and Appeal Board is a U.S. governmental agency that hears and decides adversary proceedings involving: (1) oppositions to the registration of trademarks, (2) petitions to cancel trademark registrations, (3) proceedings involving applications for concurrent use registrations of trademarks, and (4) appeals taken from a trademark examining attorney's refusal to allow registration of a trademark. United States Patent and Trademark Office, *About the TTAB*, available at <http://www.uspto.gov/godcom/ttab/about.htm> (last modified March 3, 2004).

doctrine of foreign equivalents.”⁵ As a result, and as this collection and critical examination of cases will demonstrate, the current state of the doctrine of foreign equivalents provides little guidance to owners of trademarks and service marks when choosing their marks, or to the TTAB and the courts when assessing a mark’s protectibility and registrability, or analyzing the likelihood of confusion between marks.

It is submitted that many of the cases reviewed in this article have reached incorrect decisions due to misconstructions of the doctrine of foreign equivalents and uncertainties regarding its application. Nevertheless, it is not the author’s view that this is the result of sloppiness by the courts, or of the courts abusing their discretion. Rather, it is the aftermath of the lack of a clear, well-reasoned precedent set by the U.S. legislature or by the U.S. Supreme Court.

Trademark law in the United States is primarily federal law. As such, based on the problems created and evidenced by the inconsistent application of the doctrine of foreign equivalents, the adoption of a national standard may be warranted. It is not suggested that the doctrine should be a mechanical rule. To the contrary, the doctrine should remain just a guideline, but a guideline that is constructed from precise definitions and clear standards so that more consistent, reconcilable, and instructive precedential decisions result.

In lieu of the current ambiguous guideline, which has resulted in uncertainty and inconsistency, this article proposes that the following more clearly defined principles form the basis of a revised doctrine of foreign equivalents upon which all mark owners, reviewing boards, and courts may rely when assessing a foreign-word mark.

A. When the Doctrine Should Apply

The doctrine of foreign equivalents should apply with equal force to all likelihood of confusion inquiries involving a comparison of two foreign-word marks, whether they are from the same foreign language (e.g., the French-word marks TRÈS JOLIE and BIEN JOLIE⁶), or different foreign languages (e.g., the Italian-word mark DUE TORRI and Spanish-word mark TORRES⁷), and to those cases that compare a foreign-word mark and an English-

5. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1377 (Fed. Cir. 2005).

6. *In re Lar Mor Int’l, Inc.*, 221 U.S.P.Q. 180, at *13 (T.T.A.B. 1983).

7. *Miguel Torres S.A. v. Casa Vinicola Gerardo Cesari S.R.L.*, 49 U.S.P.Q.2d 2018, at *6-7 (T.T.A.B. 1998).

language mark (e.g., the Spanish-word mark BUENOS DÍAS and English-word mark GOOD MORNING⁸).⁹

B. Languages to Which the Doctrine Should Apply

Before applying the doctrine of foreign equivalents, it must be shown that the foreign language is one that is *familiar* to an appreciable segment of those American consumers *likely to purchase* the particular goods or services, and the *translation* must be one that is *likely to be made* by a significant number of those American prospective purchasers.¹⁰ This should not be presumed, one way or the other, by the courts. Rather, courts and other reviewing entities should utilize competent sources to investigate prospective purchasers' familiarity with the language as well as the likelihood of translation.¹¹ Competent sources could include: dictionary definitions, research databases, newspapers and other publications, expert witness testimony in the fields of, among others, language, society and culture, survey evidence of prospective purchasers, market research, consumer reaction studies, and any other useful and relevant evidentiary method.¹²

C. The Relevant Consumer

The doctrine should *only* be applied when an *appreciable number of ordinary American purchasers of the particular goods or services* in the United States, who speak English as well as the pertinent foreign language, will *understand* the meaning of the foreign-word mark at issue, *and will actually translate* that mark into its English equivalent.¹³ Defining an "ordinary American purchaser" should not be an abstract concept, but should be defined to refer *only* to the class or classes of actual or prospective American purchasers of the applicant's particular goods or services.¹⁴ Whether these purchasers will understand and actually translate the mark should not be presumed, one way or the other. Rather, courts and reviewing entities should require demonstration of purchaser understanding and actual translation by reference to competent sources.

8 *In re American Safety Razor Co.*, 2 USPQ 2d 1459, at *5 (T.T.A.B. 1987)

9 *Sutter Home Winery, Inc. v. Madrona Vineyards, L.P.*, 2005 U.S. Dist. LEXIS 4581, at *20-21 (N.D. Cal. 2005).

10 Richard L. Kirkpatrick, *Likelihood of Confusion in Trademark Law*, § 4:3 (2005)

11 *See In re Northland Aluminum Prods., Inc.*, 777 F.2d 1556, 1559 (Fed. Cir. 1985).

12 The phrase "competent sources" will be used numerous times in this article. In each instance the phrase refers to the variety of sources listed in the above-noted paragraph.

13 *Sutter Home Winery*, 2005 U.S. Dist. LEXIS 4581, at *22.

14 *In re Omaha Nat'l Corp.*, 819 F.2d 1117, 1119 (Fed. Cir. 1987)

Furthermore, before applying the doctrine, it should be shown that the translation is one that is *likely* to be made by a significant number of American prospective purchasers of those particular goods or services.¹⁵ In other words, it must be likely that the pertinent consumers will *stop and translate* the word into its English equivalent.¹⁶ After this analytical evaluation is completed by utilizing and relying on competent sources, if it is proven to be *likely* that an American buyer of the particular goods or services will *understand and then stop and actually translate* the foreign-word mark, the doctrine of foreign equivalents should be applied. However, if it is found that the mark is one that is *not* likely to be understood or translated by a relevant *American* consumer who speaks both English and the pertinent foreign language, the doctrine should not apply.¹⁷ For example, if it can be shown that an American consumer of the particular goods or services would take the mark "as is,"¹⁸ the doctrine of foreign equivalents should not be applied and the mark should not be translated into English.

D. Marks That Are Generic or Merely Descriptive Under the Doctrine of Foreign Equivalents

If once a foreign-word mark is translated into English the English word is generic or merely descriptive *in the United States, to American consumers*, as applied to the goods or services, it does not warrant protection in the United States. On the other hand, if a word or phrase had "no significance to the American people generally,"¹⁹ or to an appreciable number of the prospective American purchasers of the particular goods or services prior to introduction by the mark applicant, the mark should be registered and/or protected with the full backing of the United States trademark law, regardless of whether the word is generic or descriptive in *another country*.²⁰ The *only* issue should be

15. Kirkpatrick, *supra* note 10, § 4:3.

16. *Palm Bay Imps., Inc v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F 3d 1369, 1377 (Fed. Cir. 2005)

17. *Sutter Home Winery*, 2005 U.S. Dist. LEXIS 4581, at *21

18. *In re Tia Maria, Inc.*, 188 U.S.P.Q. 534 (T.T.A.B. 1975) (holding the term TIA MARIA was likely to be taken "as is" and not be translated by consumers)

19. *Holland v. C. & A. Imp. Corp.*, 8 F. Supp. 259, 261 (S.D.N.Y. 1934).

20. This rule does not ignore the need for international comity or the realities of a global marketplace. While it must not be forgotten that commerce is becoming increasingly global, one also must not forget that the primary concern when dealing with *American* trademark law is the impression a mark has on *American* consumers. As such, it should not matter if a word is generic or descriptive in another country if it would not be perceived as such by *American* purchasers.

Further, United States trademark law generally does not extend or apply beyond America's borders. Thus, it is of little importance whether the word is generic or descriptive

consumer recognition in the United States.²¹

Additionally, the proper translation of a foreign term for purposes of the doctrine of foreign equivalents should not be a literal one. Rather, the translation should be the English word or phrase that carries the *same meaning or significance* as the foreign language word or phrase.²² The ultimate goal should be to identify the translation that reflects the *true meaning* of the foreign word(s) in the mark and that reflects the commercial impression made by the entire phrase.²³

*E. Tests for Likelihood of Confusion and
Commercial Impression When
Applying the Doctrine of Foreign Equivalents*

The commercial impression created by a foreign-word mark always must be considered in the test for likelihood of confusion between marks.²⁴ Translation alone should never decide the question of likelihood of confusion.²⁵ In other words, the mark's sound, meaning and appearance, as well as the sum of all three, should be considered.²⁶ When examining a foreign-word mark's *commercial impression*, the connotation of a term should be irrelevant if it is not commonly known in the United States.²⁷

It is proffered that if the above-enumerated principles are set forth by a federal judicial or legislative entity with overarching authority, such as the U.S. Supreme Court or the U.S. Congress, the doctrine of foreign equivalents will evolve into a useful and equitable tool of U.S. trademark law, providing guidance to future foreign-word mark applicants, to the TTAB and to the courts.

in *another country* if it would not be conceived as such on American soil. If the mark, when translated into English, would be fanciful, arbitrary or suggestive to *American* consumers as applied to the applicant's goods or services, the mark should be protected under American trademark law. However, if once translated the mark is merely descriptive or generic of the applicant's goods or services as perceived by *American* consumers, it should not be registered or protected. This does not, of course, suggest a foreign-language mark that is found to be inherently distinctive of the goods or services to which it is applied in America should or would be protected under foreign trademark systems. Trademark protection in a country other than the United States must be analyzed under that country's trademark laws.

21. *Seiko Sporting Goods U.S.A., Inc. v. Kabushiki Kaisha Hattori Tokeiten*, 545 F. Supp. 221, 226 (S.D.N.Y. 1982).

22. *Trademark Manual of Examining Procedures* [hereinafter TMEP] § 809.01 (4th ed., 2005).

23. *Id.*

24. Siegrun D. Kane, *Selecting a Trademark*, § 2:6 (4th ed. 2005); see also *Bottega Veneta, Inc. v. Volume Shoe Corp.*, 226 U.S.P.Q. 964, 970 (T.T.A.B. 1985).

25. Kirkpatrick, *supra* note 10, at § 4:3 1.

26. *Id.*

27. *In re Mucky Duck Mustard Co., Inc.*, 6 U.S.P.Q.2d 1467, 1469 (T.T.A.B. 1988).

II. BASIC TENETS OF TRADEMARK LAW

It is presumed that readers possess, at the very least, a basic understanding of trademark law. As such, only a very general overview of some of its fundamental tenets will be set forth here and only to the extent that it is useful to an understanding of the doctrine of foreign equivalents.

Trademark law is primarily federal law codified in the U.S. Trademark (Lanham) Act, found at 15 U.S.C.S. §§ 1051, *et seq.* (hereinafter the “Lanham Act”). The Lanham Act defines “trademark” as including “any word, name, symbol, or device, or any combination thereof used by a person . . . to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others, and to indicate the source of the goods, even if that source is unknown.”²⁸ A “service mark” is defined as “any word, name, symbol, or device, or any combination thereof used by a person . . . to identify and distinguish the services of one person, including a unique service, from the services of others, and to indicate the source of the services, even if that source is unknown.”²⁹ In this article, the word “mark” will be used to refer to both trademarks and service marks as defined by the Lanham Act.

A. *The Purpose of Trademarks*

1. Identification of the Source or Origin of Goods or Services

The roles of a trademark are to identify and distinguish the trademark owner’s goods and services from those offered by others, to indicate the source or origin of the trademark owner’s goods and services, to assure the public that they are procuring the genuine goods and services from the trademark owner, and to secure the trademark owner against the substitution and sale of inferior or different goods and services bearing the mark of the trademark owner, or a mark confusingly similar thereto.³⁰ In fact, the paramount purpose of trademark law is to assist consumers in the identification of the *source or origin* of goods or services.³¹ The primary function of a trademark is to designate goods or services

28 15 U.S.C.S. § 1127 (2006).

29. *Id.*

30 15 U.S.C.S. § 1051 (2006) (citing *Manufacturing Co. v. Trainer*, 101 U.S. 51, 53 (1880)).

31. *See, e.g., Clairol, Inc. v. Gillette Co.*, 389 F.2d 264, 269 (2d Cir. 1968) (emphasis added) (“It is elementary that the function of a trademark is to indicate the origin of the products to which it is attached.”); 15 U.S.C.S. § 1051 (2006) (citing *Manufacturing Co. v. Trainer*, 101 U.S. 51, 53 (1880)).

as the product of a particular trader, and to protect that trader's goodwill against the sale of another's products as the trader's own.³²

2. Prevention of Likelihood of Confusion in the Marketplace

Stemming from and related to a trademark's ultimate goal of indicating a single source of origin is the equally important goal of preventing consumer confusion in the marketplace. A likelihood of confusion exists when consumers are likely to assume that a product or service has a source other than its actual source because of similarities between the two sources' marks or marketing techniques.³³

Under the doctrine of foreign equivalents, foreign words from "common languages" are translated into English before undertaking the likelihood of confusing similarity analysis.³⁴ Common languages are defined as those languages "familiar to an appreciable segment of American consumers."³⁵ This does not mean that in order to be "common," the language or dialect must be spoken across America as a whole; it is sufficient if the language is associated with a particular region, cultural movement, or legend.³⁶ However, even words from familiar modern languages that are not in general or common use, and that are unintelligible and non-descriptive to the general American public, even though possibly known to linguists or scientists, should *not* be translated into English under the doctrine of foreign equivalents.³⁷ Also, words from "dead or obscure" languages, such as Latin, may be so unfamiliar to the American buying public that they should not be translated into English.³⁸ Application of the likelihood of confusion analysis as performed in conjunction with the doctrine of foreign equivalents will be explored more thoroughly below.

32. *United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90, 97 (1918) (superseded by statute as stated in *Foxtrap, Inc. v. Foxtrap, Inc.*, 671 F.2d 636, 640 n.5 (App. D.C. 1982)).

