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TOMATO, TAMATIE?
REVISING THE DOCTRINE OF FOREIGN EQUIVALENTS
IN AMERICAN TRADEMARK LAW

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The growing specter of globalization impacts industries from communication to transportation, resulting in an unparalleled proliferation of cultural diffusion unmatched throughout history. Naturally, this cultural diffusion has familiarized American consumers with foreign brands and foreign languages despite the obvious English dominance domestically, resulting in a trademark quagmire. Under the current American doctrine of foreign equivalents, trademark examiners and courts translate non-English words into English to determine whether they meet the general United States Patent & Trademark Office (USPTO) registration requirements. However, by treating English and non-English words alike, the pool of source-identifying marks is unnecessarily restricted. This note argues that a clear rule-like form that relaxes restrictions of registering descriptive foreign language marks through offering ‘descriptive’ foreign-language a presumption of eligibility for protection would mitigate inconsistent application of the doctrine. Such a rule would also limit costs on consumers and producers that are caused by restricting the range of available marks and inhibiting creative and communicative branding.

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INTRODUCTION.....	312
I. TRADEMARK FOUNDATIONS AND THE ROLE OF THE DOCTRINE OF FOREIGN EQUIVALENTS	313
A. <i>Locating the Origins and Sources of Trademark Law</i>	314
1. <i>From Consumer Protection to Brand Protection: Understanding the Goals and Justifications for Contemporary Trademark Law</i>	315
i. Consumer Protection as the Historical Basis for Trademark Protection	315
ii. Protecting the Valuable Goodwill and Communicative Branding Abilities of Mark Holders	316
2. <i>Optional, but Essential: The Value of Trademark Registration</i>	320
i. Distinctiveness as the Principal Requirement.....	320
ii. Use and the Geographic Scope of Protection	321
B. <i>Explaining the Doctrine of Foreign Equivalents</i>	322
1. <i>The Doctrine's Elements</i>	322
2. <i>Justifications for the Doctrine: Domestic Competition and International Comity</i>	324
II. ISSUES WITH THE CURRENT STATE OF THE DOCTRINE	325
A. <i>Inconsistent Application Based on Disparate Judicial Intuitions</i>	325
B. <i>Mismanaging the Relationship Between Information Gains Consumer Confusion</i>	328
1. <i>Information vs. Confusion: Determining the Proper Relationship</i>	329
2. <i>The American Marketplace and Overprotection of Consumers</i>	330
C. <i>Inhibition of Imagination and Communicative Branding</i>	332
III. REEVALUATING THE DOCTRINE AND PROPOSING SOLUTIONS	337
A. <i>A Rule is Preferable to the Current Guideline</i>	338
1. <i>Benefits of Adopting a Foreign Equivalents Rule</i>	339
2. <i>Features of the Proposed Rule: Standardizing Translation Methods and Adopting a Confusion Threshold</i>	339
B. <i>Permitting Registration of Foreign Descriptive Terms</i>	342
1. <i>Informational and Branding Advantages from Protecting Descriptive Foreign-Language Marks</i>	342
2. <i>Precedent for Protecting Descriptive Foreign-Language Marks</i>	344
C. <i>Applying the Proposed Rule: "DELICIOSA" Versus "NÓSTIMA"</i>	346
D. <i>Addressing Competition Concerns through Descriptive Fair Use and Reexamination</i>	347
CONCLUSION	349

INTRODUCTION

International trade has grown tremendously over the last thirty years due to significant decreases in communication and transportation costs,¹ and with such growth the impact of effective brand and trademark protection has increased correspondingly. Trademarks move across national borders as they never have before, reaching new populations of diverse and multilingual consumers.² Although English remains the dominant language in the United States, American consumers are growing more familiar with foreign brands and foreign languages.³ Accordingly, American trademark law, which addresses foreign language trademarks under the doctrine of foreign equivalents, must critically assess its foundational objectives and its means for achieving them in today's complex marketplace.

Under the American doctrine of foreign equivalents, trademark examiners and courts translate non-English words into English to determine whether they meet the general United States Patent & Trademark Office (USPTO) registration requirements. The doctrine aims to provide a guideline for the registration of foreign words in a country where the vast majority of consumers exclusively speak English, but twenty-one percent of the population speaks a language other than English in the home.⁴ However, as commentators have noted, the precarious "guideline" nature of the doctrine has occasioned unequal application of the law and disparate results.⁵ When the doctrine *is* applied, it treats foreign words exactly the same as English words in assessing their distinctiveness and their likelihood of causing consumer confusion. By treating English and non-English words alike, however, those applying the doctrine often excessively restrict the pool of source-identifying marks and waste creative branding opportunities.

This note will argue that the doctrine of foreign equivalents requires a clearer, rule-like form and a reformed substance. A rule-like form, as opposed to the doctrine's current form as a guideline, would mitigate inconsistent application of the doctrine. Moreover, relaxing the restrictions on registering certain descriptive

¹ See generally WORLD TRADE ORGANIZATION, WORLD TRADE REPORT (2015), available at https://www.wto.org/english/res_e/booksp_e/world_trade_report15_e.pdf.

² See CAMILLE RYAN, U.S. CENSUS BUREAU, LANGUAGE USE IN THE UNITED STATES: 2011, at 1 (2013).

³ *Id.* at 2.

⁴ *Id.*

⁵ See generally Elizabeth J. Rest, *Lost in Translation: A Critical Examination of Conflicting Decisions Applying the Doctrine of Foreign Equivalents*, 96 TRADEMARK REP. 1211 (2006).

foreign-language marks would allow consumers to recognize informational gains and mark holders to establish communicative branding strategies.

Part I of this note will examine American trademark law's general purposes and the scope of the trademark holder's rights. This section will then proceed to place the doctrine's treatment of foreign-language marks within trademark law's broader framework. Part II explains how and why examiners and courts apply the doctrine both inconsistently and in a manner that fails to assess properly what information consumers are losing or gaining through foreign-language marks. This part concludes that the doctrine imposes costs on consumers and producers by restricting the range of available marks, thereby inhibiting creative and communicative branding.

Part III outlines how Congress or the courts should adapt the doctrine to increase the consistency and predictability of its application as well as the substantive benefits for the marketplace. Specifically, this part advocates that 'descriptive' foreign-language marks gain a presumption of eligibility for protection.⁶ This section justifies the presumption by assessing the advantages to both consumers and producers and showing how many marks with descriptive features or elements already gain registration in the United States. Recent foreign precedent from both the European Court of Justice and the Australian High Court enhance the viability of the proposal.

I

TRADEMARK FOUNDATIONS AND THE ROLE OF THE DOCTRINE OF FOREIGN EQUIVALENTS

This section aims to provide the reader with an understanding of how the doctrine of foreign equivalents functions within American trademark law. After identifying the bases for trademark protection and describing the Lanham Act's registration requirements, this section will offer the rationales and general vision of the doctrine of foreign equivalents using case law and the USPTO's Trademark Manual of Examining Procedure (TMPEP).

⁶ Descriptive marks refer to one or more features of the products to which they are attached, and typically are ineligible for trademark protection unless they have acquired a "secondary meaning" to consumers. *See infra* Part I.A.ii.a.

A. *Locating the Origins and Sources of Trademark Law*

Unlike patents and copyrights, trademarks do not have a specific constitutional basis for protection in the United States.⁷ Rather, trademarks derive their status as protectable intellectual property from common law and the Lanham Act.⁸ In its earliest trademark case, the United States Supreme Court explicitly distinguished trademarks from patents and copyrights: “the ordinary trade-mark has no necessary relation to invention or discovery The trade-mark may be, and generally is, the adoption of something already in existence as the distinctive symbol of the party using it.”⁹ From their birth, trademarks held a different status than other intellectual property. Rather than protecting creation of an artistic or scientific work, trademarks were “useful and valuable aid[s] or instrument[s] of commerce.”¹⁰

The Lanham Act, passed in 1946, marked a new era for trademarks while continuing to emphasize the commerce facilitation aspect of protection found in the common law. The Lanham Act defines a trademark as

any word, name, symbol, or device, or any combination thereof used by a person, or which a person has a bona fide intention to use in commerce and applies to register on the principal register . . . to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.¹¹

Several elements of this definition require definition and explanation to understand the doctrine of foreign equivalents: namely, “use,” “register,” and “indicate the source.” “Use” and “register” relate to the creation and perfection of trademark rights, while source identification pertains to the essence, or purpose, of trademark protection. We begin with the latter.

