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Far from Fluent: Making Sense of the Doctrine of Foreign Equivalents

Anne Gilson LaLonde

Commentary: The Rogers Test Dances Between Trademark Protection Under the Lanham Act and Freedom of Speech Under the First Amendment.

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The Trademark Reporter®

FAR FROM FLUENT: MAKING SENSE OF THE DOCTRINE OF FOREIGN EQUIVALENTS*

*By Anne Gilson LaLonde***

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I. INTRODUCTION

My vote for the best Google Translate translation of “the doctrine of foreign equivalents” is Welsh: *athrawiaeth cyfatebolion tramor*.¹

Still, there are plenty of other worthy candidates. In Bengali, it’s বিদেশী সমতুল্য মতবাদ. In Maltese, it’s *id-duttrina tal-ekwivalenti barranin*. In Kyrgyz, it’s чет өлкөлүк эквиваленттер доктринасы. In Swahili, it’s *mafundisho ya wa kinegi*. And in Telugu, it’s విదేశీ సమానమైన సిద్ధాంతం.

Understanding the trademark law doctrine of foreign equivalents can feel much like an English-language speaker attempting to decipher an article in Welsh: mind-numbing, frustrating, and confounding.² This article aspires to be none of those.

For decades, it has been “well established that foreign words or terms may not be registered if the English language equivalent has been previously used on or registered for products which might reasonably be assumed to come from the same source.”³ Also true for decades, it has been “well established . . . that the foreign equivalent of a merely descriptive English word is no more registrable than the English word itself despite the fact that the foreign term may be meaningless to the public generally.”⁴ Though the basic principles of the doctrine seem to have been “well established” for many years, there remains much confusion and consternation about its application in practice.

Let’s see if we can sort it out. This article will begin by showing how the doctrine works in the United States, both in litigation and at the United States Patent and Trademark Office (“USPTO”), with plenty of examples. Then it will dig into the fundamentals of each element, pausing occasionally to wrestle with the doctrine’s assumptions, flaws, and inconsistencies. And it will provide a handy checklist of exceptions that may prevent the doctrine from being applied. There should be something for everyone.

¹ See Google Translate, <https://translate.google.com> (last visited September 19, 2022).

² For those of you just here for the Welsh, that Google translates as: *Gall deall athrawiaeth y gyfraith nod masnach o gywerthoedd tramor deimlo'n debyg iawn i siaradwr Saesneg yn ceisio dehongli erthygl yn Gymraeg: dideimlad, rhwystredig a dryslyd*.

³ *Ex parte Odol-Werke Wien Gesellschaft M.B.H.*, 111 U.S.P.Q. 286 (Comm’r 1956).

⁴ *In re Hag Aktiengesellschaft*, 155 U.S.P.Q. 598 (T.T.A.B. 1967); see also, e.g., *In re Northern Paper Mills*, 64 F.2d 998, 998–99 (C.C.P.A. 1933) (“[W]e believe the rule has been well established by other courts . . . that a word taken from a well-known foreign modern language, which is, itself, descriptive of a product, will be so considered when it is attempted to be registered as a trade-mark in the United States for the same product.”); *In re Bradford Dyeing Ass’n*, 46 App. D.C. 512, 513 (D.C. Cir. 1917) (“Descriptive words and phrases in a foreign language are not registerable.”).

II. OVERVIEW OF THE APPLICATION OF THE DOCTRINE

A. Origin and Context

The doctrine of foreign equivalents has been around for a long time in the United States. In 1904, the Southern District of New York found that PARCHEESI was not a valid trademark for a particular board game because that term was quite similar to “the Hindoostanee name of the game pronounced in India.”⁵ In 1920, the D.C. Circuit affirmed the then-U.S. Patent Office’s refusal to register EL GALLO for tobacco based on another entity’s preexisting registration for OUR ROOSTER and the image of a rooster for the same product, saying: “It matters not that appellant has employed the Spanish language, instead of English.”⁶

In the United States, under the doctrine of foreign equivalents,⁷ foreign-language words in trademarks may be translated into English to answer one of two questions: (1) would consumers understand the English translation to be distinctive for the goods or services at issue, and (2) would the English translation make it likely that consumers would be confused about the source of those goods or services? So, the doctrine can come into play in two distinct contexts: assessing the *validity* of a foreign-language mark and determining whether a foreign-language mark and an English mark are *confusingly similar*.

This odd duality tends to complicate matters. They’re both known as the doctrine of foreign equivalents but they don’t have the same function. Let’s first split them up and then return to larger questions about the doctrine as a whole.

B. Validity Analysis

1. Basic Principles

Generic terms cannot receive trademark protection for the goods or services they designate.⁸ If a foreign-language mark translated

⁵ Selchow v. Chaffee & Selchow Mfg., 132 F. 996, 998 (S.D.N.Y. 1904).

⁶ *In re Maclin-Zimmer-McGill Tobacco Co.*, 262 F. 635, 635 (D.C. Cir. 1920).

⁷ Definitely not to be confused with the patent law doctrine of equivalents. See *AquaTex Indus. v. Techniche Solutions*, 479 F.3d 1320, 1326 (Fed. Cir. 2007) (“A finding of infringement under the doctrine of equivalents requires a showing that the difference between the claimed invention and the accused product or method was insubstantial or that the accused product or method performs the substantially same function in substantially the same way with substantially the same result as each claim limitation of the patented product or method.”); United States Patent and Trademark Office (“USPTO”) Manual of Patent Examining Procedure (“MPEP”) § 2186 (9th ed. 2020) (“If an accused product or process does not literally infringe a patented invention, the accused product or process may be found to infringe under the doctrine of equivalents.”).

⁸ See Anne Gilson LaLonde, *Gilson on Trademarks*, § 2.02, for more on generic names.

into English is generic for the goods or services sold under the mark, it is unregistrable and unenforceable in the United States to the same extent the English version of the mark would be.⁹ If the foreign-language mark as translated is merely descriptive of the goods or services, it has to acquire distinctiveness in consumers' minds in order to be registrable and enforceable, just as a merely descriptive term in English would.¹⁰

2. Examples and Guidelines

The following have been categorized as *generic* terms that were refused registration under the validity analysis of foreign equivalents:

- FAMILIA DENTAL (translated as “family dental” from Spanish), generic for “dental hygienist services; dentist services; orthodontic services”¹¹
- KUHLEBRAU (translated as “cool brew” from German), generic for beer¹²
- KUK SOOL and KUK SOOL WON (translated as “traditional martial arts” and “martial arts instruction entity” from Korean), generic for martial arts¹³
- CHAO (translated as “fermented tofu” from Vietnamese), generic for non-dairy cheese¹⁴

⁹ See, e.g., *Enrique Bernat F., S.A. v. Guadalajara, Inc.*, 210 F.3d 439, 443 (5th Cir. 2000) (holding that the doctrine of foreign equivalents “requires courts to translate foreign words into English to test them for genericness or descriptiveness”); *Nestle’s Milk Prods., Inc. v. Baker Importing Co.*, 182 F.2d 193, 196 (C.C.P.A. 1950) (“Foreign language words, not adopted into the English language, which are descriptive of a product, are so considered in registration proceedings. . . .”); *In re Twenty-Two Desserts, LLC*, 2019 U.S.P.Q.2d 292782 (T.T.A.B. 2019) (“The doctrine of foreign equivalents is a guideline pursuant to which foreign-language terms in marks may be translated into English and serve as evidence that the English equivalent is understood among the relevant consumers as referring to the goods to show, e.g., that a term is generic.”); *In re Highlights for Children, Inc.*, 118 U.S.P.Q.2d 1268 (T.T.A.B. 2016) (“[N]ormally no distinction can be made between English terms and their foreign equivalents with respect to registrability.”); USPTO Trademark Manual of Examining Procedure § 1209.03(g) (8th ed. July 2022) (hereinafter “TMEP”) (“The foreign equivalent of a merely descriptive English word is no more registrable than the English word itself.”).

¹⁰ For more on descriptiveness, see *Gilson on Trademarks*, *supra* note 8, § 2.03, and for more on acquired distinctiveness, see *id.* § 2.06.

¹¹ *In re Familia Mgmt. Gp., LLC*, 2019 TTAB LEXIS 351 (T.T.A.B. 2019) (not precedential).

¹² *In re Jos. Schlitz Brewing Co.*, 223 U.S.P.Q. 45 (T.T.A.B. 1983).

¹³ *In Hyuk Suh v. Choon Sik Yang*, 987 F. Supp. 783 (N.D. Cal. 1997).

¹⁴ *In re Field Roast Grain Meat Co.*, 2017 TTAB LEXIS 352 (T.T.A.B. 2017) (not precedential).

- MAGNESITA (translated as “magnesia” from Italian and “magnesite” from Spanish and Portuguese), generic for refractory products¹⁵

And the following have been categorized as *descriptive* under the validity analysis:

- LAPELLE (translated as “leather” from Italian), merely descriptive of leather for furniture¹⁶
- EL DÍA MUNDIAL DE LA SALSA (translated as “the World Day of Salsa” from Spanish), merely descriptive of advertising, marketing, and promotion services; entertainment services in the nature of organizing social entertainment events; organization of events for cultural purposes, services to include a salsa music festival¹⁷
- YAMSAFER (transliteration of “traveler” from Arabic), merely descriptive of travel agency services¹⁸
- IMÁGENES ESCONDIDAS (translated as “hidden pictures” from Spanish), merely descriptive of books and magazines for children that feature puzzles where “the reader search[es] for certain objects which are not apparent”¹⁹
- The following mark (translated as “auction” or “sale” from Persian), merely descriptive of “classified advertising services”:²⁰

حراج

Soundalikes, or phonetic equivalents, of foreign descriptive terms are also considered descriptive in the United States.²¹ The Federal Circuit’s predecessor court affirmed cancellation of the mark HA-LUSH-KA for egg noodles and “egg noodle novelties” in light of “haluska” being the Hungarian word for “noodles” and

¹⁵ *In re Magnesita Refractories Co.*, 716 Fed. Appx. 978 (Fed. Cir. 2017).

¹⁶ *In re Shanghai Leather, Inc.*, 2011 TTAB LEXIS 396 (T.T.A.B. 2011) (not precedential).

¹⁷ *In re Pan American Props. Corp.*, 2018 TTAB LEXIS 257 (T.T.A.B. 2018) (not precedential).

¹⁸ *Almosafer Travel & Tourism Co. v. Yamsafer Inc.*, 2018 TTAB LEXIS 446 (T.T.A.B. 2018) (not precedential).

¹⁹ *In re Highlights for Children*, 118 U.S.P.Q.2d 1268.

²⁰ *In re Alreshidi*, 2016 TTAB LEXIS 532 (T.T.A.B. 2016) (not precedential).

²¹ *In re Hag Aktiengesellschaft*, 155 U.S.P.Q. 598 (holding that “variations or phonetic equivalents of foreign designations are equally unregistrable if they are likely to be recognized as such”).

pronounced “ha-lush-ka” in Hungarian.²² The court found that registration “would be contrary to law for no one can be granted the exclusive use of the name of an article, either in our native tongue or its equivalent in any foreign language.”²³

Of course, the translated mark must be compared to the goods or services being sold to determine its distinctiveness.²⁴ For example, the Southern District of New York found that SHAMIR SALADS included the Hebrew word for “dill,” but the mark was not being used to designate salads made with dill.²⁵ Instead, it was used for “a large category of vegetable salads, dips, spreads, and herring products,” so it was suggestive and entitled to protection. Another district court found the mark DUDO OSUN suggestive of African black soap made with camwood and several other ingredients where the phrase meant “black camwood” or “funky camwood” in Yoruba, a West African language.²⁶ And the First Circuit upheld a jury verdict finding ATTREZZI—“tools” in Italian—suggestive of kitchen appliances, utensils, and dinnerware.²⁷

Common laudatory terms in foreign languages may also be excluded from registration or protection in the United States. The Trademark Trial and Appeal Board (“TTAB”), for instance, upheld a refusal to register the following mark for dry sausage where the record showed it was Italian for “tasty.”²⁸

²² Weiss Noodle Co. v. Golden Cracknel & Specialty Co., 290 F.2d 845, 846 (C.C.P.A. 1961). What do you think “egg noodle novelties” could be, reader? Intriguing. *See also, e.g., In re Monarch Wine Co. of Georgia*, 117 U.S.P.Q. 454 (Comm’r Pats. 1958) (affirming refusal to register VINKA for wine where Polish word “winka” (a diminutive for the word for wine) was pronounced “vinka”); *In re The Coney Island Bredzel Co.*, 199 U.S.P.Q. 45 (T.T.A.B. 1978) (BREDZEL, phonetic equivalent of German word “brezel,” not capable of distinguishing source of pretzels).

²³ *Weiss Noodle*, 290 F.2d at 847.

²⁴ *See Gilson on Trademarks, supra* note 8, § 2.01 for more on measuring distinctiveness.

²⁵ *Blue & White Food Prods. Corp. v. Shamir Food Indus.*, 350 F. Supp. 2d 514, 517 (S.D.N.Y. 2004).

²⁶ *Maduka v. Tropical Naturals, Ltd.*, 409 F. Supp. 3d 337, 353–54 (E.D. Pa. 2019) (“[E]ven assuming that the ordinary American purchaser would (or could) stop and translate DUDU OSUN into English, which is highly unlikely, the Court concludes that the DUDU OSUN mark is inherently distinctive and constitutes a valid and legally protectable mark.”). Camwood is “a shrubby, leguminous, hard-wooded tree from central west Africa,” but the Wikipedia entry does not explain what could be “funky” about it. *See* https://en.wikipedia.org/wiki/Baphia_nitida (last visited September 19, 2022).

²⁷ *Attrezzi, LLC v. Maytag Corp.*, 436 F.3d 32, 38 (1st Cir. 2006).

²⁸ *In re Geo. A. Hormel & Co.*, 227 U.S.P.Q. 813 (T.T.A.B. 1985).



Along those lines, finding DOBRA to be Polish for “good,” the TTAB refused to register that mark for the applicant’s canned ham.²⁹

As it does with English-language marks, if a foreign translation is found to be descriptive of the goods or services, the USPTO will consider any stylization to see if that renders the mark registrable. In one case, the applicant had applied for registration of the following mark for “motorcycle seats and ergonomic motorcycle pads for use with seats”:³⁰



Translated from Japanese, SADORU means “saddle.”³¹ Finding the term highly descriptive, if not generic, for the applicant’s goods, the TTAB asked whether the stylized version “creates a separate and inherently distinctive commercial impression apart from the word itself, such that the mark as a whole is not merely descriptive.”³² Unfortunately for the applicant, the TTAB ultimately held that the stylization did not change the tenor of the mark, finding it as a whole merely descriptive.³³

U.S. courts, too, have not hesitated to find foreign-language terms generic or descriptive. In a much-cited decision, the Second Circuit found that “otokoyama” referred to a type of sake in Japan

²⁹ *In re New Yorker Cheese Co.*, 130 U.S.P.Q. 120 (T.T.A.B. 1961); *see also, e.g.*, *Ushodaya Enters. v. V.R.S. Int’l, Inc.*, 63 F. Supp. 2d 329 (S.D.N.Y. 1999) (finding PRIYA merely descriptive of Indian pickles where Indian-English dictionaries suggested the word was laudatory); *In re San Miguel Corp.*, 229 U.S.P.Q. 617 (T.T.A.B. 1986) (finding SELECTA (Spanish for “select”) to be laudatory and descriptive for beer); *In re Bradford Dyeing*, 46 App. D.C. at 513 (affirming the refusal to register E’CLATANT for “cotton piece goods” where the mark was “a French word meaning brilliant, shining, glittering, etc.”).

³⁰ *In re Sadoru Gp., Ltd.*, 105 U.S.P.Q.2d 1484 (T.T.A.B. 2012).

³¹ *Id.*

³² *Id.*

³³ *Id.*; *cf. In re OTRAJET Inc.*, 2018 TTAB LEXIS 275 (T.T.A.B. 2018) (not precedential) (stylized depiction of NEXO did not “mask the translated meaning of Applicant’s mark as ‘nexus’” for comparison to allegedly similar mark).

and denied protection for that term as a trademark for sake.³⁴ In 1966, a district court in California found “volkswagen” descriptive for cars because it meant “peoples’ car” in German, but the court did find it had gained secondary meaning.³⁵

If the translation of the foreign term is a suggestive or arbitrary designation when applied to the goods or services, then it is likely to be categorized as a suggestive or arbitrary trademark. For example, a court found MONDO—“world” in Italian—arbitrary for luggage.³⁶

3. Rationales

There are a few rationales for applying the doctrine of foreign equivalents in validity analysis. The doctrine, first, “strives to prohibit the monopolization of certain words or descriptions that may be shared among languages.”³⁷ Competitors need to be able to use the generic terms for their products and services in the United States, in whatever language their customers speak.³⁸ Proponents

³⁴ *Otokoyama Co. v. Wine of Japan Imp., Inc.*, 175 F.3d 266, 272 (2d Cir. 1999); *see also*, *e.g.*, *Vista India v. Raaga, LLC*, 501 F. Supp. 2d 605, 616 (D.N.J. 2007) (holding that the transliterated Hindi word “Raaga” referred to South Asian music and was generic when used in connection with the sale of such music); *Krav Maga Ass’n of America, Inc. v. Yanilov*, 464 F. Supp. 2d 981, 987 (C.D. Cal. 2006) (holding that “krav maga” was generic for an Israeli self-defense system).

³⁵ *Volkswagenwerk Aktiengesellschaft v. Church*, 256 F. Supp. 626, 629–30 (S.D. Cal. 1966) (“The evidence . . . shows that plaintiff has spent immense sums in advertising and promotion of the term ‘Volkswagen’ in connection with its products and that the public identifies the plaintiff and its United States subsidiary in connection with that term.”), *aff’d*, 411 F.2d 350 (9th Cir. 1969).

³⁶ *Mondo, Inc. v. Sirco Int’l Corp.*, 1998 U.S. Dist. LEXIS 18996 n.2 (S.D.N.Y. 1998); *see also*, *e.g.*, *Balady, Inc. v. Elhindi*, 2014 U.S. Dist. LEXIS 177166 (E.D.N.Y. 2014) (finding BALADY, which translates to “my town,” plausibly suggestive for grocery stores), *adopted by* 2014 U.S. Dist. LEXIS 176845 (E.D.N.Y. 2014).

³⁷ Jonathan Skinner, *Overcoming Babel’s Curse: Adapting the Doctrine of Foreign Equivalents*, 93 J. Pat. & Trademark Off. Soc’y 57, 58 (2011).

³⁸ *See, e.g.*, *Otokoyama*, 175 F.3d at 271 (“No merchant may obtain the exclusive right over a trademark designation if that exclusivity would prevent competitors from designating a product as what it is in the foreign language their customers know best.”); *Blue & White Food Prods.*, 350 F. Supp. 2d at 517 (“This doctrine ensures that a trader will not be able to acquire an exclusive right to terms that would prevent other traders from accurately describing their products in any language.”); *see also* Thomas Merante, *Tomato, Tamatie? Revising the Doctrine of Foreign Equivalents in American Trademark Law*, 6 J. Intel. Prop. & Ent. Law 310, 324 (2017) (One rationale “is the promotion of domestic competition in a diverse contemporary American marketplace.”); Susan M. Richey, *The Second Kind of Sin: Making the Case for a Duty to Disclose Facts Related to Genericism and Functionality in the Trademark Office*, 67 Wash. & Lee L. Rev. 137, 200 (2010) (“[A] foreign term or phrase that designates applicant’s product, service category, or subcategory generally should not be accorded trademark status in the United States. To protect such subject matter under the Lanham Act would allow a registrant to exercise dominion over a generic designator, at least from the perspective of multilingual consumers, and thereby hinder competition by those who would market to the same consumer base.”) (footnotes omitted).

of the anti-monopolization rationale may say that the doctrine should apply even if no one in the United States speaks a particular language at the time of the decision.³⁹ The Second Circuit declared that the rule against protecting generic terms extends to foreign-language marks because we assume that “there are (or someday will be) customers in the United States who speak that foreign language.”⁴⁰ The Restatement (Third) of Unfair Competition declares that “[t]he multilingual character of the purchasing public and the increasing exposure to foreign terms on imported goods justify general adherence to the ‘doctrine of foreign equivalents’ under which the descriptiveness of a foreign word is determined according to its English translation.”⁴¹

Another concern is that limiting use of a foreign descriptive or generic term to one producer will deceive consumers familiar with the foreign language into believing that there is only one source of that type of good or service available in the United States.⁴² This could hurt both competitors trying to enter the market and consumers thinking they lack choices in that market.

And use of the doctrine in validity analysis is often justified by considerations of international comity. The Fifth Circuit reasoned that, “because U.S. companies would be hamstrung in international trade if foreign countries granted trademark protection to generic English words, the U.S. reciprocates and refuses trademark protection to generic foreign words.”⁴³ The TTAB has similarly

³⁹ See U Shen Goh, *Branding Unfair Competition: What Foreign-Language Marks Mean for International Businesses*, Asper Rev. Int’l Bus. & Trade L. 25, 39 (2015) (“Even if no consumers understand the foreign language used in the trademark, a trader should not be permitted to do in a foreign language what it cannot do in the English language. Namely, a trader cannot monopolize common words and prohibit other traders from their descriptive or generic use.”).

⁴⁰ *Otokoyama*, 175 F.3d at 270; see also *In re Bradford Dyeing*, 46 App. D.C. at 513 (“The reason for bringing descriptive foreign words and phrases within the limitations of the statute is apparent. Not only would the meaning soon become known to the public, but the user of the mark would appreciate the advantage of disseminating such information by advertisement or otherwise.”); Alan Montera, *The Foreign Equivalents Doctrine . . . In English?* 28 Tex. Intell. Prop. L.J. 129, 130 (2019) (Refusing to protect such a “trademark would prevent competition by allowing an early importer or manufacturer to have a monopoly on the generic term that accurately describes the product.”).

⁴¹ Restatement (Third) of Unfair Competition § 14 (Am. L. Inst. 1995).

⁴² *Otokoyama*, 175 F.3d at 272 (“Any Japanese-speaking customers and others who are familiar with the Japanese terminology would be misled to believe that there is only one brand of otokoyama available in the United States.”); Montera, *supra* note 40, at 130 (“[T]hat trademark may confuse someone from another country that only one supplier sells the product the foreigner is used to.”).

⁴³ *Enrique Bernat*, 210 F.3d at 443; see also, e.g., Skinner, *supra* note 37, at 63 (“If United States producers want to prohibit the registration of a generic English word in a non-English speaking country, principles of reciprocity and international comity would require that the United States not permit registration of foreign generic words.”); Montera, *supra* note 40, at 130 (“[O]ut of the concern for international comity, we do not want other countries allowing their citizens to trademark generic terms from our country

noted that registration of generic terms internationally “would interfere with the free flow of international trade in products known by that generic term.”⁴⁴

C. Confusing Similarity Analysis

1. Basic Principles

Trademarks, including those in different languages, are confusingly similar when consumers would believe they indicate the same source.⁴⁵ For registration, the USPTO will reject an application if the mark “so resembles a mark registered in the Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods or services of the defendant, to cause confusion, or to cause mistake, or to deceive.”⁴⁶ In civil litigation, U.S. courts will find trademark infringement when consumers are likely to be misled and confused about the source of goods or services.⁴⁷

The USPTO assesses confusing similarity by weighing the appearance, sound, connotation, and commercial impression of the marks at issue,⁴⁸ while also taking into account factors including the parties’ goods or services, channels of trade, and conditions of sale, as well as third-party use and actual confusion.⁴⁹ Courts generally analyze similar factors, also emphasizing appearance, sound, connotation, and overall commercial impression.⁵⁰

so we should not allow the generic foreign terms to be trademarked in the United States.”).

⁴⁴ *In re Le Sorbet, Inc.*, 1985 TTAB LEXIS 27 (T.T.A.B. 1985); *see also In re Johanna Farms, Inc.*, 8 U.S.P.Q.2d 1408 (T.T.A.B. 1988) (Simms, J., dissenting) (“[T]he consequences of registration in a foreign country of a corruption or phonetic equivalent of an English generic is distressing to merchants who are thereby hindered in their efforts to sell their products abroad. Those merchants would be harmed if foreign countries protected such corruptions or misspellings, exposing them to potential harassment and interference with the free use of English generic words.”).

⁴⁵ *See Gilson on Trademarks, supra* note 8, § 5.01, for the basics of likelihood of confusion.

⁴⁶ 15 U.S.C. § 1052(d) (2022).

⁴⁷ *Id.* §§ 1114(1), 1125(a)(1)(A).

⁴⁸ *E.g., In re E.I. duPont de Nemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973); *In re Sarkli, Ltd.* 721 F.2d 353, 354 (Fed. Cir. 1983); *In re Compass Automotive, Inc.*, 2019 TTAB LEXIS 143 (T.T.A.B. 2019); *In re Ness & Co.*, 18 U.S.P.Q.2d 1815 (T.T.A.B. 1991); TMEP § 1207.01(b).

⁴⁹ *In re Guild Mortg. Co.*, 912 F.3d 1376, 1378–79 (Fed. Cir. 2019); *In re E.I. duPont de Nemours & Co.*, 476 F.2d at 1361; *see also* TMEP § 1207.01(b)(vi) (“If an examining attorney determines that the doctrine [of foreign equivalents] is applicable, the examining attorney must also consider all other relevant *du Pont* factors in assessing whether there is a likelihood of confusion.”). For more on the *du Pont* factors considered at the USPTO, *see Gilson on Trademarks, supra* note 8, § 5.02[1][l].

⁵⁰ *See id.*, § 5.02 for a discussion of the federal circuits’ likelihood of confusion factors.

Confusing similarity analysis, combined with the doctrine of foreign equivalents, holds that a foreign term and its direct English equivalent may be found confusingly similar.⁵¹ The analysis in this context focuses on the *connotation* factor. True, connotation is just part of the overall determination of confusing similarity.⁵² Nevertheless, an equivalent meaning or connotation can outweigh other differences between the marks, no matter how different they may sound or look.⁵³ The USPTO may even refuse registration “solely because of similarity in meaning of the mark sought to be registered with a previously registered mark,” though if the only similarity between the marks is their connotation and they are otherwise dissimilar, their meaning must be close to justify a refusal to register on that basis.⁵⁴

2. Examples and Guidelines

Though these marks look quite distinct at first glance, the TTAB found confusion likely in each case:

- ELECTRIC JELLYFISH (beer) and AGUAMALA (“bad water” or “jellyfish” in Spanish for beer)⁵⁵
- 100 PERCENT WINE (wine) and CENTO PER CENTO (“hundred percent” in Italian for wine)⁵⁶
- SEAGULL (water purification units) and GAVIOTA (“seagull” in Spanish for faucets, showerheads, and other fixtures)⁵⁷
- BLACK MARKET MINERALS (retail jewelry and mineral store services) and MARCHE NOIR (“black market” in French for jewelry)⁵⁸

⁵¹ *E.g.*, TMEP § 1207.01(b)(vi).

⁵² *See, e.g.*, *In re Sarkli*, 721 F.2d at 354 (“[S]uch similarity as there is in connotation must be weighed against the dissimilarity in appearance, sound, and all other factors, before reaching a conclusion on likelihood of confusion as to source.”); *see also* Elizabeth J. Rest, *Lost in Translation: A Critical Examination of Conflicting Decisions Applying the Doctrine of Foreign Equivalents*, 96 TMR 1211, 1215 (2006) (footnote omitted) (“Translation alone should never decide the question of likelihood of confusion. In other words, the mark’s sound, meaning and appearance, as well as the sum of all three, should be considered.”).

⁵³ *E.g.*, *In re Compass Automotive*, 2019 TTAB LEXIS 143; *In re Aquamar, Inc.*, 115 U.S.P.Q.2d 1122 (T.T.A.B. 2015); *In re Thomas*, 79 U.S.P.Q.2d 1021 (T.T.A.B. 2006).

⁵⁴ *In re Sarkli*, 721 F.2d at 355.

⁵⁵ *In re Pinthouse Pizza Holdings, LLC*, 2019 TTAB LEXIS 401 (T.T.A.B. 2019) (not precedential).

⁵⁶ *In re Big Heart Wine LLC*, 2017 TTAB LEXIS 29 (T.T.A.B. 2017) (not precedential).

⁵⁷ *In re California Faucets, Inc.*, 2018 TTAB LEXIS 463 (T.T.A.B. 2018) (not precedential).

⁵⁸ *In re Thomas*, 79 U.S.P.Q.2d 1021.