33. *Sutter Home Winery, Inc. v. Madrona Vineyards, L.P.*, 2005 U.S. Dist. LEXIS 4581, at *14 (N.D. Cal. 2005) (citing *Nutri/System, Inc. v. Con-Stan Indus., Inc.*, 809 F.2d 601, 604 (9th Cir. 1987); *Shakey's Inc. v. Covall*, 704 F.2d 426, 431 (9th Cir. 1983)).

34. See *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1377 (Fed. Cir. 2005); see also *Sutter Home Winery, Inc. v. Madrona Vineyards, L.P.*, 2005 U.S. Dist. LEXIS 4581, at *18 (N.D. Cal. 2005).

35. TMEP § 1207.01(b)(vi).

36. *Enrique Bernat F., S.A. v. Guadalajara, Inc.*, 210 F.3d 439, 444 n.4 (5th Cir. 2000), *reh'g and reh'g en banc denied*, 218 F.3d 745 (5th Cir. 2000) (citing *Otokoyama Co. Ltd. v. Wine of Japan Imp., Inc.*, 175 F.3d 266, 271 (2d Cir. 1999)).

37. E.g., *Le Blume Imp. Co. v. Coty*, 293 F. 344, 358 (2d Cir. 1923); *General Cigar Co. Inc. v. G.D.M. Inc.*, 988 F. Supp. 647, 660 (S.D.N.Y. 1997).

38. TMEP § 1207.01(b)(vi).

B. The Continuum of Trademark Significance

When determining whether to grant registration on either the Principal or Supplemental Register of the United States Patent and Trademark Office (USPTO),³⁹ trademark examining attorneys will categorize a mark along a continuum of distinctiveness.

1. Coined Marks, Fanciful Marks, and Arbitrary Marks

At one extreme of the continuum are marks that, when used on or in connection with the goods or services, are coined, fanciful or arbitrary, and are therefore deemed inherently distinctive.⁴⁰ A coined mark is an artificial word that has no language meaning other than as a trademark; whereas fanciful marks, like coined marks, comprise terms that have been invented for the sole purpose of functioning as a trademark or service mark, but may bear a relationship to another word, or may be an obsolete word.⁴¹ Arbitrary marks comprise words that are in common linguistic use but, when used to identify particular goods or services, do not suggest or describe the nature of or a significant ingredient, quality, or characteristic of those goods or services.⁴² An oft-cited example of an arbitrary mark is APPLE, used to identify computers and computer-related products.⁴³ The mark is arbitrary when applied to the particular goods or services because although "apple" is recognized as a word used in everyday language, it does not in any way suggest or describe computers, and in no way is the fruit related to the product, *i.e.*, computers.

39. When a mark has been registered on the Principal Register, the mark is entitled to all the rights provided by the Lanham Act. The advantages of owning a registration on the Principal Register include the following: (1) constructive notice to the public of the registrant's claim of ownership of the mark; (2) a legal presumption of the registrant's ownership of the mark and the registrant's exclusive right to use the mark nationwide on or in connection with the goods or services listed in the registration; (3) a date of constructive use of the mark as of the filing date of the application; (4) the ability to bring an action concerning the mark in federal court; (5) the ability to file the U.S. registration with the U.S. Customs Service to prevent importation of infringing foreign goods; (6) the registrant's exclusive right to use a mark in commerce on or in connection with the goods or services covered by the registration can become "incontestable," subject to certain statutory defenses; and (7) the use of the U.S. registration as a basis to obtain registration in foreign countries. Certain marks, however, that are not eligible for registration on the Principal Register, but are capable of distinguishing an applicant's goods or services, may be registered on the Supplemental Register. Marks registered on the Supplemental Register are excluded from receiving many of the advantages provided by the Lanham Act to marks registered on the Principal Register. TMEP §§ 801.02 (a) and (b) (internal citations omitted).

40. TMEP § 1209.01

41. *Id.* at § 1209.01(a).

42. *Id.*

43. *See, e.g., Little Caesar Enter., Inc. v. Pizza Caesar, Inc.*, 834 F.2d 568, 571 (6th Cir. 1987).

2. Suggestive Marks

Following coined, fanciful, and arbitrary marks on the continuum are suggestive marks, which are also deemed inherently distinctive, albeit not to the same extent reserved for coined, arbitrary and fanciful marks.⁴⁴ Suggestive marks are those that, when applied to the goods or services at issue, require imagination, thought or perception to reach a conclusion as to the nature, ingredients, quality, or characteristics of the goods or services.⁴⁵ Courts have noted that often the best trademarks are highly suggestive.⁴⁶ For example, the mark SKINVISIBLE, which is applied to medical and surgical tapes through which the skin of the user is visible, was held to be a protectible trademark although it was highly suggestive of the product.⁴⁷ This was so because the mark did not merely describe, but only suggested, that the skin was visible through the goods to which the term was applied; the term merely suggested the quality of invisibility and an attribute of the tape.⁴⁸

All of the aforementioned categories of marks—coined, fanciful, arbitrary, and suggestive—are protectible under United States trademark law. These types of marks are considered to be inherently distinctive and may be registered on the Principal Register without having to submit proof of distinctiveness.⁴⁹

3. Merely Descriptive Marks

Following suggestive marks on the continuum are marks that are merely descriptive of the nature, ingredients, quality, or characteristics of the goods or services they identify.⁵⁰ In this context, “merely” means “only.”⁵¹ Whether a mark is merely descriptive is a question of fact, determined from the viewpoint of the relevant purchasing public.⁵² Determination of whether a mark is merely descriptive must be made on a case-by-case basis in relation to the goods or services for which protection or registration

44. TMEP § 1209.01.

45. *Id.* at § 1209.01(a).

46. *E.g., Van Camp Sea Food Co. v. Alexander B. Stewart Org.*, 18 C.C.P.A. 1415, 1420 (C.C.P.A. 1931).

47. *Minnesota Mining & Mfg. Co. v. Johnson & Johnson*, 59 C.C.P.A. 971, 973 (C.C.P.A. 1972).

48. *Id.*

49. TMEP § 1209.01. As used in the Lanham Act, the word “distinctiveness” has been substituted for the common-law phrase “secondary meaning.”

50. *Id.*

51. *In re Quik-Print Copy Shops, Inc.*, 616 F.2d 523, 525 n.7 (C.C.P.A. 1980) (citing *In re Colonial Stores*, 294 F.2d 549, 552 (C.C.P.A. 1968)).

52. *In re Bed & Breakfast Registry*, 791 F.2d 157, 160 (Fed. Cir. 1986).

is sought.⁵³ In other words, a mark should not be considered in the abstract, but only in the context in which the mark is used or intended to be used, and in terms of the possible significance the mark would have to the average purchaser of the goods or services in the marketplace.⁵⁴

A mark will be considered to be merely descriptive if it *immediately* conveys to one seeing or hearing it knowledge of the nature, an ingredient, quality, characteristic, function, feature, purpose, or use of the specified goods or services.⁵⁵ It is not necessary that a term describe *all* of the properties or functions of the goods or services in order for it to be deemed merely descriptive thereof; registration will be refused if the term is merely descriptive of *any* of the goods or services for which protection or registration is sought, or if the term describes a significant attribute of the goods or services.⁵⁶ For example, the mark BABY BRIE for brie cheese was held to be descriptive of cheese sold in a size smaller than the average wheel of cheese because in the food industry “baby” is often used to indicate size, and as such, the term “baby” combined with the name of the cheese described a significant attribute of the good.⁵⁷

a. Acquired Distinctiveness (Secondary Meaning)

Merely descriptive marks may not be registered on the Principal Register absent proof of acquired distinctiveness, that is, proof that the mark has acquired a secondary meaning different from its primary language descriptive meaning when applied to the applicant's goods or services in commerce.⁵⁸ In other words, a merely descriptive mark will not be registered on the Principal Register or granted the full protection of United States trademark law unless the mark owner can show that in the minds of the public, the primary significance of the mark has become an identifier of the *source* of the product or service, rather than the product or service itself.⁵⁹ Merely descriptive marks may, however, be registered on the Supplemental Register without a showing of

53. TMEP § 1209.01(b).

54. *Id.*

55. TMEP § 1209.01(b); *In re Quik-Print Copy Shops, Inc.*, 616 F.2d 523, 525 (C.C.P.A. 1980) (emphasis added); *In re Hutchinson Tech., Inc.*, 852 F.2d 552, 555 (Fed. Cir. 1988); *Stix Prod., Inc. v. United Merch. & Mfrs., Inc.*, 295 F. Supp. 479, 488 (S.D.N.Y. 1968).

56. *In re Mine Safety Appliances Co.*, 66 USPQ2d 1694, at *5 (T.T.A.B. 2002) (emphasis added)

57. *In re Bongrain Int'l Corp.*, 894 F.2d 1316, 1317 (Fed. Cir. 1990)

58. TMEP §§ 1209.01, 1212; 15 U.S.C. § 1052(f) (2006).

59. *Inwood Labs., Inc. v. Ives Labs.*, 456 U.S. 844, 851 n.11 (1982); TMEP § 1212 (stating secondary meaning and acquired distinctiveness is the special significance a term has acquired as a result of usage by one producer with reference to his product).

acquired distinctiveness so long as the mark is deemed to be capable of distinguishing the applicant's goods or services from those of others.⁶⁰

b. Merely Deceptively Misdescriptive Terms

Included in the category of merely descriptive marks are those marks that are merely deceptively misdescriptive of the goods or services.⁶¹ Section 2(e)(1) of the Lanham Act prohibits registration of designations that are merely deceptively misdescriptive of the goods or services to which they are applied.⁶² Marks that are merely descriptive of the nature, ingredients, quality or characteristics of the type of goods or services they identify, but as applied to an applicant's particular goods or services would be factually false, are merely deceptively misdescriptive designations under Section 2(e)(1).

As with merely descriptive marks, marks that have been refused registration on the grounds that they are merely deceptively misdescriptive may be registerable on the Principal Register only upon a showing of acquired distinctiveness (*i.e.*, secondary meaning), or they may be registered on the Supplemental Register if they are capable of distinguishing the applicant's goods or services from those goods or services of others.⁶³

4. Generic Marks

Finally, at the opposite end of the continuum from coined, arbitrary, and fanciful marks are generic terms for goods or services.⁶⁴ Generic words comprise terms that the relevant purchasing public understands primarily to be the common or class name(s) for the goods or services.⁶⁵ Terms that are generic are never protectible as trademarks and are never registerable on either the Principal or the Supplemental Register under any circumstances as the "generic name of a thing is the ultimate in descriptiveness"⁶⁶ and as such, can never function as a trademark

60 15 U.S.C. § 1091 (2006).

61 15 U.S.C. § 1052(e) (2006).

62 15 U.S.C. § 1052(e)(1) (2006).

63 TMEP § 1209.04; *see also* 15 U.S.C. §§ 1052(f) and 1091 (2006).

64 TMEP § 1209.01.

65 *Id.* at § 1209.01(c); *see also In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1344 (Fed. Cir. 2001); *In re American Fertility Soc'y*, 188 F.3d 1341, 1346 (Fed. Cir. 1999).

66 TMEP § 1209.01(c); *H. Marvin Ginn Corp. v. International Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 989 (Fed. Cir. 1986).

to indicate origin.⁶⁷ It should always be remembered that one of the primary purposes of trademark law is to assist consumers in the identification of the source or origin of goods or services.⁶⁸

It should also be noted that a term can be the generic name of one thing, but be a valid trademark for some other product or service.⁶⁹ For example, APPLE is a highly protectible arbitrary trademark for computers, but the term APPLE would be generic if applied to the edible fruit of the apple tree.⁷⁰ Also, the mark BICYCLE is the generic name for a two-wheeled mode of transportation, but has been a highly protectible trademark since 1885 for playing cards.⁷¹

III. THE DOCTRINE OF FOREIGN EQUIVALENTS

The doctrine of foreign equivalents recognizes the cosmopolitan character of populations and the international character of trade.⁷² As stated in the Introduction, the policy behind the doctrine is one of international comity. Because U.S. companies would be impaired in international trade if foreign countries granted trademark protection to generic or merely descriptive English words in their countries, the U.S. reciprocates and refuses trademark protection to generic or merely descriptive foreign words.⁷³ The rationale for the doctrine is the maintenance of fair competition in the international trade of goods and services. Based on this policy of international harmony and mutual respect, the foreign equivalent of a generic or merely descriptive English word is no more protectible or registerable than the English word itself.⁷⁴

A. The Guideline That Is the Rule

Under the doctrine of foreign equivalents, a mark consisting of a foreign word or words is translated into English before protection

67. 2 McCarthy, *supra* note 1, § 12:1, at 12-4; see also *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1344 (Fed. Cir. 2001); *In re American Fertility Soc'y*, 188 F.3d 1341, 1346 (Fed. Cir. 1999).

68. See, e.g., *Clairol, Inc. v. Gillette Co.*, 389 F.2d 264, 269 (2d Cir. 1968).

69. 2 McCarthy, *supra* note 1, § 12:1, at 12-5.

70. *Id.*

71. *Id.*

72. Kirkpatrick, *supra* note 10, § 4:3

73. *Enrique Bernat F., S.A. v. Guadalajara, Inc.*, 210 F.3d 439, 443 (5th Cir. 2000), *reh'g and reh'g en banc denied*, 218 F.3d 745 (5th Cir. 2000); see *In re Le Sorbet, Inc.*, 228 USPQ 27, 31 (TTAB. 1985)

74. TMEP § 1209.03(g).

or registration analyses.⁷⁵ After translation by the United States Patent and Trademark Office or the courts, the mark consisting of the foreign word(s) may be held to be generic, merely descriptive, or merely deceptively misdescriptive of the goods or services, and thus denied registration or protection. Additionally, in an opposition to registration, or in a trademark infringement case, a foreign word and an English word, or two foreign words, may be held to be confusingly similar.⁷⁶

Although words from modern languages are *generally* translated into English, the doctrine of foreign equivalents is not an absolute rule, but is merely a guideline.⁷⁷ The doctrine does not apply to every foreign word that appears in a trademark or service mark.⁷⁸ Because the doctrine is only a guideline and not a stringent rule, courts in different jurisdictions, as well as the U.S. Trademark Trial and Appeal Board (TTAB), have often rendered contradictory decisions when deciding cases applying the doctrine. One primary complicating factor is that the act of translation, itself, is an imprecise task, as foreign words sometimes have no exact equivalents in English.⁷⁹ Accordingly, courts are permitted to rely on the primary and common translation in determining English equivalency.⁸⁰ A further difficulty is that there is little agreement among courts regarding what the doctrine actually dictates, and there is disagreement as to when and how the doctrine should be applied.