⁷ The Constitution grants Congress the power “[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.” U.S. CONST. art. I, § 8, cl. 8. In the seminal *Trade-Mark Cases*, the U.S. Supreme Court held that trademarks do not fall under this clause’s umbrella. *In re Trade-Mark Cases*, 100 U.S. 82, 93–94 (1879).

⁸ 15 U.S.C. § 1051 et seq. (2013).

⁹ *Trade-Mark Cases*, 100 U.S. at 94.

¹⁰ *Id.* at 95.

¹¹ 15 U.S.C. § 1127.

1. From Consumer Protection to Brand Protection: Understanding the Goals and Justifications for Contemporary Trademark Law

To identify the basis or bases for trademark protection, it is essential to begin with the historical emphasis on consumer protection through source identification. However, the twenty-first century observer must also consider the significance of goodwill and ‘branding’ to fully understand the foundation for trademark protection in the contemporary marketplace.

i. Consumer Protection as the Historical Basis for Trademark Protection

The most prevalent trademark protection rationale is the desire to guard against consumer confusion by assisting consumers in identifying a product’s source.¹² Recall that the Lanham Act’s definition of a trademark refers to a mark’s ability to “identify” and “distinguish” one firm’s product or service from those of others.¹³ In this sense, trademarks function as tools (source identifiers) that reduce information costs in a competitive marketplace. Thus, the source identification function is consumer-based and enhances competition.¹⁴ The consumer-protection philosophy dominates American trademark law and is, for instance, the impetus behind the trademark infringement cause of action.¹⁵ Note that although it is mark holders, and not consumers, that bring infringement actions, the legal end of such lawsuits is to abate harms to consumers.¹⁶ This requirement that mark holders frame the harm in an infringement suit as one to their consumers underscores the traditional understanding of trademarks as pro-competitive, consumer-protecting tools rather than proprietary assets of mark holders.¹⁷

¹² *See id.*

¹³ *Id.*

¹⁴ *See* Smith v. Chanel, Inc., 402 F.2d 562, 566 (9th Cir. 1968) (“Without some such method of product identification, informed consumer choice, and hence meaningful competition in quality, could not exist.”); William M. Landes & Richard A. Posner, *The Economics of Trademark Law*, 78 TRADEMARK REP. 267, 271 (1988).

¹⁵ *See* 15 U.S.C. § 1114(1)(a).

¹⁶ Vincent Chiappetta, *Trademarks: More Than Meets the Eye*, 2003 U. ILL. J.L. TECH. & POL’Y 35, 43 (2003).

¹⁷ The conception of trademarks as “tools” rather than “property rights in gross” distinguishes trademarks from other forms of intellectual property. *See, e.g.,* Deven R. Desai, *From Trademarks to Brands*, 64 FLA. L. REV. 981, 1011–12 (2012).

ii. Protecting the Valuable Goodwill and Communicative Branding Abilities of Mark Holders

In today's marketplace, trademarks also serve two significant functions beyond consumer protection through source identification.¹⁸ Although consumer protection remains the dominant foundation for trademark law, these alternative justifications highlight the economic significance of branding for mark holders, as well as the ability of marks to communicate to consumers the values or characteristics of an individual product or the firm that produces the product.

First, trademarks embody the mark holder's goodwill and contribute to a brand's value in a manner that results in trademarks being perceived more as rights in gross than merely pro-competitive tools.¹⁹ To understand this position, one must distinguish and understand the relationship between trademarks and brands. Though the law does not define the term "brand," a fair definition is an exclusive identity that a firm creates through marketing its products or services and garnering goodwill – for example, a reputation for quality, value, or even prestige.²⁰ Trademarks encapsulate, and present to the marketplace, the goodwill that a brand generates. This goodwill, though intangible, is a highly valuable asset.²¹ Indeed, if goodwill were readily quantifiable, it would represent a large proportion of many firms' overall value – in some instances, eighty percent or more.²² Therefore, one alternative justification for trademark protection holds that consumers purchase products or services in part or in whole because of their trademarks, and that

¹⁸ See, e.g., Andrew Griffiths, *Quality in European Trade Mark Law*, 11 NW. J. TECH. & INTELL. PROP. 621, 627 (2013) ("Trade marks. . . provide the means whereby undertakings can cultivate an image and other associations for their products in advertising and other promotional activity. This role goes beyond providing reassurance about the quality of the marked products, to a more active role of conferring intangible quality onto the products or even forming part of their overall quality.").

¹⁹ Lisa H. Johnston, *Drifting Toward Trademark Rights in Gross*, 85 TRADEMARK REP. 19, 22 (1995) ("Despite the well-established principle that trademarks exist only in connection with the good will of a business, trademark and unfair competition law has drifted toward a recognition of trademark rights in gross.").

²⁰ Andrew Griffiths, *Brands, Firms, and Competition*, in BRANDS, COMPETITION LAW AND IP 241 (Deven R. Desai et al. eds., 2015).

²¹ *Id.* at 246.

²² Irina D. Manta, *Privatizing Trademarks*, 51 ARIZ. L. REV. 381, 389–90 (2009) ("In 1988, for example, Kraft, which owns trademarks such as Kraft cheese, Miracle Whip, and Breyers ice cream, was purchased for a total of \$12.9 billion, a sum worth four times Kraft's tangible assets. Similarly, the impressive growth of Starbucks's revenues from \$975 million to over \$2.6 billion in only four years has been attributed to the company's strong brand name Trademarks are therefore obviously extremely valuable assets in their own right.").

trademarks encapsulate highly significant value for firms. Indeed, some contend that even more than symbolizing the goodwill, trademarks *become* part of a particular product's goodwill.²³ For this reason, trademarks deserve and require protection for purposes beyond their consumer protection function. As one scholar argues, "Trademark law continues to face business realities that see the brand as valuable in and of itself and as a way to engage in a range of business activities."²⁴ Contemporary trademarks' branding functions highlight the increasingly prevalent conception of trademarks as evolving from consumer protection tools into property rights in gross.

Second, trademarks communicate characteristics about the products and brands to which they are attached.²⁵ Ironically, the communicative function was an original purpose of trademarks before the source identification function superseded it.²⁶ Trademarks' communication to consumers may be direct or indirect. Generally, trademarks that directly communicate information about their accompanying products cannot gain registration without an additional showing of a source-identifying function.²⁷ Nevertheless, businesses seek to adorn their products with terms as descriptive as possible because there is value in the "richness of evocation that inferably descriptive expressions allow."²⁸ Other trademarks communicate aspects of their accompanying products indirectly. "JAGUAR," for example, does

²³ Frank I. Schechter, *The Rational Basis of Trademark Protection*, 40 HARV. L. REV. 813, 818 (1927) ("To describe a trademark merely as a symbol of good will, without recognizing in it an agency for the actual creation and perpetuation of good will, ignores the most potent aspect of the nature of a trademark and that phase most in need of protection.").

²⁴ Desai, *supra* note 17, at 1019. Note, however, that not everyone sees this a desirable shift. *E.g.*, Johnston, *supra* note 19, at 53 ("According trademark rights in gross would stifle competition — the very premise upon which capitalism is based — and create monopolistic enterprises.").

²⁵ Sonia K. Katyal, *Cosmopolitanism and the Transnational Trademark*, in *THE LUXURY ECONOMY AND INTELLECTUAL PROPERTY: CRITICAL REFLECTIONS* 309, 316 (Haochen Sun et al. eds. 2015) ("Trademarks, today, are less about identifications of origin; instead, their earlier function has been surpassed by their growing role as 'messengers' that convey a broad range of information to the public about the product, the company, the people behind the company, and the attributes of each."); Chiappetta, *supra* note 16, at 45 ("At its most basic level, a brand carries the assurance of product-specific 'experiential' characteristic consistency — qualities such as freshness, energy efficiency, low maintenance, or enjoyable taste.").