- BLACK CAT (goods including perfume) and CHAT NOIR (“black cat” in French for eau de cologne)⁵⁹
- THE FINAL TOUCH (cologne) and DERNIERE TOUCHE (“final touch” in French for face powder)⁶⁰
- RED BULL (Scotch whiskey) and TORO ROJO (“red bull” in Spanish for rum)⁶¹
- THANH LONG (“green dragon” in Vietnamese for restaurant and bar services) and the following mark (restaurant and bar services):⁶²



- TACOLAND (bar and cocktail lounge services) and the following mark (“taco land” in Spanish for restaurant services):⁶³



- SEAHORSE (bar and lounge services) and the following marks (“Japanese seahorse cuisine” in Japanese for restaurant services):⁶⁴

⁵⁹ *Ex parte Odol-Werke Wein Gesellschaft*, 111 U.S.P.Q. 286.

⁶⁰ *In re Hudnut*, 121 U.S.P.Q. 636 (T.T.A.B. 1959).

⁶¹ *Rosenblum v. George Willsher & Co.*, 161 U.S.P.Q. 492 (T.T.A.B. 1969).

⁶² *In re Green Dragon Tavern, Inc.*, 2016 TTAB LEXIS 30 (T.T.A.B. 2016) (not precedential).

⁶³ *In re TacoLand Holdings, LLC*, 2018 TTAB LEXIS 351 (T.T.A.B. 2018) (not precedential).

⁶⁴ *In re Crystal Cruises, LLC*, 2018 TTAB LEXIS 472 (T.T.A.B. 2018) (not precedential).

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Context is vital when comparing marks to assess confusing similarity. Design elements may strengthen the effect of a translation in the likelihood of confusion analysis. The TTAB, for instance, found CHEETAH for “pneumatically powered tire changer machines for land vehicles” and “tire irons [and] wheel pullers” to be confusingly similar to GUEPARDO and the following mark for vehicle wheels:⁶⁵



While the marks are entirely different in sound and appearance, the design element reinforced the translation and the connotations were sufficiently close to find them confusingly similar.⁶⁶

Despite extensive precedent in the other direction, the TTAB may still balk at finding confusion where the two marks are very dissimilar aurally and visually. One applicant filed to register NABOSO for various goods, including yoga mats, exercise mats, and orthotics for feet, and the trademark examining attorney issued a final refusal based on various registrations for BAREFOOT (standard character and stylized) for yoga mats and accessories, floor mats, and orthotics.⁶⁷ NABOSO, the examining attorney had found, is Czech for “barefoot.”⁶⁸ Given its past practice in cases involving the doctrine of foreign equivalents, one might have wagered a tidy sum that the TTAB would easily affirm the refusal.

⁶⁵ *In re Compass Automotive*, 2019 TTAB LEXIS 143.

⁶⁶ *Id.*; see also *In re American Safety Razor Co.*, 2 U.S.P.Q.2d 1459 (T.T.A.B. 1987) (sun design in cited mark “serving merely to reinforce the commercial impression engendered by the word portion” that BUENOS DIAS means “good morning” in Spanish).

⁶⁷ *In re Naboso Technology, LLC*, 2019 TTAB LEXIS 195 (T.T.A.B. 2019) (not precedential).

⁶⁸ *Id.*

It did not. In a 2019 decision, the TTAB assumed that the doctrine applied and that the terms had an identical connotation. But similarity in meaning, found the TTAB, “is not *necessarily* sufficient.”⁶⁹ Comparing NABOSO to BAREFOOT, even for the same goods, was over the line.

Another case that crossed the line involved the mark BACIO for hotel, bar, and restaurant services, which the TTAB found unlikely to cause confusion with the following mark for restaurant and coffee house services:⁷⁰



While BACIO means “kiss” in Italian, the TTAB found that the sound, appearance, and overall commercial impression were too different to cause confusion, particularly given the incongruity of the iconic, stylized KISS mark.⁷¹

Weaker marks, those with a more limited scope of protection, may not be likely to confuse consumers even if the translation is close and the goods and services are closely related. For instance, the TTAB reversed a refusal to register the mark on the left, despite the fact that the marks are used on nearly identical goods and “la bonté” means “the goodness” in French.⁷²



Clearly, the marks are quite different in appearance and pronunciation, and the TTAB also relied on the difference between “goodness” and the applicant’s mark, which is slightly different: “good-ness.”⁷³ It also noted that “goodness” is highly laudatory for food and thus receives a narrower scope of protection.⁷⁴ The TTAB also relied on the laudatory nature of the marks in the following case. Even though both of the marks below for women’s apparel

⁶⁹ *Id.*

⁷⁰ *In re Tropicana Las Vegas, Inc.*, 2013 TTAB LEXIS 295 (T.T.A.B. 2013) (not precedential).

⁷¹ *Id.*

⁷² *In re Ness & Co.*, 18 U.S.P.Q.2d 1815.

⁷³ *Id.*

⁷⁴ *Id.*

translate generally to “very pretty” or “quite pretty,” the TTAB found that they were not confusingly similar:⁷⁵

Because they were both highly laudatory marks when translated,



they were less likely to be seen as source indicators.⁷⁶

Where the marks are visually similar *before* translation, it is more likely that the relevant consumer will be confused. The following marks were found confusingly similar under the doctrine of foreign equivalents in part because of their relative similarity in appearance, despite the difference in meaning for the translations of the two terms:⁷⁷



Consumers are more likely to see the mark on the left as the foreign-language equivalent of the one on the right because of their similarity, found the TTAB.⁷⁸

In one federal court case, the parties’ marks were even more similar than those shown above: the plaintiff’s mark was GALLO and the defendant’s was EL GALLO.⁷⁹ The defendant argued that the marks were dissimilar under the doctrine of foreign equivalents because consumers would translate EL GALLO into “the rooster” but would not translate GALLO, claiming that GALLO on its own had no foreign translation.⁸⁰ The court rejected this bold argument, finding “no case that states that the doctrine of foreign equivalents is applied to rebut or destroy similarity of appearance.”⁸¹

⁷⁵ *In re Lar Mor Int’l, Inc.*, 221 U.S.P.Q. 180 (T.T.A.B. 1983). See *infra* Part IV.F for more on comparing two marks in the same foreign language under the doctrine of foreign equivalents.

⁷⁶ *In re Lar Mor Int’l*, 221 U.S.P.Q. 180; see also *In re L’Oreal S.A.*, 222 U.S.P.Q. 925 (T.T.A.B. 1984) (no likelihood of confusion between HAUTE MODE for hair coloring and HI-FASHION SAMPLER for nail polish due to the weakness of the marks and the different types of goods).

⁷⁷ *In re OTRAJET*, 2018 TTAB LEXIS 275.

⁷⁸ *Id.*

⁷⁹ *E. & J. Gallo Winery v. Grenade Bev. LLC*, 2014 U.S. Dist. LEXIS 156457 (E.D. Cal. 2014), *aff’d*, 670 Fed. Appx. 634 (9th Cir. 2016).

⁸⁰ *Id.*

⁸¹ *Id.* The magistrate judge had declared: “Defendant offers no facts or rationale argument as to why EL GALLO would be translated by the average consumer from Spanish to English, but GALLO would not.” *E. & J. Gallo Winery v. Grenade Bev. LLC*, No. 1:13-

When courts apply the doctrine of foreign equivalents to find confusion likely based on translations, they appear to be less strict than the TTAB in applying the doctrine and less likely to translate a foreign mark for purposes of confusing similarity when comparing an English-language mark to one in a different language.⁸² One court found no confusion between HERE & THERE for perfume and DECI DELA for publishing fashion magazines and consulting services to the fashion industry, though the translation from French of the latter mark is “here and there.”⁸³ It reasoned that the English translation was only relevant to similarity of meaning and concluded that similarity of connotation was outweighed by the visual and aural differences.⁸⁴

Courts have also struggled with how to proceed where the two marks are in the same foreign language. Where a court compared MELANGE DE TROIS and MENAGE A TROIS, both for wine, it admitted that “its attempt to evaluate the similarity of the relevant marks from the perspective of the average American wine purchaser is complicated by the fact that both marks are comprised of French words.”⁸⁵ It concluded that it could not disregard the meanings of the marks where an appreciable number of the U.S. consumers of the products would understand the meanings of the two phrases.⁸⁶ MENAGE A TROIS, found the court, “is so commonly used and understood that it could just as aptly be characterized as part of the lexicon of American English as it could be considered a foreign-language expression,” and wine purchasers would understand MELANGE A TROIS to mean a mixture of three grape varieties.⁸⁷ Thus, the dissimilar meanings in English would tend to reduce the

cv-00770-AWI-SAB, 2014 U.S. Dist. LEXIS 113841, at *15 (E.D. Cal. Aug. 15, 2014), adopted by 2014 U.S. Dist. LEXIS 156457 (E.D. Cal. 2014); see also *In re Maclin-Zimmer-McGill Tobacco*, 262 F. 635 (affirming refusal to register EL GALLO for tobacco where OUR ROOSTER and an image of a rooster was already registered for the same goods); *In re Perez*, 21 U.S.P.Q.2d 1075 (T.T.A.B. 1991) (EL GALLO for fresh vegetables likely to be confused with ROOSTER for fresh fruit: “While the marks are concededly distinguishable in their appearance and sound, it is our view that the equivalency in meaning or connotation is sufficient, in this case, to find likelihood of confusion.”).

⁸² Still, courts will apply the doctrine in clear cases. See, e.g., *General Conf. Corp. of Seventh-Day Adventists v. Perez*, 97 F. Supp. 2d 1154, 1160 (S.D. Fla. 2000) (finding infringement where MINISTERIO ADVENTISTA DEL SEPTIMO DIA DEL EVANGELIO ETERNO contained “an exact translation” of the mark SEVENTH-DAY ADVENTIST).

⁸³ *Horn’s Inc. v. Sanofi Beaute, Inc.*, 963 F. Supp. 318, 322–23 (S.D.N.Y. 1997).

⁸⁴ *Id.*

⁸⁵ *Sutter Home Winery, Inc. v. Madrona Vineyards, L.P.*, 2005 U.S. Dist. LEXIS 4581 (N.D. Cal. 2005).

⁸⁶ *Id.*

⁸⁷ *Id.*

likelihood of confusion, though the court ultimately found that the plaintiff was unlikely to succeed on the merits.⁸⁸

The doctrine of foreign equivalents has also been applied in domain name litigation in the United States, where a court found a violation of the Anti-Cybersquatting Consumer Protection Act when an individual registered the Hindi translation of MASTERCARD as a domain name:⁸⁹

मास्टर्कार्ड.com

Unfortunately for the defendant, he had admitted the copying when he emailed MasterCard with an offer to sell the “domain name for MasterCard in Hindi.”⁹⁰ And while the domain name did not look anything like MASTERCARD, the court found it was “identical in translation, pronunciation, and meaning.”⁹¹

3. Rationales

Applying the doctrine of foreign equivalents to confusing similarity analysis protects bilingual consumers in the United States from source confusion. It also protects trademark owners from infringement by junior users’ marks that would confuse those bilingual consumers, whether the senior user used an English language mark and the junior user used the foreign equivalent or vice versa.

III. NUTS AND BOLTS OF THE DOCTRINE

Now that we have seen what the doctrine of foreign equivalents looks like in practice, it is time to roll up our figurative sleeves and get into the fundamentals. Let’s walk through the basic elements of the doctrine, noting some critiques and points of confusion along the way.

We begin with a deceptively simple checklist.

⁸⁸ *Id.*

⁸⁹ *Mastercard Int’l Inc. v. Trehan*, 629 F. Supp. 2d 824 (N.D. Ill. 2009); *see also* WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, § 1.14 (“A domain name that consists or is comprised of a translation or transliteration of a trademark will normally be found to be identical or confusingly similar to such trademark for purposes of standing under the Policy, where the trademark—or its variant—is incorporated into or otherwise recognizable, through such translation/transliteration, in the domain name.”).

⁹⁰ *Mastercard Int’l*, 629 F. Supp. 2d at 829.

⁹¹ *Id.* at 830.

A. Elements of the Doctrine

The doctrine of foreign equivalents will apply when the following elements are met:

- The trademark consists of or contains a foreign word or phrase.
- The English equivalent is a literal, direct, and exact translation of the foreign mark and the evidence does not suggest a different relevant meaning.
- The mark is in a modern language that is common in the United States.
- The ordinary American purchaser knowledgeable or proficient in the foreign language would stop and translate the foreign term into its English equivalent.

B. A Guideline, Not a Strict Rule

The doctrine of foreign equivalents is a guideline rather than a strict rule, an art rather than a science.⁹² In other words, courts and the USPTO do not simply look up every foreign term in a trademark in a bilingual dictionary, take the first entry, and plug that translation in to their analysis. (Or they shouldn't, at least.) The translation must be direct and clear, the language must be common and modern, and the "ordinary American purchaser" must be inclined to translate the mark. Even if it is translated, a close translation will not mandate a finding of descriptiveness or likely confusion.

As the TTAB has said, "it is important to note that the doctrine of foreign equivalents is not conclusive. It is just one way of understanding the meaning of a mark"⁹³ For validity analysis, the translation must be balanced with the relevant goods or services to assess distinctiveness, and other elements, like visual incongruity, may ultimately render the mark protectable.⁹⁴ For confusing similarity analysis, a similar connotation in translation is always weighed against dissimilarity in appearance and sound, as well as the other likelihood of confusion factors, when determining whether or not confusion is likely.⁹⁵

⁹² *E.g.*, *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369 (Fed. Cir. 2005); *Sutter Home Winery*, 2005 U.S. Dist. LEXIS 4581; *In re Centruero, S.A. de C.V.*, 2019 TTAB LEXIS 273 (T.T.A.B. 2019); TMEP §§ 1207.01(b)(vi)(A), 1209.03(g).

⁹³ *In re Lettuce Entertain You Enters., Inc.*, 2013 TTAB LEXIS 254 (T.T.A.B. 2013) (not precedential).

⁹⁴ *See supra* Part II.B.

⁹⁵ *See supra* Part II.C.

Of course, predictability suffers when outcomes are governed by a flexible guideline rather than a rule.⁹⁶ This article identifies some established criteria for applying the doctrine, to inject more certainty into the practice, but even the established precepts are not universally followed.

C. Contains a Foreign Word or Phrase

A basic requirement for applying the doctrine of foreign equivalents is the appearance of a foreign-language word or phrase in a trademark. This requirement appears relatively straightforward. In most cases, it is. But there are wrinkles.

First, what about words *in English* that are not used in the United States as they would be in other countries, like Great Britain or Australia? Because those words may be foreign to Americans, they should be “translated” if they meet the other requirements for the doctrine.⁹⁷ That situation is less of a translation than simply a determination of how U.S. consumers understand a certain word and whether they are aware of its meaning in other countries. Even if courts or the USPTO do not call this a use of the doctrine of foreign equivalents, it is the same process.

Second, the ease of plugging a word or phrase from a trademark into free online systems like Google Translate, Microsoft’s Bing Translator, or Babelfish may create a “foreign” word where one might not really be present.⁹⁸ Trademark examining attorneys at the USPTO, faced with fanciful-looking terms in applied-for

⁹⁶ See, e.g., *Merante*, *supra* note 38, at 325 (“[T]he ‘guideline’ nature of the doctrine provides insufficient guidance for examiners and courts, which thereby produces uncertainty for prospective mark registrants.”).

⁹⁷ *In re Kabushiki Kaisha King Jim*, 2008 TTAB LEXIS 740 (T.T.A.B. 2008) (not precedential) (applying doctrine to British slang term); *In re Consolidated Cigar Corp.*, 13 U.S.P.Q.2d 1481 (T.T.A.B. 1989) (Sams, J., concurring) (“I see no reason . . . to discriminate in the application of the doctrine of foreign equivalents solely on the basis that the ‘foreign’ language . . . is British English, rather than a language more obviously ‘foreign’ to American English than is British English.”); *Montera*, *supra* note 40, at 155 (“The foreign equivalents doctrine should apply to words and phrases from both English and non-English-speaking countries. . . . Companies should not be able to monopolize a generic term from a country outside of the United States.”); *Rest*, *supra* note 52, at 1243–44 (“Although the doctrine of foreign equivalents most often applies when marks are made up of terms from *foreign languages*, 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*.”) (emphases in original). *But see* *UGG Holdings, Inc. v. Severn*, 2005 U.S. Dist. LEXIS 45783 (C.D. Cal. 2005) (finding the doctrine of foreign equivalents inapplicable when the disputed term was from English-speaking nation Australia).

⁹⁸ See Google Translate, *supra* note 1; Bing Microsoft Translator, <https://www.bing.com/translator/> (last visited September 19, 2022); BabelFish, <https://www.babelfish.com/> (last visited September 19, 2022). Some of these services will even auto-detect which language might be applicable. In the case of Google Translate, for example, that could include anything from Amharic to Kyrgyz to Xhosa. See Google Translate, *supra* note 1.

trademarks, may issue rejections based on translations of those terms into obscure languages in the United States like Hungarian or Romanian when relying on these simple systems. Such rejections should be prevented by the requirement that the language be a common one in the United States, but as we shall see, that backstop is almost nonexistent in practice.⁹⁹

Third, for an application to be complete, an applicant must provide to the USPTO an accurate English translation of its mark if the mark “includes non-English wording.”¹⁰⁰ The TTAB has said:

The meaning of words is of critical importance in a trademark application. A translation made part of the application provides public notice of the meaning of the words in applied-for matter, allowing third parties to assess the scope of an applicant’s or registrant’s rights.¹⁰¹

The requirement must be met even if the translation is uncontroversial or even obvious, does not lead to a refusal of registration, and is not necessary for the examination of the application.¹⁰²

Failure to submit a proper translation statement may lead to a refusal to register the mark,¹⁰³ an adverse inference by the TTAB that a translation provided later is inaccurate,¹⁰⁴ or even a finding of fraud on the USPTO.¹⁰⁵ Submission of a translation may be useful to an applicant by blocking later registrations or discouraging use of certain marks after a database search. Where an examining attorney finds a foreign-language translation online that the

⁹⁹ See *infra* Part III.E.

¹⁰⁰ 37 C.F.R. § 2.32(a)(9); see generally TMEP § 809.

¹⁰¹ *In re Talyoni, LLC*, 2019 TTAB LEXIS 145 (T.T.A.B. 2019).

¹⁰² *In re Lettuce Entertain You Enters.*, 2013 TTAB LEXIS 254 n.17 (distinguishing the requirement for a translation from the requirement for information in 37 C.F.R. § 2.61(b)).

¹⁰³ *E.g., In re Talyoni*, 2019 TTAB LEXIS 145 (translation statement submitted was “too verbose” and inconsistent with the majority of dictionary definitions of the foreign term).

¹⁰⁴ *In re Transtechsol, LLC*, 2020 TTAB LEXIS 552 (T.T.A.B. 2020) (not precedential).

¹⁰⁵ *Otokoyama*, 175 F.3d at 273 (finding sufficient indicia of fraud when registrant knew the word “otokoyama” was a Japanese term for sake but repeatedly responded to inquiries from the USPTO stating it was an arbitrary, fanciful term with no meaning); *Bart Schwartz Int’l Textiles, Ltd. v. FTC*, 289 F.2d 665, 667 (C.C.P.A. 1961) (finding that a registration for fabrics had been obtained fraudulently where the applicant did not disclose the fact that the mark, FIOCCO, had long been used in Italy and the United States as a generic designation for rayon); see also Richey, *supra* note 38, at 201 (arguing that applicants should have a duty to disclose information relevant to the generic nature of their marks, including “a duty to investigate and disclose foreign language meanings of a purported mark . . . measured by a rule of reasonableness”). But see *Slaska Wytownia Wodek Gatunkowtch “Polmos” SA v. Stawski Distrib. Co.*, 2010 TTAB LEXIS 342 (T.T.A.B. 2010) (not precedential) (rejecting claim of fraud for failure to disclose translation of mark allegedly showing genericness where “the record shows that there is no precise translation of the term” and there was no evidence of intent to deceive).

applicant did not intend, the applicant may be pressed to issue translation statements even if the foreign terms are not relevant to the goods or services listed in its identification or do not render the mark confusingly similar to another mark.

Note that providing a translation that shows that the mark is a generic or descriptive term for the goods or services in English is essentially an admission against interest. It means the applicant “has a more difficult burden to then show that the term is not merely descriptive or generic.”¹⁰⁶ And a translation statement can be used against a party in a later TTAB proceeding as evidence that the meaning provided by the applicant was an exact translation.¹⁰⁷

D. Literal, Direct Translation

For the doctrine of foreign equivalents to apply, the English translation must be “literal and direct,” with “no contradictory evidence of other relevant meanings or shades of meaning.”¹⁰⁸ Where the foreign term has more than one relevant, acceptable, distinct translation in English, it will likely not be considered a “foreign equivalent.” In that case, the doctrine does not apply and the foreign-language mark should be taken as is for purposes of determining validity and confusing similarity. This section discusses the contours of the “literal and direct” translation requirement and looks briefly at the types of evidence typically presented to prove a translation.

1. Exact Equivalents

Sometimes, translation is straightforward. The TTAB easily found BUENOS DIAS (Spanish) for soap confusingly similar to GOOD MORNING for shaving cream,¹⁰⁹ and likewise found LUPO (Italian) for underwear confusingly similar to WOLF for various apparel.¹¹⁰ Those translations were unambiguous and held no other connotations.¹¹¹ But, as the Fifth Circuit noted in a significant

¹⁰⁶ *In re Tokutake Indus. Co.*, 87 U.S.P.Q.2d 1697 (T.T.A.B. 2008).

¹⁰⁷ *In re Thomas*, 79 U.S.P.Q.2d 1021.

¹⁰⁸ TMEP § 1207.01(b)(vi)(B).

¹⁰⁹ *In re American Safety Razor*, 2 U.S.P.Q.2d 1459.

¹¹⁰ *In re Ithaca Indus., Inc.*, 230 U.S.P.Q. 702 (T.T.A.B. 1986); *see also, e.g., In re La Peregrina Ltd.*, 86 U.S.P.Q.2d 1645 (T.T.A.B. 2008) (LA PEREGRINA and PILGRIM “identical in meaning”).

¹¹¹ *In re Crystal Cruises*, 2018 TTAB LEXIS 472 (“[B]ecause the evidence shows that the English translation is unambiguously literal and direct, with no other relevant connotations or variations in meaning, we deem it appropriate to apply the doctrine.”).

understatement: “The act of translation, of course, can itself be an imprecise task.”¹¹²

Often, a literal translation does not capture what a term conveys to one who knows the foreign language. Perhaps it is an idiom, perhaps there is a double entendre when applied to the goods or services, or perhaps there is a different connotation to the term in the original language, rendering a literal translation not an *exact* translation.¹¹³ The relevant meaning is the one consumers would understand and not the literal translation.

If the English translation is not a direct translation of the mark to be compared for confusing similarity or of the descriptive term to be assessed for validity, the doctrine should not be applied. For example, the English words HAIR OF THE DOG were registered for clothing despite the existence of a prior registration for LES CHEVEUX DU CHIEN for clothing and accessories.¹¹⁴ The word-for-word translation of the two phrases was the same but the two were not equivalent in meaning.¹¹⁵ The idiomatic meaning of an alcoholic drink meant to relieve a hangover, said the TTAB, “differs substantially from the literal meaning of the words—far afield from a discussion of the keratinous epidermal filaments of the canine species.”¹¹⁶ Thus, the marks were compared as is, without using a translation of the foreign-language mark.¹¹⁷

Similarly, in another case, the TTAB found that GO GIRLS was the *literal* translation of the following mark, but that the two were not *equivalent in meaning*, in part because of the slang connotation of GO GIRL in English.¹¹⁸

¹¹² *Enrique Bernat*, 210 F.3d at 443; *see also* Goh, *supra* note 39, at 45 (“The danger of equating a foreign-language mark with a translation, without evidence connecting the two, is that translations can be multiple and arbitrary.”).

¹¹³ *E.g.*, *In re Pan Tex Hotel Corp.*, 190 U.S.P.Q. 109 (T.T.A.B. 1976) (LA POSADA for hotels literally translated as “the inn” but the definition also implied a home or dwelling, and thus had a connotation slightly different from that of the words “the inn”; LA POSADA capable of distinguishing services and registrable on the Supplemental Register).

¹¹⁴ *In re Innovative Tech. Corp. of Am., Inc.*, 2008 TTAB LEXIS 305 (T.T.A.B. 2008) (not precedential).

¹¹⁵ *Id.*

¹¹⁶ *Id.*

¹¹⁷ *Id.*

¹¹⁸ *In re Trimarchi*, 2009 TTAB LEXIS 370 (T.T.A.B. 2009) (not precedential). A judge writing in dissent, however, argued that the evidence showed that the marks had the same meaning and those who spoke only limited French might understand the phrase ALLEZ FILLES as meaning GO GIRLS. *See also In re Alison Raffaele Cosmetics, Inc.*, 2013 TTAB LEXIS 446 (T.T.A.B. 2013) (not precedential) (explaining that *In re Trimarchi* “is not authority for looking at the mark as a whole in an attempt to divine a general impression, *despite* the meaning (or lack of it) in the foreign tongue”). For another perspective on this case, *see* Serge Krimnus, *The Doctrine of Foreign Equivalents at Death’s Door*, 12 N.C. J.L. & Tech. 159, 173 (2010) (“The Board [in *In re Trimarchi*] . . . gave absolutely no reason why a French speaker would not translate two very simple words even if they are grammatically incorrect. This rule is also confusing in that it does



The TTAB stated: “Literal translations of idiomatic phrases cannot fully capture the connotation, which diminishes the weight to be given that element.”¹¹⁹ It was not clear to the TTAB that French speakers encountering the mark in the United States would translate the phrase rather than just taking it as is.¹²⁰ It reversed the refusal to register the mark above for apparel, finding confusion unlikely with GO GIRL for apparel.¹²¹

To avoid inaccurate literal translations, the expression as a whole should be translated, rather than each word separately.¹²² Similarly, combining two foreign words together without a space does not immunize them from the doctrine. For example, one applicant tried to register MARAZUL for frozen and fresh fish and seafood, and the evidence in the proceeding showed that the two Spanish words “mar azul” meant “blue sea.”¹²³ The TTAB found no evidence that combining the two words gave a different commercial impression from what the words would have had separately, and the MARAZUL mark was found confusingly similar to BLUE SEA for frozen and fresh fish.¹²⁴

In analyzing confusing similarity, where the marks are similar only in their *connotation* but are otherwise dissimilar, the translation should be a close one for the USPTO to find likely confusion. In a 1983 decision, the Federal Circuit reversed the USPTO’s denial of registration, finding no likelihood of confusion between REPECHAGE and SECOND CHANCE for overlapping skin care products.¹²⁵ The TTAB had found that REPECHAGE, translated from French, literally meant “second chance,” thus the marks were similar in connotation.¹²⁶ The reviewing court, however, considered the translation evidence and concluded that the translation was *not* an exact one and the two terms were not

not provide a clear standard—there is no indication of whether all grammatically incorrect phrases would be excepted from translation or where the bar would be set.”).

¹¹⁹ *In re Trimarchi*, 2009 TTAB LEXIS 370.

¹²⁰ *Id.*

¹²¹ *Id.*

¹²² *In re Thomas*, 79 U.S.P.Q.2d 1021.

¹²³ *In re Aquamar*, 115 U.S.P.Q.2d 1122, at *6.

¹²⁴ *Id.*

¹²⁵ *In re Sarkli*, 721 F.2d 353.

¹²⁶ *Id.*

equivalent.¹²⁷ The court did refuse to “rule out the possibility that likelihood of confusion may be shown between an English word mark and a foreign word mark which are not exact synonyms, just as two English word marks need not be exact equivalents in meaning to create a likelihood of confusion.”¹²⁸ It emphasized that where the marks are similar only in their connotation and otherwise “totally dissimilar,” the translation must be much closer than the one between REPECHAGE and SECOND CHANCE to justify a refusal to register on the basis of confusing similarity.¹²⁹

The meaning to consumers will prevail over the literal meaning, if those are different. For example, the Second Circuit found that Japanese speakers understood “otokoyama” as meaning “sake,” therefore “otokoyama” was generic for sake despite the fact that its literal translation was “man/mountain.”¹³⁰ And “uno” in PIZZERIA UNO did not mean “number one” in a laudatory sense as defined in Italian, just the number one, and was not descriptive of restaurants.¹³¹ Thus, an “exact equivalent” is not limited to straightforward dictionary definitions.

What if there are several different definitions for the foreign-language term? As a general rule, the doctrine does not apply if a term has more than one direct and distinct translation.¹³² The TTAB, for example, found the following mark not confusingly similar to PALOMA, which could be translated from Spanish as either “dove” or “pigeon”¹³³:

¹²⁷ *Id.* at 354 (“In special circumstances, ‘repechage’ appears to have the connotation of a reprieve or, loosely, a second chance . . . but this is not the same as saying that ‘repechage’ is *equivalent* to ‘second chance.’”).