It must be stressed that because of the impreciseness of English translations and because there have been ambiguities in applying the doctrine, there is an imperative need for reliable standards that trademark and service mark applicants, as well as the courts, can follow when applying the doctrine. As is demonstrated by the cases discussed in this article, about the only thing upon which a mark owner can rely, and the only thing upon which the courts tend to agree, is that as the doctrine currently stands, the doctrine is a guideline and not a rule.

75. 2 McCarthy, *supra* note 1, § 11:34, at 11-66

76. TMEP § 1207.01(b)(vi)

77. *Id.* (emphasis added)

78. *Sutter Home Winery, Inc. v. Madrona Vineyards, L.P.*, 2005 U.S. Dist. LEXIS 4581, at *18 (N.D. Cal. 2005) (quoting *In re Pan Tex Hotel Corp.*, 190 U.S.P.Q. 109, 110 (TTAB 1976)).

79. *Enrique Bernat F., S.A. v. Guadalajara, Inc.*, 210 F.3d 439, 443 (5th Cir. 2000), *reh'g and reh'g en banc denied*, 218 F.3d 745 (5th Cir. 2000)

80. *Id.*

B. When the Doctrine Should Apply

1. When *Only One* of the Marks Is From a Language Other Than English

The Trademark Manual of Examining Procedures (TMEP) suggests that the doctrine of foreign equivalents should be invoked *only* when one of the marks at issue is in English and the other is in a foreign language.⁸¹ For example, the TMEP would suggest invoking the doctrine when BUENOS DÍAS is compared with GOOD MORNING,⁸² LUPO with WOLF,⁸³ or EL SOL with SUN.⁸⁴ Like the doctrine as a whole, however, this is not an absolute rule. The TMEP itself states that although the doctrine is not “normally” invoked if the marks are *both* foreign words, application of the doctrine is not barred when the respective marks both consist of terms from foreign languages.⁸⁵ Consequently, as will be demonstrated hereinafter, many courts hold the doctrine to be equally applicable where *both* marks contain foreign terms.⁸⁶

2. When the Words Are *Both* From Foreign Languages

The typical doctrine of foreign equivalents case involves the comparison of one foreign-word mark with an English-word mark, and, as stated above, there is some authority to suggest that the doctrine is operative *only* under these circumstances.⁸⁷ Even so, as also stated before, application of the doctrine is not mandated, but is also not barred, where both of the marks consist of terms from foreign languages.⁸⁸ As a result of the lack of a mandate, there is no authoritative guidance on the question of whether the doctrine of foreign equivalents applies where both of the marks are foreign-language marks.⁸⁹ Some courts hold that the doctrine applies with equal force when there is a comparison of two foreign-word marks and assert that the “fact that both marks [are] comprised of foreign

81. TMEP § 1207.01(b)(vi)

82. *In re American Safety Razor Co.*, 2 U.S.P.Q.2d 1459, at *5 (T.T.A.B. 1987).

83. *In re Ithaca Indus., Inc.*, 230 U.S.P.Q. 702, at *4 (T.T.A.B. 1986).

84. *In re Hub Distributing, Inc.*, 218 U.S.P.Q. 284, at *2 (T.T.A.B. 1983).

85. TMEP § 1207.01(b)(vi)

86. *E.g.*, *Sutter Home Winery*, 2005 U.S. Dist. LEXIS 4581, at *20

87. TMEP § 1207.01(b)(vi); *see also Sutter Home Winery*, 2005 U.S. Dist. LEXIS 4581, at *20; *Safeway Stores, Inc. v. Bel Canto Fancy Foods, Ltd.*, 5 U.S.P.Q.2d 1980, 1982 (T.T.A.B. 1987) (quoting 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 23:14, at 80 (2d ed. 1984) (“If the two marks alleged to be confusingly similar are both foreign words, it may be that the doctrine of foreign equivalents is not applicable.”)).

88. TMEP § 1207.01(b)(vi)

89. *Sutter Home Winery*, 2005 U.S. Dist. LEXIS 4581, at *20.

words [does] not mean that a court can disregard their meanings when doing a likelihood of confusion analysis.”⁹⁰

a. Comparing Terms From the Same Foreign Language

In a comparison of the English-language equivalents of terms from the *same* foreign language, the mark TRÈS JOLIE (“very pretty”) and the mark BIEN JOLIE (“quite pretty”) were found not to be confusingly similar because “many members of the American public, even those who have only a rudimentary acquaintance with the French language,” were likely to understand the difference between the respective terms.⁹¹ Further, both of the marks were laudatory in nature, and were so non-arbitrary and non-distinctive that the public would be able to easily distinguish the differences between the two marks.⁹²

In the first U.S. Court of Appeals for the Fifth Circuit case to adopt the doctrine of foreign equivalents in instances where both marks are from a foreign language, the court was asked to settle a controversy between two marks for lollipops that both contained the term *chupa*, which means “lollipop” in Spanish slang.⁹³ The proper Spanish translation of *chupa* is “to lick” or “to suck.”⁹⁴ In applying the doctrine of foreign equivalents, the court reasoned that although *chupa* does not literally mean “lollipop” when translated into English, the term is nevertheless generic when applied to the parties’ products because *chupa* is the generic Spanish slang term for the applicants’ goods.⁹⁵ The Second, Fourth, and Ninth Circuits have adopted the Fifth Circuit rule that the doctrine of foreign equivalents applies with the same force to the comparisons of two foreign-word marks (from the same or different languages) as it does when analyzing a foreign-word mark and an English-word mark.⁹⁶

b. Comparing Terms From Different Foreign Languages

When comparing marks from *different* foreign languages, courts, including the TTAB, have applied the doctrine of foreign equivalents in some cases, but not in others. The TTAB has

90. *Id.* at *20-21 (quoting *In re Lar Mor Int’l, Inc.*, 221 U.S.P.Q. 180, 181 (TTAB. 1983)).

91. *Lar Mor Int’l, Inc.*, 221 U.S.P.Q. 180, at *13.

92. *Id.* at *12.

93. *Enrique Bernat F, S.A. v. Guadalajara, Inc.*, 210 F.3d 439, 443-44 (5th Cir.), *reh’g and reh’g en banc denied*, 218 F.3d 745 (5th Cir. 2000).

94. *Id.*

95. *Id.*

96. *Sutter Home Winery*, 2005 U.S. Dist. LEXIS 4581, at *20-21 (internal citations omitted).

clarified that they have not laid down a proposition of law that bars the application of the doctrine in all cases involving two foreign languages and that each case must therefore be determined on its own merits.⁹⁷ In one case, the TTAB found it improper to apply the doctrine of foreign equivalents and take the French expression BEL AIR and the Italian expression BEL ARIA and convert them into their English translations before comparing them.⁹⁸ In a contradictory decision, the TTAB applied the doctrine of foreign equivalents when evaluating a likelihood of confusion between the Italian-word mark DUE TORRI (meaning "two towers") for wines, the Spanish-word mark TORRES ("towers") for wines and brandy, and the Spanish-word mark TRES TORRES ("three towers") for brandy.⁹⁹ The TTAB reasoned that although it was unlikely that an American purchaser would speak both Spanish and Italian, a purchaser fluent in one or the other would likely be able to decipher the meaning of both marks.¹⁰⁰ The TTAB distinguished the prior-cited decision comparing BEL AIR with BEL ARIA on the ground that the opposer in that case did not argue that the marks had similar connotations, so it was unnecessary to consider their English translations.¹⁰¹

The troublesome absence of a clear precept regarding whether the doctrine of foreign equivalents should be applied in a comparison of two marks comprising foreign words results in registration applicants and the courts being left with little or no guidance. Of course, in those circuits that have clearly adopted the doctrine when evaluating conflicting foreign-word marks, there is some precedent. Nevertheless, even in those circuits, the doctrine is still only a "guideline" and a clouded one at that. Even those cases that apply the doctrine when two foreign-word marks are at issue are quick to hedge their bets and point out that there is neither a mandate to apply the doctrine in these situations, nor a bar against application of it, and application of the doctrine must be evaluated on a case-by-case basis.¹⁰² As stated, although there is some state protection for marks, trademark law is now primarily federal law. As such, there should not be splits between the circuits and certainly not within the TTAB itself. A clear mandate by either the U.S. Congress or the U.S. Supreme Court is

97. *Miguel Torres S.A. v. Casa Vinicola Gerardo Cesari S.R.L.*, 49 U.S.P.Q.2d 2018, at *6-7 (T.T.A.B. 1998).

98. *Safeway Stores, Inc. v. Bel Canto Fancy Foods, Ltd.*, 5 U.S.P.Q.2d 1980, 1982 (T.T.A.B. 1987).

99. *Miguel Torres*, 49 U.S.P.Q.2d 2018, at *6-7 (T.T.A.B. 1998).

100. *Id.*

101. *Id.* at *8.

102. *Id.* at *6-7.

warranted to resolve the disparities in the application of the doctrine when two foreign-word marks are at issue. It is proffered that for the sake of consistency, the doctrine of foreign equivalents should apply with equal force to a comparison of two foreign-word marks, whether they are from the same or different foreign languages, and to those cases comparing a foreign-word mark and an English-word mark.

3. When the Mark Is a *Combination of a Foreign and English Word*

As a general proposition, the doctrine of foreign equivalents does not apply when a mark is a combination of foreign and English words.¹⁰³ For example, the addition of a foreign article (*e.g.*, the French article *le*, or the Spanish article *el*) to an English word more than likely creates a commercial impression of the combination as a mark rather than as a generic identifier for a product or service.¹⁰⁴ The doctrine of foreign equivalents also becomes unnecessary for foreign-English language combination marks because when a mark is composed of *all* foreign components, translation of the entire mark by the consumer is more likely to take place than when only a part of the mark is in a foreign language.¹⁰⁵

Using this reasoning, the TTAB found that LA YOGURT was registerable because the combination of the French article *La* with the English word yogurt changed the commercial impression of the mark as a whole so that LA YOGURT would be perceived as a trademark identifying source rather than as a generic product name for the goods.¹⁰⁶ On almost identical grounds, the TTAB found that the mark LE CASE was registerable for "jewelry boxes and gift boxes made of precious metal" because the mark created a commercial impression having a continental connotation that potential purchasers of jewelry boxes might prefer over American-made boxes.¹⁰⁷ Using these and similar cases as precedent, the applicant for registration of the LE SORBET mark for "fruit ice" attempted to convince the TTAB that although "sorbet" was generic for its goods when translated into English, the French article *Le* before the term sorbet imparted a French flavor that

103 *French Transit v. Modern Coupon Sys.*, 818 F. Supp. 635, 636 (S.D.N.Y. 1993) (holding LE CRYSTAL NATUREL for body deodorant not merely descriptive).

104 *In re Johanna Farms*, 1988 T.T.A.B. LEXIS 31, 8 U.S.P.Q.2D (BNA) 1408, 1413 (T.T.A.B. 1988).

105 *In re Universal Package Corp.*, 222 U.S.P.Q. (BNA) 344, 347 (T.T.A.B. 1984).

106 *In re Johanna Farms*, 1988 T.T.A.B. LEXIS 31, 8 U.S.P.Q.2D (BNA) 1408, 1413 (T.T.A.B. 1988).

107 *In re Universal Package Corp.*, 222 U.S.P.Q. 344, at *9 (T.T.A.B. 1984).

created a registerable mark with the commercial impression of a source identifier.¹⁰⁸ The applicant argued that through widespread American use, "sorbet" had become an English term, and that therefore the mark was a combination of an English word and a French article.¹⁰⁹ The TTAB disagreed.¹¹⁰ The LE SORBET mark was found to be entirely French, so the doctrine of foreign equivalents did apply, and when translated into English, the mark was found to be the generic term for the applicant's goods.¹¹¹

The above-referenced cases that chose not to apply the doctrine of foreign equivalents to marks that are a combination of foreign and English words were correctly decided. The author concurs with the assertion that the combination of a foreign article or word with an English word changes the commercial impression of the mark as a whole, and consequently the term or phrase is more likely to be perceived as a trademark identifying source or origin rather than as a generic product name for goods or services. Of course, as with all trademarks and service marks, evaluation of foreign-English-combination marks should be done on a case-by-case basis, keeping in mind the basic tenets of trademark law that a mark must identify source or origin and not the product itself, and must not be likely to cause confusion when in use in the marketplace.¹¹²

Additionally, the doctrine of foreign equivalents should apply to marks that consist entirely of foreign language components, such as LE SORBET, regardless of whether a foreign language word (such as sorbet) is in widespread use in the United States. The common understanding of a word among American consumers of a product or service is part of the analysis of *any* trademark, especially when deciding if the word is coined, arbitrary, fanciful, suggestive, descriptive, or generic as applied to the goods or services. This is true for all marks, whether they are translated from a foreign language or whether they consist only of English-language words. The examination of a mark to determine where it falls on the continuum of distinctiveness is not avoided or altered because the doctrine of foreign equivalents applies to the particular mark. Rather, if a mark is a combination of all foreign-language words, the mark should be translated into English, and then an analysis should be done to determine the mark's distinctiveness, registrability and protection. If once translated into English the mark is deemed to be merely descriptive, for

108. *In re Le Sorbet, Inc.*, 1985 T.T.A.B. LEXIS 27, at *4 (T.T.A.B. 1985).