²⁶ Chiappetta, *supra* note 16, at 44.

²⁷ These marks are termed "descriptive." *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4 (2d Cir. 1976); see *infra* Part I.A.2.i.

²⁸ Alan Durant, *How Can I Tell the Trade Mark on a Piece of Gingerbread from All the Other Marks on It? Naming and Meaning in Verbal Trademark Signs*, in *TRADE MARKS AND BRANDS: AN INTERDISCIPLINARY CRITIQUE* 107, 129 (Bently et al. eds. 2008).

not directly describe anything about the luxury automobile to which it is attached; however, it certainly conveys to consumers that the car is fast and powerful.²⁹

Whether and how trademark law should recognize these alternative trademark functions is controversial.³⁰ American trademark law has not explicitly acknowledged a proprietary interest in trademark rights (unlike some European trademark law)³¹ and at times has strongly resisted fuller recognition of goodwill as a property right in gross. The naked licensing doctrine, for example, holds that a mark holder abandons (i.e., forfeits its right to) its registered, protected mark if the mark holder licenses the mark without maintaining quality control over the licensee's products.³² Nevertheless, trademark law has demonstrated openness to the expansion of trademark rights through the birth of the dilution cause of action codified in U.S.C. § 1125(c) and the evolution of trademark licensing.

Dilution, for instance, is fueled by mark holder protection rather than consumer protection.³³ Dilution takes two forms: blurring and tarnishment.³⁴ Blurring occurs when a defendant's mark, though not confusing as to source, still interrupts the nexus between the plaintiff's mark and the plaintiff's product.³⁵ The

²⁹ ADRIAN ROOM, *NTC'S DICTIONARY OF TRADE NAME ORIGINS* 98 (1990). In many cases, such marks are deemed "suggestive" and worthy of protection. *Abercrombie*, 537 F.2d, at 10–11.

³⁰ Compare Mark A. Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 *YALE L.J.* 1687, 1713–14 (1999) (arguing against expansion and proprietization of trademark law as impinging on free speech) with Schechter, *supra* note 23, at 813, 823–26 (arguing for broader scope of trademark causes of action). See also Alex Kozinsky, *Trademarks Unplugged*, 68 *N.Y.U. L. REV.* 960 (1993) (weighing the moral, utilitarian, and free expression implications of expanded trademark rights).

³¹ See, e.g., Loi n° 64-1360 du 31 décembre 1964 sur les marques de fabrique, de commerce ou de service (Fr.) ("La propriété de la marque s'acquiert par le premier dépôt, valablement effectué conformément aux dispositions de la présente loi et des décrets pris pour son application, qui déterminent les modalités et conditions du dit dépôt, ainsi que les actes ou paiements de taxes qui en perpétuent l'existence.").

³² See, e.g., *Barcamerica Int'l USA Trust v. Tyfield Imps., Inc.*, 289 F.3d 589, 592 (9th Cir. 2002).

³³ See, e.g., *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 429 (2003) ("Unlike traditional infringement law, the prohibitions against trademark dilution are not the product of common-law development, and are not motivated by an interest in protecting consumers.").

³⁴ 15 U.S.C. § 1125(c).

³⁵ For example, the Ninth Circuit held that 'eVisa,' a "multilingual education and information business," blurred Visa International's mark for credit cards. Visa International already had gained an association between its products and services and the "VISA" mark, and eVisa's mark would cause harm to Visa International because it would disrupt the association between product and mark in consumers' minds. *Visa Int'l Serv. Ass'n v. JSL Corp.*, 610 F.3d 1088, 1090–91 (9th Cir. 2010).

dilution by tarnishment cause of action further suggests a proprietary status of trademarks in the United States, protecting mark holders' goodwill from undesirable associations in the marketplace.³⁶ Tarnishment occurs when a defendant's product somehow reduces or deteriorates the reputation of another's mark.³⁷

Like the dilution cause of action, the evolution of trademark licensing supports the notion that trademarks contain a proprietary element in the contemporary marketplace. Common law and statutory law initially prohibited licensing because many viewed licensing as violating a mark's source identification function.³⁸ That is, the licensed mark failed to function as a source identifier if the producer of the trademarked good was not the trademark owner.³⁹ However, the Lanham Act changed the landscape of trademark licensing in the United States.⁴⁰ Although the law has maintained elements of the source-identification function through requirements of quality control and use "as [not] to deceive the public," licensing's primary advantage—and arguably the reason for its inception—is the capitalization of goodwill and the intrinsic value of trademarks.⁴¹

Together, dilution and licensing indicate that American trademark law has taken a step beyond merely consumer protection via source identification. Dilution focuses on harms to mark holders, while licensing opens a market in the goodwill of certain brands. Ultimately, this note recommends that trademark law should continue to recognize its consumer-protection function, but afford greater recognition to these alternative bases for trademark protection.⁴² Part II will establish the reasons for such an expansion.

³⁶ 15 U.S.C. § 1125(c)(2)(C).

³⁷ *E.g.*, *V Secret Catalogue, Inc. v. Moseley*, 558 F. Supp. 2d 734, 750 (W.D. Ky. 2008) *aff'd*, 605 F.3d 382 (6th Cir. 2010) (finding that an adult video and novelty store operating under the name "Victor's Little Secret" was likely to tarnish the "VICTORIA'S SECRET" mark).

³⁸ Neil Wilkof, *Trademark Licensing: The Once and Future Narrative*, 104 TRADEMARK REP. 895, 898 (2014) (citing *Bowden Wire v. Bowden Brake*, [1914] R.P.C. 385 (Eng.)).

³⁹ *Id.*

⁴⁰ 15 U.S.C. § 1055; Irene Calboli, *The Sunset of "Quality Control" in Trademark Licensing*, 57 AM. U. L. REV. 341, 354 (2007) (suggesting that changes in manufacturing and distribution in the early twentieth century spawned the opportunity for legitimate licensing practices).

⁴¹ *See* Wilkof, *supra* note 38, at 915.

⁴² *But see* Sandra L. Rierson, *The Myth and Reality of Dilution*, 11 DUKE L. & TECH. REV. 212, 214 (2012) ("[T]he federal dilution statute turns competition on its head and serves to entrench and further concentrate economic power in the hands of dominant corporate firms at the expense of consumers and competitors alike. Dilution law should be repealed or, at the very least, reformed.").

2. *Optional, but Essential: The Value of Trademark Registration*

The Lanham Act establishes the means by which an entity gains rights in a mark. Firms and individuals may gain common law protection for their marks through “use in commerce.”⁴³ Registration on the USPTO’s Federal Register, though not necessary to gain rights in a mark, provides additional benefits to those interested in expanding their brands: a legal presumption to use the mark nationwide, a presumption that the mark is distinctive, public notice of the mark holder’s claim of ownership, the ability to use the ‘®’ federal registration symbol, and a basis for obtaining protection in foreign countries under the Madrid Agreement.⁴⁴ Registration requires that the mark be “distinctive” and used in commerce.⁴⁵

i. Distinctiveness as the Principal Requirement

In keeping with the original source identification function of trademarks, a mark must distinguish one good’s source from the sources of other goods in the market. That is, it must be “distinctive.”⁴⁶ A seminal 1976 Second Circuit case, *Abercrombie & Fitch Co. v. Hunting World, Inc.*,⁴⁷ generated trademark law’s metric of distinctiveness for word marks.⁴⁸ According to *Abercrombie* there are five categories of distinctiveness: fanciful, arbitrary, suggestive, descriptive, and generic.⁴⁹ Fanciful, arbitrary, and suggestive marks are the strongest on the spectrum.⁵⁰ These three categories of marks are “inherently distinctive” because consumers will readily identify marks such as “Kodak” (fanciful), “Apple Computers” (arbitrary), and “Greyhound” (suggestive) as indicative of the products’ sources.⁵¹ Descriptive marks describe a characteristic of the product on which the mark is placed, such as “Bran-Nut” for cereal containing bran and walnuts. Because they lack inherent distinctiveness, descriptive marks may be registered only with a showing of “secondary meaning.”⁵² That is, they may gain protection only if the

⁴³ 15 U.S.C. § 1127.