¹²⁸ *Id.* at 354–55; *see also, e.g., In re Cababie*, 2016 TTAB LEXIS 138 (T.T.A.B. 2016) (not precedential) (finding two valid translations, one descriptive and the other a double entendre, and allowing registration).

¹²⁹ *In re Sarkli*, 721 F.2d at 355.

¹³⁰ *Otokoyama*, 175 F.3d at 268; *see also Enrique Bernat*, 210 F.3d at 444 (“[D]espite the fact that the lower court did not literally translate it to mean ‘lollipop,’ ‘chupa’ could be generic if it has come to signify lollipops in Spanish-speaking countries, like Mexico.”); *Holland v. C. & A. Import Corp.*, 8 F. Supp. 259 (D.N.Y. 1934) (finding “est est est” generic for Montefiascone wine despite its literal translation as “it is it is it”).

¹³¹ *Pizzeria Uno Corp. v. Temple*, 747 F.2d 1522, 1533 (4th Cir. 1984) (“There is not the slightest evidence or even suggestion that this word, which is a part of ‘that soft bastard Latin’ which Lord Byron admiringly declared, ‘melts like kisses from a female mouth,’ was ever used either in its Latin or Italian version, to mean the ‘best’ or as descriptive of any product or was so understood by anyone familiar with either the Latin or Italian language.”).

¹³² *E.g., Taza Sys., LLC v. Taza 21 Co.*, 2013 U.S. Dist. LEXIS 130974 (W.D. Pa. 2013) (rejecting application of doctrine in part because evidence showed “multiple translations and varying foreign spellings and pronunciations” of the mark).

¹³³ *In re Buckner Enters.*, 6 U.S.P.Q.2d 1316 (T.T.A.B. 1987).



In another case, the TTAB held that a registration of KOKORO and the design mark below for restaurant services did not bar HEART for restaurant services, even though the registrations both stated that the English translation of the Japanese term “kokoro” is “heart”¹³⁴:



In fact, the term could also be translated from Japanese as “mind,” “mentality,” “thought,” or other like terms.¹³⁵ As another relevant factor in finding confusion unlikely, the marks “obviously have no similarity whatsoever in terms of sound, appearance and commercial impression.”¹³⁶

But the existence of multiple possible translations does not mean that the USPTO will necessarily reject the use of the doctrine. One question is whether the translations are related to each other or dissimilar. Where the possible translations are closely related to each other and clearly intersect, the doctrine is likely to apply. This Greek term translated as “marriage,” “matrimony,” and “wedding,” which the TTAB found were “not contradictory of one another, but, rather, are highly related” and overlapping¹³⁷:



¹³⁴ *In re OpBiz, LLC*, 2009 TTAB LEXIS 94 (T.T.A.B. 2009) (not precedential).

¹³⁵ *Id.*

¹³⁶ *Id.*

¹³⁷ *In re S. Malhotra*, 128 U.S.P.Q.2d 1100; *see also In re Elkay Plastics Co.*, 2021 TTAB LEXIS 3 (T.T.A.B. 2021) (not precedential) (finding that the relevant English definitions of COMPOSTA—compost, mixture, and compound—were “highly related”); *In re Tokutake Indus.*, 87 U.S.P.Q.2d 1697 (affirming refusal to register AYUMI and its equivalent in Japanese characters as descriptive of footwear despite evidence of multiple definitions of “ayumi,” where those definitions overlapped and included the similar meanings “walking,” “a step,” and “one’s pace”); *In re Geo. A. Hormel*, 227 U.S.P.Q. 813 (affirming refusal to register Italian word meaning “tasty” as descriptive and laudatory of applicant’s goods though there were other definitions, including “lively,” “witty,” and “expensive”).

The mark was found to be merely descriptive of jewelry.¹³⁸

Where translations are contradictory, application of the doctrine may still be appropriate if there is one *relevant* translation.¹³⁹ And that translation may be used to the exclusion of the others in validity or confusing similarity analysis. The TMEP says: “The translation that should be relied upon in examination is the English meaning that has significance in the United States as the equivalent of the meaning in the non-English language.”¹⁴⁰

For instance, because “green” is descriptive for products and services that purport to be environmentally friendly,¹⁴¹ VERDE (Spanish for “green”) is also descriptive for such products and services.¹⁴² The TTAB found that to be true despite evidence showing that VERDE also translated to “foliage,” “bawdy,” “verdant,” and “unripe.”¹⁴³ Further evidence showed that VERDE connoted energy efficiency in Spanish just as the word “green” does in English.¹⁴⁴ Outside the realm of foreign-language trademarks, “it is well settled that so long as any one of the meanings of a term is descriptive when considered in connection with the identified goods, the term may be considered to be merely descriptive.”¹⁴⁵

2. Evidence of Translation

As the Second Circuit has declared, “[u]nder the doctrine of foreign equivalents, numerous types of evidence may be probative of the term’s proper classification.”¹⁴⁶ Here is a brief synopsis of typical ways to prove a translation:

- The trademark owner’s own translation statement at the USPTO
- The way the trademark owner itself uses the term
- Dictionaries
- USPTO’s Translations Branch
- Expert witness testimony
- Declarations from native speakers of the language
- Translation websites

¹³⁸ *In re S. Malhotra*, 128 U.S.P.Q.2d 1100.

¹³⁹ TMEP § 809.02 (“The determination of the appropriate translation often requires consideration of the meaning in relation to the goods and/or services.”).

¹⁴⁰ *Id.*

¹⁴¹ *See In re Green Bancorp, Inc.*, 2011 TTAB LEXIS 382 (T.T.A.B. 2011) (not precedential).

¹⁴² *In re Verde Power Supply, Inc.*, 2012 TTAB LEXIS 349 (T.T.A.B. 2012) (not precedential).

¹⁴³ *Id.*

¹⁴⁴ *Id.*

¹⁴⁵ *Id.*

¹⁴⁶ *Otokoyama Co. v. Wine of Japan Imp., Inc.*, 7 Fed. Appx. 112, 115 (2d Cir. 2001).

- News databases
- Other website evidence

The trademark owner's own translation statement or use: A trademark owner's translation statement at the USPTO can be evidence of the correct meaning of the term in English.¹⁴⁷ In addition, if the trademark owner's packaging or website conveys a translation of a term, that is also evidence of the relevant translation.¹⁴⁸

Dictionaries: Dictionaries are classic evidence of translations, for courts and the USPTO. The TTAB can even take judicial notice of definitions in "translation dictionaries that exist in printed format."¹⁴⁹ The evidence may be obtained online so long as the definitions are derived from dictionaries that are in print or "have regular fixed editions."¹⁵⁰ For Spanish translations, for example, the TTAB has considered entries from Cassell's Spanish-English English-Spanish Dictionary, the Collins Spanish-to-English Dictionary, Collins Complete Spanish Electronic Dictionary, the Spanish Oxford Living Dictionaries, Merriam-Webster SpanishCentral.com, and the American Heritage Spanish Dictionary, among others.

USPTO's Translations Branch: Trademark examining attorneys may request translations from the USPTO's own Translations Branch.¹⁵¹

Expert witness testimony: Parties may submit expert witness testimony from translators¹⁵² or even experts such as "the vice-consul at the Consulate General of France in San Francisco"¹⁵³ on the proper translation of a foreign-language mark.

¹⁴⁷ *E.g.*, *Quoc Viet Foods, Inc. v. VV Foods, LLC*, 192 F. Supp. 3d 1067, 1075 (C.D. Cal. 2016) (finding translation in party's registration to be evidence of descriptiveness); *In re Crystal Cruises*, 2018 TTAB LEXIS 472; *In re Field Roast Grain Meat Co.*, 2017 TTAB LEXIS 352; *In re Tokutake Indus.*, 87 U.S.P.Q.2d 1697.

¹⁴⁸ *E.g.*, *In re Centruro*, 2019 TTAB LEXIS 273 (noting screenshots from applicant's website displaying image of a scorpion next to designation ALACRAN).

¹⁴⁹ *E.g.*, *In re Omniome, Inc.*, 2019 WL 7596207 n.17 (T.T.A.B. 2019) (citing *In re White Jasmine LLC*, 106 U.S.P.Q.2d 1385 n.23 (T.T.A.B. 2013)); see USPTO Trademark Trial and Appeal Board Manual of Procedure (hereinafter "TBMP") (2022) § 1208.04.

¹⁵⁰ *In re White Jasmine*, 106 U.S.P.Q.2d 1385 n.23; TBMP § 1208.04; see also *In re California Wineries & Vineyards LLC*, 2020 TTAB LEXIS 384 (T.T.A.B. 2020) (not precedential) (declining to take judicial notice of a translation from online source SpanishDict.com because it "was not shown to exist in printed form or have a regular fixed edition").

¹⁵¹ TMEP § 809.02 ("If any question arises as to the proper translation of a mark, the examining attorney may consult the Trademark Library or Translations Branch of the USPTO."); see, e.g., *In re Pinthouse Pizza Holdings*, 2019 TTAB LEXIS 401; *In re Cababie*, 2016 TTAB LEXIS 138.

¹⁵² *E.g.*, *Win Luck Trading Inc. v. Northern Food I/E Inc.*, 2017 TTAB LEXIS 241 (T.T.A.B. 2017) (not precedential).

¹⁵³ *In re Lar Mor Int'l*, 221 U.S.P.Q. 180.

Declarations from native speakers of the language: Parties may submit declarations from native speakers of the foreign language to explain the correct translation. In one case before the TTAB, the examining attorney did not rebut a translation from a native Spanish speaker that a Spanish phrase carried a double entendre and the TTAB reluctantly found the mark to be registrable.¹⁵⁴ The affidavits should come from bilingual speakers who are representative of ordinary consumers.

Translation websites: In several cases, the TTAB has accepted evidence from examining attorneys and parties from online translation services, such as Google Translate, Bing Translator, Freetranslation.com, Wordreference.com, and Babelfish.¹⁵⁵ In other cases, however, the TTAB has expressed skepticism as to the accuracy of such free online translation services. It has rejected screenshots of Google Translate, stating that “there is no indication that the Google Translate website . . . constitutes an authoritative source of information.”¹⁵⁶ Similarly, it has given other Internet translations limited probative value, observing that they “are not standard, authoritative dictionaries. They do not provide detailed definitions, usage notes, etymologies, alternative meanings, or other information that might be provided by an authoritative dictionary.”¹⁵⁷

News databases: Articles from LexisNexis or other news databases can be evidence of translation.¹⁵⁸

Other websites: The USPTO Trademark Trial and Appeal Board Manual of Procedure states: “Website evidence may . . . be used to show the translation of a word or term.”¹⁵⁹ Evidence of use of the

¹⁵⁴ See *In re Cababie*, 2016 TTAB LEXIS 138 (“This is not to say that we would not reach a different conclusion on a different record, such as might be adduced in an *inter partes* proceeding, which includes evidence of the descriptiveness of [the phrase].”). And a single declaration may not suffice. See *In re Twenty-Two Desserts*, 2019 U.S.P.Q.2d 292782 n.20 (holding in a foreign equivalents case that “three declarations are too few in number to make a determination as to how consumers in general would perceive a term”).

¹⁵⁵ *In re Tokutake Indus.*, 87 U.S.P.Q.2d 1697 (“While we agree with applicant that there are some elements of the www.freedict.com dictionary that may not enhance its reliability, when the meaning is consistent with applicant’s own translation and applicant’s own submitted dictionary definition, it is at least evidence that supports the examining attorney’s position.”); *In re La Peregrina*, 86 U.S.P.Q.2d 1645 n.3; *In re Brown-Forman Corp.*, 81 U.S.P.Q.2d 1284, 1286 (T.T.A.B. 2006).

¹⁵⁶ *Almosafer Travel*, 2018 TTAB LEXIS 446 n.19.

¹⁵⁷ *In re Luvanis S.A.*, 2016 TTAB LEXIS 32 (T.T.A.B. 2016) (not precedential); see also *In re Cababie*, 2016 TTAB LEXIS 138 (“[W]e accept the point that the online or automatic translations that are generated by software may not be totally accurate, or may merely combine the translations of individual words.”).

¹⁵⁸ *E.g.*, *In re Centruero*, 2019 TTAB LEXIS 273.

¹⁵⁹ TBMP § 1208.03; see also *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 966 (Fed. Cir. 2007) (“Internet evidence is generally admissible and may be considered for purposes of evaluating a trademark.”).

foreign-language mark as a descriptive or generic term may be found, for example, in reviews of the product.¹⁶⁰

Evidence of registration or rejection in other countries: The USPTO generally does not see such evidence as probative of the understanding of U.S. consumers.¹⁶¹

E. Common, Modern Language

The doctrine can apply only where the foreign-language mark is in a modern language that is spoken by purchasers in the United States. It does not apply where the language is “dead, obscure, or unusual.”¹⁶²

1. Which Languages Are Common and Modern, Not Obscure and Dead?

In practice, vanishingly few languages are obscure and excluded from the doctrine of foreign equivalents. The TTAB has found several languages to be “common” and “modern,” including:¹⁶³

- Afrikaans
- Arabic
- Chinese
- Dutch
- Estonian
- French
- German

¹⁶⁰ *E.g.*, *In re Field Roast Grain Meat Co.*, 2017 TTAB LEXIS 352.

¹⁶¹ *In re Bayer*, 488 F.3d at 969 (“Evidence of registration in other countries is not legally or factually relevant to potential consumer perception of [the applicant’s] goods in the United States.”). For a discussion of the relevance of translations understood outside the United States, see *infra* Part III.F.2.d.

¹⁶² TMEP § 1207.01(b)(vi)(B).

¹⁶³ *E.g.*, *In re Savisa (Pty) Ltd.*, 2005 TTAB LEXIS 91 (T.T.A.B. 2005) (not precedential) (Afrikaans); *Semiramis v. MDJ Nemry Corp.*, 2021 TTAB LEXIS 130 (T.T.A.B. 2021) (not precedential) (Arabic); *In re Crystal Cruises*, 2018 TTAB LEXIS 472 (Chinese); *In re Shenzhen Airmart Technology Co.*, 2021 TTAB LEXIS 34 (T.T.A.B. 2021) (not precedential) (Dutch); *Walters Gardens, Inc. v. Pride of Place Plants, Inc.*, 2008 TTAB LEXIS 800 (T.T.A.B. 2008) (not precedential) (Estonian); *In re Thomas*, 79 U.S.P.Q.2d 1021 (French); *FALKE KGaA v. Tahir*, 2020 TTAB LEXIS 51 (T.T.A.B. 2020) (not precedential) (German); *In re S. Malhotra*, 128 U.S.P.Q.2d 1100 (Greek); *In re Hans Merensky Holdings (Pty) Ltd.*, 2005 TTAB LEXIS 271 (T.T.A.B. 2005) (not precedential) (Hungarian); *In re Magnesita Refractories Co.*, 2016 TTAB LEXIS 202 (T.T.A.B. 2016) (not precedential) (Italian, Portuguese, Spanish), *aff’d*, 716 Fed. Appx. 978 (Fed. Cir. 2017); *In re Tokutake Indus.*, 87 U.S.P.Q.2d 1697 (Japanese); *In re Alreshidi*, 2016 TTAB LEXIS 532 (Persian); *In re Joint Stock Co. “Baik,”* 80 U.S.P.Q.2d 1305 (T.T.A.B. 2006) (Russian); *In re S Squared Ventures, LLC*, 2017 TTAB LEXIS 314 (T.T.A.B. 2017) (not precedential) (Swahili); *In re Field Roast Grain Meat Co.*, 2017 TTAB LEXIS 352 (Vietnamese).

- Greek
- Hungarian
- Italian
- Japanese
- Persian
- Portuguese
- Russian
- Spanish
- Swahili
- Vietnamese

The TTAB has also translated a mark into Serbian and Ukrainian, though without explicitly deciding those languages were common or modern.¹⁶⁴ Languages where the evidence of common use in the United States was *insufficient* include:¹⁶⁵

- Esperanto
- Hawaiian
- Irish
- Tamil

Trademark examining attorneys applying the doctrine of foreign equivalents should provide evidence that the foreign language is a “common, modern language.”¹⁶⁶ The form of such evidence can vary, but “evidence of the percentage or number of United States consumers who speak the language in question” is preferred at the USPTO.¹⁶⁷ Evidence from the U.S. Census Bureau of the number of people who speak particular languages in the United States is a typical method of proof.¹⁶⁸ The TTAB takes judicial notice of reports from the Census Bureau, which report data on whether respondents speak a language other than English at home and, if so, what language they speak.¹⁶⁹

¹⁶⁴ *In re Hag Aktiengesellschaft*, 155 U.S.P.Q. 598.

¹⁶⁵ See *ABBY Software Ltd. v. Ectaco Inc.*, 2011 TTAB LEXIS 97 (T.T.A.B. 2011) (not precedential) (Esperanto); *In re Fahey*, 2015 TTAB LEXIS 549 (T.T.A.B. 2015) (not precedential) (Hawaiian); *In re Dunville Peat & Herbal Prods. Ltd.*, 2014 TTAB LEXIS 117 (T.T.A.B. 2014) (not precedential) (Irish); *Aachi Spices & Foods v. Raju*, 2016 TTAB LEXIS 469 (T.T.A.B. 2016) (not precedential) (Tamil).

¹⁶⁶ TMEP § 1207.01(b)(vi)(B).

¹⁶⁷ *Id.*

¹⁶⁸ TMEP § 1207.01(b)(vi)(B) directs trademark examining attorneys to the following web page, for the U.S. Census Bureau, for this purpose: <https://www.census.gov/data/tables/2013/demo/2009-2013-lang-tables.html> (last visited September 19, 2022).

¹⁶⁹ *E.g.*, *Semiramis*, 2021 TTAB LEXIS 130. See *Language Use in the United States: 2019, American Community Survey Report*, <https://www.census.gov/content/dam/Census/library/publications/2022/acs/acs-50.pdf> (last visited September 19, 2022).

Whether a language is “common” in the United States is counterintuitive. One only needs to show that a very small percentage of the American public is proficient in a language to show that that language is commonly spoken in the United States. The Census Bureau reported that, in 2019, there were 308,834,688 people in the United States five years old or older, and 22% of them spoke a language other than English at home.¹⁷⁰ A showing that “over 708,000 people in the United States speak Italian” was still enough to show that Italian is a common language in the United States.¹⁷¹ And a showing that 706,000 Russian speakers lived in the United States established that a “significant portion of consumers” would understand the English meaning of a Russian trademark.¹⁷² Those are each approximately 0.25% of the American population. In other words, 99.75% of the American public does not speak either Italian or Russian. Arguing that the number of possible consumers that could be confused is simply too small to be relevant will pretty much never persuade the USPTO in a foreign equivalents case.

There are a *few* limits, however. The TTAB declined to translate LINGVO from Esperanto, a language constructed in 1887 that has not been adopted by any country, and evidence in the proceeding suggested that it has perhaps 1000 native speakers.¹⁷³ Despite the typical low bar for commonality of languages, the respondent in that case failed to show how widespread the language was in the United States.

The TTAB did not find Irish to be a common language in the United States, but that conclusion appears to have been reached largely because of insufficient evidence in one particular proceeding: “[A]lthough Irish may qualify, in reality, as a ‘common, modern foreign language,’ the examining attorney has failed to introduce the type of probative evidence upon which we could base such a finding.”¹⁷⁴ There had been no showing of “the percentage or number of U.S. consumers who speak Irish; the degree to which Ireland is a prominent trading partner of the United States; or that Irish is spoken by a sizeable world population.”¹⁷⁵

¹⁷⁰ *See id.*

¹⁷¹ *In re Ithaca Indus.*, 230 U.S.P.Q. 702 (holding that the TTAB “does not require any authority to conclude that Italian is a common, major language in the world and is spoken by many people in the United States”).

¹⁷² *In re Joint Stock Co. “Baik,”* 80 U.S.P.Q.2d 1305.

¹⁷³ *ABBY Software*, 2011 TTAB LEXIS 97. The creator’s “goal was to create an easy and flexible language that would serve as a universal second language, to foster world peace and international understanding, and to build a ‘community of speakers.’” *See* <https://en.wikipedia.org/wiki/Esperanto> (last visited September 19, 2022).

¹⁷⁴ *See In re Dunville Peat & Herbal Prods.*, 2014 TTAB LEXIS 117. Whether or not the TTAB finds that a language is “common” and “modern” depends on the evidence presented, so the issue is really whether the party or examining attorney has *showed* that the language is common and modern.

¹⁷⁵ *Id.*

Also, if the language is obscure or dead, the doctrine generally does not apply.¹⁷⁶ Old English is certainly obscure, and also dead,¹⁷⁷ and the same is true of ancient Greek.¹⁷⁸ Latin, too, is considered a dead language, and if a mark is in Latin, consumers are not typically expected to translate it into English.¹⁷⁹ For example, ordinary American consumers would not translate SOLIS into “sunshine.”¹⁸⁰ The TMEP cautions, however, that if a Latin term is currently in use “by the relevant purchasing public,” then it would not be considered dead and would be translated under the doctrine.¹⁸¹

Notably, the TMEP states that the doctrine of foreign equivalents will not be applied where “evidence shows that the language at issue is *highly obscure* or a dead language.”¹⁸² This gloss—requiring the language to be not just obscure but *highly* obscure—seems disingenuous. Only two TTAB opinions use the phrase “highly obscure,” both quoting from the TMEP.¹⁸³ It’s an accurate statement of the strict TTAB practice but there is no explanation for the heightened standard anywhere, much less a reason for it to appear in the examination manual.

Courts generally have a more commonsensical interpretation than the USPTO of whether a language is commonly spoken in the United States. One court found that no reasonable juror could find that the “ordinary American purchaser” would stop and translate a mark from Arabic to English because the “uncontroverted evidence is that only a third of one percent of the United States population speaks Arabic. This statistic alone compels the conclusion that it would be unlikely for an ordinary American buyer to stop and translate the foreign mark.”¹⁸⁴ Another court found that “no sizable

¹⁷⁶ *E.g.*, *Palm Bay Imps.*, 396 F.3d at 1377.

¹⁷⁷ *In re Isabella Fiore, LLC*, 75 U.S.P.Q.2d 1564 (T.T.A.B. 2005) (“Italian, as a major, modern language, is not an obscure language such as Old English.”) (citing *In re Winegard Co.*, 162 U.S.P.Q. 261 (T.T.A.B. 1969) (“Applicant indicates that ‘WINEGARD’ is the equivalent of ‘Winegeard,’ an Old English term meaning a vineyard. We are of the opinion that few of the prospective purchasers of applicant’s goods would be aware that ‘WINEGARD’ is the equivalent of ‘Winegeard,’ if that be so.”)).

¹⁷⁸ *In re Fahey*, 2015 TTAB LEXIS 549 (calling ancient Greek “the prototype of a dead language”).

¹⁷⁹ *In re Int’l Tractors Ltd.*, 2018 TTAB LEXIS 98 (T.T.A.B. 2018) (not precedential) (finding Latin to be a dead language “no longer in everyday use” and “no longer learned as a native language by speech communities”).

¹⁸⁰ *Id.*

¹⁸¹ TMEP §§ 1207.01(b)(vi)(B), 1209.03(g); *see also In re Novus Advisors, LLC*, 2016 TTAB LEXIS 165 (T.T.A.B. 2016) (not precedential) (Latin “is usually considered to be a ‘dead’ language, and unless the term in question is commonly used in English, we do not consider the English meaning of the Latin term in determining registrability.”).

¹⁸² TMEP § 1207.01(b)(vi)(B) (emphasis added).

¹⁸³ *In re Int’l Tractors*, 2018 TTAB LEXIS 98; *In re Dunville Peat & Herbal Prods.*, 2014 TTAB LEXIS 117.

¹⁸⁴ *Taza Sys.*, 2013 U.S. Dist. LEXIS 130974.

segment of the relevant public is likely to speak the Algonquin language” and translate MOHEGAN into “wolf.”¹⁸⁵ And another court noted that defendants in its case did not offer any evidence to suggest that U.S. consumers would be likely to translate AMARETTI DI SARONNO from Italian.¹⁸⁶ But courts will translate foreign terms where appropriate, such as where many consumers in South Florida would recognize the English meaning of a mark in Spanish.¹⁸⁷

Courts may also decline to translate words from Latin into their generic or descriptive English meanings.¹⁸⁸ One district court noted that the plaintiff’s NATURALIS mark for insecticides was Latin for “natural,” but noted that the language is “far from commonplace today” and saw “no evidence . . . supporting that the meaning of the Latin is familiar to a sizeable segment of the American buying public so as to render it merely descriptive.”¹⁸⁹ The court found it to be a suggestive mark for insecticides. The Second Circuit, however, found that LEXIS, a term from Latin and ancient Greek, had become part of the English language so that its definition was relevant to the distinctiveness of the mark.¹⁹⁰

2. Critique and Confusion

Determinations by the USPTO of whether a language is commonly spoken in the United States are unsatisfying. For one, the evidence underlying those determinations is often somewhat dubious. In addition, allowing such small groups of potential consumers to hold sway over whether a mark is valid or is likely to confuse is antithetical to trademark law principles followed outside the foreign-language context.

a. Debatable Interpretations of Evidence

In a 2021 opinion, the TTAB noted that U.S. Census evidence from the year 2000 showed that 150,396 people in the United States

¹⁸⁵ *Mohegan Tribe of Indians of Conn. v. Mohegan Tribe & Nation, Inc.*, 769 A.2d 34 (Conn. 2001).

¹⁸⁶ *Lazzaroni USA Corp. v. Steiner Foods*, 2006 U.S. Dist. LEXIS 20962 (D.N.J. 2006); *see also* *General Cigar Co. v. G.D.M. Inc.*, 988 F. Supp. 647, 660–61 (S.D.N.Y. 1997) (finding applicant had no obligation to disclose that COHIBA for cigars means “tobacco” in the language of the Taino Indians in the Dominican Republic because U.S. cigar smokers would not be aware of that meaning).

¹⁸⁷ *See* *Popular Bank v. Banco Popular*, 9 F. Supp. 2d 1347 (S.D. Fla. 1998).

¹⁸⁸ *Enrique Bernat*, 210 F.3d at 443 (stating that “courts need not concern themselves with words from obsolete, dead, or obscure languages”).

¹⁸⁹ *Troy Biosciences v. DowElanco*, 1996 U.S. Dist. LEXIS 22245 (D. Ariz. 1996), *vacated by* 1997 U.S. Dist. LEXIS 23190 (D. Ariz. 1997).

¹⁹⁰ *Mead Data Cent., Inc. v. Toyota Motor Sales, U.S.A., Inc.*, 875 F.2d 1026, 1027 (2d Cir. 1989).

spoke Dutch at home.¹⁹¹ Surely that could not be enough to show that Dutch is a common language. Well, that wasn't all. There was also evidence that classes are offered in the United States to teach Dutch and that Facebook and other groups exist to meet and practice speaking that language.¹⁹² "This evidence," found the TTAB, "establishes that Dutch is a common modern language spoken by an appreciable number of consumers in the United States."¹⁹³ This conclusion is a stretch, to put it mildly.

Along with its willingness to accept a very minimal level of evidence as proof that a language is common, the TTAB also does not take U.S. Census evidence at face value. Instead, it assumes that Census data *undercounts* the number of foreign-language speakers in the United States, concluding that the percentages of those who speak a language as the primary language spoken at home "should not be confused with the percentages of Americans who know a particular language."¹⁹⁴ In one case, it found that Chinese was a common, modern language based on U.S. Census data on the languages Americans speak at home, but went on to add that many U.S. residents know Chinese but speak English at home and they would *not* have been included in the Census data.¹⁹⁵

The TMEP directs that, if Census evidence is "unavailable or *unpersuasive*," the trademark examining attorney may provide additional evidence from "the USPTO's Translations Branch, . . . the Internet, LexisNexis®, and any other relevant electronic or print resources."¹⁹⁶ But perhaps if Census data is *unpersuasive*, the TTAB should not be persuaded and should indeed find that the language is not commonly spoken in the United States.

One examining attorney was able to convince the TTAB that Swahili is a common, modern language in the United States despite evidence that only 88,685 people in the United States speak Swahili at home.¹⁹⁷ But, said the TTAB, there are surely more who are fluent—those who have emigrated to the United States, perhaps, or whose parents are fluent or who studied the language at school.¹⁹⁸ "None of those speakers," said the TTAB, "would be represented in Applicant's cited statistic of the number of Americans who speak Swahili in their homes, yet each would be among the appreciable

¹⁹¹ *In re Shenzhen Airsmart Technology*, 2021 TTAB LEXIS 34. This is approximately 0.05% of the U.S. population, meaning 99.95% of U.S. residents do *not* speak Dutch.