109. *Id.*

110. *Id.*

111. *Id.* at *6, *12.

112. *See Clairrol, Inc. v. Gillette Co.*, 389 F.2d 264, 269 (2d Cir. 1968).

example, as applied to the goods or services, such as LE SORBET, the mark should not be registered or protected under American trademark law, unless it can be demonstrated that the mark has acquired distinctiveness or secondary meaning.

C. Languages to Which the Doctrine Applies

1. Common Modern Languages

There is some consensus as to which foreign languages the doctrine of foreign equivalents applies. The TMEP states that only foreign words from a “common modern language” that is “familiar to an appreciable segment of American consumers” need be translated into English prior to examination and analysis.¹¹³ The TMEP does not further define what is meant by the phrase “familiar to an appreciable segment of American consumers,” but courts have interpreted this phrase to mean those consumers likely to purchase the particular good or service, *i.e.*, the *relevant* purchasing public.¹¹⁴ Further, it is not required that the language or dialect be spoken in the United States as a whole; rather, a word may be from a language found only in a particular region, cultural movement, or legend, so long as it is one that is familiar to an appreciable number of the relevant consumers of the particular product or service.¹¹⁵ Courts have even translated (to the extent they can be translated) slang terms from modern foreign languages.¹¹⁶ However, even words from familiar modern languages that are not in general or common use, and that are unintelligible and non-descriptive to the general public, although possibly known to linguists or scientists, should not be translated into English under the doctrine of foreign equivalents.¹¹⁷

2. Dead, Archaic and/or Obscure Languages

Words from “dead or obscure” languages may be so unfamiliar to the American buying public that they should not be translated into English.¹¹⁸ The determination of whether a language is “dead

113. TMEP § 1207.01(b)(vi)

114. *See, e.g., Dictaphone Corp. v. Dictamatic Corp.*, 199 USPQ 437, at *7 (D. Or. 1978).

115. *Enrique Bernat F, S.A. v. Guadalajara, Inc.*, 210 F.3d 439, 444 n.4 (5th Cir. 2000), *reh'g and reh'g en banc denied*, 218 F.3d 745 (5th Cir. 2000) (citing *Otokoyama Co. Ltd. v. Wine of Japan Imp., Inc.*, 175 F.3d 266, 271 (2d Cir. 1999))

116. *See, e.g., id.* (finding the term “chupa” is a slang word in Spanish meaning “lollipop”)

117. *E.g., Le Blume Imp. Co. v. Coty*, 293 F. 344, 358 (2d Cir. 1923); *General Cigar Co. Inc. v. G.D.M. Inc.*, 988 F. Supp. 647, 660 (S.D.N.Y. 1997).

118. TMEP § 1207 01(b)(vi); *see also Enrique Bernat F., S.A.*, 210 F.3d at 444, n.4.

or obscure” is to be made on a case-by-case basis, based upon the meaning that the term would have to the *relevant purchasing public*.¹¹⁹ The fact that only lexicographers or devotees of antiquity may recognize the non-distinctive nature of a mark is irrelevant to the critical enquiry of the effect of the term upon a substantial segment of prospective purchasers.¹²⁰

The TMEP uses Latin as an example of a dead language, but includes the caveat that if there is evidence that a Latin term is still in use by the relevant purchasing public, then that particular Latin term will not be considered dead.¹²¹ It is urged by the TMEP that this same analysis should be applied to other uncommon languages.¹²²

Applying this case-by-case analysis standard has produced varied results. The mark COHIBA, meaning “tobacco” in the language of the Taino Indians, was held not to be merely descriptive of cigars.¹²³ The court held that it was doubtful that relevant prospective purchasers of COHIBA cigars would make an association between the mark and a non-English word in a language spoken only by the indigenous population of the Dominican Republic.¹²⁴ Further, purchasers were more likely to recognize the word *cohiba* as a derivative of the Spanish verb *cohibir*, meaning “to prohibit or restrain,” and that particular English translation is not merely descriptive of cigars.¹²⁵ Also, the mark DICTAPHONE was found not only registerable, but also to be a strong mark because although it is derived from the Latin *dicere* (to say) and the Greek *phono* (voice or sound), it had no inherent meaning to the relevant purchasing public.¹²⁶

In two cases involving the ancient Greek prefix *tele*, meaning “from afar,” courts have found the marks containing the prefix to be arbitrary. Registration was upheld for the coined-word mark TELECHRON for clocks and electric motors.¹²⁷ TELECHRON was formed by prefixing the Greek root *chron* (Kronos was the

119. TMEP § 1207.01(b)(vi); see also *Blisscraft of Hollywood v. United Plastics Co.*, 294 F.2d 694, 699 (2d Cir. 1961) (holding only the meaning to prospective purchasers of the actual product is relevant; meaning to a non-purchasing segment of the population is not important).

120. 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 11:33, at 11-64-65 (4th ed. 2004); *Stix Prod., Inc. v. United Merch. & Mfrs., Inc.*, 295 F. Supp. 479, 488 (S.D.N.Y. 1968).

121. TMEP § 1207.01(b)(vi).

122. *Id.*

123. *General Cigar Co. Inc. v. G.D.M. Inc.*, 988 F. Supp. 647, 660 (S.D.N.Y. 1997).

124. *Id.*

125. *Id.* at 651.

126. *Dictaphone Corp. v. Dictamatic Corp.*, 199 U.S.P.Q. 437, at *7 (D. Or. 1978).

127. *Telechron, Inc. v. Telicon Corp.*, 198 F.2d 903, 905-06 (3d Cir. 1952).

mythological God of time, so the root has come to mean "time") with the Greek prefix *tele*.¹²⁸ Hence, the etymology of the coined word yielded a connotation of "time from a distance."¹²⁹ Since the word was based in ancient languages and was not in existence before the mark owner created it, the mark was registerable.¹³⁰ In another decision regarding a mark containing the prefix *tele*, use of the archaic and obscure word *telesis* ("progress intelligently planned and directed") in the mark PACIFIC TELESIS for a telephone company was found to be arbitrary even though a modern person might think that the *tele* portion of the word in the context of telecommunications somehow denoted a system of distance communications.¹³¹ This case appears to represent a situation in which the court stretched the rules in order to protect a valuable mark of a large corporation that spanned state lines and numerous industries. As mentioned, a mark is merely descriptive if it immediately conveys to a member of the relevant purchasing public seeing or hearing it some knowledge of an ingredient, quality, characteristic, function, feature, purpose or use of the specified goods or services.¹³² To be found to be merely descriptive a term need only describe a significant attribute of the goods or services.¹³³ Under the doctrine of foreign equivalents, if the prefix *tele* had been translated into English as "from afar" or "from a distance," or if *telesis* had been translated as "progress intelligently planned and directed," the mark would have been merely descriptive of a characteristic, function or attribute of the burgeoning global telecommunications services provided under the mark, and consequently unregistrable without proof of acquired distinctiveness. Additionally, in deciding registrability and likelihood of confusion, courts are to assess the commercial impression of the mark, as well as the overall impression created.¹³⁴ The PACIFIC TELESIS case was decided in 1993, when telecommunications, including telephones and televisions, were prevalent in American society.¹³⁵ Based on the common *understanding* (as opposed to the literal translation) of the prefix

128. *Id.* at 905

129. *Id.*

130. *Id.* at 905-06

131. *Pacific Telesis Group v. Int'l Telesis Communications*, 994 F.2d 1364, 1365, 1367 (9th Cir. 1993).

132. TMEP § 1209.01(b); *In re Bed & Breakfast Registry*, 791 F.2d 157, 160 (Fed. Cir. 1986).

133. *In re Mine Safety Appliances Co.*, 66 USPQ2d 1694, at *5 (TTAB. 2002) (emphasis added).

134. Kirkpatrick, *supra* note 10, at § 4:3:1.

135. *Pacific Telesis Group v. International Telesis Communications*, 994 F.2d 1364, 1370 (9th Cir. 1993).

tele in American society in 1993, and consequently the commercial impression created by a mark for a telephone company including that term, the mark should have been found to be merely descriptive.

As the ever-changing marketplace becomes more global and less local, and as international commerce becomes increasingly the norm, which languages qualify as dead or obscure will no doubt further evolve. The U.S. Central Intelligence Agency's website breaks down the languages spoken in America as follows: English 82.1%, Spanish 10.7%, other Indo-European 3.8%, Asian and Pacific island 2.7%, and other 0.7%.¹³⁶ Languages once thought to be obscure, such as Farsi and Arabic, are now in common use in American society, especially in urban areas. As the variety of languages spoken in America increases and as the percentage of the United States population that speaks English shrinks, courts will have to evolve their understanding of which languages qualify as dead or obscure languages in today's global marketplace.

D. The Relevant Consumer

The courts and legal scholars have not reached an agreement regarding which consumers are "relevant" when applying the doctrine of foreign equivalents. Although the difference between definitions may seem slight, in application the variations could mean the difference between the grant of registration and protection of a mark, and denial of registration and protection.

1. The Relevant Purchasing Public

The general rule is that the determination of whether a mark is merely descriptive, for example, is a question of fact to be ascertained from the viewpoint of the "relevant purchasing public."¹³⁷ Evidence of the purchasing public's understanding of the term may be obtained from any competent source.¹³⁸ It is recognized that the public's understanding of a term may change with time.¹³⁹

2. The Average American Buyer

In an article published by the Practising Law Institute, it is stated that a foreign word should not be translated into English unless the "average American buyer" would be familiar with the

136. Central Intelligence Agency, *The World Factbook*, available at <http://www.cia.gov/cia/publications/factbook/geos/us.html#People> (last modified Jan 10, 2006).

137. *In re Bed & Breakfast Registry*, 791 F.2d 157, 160 (Fed. Cir. 1986).

138. *Id.*

139. *Id.*

translation.¹⁴⁰ The most obvious problem with this definition is the vagueness of the term “average.” Only about one-third of seventh to twelfth grade students in America study a foreign language and approximately 9% of students enroll in a foreign language class in college, and most of those students take only an introductory language course.¹⁴¹ Based on these statistics, illustrating the low number of Americans that study a language other than English, it could be reasoned that an “average” American would be deemed to speak only one language—English. However, as previously stated, only 82.1% of Americans speak English at all, and the remaining percentages speak primarily or solely a foreign language.¹⁴² Thus, defining the “average” American buyer is difficult.

3. An Appreciable Segment of American Consumers Who Are Likely to Translate

In another article written for the Practising Law Institute, a different author said that the doctrine of foreign equivalents should not be applied unless the foreign language is “familiar to an appreciable segment of American consumers” and unless the translation is one that is “likely to be made by a significant number of prospective purchasers.”¹⁴³ The article goes on to state that the doctrine of foreign equivalents does not apply in cases where the marks are both foreign words that consumers are “unlikely to translate” into English.¹⁴⁴ Does this suggest that if a mark on a product contains, for example, a Spanish word, and the product is being marketed to the Asian community, the doctrine of foreign equivalents will not apply because a translation is not “likely” to be made by the “prospective purchasers?” Who is to say whether consumers are likely to translate a mark? Are expensive and time-consuming market surveys required to determine how *likely* the mark is to be translated? It could be argued that because none of the prospective purchasers in this imaginary scenario are likely to translate the mark, as it is unlikely they speak Spanish, the doctrine should not apply at all.

140. Kane, *supra* note 24, at § 2:6

141. Press Release, Committee for Economic Development, *CED Urges Increased Investment in International Education and Foreign Language Studies* (Feb. 9, 2006), available at <http://www.actfl.org/i4a/pages/index.cfm?pageid=4277>

142. Central Intelligence Agency, *The World Factbook*, available at <http://www.cia.gov/cia/publications/factbook/geos/us.html#People> (last modified Jan. 10, 2006).

143. Kirkpatrick, *supra* note 10, § 4:3

144. *Id.*

4. The Ordinary American Purchaser Who Would Stop and Translate the Foreign Word Into Its English Equivalent

Both the U.S. Court of Customs and Patent Appeals (now the U.S. Court of Appeals for the Federal Circuit) and the TTAB follow the last-stated approach, and hold that the doctrine of foreign equivalents only applies when the word is from a language familiar to “an appreciable segment of American consumers,”¹⁴⁵ meaning “those American buyers familiar with the foreign language” at issue.¹⁴⁶ However, the Federal Circuit and the TTAB have limited application of the doctrine of foreign equivalents to only those instances where it is likely that “the ordinary American purchaser” would “stop and translate the foreign word” into its English equivalent.¹⁴⁷ Thus, if it is unlikely that an ordinary American buyer will translate the foreign-word mark and will simply take it as is, then the doctrine of foreign equivalents will not be applied.¹⁴⁸ The question thus becomes whether the consumer is *likely* to translate the foreign word, and the ultimate conclusion depends on whether an appreciable number of purchasers in the United States, whom courts presume to speak English as well as the pertinent foreign language, will not only understand the meaning of the foreign-word mark at issue, but will also translate the mark into its English equivalent.¹⁴⁹

For example, in a case involving a Chinese-language mark for a newspaper targeted at the Chinese-American community, registration of the mark was refused on the ground that a “sizeable number” of American consumers who speak Chinese would be likely to understand and translate the mark, and in so doing the mark would become merely descriptive.¹⁵⁰ Contrastingly, in a case involving the marks TIA MARIA for a Mexican restaurant and AUNT MARYS for canned vegetables, no confusion was found because ordinary consumers were likely to take the phrase TIA MARIA as is without translating it into English.¹⁵¹

145. TMEP § 1207.01(b)(vi).

146. *Id.* at § 1209.03(g).

147. *E.g.*, *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1377 (Fed. Cir. 2005) (citing *In re Pan Tex Hotel Corp.*, 190 U.S.P.Q. 109, 110 (T.T.A.B. 1976)).

