

## Translating USPTO Case Law On Foreign-Language TMs

Authored by Davide Schiavetti for Law360

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Foreign-language trademarks can be creative, appealing and exotic, but they can carry risks. The primary risk is the application of the doctrine of foreign equivalents.

The Federal Circuit established the foreign equivalents doctrine in *Palm Bay*, in which it decided that marks composed of foreign words are to be translated into English to determine similarity in meaning and connotation with English word marks. The doctrine itself is very straightforward and leaves no room for interpretation. Its application, however, can be more challenging.

In *Palm Bay*, to avoid an unconditional application of the doctrine, the court specified that the U.S. Patent and Trademark Office has to apply the foreign equivalents doctrine only when it is likely that an American buyer will “stop and translate” the foreign term into its English equivalent. While the USPTO’s discretion in the application of the doctrine can prevent its abuse, that discretion can — at times — also create uncertainty.

Section 1207.01(b)(vi)(B) is the rule that is most open to interpretation, and creates the greatest uncertainty. The provision mandates that the doctrine apply to words or terms from “common, modern languages, which encompasses all but dead, obscure, or unusual languages.” The question then becomes: What languages qualify as obscure or unusual?

The goal of the doctrine is to extend the protection of the Lanham Act to consumers in the United States who speak other languages in addition to English, so it seems fair to exclude application for languages that are not widespread in the United States. This determination, however, is quite problematic as there are no specific standards that indicate whether a language is “common” or “modern” in the United States. Is the determination based on the number of speakers in the country? At what level of fluency does one consumer begin to be confused by a foreign equivalent?

### Key Contact

Davide F. Schiavetti

### Related Areas of Practice

Trademark Litigation

Trademark Prosecution

In July 2017 in the Field Roast Grain Meat Company case, the USPTO had to decide whether to register the mark “Chao” (Vietnamese word for fermented tofu), for “non-dairy cheese composed primarily of filtered water, coconut milk [...] and seasoned with fermented tofu.” To counter the examining attorney’s refusal based on the doctrine of foreign equivalents, the applicant claimed that “Chao” is an obscure word in an obscure language. However, the Trademark Trial and Appeal Board rejected this argument as the record contained evidence that 1.7 million people in the United States speak Vietnamese, more than Italian, French, German, Russian or Korean.

In the Joint-Stock Company Baik case, the USPTO provided more insight as to how many speakers are considered a sufficient portion of the market to warrant application of the doctrine. Here, the applicant sought registration of the mark “Baikalskaya” for vodka. The examining attorney issued a refusal based on the fact that the term was geographically descriptive as it signifies “from Baikal” in Russian. In support of its position, the examining attorney provided evidence from the CNN website and LexisNexis database that there exist 706,000 Russian speakers in the United States. The board explained that since there was no alternative meaning in the public mind, 706,000 speakers constituted a “significant portion of consumers” so that the mark could be deceptive.

In re Christopher A. Fahey, DBA Gravity Guitar Picks is a case where the board refused to apply the doctrine. The applicant was seeking registration of the mark “Sunrise” for guitar picks but the examining attorney issued a refusal based on likelihood of confusion with the mark “Pukana La,” Hawaiian for “sunrise.” The board acknowledged that Hawaiian classifies as a modern language because of its current significance to the Hawaiian people and revival over the past several decades. It did not, however, consider it common. The rationale was that the record showed 25,000 active speakers, including people living in the U.S. mainland. As a result, the Hawaiian language did not meet the “common” requirement for the application of the foreign equivalents doctrine and the marks were considered sufficiently dissimilar to avert likelihood of confusion.

Ascertaining the number of speakers of a specific language can be difficult, and so is determining whether a language is modern or common only based on such figure. In multiple decisions, the board has noted that the primary language spoken at home is no indication of the percentage of consumers who know a particular language — as individuals may choose to speak English at home but still be fluent in a different language. In doing so, the board indicated additional types of evidence that can support a finding that the doctrine of foreign equivalents is applicable to a specific language.

For instance, in the S Squared Ventures LLC case, the board accepted the examining attorney’s evidence consisting of educational programs, religious and cultural organizations and broadcasting media in Swahili to prove that the doctrine of foreign equivalents applies to Swahili words. The evidence included a list of classes and programs offered in major universities across the country, as well as radio and streaming programs catered to either native Swahili speakers or people willing to familiarize with the language. As a result, the board denied registration of the mark “Uhai” (Swahili for “life”) for hair care products for likelihood of confusion with the mark “Life For Hair” for identical goods.

In conclusion, it appears that the main criterion used by the board in determining the application of the doctrine of foreign equivalents is still the number of speakers of a given language in the prospective marketplace where the marks will be utilized. Based on the case law, it seems that a significant portion of consumers in the United States is a number between a minimum of 25,000 and maximum of 706,000. However, in light of the above, it is possible that additional evidence — i.e. educational, cultural and radio programs — indicating the pervasiveness of a language in the marketplace could support an examining attorney's refusal based on the doctrine of foreign equivalents. In more cases than not, the doctrine of foreign equivalents applies, and applicants should take this into account when deciding to file a foreign-language trademark, for instance by conducting appropriate pre-filing availability searches.

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