¹⁹² *Id.*

¹⁹³ *Id.*

¹⁹⁴ *In re S Squared Ventures*, 2017 TTAB LEXIS 314.

¹⁹⁵ *In re Crystal Cruises*, 2018 TTAB LEXIS 472.

¹⁹⁶ TMEP § 1207.01(b)(vi)(B) (emphasis added).

¹⁹⁷ *In re S Squared Ventures*, 2017 TTAB LEXIS 314. This represents roughly 0.03% of U.S. residents, meaning around 99.97% of the population does *not* speak Swahili.

¹⁹⁸ *Id.*

group who would translate Applicant's mark"¹⁹⁹ In addition to the fact that Swahili is spoken in multiple other countries, the relevance of which is unclear, the following evidence proved persuasive to the TTAB:

- Major American universities offer classes in Swahili
- Many American universities have student Swahili clubs
- A streaming Swahili-language radio station originates in the United States
- American churches exist that have Swahili-speaking congregations and sermons in Swahili and English
- An institute located in Chicago promotes Swahili culture
- A teacher in Milwaukee was teaching Swahili to young children in a child development center

Thus, Swahili was not just common and modern, but, according to the TTAB, "*far from 'dead, obscure, or unusual,'*"²⁰⁰ and the doctrine applied.

One applicant argued against use of the doctrine to translate a mark allegedly in Afrikaans, providing evidence that just 0.096% of Americans speak that language as the primary language in their homes.²⁰¹ The TTAB did not accept this number, suggesting that other Americans likely studied the language in school or emigrated from another country but still speak English as their primary language at home.²⁰² In addition, the USPTO translator stated that Afrikaans is "a well-established language, recognized by all of the advanced and developed nations, and is a form of old Dutch."²⁰³ The TTAB went on to note that the language is "taught in the schools in the Republic of South Africa, and all road signs there are in Afrikaans as well as English."²⁰⁴ The TTAB took judicial notice of a world almanac stating that six million people speak Afrikaans, "with significant numbers in ten countries."²⁰⁵ Thus, found the TTAB, Afrikaans is a modern language that is not obscure, so the doctrine of foreign equivalents applied.²⁰⁶

The analysis from these cases is implausible. All that is needed to find a language "common" is an examining attorney or petitioner with the ability to search the Internet to find Swahili clubs at

¹⁹⁹ *Id.*

²⁰⁰ *Id.* (emphasis and eyebrow-raising added).

²⁰¹ *In re Savisa*, 2005 TTAB LEXIS 91. That means, yes, that 99.9% of U.S. residents do *not* speak Afrikaans as the primary language in their homes.

²⁰² *Id.*

²⁰³ *Id.*

²⁰⁴ *Id.*

²⁰⁵ *Id.*

²⁰⁶ *Id.*

American universities, the language on road signs in South Africa, and Facebook groups meeting to practice Dutch. Remember, the relevant question is whether the language is “from a language familiar to an appreciable segment of American consumers” commonly spoken in the United States.²⁰⁷ Certainly, evidence of the language being spoken around the world is relevant to how much it is spoken in the United States, but surely “significant numbers in ten countries” does not automatically mean that it is a common language *in the United States*.

The TTAB fails to consider another important fact. For the doctrine to apply, at least in the confusing similarity context,²⁰⁸ U.S. consumers translating marks from a foreign language into English must understand both that foreign language *and* English. Otherwise, they would simply be unable to convert a term from one language to the other.

A few examples are in order on this point. A table from the Census Bureau from 2015 gives the number of Dutch speakers in the United States as 141,580 but also states that, of those, 25,030 speak English less than “very well.”²⁰⁹ So only around 116,550 people in the United States speak Dutch *and* English proficiently. The same table lists the number of speakers of Swahili in the United States as 88,685, with 22,055 speaking English less than “very well.”²¹⁰ Bilingual Swahili-English speakers in the United States number, then, around 66,630. The number of Afrikaans speakers in the United States is just 23,010, with 1885 speaking English less than “very well,”²¹¹ making the number of bilingual Afrikaans-English speakers around 21,125. Those bilingual consumers are the only ones likely to translate a trademark from that foreign language into English. That’s not an “appreciable segment of American consumers”²¹² by any means.

It is entirely true that the USPTO’s ability to gather evidence is limited. Its trademark examining attorneys have limited resources and limited time to spend on each application. But that does not justify applying the doctrine of foreign equivalents by relying on unconvincing evidence or making speculative assumptions to bolster that evidence.

²⁰⁷ TMEP § 1207.01(b)(vi); *see also* TMEP § 1207.01(b)(vi)(B) (“The doctrine applies to words or terms from common, modern languages, which encompasses all but dead, obscure, or unusual languages.”).

²⁰⁸ *See infra* Part III.F.2.c.

²⁰⁹ *See* “Detailed Languages Spoken at Home and Ability to Speak English for the Population 5 Years and Over for United States: 2009–2013,” <http://www2.census.gov/library/data/tables/2008/demo/language-use/2009-2013-acs-lang-tables-nation.xls> (last visited September 19, 2022).

²¹⁰ *Id.*

²¹¹ *Id.*

²¹² TMEP § 1207.01(b)(vi).

b. Failure to Meet “Appreciable Number” Standard

Under the doctrine of foreign equivalents as currently applied, tiny percentages of U.S. consumers have a disproportionate influence on whether a mark is registered or enforced.²¹³ The number of people in the United States who speak the relevant language *and* who might realistically purchase the product or service may be insignificant compared to the entire U.S. population. Even though the USPTO refuses to accept almost any challenge based on the scarcity of potentially affected consumers, that number may be so small as to make applying the doctrine nonsensical.

In the typical trademark infringement case, a court will find liability only if an “appreciable” or “substantial” number of consumers are likely to be confused.²¹⁴ While the Lanham Act does not require a specific level, confusion surveys showing very low percentages are unlikely to persuade a court.²¹⁵ Nor should they.

But with the doctrine of foreign equivalents, it is rarely accurate to say that a “substantial portion” of the public is affected by the relevant bar to registration. To a great majority of consumers in the United States, a foreign-language mark is arbitrary when compared to the goods or services or will not be confused with a mark that is its English equivalent.²¹⁶

²¹³ Krimnus, *supra* note 118, at 159–60 (“Imagine a state of the law where a trademark can be refused registration where less than a mere 0.01% of the purchasing public is confused by the mark. Such a rule seems antithetical to the basic purpose of trademark law. . . . Unfortunately, this is exactly the current state of affairs under the doctrine of foreign equivalents.”).

²¹⁴ *E.g.*, Savin Corp. v. Savin Grp., 391 F.3d 439, 456 (2d Cir. 2004) (citation omitted) (“The crucial issue in an action for trademark infringement. . . is whether there is any likelihood that an appreciable number of ordinarily prudent purchasers are likely to be misled, or indeed simply confused, as to the source of the goods in question.”); Entrepreneur Media, Inc. v. Smith, 279 F.3d 1135, 1151 (9th Cir. 2002) (“To constitute trademark infringement, use of a mark must be likely to confuse an appreciable number of people as to the source of the product.”); Rust Env’t & Infrastructure, Inc. v. Teunissen, 131 F.3d 1210, 1219 (7th Cir. 1997) (finding that the common law test for likelihood of confusion is “whether ‘an appreciable number of ordinarily prudent prospective purchasers will be confused’” and noting that the test “is the same as that for likelihood of confusion under the Lanham Act”); International Ass’n of Machinists & Aerospace Workers, AFL-CIO v. Winship Green Nursing Ctr., 103 F.3d 196, 201 (1st Cir. 1996) (“The law has long demanded a showing that the allegedly infringing conduct carries with it a likelihood of confounding an appreciable number of reasonably prudent purchasers exercising ordinary care.”); *see generally* Gilson on Trademarks, *supra* note 8, § 5.17.

²¹⁵ *See, e.g.*, Surfivor Media, Inc. v. Survivor Prods., 406 F.3d 625, 633 (9th Cir. 2005) (finding that survey showing only 2% respondent confusion “showed an absence of significant confusion”); Sara Lee Corp. v. Kayser-Roth Corp., 81 F.3d 455, 467 n.15 (4th Cir. 1996) (finding that “survey evidence clearly favors the defendant when it demonstrates a level of confusion much below ten percent”).

²¹⁶ *E.g.*, John T. Cross, *Language and the Law: The Special Role of Trademarks, Trade Names, and Other Trade Emblems*, 76 Neb. L. Rev. 95, 139 (1997) (“[D]epending on the word, some percentage of the population will not recognize the meaning of the foreign term. To this group, the word conveys no descriptive or allusive messages whatsoever.”).

This situation mirrors that of surname rejections, where the USPTO reflexively rejects registrations for marks that resemble surnames even if the number of people with those surnames in the United States is exceedingly small.²¹⁷ In one case, for example, only 868 mentions of the name “Azeka” appeared on a list of U.S. surnames, but the name was mentioned on “at least three websites”; the TTAB concluded that it was primarily merely a surname and refused registration.²¹⁸

c. A Suggestion

The doctrine’s underlying concerns about protection and enforcement are understandable. What if the foreign-language mark is *precisely* the generic term for a product to 10,000 people? 1000? 500? 200? Should the putative mark owner be barred from using that term as a trademark? Likewise, what if 10,000 consumers would be confused over the source of a product if they happened to encounter both the foreign-language mark and the English-language mark? 1000? 500? 200? What is the appropriate limit?

One option is for the USPTO to drop the façade of asking whether a language is common in the United States. The TTAB would no longer have to pretend that Swahili is “far from” obscure in the United States. The USPTO could come out with an Examination Guide directing trademark examining attorneys to translate a foreign-language mark into any language if those who speak that language would translate that mark in the marketplace.

For validity analysis, the descriptive or generic nature would have to be extremely clear to find a foreign-language mark lacked distinctiveness. Perhaps there could be a sliding scale: the fewer people who speak the language in the United States, the stronger the evidence of descriptiveness or genericness must be. And a company using a descriptive foreign-language mark could still show acquired distinctiveness, as it can now, and retain rights in that term.

For confusing similarity analysis, if the USPTO states plainly that any language is fair game for translation, the comparison between foreign-language and English marks should explicitly depend more on their visual and aural similarity, channels of trade, and other factors, and less on their connotation. The “appreciable”-number-of-purchasers standard should not be jettisoned; instead, the more obscure the language, the more difficult it should be to find that confusion is likely.

²¹⁷ See *Gilson on Trademarks*, *supra* note 8, § 2.03[4][d][vi][I] for more on the relevance of rarity in surname rejections at the USPTO.

²¹⁸ *Azeka Building Corp. v. Azeka*, 122 U.S.P.Q.2d 1477 (T.T.A.B. 2017).

F. Ordinary American Purchaser

The doctrine applies only when the “ordinary American purchaser” would stop and translate a foreign-language mark into English.²¹⁹

1. Who Is the Ordinary American Purchaser?

a. In General

The Federal Circuit, in 2005, set out the requirement that the “ordinary American purchaser” would be the judge of when the doctrine of foreign equivalents applied.²²⁰ The court unfortunately did not elaborate on the meaning of this phrase.

Then, in 2006, the TTAB explained that the “ordinary American purchaser” must be a person “who is knowledgeable in the foreign language.”²²¹ And this person must be knowledgeable in English *as well as* the foreign language at hand.²²² In other words, the *ordinary* American purchaser is not the *average* American purchaser. If it were, said the TTAB, that “would write the doctrine out of existence” because the average American is not bilingual and so would simply not translate any foreign term.²²³

b. In Cases Where the Mark May Be Primarily Geographically Deceptively Misdescriptive

That was not the last word on the “ordinary American purchaser,” however. In a 2009 decision, the Federal Circuit appeared to clarify the TTAB’s 2006 definition:

The “ordinary American purchaser” is not limited to only those consumers unfamiliar with non-English languages; rather, the term includes *all American purchasers, including those proficient in a non-English language* who would ordinarily be expected to translate words into English.²²⁴

That sentence suggests that, when asking whether the doctrine applies, the understanding of “all American purchasers” is relevant, *not just* those who speak the foreign language.²²⁵ Again, the relevant

²¹⁹ *Palm Bay Imps.*, 396 F.3d at 1377.

²²⁰ *Id.*

²²¹ *In re Thomas*, 79 U.S.P.Q.2d 1021, at *3 (T.T.A.B. 2006).

²²² *Id.*

²²³ *Id.*

²²⁴ *In re Spirits Int’l, N.V.*, 563 F.3d 1347, 1352 (Fed. Cir. 2009) (emphasis added).

²²⁵ Note that the sentence refers to (1) all American purchasers, a group that includes (2) those American purchasers proficient in a foreign language who would translate certain words into English. It does not refer only to “all American purchasers who would translate certain words into English.” There is no comma in the sentence after “including

group includes not *only* those proficient in both English and another language, but it also includes *everyone* in the United States who might purchase the good or service.

In practice, however, that expansive definition applies to a very small subset of trademarks. The 2009 Federal Circuit case, *In re Spirits International*, involved a refusal to register the mark MOSKOVSKAYA for vodka under Section 2(e)(3) of the Lanham Act on the ground that the mark was primarily geographically deceptively misdescriptive.²²⁶ Translated from Russian under the doctrine of foreign equivalents, the TTAB found that the mark meant “of or from Moscow,” but the vodka in fact had no connection to Moscow.²²⁷ Using the criteria of Section 2(e)(3), the TTAB found that the misrepresentation was likely to be a material factor in the decision of a substantial portion of relevant consumers—that is, those consumers in the United States who spoke Russian—making the mark unregistrable.²²⁸

On appeal, the main issue was the scope of the materiality requirement.²²⁹ The TTAB’s materiality inquiry was too narrow, according to the Federal Circuit.²³⁰ Instead of simply considering Russian speakers, “the appropriate inquiry for materiality purposes is whether a substantial portion of the relevant consumers is likely to be deceived, not whether any absolute number *or particular segment of the relevant consumers (such as foreign language speakers)* is likely to be deceived.”²³¹ In other words, the question is whether a considerable number of all relevant consumers would be deceived, not whether a smaller portion of those consumers would be deceived; people other than Russian speakers would presumably purchase the vodka as well.²³² The court emphasized that there was already a proportionality requirement for materiality in deceptiveness cases and false advertising cases, “requiring that a substantial portion of the audience be deceived.”²³³

With this background, the court held that the TTAB had failed to ask whether Russian speakers were a significant portion of the

those proficient in a non-English language” to suggest a limitation on “all American purchasers.”

²²⁶ *Id.* See 15 U.S.C. § 1052(e)(3) (“No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it . . . [c]onsists of a mark which . . . when used on or in connection with the goods of the applicant is primarily geographically deceptively misdescriptive of them.”); Gilson on Trademarks, *supra* note 8, § 3.08[2][e].

²²⁷ *In re Spirits Int’l*, 563 F.3d at 1350.

²²⁸ *Id.*

²²⁹ *Id.* at 1352.

²³⁰ *Id.* at 1357.

²³¹ *Id.* at 1353 (emphasis added).

²³² See *id.*

²³³ *Id.* at 1355.

relevant consuming public for that product.²³⁴ The TTAB must consider the opinions of the entire relevant consuming public, but it was possible that Russian speakers *were* the universe of the relevant consuming public, or most of that universe.²³⁵ The Federal Circuit remanded the case, noting that only 0.25% of the U.S. public speaks Russian.²³⁶

The “relevant consuming public” is often huge—anyone in the United States “interested in purchasing the product or service.”²³⁷ However, where the use of a foreign-language mark may show that the product is targeted at a small group of U.S. consumers—those who speak that language—then that smaller group *may* constitute the “relevant consuming public.”²³⁸ Then the translation could deceive a sufficient percentage of relevant consumers to be primarily geographically deceptively misdescriptive even if those consumers make up a very small part of the U.S. population.²³⁹ But where the goods or services at issue are not restricted to any particular group of purchasers, a group limited to speakers of a particular language will not be the relevant consuming public.²⁴⁰

The court expressly limited its holding to Section 2(e)(3), saying it had “no occasion here to decide the scope of the doctrine of foreign equivalents in other contexts.”²⁴¹ The TMEP says that, in Section 2(e)(3) cases, “the requirement that a substantial portion of the relevant consuming public would likely be deceived raises special issues.”²⁴² The trademark examining attorney must ask whether the foreign-language place name at issue would be translated by those who do not speak that language “and/or” whether consumers who do speak that language could make up a substantial portion of the relevant consumers, perhaps because they are the target audience for the goods or services.²⁴³

²³⁴ *Id.* at 1357.

²³⁵ *Id.*

²³⁶ *Id.*

²³⁷ *Id.* at 1356.

²³⁸ *Id.*

²³⁹ *Id.*

²⁴⁰ *See, e.g., In re Branded LLC*, 2020 TTAB LEXIS 184 (T.T.A.B. 2020) (not precedential) (finding that a substantial portion of purchasers of “bed sheets; pillow cases; comforters; bedspreads” would find mark primarily geographically deceptively misdescriptive).

²⁴¹ *In re Spirits Int’l*, 563 F.3d at 1356 n.5; *see Krimnus, supra* note 118, at 182 (“*Spirits* effectively abolished the doctrine [of foreign equivalents] in cases concerning primarily geographically deceptively misdescriptive marks under subsection 2(e)(3).”).

²⁴² TMEP § 1210.05(b).

²⁴³ *See Corporacion Habanos, S.A. v. Guantanamera Cigars Co.*, 102 U.S.P.Q.2d 1085, 1097 (T.T.A.B. 2012) (finding that Spanish speakers were a substantial portion of the intended audience for applicant’s GUANTANAMERA cigars where advertising was almost entirely in Spanish and finding that the Cuban origin of cigars was material to a substantial portion of those relevant consumers).

At least one applicant has tried to argue to the TTAB that *Spirits International* requires the USPTO to appraise all foreign trademarks from the point of view of all American purchasers, including those who do not speak the relevant foreign language, and the expansive definition applies beyond Section 2(e)(3).²⁴⁴ Not surprisingly, the TTAB found the Federal Circuit opinion inapplicable to non-Section 2(e)(3) cases.²⁴⁵

The TTAB explained that the Federal Circuit had held only that, *in the context of a refusal to register under Section 2(e)(3)*, one factor required a showing that the mark or advertising “must deceive a *substantial portion* of the relevant consumers.”²⁴⁶ Therefore, where there is a refusal to register under Section 2(e)(3) and the alleged deception depends on how foreign terms in the mark are understood, the USPTO must show that a “substantial portion of the intended audience” would understand the relevant foreign language before showing they could be deceived.²⁴⁷ The TTAB concluded:

[T]he requirement in *Spirits International* that a “substantial portion of the intended audience” understand a foreign term used in a mark is a direct result of the requirement for materiality in Trademark Act § 2(e)(3). . . . *Spirits International* clearly did not make the “materiality” standard applicable to any and all cases involving the doctrine of foreign equivalents.²⁴⁸

To hold otherwise would have ignored binding precedent on the application of the doctrine in other contexts.²⁴⁹ The TTAB, then, refused to extend that holding to “other applications of the doctrine of foreign equivalents.”²⁵⁰

In sum, the USPTO uses a different standard for “ordinary American purchaser” under Section 2(e)(3).²⁵¹

²⁴⁴ *In re Lettuce Entertain You Enters.*, 2013 TTAB LEXIS 254.

²⁴⁵ *Id.*

²⁴⁶ *Id.* (emphasis added) (quoting *In re Spirits Int’l*, 563 F.3d at 1356).

²⁴⁷ *Id.*

²⁴⁸ *Id.*

²⁴⁹ *Id.* at n.11 (“To the extent that *Spirits International’s* treatment of foreign equivalents is in conflict with the interpretation of the Court of Customs and Patent Appeals or of a prior panel of the Federal Circuit, the prior decision is controlling precedent and must be followed.”).

²⁵⁰ *Id.*

²⁵¹ See Krimnus, *supra* note 118, at 186 (footnote omitted) (“[W]hen analyzing a foreign mark for geographic deceptiveness, the Board will consider the mark from the standpoint of the ordinary American purchaser, including the majority of purchasers who do not speak the pertinent foreign language. For all other bars to registration, however, the Board will continue to . . . only consider the mark’s effect on purchasers who speak the foreign language.”).

2. Critique and Confusion

In addition to the odd distinction between primarily geographically deceptively misdescriptive trademarks and descriptive or confusing trademarks, the identity of the ordinary American purchaser and his or her knowledge of foreign language and culture are unclear in the case law.

a. Incorrect Standard Quoted in TMEP and Case Law

Note that the TMEP and some doctrine of foreign equivalents cases incorrectly echo the language from *Spirits* that requires looking at the viewpoint of “all American purchasers.”²⁵² In fact, the doctrine applies only when the ordinary American purchaser “who is knowledgeable in the foreign language” would stop and translate the mark,²⁵³ *except if the mark may be primarily geographically deceptively misdescriptive*. In practice, courts and the TTAB follow the narrower standard while sometimes improperly using the language of the broader standard.

b. What Is the Relevant Group of Ordinary American Purchasers?

Whose point of view *should* be relevant in deciding whether a mark is distinctive or confusing in the United States under the doctrine? As one commentator aptly observes: “Defining the relevant group of consumers proves to be the critical determining factor in analyzing the effect of a non-English mark.”²⁵⁴ The identity of this group matters a great deal for enforcement and registration.

Under the general principles of U.S. trademark law, the ordinary American purchaser should be the actual or likely

²⁵² See, e.g., *Taza Sys.*, 2013 U.S. Dist. LEXIS 130974 (“[T]he ‘ordinary American purchaser’ is not limited to only those consumers unfamiliar with non-English languages; rather, the term includes all American purchasers, including those proficient in a non-English language who would ordinarily be expected to translate words into English.”); *In re Highlights for Children*, 118 U.S.P.Q.2d 1268 (“The ‘ordinary American purchaser’ is not limited to those purchasers who speak only English.”); TMEP §§ 1209.03(g), 1210.10. It is incorrect for the TTAB to state that the rationale behind the doctrine of foreign equivalents “is that a foreign, non-English word familiar to an appreciable segment of American purchasers may be confusingly similar to its English equivalent.” *In re The Line and Dot LLC*, 2016 TTAB LEXIS 481 (T.T.A.B. 2016) (not precedential). The TMEP perpetuates the misunderstanding of the doctrine by stating, outside the Section 2(e)(3) context, that the ordinary American purchaser is “all American purchasers, including those proficient in a non-English language who would ordinarily be expected to translate words into English.” TMEP §§ 1207.01(b)(vi)(A), 1209.03(g). That standard applies only to Section 2(e)(3) cases.

²⁵³ E.g., *In re Compass Automotive*, 2019 TTAB LEXIS 143.

²⁵⁴ Skinner, *supra* note 37, at 63.

purchaser of the relevant goods or services.²⁵⁵ In other words, the *Spirits International* standard should apply across the board to all doctrine of foreign equivalents cases, not just to the small subset of cases decided under Section 2(e)(3) of the Lanham Act.

It may be that many or all of those actual or likely purchasers will in fact speak the relevant foreign language. The product or service may be targeted to their demographic. In that case, they will be more likely to translate the foreign-language mark and thus the courts and USPTO should do so as well. One court found, for instance, that, while RAAGA translated to “color or passion or rhythmic patterns” from Hindi, the term was used generically to mean Indian and/or South Asian music generally.²⁵⁶ It was not the *translation* that was conclusive to the holding of the case, however, but the use by “the relevant public that purchases Indian and South Asian music.”²⁵⁷ In one proceeding, the TTAB was persuaded that American consumers would not translate a mark from the Russian Cyrillic alphabet into English where the goods were musical sound recordings in Spanish.²⁵⁸

The Restatement (Third) of Unfair Competition would apply the broader *Spirits* standard. In validity cases, it states that the standard for finding invalidity of a mark with non-English wording should be “whether a significant number of prospective purchasers are likely to understand the word merely in its descriptive sense.”²⁵⁹ It goes on to say in this context that the doctrine should apply to “words from major foreign languages and to other foreign words used on products marketed to groups familiar with the language from which the word is taken.”²⁶⁰ And for confusing similarity, the translation “must be one that is likely to be made by a significant number of prospective purchasers.”²⁶¹

A state court judge in New York in 1895 was faced with this dilemma and came down strongly against protection of descriptive terms understood by only a tiny part of the population.²⁶² A business

²⁵⁵ See Rest, *supra* note 52, at 1213 (“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.”).

²⁵⁶ *Vista India*, 501 F. Supp. 2d at 615.

²⁵⁷ *Id.*

²⁵⁸ *In re Fonovisa, Inc.*, 1998 TTAB LEXIS 138 (T.T.A.B. 1998) (not precedential) (“Clearly, in the United States, the prospect of an appreciable number of prospective purchasers of applicant’s and registrant’s Spanish language musical sound recordings who, in addition to knowing Spanish, are familiar with the Russian language and are also fluent in English, so as to be able both to translate registrant’s . . . mark from Russian into English and understand Spanish musical recordings, seems extremely remote.”).

²⁵⁹ Restatement (Third) of Unfair Competition § 14.

²⁶⁰ *Id.*

²⁶¹ *Id.* § 21 cmt. e.

²⁶² See *Dadirrian v. Theodorian*, 37 N.Y.S. 611, 612–13 (Sup. Ct. N.Y. 1895).

had sold fermented milk in the United States under a trademark that was quite close to the term used by Armenians to signify that type of product.²⁶³ The judge concluded:

I do not think that such a term can properly be regarded as descriptive in this country. It would be absolutely meaningless to all but a little group of Armenians in the millions of inhabitants of the United States. . . . A Choctaw word would signify just as much. To the medical profession, among whom the plaintiff sought approval for his product, and to the drug trade, the name . . . was practically an arbitrary or fanciful designation. It was not incorporated into the English language; it was derived from a language hardly known here, and to the vast majority of our people it meant nothing. Hence, the rule upon which the defendant relies has no application here.²⁶⁴

One issue with this standard is that, unlike courts, the USPTO looks at only the identifications of goods as listed in applications and registrations, not at how the goods actually appear in the marketplace.²⁶⁵ Prospective purchasers, then, will be anyone who would purchase the listed goods, likely not limited to speakers of a certain foreign language. In one doctrine of foreign equivalents case, for example, the TTAB observed: “Even if Applicant’s goods are not targeted to Dutch speakers, the consuming public for Applicant’s goods includes those American consumers proficient in Dutch because there are no limitations in Applicant’s identification of goods.”²⁶⁶ Certainly it does, but it includes *all* potential customers for those goods—which was stereo equipment—and very few in that large group speak Dutch.

This suggested standard is far from perfect, and its anticompetitive effects could be real.²⁶⁷ Another New York judge,

²⁶³ *Id.* at 612.

²⁶⁴ *Id.* at 612–13. Several lawsuits involved this trademark, interestingly, and their results were in opposition. *See, e.g.,* Dadirrian v. Yacubian, 98 F. 872, 879 (1st Cir. 1900) (finding that “Matzoon” was not an arbitrary mark but was instead the designation in Armenian for “a historically and locally well known Armenian healthful beverage, containing certain medicinal qualities”).

²⁶⁵ Gilson on Trademarks, *supra* note 8, § 9.03[2][a][iii].

²⁶⁶ *In re Shenzhen Airmart Technology*, 2021 TTAB LEXIS 34; *cf.* Deckers Outdoor Corp. v. Australian Leather Pty Ltd., 340 F. Supp. 3d 706, 715 (N.D. Ill. 2018) (disregarding the fact that an Australian term was generic “among American surfers in the 1970s,” saying, “Sheepskin boots are not a specialized technology that appeals only to some limited consumer base”).

²⁶⁷ Robert Brauneis & Anke Moerland, *Monopolizing Matratzen in Malaga: The Mistreatment of Distinctiveness of Foreign Terms in EU and US Trademark Law* (Oct. 24, 2018), GWU Law School Public Law and Legal Theory Paper No. 2020-61, <https://ssrn.com/abstract=3273701> (arguing that “trademark protection for terms that are generic or descriptive in a foreign language can have anticompetitive effects even when domestic consumers do not currently understand them”); Michael Grynberg, *A Trademark Defense of the Disparagement Bar*, 126 Yale L.J. F. 178, 188–89 (2016) (“[T]he

this one writing in 1934, makes a compelling case for the opposite point of view:

[A] word commonly used in other countries to identify a kind of product and there in the public domain as a descriptive or generic name may not be appropriated here as a trade-mark on that product, even though the person claiming the word was the one who introduced the product here and the word then had no significance to our people generally. The rule is a just one. Why should the first comer be given a monopoly of the word when he knew all along that he had no better right to it than any one else? If others who may bring the same product here later cannot sell it under its real name, fair competition would be greatly impeded.²⁶⁸

But courts and the USPTO should stop engaging in an insupportable legal fiction that itself overreaches in findings of invalidity and likelihood of confusion.²⁶⁹ It should acknowledge the reality that cases are invoking very small numbers of U.S. residents to bar registration and find confusion and should align the doctrine of foreign equivalents with the standards used outside of that context.

c. Must the Relevant Purchaser Be Bilingual?