148. *Palm Bay Imps.*, 396 F.3d at 1377; *Sutter Home Winery, Inc. v. Madrona Vineyards, L.P.*, 2005 U.S. Dist. LEXIS 4581, at *21 (N.D. Cal. 2005); *see also In re Tia Maria, Inc.*, 188 U.S.P.Q. 534 (T.T.A.B. 1975).

149. *Sutter Home Winery*, 2005 U.S. Dist. LEXIS 4581, at *21-22; *Palm Bay Imps.*, 396 F.3d at 1377.

150. *In re Oriental News, Inc.*, 230 U.S.P.Q. 637, 638 (T.T.A.B. 1986).

151. *Tia Maria*, 188 U.S.P.Q. 534.

5. Problems Created by the Ambiguity and a Suggested Clarification

As demonstrated, which consumer is relevant for purposes of the doctrine of foreign equivalents remains unclear. Is the relevant consumer the "average American buyer,"¹⁵² or "those American buyers familiar with the foreign language,"¹⁵³ or an "appreciable number" of the "prospective purchasers" of the particular goods or services to which the mark applies,¹⁵⁴ or an "appreciable number of purchasers in the United States, whom courts presume to speak English as well as the pertinent foreign language,"¹⁵⁵ or the "ordinary American purchaser" familiar with the foreign language at issue?¹⁵⁶ Impreciseness in the selection of vocabulary has resulted in confusion as to who is the "relevant consumer" for purposes of the doctrine of foreign equivalents. No blame is placed on the courts or scholars who penned these ambiguous definitions; the lack of specificity in the "guideline" that is the doctrine of foreign equivalents itself invites such vagueness. Nevertheless, if the doctrine is to be applied with consistency by lower courts, precision in definitions related to the doctrine is required. Such precision can only be achieved by the origination of a clear definition by an overarching federal governing body, such as the U.S. Congress or the United States Supreme Court.

It is asserted that the following definitions gleaned from various sources should be adopted to determine the "relevant public" for purposes of applying the doctrine of foreign equivalents. The doctrine should *only* be applied when an *appreciable number of ordinary American purchasers of the particular goods or services* in the United States, who speak English as well as the pertinent foreign language, will *understand* the meaning of the foreign-word mark at issue, *and* will *actually translate* that mark into its English equivalent.¹⁵⁷ In this context, "ordinary" should refer only to the class or classes of actual or prospective American customers of the particular goods or services.¹⁵⁸ Further, the translation must be one that is *likely* to be made by a significant number of American prospective purchasers of the particular good or service.¹⁵⁹ In other words, it must be likely that the pertinent

152. Kane, *supra* note 24, § 2:6.

153. TMEP § 1207.01(b)(vi).

154. Kirkpatrick, *supra* note 10, § 4:3.

155. *Palm Bay Imps.*, 396 F.3d at 1377; *Sutter Home Winery*, 2005 U.S. Dist. LEXIS 4581, at *21.

156. *Palm Bay Imps.*, 396 F.3d at 1377.

157. *Sutter Home Winery*, 2005 U.S. Dist. LEXIS 4581, at *22.

158. *In re Omaha Nat'l Corp.*, 819 F.2d 1117, 1119 (Fed. Cir. 1987).

159. Kirkpatrick, *supra* note 10, § 4:3.

consumers will *stop and translate* the word into its English equivalent.¹⁶⁰ This should not be presumed one way or the other; rather, courts and reviewing entities should require demonstration of public understanding and actual translation by reference to competent sources. After this analytical evaluation, if it is proven likely that an American buyer of the particular good or service will understand and then stop and actually translate the foreign-word mark, the doctrine of foreign equivalents should be applied. However, if it is found that the mark is one that is not likely to be understood or to be translated by a relevant consumer that speaks both English and the pertinent foreign language, the doctrine should not apply.¹⁶¹ For example, if it can be shown that a consumer of a particular good or service would take the mark "as is" (such as TIA MARIA¹⁶²), the doctrine of foreign equivalents should not be applied and the mark should not be translated into English.

It should be noted that although the above-stated definitions have already been set forth by various courts and authorities, they have not yet been compiled into one decision by a court or entity with federal precedential weight. These definitions need to be codified in one single opinion by the United States Supreme Court, or in a statute by a federal governing body, such as the U.S. Congress.

E. Marks That Are Generic or Merely Descriptive Under the Doctrine of Foreign Equivalents

The need for more defined standards for the doctrine of foreign equivalents is most obvious in the areas of genericness and mere descriptiveness. Viewed as a whole, decisions in these areas appear arbitrary and random—the unfortunate result of lower court efforts to follow an uncertain guideline because they lack a clear rule.

1. Literal Translation Versus Similar Connotations Versus Primary and Common Translations

Under the doctrine of foreign equivalents, words from modern languages are translated into English before being tested for genericness or mere descriptiveness.¹⁶³ The TTAB has suggested in

160 *Palm Bay Imps.*, 396 F.3d at 1377.

161 *Sutter Home Winery*, 2005 U.S. Dist. LEXIS 4581, at *21.

162 *Tia Maria, Inc.*, 188 U.S.P.Q. 534.

163 2 *McCarthy*, *supra* note 10, § 11:34, at 11-66; Kane, *supra* note 24, § 2:6. It should be noted that foreign surnames should not be translated, but should be treated as surnames.

some case holdings that if the foreign word does not *directly or literally* translate into a term generic for or merely descriptive of the goods the term is only suggestive, and not generic or descriptive.¹⁶⁴

At the same time, other TTAB decisions and the TMEP, indicate that the translation of the mark that counts in determining registrability of a foreign term is not necessarily a literal one; the translation should be the English word or phrase that carries the *same meaning or significance* as the foreign language word or phrase.¹⁶⁵ The test set forth in the TMEP is whether, to those American buyers familiar with the foreign language, the word would have a descriptive or generic connotation.¹⁶⁶ The ultimate goal is to provide a translation that reflects the true meaning of the non-English wording in the mark and that reflects the commercial impression made by the entire phrase.¹⁶⁷

Adding to the muddle, some U.S. Circuit Courts of Appeal have pointed out that the act of translation is an imprecise task, as foreign words sometimes have no exact English equivalent.¹⁶⁸ Thus, it is recommended that courts look to the *primary and common translation* when doing a mark analysis under the doctrine of foreign equivalents.¹⁶⁹ Applying this theory, in an aforementioned case, two marks for lollipops containing the word *chupa* were denied on the basis that *chupa* is Spanish slang for "lollipop" and although the proper Spanish translation of *chupa* is "to lick" or "to suck," when using the primary and common translation of the word the term was held to be generic as applied to the parties' products.¹⁷⁰

The confusion created by these variances in translation is evident from case decisions. For example, applying the rule that the foreign word must have a "direct" translation into English, the TTAB found the mark ATAVIO suggestive of fashion jewelry because its translation from Spanish is "the dress and ornament of a person" and does not literally translate as "jewelry."¹⁷¹ However, in another decision, the TTAB found the mark SAPORITO, an Italian word meaning "tasty," to be merely descriptive because it

164. See *In re Atavio, Inc.*, 25 U.S.P.Q.2d 1361, at *5 (T.T.A.B. 1992).

165. Kane, *supra* note 24, § 2:6 (emphasis added); TMEP § 809.01.

166. TMEP § 1209.03(g).

167. *Id.* at § 809.01.

168. *Enrique Bernat F., S.A. v. Guadalajara, Inc.*, 210 F.3d 439, 443-44 (5th Cir.), *reh'g and reh'g en banc denied*, 218 F.3d 745 (5th Cir. 2000).

169. *Id.*

170. *Id.*

171. *In re Atavio, Inc.*, 25 U.S.P.Q.2d 1361, at *6 (T.T.A.B. 1992).

described a desirable characteristic of the applicant's dry sausage.¹⁷² It is nearly impossible to reconcile these two decisions. It is submitted that if the *connotation* analysis used in the SAPORITO case was used when examining the ATAVIO mark, the mark would have been denied registration. Although the term ATAVIO does not specifically translate to "jewelry," the term does describe an "ingredient, quality, characteristic, function, feature, purpose or use"¹⁷³ of jewelry, as jewelry is used primarily to ornament the person. Likewise, it is suggested that if the *direct translation* analysis as applied in the ATAVIO case had been used when examining the SAPORITO mark, the mark would have been granted registration. Although some may think that SAPORITO dried sausage is "tasty" and although that term may describe one of the attributes of the applicant's product, the mark does not *directly translate* into English as "dried sausage."

Additionally, in cases decided by the U.S. Court of Customs and Patent Appeals, the U.S. Court of Appeals for the Federal Circuit, and the TTAB, it has been said that if a mark does not *clearly tell* the potential purchaser what the applicant's goods or services are, the term is not merely descriptive.¹⁷⁴ The term "tasty" does not clearly tell the potential purchaser what the applicant's goods or services are. Those same courts have also said that in order for a term to be merely descriptive, it must "immediately convey" knowledge of the ingredients, qualities or characteristics of the applicant's goods.¹⁷⁵ While "tasty" may be a quality or characteristic of sausage, it does not immediately convey knowledge of the identity of the product; tasty could apply to a seemingly limitless array of goods. The decision of the court in the SAPORITO case is more sound when one considers that laudatory terms, such as those that attribute quality or excellence to goods or services, are considered to be merely descriptive under Section 2(e)(1) of the Lanham Act.¹⁷⁶ Even so, the term "tasty," although implying the applicant's sausage tastes good, is not a

172. *In re Geo. A. Hormel & Co.*, 227 U.S.P.Q. 813, at *5 (T.T.A.B. 1985)

173. TMEP § 1209 01(b)

174. *See, e.g., In re Abcor Dev Corp.*, 588 F.2d 811, 814 (C.C.P.A. 1978); *In re Venture Lending Assoc.*, 226 U.S.P.Q. 285, at *2 (T.T.A.B. 1985).

175. *In re Quik-Print Copy Shops, Inc.*, 616 F.2d 523, 525 (C.C.P.A. 1980); *In re Hutchinson Techn., Inc.*, 852 F.2d 552, 555 (Fed. Cir. 1988); *see also Stix Prod., Inc. v. United Merch. & Mfrs., Inc.*, 295 F. Supp. 479, 488 (S.D.N.Y. 1968).

176. TMEP § 1209 03(k).

traditional laudatory term, such as “the best”¹⁷⁷ or “the ultimate.”¹⁷⁸

In the author’s estimation, both of the foregoing cases were wrongly decided. The ATAVIO mark should have been denied registration and the SAPORITO mark should have been granted registration; “the dress and ornament of a person” is much more descriptive of jewelry than is “tasty” of sausage. Even if laudatory, “tasty” could apply to an almost unlimited number of items, whereas the “dress and ornament of a person” can apply to only a limited number of things, one of which is jewelry. Although the “dress and ornament of a person” could apply to all forms of clothing, which is a large category, it is clearly more limited than the categories of items to which the word “tasty” could be applied. Regardless of whether one agrees with that conclusion, the ATAVIO and SAPORITO cases are demonstrative of the disparate results reached, often by the same court, when there is no general agreement as to whether direct, literal translation, similar meaning and connotation, or primary and common translation is the proper standard for determining registrability of a mark.

It is asserted that the proper translation of a foreign term for purposes of the doctrine of foreign equivalents is not the literal one. Rather, the author agrees with the TMEP that the translation should be the English word or phrase that carries the *same meaning or significance* as the foreign language word or phrase.¹⁷⁹ Additionally, the ultimate goal should be to identify the translation that reflects the *true meaning* of the foreign word(s) in the mark and that reflects the *commercial impression* made by the entire phrase.¹⁸⁰

2. Multi-Stage Reasoning Model for Determining Genericness or Descriptiveness

The multi-stage reasoning model is one method used by courts to examine marks for genericness and mere descriptiveness under the doctrine of foreign equivalents. Based on the number of steps (although there is no set number) that are required to get from the mark in a foreign language to the applicant’s product, it will be decided whether the mark is generic or merely descriptive. For

177. *E.g.*, *In re Boston Beer Co. L.P.*, 198 F.3d 1370, 1374 (Fed. Cir. 1999) (holding THE BEST BEER IN AMERICA so highly laudatory and descriptive as applied to beer and ale that it is incapable of acquiring distinctiveness).

178. *E.g.*, *In re Nett Designs Inc.*, 236 F.3d 1339, 1342 (Fed. Cir. 2001) (holding THE ULTIMATE BIKE RACK to be merely descriptive because “ultimate” is laudatory as applied to the goods).

179. TMEP § 809.01.

180. *Id.*

example, a court will take the following steps: (1) no immediate recognition of the term (*e.g.*, dictionary definition, spelling similarity); (2) translation of the term into English; (3) ask if the English term is synonymous with the applicant's product; and (4) ask if the term is the functional equivalent of the applicant's product.¹⁸¹

Using this model, the mark NEPHROSS was denied registration for hollow fiber dialyzes for medical use because NEPHROSS is a misspelling of the word *nephros*, which means "kidney" in Greek, and since the applicant's goods perform the function of the kidney, the mark is merely descriptive applied to the goods.¹⁸² The multi-stage reasoning process for this mark is as follows: (1) spelling similarity—*nephross* to *nephros*; (2) translation—*nephros* (Greek) to human kidney (English), and (3) functional equivalence—human kidney to hollow fiber dialyzer for medical use.¹⁸³ Although the goods are not "kidneys," which is the exact translation of the term into English, it was held sufficient that the mark identified the function or purpose of the goods.¹⁸⁴ The applicant argued that it was unlikely that a significant number of prospective purchasers of their product would speak Greek, and even if they made the translation to English from Greek, their sophisticated buyers, *i.e.*, hospitals, clinics and physicians, would not believe they were buying a human kidney.¹⁸⁵ The court nevertheless followed the rule that the foreign equivalent of a merely descriptive English word is no more registerable than is its English equivalent *regardless of whether or not the foreign term would have any meaning to the general public*.¹⁸⁶ Under this majority rule, when dealing with a foreign term, the concern is not with whether the mark means anything in the English language, but what the term means in the language in which it is written.¹⁸⁷ By the same token, variations or phonetic equivalents of foreign designations are equally unregistrable.¹⁸⁸ The author finds the majority rule misplaced; if the foreign term, once translated, has no meaning to the general American public, it should be registerable. The only issue when considering marks for

181. See *In re Organon Teknika Corp.*, 1983 T.T.A.B. LEXIS 185, at *2, n.1 (T.T.A.B. 1983).

182. *Id.* at *4.