⁴⁴ U.S. PATENT & TRADEMARK OFFICE, PROTECTING YOUR TRADEMARK: ENHANCING YOUR RIGHTS THROUGH FEDERAL REGISTRATION (2014), available at <http://www.uspto.gov/sites/default/files/trademarks/basics/BasicFacts.pdf>.

⁴⁵ *Id.*

⁴⁶ See 15 U.S.C. § 1052(f).

⁴⁷ 537 F.2d 4 (2d Cir. 1976).

⁴⁸ *Id.*

⁴⁹ *Id.* at 9.

⁵⁰ *Id.* Fanciful marks are “words invented solely for their use as trademarks.” *Id.* at 11 n.12. Arbitrary marks involve the uncommon use of a word or phrase. *Id.*

⁵¹ See *id.*

⁵² 15 U.S.C. § 1052(f); *Abercrombie*, 537 F.2d.at 9.

consuming public attaches source-identifying significance to them.⁵³ Finally, generic marks, such as “chocolate,” describe a genus of goods, and can never be protected because protection would preclude competitors from using the word on their products.⁵⁴ Granting one firm or individual the exclusive use of a generic word would undoubtedly inhibit competition: competitors would be unable to use words that are necessary to describe their products, consequently limiting vital consumer information and causing consumer confusion.⁵⁵

Understanding the relevant consumer market is vital to determining whether a mark is distinctive, for one must appreciate the general vocabulary of the marketplace to understand a word’s significance to that marketplace.⁵⁶ Differences across linguistic populations mean that a mark that is inherently distinctive in one territory is not necessarily so in another territory.⁵⁷ For example, the mark “GREENGROCER” can be generic in the United Kingdom but inherently distinctive in the United States.⁵⁸ The significance of this point is that the relevant consumers for marks gaining protection in the USPTO must be consumers in the American market for a particular product.⁵⁹ Trademark examiners and judges must assess distinctiveness with the American purchasing public in mind.⁶⁰

ii. Use and the Geographic Scope of Protection

Since the passage of the Trademark Law Revision Act in 1988 and its subsequent revisions, satisfying the second registration requirement, “use in commerce,” is rarely an issue.⁶¹ A registrant must demonstrate actual use of the mark

⁵³ An example of a descriptive term that has acquired secondary meaning is “Best Buy.”

⁵⁴ *Abercrombie*, 537 F.2d at 9.

⁵⁵ *Id.* (“[N]o matter how much money and effort the user of a generic term has poured into promoting the sale of its merchandise and what success it has achieved in securing public identification, it cannot deprive competing manufacturers of the product of the right to call an article by its name.”).

⁵⁶ See Jake Linford, *A Linguistic Justification for Protecting “Generic” Trademarks*, 17 YALE J. L. & TECH. 110, 163 (2015).

⁵⁷ *Abercrombie*, 537 F.2d at 9.

⁵⁸ *Carcione v. Greengrocer, Inc.*, No. S-78-561, 1979 WL 25110, at *1 (E.D. Cal. Oct. 12, 1979).

⁵⁹ Rest, *supra* note 5, at 1244.

⁶⁰ *Id.*

⁶¹ 15 U.S.C. §§ 1051–1128 (1988). However, modern computer technology has raised questions about defining “use in commerce.” *E.g.*, *Rescuecom Corp. v. Google Inc.*, 562 F.3d 123 (2d Cir. 2009) (finding Google’s suggestion of competitors’ trademarks as search terms for advertisers constituted “use in commerce” under the Lanham Act).

in commerce, or offer a bona fide intent to use the mark in commerce.⁶² The use requirement also has significant implications even *after* a mark gains registration because even if a mark holder gains nationwide priority with registration in the PTO, he must show actual use when seeking an injunction to suppress another's use of the mark in a particular location.⁶³ Thus, the mark holder's radius of use defines the geographic scope of the trademark rights even after the time of registration.⁶⁴ Ultimately, distinctiveness is the primary registration concern for registrants of foreign-language marks, but one should be aware that the use in commerce requirement always remains.

B. Explaining the Doctrine of Foreign Equivalents

Consider now a hypothetical. A young entrepreneur decides to bottle his family's tomato sauce and sell it under the mark "FRUTTO DELLA TERRA." If the entrepreneur submits a registration application, the question arises: how ought an examiner or a court of review determine whether "FRUTTO DELLA TERRA" is eligible for protection? Alternatively, if the mark gains registration, what happens if a competitor using the mark "FRUIT OF THE EARTH" for tomato sauce brings a trademark infringement suit under Section 43(a) of the Lanham Act?

1. The Doctrine's Elements

Using the doctrine of foreign equivalents, examiners and courts translate non-English words into English to determine their place on the *Abercrombie* spectrum (i.e., whether they are fanciful, arbitrary, suggestive, descriptive, or generic) and consequently, whether they are eligible for registration. Likewise, in infringement cases, courts translate the word to see if it is likely to cause confusion with an existing English-language mark (or vice versa, if a foreign-language mark is registered and another firm seeks to register an English-language mark).

Courts and the TMEP have made clear that the doctrine is not a rule, but rather a "guideline" to help determine whether a mark is registrable.⁶⁵ The fact that the doctrine is a guideline, rather than a rule, means there is no strict procedure for its application. Rather, trademark examiners and judges have discretion to choose

⁶² 15 U.S.C. § 1051(b) (1988).

⁶³ *E.g.*, *Dawn Donut Co. v. Hart's Food Stores, Inc.*, 267 F.2d 358, 364 (2d Cir. 1959) (holding that the senior user of a mark could not enjoin the junior user from using "Dawn" for donuts until it could show that it was expanding into the junior user's market, even though the senior user had nationwide rights).

⁶⁴ *Id.*

⁶⁵ TMEP §§ 1209.03(g), 1210.10, 1211.01(a)(vii) (Jan. 2017).

whether to employ the doctrine at all, and then have fairly wide latitude to determine whether the foreign-language mark is distinctive.

In applying this guideline, examiners and courts are tasked with considering how American consumers understand non-English trademarks in the marketplace. The doctrine is meant to apply only to words from “common” foreign languages.⁶⁶ “Common” languages include Spanish, Italian, Russian, and Yiddish.⁶⁷ By contrast, the doctrine does not apply to dead or obscure languages such as Latin.⁶⁸ If the doctrine acts as a proxy for determining whether consumers would find the foreign-language mark inherently distinctive or not, then the rationale for the common language requirement seems apparent: the more consumers that speak the language, the greater the probability that the consuming public will understand the meaning of the foreign-language mark in its original form. The Federal Circuit has stated that the doctrine “should be applied only when it is likely that the ordinary American purchaser would stop and translate the foreign word into its English equivalent.”⁶⁹ Thus, examiners and courts should translate foreign-word marks as if they were consumers purchasing the product to which the mark is affixed.

If, upon translation, the TTAB or court finds that the mark is generic or merely descriptive in the foreign language, then the mark is ineligible for registration. In other words, if the word is from a “common” language, the “ordinary American consumer” would translate the word, and if the word would not be inherently distinctive of source in the foreign language, then it cannot enter the Federal Register.⁷⁰ Likewise, if the TTAB or court finds that the ordinary American consumer is likely to confuse the foreign-language mark with a registered English-language mark, the foreign-language mark is ineligible for protection.⁷¹

Return now to the “FRUTTO DELLA TERRA” tomato sauce example. Were an examiner to receive an application for this trademark, she would have to determine whether to apply the doctrine of foreign equivalents. Upon realizing that

⁶⁶ *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1377 (Fed. Cir. 2005); TMEP § 1209.03(g) (Jan. 2017).