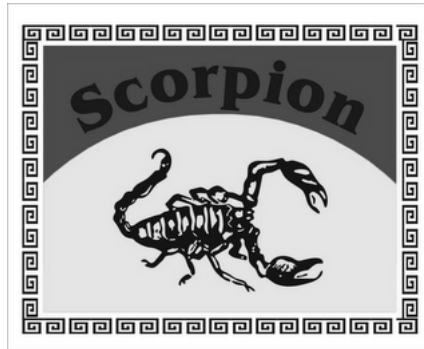
For confusing similarity analysis between a foreign-language mark and an English mark, only the point of view of American consumers who are familiar with both languages should be relevant. They are the only ones, for example, who could be confused when seeing ALACRAN into believing it is connected with SCORPION. An applicant sought registration for ALACRAN for alcoholic beverages but was blocked by the standard character mark SCORPION MEZCAL and the following design mark (in color), both registered for alcoholic beverages.²⁷⁰

doctrine of foreign equivalents prevents registration applicants from circumventing registration restrictions by substituting words from foreign languages with equivalent meanings. It does so notwithstanding the fact that many Americans are monolingual and would not recognize non-English terms.”).

²⁶⁸ *Holland*, 8 F. Supp. at 261.

²⁶⁹ See Merante, *supra* note 38, at 349 (“Foreign-language marks have immense branding potential, but this potential will never be realized if prospective mark registrants are wary of investing in a mark that may be rejected or face excessive word choice restrictions at the PTO.”).

²⁷⁰ *In re Centruro*, 2019 TTAB LEXIS 273.



The TTAB found that the ordinary American purchaser of alcoholic beverages would translate ALACRAN from Spanish into SCORPION.²⁷¹ Nevertheless, someone who does not speak Spanish and English is never going to see those as confusingly similar.

Validity analysis is different. Here, the ordinary American purchaser need not necessarily be bilingual. Take the example of FAMILIA DENTAL. The USPTO refused registration because the mark simply means “family dental” in Spanish, clearly generic for “dental hygienist services; dentist services; [and] orthodontic services.”²⁷² Prospective consumers of those services do not need to know what the phrase means in English for it to be generic for those services. They only need to know that, in their language, it signifies the services being offered.

While there is no expectation that the ordinary American purchaser is trilingual, the TTAB has applied the doctrine on occasion in this situation and translated marks from their respective languages into English to compare them. In one proceeding, the TTAB applied the doctrine of foreign equivalents where the applicant’s mark was in Italian and the opposer’s marks were in Spanish.²⁷³ The applicant sought to register the mark below on the left, which included the Italian phrase DUE TORRI, meaning “two towers,” for wines.²⁷⁴ The opposer’s marks, below on the right, used the Spanish words TORRES and TRES TORRES, meaning “towers” and “three towers,” and were registered for brandy and wine.²⁷⁵

²⁷¹ *Id.*

²⁷² *In re Familia Mgmt. Gp.*, 2019 TTAB LEXIS 351.

²⁷³ *Miguel Torres S.A. v. Casa Vinicola Gerardo Cesari S.R.L.*, 49 U.S.P.Q.2d 2018 (T.T.A.B. 1998), *vacated and remanded on other grounds*, 230 F.3d 1372 (Fed. Cir. 1999).

²⁷⁴ *Id.*

²⁷⁵ *Id.*

DUE TORRI



TORRES



Tres Torres

The TTAB found confusion likely, concluding that it was not necessary for consumers to be fluent in both Italian and Spanish to understand the meaning of the words in the marks.²⁷⁶ A Spanish-speaking purchaser who knew what TORRES means could translate the Italian, particularly given a design with two towers.²⁷⁷

d. Relevance of Foreign Perception

Is perception of the mark by purchasers outside the United States relevant to the view of the ordinary American purchaser? In other words, is the ordinary American purchaser one who would see a generic term from another country as a generic term in the United States?

Courts²⁷⁸ and the TTAB²⁷⁹ have generally found that the perception of a mark *by a resident of a foreign country as used in that country* is not relevant to whether the mark as used in the

²⁷⁶ *Id.*

²⁷⁷ *Id.* For more on comparison between marks in two different foreign languages, see *infra* Part IV.E.

²⁷⁸ *E.g.*, *Carcione v. The Greengrocer, Inc.*, 205 U.S.P.Q. 1075 (E.D. Cal. 1979) (GREENGROCER, while generic in Britain for a seller of fruits and vegetables, was not entitled to protection in the United States; “Since we deal here with American trademark law, and thus American consumers, neither British usage nor the dictionary definition indicating such usage are determinative.”).

²⁷⁹ *In re Migea S.p.A.*, 2018 TTAB LEXIS 466 n.13 (T.T.A.B. 2018) (not precedential) (“[A] foreign person’s perception of a mark used in a foreign country is not probative of the perceptions of consumers in the United States of that same mark used in U.S. commerce in determining whether or not the mark is descriptive of the goods and services upon which it used.”); *In re Consolidated Cigar*, 13 U.S.P.Q.2d 1481 (Regarding evidence of generic use of the mark, “[e]ven if considered, this evidence, since it comprises foreign publications, would be of little moment in determining the instant issue.”); *cf. In re Mucky Duck Mustard Co.*, 6 U.S.P.Q.2d 1467 (T.T.A.B. 1988) (Assuming that a phrase is a “common British slang expression, . . . there is no evidence whatsoever in the record, nor does applicant even assert, that this meaning of the term is commonly known in the United States. It is, of course, the significance of the term to purchasers in the United States which we must consider herein.”).

United States is distinctive. As the Eighth Circuit said, “A number of cases hold that a term may be generic in one country and suggestive in another. . . . We believe these holdings are correct.”²⁸⁰ Commentators typically agree with this position.²⁸¹

Still, this is not a universal view. A 1985 TTAB opinion emphasized that refusing to register terms in the United States that are generic elsewhere is vital to maintaining “the free flow of international trade.”²⁸² An administrative trademark judge at the TTAB concurring in a later opinion agreed. The TTAB had rejected evidence showing that WHIFFS is a generic term *in Great Britain* for a type of cigar, finding it irrelevant to the perception of the term by U.S. purchasers.²⁸³ Judge Sams, concurring in the result, would have found such evidence probative, because “all generic names for a product, in whatever language, belong in the public domain” and “to that often substantial number of U.S. purchasers who understand a given foreign language, a generic or descriptive term in that language is as generic or descriptive as its American language equivalent and, for that reason, ought not to be registered.”²⁸⁴

Along those lines, the Fifth Circuit found that the word “chupa” could be generic for lollipops in the United States “if it has come to signify lollipops in Spanish-speaking countries, like Mexico.”²⁸⁵ The Second Circuit praised a lower court for asking whether Italian consumers understood BELLA DI CERIGNOLA as generic for a type of olive: “the relevant inquiry is . . . the meaning of the term or phrase in its country of origin.”²⁸⁶ And the Second Circuit allowed the admission into evidence of a decision of the Japanese Patent

²⁸⁰ *Anheuser-Busch, Inc. v. Stroh Brewery Co.*, 750 F.2d 631, 642 (8th Cir. 1984) (finding that the district court was correct in rejecting evidence of use of term in Australia when looking at consumer perception in the United States); *see also Deckers Outdoor*, 340 F. Supp. 3d at 715 (“[E]ven assuming [defendant] established that [the mark] was generic in Australia, . . . it has not linked that finding in any way to consumer perceptions in the U.S. and so considering this evidence would not change the result here.”).

²⁸¹ *See* Quentin J. Ullrich, *Corpora in the Courts: Using Textual Data to Gauge Genericness and Trademark Validity*, 108 TMR 989, 1008 n.104 (2018) (“U.S. trademark law is concerned exclusively with U.S. consumers’ usage and understanding of marks. Thus, foreign publications are not probative of genericness in the eyes of U.S. courts.”); Rest, *supra* note 52, at 1240–41 (“The only issue when considering marks for American trademark registration protection should be consumer recognition in the United States.”).

²⁸² *In re Le Sorbet*, 1985 TTAB LEXIS 27.

²⁸³ *In re Consolidated Cigar*, 13 U.S.P.Q.2d 1481.

²⁸⁴ *Id.* (Sams, J., concurring).

²⁸⁵ *Enrique Bernat*, 210 F.3d at 444.

²⁸⁶ *Orto Conserviera Cameranesa di Giacchetti Marino & C. v. Biconserve S.R.L.*, 2000 U.S. App. LEXIS 1849 (2d Cir. 2000) (noting approvingly that the district court had “based its finding on evidence of use of the phrase by members of the trade in Italy, official decisions of Italy’s courts, official listings of the Italian government, Italian publications, and use by the party seeking protection”).

Office (“JPO”) rejecting a trademark registration “to prove the fact assertedly found by the JPO that the word ‘otokoyama’ in Japanese refers to a type or class of sake.”²⁸⁷

Even though the descriptive nature of a mark in a foreign country does not mean it is descriptive in the United States, certainly evidence of descriptive use in the other country could be relevant *if it can be shown* that U.S. consumers would be aware of that meaning.²⁸⁸ In TTAB proceedings, material obtained from a website from outside the United States may be probative “depending on the circumstances, including whether it is likely that U.S. consumers have been exposed to the foreign website and whether the website is in English (or has an optional English language version).”²⁸⁹

G. “Stop and Translate”

The doctrine “should be applied only when it is likely that the ordinary American purchaser would ‘stop and translate [the term] into its English equivalent.’”²⁹⁰

1. When Would Someone “Stop and Translate”?

The checklist in the next section (Part IV) provides more analysis of these situations, but in brief, the USPTO’s default position is that the ordinary American purchaser would stop and translate any mark in a common, modern language into its literal English meaning.²⁹¹ From that presumption, the USPTO determines whether the mark falls into an exception because “many non-English marks . . . will not be translated in context but instead accepted at face value by the ordinary American consumer,

²⁸⁷ *Otokoyama*, 175 F.3d at 273. That opinion failed to distinguish between the meaning of the foreign word in Japan and its meaning in Japanese to a U.S. consumer.

²⁸⁸ *In re Bayer*, 488 F.3d at 969 (information originating on foreign websites that are accessible to the United States public may be relevant to discern U.S. consumer impression of a proposed mark).

²⁸⁹ TBMP § 1208.03 (footnote omitted); *see also* TBMP § 1208.01 (“As for articles from foreign publications, the probative value of such articles is evaluated on a case-by-case basis, with consideration given to the nature of the involved goods or services and the growing availability and use of the Internet as a resource for news.”).

²⁹⁰ *Palm Bay Imps.*, 396 F.3d at 1376–77 (quoting *In re Pan Tex Hotel*, 190 U.S.P.Q. 109).

²⁹¹ *See, e.g., In re Crystal Cruises*, 2018 TTAB LEXIS 472 (applying the doctrine where the literal, direct translation was undisputed and there was “no evidence that the relevant consumer would not stop and translate the mark”); *In re Tokutake Indus.*, 87 U.S.P.Q.2d 1697 (finding “no evidence that the relevant American purchaser who speaks Japanese would not stop and translate the mark”); TMEP § 1207.01(b)(vi)(B) (“[I]f the evidence shows that the English translation is ‘literal and direct,’ with no contradictory evidence of other relevant meanings or shades of meaning, then the doctrine should be applied, barring unusual circumstances.”).

including those familiar with the literal meaning of the mark in the non-English language.”²⁹²

Those exceptions may include situations where the context in which the mark appears suggests that purchasers should not translate it, the English translation is ambiguous, the foreign term is grammatically incorrect, the foreign term has been adopted into the English language, the foreign term is too obscure, and others. Again, these are all treated individually in the next section.

2. Critique and Confusion

There is some logic to courts and the USPTO translating foreign marks if the ordinary consumer would translate them. But there remain several concerns and uncertainties about “stop and translate.”

a. Explanation of Standard Unclear in Case Law

The “stop and translate” standard was created in a decision that provided no explanation for when a consumer might in fact stop and translate. In that case, Palm Bay Imports had filed an intent-to-use application for VEUVE ROYALE for sparkling wine, and Veuve Clicquot Ponsardin opposed the application, asserting likely confusion with several of its marks, including VEUVE CLICQUOT, VEUVE CLICQUOT PONSARDIN, and THE WIDOW, all registered for wines.²⁹³ The TTAB refused registration to VEUVE ROYALE based on confusion with THE WIDOW, holding: “An appreciable number of purchasers in the United States speak and/or understand French, and they will translate applicant’s mark into English as ROYAL WIDOW.”²⁹⁴ Puzzlingly, when the TTAB compared VEUVE ROYALE to VEUVE CLICQUOT and VEUVE CLICQUOT PONSARDIN, it made a contradictory statement: “[A]n appreciable number of purchasers are unlikely to be aware that VEUVE means ‘widow’ and are unlikely to translate the marks into English.”²⁹⁵

On appeal, the Federal Circuit noted the contradiction and took a step back to review the relevant standard. True, it said, under the doctrine of foreign equivalents, “foreign words from common languages are translated into English to determine genericness, descriptiveness, as well as similarity of connotation in order to

²⁹² *In re Spirits Int’l*, 563 F.3d at 1352.

²⁹³ *Veuve Clicquot Ponsardin, Maison Fondée en 1772 v. Palm Bay Imps., Inc.*, 2003 TTAB LEXIS 388 (T.T.A.B. 2003) (not precedential), *rev’d in relevant part*, 396 F.3d 1369 (Fed. Cir. 2005).

²⁹⁴ *Id.*

²⁹⁵ *Id.*

ascertain confusing similarity with English word marks.”²⁹⁶ But the doctrine is just a guideline, the court clarified.²⁹⁷ When it is *unlikely* that an American buyer will translate the foreign mark and will take it as is, the TTAB should not translate the term and the doctrine would not apply.²⁹⁸

The Federal Circuit then chose a side from the contradictory holdings below. It declared it improbable that the average American purchaser would stop and translate VEUVÉ into “widow,” reversing the TTAB’s holding of likely confusion between THE WIDOW and VEUVÉ ROYALE.²⁹⁹ But it failed to explain why the average purchaser would not translate the term. It only echoed one of the TTAB’s contradictory determinations, that the average American purchaser would not be aware that VEUVÉ means “widow,” and ignored its other finding.³⁰⁰ Was the term too obscure? Did the average American purchaser not speak French? Why didn’t the Federal Circuit adopt the other conclusion from the TTAB, that an appreciable number of American purchasers speak French and *would* translate VEUVÉ ROYALE into “royal widow”? We will never know.

A later Federal Circuit opinion interpreted the case: “The ordinary American consumer would not translate VEUVÉ CLICQUOT because its literal translation would be irrelevant to even those ordinary American consumers who speak French.”³⁰¹ This gloss does not help and, in fact, only adds confusion. Perhaps a translation would be irrelevant because the phrase was an arbitrary trademark when compared to the goods. Perhaps it would be irrelevant because consumers don’t really care what this trademark means in French. Or perhaps it would be irrelevant here because this mark is so well known that it had essentially entered the American vocabulary.³⁰² Any of these explanations is possible. Ultimately, the source in case law of the “stop and translate” distinction is unsatisfying and unenlightening.

²⁹⁶ *Palm Bay Imps.*, 396 F.3d at 1377.

²⁹⁷ *Id.*

²⁹⁸ *Id.*

²⁹⁹ *Id.*

³⁰⁰ *Id.*

³⁰¹ *In re Spirits Int’l*, 563 F.3d at 1352.

³⁰² *Palm Bay Imps.*, 396 F.3d at 1376 (affirming TTAB holding that VEUVÉ CLICQUOT was famous); *see also In re Highlights for Children*, 118 U.S.P.Q.2d 1268 (“We recognize that there are situations in which the doctrine of foreign equivalents does not apply, for example, when the literal translation of the foreign term would be irrelevant even to ordinary purchasers familiar with the foreign language, or because the term itself is well-known to ordinary purchasers and has become a part of the English language, or the context in which the foreign term is used requires no translation.”).

***b. “Stop and Translate” Is Not Appropriate
in Validity Analysis***

This article argued earlier that, in validity analysis, the ordinary American purchaser need not be bilingual.³⁰³ Prospective consumers do not need to know what a foreign-language term in a trademark means *in English*. They simply need to understand it in their native language and see that it describes or signifies the goods or services offered for sale. A Spanish speaker, for instance, knows that “queso” is generic for “cheese” even without translating the term into English and, in fact, even without being *able* to translate.³⁰⁴ It should not matter, therefore, that consumers would not “stop and translate” for purposes of distinctiveness so long as they would understand the foreign term to refer to the type of product or service at hand.

c. Do Consumers Really Stop . . . and Then Translate?

“Stop and translate” is an awkward phrase, implying a deliberate two-step process. The consumer takes a second to focus on the mark and then says, “Ohhh, I get it, X means Y,” like solving a crossword puzzle clue. But would a consumer fluent in, say, German and English really stop and translate a German word into English? Or will the bilingual consumer instead know the meaning without translating it? In beginner foreign-language classes, one learns haltingly and must stop and translate word for word into one’s native language. However, when someone is proficient in both a foreign language and English, they may simply understand the meaning of a foreign word without stopping . . . and translating.

Translating one mark before comparing it to another is not limited to the foreign-language context. The TTAB and courts may also “translate” images when determining likelihood of confusion. One of the factors in the Restatement’s likelihood of confusion analysis directs courts to consider “the verbal translation of any pictures, illustrations, or designs contained in the designations,”³⁰⁵ and the Sixth and Tenth Circuits have at times listed that consideration as a factor in their similarity analysis.³⁰⁶ In 1986, the Southern District of New York found the word mark PEGASUS

³⁰³ See *supra* Part III.F.2.c.

³⁰⁴ See Brauneis & Moerland, *supra* note 267, at 22 (“Distinctiveness inquiries need not involve translation at all, and certainly should not involve a ‘stop and translate’ test, which is inappropriate and can lead to mistaken conclusions.”).

³⁰⁵ Restatement (Third) of Unfair Competition § 21.

³⁰⁶ See, e.g., *Progressive Distrib. Servs. v. UPS, Inc.*, 856 F.3d 416, 432 (6th Cir. 2015); *Universal Money Ctrs., Inc. v. AT&T*, 22 F.3d 1527, 1530 (10th Cir. 1994).

confusingly similar to the following design mark, both used for petroleum:³⁰⁷



Do consumers *stop and translate* images? Or do they simply understand what the image represents and, perhaps, remember that impression later when they see the *word* used as a trademark and experience source confusion?

Images can undoubtedly cause confusion with words—the PEGASUS/Pegasus example is compelling—and a foreign speaker could certainly be confused between an English term and its foreign-language equivalent. But those could happen without this halting two-step process. True, the typical shopper may stop . . . and translate, but it is unfortunate that an important underpinning of the doctrine of foreign equivalents relies on an unproven assumption about human psychology.

***d. Foreign Terms May Simply Have
Different Commercial Impressions from
English Terms, Regardless of Translation***

Consumers in the United States can typically tell the difference between a word in English and a word in a foreign language.

³⁰⁷ Mobil Oil Corp. v. Pegasus Petro. Corp., 229 U.S.P.Q. 890 (S.D.N.Y. 1986) (“[V]erbal translations of trademark symbols, designs or pictures may be considered as a factor in assessing the likelihood of confusion.”), *aff’d*, 818 F.2d 254 (2d Cir. 1987) (“While we agree that words and their pictorial representations should not be equated as a matter of law, a district court may make such a determination as a factual matter.”); *see also*, e.g., Beer Nuts, Inc., v. King Nut Co., 477 F.2d 326, 329 (6th Cir. 1973) (“It is well settled that words and their pictorial representation are treated the same in determining the likelihood of confusion between two marks.”) (image of overflowing beer stein caused confusion with BEER NUTS); Shunk Mfg. Co. v. Tarrant Mfg. Co., 318 F.2d 328, 331 (C.C.P.A. 1963) (“It is well settled that words and the symbols identified thereby will be given the same significance in determining the likelihood of confusion between two marks.”) (image of Scotsman confusingly similar to SCOTCHMAN word mark for same goods). *See Gilson on Trademarks*, *supra* note 8, § 5.03 for more on sound, appearance, and meaning similarity.

GUEPARDO and CHEETAH, for example, are plainly different words.³⁰⁸ As one commentator states:

Even shoppers who know the translation of the term will detect something out of the ordinary when they encounter a foreign term on a good or service. Shoppers are accustomed to product names and descriptions in the official language of the market. A foreign term will therefore stand out and may be recognized by shoppers as a seller's attempt to identify itself to the market.³⁰⁹

Use of a foreign term could be an attempt to convey fanciness or exoticness, giving an additional gloss to the term besides simply its literal translation.³¹⁰ In an older foreign-language marks case, the TTAB found it important that “buyers of perfumes and cosmetics do not necessarily—and probably do not ordinarily—translate trademarks used on such products as are involved here, since there seems to be a certain ‘snob appeal’ to the foreign words.”³¹¹

IV. CHECKLIST OF EXCEPTIONS TO APPLYING THE DOCTRINE

The Federal Circuit has declared a “threshold limitation” on applying the doctrine of foreign equivalents: it “applies only in those situations where the ordinary American consumer would stop and translate the mark into English.”³¹² And many non-English marks, when seen in context, “will not be translated . . . but instead accepted at face value by the ordinary American consumer, including those familiar with the literal meaning of the mark in the non-English language.”³¹³

This section provides a checklist of those exceptions, occasions when the TTAB and courts have found that consumers will not translate foreign-language marks. Where consumers will not translate the marks, the TTAB and the courts will not either, and

³⁰⁸ *In re Compass Automotive*, 2019 TTAB LEXIS 143. *See supra* Part II.C.2.

³⁰⁹ Cross, *supra* note 216, at 139.

³¹⁰ *Id.* at 139–40 (“Foreign or foreign-sounding terms . . . may also impart an abstract, vague sense of mystery or quality to a product. . . . Regardless of whether shoppers know the translation, a seller’s use of the Swedish term CHOKLAD will create an impression that the English equivalent CHOCOLATE will not. . . . At the very least courts should consider evidence of how purchasers actually perceive a foreign trade emblem.”).

³¹¹ *In re Societe des Parfums Schiaparelli, Societe Anonyme*, 122 U.S.P.Q. 349 (T.T.A.B. 1959) (finding SI not the equivalent of MAIS OUI in French or BUT YES in English).

³¹² *In re Spirits Int’l*, 563 F.3d at 1351; *see In re Weiss Watch Co.*, 123 U.S.P.Q.2d 1200 (T.T.A.B. 2017) (“The Board has found that consumers would stop and translate a term when it is from a major, modern language, spelled in the standard way in the foreign language, and is the only translation of the English word to which it translates, so that there is no question that its translated meaning would be recognized and not considered obscure.”).

³¹³ *In re Spirits Int’l*, 563 F.3d at 1352.

the doctrine of foreign equivalents does not apply. The mark at issue will be either judged on its distinctiveness as is or compared to the opposing party's mark as is.

***A. Marketplace Context Suggests
Purchasers Would Not Translate Foreign Term***

If the context in which the product or service is offered to consumers suggests that the foreign term should be seen *as a foreign term* and not as its English equivalent, customers are likely to take the term as is and not translate it. Thus, the doctrine should not apply in such situations. This context could be cues received from the packaging, say, or the environment where the good or service is purchased.³¹⁴

The TTAB has held, for example, that the décor of a restaurant that evokes another culture will prevent consumers from translating a mark that is in that culture's language. A 1975 TTAB decision, much cited in later cases, involves the co-existence of AUNT MARY canned fruits and vegetables and TIA MARIA Mexican restaurant.³¹⁵ The opinion proceeds from the fact that "Tia Maria" in Spanish translates to "Aunt Mary" in English and next opines that fruits and vegetables "marketed in cans are generally of a nondescript character and hardly of the caliber of products that one would . . . associate with a particular restaurant much less with a Mexican restaurant because of prior gourmet or like delightful experiences."³¹⁶ (It is a solid guiding principle, that the source of "nondescript" canned food is unlikely to be confused with the source of "delightful" food from a Mexican restaurant.)

The TTAB moved on to a comparison of TIA MARIA and AUNT MARY. Acknowledging prior decisions holding that foreign terms and their English equivalents are to be treated as the same, TTAB declared (in a passage worth quoting in full):

[N]evertheless there are foreign expressions that even those familiar with the language will not translate, accepting the term as it is, and situations arise in the marketplace which make it unfeasible or even unlikely that purchasers will translate the brand names or labels appearing on canned foods and other like products. . . . [I]t is unlikely to expect that a person encountering "AUNT MARY'S" canned fruits and vegetables in a supermarket or other establishment where goods of this type are customarily sold would translate

³¹⁴ *In re Jos. Schlitz Brewing Co.*, 223 U.S.P.Q. 45 ("[E]xceptions to this general rule . . . have been made in a small number of cases where . . . it was unfeasible or unlikely that purchasers would translate the foreign expression as it was encountered on goods in a marketing environment.").

³¹⁵ *In re Tia Maria, Inc.*, 188 U.S.P.Q. 524 (T.T.A.B. 1975).

³¹⁶ *Id.*

“AUNT MARY’S” into “TIA MARIA”, and then go one step further and associate these food products with applicant’s restaurant. Likewise, going the other route, it is difficult to perceive that a person who had purchased “AUNT MARY’S” canned fruits and vegetables on the shelves of a supermarket would, upon dining at the “TIA MARIA” restaurant in Mexican decor and surrounded by a menu of Mexican delicacies, translate “TIA MARIA” into “AUNT MARY” and then mistakenly assume that the “TIA MARIA” restaurant and “AUNT MARY’S” canned fruits and vegetables originate from or are sponsored by the same entity. This stretches a person’s credulity much too far.³¹⁷

And the TTAB reversed the refusal to register TIA MARIA,³¹⁸ then presumably all went out for enchiladas.

A court likewise found that an American consumer would not translate a mark to English from the Lebanese dialect of Arabic due to “association of the word with its foreign language through décor.”³¹⁹ It found the doctrine of foreign equivalents inapplicable where the mark TAZA (meaning “fresh”) appeared “in the context of a restaurant that serves Lebanese food, plays Lebanese music, and is decorated with Lebanese décor.”³²⁰ Because of the context cues, the reasoning went, TAZA would remain in its original language in consumers’ minds.³²¹

On the other hand, if products bearing foreign-language trademarks are targeted toward consumers who speak that language, those consumers may be more likely to translate the terms. In one case, the TTAB found that consumers would translate BUENOS DIAS where specimens used the Spanish word for the product and included descriptions of the product in Spanish.³²²

If foreign-language terms appear next to their English equivalents, consumers would also be likely to translate them. Where an applicant declared it was targeting Hispanic customers in the United States and used Spanish words *alongside their English translations* on its packaging, the TTAB found that purchasers

³¹⁷ *Id.*

³¹⁸ *Id.*

³¹⁹ *Taza Sys.*, 2013 U.S. Dist. LEXIS 130974 (“Where the ordinary American purchaser would not be prompted to translate a foreign word because of the context in which it is used, the doctrine of foreign equivalents does not apply.”).

³²⁰ *Id.*

³²¹ *Id.*

³²² *In re American Safety Razor*, 2 U.S.P.Q.2d 1459. *But see* *Ricardo Media Inc. v. Inventive Software, LLC*, 2019 TTAB LEXIS 283 (T.T.A.B. 2019) (where magazine’s content was in English, there was “no reason to think that American consumers, even Spanish speakers, would translate” the name of the magazine, RICHARD, to RICARDO).

would translate the Spanish-language mark into English.³²³ Another applicant made the gutsy argument that the juxtaposition of its foreign-language mark and the English translation would mean “that an ordinary purchaser will have no need to translate a term that Applicant has already translated for the purchaser, and hence the doctrine of foreign equivalents is inapplicable.”³²⁴ The TTAB rejected this argument, stating that, “when foreign words appear next to the English language equivalents, an ordinary purchaser will still recognize the terms as equivalents because of the provided translation.”³²⁵

B. Relevant English Translation Is Imperfect or Ambiguous

If the English translation of the foreign mark has some other meaning or nuance so that it is not an exact or literal translation, the doctrine does not apply.³²⁶ The USPTO will not apply either the validity analysis or the confusing similarity analysis if the translation is ambiguous, uncertain, or uncommon. The translation must be “literal and direct” or “exact.” In other words, it must be a genuine *equivalent*. A nuance, alternative connotation, or double entendre can prevent the doctrine from being applied.