183. *Id.* at *2, n.1.

184. *Id.* at *1.

185. *Id.* at *2.

186. *In re Organon Teknika Corp.*, 1983 T.T.A.B. LEXIS 185, at *3-4 (T.T.A.B. 1983) (citing *Weiss Noodle Co. v. Golden Cracknel & Specialty Co.*, 290 F.2d 845, 846 (C.C.P.A. 1961) (finding "HA-LUSH-KA" generic for noodles when translated from Hungarian)).

187. *Id.* at *3.

188. *Id.* at *3-4.

American trademark registration protection should be consumer recognition in the United States.¹⁸⁹

3. Marks Deemed Generic Under the Doctrine

Generic terms are those that the relevant purchasing public understands primarily as the common or class name for the goods or services.¹⁹⁰ Generic terms are incapable of ever functioning as trademarks denoting source or origin.¹⁹¹ Evidence of the public's understanding of a term can be obtained from any competent source.¹⁹² If the mark is a phrase, the individual components of the mark should not be assessed; rather, the meaning of the composite mark as a whole must be considered to determine its generic character.¹⁹³

The leading case on genericness and the doctrine of foreign equivalents examined the mark "HA-LUSH-KA" (the mark includes the quotation marks) for "egg noodles and egg noodle products."¹⁹⁴ The mark was found to be nothing more than a hyphenated, phonetically-spelled version of the Hungarian *haluska*, meaning "noodles," and therefore the mark is generic as applied to the applicant's goods.¹⁹⁵ The court declared that the name of a thing is the "ultimate in descriptiveness" and it is immaterial that the name is in a foreign language.¹⁹⁶ As the buyers of the "HA-LUSH-KA" noodles were found to be those of the Hungarian-American communities, it was reasoned that they likely would have recognized the term as the generic name of the applicant's noodle products.¹⁹⁷ The court could also have based its decision on the well-established rule that a slight misspelling of a word will not turn a generic word into a non-generic mark.¹⁹⁸ If the misspelling is so phonetically identical to the original generic term that buyers will recognize it as generic, then the misspelled term is still generic.¹⁹⁹

189. *Seiko Sporting Goods U.S.A., Inc. v. Kabushiki Kaisha Hattori Tokeiten*, 545 F Supp. 221, 226 (S.D.N.Y. 1982).

190. TMEP § 1209.01(c).

191. *Id.*

192. *Id.*

193. *Id.* at § 1209.01(c)(i).

194. *Weiss Noodle*, 290 F.2d at 846.

195. *Id.*

196. *Id.* at 847.

197. *Id.* at 846.

198. 2 McCarthy, *supra* note 1, § 11:31, at 11-60 (citing *Restatement (Third) of Unfair Competition* § 14 cmt. a (1995)).

199. *Id.* at 11-62.

a. Majority Jurisdictions

The majority of jurisdictions hold that a word commonly used in another country to identify a kind of product, and in the public domain as a generic or general name in that country, may not be appropriated in the United States as a trademark on that product, "even though the person claiming the word was the one who introduced the product here in the United States, and the word had no significance to the American people generally prior to that introduction."²⁰⁰ Alternatively stated, the foreign equivalent of a generic English word is no more registerable than the English word is regardless of whether or not the foreign term would have any meaning to the general American public.²⁰¹ For example, the mark EST EST EST was held to be generic for an Italian wine because although American consumers were likely unaware of this fact, the term is in common use in Italy to signify wine made in the Italian area of Montefiascone.²⁰² Also, the term OTOKOYAMA was found to be generic for sake when translated from Japanese.²⁰³ The literal translation of *otokoyama* into English is "man/mountain," and not "rice liquor."²⁰⁴ However, in Japan the term *otokoyama* is slang for sake, and although American purchasers would not likely know Japanese slang, it was nevertheless found to be generic as applied to the applicant's goods.²⁰⁵

The difficulty with the majority position is that the decisions have nothing to do with consumer recognition in the United States. As the minority jurisdictions point out, when dealing with American trademark law the only relevant purchasers are American consumers, and therefore foreign usage is not relevant.²⁰⁶ As such, if a term would not be perceived as generic in the United States after being translated into English under the doctrine of foreign equivalents, the mark should be registered and protected in the United States. For example, if translating OTOKOYAMA from Japanese results in "man/mountain," and prospective purchasers of sake in the United States are *unaware* that the term is slang for sake in Japan, the test should be whether "man/mountain" is a generic name for the product. The point of contention taken with the majority jurisdictions is that

200. *Holland v. C. & A. Imp. Corp.*, 8 F. Supp. 259, 261 (S.D.N.Y. 1934) (emphasis added)

201. *Weiss Noodle*, 290 F.2d at 846.

202. *Holland*, 8 F. Supp. at 261.

203. *Otokoyama Co. Ltd. v. Wine of Japan Imp., Inc.*, 175 F.3d 266, 270 (2d Cir. 1999).

204. *Id.*

205. *Id.*

206. *Carcione v. The Greengrocer, Inc.*, 1979 U.S. Dist. LEXIS 9188, at *3, 205 U.S.P.Q. 1075 (E.D. Cal. 1979).

while it is agreed that if a mark is generic *in the United States to American consumers* once translated into English, it does not warrant protection in the United States, if the word had "no significance to the American people generally"²⁰⁷ prior to introduction by the mark applicant, the mark should be granted registration.

b. Minority Jurisdictions

(1) Meaning of a Word in a Foreign Country in Which a Foreign Language Is Spoken

The minority jurisdictions have a much more logical and preferable approach to the genericness (and descriptiveness) analysis. These jurisdictions hold that a term may be generic in one country and suggestive in another.²⁰⁸ The test is whether the mark is generic or descriptive to *prospective purchasers of the good or service in the United States*; persons engaged in the trade for the goods or services, or a non-purchasing segment of the population, are not important.²⁰⁹ For example, efforts to challenge the defendant's mark SEIKO for watches and clocks by attempting to prove that the mark SEIKO is generic in Japan when applied to the defendant's goods were rejected by the District Court in New York *since the only issue was consumer recognition in the United States*.²¹⁰ Although the court did not elucidate what *seiko* means in Japanese, it held that while it may be a generic term in Japan, it is not so recognized in this country, and therefore the mark was still regarded as arbitrary and fanciful in the United States when applied to the defendant's goods.²¹¹

(2) Meaning of a Word in an English-Speaking Foreign Country

Although the doctrine of foreign equivalents most often applies when marks are made up of terms from *foreign languages*,

207. *Holland*, 8 F. Supp. at 261.

208. See, e.g., *Carcione*, 1979 U.S. Dist. LEXIS 9188, at *3, 205 U.S.P.Q. 1075; *Seiko Sporting Goods U.S.A., Inc. v. Kabushiki Kaisha Hattori Tokeiten*, 545 F. Supp. 221, 226 (S.D.N.Y. 1982).

209. *Anheuser-Busch, Inc. v. Stroh Brewery Co.*, 750 F.2d 631, 638 (8th Cir. 1984); *WSM, Inc. v. Hilton*, 724 F.2d 1320, 1328 n.3 (8th Cir. 1984); *Big O Tire Dealers v. Goodyear Tire & Rubber Co.*, 561 F.2d 1365, 1369 (10th Cir. 1977), cert. denied, 434 U.S. 1052 (1978); *Nature's Bounty, Inc. v. SuperX Drugs Corp.*, 490 F. Supp. 50, 54 n.3 (E.D.N.Y. 1980); *Salton Inc. v. Cornwall Corp.*, 477 F. Supp. 975, 985 (D.N.J. 1979); *Blisscraft v. United Plastics Co.*, 294 F.2d 694, 699 (2d Cir. 1961).

210. *Seiko Sporting Goods U.S.A., Inc. v. Kabushiki Kaisha Hattori Tokeiten*, 545 F. Supp. 221, 226 (S.D.N.Y. 1982) (emphasis added).

211. *Id.*

consideration also must be given to marks that are generic or merely descriptive in foreign *countries*—even those countries in which *English is the primary language*. A California court held that it is irrelevant how a term is used outside the United States, and that the genericness of GREENGROCER for fruit and vegetable retailers in England was not determinative of the alleged genericness of that term in the United States.²¹² The court reasoned that because American trademark law and American consumers were at issue, neither British usage of the term, nor the British dictionary definition indicating such usage, was determinative.²¹³ In a U.S. Court of Appeals for the Eighth Circuit case giving consideration to another English-speaking foreign nation, the term L.A. for low alcohol beer was held protectible in the United States because evidence that the term is generic for low alcohol beer in Australia is irrelevant to the question whether it should be accorded the same status in America.²¹⁴ The court did not ascribe weight to the Australian experience in its determination of consumer perceptions or in its ultimate classification of the mark.²¹⁵

The minority jurisdictions engage in a more equitable analysis than that applied by the majority jurisdictions. Although in this digital age and ever-expanding global marketplace the distinction between the majority and minority positions is perhaps more blurred than it once was, the author continues to believe the distinction to be an important and valid one. The function of American trademark law is to distinguish the source of goods or services in the American marketplace. Thus, while consideration of a term's meaning and understanding in a foreign country, with deference to international comity, may be appropriate as one small aspect of the analysis, overall it should not matter if a word is generic or descriptive in another country if it would not be so perceived by *American* purchasers. The only issue should be consumer recognition *in the United States*.²¹⁶ While a blind eye must not be turned to the desire for international comity and the fact that commerce is becoming increasingly global, one must also not lose sight of the fact that the primary concern when dealing with *American* trademark law is how *American* consumers perceive the mark.

Further, since United States trademark protection does not extend or apply beyond America's borders, it is of little importance

212 *Carcione*, 1979 U.S. Dist. LEXIS 9188, at *3, 205 U.S.P.Q. 1075.

213 *Id.*

214 *Anheuser-Busch*, 750 F.2d at 638.

215 *Id.*

216 *Seiko Sporting Goods U.S.A.*, 545 F. Supp. at 226.

whether the word is generic or descriptive in *another country* if it would not be so perceived on American soil. The purpose of an American trademark is not to determine whether someone from a foreign country would recognize it as a descriptive or generic term for a product in their *own country*; rather, the purpose is to identify the source of the product and provide protection to the American purchasing public.²¹⁷

It is submitted that if a mark is generic *in the United States to American consumers* once translated into English, it does not warrant protection in the United States. However, if the word had "no significance to the American people generally"²¹⁸ prior to introduction of the mark to *American consumers*, or if once translated it is arbitrary, fanciful or suggestive to *American consumers*, the mark should be granted and protected under United States trademark law, regardless of the significance the term may have had in its original country.

c. *Conflicted Jurisdictions*

An additional problem is that individual jurisdictions do not consistently follow the majority or minority rule. The GREENGROCER case, cited as a minority jurisdiction case, was decided by a U.S. District Court in California.²¹⁹ However, two early California Supreme Court cases appear to follow the majority jurisdiction rule that a generic word for a product in another country may not be utilized in the United States as a trademark on that same product even though the person claiming trademark rights in the word was the one who introduced the product in America, and at the time of introduction, the word had no significance to the American people.²²⁰ In one of these cases the California Supreme Court held that SCHNAPPS was generic for gin when translated from Dutch, despite the fact that its literal translation from German means "dram" or "drink."²²¹ The court noted that although the term's former use had previously been confined to Europe, it had long been in common use there to designate gin manufactured at Schiedam, Holland, and therefore could not be appropriated as a trademark for gin in the United States.²²² In another decision by the California Supreme Court, a potential infringer of the mark TIPO for wine introduced evidence that the term *tipo* was an adjective in Italian indicating "type" or

217. *Coca-Cola Co. v. Vivian Ice, Light & Water Co.*, 150 La. 445, 448 (La. 1920).

218. *Holland*, 8 F. Supp. at 261.

219. *Carcione*, 1979 U.S. Dist. LEXIS 9188, at *3, 205 U.S.P.Q. 1075.

220. *Holland*, 8 F. Supp. at 261.

221. *Burke v. Cassin*, 45 Cal. 467, 476 (Cal. 1873)

222. *Id.*

"kind."²²³ The owner of the TIPO mark had been using it for many years when the defendant began marketing wine using the word *tipo* as an adjective to connote a wine with the general characteristics or qualities of a kind of wine (e.g., Tipo Barbera, Tipo Chianti).²²⁴ The court held that since *tipo* means "type," and the English word "type" would not be protected under trademark law, the word *tipo* may not be protected in the United States either, even though it was not previously known to the American public to mean "type."²²⁵

The California courts are thus conflicted regarding whether a mark may be protected in the United States if it is generic in a foreign country and then introduced to America as a proprietary mark. Perhaps these three cases can be reconciled in that the two California Supreme Court cases dealt with translation of a word from a foreign language, while the GREENGROCER case dealt only with the generic connotation that an English-language term had previously in a foreign country. Notwithstanding this distinction, it is suggested that even allowing for that possibility, the cases cannot be reconciled. Either a court should give deference to evidence that a word is generic for a product in another country, even though the person claiming the word as a trademark was the first one who introduced the product in America (majority rule), or the court should test genericness by the understanding of prospective purchasers of the article in the United States and it is irrelevant how the word is perceived in a foreign country (minority).

The author firmly supports the minority rule. As previously argued, once a mark is translated from a foreign language into English under the doctrine of foreign equivalents, if that mark is generic *in the United States to American consumers*, it does not warrant protection. However, if the word had "no significance to the American people generally"²²⁶ prior to introduction into the United States, the mark should be granted registration and protected.