⁶⁷ 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:34 (4th ed. 2017). Others include French, German, Chinese, Japanese, Polish, Hungarian, and Serbian.

⁶⁸ TMEP § 1209.03(g) (Jan. 2017).

⁶⁹ *Id.*; *Palm Bay Imports*, 396 F.3d at 1377.

⁷⁰ Note, however, that the “ordinary consumer” has assumed a multitude of meanings over time, making this part of the definition quite murky. Rest, *supra* note 5, at 1235. See *infra*, Part II.A.

⁷¹ *E.g.*, *In re Ithaca Indus.*, 230 U.S.P.Q. 702 (T.T.A.B. 1986) (refusing registration of “LUPO” mark due to confusing similarity with a previously registered “WOLF” mark.).

the mark does not employ English words, she would next determine whether the doctrine should apply to Italian words. Based on the number of consumers in the market that understand Italian and English, is the language common or obscure?⁷² If it is a common language, then the examiner must determine who the ordinary consumer is, and whether he would be likely to “stop and translate” the mark into English.⁷³ Finally, the examiner would have to determine whether the English translation is distinctive according to the *Abercrombie* spectrum, and whether it is confusingly similar to any other registered marks. In other words, the examiner must decide whether “FRUTTO DELLA TERRA” is confusingly similar in sight, sound, or meaning to another registered mark, e.g., “EARTH’S FRUIT.”⁷⁴ One can see that the doctrine, while perhaps not overly complex, is flexible and affords examiners a fair amount of discretion in determining whether a mark is eligible for protection.

2. *Justifications for the Doctrine: Domestic Competition and International Comity*

The stated rationales for the doctrine are twofold.⁷⁵ First is the promotion of domestic competition in a diverse contemporary American marketplace. The Second Circuit explained that barring non-inherently-distinctive foreign-language marks from registration

[R]ests on the assumption that there are (or someday will be) customers in the United States who speak that foreign language. . . . [C]ommerce in the United States utilizes innumerable foreign languages. 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.⁷⁶

The court’s rationale, unsurprisingly, is consumer-oriented. It emphasizes the source identification function in its concern that non-English speakers who are in the United States, either permanently or temporarily, will be harmed by generic, descriptive, or otherwise confusing foreign-language trademark uses.⁷⁷ The second rationale for the doctrine rests on a notion of international comity; namely, that there

⁷² MCCARTHY, *supra* note 67, at § 11:34.

⁷³ TMEP § 1209.03(g) (Oct. 2015). However, note that the relevant purchasing public is one of the inconsistencies noted in Part II, *infra*.

⁷⁴ For the factors used to determine whether there is a likelihood of confusion, see *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973).

⁷⁵ Sujata Chaudhri, *Trademark Doctrine of Foreign Equivalents*, NYIPLA BULLETIN, Jan./Feb. 2007, at 12.

⁷⁶ *Otokoyama Co. v. Wine of Japan Imp.*, 175 F.3d 266, 270–71 (2d Cir. 1999).

⁷⁷ *See id.*

ought to be parity in the international treatment of foreign-language marks. Because the United States has previously sought to bar foreign registration of English-language generic trademarks, “to permit registration here of terms in a foreign language which are generic for products sold in a foreign country would be inconsistent with the rationale supporting these international protests.”⁷⁸ Like the first rationale, international comity sounds in consumer protection, but on a larger geographic scale.

Thus, consumer protection lies at the heart of the two principal justifications for the doctrine of foreign equivalents. The next part will show the limits of relying on consumer protection as the foundation for the doctrine, especially when the doctrine fails to address the proper range of consumers.

II

ISSUES WITH THE CURRENT STATE OF THE DOCTRINE

Although the doctrine of foreign equivalents has applied to cases for many years, legitimate questions of its continued usefulness and application have grown over the past decade.⁷⁹ This section reveals the inconsistencies between various applications of the doctrine of foreign equivalents and demonstrates how such inconsistencies impose costs on both producers and consumers. First, this section will describe how the “guideline” nature of the doctrine provides insufficient guidance for examiners and courts, which thereby produces uncertainty for prospective mark registrants. Next, this section will demonstrate how application of the current doctrine often overestimates the potential for consumer confusion, consequently hindering information gains to American consumers by rejecting marks that should be accepted. Finally, this section will suggest that the doctrine of foreign equivalents leaves little room for imaginative branding, thereby harming producers and reducing the range of valuable source identifiers for consumers.

A. Inconsistent Application Based on Disparate Judicial Intuitions

Because the doctrine of foreign equivalents is a guideline rather than a rule, examiners’ and judges’ discretion and disparate intuitions about the doctrine’s features result in some unpredictability in the doctrine’s application. Uncertainty, in turn, places costs on prospective mark registrants, who must guess as to how their marks will be received and how much to invest in a brand or mark that ultimately may be rejected. This is by no means to suggest that judges or examiners are poor at

⁷⁸ *In re Le Sorbet, Inc.*, 1985 T.T.A.B. LEXIS 27, at *9 (T.T.A.B. 1985).

⁷⁹ *See, e.g.*, Serge Krimnus, *The Doctrine of Foreign Equivalents at Death’s Door*, 12 N.C. J. L. & TECH. 159 (2010).

assessing trademark distinctiveness; trademark cases often rely on intuition about how the consuming public will receive a mark.⁸⁰ Rather, in the context of foreign equivalents, there are remaining ambiguities in the doctrine that could be fixed with a more consistent application procedure and definition of terms.

One of the issues arising from decision makers' discretion relates to the basic mechanics of translation. The USPTO permits consultation of a wide variety of online resources (X-search, foreign language dictionaries, "free online translation tools") or the Office's Translations Branch.⁸¹ While the purpose presumably is to provide examiners with an array of resources to gain the meaning of a specific foreign term, an unfixed pool of sources makes it unnecessarily difficult for registrants to predict how a mark will be received. Translation mechanics are complicated even further in cases involving characters outside of the Latin alphabet. Take, for example, the application for the mark, "DARK HORSE."⁸² The examiner rejected the applicant's "DARK HORSE" mark for spirits on the grounds that it was confusingly similar to "KUROUMA," which was already on the Federal Register for spirits in both the Latin and Japanese alphabets.⁸³ The TTAB reversed the examiner's decision, holding that the doctrine of foreign equivalents did not apply because there was no single and literal translation of "KUROUMA."⁸⁴ In fact, there are twelve possible interpretations depending on how one reads the Japanese characters.⁸⁵ Moreover, even once one chooses a reliable source for translation, there is no guarantee of direct equivalence between the foreign and English words.⁸⁶ Indeed, the Fifth Circuit explicitly acknowledged common ambiguities of translation and attempted to clarify its translation procedure: "The act of translation, of course, can itself be an imprecise task, as foreign words sometimes have no exact equivalent in English; therefore, courts may rely on the 'primary and common translation' in

⁸⁰ See Michael Grynberg, *The Judicial Role in Trademark Law*, 52 B.C. L. REV. 1283, 1302–18 (2011) (discussing judicial discretion in trademark cases, particularly in assessing likelihood of confusion using multifactor tests).

⁸¹ *Examination Guide 1-08*, USPTO (Apr. 23, 2008), http://www.uspto.gov/trademarks/resources/exam/examguide1_08.jsp#ftn2; TMEP § 809.01 (Oct. 2015). For example, in *In re Tokutake Indus. Co.*, 87 U.S.P.Q.2d 1697 (T.T.A.B. 2008), the T.T.A.B. permitted as evidence a translation provided by freedict.com. While such a site may suffice for the casual user, its lack of reputation for accuracy renders it unsuitable as a basis for judicial decision-making.

⁸² *In re Dark Horse Distillery, LLC*, No. 85104448, 2012 WL 4832274, at *2 (T.T.A.B. Sept. 30, 2012) (not precedential).

⁸³ *Id.* "KUROUMA" is registered for "Japanese distilled spirits of barley soju."