One court faced an interesting situation in which the mark, TAZA, meant both “fresh” in Arabic and “cup” in Spanish.³²⁷ It found that, because Spanish is the most commonly spoken second language in the United States, consumers would more likely translate the term from Spanish than from Arabic.³²⁸ In the end, though, neither translation was descriptive of plaintiff’s restaurant and bar services.³²⁹

C. Foreign Term Is Misspelled or Not Grammatically Correct

The USPTO may also take into account the fact that a foreign mark is not in “the standard orthography” for the foreign translation. In one case, the TTAB found that the doctrine did not

³²³ *In re Aquamar*, 115 U.S.P.Q.2d 1122; see also *In re Talyoni*, 2019 TTAB LEXIS 145 (The applicant had emphasized the English translation of its mark in its ads, and the TTAB found easily that the foreign-language mark would be translated; “Applicant’s own actions thus appear to associate its EL PATRÓN mark with ‘the boss’ as opposed to other potential definitions of the term.”).

³²⁴ *In re Highlights for Children*, 118 U.S.P.Q.2d 1268.

³²⁵ *Id.*

³²⁶ See *supra* Part III.D.1.

³²⁷ *Taza Sys.*, 2013 U.S. Dist. LEXIS 130974.

³²⁸ *Id.*

³²⁹ *Id.*

apply where the word WEISS in the mark WEISS WATCH COMPANY was not the standard spelling for the German translation of the term “white,” which is “Weiß.”³³⁰ The TTAB did refuse registration based on surname significance, finding that German speakers would see it as a surname and would not translate it.³³¹ But where the mark is a soundalike for an English term, it may be translated and found generic or descriptive even if it is not spelled correctly.³³²

Application of the doctrine may assume that foreign-language speakers in the United States are truly fluent and not just dabblers in that language. Those with no more than high school French might well translate PARFAIT VISAGE into “perfect face,” but the TTAB found that it was “not an exact translation.”³³³ “Perfect face” should properly be “le visage parfait,” and the “grammatically incorrect translation” signaled to the TTAB that consumers would not stop and translate the French mark.³³⁴ Thus, because the marks’ sound, appearance, and connotations were not similar, consumers were unlikely to confuse PARFAIT VISAGE and PERFECT FACE.³³⁵

In general, descriptive terms that are misspelled remain descriptive.³³⁶ And despite attempts by owners of foreign-language trademarks to argue otherwise, the misspelled foreign-language equivalent of a descriptive English term is still considered descriptive.³³⁷

D. Foreign Mark Is in More Than One Language

What happens when the mark being analyzed is itself in more than one language? The TTAB and courts alike generally do not apply the doctrine of foreign equivalents and instead take the mark as is.³³⁸

³³⁰ *In re Weiss Watch*, 123 U.S.P.Q.2d 1200; see also *In re Jacqueline Cochran*, 196 U.S.P.Q. 715 (T.T.A.B. 1977) (AIROMATIQUE, misspelling of French word *aromatique*, not capable of distinguishing source of toilet water).

³³¹ *In re Weiss Watch*, 123 U.S.P.Q.2d 1200.

³³² *In re Coney Island Bredzel*, 199 U.S.P.Q. 45.

³³³ *In re Sheeb*, 2015 TTAB LEXIS 266 (T.T.A.B. 2015).

³³⁴ *Id.*

³³⁵ *Id.*

³³⁶ See Gilson on Trademarks, *supra* note 8, § 2.02[1][b].

³³⁷ See, e.g., *In re Coney Island Bredzel*, 199 U.S.P.Q. 45.

³³⁸ See *Chatam Int’l, Inc. v. UDV N. Am., Inc.*, 2000 U.S. App. LEXIS 2087 (Fed. Cir. 2000) (“Because both marks [GOLDSCHLÄGER and GOLDSTRASSEN] are hybrid combinations of English and German terms and many consumers may be unfamiliar with their English translations, the board did not err in analyzing the composite marks for confusing similarity without translating their German portions into English.”).

Consumers, the TTAB reasons, would not translate just part of a unitary mark.³³⁹ Thus, the TTAB found that consumers would not translate the French term in the mark MONFRÈRE FASHION for various items of apparel.³⁴⁰ Because the term “combines a French compound word with an English word, translation would in many ways be illogical.”³⁴¹ Similarly, the TTAB found that consumers would not translate CLAIR as “clear” in the mark TROPIC CLAIR PLUS because “CLAIR is positioned between two English language terms, and it has been held that when marks consist of both foreign and English words, the mark may not be translated.”³⁴²

One concurring administrative trademark judge on a TTAB panel would have declined to apply the doctrine altogether to a mark mixing English and French: THE SAISON D’HERETIQUE for beer.³⁴³ “A mark that comprises a foreign word, or words, combined with English words, is not, in my estimation, a ‘foreign mark,’” said the judge, “and the concept of ‘stop and translate’ embodied in the doctrine does not apply.”³⁴⁴ The majority in that case had briefly considered the translation of the French terms, deciding consumers would likely not translate them but ultimately still finding confusion likely between THE SAISON D’HEREITIQUE and HERETIC BREWING COMPANY, also for beer.³⁴⁵

Where the USPTO finds that “the commercial impression created by the combination differs from that which would be created by two English words,” marks that combine a term from a foreign language with an English term may be registrable.³⁴⁶ For example, the following mark was found sufficiently incongruous because of the juxtaposition of the French word GLACE and the English word

³³⁹ *In re Monfrere*, 2020 TTAB LEXIS 160 (T.T.A.B. 2020) (not precedential) (“[B]ecause Applicant’s mark is in two different languages, it is an incongruous, unitary term, such that attempting to translate it into a single language would not make sense.”); *In re JS ADL, LLC*, 2018 TTAB LEXIS 103 (T.T.A.B. 2018) (not precedential) (noting consumers unlikely to translate Spanish word in ARTESANO NEW YORK CITY), *aff’d*, 777 Fed. Appx. 991 (Fed. Cir. 2019); *In re Universal Package Corp.*, 222 U.S.P.Q. 344, 347 (T.T.A.B. 1984) (“Here only one of the two components is foreign. Translation of an entire compound word mark is more likely to take place in the marketplace than is the translation of only part of the mark.”).

³⁴⁰ *In re Monfrere*, 2020 TTAB LEXIS 160.

³⁴¹ *Id.*

³⁴² *Topiclear, Inc. v. K & N Distributors*, 2019 TTAB LEXIS 160 (T.T.A.B. 2019) (not precedential); *see also* *French Transit, Ltd. v. Modern Coupon Sys.*, 818 F. Supp. 635, 636–37 (S.D.N.Y. 1993) (holding that doctrine does not apply to mark that combines English and another language; finding that consumers would not translate “le” and “naturel” from LE CRYSTAL NATUREL for deodorant).

³⁴³ *In re C G Asset Mgmt. Pty. Ltd.*, 2017 TTAB LEXIS 478 (T.T.A.B. 2017) (Wolfson, J., concurring) (not precedential).

³⁴⁴ *Id.*

³⁴⁵ *Id.* (majority opinion).

³⁴⁶ TMEP § 1209.03(g).

LITE to be registered for ice cream, sherbet, frozen yogurt, and nondairy frozen desserts:³⁴⁷

Glacé Lite

Some English/other language marks may not be registrable. The TTAB found the following mark for bakery goods and pastry shops to be a merely descriptive compound term composed of BON and CHOU:³⁴⁸

BONCHOU

The combination of “good” in French and “chou,” a term used generically in the United States for puff pastry, did not create a unique, unitary mark or a mark with an incongruous meaning compared to the goods and services at issue.³⁴⁹

There is a body of case law focused on articles (“the,” “an,” etc.) in a foreign language and nouns in English. In 1984, the TTAB declared: “Previous decisions by this Board concerning the registrability of various terms preceded by foreign translations of the word ‘THE’ are difficult to reconcile.”³⁵⁰ After that decision, the TTAB has generally (though not universally) held that consumers would not translate marks that combine a foreign-language article and an English noun.³⁵¹ Even combined with a generic English noun, the combination may be registrable, with the generic term disclaimed by the applicant.³⁵²

For example, the TTAB found that the doctrine of foreign equivalents did not apply to an assessment of the validity of LA YOGURT for yogurt.³⁵³ That case involved a rare augmented panel of eight members of the TTAB overruling a prior decision refusing

³⁴⁷ *In re Sweet Victory, Inc.*, 228 U.S.P.Q. 959 (T.T.A.B. 1986).

³⁴⁸ *In re Levantine Concepts LLC*, 2016 TTAB LEXIS 505 (T.T.A.B. 2016) (not precedential).

³⁴⁹ *Id.*

³⁵⁰ *In re Universal Package Corp.*, 222 U.S.P.Q.2d 344.

³⁵¹ See Eric E. Bowman, Comment, *Trademark Distinctiveness in a Multilingual Context: Harmonization of the Treatment of Marks in the European Union and the United States*, 4 San Diego Int’l L.J. 513, 526 (2003) (“An appropriate limitation would exclude marks that consist of words in one language with articles or numbers from another language.”).

³⁵² Note that adding the word “the” to an English generic term does not make a registrable mark. *E.g.*, *In re Weather Channel, Inc.*, 229 U.S.P.Q. 854 (T.T.A.B. 1985) (use of “the” does not add distinctiveness to THE WEATHER CHANNEL); *In re The Computer Store, Inc.*, 211 U.S.P.Q. 72 (T.T.A.B. 1981) (adding “the” does not add distinctiveness to THE COMPUTER STORE).

³⁵³ *In re Johanna Farms*, 8 U.S.P.Q.2d 1408.

registration.³⁵⁴ The prior opinion had found that the “Frenchifying” addition of “LA” did not alter the commercial impression of the generic term.³⁵⁵ It had held that the French-speaking purchasing public would perceive LA YOGURT as a “variation or corruption” of the French word for yogurt and thus it was unregistrable under the doctrine of foreign equivalents.³⁵⁶ The later decision found no support for that conclusion, holding that the use of the French article changed the commercial impression of the mark as a whole.³⁵⁷

Nor did the doctrine apply in the case of LE CASE, a mark made up of a French article and an English term that was generic for the goods—jewelry cases.³⁵⁸ The TTAB found that the commercial impression of that mark was not simply THE CASE and the addition of the French word sufficiently changed the commercial impression of the mark: “The French article imparts to the mark a French flavor, a continental connotation which is presumably desirable from the perspective of manufacturers of jewelry boxes. Potential purchasers of goods such as these might be expected to prefer jewelry boxes of European design over ordinary boxes.”³⁵⁹

E. Foreign Marks Being Compared to Each Other Are in Different Languages

The TTAB generally does not apply the doctrine where both marks are foreign-language marks but are each in a different

³⁵⁴ *Id.*

³⁵⁵ *In re Johanna Farms, Inc.*, 222 U.S.P.Q. 607 (T.T.A.B. 1984) (finding LA YOGURT generic for yogurt), *reconsideration denied*, 223 U.S.P.Q. 459 (T.T.A.B. 1984), *overruled*, 8 U.S.P.Q.2d 1408 (T.T.A.B. 1988) (finding LA YOGURT not generic for yogurt).

³⁵⁶ *Id.*; *see also In re LesConcierges, Inc.*, 2000 TTAB LEXIS 631 (T.T.A.B. 2000) (not precedential) (refusing registration for LESCONCIERGES for party planning services as “highly” descriptive, reasoning in part that “concierges” is a French term and consumers would translate the mark because it was entirely in a foreign language); *In re Le Sorbet*, 1985 TTAB LEXIS 27 (where “sorbet” is a French word, the entire term LE SORBET is French and does not have the incongruity of a foreign article plus an English noun).

³⁵⁷ *In re Johanna Farms*, 8 U.S.P.Q.2d 1408.

³⁵⁸ *In re Universal Package Corp.*, 222 U.S.P.Q.2d 344, *overruling In re Owens-Illinois, Inc.*, 217 U.S.P.Q. 1038 (T.T.A.B. 1983) (refusing registration of LE JAR for glass canisters).

³⁵⁹ *Id.*; *see also In re Monfrere*, 2020 TTAB LEXIS 160 (“[T]he mark’s commercial impression is, essentially, that Applicant offers French ‘fashion,’ or fashion with ‘French’ style or features. Indeed, because Applicant’s mark combines an apparently arbitrary French term with a merely descriptive or generic English word, and is used in a primarily English-speaking country in connection with goods described by its English word, the entire mark MONFRÈRE FASHION conveys the types of goods Applicant offers, and signals that the goods have some connection to France or another French-speaking location, or are French-style.”). For more on the argument that foreign terms have different commercial impressions than their English equivalents, *see supra* Part III.G.2.d.

language.³⁶⁰ In one case, for instance, it declared: “[T]his Board does not think it proper to take the French expression ‘bel air’ and the Italian expression ‘bel aria’ and then convert both into English and compare the English translations to determine whether there is similarity as to connotation, especially in this case.”³⁶¹ Both marks were used in connection with food items, though the goods were otherwise dissimilar, and the TTAB found them not likely to be confused.³⁶² In another case, the TTAB noted: “[T]he universe of potential customers in the United States who are sufficiently fluent in three languages, and thus would be able to translate two different foreign-language terms or expressions into their corresponding English equivalents, is undoubtedly very small.”³⁶³

F. Foreign Marks Being Compared to Each Other Are in the Same Foreign Language

In confusing similarity analysis, the doctrine of foreign equivalents may apply where both marks are in the same foreign language. Then again, it may not. This is an instance where treating the doctrine as a guideline and not a rule allows unpredictability to creep in.³⁶⁴

When the TTAB translated the common French phrases BIEN JOLIE and TRES JOLIE, finding confusion unlikely, it opined that “[i]t seems to us that the fact that both marks may be comprised of foreign words should not mean that we can disregard their meanings.”³⁶⁵ But in another case, the TTAB declined to translate the Spanish words PALOMA and PALOMITA, stating: “We do not

³⁶⁰ *In re COPAN ITALIA S.P.A.*, 2018 TTAB LEXIS 54 n.5 (T.T.A.B. 2018) (not precedential) (“[I]n general, the Board does not apply the doctrine of foreign equivalents in cases where both marks are non-English words from two different languages.”); *Brown Shoe Co. v. Robbins*, 90 U.S.P.Q.2d 1752 (T.T.A.B. 2009) (same); *see also In re Alison Raffaele Cosmetics*, 2013 TTAB LEXIS 446 (“[T]he Board has been reticent to apply the doctrine of foreign equivalents to compare a mark in one foreign language to a mark in different one, although this is not a hard-and-fast rule either.”).

³⁶¹ *Safeway Stores Inc. v. Bel Canto Fancy Foods Ltd.*, 5 U.S.P.Q.2d 1980 (T.T.A.B. 1987).

³⁶² *Id.*

³⁶³ *In re Fonovisa*, 1998 TTAB LEXIS 138; *see also* TMEP § 1207.01(b)(vi)(A) (“One reason for not applying the doctrine where the marks are in different foreign languages is that it is less likely that the ordinary American purchaser would be fluent in two or more foreign languages.”).

³⁶⁴ *Rest, supra* note 52, at 1226–27 (“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. . . . 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.”).

³⁶⁵ *In re Lar Mor Int’l*, 221 U.S.P.Q. 180; *see* TMEP § 1207.01(b)(vi)(A).

think the circumstances present in this case warrant application of the doctrine.”³⁶⁶

In a somewhat similar case, the TTAB declined to apply the doctrine where there were two French marks at issue, DUBOIS (applicant) and CLOS DU BOIS (opposer), the first sounding much like a surname.³⁶⁷ “Arguably,” found the TTAB, “the doctrine would apply here only if Opposer’s mark were treated as a French language mark while Applicant’s were treated as an English language mark.”³⁶⁸

G. Foreign Term Has Become an English Word or Is Otherwise Known to English Speakers

Many terms that originate in a non-English language have clearly become generic terms in English, such as “hors d’oeuvre,” “piñata,” and “dim sum.” Consumers looking, say, at the term “hors d’oeuvre” on a box of frozen pot stickers or mini quiches would not think, “Oh, that word means ‘appetizer’ in English.” They understand the meaning of the term without translation.

The doctrine, then, does not apply where the foreign term itself has a meaning to English speakers. The Restatement (Third) of Unfair Competition gives the example of BLANC for white wine, not a word in English but one that is certainly understood by English speakers in the context of wine.³⁶⁹ The TTAB, for example, found the Hindi word MALAI generic for “cream” without applying the doctrine of foreign equivalents.³⁷⁰ The term, found the TTAB, had taken on an independent meaning in English to American speakers.³⁷¹ Thus, the relevant purchaser did not even have to translate the mark upon seeing it to know it was a key element of the goods.³⁷² Similarly, the Federal Circuit found the Spanish and Portuguese term “churrasco” to have taken on an independent meaning in English: barbeque or grilled meat.³⁷³ Thus, the following

³⁶⁶ *Brown Shoe*, 90 U.S.P.Q.2d 1752.

³⁶⁷ *Constellation Brands U.S. Operations, Inc. v. LeVecke Corp.*, 2018 TTAB LEXIS 489 (T.T.A.B. 2018) (not precedential).

³⁶⁸ *Id.*

³⁶⁹ Restatement (Third) of Unfair Competition § 14.

³⁷⁰ *In re Twenty-Two Desserts*, 2019 U.S.P.Q.2d 292782.

³⁷¹ *Id.*

³⁷² *Id.* (stating that “the foreign word itself, not its English translation, has an understood meaning in the English language among the relevant consumers as referring to the applied-for goods”); *see also In re Buchanan*, 2018 TTAB LEXIS 179 (T.T.A.B. 2018) (not precedential) (finding that “kopi cham” had “entered the English language and would be understood by buyers as naming a type of coffee beverage popular in Malaysia and nearby Asian countries” and declining to apply the doctrine of foreign equivalents because an American purchaser would not translate the mark but would “take it as is”).

³⁷³ *In re Cordua Rests., Inc.*, 823 F.3d 594, 602–03 (Fed. Cir. 2016).

was generic for restaurants that serve grilled meat and thus unregistrable for restaurant services.³⁷⁴

Churrascos

The court explicitly did not rely on the doctrine of foreign equivalents because it looked to dictionary evidence of the meaning of the term *in English*.³⁷⁵ In addition, the following mark was generic for undergarments because “lingerie” has become an English term, despite the signal of the French article “la”.³⁷⁶

La Lingerie

The Federal Circuit has declared that the doctrine of foreign equivalents does not apply “when the literal translation of the foreign term would be irrelevant even to ordinary purchasers familiar with the foreign language.”³⁷⁷ This idea of when a translation would be “irrelevant” makes sense in situations where the foreign phrase is used by English speakers and has a meaning different from the literal translation. For example, the term CORDON BLEU, while not exactly an English language term, has been adopted by English speakers. The Federal Circuit’s predecessor court held that even those who speak French would not translate that phrase into its English equivalent, BLUE RIBBON.³⁷⁸ Still, in that case, as one commentator points out, “the court did not explain why an American purchaser fluent in a foreign language would fail to translate a foreign mark even if it has a second non-literal meaning in English. For example, many foreign-

³⁷⁴ *Id.*

³⁷⁵ *Id.*

³⁷⁶ *In re Bonni Keller Collections, Ltd.*, 6 U.S.P.Q.2d 1224 (T.T.A.B. 1987). But see *supra* Part IV.D for more on applying the doctrine to generic English terms preceded by articles in a foreign language.

³⁷⁷ *In re Spirits Int’l*, 563 F.3d at 1352. See *supra* Part III.G.2.a for a critique of this statement.

³⁷⁸ *Le Continental Nut Co. v. Le Cordon Bleu S.A.R.L.*, 494 F.2d 1395 (C.C.P.A. 1974); see also TMEP § 1207.01(b)(vi)(B) (“Typically, the doctrine will not be applied where the foreign wording has developed an alternate meaning in the relevant marketplace that is different from the translated meaning in English, and the evidence shows that the alternate meaning would be understood by the relevant purchasing public.”).

language speakers who are not native English speakers may be unaware of English idioms and may, for this reason, translate foreign marks literally.”³⁷⁹

In another case, the mark was an abbreviation of a foreign phrase, and the TTAB found that consumers would simply see the abbreviation as a generic term without translating it.³⁸⁰ The mark AOP was held to be deceptively misdescriptive for wines where applicant’s wines were not certified under the European regulatory system that would earn it the ability to use that term on its labels.³⁸¹ American consumers would be aware of this certification system without knowing it was an acronym for “appellation d’origine protegee.”³⁸²

Where a mark is a misspelling of a word that originated in a foreign language but is otherwise known to English speakers, American consumers may still be unlikely to translate. In reviewing an application for the following mark for apparel, various foods, and hotel services, the TTAB found the doctrine of foreign equivalents inapplicable because American consumers recognize “cappuccino” as an English word.³⁸³



Though the TTAB found that American consumers would not stop and translate CA’PUCCINO, the applicant rather brazenly argued that the designation “directly and literally translates to ‘House of Puccino.’”³⁸⁴ The TTAB rejected applicant’s evidence that CA’ is an Italian slang term that is an abbreviation of CASA, meaning “house” in English.³⁸⁵ It found that CA’ does not directly translate to “house,” which was “problematic” for the applicant “because the doctrine of foreign equivalents is properly applied to cases where the evidence shows that the relevant English translation is literal and direct, and no contradictory evidence of shades of meaning or other relevant meanings exists.”³⁸⁶

³⁷⁹ Krimnus, *supra* note 118, at 173.

³⁸⁰ *In re AOP LLC*, 107 U.S.P.Q.2d 1644 (T.T.A.B. 2013).

³⁸¹ *Id.*

³⁸² *Id.*

³⁸³ *In re Migeca*, 2018 TTAB LEXIS 466. In the mark, CA’PUCCINO appears in brown.

³⁸⁴ *Id.*

³⁸⁵ *Id.*

³⁸⁶ *Id.* (“Applicant is effectively requiring U.S. consumers to study the designation CA’ PUCCINO to determine that the mark is not ‘cappuccino,’ and instead pause and translate the term, including translating the Italian slang term CA’ to the word ‘casa,’

Arguably, where the foreign trademark is very well known in the United States, it seems more likely that consumers would *not* stop and translate it but would instead see it as its own source identifier, much like an English word with which they are already familiar. The TTAB may have reached the wrong conclusion when it found that French-speaking consumers would translate LE CREUSET, a very well-known cookware brand, as CRUCIBLE.³⁸⁷

Finally, a foreign trademark could become a generic term in English “regardless of whether it was a generic term in the mother tongue The language of the market can adopt fanciful and foreign terms as product names with equal ease.”³⁸⁸

H. Foreign Term Is a Personal Name or Resembles One

The TTAB holds that the doctrine of foreign equivalents should “generally” not apply to first names “that are widely recognizable to American consumers,” unless some evidence suggests consumers would translate the names given the context.³⁸⁹ It refused to apply the doctrine to the mark RICARDO for magazines, which it assumed consumers would not translate into part of the opposer’s mark, RICHARD MAGAZINE.³⁹⁰ The applicant did not dispute that RICARDO was a Spanish name that is the equivalent of the English name “Richard.”³⁹¹ But the TTAB found it unlikely that those using personal name trademarks would switch between the foreign-language version and the English language version; doing so would point consumers to two different sources and make it difficult for either mark to gain recognizability.³⁹² In addition, consumers would not stop and translate a “common personal name” but would “instead take each name as it is, in its own language, as identifying the person named, whether real or fictional, known or anonymous.”³⁹³ The TTAB concluded by saying: “The principle that there are ‘foreign expressions that even those familiar with the

and then translating ‘casa’ to the English term ‘house.’ It is unlikely that consumers of Applicant’s goods and services will engage in these mental gymnastics.”).

³⁸⁷ *In re A.F. Djurberg AB*, 2019 TTAB LEXIS 421 (T.T.A.B. 2019) (not precedential) (finding confusion likely between LE CREUSET kitchen goods and CRUCIBLE COOKWARE).

³⁸⁸ Cross, *supra* note 216, at 138 n.130.

³⁸⁹ *Ricardo Media*, 2019 TTAB LEXIS 283.

³⁹⁰ *Id.*

³⁹¹ *Id.*

³⁹² *Id.*

³⁹³ *Id.* (“There is . . . no evidence that owners of any personal name trademarks use translations of their personal names, or that consumers translate personal name trademarks.”).

language will not translate, accepting the term as it is' . . . applies with equal if not greater force to personal names."³⁹⁴

At the motion to dismiss stage, a district court in Ohio was quite skeptical of the argument that the doctrine of foreign equivalents required translation of a personal name. Where the plaintiff's trademark was its founder's name, HABEEBA, "then there exists the legal issue of whether the doctrine of foreign equivalents would even apply."³⁹⁵ The court went on to note that a "well-established framework for analyzing the protectability of trademarks based on personal names is already in place."³⁹⁶

I. Foreign Term and English Term Have Distinct Commercial Impressions

Even if the two marks are close in translation and used in connection with similar goods or services, their presentation to consumers may simply be too different to find that confusion is likely. For example, the TTAB concluded that the commercial impression of STELLA ROSSA PIZZA BAR, where "Stella Rossa" means "red star" in Italian, was too dissimilar to the following mark, despite overlapping services:³⁹⁷



Similarly, in the context of validity analysis, a mark may translate literally into a descriptive term but may be presented in a stylized version that creates a distinctive commercial impression, saving it from being merely descriptive.³⁹⁸

J. Foreign Term Is in a Dead or "Highly Obscure" Language

Black-letter law holds that, if the foreign term is in a dead or obscure language, the doctrine generally does not apply and the

³⁹⁴ *Id.*

³⁹⁵ *Habeeba's Dance of the Arts, Ltd. v. Knoblauch*, 430 F. Supp. 2d 709, 716 (S.D. Ohio 2006).

³⁹⁶ *Id.*

³⁹⁷ *In re Lettuce Entertain You Enters.*, 2013 TTAB LEXIS 254.

³⁹⁸ See *In re Cordua Rests.*, 823 F.3d at 606. For more, see *supra* Part II.B.2.

term should not be translated.³⁹⁹ Most descriptions of the doctrine of foreign equivalents declare that the term should be in a “common, modern language.”⁴⁰⁰ This position makes sense: if no one in the United States speaks that language, no one will translate the mark and be confused and no mark owner will be stymied from using a generic term for its goods or services.

An attempt to avoid translation of a foreign term in a trademark will not succeed by arguing that the typical American purchaser does not speak the relevant foreign language. As we have seen, very few languages are so obscure that the USPTO will decline to apply the doctrine on that basis.⁴⁰¹ Note again that the TMEP directs trademark examining attorneys not to apply the doctrine if “evidence shows that the language at issue is *highly obscure* or a dead language.”⁴⁰² Fingers crossed that someone will bring a test case soon with Klingon, a fictional but robust language spoken by a warrior race in the *Star Trek* universe.⁴⁰³

K. Foreign Term Is Obscure

In validity analysis, where the foreign term itself is so uncommon that even fluent speakers of that language may not understand its meaning, the doctrine would not apply, at least in theory. Proponents of foreign-language marks often argue that the term or its relevant English meaning is too obscure, but time after time, the TTAB finds that obscurity has not been proved.⁴⁰⁴ Perhaps here too, the real standard is “highly obscure.”

³⁹⁹ *In re Spirits Int'l*, 563 F.3d at 1351; TMEP §§ 809.01(b)(iii), 1209.03(g) (“While foreign words are generally translated into English for purposes of determining descriptiveness, foreign words from dead or obscure languages may be so unfamiliar to the American buying public that they should not be translated into English for descriptiveness purposes.”).

⁴⁰⁰ See *supra* Part III.E.

⁴⁰¹ See *supra* Part III.E.1.

⁴⁰² TMEP § 1207.01(b)(vi)(B) (emphasis added).

⁴⁰³ Actually, Klingon is among the languages on Microsoft’s Bing Translator. See Bing Microsoft Translator, *supra* note 98. (“The doctrine of foreign equivalents” translates as “n’lvqu’ chal tera’ je nguvwl,” in case you were wondering.) And you can study Klingon on the Duolingo language-learning app: <https://www.duolingo.com/course/tlh/en/Learn-Klingon> (last visited September 19, 2022).

⁴⁰⁴ *E.g.*, *In re Magnesita Refractories*, 2016 TTAB LEXIS 202 (“There is no evidence of record suggesting . . . that MAGNESITA is so obscure it would not be easily recognized and translated by Spanish, Portuguese or Italian speakers in the U.S. marketplace.”); *In re Amuse Bouche LLC*, 2013 TTAB LEXIS 537 (T.T.A.B. 2013) (not precedential) (“There is no evidence of record suggesting . . . that ‘pret a boire’ is so obscure that it would not be easily recognized and translated by French speakers in the U.S. marketplace.”); *In re Marchesi de’ Frescobaldi Societa’ Agricola S.p.A.*, 2008 TTAB LEXIS 539 (T.T.A.B. 2008) (not precedential) (“We find . . . that applicant has provided no evidence to support its contention that AMMIRAGLIA is . . . an obscure term.”).