4. Marks Deemed Merely Descriptive Under the Doctrine

A mark is merely descriptive if it *immediately* conveys to one seeing or hearing it some knowledge of an ingredient, quality, characteristic, function, feature, purpose or use of the specified

223. *Italian Swiss Colony v. Italian Vineyard Co.*, 158 Cal. 252, 257 (1910)

224. *Id.* at 255.

225. *Id.*

226. *Holland*, 8 F Supp. at 261.

goods or services.²²⁷ It is not necessary that a term describe all of the properties or functions of the goods or services in order for it to be deemed descriptive thereof; registration will be refused if the term is merely descriptive of *any* of properties or functions of the goods or services for which the registration is sought, or if the term describes any other significant attribute of the goods or services.²²⁸ Marks should not be considered in the abstract, but in the context in which the mark is used or intended to be used, and taken into consideration as well is the possible significance the mark would have to the average purchaser of the goods or services in the marketplace.²²⁹

Like the cases previously analyzed that examined genericness, there is also a split in authorities regarding when a mark will be deemed to be merely descriptive under the foreign equivalents doctrine. The majority of courts find that the foreign equivalent of a merely descriptive English term is no more registerable than the English term itself, *despite the fact that the foreign term may not be commonly known to members of the general public* in the United States.²³⁰ The minority rule, however, and the rule applied even in a small number of cases in purported “majority” jurisdictions, is that a foreign-word mark may be registered where the foreign expression is one that even those familiar with the foreign language would not translate, or where it is unfeasible or unlikely that a purchaser would translate the foreign expression when it is encountered on goods in a marketing environment.²³¹ The minority rule, considered an “exception” to the general rule, seems to be followed more often than the rule itself. This “exception” is more logical; if the foreign term is not commonly known to members of the general public in the United States, there seems to be little reason to deny it registration. The majority rule goes against the premise that the only relevant purchasers are American consumers.²³²

There are several cases that tellingly illustrate the need for a more reliable rule regarding the merely descriptive nature of

227. TMEP § 1209.01(b); *In re Quik-Print Copy Shops, Inc.*, 616 F.2d 523, 525 (C.C.P.A. 1980); *In re Hutchinson Tech., Inc.*, 852 F.2d 552, 555 (Fed. Cir. 1988); *Stix Prod., Inc. v. United Merch. & Mfrs., Inc.*, 295 F. Supp. 479, 488 (S.D.N.Y. 1968).

228. *In re Mine Safety Appliances Co.*, 66 U.S.P.Q.2d 1694, at *5 (T.T.A.B. 2002) (emphasis added).

229. TMEP § 1209.01(b)

230. *In re Jos. Schlitz Brewing Co.*, 223 U.S.P.Q. 45, at *1 (T.T.A.B. 1983) (emphasis added) (denying registration of the mark KUHLBRAU for beer since it is likely purchasers will translate it into English as “Fresh or Cool Brewery” or “Fresh or Cool Brew”)

231. *Id.* at *2

232. *Carcione v. The Greengrocer, Inc.*, 1979 U.S. Dist. LEXIS 9188, at *3, 205 U.S.P.Q. 1075 (E.D. Cal. 1979)

foreign-word marks.²³³ However, the case that most thoroughly demonstrates the need for firmer guidance is the GASA decision.²³⁴

In a leading, but what the author deems to be a poorly-reasoned and wrongly-decided foreign equivalents case, the mark GASA for toilet paper was held to be merely descriptive since *gasa* is the Spanish word for gauze (a thin, slight, transparent fabric).²³⁵ The Commissioner of Trademarks concluded that the mark was merely descriptive of the supposed quality of the toilet paper.²³⁶ The Commissioner, relying on the premise that a mark may be refused registration on the alternative grounds that the mark is *either* merely descriptive *or* deceptively misdescriptive of the goods or services,²³⁷ further concluded that even if the word was not merely descriptive of toilet paper, it was plainly deceptively misdescriptive because toilet paper is not made of gauze.²³⁸ The author argues that even if the term GASA is translated into English to mean "gauze," it is unlikely that *American* purchasers would think of "gauze" as merely descriptive of toilet paper; it is much more reasonable to assume they would imagine something used for first aid purposes.

The GASA opinion adopts the rule that a merely descriptive word in a foreign language, *though meaningless to the public generally*, falls within the doctrine of foreign equivalents and the U.S. Trademark (Lanham) Act because it is the real signification of the word or device, and not the ideas that it may, or may not, convey to the general public, that bring it within the Lanham

233. *E.g.*, *In re Geo. A. Hormel & Co.*, 227 U.S.P.Q. 813, at *5 (T.T.A.B. 1985) (finding the mark SAPORITO, an Italian word meaning "tasty," merely descriptive because it described a desirable characteristic of the applicant's dry sausage); *In re Atavio, Inc.*, 25 U.S.P.Q.2d 1361, at *6 (T.T.A.B. 1992) (finding the mark ATAVIO suggestive of fashion jewelry because its translation from Spanish is "the dress and ornament of a person," and that does not specifically describe jewelry)

234. *In re N. Paper Mills*, 20 C.C.P.A. 1109, 1111 (C.C.P.A. 1933).

235. *Id.* at 1110.

236. *Id.* at 1111.

237. *Trademark Trial and Appeal Board Manual of Procedures* § 1215 (2d ed. 2004). The result of the rule allowing marks to be denied registration on alternative grounds is that a trademark applicant is forced to delicately tread the tightrope between mere descriptiveness and deceptive misdescriptiveness. For example, if a trademark application is denied based on mere descriptiveness, the applicant may wish to file a response with the Examiner in an attempt to convince him or her that, in fact, the mark is not merely descriptive of the applicant's goods or services. Yet, if the applicant succeeds in so convincing the Examiner, the applicant still risks having the mark deemed deceptively misdescriptive. In this Catch-22 scenario an applicant can work against itself if not careful. How is an applicant to know when to stop arguing that the mark is not merely descriptive before the line is crossed into deceptive misdescriptiveness? The ability of an Examiner to base refusal of a mark on the alternative grounds of mere descriptive or deceptive misdescriptiveness often leads to inequitable results such as the GASA case, putting an applicant in a precarious "no-win" position.

238. *N. Paper Mills*, 20 C.C.P.A. at 1111.

Act.²³⁹ This statement confuses where the focus in trademark law should be placed. As stated numerous times in this article, the United States Supreme Court, and the Lanham Act itself, set forth that the primary purposes of trademark law are to indicate the origin of the article, to assure the public that they are procuring the genuine article, and to secure the manufacturer against the substitution and sale of inferior and different articles as his product.²⁴⁰ While trademarks protect manufacturers as well, all three of these primary objects are for the protection of the consumer. Trademarks indicate origin to assist the consumer in determining the source of the product they are purchasing, and they guarantee to the consumer that what they are procuring is the genuine article and not an inferior replica. To claim that a foreign word that is meaningless to the public generally still falls within the doctrine is to ignore the main reasons the United States maintains a trademark system. If consumer protection is the ultimate goal, only those terms that, once translated into English, are meaningful to the relevant purchasing public as merely descriptive of the applicant's product should fall within the doctrine of foreign equivalents.

F. Likelihood of Confusion Test as Applied to Foreign Words

It should be remembered that relating to a trademark's primary goal of indicating a single source of origin is the equally important goal of prevention of the likelihood of consumer confusion in the marketplace. A likelihood of confusion exists when consumers are likely to assume that a product or service is associated with a source other than the original source because of similarities between the two sources' marks or marketing techniques.²⁴¹

Under the doctrine of foreign equivalents, foreign words from common languages are translated into English before undertaking the confusing similarity analysis.²⁴² As discussed, common languages are defined as those languages "familiar to an appreciable segment of American consumers."²⁴³ This does not mean that in order to be "common" the language or dialect must be

239 *Id.* at 1110.

240. *Manufacturing Co. v. Trainer*, 101 U.S. 51, 53 (1880); 15 U.S.C.S. § 1051 (2006).

241. *Sutter Home Winery, Inc. v. Madrona Vineyards, L.P.*, 2005 U.S. Dist. LEXIS 4581, at *14 (N.D. Cal. 2005) (citing *Nutri/System, Inc. v. Con-Stan Indus., Inc.*, 809 F.2d 601, 604 (9th Cir. 1987); *Shakey's Inc. v. Covalt*, 704 F.2d 426, 431 (9th Cir. 1983)).

242. *Sutter Home Winery*, 2005 U.S. Dist. LEXIS 4581, at *18; *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1377 (Fed. Cir. 2005).

243. TMEP § 1207.01(b)(vi).

spoken in America as a whole; it is sufficient if the language is associated with a particular region, cultural movement, or legend.²⁴⁴ However, words, even those from familiar modern languages, which are not in general or common use, and are unintelligible and non-descriptive to the general public, although possibly known to linguists and scientists, should *not* be translated into English under the doctrine of foreign equivalents.²⁴⁵ Also, words from “dead or obscure” languages, such as Latin, may be so unfamiliar to the American buying public that they should not be translated into English.²⁴⁶

1. Desirability of Survey Evidence

In some instances, it is possible for the likelihood of confusion analysis in conjunction with the doctrine of foreign equivalents to be effectively completed in the abstract, using common sense and without the need for evidentiary proof such as market survey evidence. For example, the mark BUENOS DÍAS, meaning “good morning” in Spanish, for soap was held likely to be confused with GOOD MORNING for shaving cream.²⁴⁷ The mark LUPU, translated from Italian to mean “wolf,” for men’s and boys’ underwear was held likely to be confused with WOLF for sportswear.²⁴⁸ Finally, the mark EL SOL, meaning “the sun” when translated from Spanish, for clothing and footwear was held likely to be confused with SUN for footwear.²⁴⁹ The likelihood of confusion between all of the above sets of English and foreign-word marks is clear and costly survey evidence would arguably be unnecessary.

In contrast, the mark DOVE for solid fuel burning stoves and furnaces was held *not* likely to be confused with PALOMA (meaning “pigeon” or “dove” in Spanish) for various forms of gas heating apparatus.²⁵⁰ The decision was based on the fact that the term *paloma* can mean either “pigeon” or “dove,” and in English those words are understood to be different things.²⁵¹ This reasoning is not convincing. Although the two marks may not be

244. *Enrique Bernat F, S.A. v. Guadalajara, Inc.*, 210 F.3d 439, 444 n.4 (5th Cir. 2000), *reh'g and reh'g en banc denied*, 218 F.3d 745 (5th Cir. 2000) (citing *Otokoyama Co. Ltd. v. Wine of Japan Imp., Inc.*, 175 F.3d 266, 271 (2d Cir. 1999)).

245. *E.g., Le Blume Imp. Co. v. Coty*, 293 F. 344, 358 (2d Cir. 1923); *General Cigar Co. Inc. v. G.D.M. Inc.*, 988 F. Supp. 647, 660 (S.D.N.Y. 1997).

246. TMEP § 1207.01(b)(vi).

247. *In re American Safety Razor Co.*, 2 U.S.P.Q.2d 1459, at *5 (T.T.A.B. 1987).

248. *In re Ithaca Indus., Inc.*, 230 U.S.P.Q. 702, at *4 (T.T.A.B. 1986).

249. *In re Hub Distributing, Inc.*, 218 U.S.P.Q. 284, at *2 (T.T.A.B. 1983).

250. *In re Buckner Enter. Corp.*, 6 U.S.P.Q.2d 1316, at *6 (T.T.A.B. 1987).

251. *Id.* at *4.

exact synonyms, they are certainly close enough for a finding of likelihood of confusion. When comparing a foreign-word mark with a mark in English, the words need not be exact synonyms to be deemed confusingly similar.²⁵² This case was decided by the TTAB, which also analyzed the marks EL SOL and SUN and came to an opposite result, although in both cases the products are similar and likely to be in the same channels of commerce.²⁵³

These cases are examples of the inconsistency with which the doctrine is applied by the TTAB and is illustrative of similar conflicting decisions by other courts. The cases are also demonstrative of why, in most cases, the likelihood of confusion analysis cannot be done effectively in the abstract without evidentiary demonstration of actual confusion in the marketplace by reference to such things as expert witness testimony in the fields of, among others, language, society and culture, survey evidence of prospective purchasers, market research, and consumer reaction studies.

2. The (Proper) Standard for a Foreign Equivalents Likelihood of Confusion Analysis as Suggested by the Wine Cases

In a fairly recent case oft-cited by numerous jurisdictions, an appeal to the U.S. Court of Appeals for the Federal Circuit was made from the denial of registration of the mark VEUVE ROYALE, translated from French to mean "royal widow," for sparkling wine on the ground of likelihood of confusion with three previously registered marks for wine by Veuve Clicquot Ponsardin, including the mark THE WIDOW.²⁵⁴ In denying registration, the only word at issue was *veuve*, meaning "widow."²⁵⁵ The TTAB found the mark was confusingly similar to THE WIDOW mark because, under the doctrine of foreign equivalents, an appreciable number of purchasers in the United States who speak and/or understand French would translate the mark into English as "Royal Widow."²⁵⁶ However, on appeal, the court held that the TTAB was "inconsistent in its application of the doctrine of foreign equivalents" and reminded the TTAB that the doctrine is only a guideline to be applied when the "ordinary American purchaser" would "stop and translate the word into its foreign equivalent."²⁵⁷

252. Kirkpatrick, *supra* note 10, at § 4:3.1

253. *In re Hub Distributing, Inc.*, 218 U.S.P.Q. 284, at *2 (T.T.A.B. 1983).

254. *Palm Bay Imps.*, 396 F.3d at 1377.