⁸⁴ *Id.* at *4–5.

⁸⁵ *Id.* at *4.

⁸⁶ *Cf. Enrique Bernat F., S.A. v. Guadalajara, Inc.*, 210 F.3d 439 (5th Cir. 2000) (debating the translation of the Spanish word "CHUPA" as applied to lollipops).

determining English equivalency.”⁸⁷ Of course, requiring examiners and judges to select the “primary” meaning of a word raises its own issues, especially when they are working with foreign words that are likely unfamiliar to them. Expert testimony, or even a clearer hierarchy of translation references, would ease the registration process for foreign-language marks, but has not yet gained widespread use.

Beyond the mechanics of translation, an important question of interpretation arises in regards to the doctrine’s substance. When do we know that consumers are likely (or unlikely) to “stop and translate” a particular foreign word into English? Is the implication that an examiner or court should not translate a Spanish-language mark marketed to a Portuguese-speaking population, because it is unlikely that native Portuguese speakers would translate the mark into English? As one commentator has noted, it is difficult to ascertain a meaningful likelihood of translation based on pure intuition.⁸⁸ Surveys, though “expensive and time-consuming,” would provide a more concrete determination of the likelihood of confusion.⁸⁹ The TMEP aims to clarify what it means for consumers to be likely to “stop and translate” a mark in Section 1207.01(b)(vi)(B), but merely compounds the analysis by referring to whether any given translation is “literal and direct” (in which case the ordinary consumer would be more likely to stop and translate) or ambiguous.⁹⁰ If the point of the “stop and translate” component of the doctrine is merely to determine whether the mark contains a “literal and direct” translation, it is unclear why it is necessary at all: it is merely a proxy for whether consumers will be confused. The wide discretion granted to examiners and judges consequently leads to broad conclusions lacking a basis in survey evidence or expert testimony. For example, in *Palm Bay Imports*,⁹¹ the Federal Circuit concluded, without any support or explanation, “that it is improbable that the average American purchaser would stop and translate ‘VEUVE’ into ‘widow.’”⁹² The TTAB similarly found that French-speaking American consumers would not stop and translate a mark that is “grammatically incorrect” because it wouldn’t have any meaningful translation to them, even though they would understand what the individual words in the phrase meant.⁹³

⁸⁷ *Id.* at 443.

⁸⁸ Rest, *supra* note 5, at 1233.

⁸⁹ *Id.*

⁹⁰ TMEP § 1207.01(b)(vi)(B) (Oct. 2015).

⁹¹ *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369 (Fed. Cir. 2005).

⁹² *Id.* at 1377.

⁹³ *In re Helen Trimarchi & Michael Merr*, No. 77222086, 2009 WL 1692509, at *6 (T.T.A.B. May 14, 2009).

Prospective registrants consequently experience uncertainty because of imprecise language in the guideline and unpredictable application of the doctrine. Explicit rules and procedures would offer a relatively easy solution and minimize registrants' uncertainty when approaching the USPTO.⁹⁴

B. Mismanaging the Relationship Between Information Gains and Consumer Confusion

The doctrine of foreign equivalents mismanages the balance between information gain and loss when a new mark is introduced into the marketplace. As it stands, the doctrine may force or influence the rejection of a mark that only a minor fraction of the population could interpret, and with an English equivalent that an even smaller fraction would be confused by.⁹⁵ Barring registration of marks with such low potential for confusion represents an overall informational loss to the market.⁹⁶

To understand the informational loss, one must begin with the concept of consumer protection through source identification.⁹⁷ A properly exercised trademark assists the consumer in making a purchasing decision by providing her with information as to the source or quality of the product to which it is attached.⁹⁸ Thus, the introduction of a new trademark adds to the pool of information in a given market. However, if a mark causes confusion among consumers, either because it reduces competition by removing words from the public domain or by mimicking a competitor's mark too closely, then that mark reduces the flow of information in the market. Imagine, for instance, that trademark 'X' is introduced into the market for perfume. For some portion of the marketplace, 'y' percent, the mark will distinguish the perfume's source from that of other perfumes on the shelf; these consumers gain from the ability of the mark to distinguish source. To the rest of consumers, 'z' percent,⁹⁹ the mark is so confusing that it disrupts their purchasing decision, or they buy the product marked 'X' thinking it is another product. The consumers

⁹⁴ See discussion *infra* Part III.A.

⁹⁵ Krimnus, *supra* note 79, at 159–60.

⁹⁶ *Id.* at 200 (“The doctrine may ensure that a negligible portion of the public is not confused or otherwise negatively affected by a mark, but in doing so, it harms the public at large by eliminating a valuable opportunity to distinguish goods in the marketplace through a registered trademark.”).

⁹⁷ See discussion *supra* Part I.A.

⁹⁸ See generally Landes & Posner, *supra* note 14.

⁹⁹ This assumes that the sum of 'y' and 'z' is one hundred. In other words, every consumer in the marketplace either gains or loses from the introduction of the mark, and there is no overlap between the two groups.

comprising ‘z’ percent of the population lose from the introduction of mark ‘X’ into the marketplace. Thus, every mark provides a net informational gain or net informational loss to the marketplace: when ‘y’ exceeds ‘z’, there is a net gain; when ‘z’ exceeds ‘y’, there is a net loss.

1. Information vs. Confusion: Determining the Proper Relationship

Because trademarks ought to add information to the marketplace for the purposes of limiting consumer confusion, only those marks that offer a net informational gain should earn protection. Nevertheless, trademark law typically requires, and should require, more than a simple showing of a net informational gain to offer protection to a mark. It is not desirable for the law to protect a mark that will assist fifty-five percent of the population but harm the other forty-five percent, because forty-five percent is a substantial portion of the marketplace. In the ideal marketplace, zero consumer confusion would exist because that would imply perfect information.¹⁰⁰ However, because zero confusion is extremely unlikely in any circumstance,¹⁰¹ the law must tolerate a certain threshold of consumer confusion or risk being unworkable.¹⁰² In other words, *zero* confusion is not the aim.¹⁰³

What, then, is the desirable relationship between information and confusion? For a successful trademark infringement claim, plaintiffs often must show a minimum of eleven percent confusion.¹⁰⁴ Note that this implies that the law has determined that a mark that potentially provides informational benefits to eighty-nine percent of the population still hurts the market overall. This eleven percent confusion threshold has led one commentator to argue, “In [situations where consumers face minor confusion], the likelihood of meaningful disruption to markets is low, so society will probably gain overall by tolerating minor confusion in exchange for the benefits that arise from consumers’ exposure to confusion.”¹⁰⁵ Let us assume, however, that the eighty-nine to eleven split is the proper tipping point for whether a foreign-language mark provides sufficient net benefit to the marketplace to warrant protection. Under this standard, one will find that examiners

¹⁰⁰ See William McGeeveran & Mark P. McKenna, *Confusion Isn’t Everything*, 89 NOTRE DAME L. REV. 253, 274 (2013).

¹⁰¹ See generally Alfred C. Yen, *The Constructive Role of Confusion in Trademark*, 93 N.C. L. REV. 77, 79 (2014) (arguing that a certain level of confusion in fact benefits consumers in the market because it facilitates more sophisticated purchasing decisions).

¹⁰² McGeeveran & McKenna, *supra* note 100, at 256.

¹⁰³ See *id.*

¹⁰⁴ 4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23:2 (4th ed. 2017).

¹⁰⁵ Yen, *supra* note 101, at 86–87.

and the TTAB have exercised extreme overprotection of consumers, to a point where the marketplace is harmed by the rejection of beneficial source-identifying marks.