***L. Foreign Mark Closely Resembles an English Mark
or a Descriptive/Generic Term***

The foreign term may be so close to the U.S. equivalent or to the other party's trademark that the doctrine of foreign equivalents doesn't even need to enter the picture. In these cases, the doctrine does not apply, though not in a way that is helpful to the party attempting to register or enforce its foreign-language trademark.

With validity analysis, the foreign mark may look and sound so much like the equivalent descriptive or generic term in English that it will not be translated to make the comparison.⁴⁰⁵ The TTAB, for example, affirmed rejection of registration of the mark EMPORIO ITALY, finding that consumers would see it as "Emporium Italy" without having to translate "emporio" to "emporium."⁴⁰⁶ Another applicant sought registration of DIVANY for furniture and the examining attorney refused registration on the ground that the mark was merely descriptive, relying on evidence that "dívány" is Hungarian for "couch."⁴⁰⁷ The TTAB affirmed but did not base its decision on the doctrine of foreign equivalents, finding that the mark—extremely close to "divan," which is a type of couch in English—was merely descriptive without reference to any translation.⁴⁰⁸

And under confusing similarity analysis, there may be no need to look to translations where the marks themselves are quite similar as is. In one case, the Federal Circuit affirmed a denial of registration for the following mark because it was "highly similar in appearance and sound" to ARTESANO NEW YORK CITY, both for clothing:⁴⁰⁹

ARTISAN  NY

Because the marks were so similar, the court did not need to rely on the doctrine of foreign equivalents and translate the Spanish word ARTESANO to "artisan."⁴¹⁰ In another case, COLOMBIANO

⁴⁰⁵ See Restatement (Third) of Unfair Competition § 14 ("If a descriptive foreign word is similar to its English equivalent, prospective purchasers are likely to understand the word in its descriptive sense. . . . Thus, OPTIQUE for eyeglasses . . . [is] descriptive.").

⁴⁰⁶ *In re Branded*, 2020 TTAB LEXIS 184 ("[N]on-Italian-speaking American consumers would readily perceive the mark as 'Emporium Italy' because the English translation is substantially similar in appearance and sound to Applicant's mark EMPORIO ITALY.").

⁴⁰⁷ *In re Lifestyle Enters., Inc.*, 2020 TTAB LEXIS 378 (T.T.A.B. 2020) (not precedential).

⁴⁰⁸ *Id.*; see also *Horos*, 2015 U.S. Dist. LEXIS 182104 (finding the doctrine of foreign equivalents not analytically useful where consumer would not need to know Italian to understand LOCALI as meaning "local").

⁴⁰⁹ *In re JS ADL, LLC*, 777 Fed. Appx. 991, 995 (Fed. Cir. 2019).

⁴¹⁰ *Id.*

COFFEE HOUSE to “providing food and drink” was blocked as confusingly similar to COLOMBIAN for coffee.⁴¹¹ “Colombiano” translates into “Colombian,” but the TTAB concluded: “Even for the relevant consumers who are unfamiliar with this direct translation, because of the near visual and aural identity of these particular terms consumers are likely to conclude that COLOMBIANO and COLOMBIAN have similar meanings.”⁴¹²

V. CONCLUSION

The doctrine of foreign equivalents is an attempt to sort out some incredibly knotty problems in trademark law, problems that are inevitable in a global economy. Who gets a monopoly on a foreign-language term in a trademark and under what conditions? Whose opinion matters in deciding descriptiveness or likely confusion and what do we reasonably know about their reactions in the market? Many have tackled these challenging questions and their answers have been varied and often irreconcilable.

The complexities and subtleties of translation, combined with the innumerable possible contexts in which trademarks appear in real life, make clear answers elusive. A good grasp on the doctrine has also been hindered by some unhelpful case law along the way, though courts and the TTAB have struggled in good faith to reach the best conclusions based on the facts before them.

This article makes a few suggestions for improving application of the doctrine. Let’s eliminate the legal fiction that requires the TTAB to find that Swahili and Dutch are languages commonly spoken in the United States. Let’s focus on *all* of the actual or likely purchasers when making decisions in cases involving foreign-language trademarks. And let’s keep in mind the differences between validity analysis and confusing similarity analysis and not apply the same principles reflexively to both.

And, of course, let’s remember the old Welsh proverb: *Dyfal donc a dyr y garreg*.⁴¹³

⁴¹¹ *In re Accelerate s.a.l.*, 101 U.S.P.Q.2d 2047 (T.T.A.B. 2012).

⁴¹² *Id.*; see also *In re The Kitchen Cafe, LLC*, 2015 TTAB LEXIS 474 (T.T.A.B. 2015) (not precedential) (finding it unnecessary to rely on translation to find that THE KITCHEN and DA KITCHEN (both for restaurant services) were confusingly similar); *In re Optica Int’l*, 196 U.S.P.Q. 775 (T.T.A.B. 1977) (holding that “the resemblance between ‘OPTIQUE’ and ‘OPTIC’ is so evident in both sound and appearance that the average member of the public in this country, whether familiar with the French language or not will automatically equate the two”).

⁴¹³ “Tapping persistently breaks the stone.” (If at first you don’t succeed, try, try again.) See <https://www.walesonline.co.uk/lifestyle/fun-stuff/24-beautiful-welsh-proverbs-sayings-9299776> (last visited September 19, 2022).

COMMENTARY

THE *ROGERS* TEST DANCES BETWEEN
TRADEMARK PROTECTION UNDER THE
LANHAM ACT AND FREEDOM OF SPEECH
UNDER THE FIRST AMENDMENT

By *Taylor E. Green**

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INTRODUCTION

“Life imitates art far more than art imitates life,”¹ according to Oscar Wilde; and therefore, our perception of life is changed by art. Watching a sunset may remind you of an artist’s painting for in that moment life imitates art. The beauty of nature is appreciated because artists feature that beauty in their paintings. Artists have latitude to create a work of art according to their vision, and their right to do so is protected under the First Amendment of the United States Constitution;² yet, this right is at times at odds with other rights, including trademark rights. We must not unconditionally revel in the glories of creativity without also respecting the Trademark Act of 1946 (the “Lanham Act”).³

In *Rogers v. Grimaldi*,⁴ the U.S. Court of Appeals for the Second Circuit developed a two-prong test for trademark infringement that attempts to balance the First Amendment right of the creators of artistic works, the Lanham Act’s protection for mark owners, and the public interest against confusion in the marketplace.⁵ The *Rogers* test is used in disputes where a defendant allegedly reproduces or imitates a plaintiff’s mark in the title or the content of an artistic work.⁶ A plaintiff alleging infringement under such a scenario must show (1) the defendant’s use of the mark either has no artistic relevance to the underlying work or, (2) if it is artistically relevant, that the use is nonetheless explicitly misleading as to the source or content of the work.⁷ In some jurisdictions, the plaintiff also must make an independent showing of actual confusion by applying the test for likelihood of confusion.⁸ With few exceptions,⁹

¹ See Oscar Wilde, *The Decay of Lying* (1891) (discussing how art affects the way we look at the world around us).

² See U.S. Const. amend. I (stating “Congress shall make no law . . . abridging the freedom of speech, or of the press”).

³ See 15 U.S.C. § 1051 *et seq.*

⁴ 875 F.2d 994 (2d Cir. 1989).

⁵ See *E.S.S. Ent. 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1099-1100 (9th Cir. 2008).

⁶ See *id.* at 1099 (holding “there is no principled reason why it ought not also apply to the use of a trademark in the body of the work”). The Ninth Circuit was the first court to extend the *Rogers* test beyond titles to include content of an artistic work.

⁷ See *Rogers*, 875 F.2d at 999 (detailing the formulation of the *Rogers* test). The title of an expressive work does not violate the Lanham Act “unless the title has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless the title explicitly misleads as to the source or the content of the work.” *Id.*

⁸ See *Cliff’s Notes, Inc. v. Bantam Doubleday Dell Publ’g Grp.*, 886 F.2d 490, 495 (2d Cir. 1989). On appeal, the court determined it needed to prevent blatant consumer confusion; so, rather than applying the same explicitly misleading test from *Rogers*, it engaged in a limited likelihood of confusion analysis. See also *Polaroid Corp. v. Polarad Elec. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961) (detailing a set of factors used to determine likelihood of confusion).

⁹ See *infra* at III, discussing *Parks v. LaFace Records*, 329 F.3d 437 (6th Cir. 2003).

courts have liberally, yet consistently, applied the first prong of the *Rogers* test and have incongruously applied the second prong.

This commentary analyzes the *Rogers* balancing test for trademark infringement by first highlighting major circuit splits in the application of that test and then analyzing the evolution of the test from circuit to circuit, including the rejection of the *Rogers* test in *Stouffer v. National Geographic Partners, LLC*¹⁰ and that court's proposal of a new test for liability. Despite its imperfections, the new *Stouffer* test may, and this commentary argues should, set into motion a timely reexamination of the *Rogers* test. After identifying the flaws, in both the *Rogers* and *Stouffer* tests, the commentary proposes the addition of two elements to the *Rogers* test. These supplemental considerations take into account consumer protection from confusion and time as a motivating factor to use the trademark, all of which are absent from the current *Rogers* test. The current test is inadequate and too defendant-friendly; a reinvention of the *Rogers* test could bring courts closer to developing a framework capable of providing a better balance between the property interest granted to trademarks under the Lanham Act and the fundamental right to free speech under the First Amendment.¹¹

I. BACKGROUND ON APPLICABLE LAWS

The interplay between the Lanham Act and the First Amendment is a crucial factor to consider when making a trademark infringement determination. The Lanham Act and the First Amendment work in tandem as the Lanham Act protects a trademark from being unfairly used, while the First Amendment protects the freedom of artistic expression. It is important first to understand interpretations of the First Amendment and the Lanham Act individually before considering how they work together, and then how they are weighed under the *Rogers* test.

A. *The Lanham Act*

The Lanham Act is the primary federal statute governing trademark law in the United States. It established a national system of trademark registration and provided statutory causes of action for mark owners to assert against the use of similar marks likely to cause confusion. As defined in the Lanham Act, a trademark is “any word, name, symbol, or device” that a person uses in commerce to distinguish their product or service from those of

¹⁰ 460 F. Supp. 3d 1133 (D. Colo. 2020) (“*Stouffer II*”), *appeal dismissed*, No. 20-1208 (10th Cir. Feb. 24, 2021).

¹¹ See *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 664 (5th Cir. 2000) (describing the tension between the protection afforded by the Lanham Act and the First Amendment).

others.¹² Examples of trademarks include the red sole heels of a pair of Christian Louboutin shoes and the golden arches in front of a McDonald's restaurant. Trademarks can appear as logos, which aid consumers in identifying the origin of a product. A mark owner may register its mark on the Principal Register of the United States Patent and Trademark Office if the mark is used in commerce, is distinctive, and is nonfunctional, in which case the registration can be either *prima facie* or conclusive evidence of the mark's validity.¹³ To avoid consumer confusion as to the source of a good or service, two sections of the Act, Section 32(1)¹⁴ and Section 43(a), recognize causes of action against, as the latter statute reads, "[a]ny person who . . . uses in commerce any word, term, name, symbol, or device . . . which is likely to cause confusion . . . as to the affiliation . . . of his or her goods."¹⁵

¹² 15 U.S.C. § 1127; *see also* *New Kids on the Block v. News Am. Publ'g, Inc.*, 971 F.2d 302, 306 (9th Cir. 1992) ("A trademark is a limited property right in a particular word, phrase or symbol.").

¹³ 15 U.S.C. §§ 1057(a), 1115(a)-(b).

¹⁴ *Id.* § 1114(1)(a), (b). This section of the Lanham Act provides:

- (1) Any person who shall, without the consent of the registrant—
 - (a) use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive; or
 - (b) reproduce, counterfeit, copy, or colorably imitate a registered mark and apply such reproduction, counterfeit, copy, or colorable imitation to labels, signs, prints, packages, wrappers, receptacles or advertisements intended to be used in commerce upon or in connection with the sale, offering for sale, distribution, or advertising of goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive, shall be liable in a civil action by the registrant for the remedies hereinafter provided. Under subsection (b) hereof, the registrant shall not be entitled to recover profits or damages unless the acts have been committed with knowledge that such imitation is intended to be used to cause confusion, or to cause mistake, or to deceive.

Id. § 1114(1)(a)-(b).

¹⁵ *Id.* § 1125(a)(1). This section of the Lanham Act provides:

- (1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—
 - (A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or
 - (B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities, shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

Id. § 1125(a)(1)(A)-(B).

The scope of the Lanham Act extends beyond disputes between producers of commercial products and their competitors and allows celebrities (and, in some circuits, non-celebrities)¹⁶ to vindicate property rights in their identities against allegedly misleading commercial uses by others. Celebrities have standing to bring a cause of action for false endorsement under Section 43(a)(1)(A) of the Act because they have an economic interest in their identities as personal brands similar to that of a traditional trademark holder. Furthermore, the Lanham Act can apply when the potential harm of consumer confusion outweighs the freedom of expression, thereby requiring courts to weigh the mark holder's rights under the Lanham Act against a defendant's right to freedom of speech under the First Amendment.

Whatever the theory of likely confusion articulated by plaintiffs, courts historically have addressed the issue by examining a series of factors: (1) "the strength of [the plaintiff's] mark"; (2) "the degree of similarity between the two marks"; (3) "the proximity of the products"; (4) "the likelihood that the . . . owner will bridge the gap"; (5) "evidence of actual confusion"; (6) "defendant's good faith in adopting [the] mark"; (7) "the quality of defendant's product"; and (8) "the sophistication of the [consumers]."¹⁷ However, as set forth below in greater detail, when a plaintiff alleges infringement of its mark in the title or content of a defendant's artistic work, a different test is applied in recognition of, and in deference to, the defendant's implicated First Amendment rights.

B. The First Amendment in the Context of Freedom of Expression

The First Amendment, comprising of a guarantee of freedom of expression, is a fundamental right granted to all persons within the United States. The First Amendment states that "Congress shall make no law respecting an establishment of religion, or prohibiting the free exercise thereof; or abridging the freedom of speech, or of the press; or the right of the people peaceably to assemble, and to petition the Government for a redress of grievances."¹⁸ The Supreme Court interprets the extent of the protection afforded to these rights. First Amendment rights are not absolute and can yield in various circumstances to countervailing interests. A notable historic case is

¹⁶ See *Hauf v. Life Extension Found.*, 547 F. Supp. 2d 771, 777 (W.D. Mich. 2008) (recognizing false endorsement is where a celebrity's image or persona is used in association with a product to imply that celebrity endorses the product). The court found plaintiff does not need to prove that he is a "celebrity." Commercial value can be established by (1) the distinctiveness of the identity and (2) the degree of recognition of the person among those receiving the publicity.

¹⁷ See *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961) (defining multi-factor test established by Second Circuit for determining likelihood of confusion).

¹⁸ U.S. Const., amend. I.

Schenck v. United States,¹⁹ in which Justice Oliver Wendell Holmes set forth a “clear and present danger test” to determine whether speech is protected by the First Amendment. The “clear and present danger test” considers whether the words are used in such circumstances and are of such a nature as to create a clear and present danger that they will bring about the substantive evils that Congress has the right to prevent. *Rogers* attempts to balance the liberal, although not absolute, freedom of speech rights guaranteed by the First Amendment with unfairly using an existing trademark.

II. CIRCUIT-BY-CIRCUIT APPLICATION OF THE *ROGERS* TEST

The *Rogers* test purported to balance the challenges of applying the fact-intensive likelihood-of-confusion test for liability for infringement under the Lanham Act against the freedom of expression granted by the First Amendment. To prevent conflict between the First Amendment and the Lanham Act, the Second Circuit in *Rogers v. Grimaldi* adopted a two-prong test. That test requires the court to determine (1) whether the defendant’s use is artistically relevant to the underlying work and (2) whether the defendant’s use is explicitly misleading as to the source or content of the work. As a practical matter, the first prong has greatly overshadowed the second prong in application, to the detriment of trademark owners. Furthermore, while the *Rogers* test is useful in making a trademark infringement determination, problems exist in its application to a wide array of cases brought before different circuits. Criticism as to whether the *Rogers* test would be better suited with more factors is explored below.

A. *Rogers v. Grimaldi*

Rogers v. Grimaldi arose from a film titled *Ginger and Fred*, which starred two fictional Italian cabaret performers who imitated Ginger Rogers and Fred Astaire, one of the most famous dancing duos in the show business and internationally known as “Ginger and Fred.”²⁰ There was no dispute that the film’s producers did not receive permission to refer to Rogers or Astaire. Ginger Rogers sued the filmmaker, seeking monetary and injunctive relief, alleging the title violated her rights under Section 43(a) of the Lanham Act by creating the false impression that the film was about her or that she sponsored or endorsed the film.²¹ Recognizing that application of the

¹⁹ 249 U.S. 47 (1919). The defendants mailed leaflets to new recruits and enlisted soldiers that compared military conscription to involuntary servitude and urged them to assert their constitutional rights.

²⁰ See *Rogers v. Grimaldi*, 875 F.2d 994, 996-97 (2d Cir. 1989).

²¹ *Id.*

Lanham Act to titles of artistic works could violate the First Amendment, the district court granted summary judgment to the defendants, holding the title of the film was artistic expression and, thus, protected under the First Amendment.²²

The Second Circuit affirmed in an opinion acknowledging the tension between the Lanham Act and First Amendment protection for artistic works and their titles.²³ The court recognized that because First Amendment rights were implicated, a test other than the standard likelihood of confusion test would need to be employed, and in resolving that tension, developed the two-prong test considering whether the defendant's use of the trademark is (1) artistically relevant and/or (2) explicitly misleading. The court reasoned that a title is an integral element of a film and a producer's artistic expression and, therefore, deserves protection under the First Amendment.²⁴ Then, applying the second prong, the court determined that the title *Ginger and Fred* contained no explicit indication that Rogers sponsored or endorsed the film.²⁵ Even if some consumers would be confused as to whether Rogers was involved in the making of the film, that was sufficiently outweighed by the interest in artistic expression to preclude liability under the Lanham Act. Furthermore, should the title mislead some individuals as to the subject of the work, that risk was outweighed by the danger that suppressing an artistically relevant title would unduly restrict expression.²⁶

B. First Prong: Artistic Relevance of the Title to the Content

The first prong of the *Rogers* test turns on artistic relevance, with liability under the Lanham Act possible if the challenged use of the trademark has no artistic relevance to the underlying work.²⁷ Artistic relevance is used to determine whether the use of a trademark is relevant to a disputed work's artistic purpose. As courts have adopted and applied the *Rogers* test, it has become clear that the threshold for a finding of artistic relevance is very low. As

²² *Id.* at 997. Section 43(a) of the Lanham Act creates civil liability for any person who, “in connection with any goods or services, . . . uses in commerce . . . any false designation of origin, false or misleading description of fact, or false or misleading representation. . . .” 15 U.S.C. § 1125(a)(1).

²³ *Id.* at 999.

²⁴ *Id.* at 998.

²⁵ *Id.* at 1001.

²⁶ *Id.*

²⁷ See *Louis Vuitton Malletier S.A. v. Warner Bros. Entm't Inc.*, 868 F. Supp. 2d 172, 178 (S.D.N.Y. 2012) (finding that the defendant satisfied the artistic relevance prong where its use of the trademark was “not arbitrarily chosen just to exploit the publicity value of [the plaintiffs’ mark] but instead ha[d] genuine relevance to the film’s story” (alterations in original) (quoting *Rogers*, 875 F.2d at 1001)).

established by the Ninth Circuit, this requirement is nothing more than the need for the artistic relevance level to be above zero.²⁸ As reflected in the following discussion, courts historically have been liberal and consistent in finding the existence of artistic relevance, thereby foreclosing relief under the Lanham Act.

Consistent with the reasoning in *Rogers*, an example of artistic relevance crossing the above-zero finish line is in *Virag, S.R.L. v. Sony Computer Entertainment America LLC*.²⁹ Virag sued the defendant for allegedly including Virag's trademark in the content of its GRAN TURISMO racing video games. The court applied the first prong of the *Rogers* test and found Sony's use of the Virag mark had artistic relevance. The mark's artistic relevance was attributable to the role realism plays in the GRAN TURISMO games. Realism qualifies as artistic expression. The real-life logos and realistic car racing simulation in the games were examples of artistic relevance showing a connection between Virag's trademark and the logos in the video games. The court did not need to determine exactly how artistically relevant the Virag mark was to the games; rather, it only needed to find the artistic relevance level was above zero.³⁰ The "above zero" standard for determining artistic relevance likely appeals to courts because of its easy applicability as a "black-and-white rule."³¹

Another example of a court pulling the trigger at the first sight of artistic relevance and leniently applying the first prong of the *Rogers* test is the Southern District of Indiana's decision in *Dillinger, LLC v. Electronic Arts, Inc.*³² *Dillinger* involved the estate of the famous gangster, John Dillinger, which alleged that the "Dillinger Tommy Gun," which appears as a weapon in *The Godfather* video games, infringed its registered JOHN DILLINGER mark for firearms.³³ *Dillinger* argued there was no artistic relevance between its mark and the video game because *The Godfather* novel and films, upon which the video game is based, were not set in the same period as when John Dillinger was alive.³⁴ Upon consideration, the court held it was not its role to determine the degree of meaningfulness of a trademark to the content of a literary work.³⁵ Consistent with *Rogers* and its progeny, any connection

²⁸ E.S.S. Entm't 2000, Inc. v. Rock Star Videos, Inc., 547 F.3d 1095, 1100 (9th Cir. 2008).

²⁹ VIRAG, S.R.L. v. Sony Comput. Entm't Am. LLC, No. 3:15-cv-01729-LB, 2015 WL 5000102 (N.D. Cal. Aug. 21, 2015), *aff'd*, 699 F. App'x 667 (9th Cir. 2017).

³⁰ VIRAG, 2015 WL 5000102, at *12.

³¹ *Id.* at *14-15 (citing *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1243 (9th Cir. 2013)).

³² *Dillinger, LLC v. Elec. Arts Inc.*, No. 1:09-cv-1236-JMS-DKL, 2011 WL 2457678 (S.D. Ind. June 16, 2011).

³³ *Id.* at *3.

³⁴ *Id.* at *4-6.

³⁵ *Id.* at *6.

whatsoever was sufficient to satisfy the low, “more than zero,” threshold of minimal artistic relevance.³⁶

In the cases discussed above, courts concluded that there was at least an “above zero” level of artistic relevance under the *Rogers* balancing test. In contrast, in *Parks v. LaFace Records*,³⁷ the Sixth Circuit found that there was a factual dispute as to whether the level of artistic relevance was sufficient to satisfy *Rogers*’s first prong, and indeed that it was “highly questionable” whether there was any relevance of the song title to the song content at all.³⁸ *Parks* involved a dispute between the civil rights icon, Rosa Parks, and the hip-hop duo OutKast over the latter’s use of Parks’ name as the title of their song “Rosa Parks.”³⁹ Parks contended the defendants violated the Lanham Act because the Rosa Parks title misled consumers into believing the song was about her or that she sponsored or endorsed the song.⁴⁰ Due to her fame, Parks acquired celebrity⁴¹ status and, as a result, had a property interest in her name similar to that of a person who owns a trademark.⁴² The district court, in ruling on cross-motions for summary judgment, found the defendant, OutKast, had added sufficient expressive content to the lyrics to warrant First Amendment protection for their use of Parks’ name as their song title.⁴³ Rosa Parks was a symbol of the civil rights movement; accordingly, the use of her name in the song title was for symbolic purposes. But the Sixth Circuit asked, “symbolic of what?” and observed that the content of the song appeared to be unrelated to the qualities for which Parks is known and, instead, was an exercise in “pure egomania” (OutKast’s assertion of superiority over other MCs).⁴⁴ If, on remand, a fact finder found (as the court suggested was likely) that there was “no artistic relevance to the lyrics of Defendants’ song,” the result

³⁶ *Id.*

³⁷ 329 F.3d 437 (6th Cir. 2003).

³⁸ *Id.* at 449, 456. The *Parks* decision is an outlier in this regard.

³⁹ *Id.* at 441.

⁴⁰ *Id.* at 446.

⁴¹ A celebrity is defined as “a celebrated or widely known person: one popularly honored for some signal achievement.” *Celebrity*, Webster’s Third New International Dictionary 359 (Phillip Babcock Grove, ed. 1976).

⁴² *Parks*, 329 F.3d at 447 (recognizing a property right in celebrity identity akin to that of a trademark holder). See, e.g., *Landham v. Lewis Galoob Toys, Inc.*, 227 F.3d 619, 626 (6th Cir. 2000); *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1110 (9th Cir. 1992), *abrogated on other grounds by* *Lexmark Int’l, Inc. v. Static Control Components*, 572 U.S. 118 (2014); *Allen v. Nat’l Video, Inc.*, 610 F. Supp. 612, 624-25 (S.D.N.Y. 1985).

⁴³ *Parks*, 329 F.3d at 447. See *Hurley v. Irish-Am. Gay, Lesbian Bisexual Grp. of Bos., Inc.*, 515 U.S. 557, 569 (1995) (stating that paintings, music, and poetry are “unquestionably shielded” by First Amendment); *Ward v. Rock Against Racism*, 491 U.S. 781, 790 (1989) (“Music, as a form of expression and communication, is protected under the First Amendment.”).

⁴⁴ *Parks*, 329 F.3d at 454.

“would be that Defendants cannot even satisfy the first prong of *Rogers* in order to justify their appropriation of Rosa Parks’ name.”⁴⁵ As to the second prong, however, the court found that there was no material dispute as to whether the song title was explicitly misleading. “Defendants did not name the song, for example, *The True Life Story of Rosa Parks* or *Rosa Parks’ Favorite Rap*” and, therefore, if a fact finder found on remand that there was artistic relevance, judgment should be entered for the defendants.⁴⁶ The case subsequently was settled.⁴⁷ A key takeaway from the Sixth Circuit’s decision is its sagacious observation that “the First Amendment cannot permit anyone who cries ‘artist’ to have carte blanche when it comes to naming and advertising his or her works.”⁴⁸

C. Second Prong: Explicitly Misleading Title or Content

While the artistic relevance prong of the *Rogers* test appears to be somewhat uniformly applied across all circuits, with the exception of *Parks*, the method for applying the explicitly misleading prong has shown some variety. Generally, “explicitly misleading”⁴⁹ refers to an obvious and unambiguous statement of sponsorship. Below are examples of how different circuits interpret the meaning of explicitly misleading.

In *Twin Peaks Productions, Inc. v. Publications International, Ltd.*,⁵⁰ Publications International published a book titled *Welcome to Twin Peaks: A Complete Guide to the Who’s Who and What’s What*, which incorporated the title of the *Twin Peaks* television series.⁵¹ The court applied the *Rogers* test and, as to the first prong, found “little question that the title is of some artistic relevance to the Book.” The second prong, thus, was the determining factor: whether the title would mislead the public into believing the book was prepared by, or otherwise associated with, the producers of the television show.⁵² Because the title involved a literary work instead of a celebrity name, the court began by utilizing the *Polaroid*

⁴⁵ *Id.* at 456.

⁴⁶ *Id.* at 459.

⁴⁷ *Parks v. LaFace Records*, Civ. No. 2:99-cv-76405 (E.D. Mich.), ECF No. 264, Stipulated Order Dismissing Case with Prejudice filed April 14, 2005.

⁴⁸ *Parks*, 329 F.3d at 447.

⁴⁹ *Explicitly* is defined as “clearly and without any vagueness or ambiguity.” *Explicitly*, MERRIAM-WEBSTER, <https://www.merriam-webster.com/dictionary/explicitly> (last visited Apr. 7, 2022).

⁵⁰ *Twin Peaks Prods., Inc. v. Publ’ns Int’l, Ltd.*, 996 F.2d 1366 (2d Cir. 1993).

⁵¹ *Twin Peaks Prods., Inc. v. Publ’ns Int’l*, 778 F. Supp. 1247, 1249, 1252 (S.D.N.Y. 1991), *aff’d in part, vacated in part*, 996 F.2d 1366.

⁵² *Twin Peaks*, 996 F.2d at 1379.

likelihood-of-confusion factors. Should likelihood of confusion exist, the court held it must be “particularly compelling” to outweigh the First Amendment interest recognized in *Rogers*.⁵³ Because the record had not been adequately developed, the case was remanded to the district court for its consideration of the likelihood-of-confusion factors.⁵⁴ The most important takeaway from this case is that the second prong does not just involve an application of the likelihood-of-confusion factors, but a heightened threshold to find liability in view of First Amendment rights.