255. *Id.*

256. *Id.*

257. *Id.*

The Federal Circuit held that it was improbable that the ordinary American purchaser of wine would stop and translate VEUVE into "widow," and as a result, there was no likelihood of confusion with the mark THE WIDOW.²⁵⁸ The Federal Circuit's analysis in this case should work as a model for other courts when analyzing cases under the doctrine of foreign equivalents; the court recognized that the doctrine is only a guideline, but stressed the importance of consistent application.²⁵⁹

In the first U.S. Court of Appeals for the Ninth Circuit case to use the doctrine of foreign equivalents when doing a likelihood of confusion analysis, the court adopted the Federal Circuit's reasoning from the VEUVE ROYALE case and considered the likelihood of confusion between the mark MÉNAGE À TROIS (the phrase commonly referring to a "sexual relationship involving three partners" or "a household of three") and the mark MÉLANGE DE TROIS ("mixture of three"), both for wine.²⁶⁰ The court initially debated whether application of the doctrine of foreign equivalents was appropriate at all, because many courts hold that the doctrine applies only to cases involving the comparison of one foreign-word mark to a mark written in English.²⁶¹ Ultimately, however, the court adopted the view that the doctrine of foreign equivalents applies with equal force to a likelihood of confusion inquiry entailing comparison of two foreign-word marks.²⁶² The court based its decision to accept this rule on the TTAB observation that "the fact that both marks may be comprised of foreign words should not mean that a court can disregard their meanings" when doing a likelihood of confusion analysis.²⁶³ The court also adopted the rule that confusion depends on whether an appreciable number of purchasers in the United States, whom courts presume to speak English as well as the pertinent foreign language, will understand the meaning of the foreign-word mark at issue and translate that mark into its English equivalent.²⁶⁴ When it is unlikely that an American buyer will translate the foreign-word mark the doctrine of foreign

258. *Id.* (quoting *In re Pan Tex Hotel Corp.*, 190 U.S.P.Q. 109, 110 (T.T.A.B. 1976) (holding the mark VEUVE ROYALE unregistrable on other grounds)).

259. *Palm Bay Imps.*, 396 F.3d at 1377.

260. *Sutter Home Winery*, 2005 U.S. Dist. LEXIS 4581, at *2, 19-20.

261. *Id.* at *20-21; e.g., *Safeway Stores, Inc. v. Bel Canto Fancy Foods, Ltd.*, 5 U.S.P.Q.2d 1980, 1982 (T.T.A.B. 1987) (quoting 2 McCarthy, *supra* note 1, § 23:14, at 23-80 ("If the two marks alleged to be confusingly similar are both foreign words, it may be that the doctrine of foreign equivalents is not applicable.")).

262. *Sutter Home Winery*, 2005 U.S. Dist. LEXIS 4581, at *20-21.

263. *Id.*; *In re Lar Mor Int'l, Inc.*, 221 U.S.P.Q. 180, 181 (T.T.A.B. 1983).

264. *Sutter Home Winery*, 2005 U.S. Dist. LEXIS 4581, at *22.

equivalents will not be applied.²⁶⁵ Applying all of the newly adopted rules and after weighing the likelihood of confusion factors,²⁶⁶ the court found that although the MÉNAGE À TROIS and MÉLANGE DE TROIS marks are very similar, there is no likelihood of confusion between them.²⁶⁷ Interestingly, the court found that both marks consisted of French words that are so commonly used and understood in America that they could just as aptly be characterized as part of the lexicon of American English, and that this was especially true if one focused on the likely purchasers of the parties' wines.²⁶⁸ In the final analysis, the court held that, presuming that an appreciable number of likely purchasers would be familiar with the English-language definitions of both marks and understand that the meanings are different, there was no likelihood of confusion.²⁶⁹ The author does not necessarily agree that these two marks are not confusingly similar; they are strikingly similar in sound, appearance and commercial impression—especially to someone who is unfamiliar with the French terms or language. Nevertheless, it is proposed that the principles used by the court in reaching its decision, like those used by the Federal Circuit in the VEUVÉ case, are correct and should serve as a framework for future application of the doctrine of foreign equivalents.

It is submitted that the rules set forth in these cases by the Federal and Ninth Circuits are sound standards that would well serve the doctrine of foreign equivalents if used by all jurisdictions and the TTAB. It is hoped that other jurisdictions and the TTAB, as well as lower courts within the Circuit Courts of Appeal, will take heed of these decisions and follow them. Courts and reviewing entities should recognize that the doctrine is only a guideline, but should nevertheless strive for consistent application of the doctrine.

265. *Id.* at *21.

266. *E.g.*, *In re E. I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973); *Palm Bay Imps.*, 396 F.3d at 1377 (test set forth in *In re E. I. Du Pont de Nemours & Co.* adopted in its entirety by the Federal Circuit); *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341, 353 (9th Cir. 1979) (eight factor revised version of test adopted).

267. *Sutter Home Winery*, 2005 U.S. Dist. LEXIS 4581, at *25-26.

268. *Id.* at *23; *But cf. In re Le Sorbet, Inc.*, 1985 T.T.A.B. LEXIS 27, at *4 (T.T.A.B. 1985) (holding that regardless of how widespread a foreign word's use is in America, it remains a foreign word for purposes of the doctrine of foreign equivalents and therefore must be translated into English).

269. *Sutter Home Winery*, 2005 U.S. Dist. LEXIS 4581, at *23-24.

*G. Commercial Impression and the
Doctrine of Foreign Equivalentents*

When examining marks to determine their commercial impression, the overall impression created by the mark is considered.²⁷⁰ The standard analysis when searching for a likelihood of confusion resulting from the similarities of the marks compares the marks at issue in sight, sound, and meaning, and then as a separate element, or as the sum of all three, compares the overall impression created by the designations as they are used in marketing.²⁷¹ Similarity of any one of the elements (sight, sound, meaning) permits, but does not require, a finding that the marks are confusingly similar.²⁷²

Under the doctrine of foreign equivalentents, the commercial impressions created by foreign-word marks are considered in the test for likely confusion between marks.²⁷³ In cases involving the *meaning* of English-language-word marks and foreign-word marks, the foreign words are first translated into English as part of the comparison of meaning or connotation.²⁷⁴ Note though that even where the English translation of a foreign-word mark is used to determine similarity of *meaning*, the *non-translated foreign-word mark* is used when examining similarity in *sight and sound*.²⁷⁵ Translation alone does not decide the question; such similarity as there is in connotation must be weighed against the dissimilarity in sight, sound, and all other factors, for example, the strength of the mark, the similarity of the goods and services, and purchaser care.²⁷⁶ Additionally, when examining commercial impression, the connotation of a term is irrelevant if it is not commonly known in the United States.²⁷⁷

When comparing a *foreign-word mark with a mark in English*, the words need not be exact synonyms to be deemed confusingly similar, but where the only similarity between the marks is in connotation, a much closer approximation may be required to

270. Kirkpatrick, *supra* note 10, § 4:3.1.

271. *Id.*

272. *Id.*

273. Kane, *supra* note 24, § 2:6; see also *Boltega Veneta, Inc. v. Volume Shoe Corp.*, 226 U.S.P.Q. 964, 970 (T.T.A.B. 1985).

274. Kirkpatrick, *supra* note 10, § 4:3.3.

275. *Sutter Home Winery, Inc. v. Madrona Vineyards, L.P.*, 2005 U.S. Dist. LEXIS 4581, at *24 (N.D. Cal. 2005) (quoting *Horn's, Inc. v. Sanofi Beaute Inc.*, 963 F. Supp. 318, 323 (S.D.N.Y. 1997); 3 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 23:37, at 23-84 (4th ed. 1996)).

276. Kirkpatrick, *supra* note 10, § 4:3.1.

277. *In re Mucky Duck Mustard Co., Inc.*, 6 U.S.P.Q. 2d 1467, 1469 (T.T.A.B. 1988).

justify a finding of confusing similarity.²⁷⁸ However, when comparing *two foreign-word marks*, either from the same language or from languages likely to be *perceived* as the same (e.g., Italian and Spanish to those who do not understand the languages), it would be improper to translate each mark and compare the English translations for similarity of connotation if consumers are unlikely to do so.²⁷⁹ Rather, only the commercial impressions created by the marks are to be assessed.²⁸⁰

When settling a likelihood of confusion dispute between the owner of the English-language mark "blue ribbon" for shelled and unshelled edible nuts, and the French-word mark CORDON BLEU for miscellaneous food products, the court found that notwithstanding that CORDON BLEU can be literally translated into English from French as "blue ribbon," the marks in the United States project different impressions and would not likely be equated as identical expressions.²⁸¹ Thus, registration of BLUE RIBBON did not preclude registration of the mark CORDON BLEU, even though the parties had overlapping channels of trade.²⁸²

To demonstrate situations where two foreign-word marks from modern languages are at issue, the marks BORSA VENETO and BOTTEGA VENETA, both for handbags, were held confusingly similar because the second words in each mark are virtually indistinguishable in sound and appearance to those persons not versed in foreign languages in general, or Italian in particular, and to persons versed in Italian, they are confusingly similar in commercial impression as well.²⁸³ Similarly, the marks GOLDTROPFCHEN and GOLDENER TROPFEN were found to be confusingly similar to those American customers who do not speak German, and thus do not know how the respective marks translate into English because "both marks are the word 'gold' followed by a jaw-breaking string of consonants."²⁸⁴

When comparing two marks containing the archaic and obscure word *telesis*, the mark PACIFIC TELESIS for a telephone company doing business under the name Pacific Telesis Group, was found *not* to be confusingly similar to the mark

278. Kirkpatrick, *supra* note 10, § 4:3.1.

279. *Id.* (citing *Safeway Stores, Inc. v. Bel Canto Fancy Foods, Ltd.*, 5 U.S.P.Q.2d 1980, 1982, (T.T.A.B. 1987) (holding BEL ARIA and BEL-AIR not confusingly similar)).

280. *Id.*

281. *Continental Nut Co. v. Cordon Bleu, Ltee*, 494 F.2d 1397, 1398 (C.C.P.A. 1974).

282. *Id.*

283. *Bottega Veneta*, 226 U.S.P.Q. at 970.

284. *Stabilisierungsfonds für Wein v. Peter Meyer Winery GmbH*, 9 U.S.P.Q.2d 1073, 1075 (T.T.A.B. 1988).

INTERNATIONAL TELESIS GROUP for a telecommunications consulting business, even though a modern person might think that the "tele" portion of both marks in the context of telecommunications denoted a system of distance communications.²⁸⁵ This case virtually sidestepped the commercial impression created by the ancient Greek prefix *tele*, as well as the use of the archaic word *telesis* in both marks. If the court had seriously considered the very similar sight, sound and commercial impressions of the marks, they likely would have been deemed confusingly similar.

Similarly, in a case already examined, the court ignored the commercial impressions created by the marks MÉNAGE À TROIS and MÉLANGE DE TROIS, and found that although the marks were very similar, there was no likelihood of confusion between them.²⁸⁶ The author believes these two marks to be just as confusingly similar, if not more so, than the marks BORSA VENETO and BOTTEGA VENETA²⁸⁷ in sight, sound and commercial impression, at least to those not versed in foreign languages.

IV. PRACTICE NOTE FOR APPLICANTS OF FOREIGN-WORD MARKS

As a quick practice note, under the trademark doctrine of foreign equivalents, a registration applicant is required to disclose the English meaning of any foreign word used in the mark, in order that the Examiner may determine whether that foreign word is generic or merely descriptive when applied to the goods or services.²⁸⁸ The application must include a statement translating the foreign word(s).²⁸⁹ The translation that should be submitted and relied upon is the English meaning that has significance in the United States.²⁹⁰ The ultimate goal is to provide a translation that reflects the true meaning of the non-English wording in the mark and, if part of a phrase, to reflect the commercial impression made by the entire phrase.²⁹¹

It is generally unnecessary to provide a translation of a foreign term if the term appears in an English dictionary (*e.g.*, *croissant*,

285. *Pacific Telesis Group v. International Telesis Communications*, 994 F.2d 1364, 1367 (9th Cir. 1993).

286. *Sutter Home Winery*, 2005 U.S. Dist. LEXIS 4581, at *25-26.

287. *Bottega Veneta*, 226 U.S.P.Q. at 970.

288. TMEP § 809, *et seq.*

289. *Id.*; 37 C.F.R. § 2.32(a) (2006).

290. TMEP § 809.01.

291. *Id.* at § 809; 37 C.F.R. § 2.32(a) (2006).

fiesta or flambé).²⁹² It is also generally unnecessary to provide a translation of foreign articles or prepositions, such as *de*, *le*, *la* or *il*, when combined with English terms, or to translate words from dead or obscure languages.²⁹³

This quick overview in no way purports to be a full explanation of the requirements for applications containing a foreign-word mark; it simply serves as a practical guidepost upon which to view the doctrine of foreign equivalents. The TMEP, as well as all relevant statutes, should be consulted before attempting to register a foreign-word mark.

V. CONCLUSION

Hopefully, this collection and critical analysis of cases applying the doctrine of foreign equivalents has illustrated that the current state of the doctrine is generally unhelpful in providing trustworthy precedents. Because many of the decisions are in direct contradiction, an applicant or court has no sound basis upon which to consider and examine marks that contain foreign words. Although an applicant or court may follow the precedent of their own jurisdiction, this presumes that decisions within one's own jurisdiction will not conflict—this is not the case. Additionally, even if an applicant or the court follows the jurisdiction's precedents, there is no guarantee that a trademark examiner or the TTAB will follow the same precedents when coming to a decision regarding registrability or the likelihood of confusion. As such, registration applicants, trademark examiners, and the courts are left to flounder in their attempts to make use of the doctrine of foreign equivalents precedents.

A more specific set of principles is warranted. As the "guideline" that is the doctrine of foreign equivalents currently stands, it does not serve a useful purpose in U.S. trademark law. This article suggests that the tenets set forth in the Introduction be adopted by either the U.S. legislature or the United States Supreme Court so that arbitrary and irreconcilable decisions are no longer reached, and so that registration applicants, trademark examiners, and the courts have a dependable standard upon which to rely.

292. TMEP § 809

293. *Id*