2. *The American Marketplace and Overprotection of Consumers*

Part of the reason for the overprotective information-confusion assessments relates to inconsistencies in how those applying the doctrine perceive the relevant national marketplace. There is uncertainty regarding whether the doctrine primarily serves the current American purchasing public, a hypothetical, more linguistically-diverse American purchasing public of the future, or the international purchasing public.¹⁰⁶ The typical consequence is that trademarks found to be non-inherently-distinctive or confusingly similar to English-language marks for infinitesimal percentages of the population are not protected. For example, in *In re Savisa*, a South African corporation appealed to the TTAB to reverse a rejection of its application for the “SONOP” mark for alcoholic beverages.¹⁰⁷ The original examiner had refused registration on the grounds that “SONOP” was confusingly similar to “SUNRISE,” already registered for the same class of goods.¹⁰⁸

Applying the doctrine of foreign equivalents, the examiner found that although the “SONOP” mark applicant provided reliable evidence that less than .01 of one percent of the American population spoke Afrikaans in the home, Afrikaans met the common language requirement because other consumers may have learned Afrikaans from family or trips abroad, despite not speaking it in the home.¹⁰⁹ However, consider that even if one takes an extremely generous estimation of what that number constitutes—e.g., nine times the number of people that actually speak Afrikaans at home—still far less than one percent of the American consuming public would be familiar with the language.¹¹⁰ Moreover, the TTAB went one step further by taking into account the number of people *worldwide* that speak Afrikaans.¹¹¹ This information is irrelevant at best; at worst, it unduly influenced the board in determining whether the mark warrants protection by shifting focus away from the

¹⁰⁶ Recall the international comity rationale for the doctrine explained in Part I.B.2, *supra*.

¹⁰⁷ *In re Savisa (Pty) Ltd.*, No. 78154196, 2005 WL 548058, at *1 (T.T.A.B. Feb. 24, 2005) (not precedential).

¹⁰⁸ *Id.* at *2.

¹⁰⁹ *Id.* at *3.

¹¹⁰ *In re Savisa* is not the only case involving application of the doctrine in circumstances where an infinitesimal percentage of the population might be confused. The Board similarly refused registration of “OIVA” for cutlery on the grounds that it translates to “excellent” in Finnish and therefore was not distinctive. *In re Marimekko Oyj*, No. 85320832, 2012 WL 3224736, at *1-2 (T.T.A.B. July 10, 2012). Less than .02 of one percent of the American population speaks Finnish. CAMILLE RYAN, U.S. CENSUS BUREAU, LANGUAGE USE IN THE UNITED STATES: 2011, at 3 (2013).

¹¹¹ *In re Savisa (Pty) Ltd.*, 2005 WL 548058, at *8.

mark's source identifying potential in the actual marketplace in which "SONOP" competes to the mark's potential for causing confusion in an amorphous and undefined market.

There are also occasionally instances where marks in modestly-spoken languages fail to gain registration on the first attempt due to an overestimation of the potential for confusion, but are saved by the TTAB on appeal. In March 2014, for instance, the TTAB in *In re Dunville Peat*¹¹² reversed a refusal of registration for the mark "ÓGRA" for beauty care products.¹¹³ The mark translates to "youth" in Gaelic and was therefore originally found to be descriptive and not inherently distinctive for beauty products.¹¹⁴ In reversing the refusal to register, the TTAB suggested that there was insufficient evidence to show that Gaelic was a common language warranting translation to English.¹¹⁵ This decision properly respects the informational assessment that ought to occur during the registration process of foreign-language marks because it understands that the potential informational gains to consumers in the beauty care market vastly outweigh the possibility of confusion.

Yet even in *In re Christopher A. Fahey*, a case similar to *In re Dunville Peat* where the TTAB properly weighed the informational gains and losses, the Board revealed a temptation to stretch the relevant consumer population too far.¹¹⁶ Like *In re Savisa*, a "sunrise" mark was at issue. "PUKANA LA," the Hawaiian translation of "sunrise," was already registered as a trademark for guitar picks when a California resident attempted to register "SUNRISE" for the same class of goods.¹¹⁷ Although the examiner initially rejected the "SUNRISE" application for registration, the TTAB reversed and permitted registration because the number of Hawaiian-language speakers in the United States, approximately 25,000, did not constitute "an appreciable number of individuals sufficient to sustain a finding of a likelihood of confusion."¹¹⁸ Indeed, according to the evidence on the record, and the Census Bureau's estimate of the current United States population, only .008 of one percent

¹¹² *In re Dunville Peat & Herbal Products Ltd.*, No. 79111854, 2014 WL 1390503 (T.T.A.B. Mar. 24, 2014).

¹¹³ *Id.* at *9–10.

¹¹⁴ Although the decision was reversed and the mark was registered after appeal, such determinations impose economic and temporal costs on mark registrants. *See* discussion *supra* Part II.A.

¹¹⁵ *In re Dunville Peat & Herbal Products Ltd.*, 2014 WL 1390503, at *9–10.

¹¹⁶ *In re Christopher A. Fahey*, DBA Gravity Guitar Picks, No. 86250337 (T.T.A.B. Apr. 13, 2015) (not precedential).

¹¹⁷ *Id.* at *1–2.

¹¹⁸ *Id.* at *3.

of the population speaks Hawaiian.¹¹⁹ Assuming generously that a full one-half of the Hawaiian-speaking population would be confused by the mark, one will conclude that .004 of one percent of the American consuming population would be harmed by the registration of the mark. Therefore, keeping in mind the eleven percent confusion threshold, this decision properly weighed the potential information gain to the marketplace against the extremely minor possibility of confusion.

However, one troubling aspect of the TTAB's opinion in *In re Christopher Fahey* is a statement made by the board after remarking on how few American consumers understand Hawaiian: "Moreover, there is substantially no population of Hawaiian speakers elsewhere around the globe."¹²⁰ Thus, like in *In re Savisa*, the TTAB in *In re Christopher Fahey* considered the distinctiveness of marks to foreign populations or to hypothetical populations beyond the current American market to which the product is sold.¹²¹ Cases like these fail to consider that even if some consumers are confused by descriptive foreign-language marks, ninety-nine percent of the market may use those marks as source identifiers. Since zero confusion is an unworkable target, the law must balance the interests of potentially confused consumers with those who benefit from the product differentiation signals provided by unique marks such as "SONOP."

Ultimately, the doctrine of foreign equivalents as it stands may force or influence the rejection of a mark that could at worst confuse a minute fraction of the American marketplace. By rejecting such marks, the doctrine overestimates the likelihood of confusion to the marketplace and constricts potential information gains for consumers. This leads us to the third problem with the doctrine's current state; namely, constrictions on mark holders' ability to present information to the marketplace through creative trademarks.

C. *Inhibition of Imaginative and Communicative Branding*

The third problem with the doctrine's current state relates to the alternative justifications for trademark protection discussed in Part I, particularly the promotion

¹¹⁹ *Id.*; *State & County QuickFacts*, U.S. CENSUS BUREAU, <https://www.census.gov/quickfacts/table/PST045216/00> (last visited Mar. 1, 2017). Interestingly, the number of Hawaiian speakers approximates the number of Gaelic speakers in the United States at .008 of one percent of the population as found in the "ÓGRA" case. U.S. CENSUS BUREAU, DETAILED LANGUAGE SPOKEN AT HOME AND ABILITY TO SPEAK ENGLISH FOR THE POPULATION FIVE YEARS AND OLDER BY STATES: 2006–2008 (2010).

¹²⁰ *In re Christopher A. Fahey, DBA Gravity Guitar Picks*, No. 86250337, at *3.

¹²¹ *In re Savisa (Pty) Ltd.*, No. 78154196, 2005 WL 548058, at *3 (T.T.A.B. Feb. 24, 2005) (not precedential); Rest, *supra* note 5, at 1242.

of communicative branding.¹²² The doctrine leaves little to no room for imaginative branding because it focuses exclusively on the source identification function of trademarks and neglects the benefits of trademark protection for alternative reasons. Its one-track focus on consumer protection, while desirable to an extent, detracts from the ability of firms to employ creative branding strategies that convey product characteristics to consumers. In other words, the doctrine does little to protect firms' branding desires and investments or consumers' ability to distinguish goods based on a mark's communicative elements.