In *VIP Products LLC v. Jack Daniel’s Properties, Inc.*,⁵⁵ the Ninth Circuit took a different approach from the Second Circuit toward *Rogers*’s explicitly misleading prong. The Ninth Circuit’s application of *Rogers*’s second prong does not consider the standard likelihood-of-confusion test when determining whether a defendant’s use is explicitly misleading, but instead focuses on the defendant’s actions. Thus, even though the court requires a plaintiff to make a separate showing of likely confusion,⁵⁶ the plaintiff’s ability to do so is a different inquiry altogether. In *VIP Products*, Jack Daniel’s, a whiskey manufacturer, sued VIP Products, the maker of a dog toy, for modeling its dog toy after the JACK DANIEL’S “Old No. 7” bottle.⁵⁷ The toy design was a creative interpretation of the liquor bottle;⁵⁸ and Jack Daniel’s alleged that the toy infringed its trademark rights in its design of the bottle.⁵⁹ Considering the second prong in *Rogers*, the Ninth Circuit held the design of the dog toy was not explicitly misleading because VIP Products made comical, dog-related alterations to the JACK DANIEL’S “Old No. 7” bottle by replacing the name “Jack Daniel’s” with “Bad Spaniels,” “Old No. 7” with “Old No. 2,” and alcohol content descriptions with “43% Poo by volume” and “100% smelly.”⁶⁰

⁵³ *Id.* at 1379.

⁵⁴ *Id.*

⁵⁵ *VIP Prods. LLC v. Jack Daniel’s Props., Inc.*, 953 F.3d 1170 (9th Cir. 2020), *cert. denied*, 141 S. Ct. 1054 (2021).

⁵⁶ *See Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 265 (9th Cir. 2018) (“If the plaintiff satisfies both elements, it still must prove that its trademark has been infringed by showing that the defendant’s use of the mark is likely to cause confusion.”).

⁵⁷ *VIP Prods. LLC*, 953 F.3d at 1172.

⁵⁸ *Id.* at 1173, 1175 (stating VIP “did not use JDPI’s identical marks or trade dress in its Bad Spaniels toy” (citation omitted)).

⁵⁹ *Id.* at 1173 (“Jack Daniel’s trade dress and bottle design were distinctive, non-generic, and nonfunctional, and therefore entitled to trademark protection.”). *See also* *Anheuser-Busch, Inc. v. VIP Prods., LLC*, 666 F. Supp. 2d 974, 986 (E.D. Mo. 2008) (preliminarily enjoining VIP Product’s sale of its Buttweiler toy after finding Anheuser-Busch demonstrated a substantial likelihood of success on the merits of the trademark infringement claim).

⁶⁰ *VIP Prods. LLC*, 953 F.3d at 1172. If the plaintiff satisfied one of the *Rogers* elements, “it still must prove that its trademark has been infringed by showing that the defendant’s use of the mark is likely to cause confusion.” *Id.* at 1176 n.2 (quoting *Gordon v. Drape*

The court also held that the toy design was not explicitly misleading because VIP Productions did not intend to confuse consumers into thinking the dog toy was a whiskey bottle for human consumption but, rather, employed a marketing tactic to humanize dogs to better relate to consumers.⁶¹ There, the court's analysis focused heavily on the defendant's intent and actions.

The Fifth Circuit has accepted the *Rogers* test for cases alleging trademark infringement and, like the Second Circuit, makes an explicitly misleading determination based on the application of the likelihood-of-confusion factors. For example, in *Westchester Media v. PRL USA Holdings, Inc.*,⁶² the court analyzed whether the use of POLO for a magazine title infringed the trademark rights of the Ralph Lauren POLO brand.⁶³ Loyal to the *Rogers* test, the Fifth Circuit conducted an artistic relevance and explicitly misleading analysis and concluded that the POLO title was likely to cause consumer confusion. The Fifth Circuit adopted the Second Circuit's two-prong test⁶⁴ and then implemented a likelihood-of-confusion test⁶⁵ to determine whether a title is misleading. Consistent with *Rogers*'s pro-defendant orientation, the Fifth Circuit held that the likelihood of confusion must be particularly compelling to fall outside of First Amendment protection.⁶⁶

Unlike the Fifth Circuit, which uses the likelihood-of-confusion test as part of the inquiry into whether a defendant's use is explicitly misleading, the Third, Sixth, and Eleventh Circuits, as well as district courts within the Seventh Circuit, have all interpreted the explicitly misleading prong in *Rogers* as requiring the defendant to

Creative, Inc., 909 F.3d 257, 265 (9th Cir. 2018)); *see also* Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC, 507 F.3d 252, 260 (4th Cir. 2007) (stating application of likelihood-of-confusion depends "to a great extent on whether its products and marks are successful parodies"). *See also* *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 970 (10th Cir. 1996) ("[P]roof of trademark infringement under the Lanham Act requires proof of a likelihood of confusion, but, *in the case of a good trademark parody, there is little likelihood of confusion*, since the humor lies in the difference between the original and the parody." (emphasis added)).

⁶¹ *VIP Prods. LLC*, 953 F.3d at 1172.

⁶² *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658 (5th Cir. 2000).

⁶³ *Id.* at 660.

⁶⁴ *Id.* at 665. *See also* *Sugar Busters LLC v. Brennan*, 177 F.3d 258, 269 n.7 (5th Cir. 1999) ("Any finding that defendants' book title is likely to cause confusion with plaintiff's book title must be 'particularly compelling' to outweigh defendants' First Amendment interest in choosing an appropriate book title for their work." (quoting *Twin Peaks Prods., Inc. v. Publ'ns Int'l, Ltd.*, 996 F.2d 1366, 1379 (2d Cir. 1993))).

⁶⁵ *Westchester Media*, 214 F.3d at 665. *See* *Pebble Beach Co. v. Tour 18 I Ltd.*, 155 F.3d 526, 543 (5th Cir. 1998) ("No single factor is dispositive, and a finding of a likelihood of confusion does not require a positive finding on a majority of these 'digits of confusion.'" (citation omitted)); *Elvis Presley Enters., Inc. v. Capece*, 141 F.3d 188, 194 (5th Cir. 1998) (same); *Conan Props., Inc. v. Conans Pizza, Inc.*, 752 F.2d 145, 149-50 (5th Cir. 1985) ("The absence or presence of any one factor ordinarily is not dispositive. . .").

⁶⁶ *Westchester Media*, 214 F.3d at 665. *See also* *Twin Peaks Prods.*, 996 F.2d at 1379.

engage in some overt act to confuse the public. For example, in *University of Alabama Board of Trustees v. New Life Art, Inc.*,⁶⁷ the university believed the defendant artist needed permission to paint football scenes because the crimson and white colors and helmet and uniform designs were trademarks of the university.⁶⁸ The Eleventh Circuit applied the second prong of the *Rogers* test and found no evidence that the defendant had engaged in an overt act, such as labeling his items as “endorsed” or “sponsored” by the university, that might confuse consumers; the defendant’s paintings, prints, and calendars were, therefore, entitled to First Amendment protection.⁶⁹ Consistent with the Eleventh Circuit’s decision, the Third and Sixth Circuits,⁷⁰ and district courts within the Seventh Circuit,⁷¹ mirror the Eleventh Circuit’s rule that explicit misstatements or overt actions are required to find a defendant’s use explicitly misleading under *Rogers*.

As demonstrated above, the various Circuit Courts of Appeals have implemented *Rogers*’s second prong in different ways. The varying interpretations of *Rogers*’s two-prong test by courts outside of the Second Circuit suggest a degree of judicial discomfort with, or perhaps misunderstanding of, the original test. Questions have arisen in at least one court as to whether the *Rogers* test is the proper test to apply or whether an alternative test may be more suitable when balancing the rights of trademark owners and the rights of artists seeking to use or reference trademarks within their creative expressions.

III. CREATION OF A NEW TEST: *STOUFFER v. NATIONAL GEOGRAPHIC PARTNERS, L.L.C.*

The Tenth Circuit has never had the occasion to consider the propriety of applying *Rogers* in a trademark-based challenge to the title or content of a creative work. However, in *Stouffer v. National Geographic Partners, LLC*,⁷² the United States District Court for the District of Colorado, in the absence of authority from its reviewing court, rejected the *Rogers* test because previous courts have struggled to accommodate unanticipated factual patterns within

⁶⁷ Univ. of Ala. Bd. of Trs. v. New Life Art, Inc., 683 F.3d 1266 (11th Cir. 2012).

⁶⁸ *Id.* at 1269.

⁶⁹ *Id.* at 1279.

⁷⁰ See, e.g., Seale v. Gramercy Pictures, 949 F. Supp. 331 (E.D. Pa. 1996), *aff’d without opinion*, 156 F.3d 1225 (3d. Cir. 1998); ETW Corp. v. Jireh Publ’g, 332 F. 3d 915 (6th Cir. 2003).

⁷¹ See Eastland Music Grp., LLC v. Lionsgate Entm’t, No. 11 C 8224, 2012 WL 2953188 (N.D. Ill. July 19, 2012).

⁷² *Stouffer v. Nat’l Geographic Partners, LLC*, 460 F. Supp. 3d 1133 (D. Colo. 2020), *appeal dismissed*, No. 20-1208 (10th Cir. Feb. 24, 2021).

that test.⁷³ The resulting “genuine artistic motive” test, also known as the *Stouffer* test, is a six-factor test detailed below.⁷⁴ The importance of *Stouffer*, and the analysis found within it, is not in its outcome or contribution to ensuing trademark infringement cases, but, rather, the fact that the court challenged whether *Rogers* is the right test at all and offered a broader analytical approach.⁷⁵

A. *Stouffer v. National Geographic Partners, L.L.C.*

Stouffer involved a nature documentary series, *Wild America*, produced by Marty Stouffer Productions (“Stouffer”). National Geographic requested permission to use the title *Wild America* or *Wildest America* for its own production.⁷⁶ Stouffer declined on the grounds that WILD AMERICA is a protected trademark and the proposed titles by National Geographic were too similar.⁷⁷ Nevertheless, National Geographic produced several television series related to the title *Wild America*, including *America the Wild*, *Surviving Wild America*, and *America’s Wild Frontier*.⁷⁸ Consequently, Stouffer brought a trademark infringement action in the District Court of Colorado against National Geographic for using the titles.⁷⁹

Since the Tenth Circuit had neither approved nor disapproved of the *Rogers* test, the district court was not bound by any controlling authority.⁸⁰ Thus addressing *Rogers*’s applicability as a question of first impression, the court concluded the test was needlessly rigid and failed to account for the realities of each situation.⁸¹ The court expressed its concerns that, in light of the heavily pro-defense nature of the *Rogers* test, a reasonable person may believe “trademarks registered for arguably artistic products and services are not worth the paper that the trademark

⁷³ *Id.* at 1135 (concluding that *Rogers* test, without more prongs, “did not strike the appropriate balance between trademark rights and First Amendment rights”).

⁷⁴ *Id.* at 1139-40.

⁷⁵ Order, *Stouffer v. Nat’l Geographic Partners*, No. 20-1208 (10th Cir. filed Mar. 1, 2021) (granting a stipulation to dismiss under Federal Rule of Appellate Procedure 42 allowing for procedural termination without judicial action).

⁷⁶ *Stouffer II*, 460 F. Supp. 3d at 1135-36. Marty Stouffer Productions owns a federal trademark registration for WILD AMERICA. *Id.* at 1136.

⁷⁷ *Id.*

⁷⁸ *Id.* at 1136-39.

⁷⁹ *Id.* at 1139.

⁸⁰ *Id.* The court asked three questions: (1) “[D]oes the Lanham Act need a limiting construction to protect First Amendment interest? . . . [Y]es.” (2) “[M]ust the First Amendment-based limiting construction on the Lanham Act lead to a test that a court may apply before trial. . . ? . . . [Y]es.” (3) “[I]s the *Rogers* test the right test?” No, it should not be applied “as-is.” *Id.* at 1139-40.

⁸¹ *Id.* at 1143.

registration is printed upon.”⁸² To make the *Rogers* test less rigid, the court concluded that the explicitly misleading prong from the *Rogers* test should be satisfied by use of the challenged mark alone without the need for an overt act by the defendant.⁸³ After considering *Rogers*, the court held that test did not strike the appropriate balance between trademark rights and First Amendment rights because it tilted too far in favor of the defendant’s freedom of expression.⁸⁴ The court, therefore, sought a more flexible test that can be tailored to each case by considering six factors designed to answer the ultimate question of whether the defendant had a genuine artistic motive for using the plaintiff’s mark or other property right protected by the Lanham Act.⁸⁵

B. The Stouffer Test

The *Stouffer* court’s analysis added elements that courts in the Second, Fifth, Sixth, Ninth, and Eleventh Circuits had identified as missing in the *Rogers* test.⁸⁶ Displeased with the two-prong *Rogers* test, the district court introduced a six-factor alternative test examining: (1) whether the plaintiff and defendant users “use the mark to identify the same kind [or similar] goods or services,” (2) “to what extent has the [defendant] added his or her own expressive content to the work,” (3) whether “the timing of the [defendant’s] use in any way suggest[s] a motive to capitalize on popularity of the [plaintiff’s] mark,” (4) whether the defendant’s use is “artistically related to the underlying work,” (5) “whether the defendant “made any statement to the public . . . suggest[ing] a non-artistic motive,” and (6) whether the defendant “made any statement in . . . private suggest[ing] a non-artistic motive.”⁸⁷ Each factor is discussed below, including its origin and intended application to future cases.

The first factor of the *Stouffer* test, which seeks to explore the similarity of the goods or services offered by the plaintiff and defendant, echoes the significance of those considerations in the standard multifactored tests for likely confusion, including the

⁸² *Id.* at 1142.

⁸³ *Id.* at 1143.

⁸⁴ *Id.* at 1140. *See Rogers*, 875 F.2d at 1006 (stating the *Rogers* test offers a “cure . . . far worse than the ailment” (Griesa, J., concurring)).

⁸⁵ *Stouffer II*, 460 F. Supp. 3d at 1140-41.

⁸⁶ *See Hermes Int’l et al. v. Mason Rothschild*, 2022 U.S.P.Q.2d 476 (S.D.N.Y. May 18, 2022); *see also Rin Tin, Inc. v. First Look Studios, Inc.*, 671 F. Supp. 2d 893 (S.D. Tex. 2009); *see also Rebellion Devs. Ltd. v. Stardock Entm’t, Inc.*, 107 U.S.P.Q.2d 2160 (E.D. Mich. May. 9, 2013); *see also VIP Prods. LLC*, 953 F.3d at 1172; *see also Legacy Entm’t Gap, LLC v. Endemol USA Inc.*, No. 3:15-cv-252-HES-PDB, 2015 WL 12838795 (M.D. Fla. Sept. 30, 2015).

⁸⁷ *Id.* at 1140.

multifactor test extant in the Tenth Circuit.⁸⁸ The first factor directs the court to analyze, from a likelihood-of-confusion perspective, how the defendant uses its mark and whether the defendant's mark is similar to the plaintiff's mark. The likelihood of confusion is an important consideration when determining whether the defendant's use infringes the plaintiff's mark.

The second factor of the *Stouffer* test considers to what extent the defendant added expressive content to the work and is developed from *Parks v. LaFace Records*.⁸⁹

The third factor of the *Stouffer* test, derived from *Gordon v. Drape Creative*,⁹⁰ analyzes whether the timing of the defendant's use suggests a motive to benefit from the fame of the plaintiff's mark. In *Gordon*, Christopher Gordon posted on YouTube "The Crazy Nastyass Honey Badger," a video known for its catchphrase "Honey Badger Don't Care" and "Honey Badger Don't Give a S---."⁹¹ Gordon registered the former phrase as a mark for numerous classes of goods, including greeting cards.⁹² Alleging trademark infringement, Gordon sued Drape Creative Inc., a greeting card design company, and Papyrus-Recycled Greetings Inc., a greeting card manufacturer, for selling greeting cards with variations of "Honey Badger Don't Care" and "Honey Badger Don't Give a S---."⁹³ Despite the popularity of Gordon's mark, the defendant could not recall how he came up with the almost identical phrase to Gordon's mark.⁹⁴ Nevertheless, the timing of the events suggests a potential intent by the defendant to take advantage of the fame of the plaintiff's mark. Although the *Gordon* court did not consider timing as an issue, because it is not an element in the *Rogers* test, the *Stouffer* court made it clear that any temporal connection should be specifically considered part of the evaluation.⁹⁵ According to the

⁸⁸ *Utah Lighthouse Ministry v. Found. for Apologetic Info. & Res.*, 527 F.3d 1045, 1054-55 (10th Cir. 2008) (citing Tenth Circuit's application of its traditional six-factor likelihood-of-confusion analysis). The Tenth Circuit held the plaintiff had not presented evidence from which a jury could conclude that the parody website was likely to cause confusion within the Lanham Act. *Id.* at 1056-57.

⁸⁹ *Stouffer II*, 460 F. Supp. 3d at 1140 (citing court's inspiration from *Parks v. LaFace Recs.*, 329 F.3d 437 (6th Cir. 2003) (exploring *Rogers*'s first prong of artistic relevance)).

⁹⁰ *Id.*, citing *Gordon v. Drape Creative, Inc.*, 897 F.3d 1184, 1186 (9th Cir.), *withdrawn and superseded on reh'g by* 909 F.3d 257 (9th Cir. 2018).

⁹¹ *Id.* at 1186-87.

⁹² *Id.* at 1187.

⁹³ *Id.* at 1186.

⁹⁴ *Id.* at 1189 (claiming to have never heard of a video involving a honey badger).

⁹⁵ *Stouffer II*, 460 F. Supp. 3d at 1140 (discussing Court's proposal of a six non-exclusive factor test to weigh First Amendment interests). One of the factors the Court states is "[t]o what extent has the junior user 'added his or her own expressive content to the work beyond the mark itself[']'?" *Id.* (second and third alterations in original) (quoting *Stouffer v. Nat'l Geographic Partners, LLC*, 400 F. Supp. 3d 1161, 1179 (D. Colo. 2019) ("*Stouffer I*").

court, even though motive is a subjective element, inferences of motive can prove helpful to the court in determining the propriety of a defendant's use of a plaintiff's mark vis-a-vis First Amendment and Lanham Act concerns.⁹⁶

The fourth factor of the *Stouffer* test is the first prong of the *Rogers* test, which questions the artistically related nature of the plaintiff's mark as compared with the defendant's use of the mark.⁹⁷ Notably, the *Stouffer* court did not outright reject the *Rogers* test, but broadened it so that the "more than zero" threshold would not be so dispositive.⁹⁸ Nevertheless, the *Stouffer* court recognized that artistic relevance is a key component to a creative work and deserves to remain a part of the test. The artistic relevance prong seeks to ensure there is an intended artistic association with the mark. It is not the court's role to determine how meaningful the artistic connection is but rather that one exists. In *Stouffer*, the defendants' *Wild America* title was artistically relevant to the underlying television series, because the series was a nature documentary taking place in America's wilderness.⁹⁹ This finding was consistent with case precedent, as courts have liberally found artistic relevance.

Additionally, the *Stouffer* court created factors five and six, which further consider motive, as in the third element, except these factors consider whether the defendant made any statement either in public or in private that suggests a non-artistic motive.¹⁰⁰ In *Gordon*, the court defined a public statement as an explicitly misleading statement, which it derived from *Rogers*'s second prong.¹⁰¹ The *Stouffer* court held that a defendant's explicitly misleading statements should be an additional factor considered when weighing First Amendment concerns with the public's interest in avoiding confusion.¹⁰²

As this analysis demonstrates, the *Stouffer* test seeks to resolve the imbalance in the *Rogers* test of allowing too much freedom of expression and, consequently, leaning too far in favor of the

⁹⁶ *Id.* at 1146.

⁹⁷ *Id.* at 1140 (citing to fourth prong of *Stouffer* test). The fourth prong asks, "In what way is the mark artistically related to the underlying work, service, or product?" *Id.*

⁹⁸ *Id.* at 1139 (stating Tenth Circuit has neither approved nor disapproved of *Rogers* test).

⁹⁹ *Id.* at 1146.

¹⁰⁰ *Id.* at 1140.

¹⁰¹ *Gordon*, 909 F.3d at 269-70. The use of a mark alone may explicitly mislead consumers about a product's source if consumers would ordinarily identify the source by the mark itself. *Id.* at 270. The Ninth Circuit provided an example with a Mickey Mouse painting containing the Disney mark at the bottom corner as the use of the mark would be relevant to the subject but mislead consumers as to the source. *Id.*

¹⁰² *Stouffer II*, 460 F. Supp. 3d at 1142. A major premise of the common-law tradition is that judges will adapt the tests and rules as unexpected situations arise.

defendant.¹⁰³ The additional *Stouffer* factors are not new but, rather, seek to resolve unanswered questions that arose in cases succeeding *Rogers*. The key distinction between the *Rogers* test and the *Stouffer* test is the additional element of motive. Recognizing there could be a more inclusive test and acknowledging the idea of reformation, the *Stouffer* test appears to be a significant achievement. However, upon closer examination, factors one, five, and six of the *Stouffer* test are effectively coextensive with the two prongs of the *Rogers* test. The *Stouffer* test accounts for artistic relevance and the additional facet of motive in reference to explicitly misleading statements. Nevertheless, three additional factors in the *Stouffer* test tilt in favor of possible liability for trademark infringement. Artists using the plaintiffs' marks for genuine artistic purposes, with no intention of confusing consumers, can find solace in knowing their freedom of expression is protected, yet within the bounds of trademark law, should courts decide to adopt this test. The development of the *Stouffer* test demonstrates a possible alternative to the *Rogers* test.

IV. A PROPOSED UPDATED TRADEMARK INFRINGEMENT TEST IN CHALLENGES TO THE TITLES OR CONTENT OF CREATIVE WORKS

Although the *Rogers* test is widely used to evaluate allegations of infringement in challenges to the titles or contents of creative works, the circuit splits in approaching its two prongs demonstrates that the test is ripe for improvement. The Second Circuit believes the two-prong *Rogers* test is sufficient for determining infringement while the Fifth, Sixth, Ninth, Eleventh, and most likely Tenth Circuits have facially adopted the test but also look to considerations such as the defendant's intent or the standard likelihood of confusion factors. The inconsistent applications of the test across circuit courts reflects at least some degree of judicial discomfort with *Rogers*.¹⁰⁴

The *Rogers* test provides a basic structure to govern the evaluation of claims of infringement originating in the titles or content of artist works, but it is not a finished product. Given the fact that courts have largely adopted this framework over the past thirty-three years, the two prongs need not be discarded completely, but as the *Stouffer* court demonstrated, the test can be expanded in order to more fairly weigh trademark protection interests. While the first prong of artistic relevance has been consistently applied, nearly

¹⁰³ *Id.* at 1140.

¹⁰⁴ *Stouffer I*, 400 F. Supp. 3d at 1171-77 (citing Second, Fifth, Sixth, Ninth, and Eleventh Circuits' different applications of *Rogers* test). Judge Friendly recognized, the "problem of determining how far a valid trademark shall be protected . . . has long been vexing and does not become easier of solution with the years." *Id.*

to the point of irrelevance, with the “non-zero” threshold for artistic relevance virtually always satisfied, courts have not applied the explicitly misleading prong with equal consistency. The *Rogers* test fails to fairly balance the plaintiff’s use and the defendant’s use of the mark by failing to take into account the defendant’s intent and actual confusion.

Building upon *Rogers*’s first prong of artistic relevance and second prong of explicitly misleading, the test needs additional elements to provide a sufficient framework for courts to follow. By adding motive and consumer confusion as additional factors, this reimagined *Rogers* test could adopt and apply uniformly across all circuits. Specifically, the *Rogers* test should include a third factor that considers whether the timing of the defendant’s use in any way suggests a motive to capitalize on the popularity of the plaintiff’s mark.¹⁰⁵ This added factor will steer courts down the path of analyzing whether a celebrity’s status contributes to the defendant’s desire to use the plaintiff’s mark. Looking to the future, software, blockchain technology, cryptocurrencies, and non-fungible tokens (“NFTs”) are all transformative concepts in our new metaverse that are beginning to present various old, but unsettled, intellectual property issues in a new light.¹⁰⁶ While some may wonder if motive is too far removed from trademark law as to be relevant, motive will help courts detect fraud or bad faith and arrive at a fairer decision. Lastly, a fourth factor should be added to the *Rogers* test requiring courts to consider whether consumers are protected from copies and confusion of similar goods, services, products, or assets. Consumer confusion can occur in both the marketplace and the metaverse. In this era of digitalization, the proposed updated *Rogers* test will allow for additional focus on consumer confusion necessary to avoid the duplication and consequent confusion of items in real life and in virtual reality. The shortfall in the current *Rogers* test is the heavy weight accorded to the freedom of expression and the lack of consideration given to enforcement of trademark law. A reinvented *Rogers* test, comprising four factors, may appeal to courts open to establishing an updated trademark infringement test where the titles and content of artistic works are concerned.

V. CONCLUSION

In the thirty years since the legendary *Rogers v. Grimaldi* case, the law continues to evolve as courts carry on in pursuit of a balancing test for trademark infringement cases implicating First Amendment rights. The *Rogers* test provides a basic framework for courts to follow when evaluating trademark infringement in

¹⁰⁵ *Id.* at 1179 (citing *Gordon*, 909 F.3d at 262).

¹⁰⁶ See *Hermes v. Int’l v. Rothschild*, 2022 U.S.P.Q.2d 476 (S.D.N.Y. May. 18, 2022).

relation to First Amendment and Lanham Act principles. Comprising only two prongs, the *Rogers* test is straightforward to apply, but over time, the need to refine the *Rogers* test has become evident.¹⁰⁷ Courts, therefore, should consider a broader test striking a fairer balance between the First Amendment protections and the Lanham Act principles.

The problem with the *Rogers* test, which considers the artistic relevance and explicitly misleading nature of a creative work, is that it provides a safe harbor to which defendants can escape to avoid trademark infringement.¹⁰⁸ Defendants effectively receive carte blanche¹⁰⁹ because the threshold for artistic relevance in *Rogers* is anything above zero, and there is a virtual absence from at least recent case law of findings that defendants' uses are explicitly misleading.¹¹⁰ Under *Rogers*, artistic creations rarely are actionable as infringement. Therefore, there needs to be a more balanced framework to apply when weighing the First Amendment freedoms against the Lanham Act's interest in preventing confusion. Recognizing this disparity, the *Stouffer* court set out to curtail the defendant's liberty by introducing motive as an additional component in a new six-prong test.¹¹¹ Borrowing elements from the *Rogers* test and the likelihood-of-confusion test, the *Stouffer* test sought to infuse key factors from each to debut a new and improved standard. Nevertheless, the court still failed to perfect the test, as decisions seem to depend on the weight awarded to each prong in relation to the others, among other issues.¹¹² The *Stouffer* opinion is historic in opening the door to conversations about refining the *Rogers* test. The inclusion of the additional factors proposed in this commentary is needed to develop a universal framework to be used by all circuits across the country in scenarios such as *Rogers*. Through carefully selected additional elements of motive and consumer protection, the *Rogers* test will now equip courts to be able

¹⁰⁷ *Rogers*, 875 F.2d at 1006-07. Judge Griesa identified the gap left by the *Rogers* test as those cases of "flagrant deception" in which the title for the underlying work will be false but artistically relevant. *Id.*; see also *Warner Bros. Pictures Corp. v. Majestic Pictures Corp.*, 70 F.2d 310 (2d Cir. 1934); see also *Orion Pictures Co. v. Dell Publ'g Co.*, 471 F. Supp. 392 (S.D.N.Y. 1979).

¹⁰⁸ *Rogers*, 875 F.2d at 999.

¹⁰⁹ *Parks v. LaFace Recs.*, 329 F.3d 437, 447 (6th Cir. 2003).

¹¹⁰ *E.S.S. Ent. 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1100 (9th Cir. 2008); see also Nedkova, *Replacing the Rogers Test :Will an Inquiry into Non-Artistic Motive in Selecting Titles of Expressive Works Remedy the Possibility of Flagrant Deception?*, 20 *UIC Rev. Intell. Prop. L.* 429 (2021).

¹¹¹ *Stouffer II*, 460 F. Supp. 3d at 1140. Prongs five and six deal with private and public statements or actions made by the plaintiff showing non-artistic motive.

¹¹² Motion by Intell. Prop. Professors for Leave to File Brief Amicus Curiae in Support of Defendants at 10, *Stouffer v. Nat'l Geographic Partners, LLC*, ECF No. 75; motion granted, ECF No. 75 (D. Colo. Oct. 16, 2019). The six-prong *Stouffer* test focuses too much on the wrong issue; see also *Gordon*, 909 F.3d at 260.

to arrive at a better balance between First Amendment and Lanham Act rights.

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