To be fair, this shortcoming is not unique to the doctrine of foreign equivalents; consumer protection continues to largely dominate the focus of trademark law.¹²³ Yet foreign-language marks are a particularly significant type of trademark in today's globalized culture, and language can provide consumers with insights into the characteristics of a product. Marketing literature has examined extensively phenomena such as the "country-of-origin effect," which highlights the effectiveness of drawing comparisons between the trademarked products and the qualities, characteristics, or emotions associated with a particular foreign country.¹²⁴ Branding has an emotional appeal to consumers, and by stimulating particular emotions or memories, a brand can communicate values that attract consumers.¹²⁵ Foreign languages, like certain geographical names, evoke emotions or associations that resonate with consumers.¹²⁶

The concept of "sound symbolism" further helps to explain how trademarks convey product characteristics to consumers.¹²⁷ Consumers consciously or subconsciously associate certain sounds with desirable qualities.¹²⁸ The letter "S" connotes quickness and ease of use for mops, such as with "SWIFFER."¹²⁹

¹²² See discussion *supra* Part I.A.1.ii.

¹²³ See discussion *supra* Part I.A.1.i.

¹²⁴ See generally Keith Dinnie, *Country-of-Origin 1965-2004: A Literature Review*, 3 JOURNAL OF CUSTOMER BEHAVIOUR 165 (2004).

¹²⁵ Griffiths, *supra* note 20, at 255–58.

¹²⁶ Cf. Alan L. Durham, *Trademarks and the Landscape of Imagination*, 79 TEMP. L. REV. 1181, 1183 (2006) ("Marketers today emphasize the importance of emotion or fantasy in selling even ordinary goods, and geographic names are a potent source of ready-made associations.").

¹²⁷ See Jake Linford, *Are Trademarks Ever Fanciful?*, 105 GEO L.J. (forthcoming 2017), available at http://papers.ssrn.com/sol3/papers.cfm?abstract_id=2732582&download=yes (arguing that "fanciful" marks on the *Abercrombie* spectrum are strategically selected by firms because of their sound symbolism, and that consequently courts should resist granting protection for such marks to prevent anticompetitive effects).

¹²⁸ *Id.* (manuscript at 5).

¹²⁹ *Id.* (manuscript at 31).

“FROSH” sounds “smoother, richer, and creamier” than “FRISH” for ice cream.¹³⁰ Likewise, by drawing from easily identifiable linguistic patterns from certain languages, the phonetic composition of trademarks such as “OIKOS” or “HÄAGEN-DAZS” can convey significant qualities of their respective products, even if American consumers are unable to translate those words to gain a precise meaning. Tapping into these common linguistic patterns can facilitate the exchange of information in the marketplace through trademarks.

Of course, one might be hesitant to give firms and their marketing departments such power. The question arises whether creative and communicative branding provides a sufficient advantage to warrant increased protection for firms’ trademarks. One skeptical commentator remarks:

In considering how far branding operates in the public interest and justifies legal protection, it is necessary to consider both what it achieves for consumers and how it influences the behaviour of firms. Having exclusive control over a source of emotional appeal to consumers can give a firm significant market power and increase its bargaining power within the streams and value chains in which it operates.¹³¹

However, despite such potential objection, strong branding provides consumers with a variety of economic and social benefits, ranging from lower transaction costs in the marketplace to expression of social values.¹³² Moreover, any notion that communicative branding only confuses or misdirects consumers assumes that consumers are largely unable to interpret information on packaging. It again fails to consider that such branding may indeed help consumers learn about the general features of a product rapidly. Consider the earlier “FRUTTO DELLA TERRA” example for tomato sauce. The name may evoke an idea of natural and fresh ingredients that may signal to the consumer such qualities in the product. Moreover, the Italian language may connote to the consumer, consciously or

¹³⁰ *Id.* (manuscript at 32).

¹³¹ Griffiths, *supra* note 20, at 241. *See also* Linford, *supra* note 127 (manuscript at 49) (“Component sounds can convey meaning about product features, and picking the right sounds can increase product desirability. Failing to account for sound symbolism may therefore lead to a level of protection for fanciful marks that imposes unacceptable costs on competitors.”).

¹³² Jerre B. Swann, *An Interdisciplinary Approach to Brand Strength*, 96 TRADEMARK REP. 943, 949–54 (2006).

subconsciously, that the product will enhance their next Sunday spaghetti dinner with rich flavor.¹³³

Both the firm and the consumer benefit from this communication. Consider, for example, the Greek yogurt trademarked “OIKOS,” a Greek word meaning “house.” Produced by Dannon, the American subsidiary of French company Danone, OIKOS entered the Greek yogurt market in 2010.¹³⁴ Why did the American subsidiary of a French company choose a Greek trademark for its yogurt? Greek-style yogurt has surged in popularity among American yogurt consumers, rising from one percent of the yogurt market in 2007 to over fifty percent of the market in 2015.¹³⁵ Consumers need not understand Greek—indeed, they need not be able to translate the word “oikos”—to appreciate that it is a Greek word. What matters is that the general sight, sound, and recognition of “oikos” as a Greek word differentiates “OIKOS” yogurt from other yogurts in the dairy aisle, including Dannon’s other yogurt varieties. “OIKOS” designates that the product is Greek-style yogurt because it has a Greek-style name.¹³⁶ Although it is impossible to state conclusively that the word mark *alone* conveys the Greek yogurt characteristics of the product without survey evidence, Dannon’s decision to use a Greek word remains rather insightful because it parallels the behavior of other firms.¹³⁷ Marks

¹³³ See ROGER SHUY, *LINGUISTIC BATTLES IN TRADEMARK DISPUTES* 36 (2002).

¹³⁴ *Our Heritage*, DANNON, <http://www.dannon.com/our-history/> (last visited Jan. 16, 2016).

¹³⁵ Carey Polis, *Greek Yogurt Food Invasion Continues As Product Is Added To Cream Cheese, Hummus And More*, HUFFINGTON POST (Mar. 5, 2013, 9:31 AM), http://www.huffingtonpost.com/2013/03/05/greek-yogurt-food-product_n_2807818.html; Hal Conick, *US Greek Yogurt Market to Reach \$4bn by 2019: Technavio*, DAIRYREPORTER.COM (Nov. 19, 2015, 9:22 AM), <http://www.dairyreporter.com/Trends/Greek-Yogurt-Revolution/US-Greek-yogurt-market-to-reach-4bn-by-2019-Technavio>.

¹³⁶ While one might argue that such inventive branding might *misinform* consumers by giving the false impression of the geographic source of the products, such concerns are unwarranted. The OIKOS products clearly state that the product is not made in Greece, and the Dannon website reinforces that point. *Frequently Asked Questions*, DANNON, <http://www.oikosyogurt.com/what-is-greek-yogurt/faq.aspx> (last visited Jan. 16, 2016) (“Though Oikos Greek yogurt is not produced in Greece, it is made according to the traditional Greek manner of production, which removes some of the whey through straining, leaving more of the milk solids.”).

¹³⁷ Interestingly, however, Dannon’s Vice President of Marketing noted that the company was careful not to overemphasize Greece in marketing because a Greek origin suggests to some consumers the idea of a product being “too old, so it’s not modern.” E.J. Schultz, *Dannon Goes Greek, Takes on (Former) Little Guy*, ADVERTISINGAGE (Sept. 26, 2011) <http://adage.com/article/cmo-interviews/dannon-s-greek-yogurt-oikos-sights-set-1-chobani/230009/>.

such as “HÄAGEN-DAZS”¹³⁸ and “FRUSEN GLÄDJÉ,”¹³⁹ both used for ice cream, are designed by firms to sound foreign, and consequently to attract consumers based on the associations between certain products, sounds, and places of origin.¹⁴⁰

The doctrine of foreign equivalents restricts such opportunities for creative branding by shifting marks that are inherently distinctive to the vast majority of consumers to the “descriptive” *Abercrombie* category, rendering them ineligible for protection without a showing of acquired distinctiveness. For example, Hormel was unable to gain registration for the mark “SAPORITO” for sausages because the USPTO found the word to mean “tasty” in Italian, and classified it as descriptive without secondary meaning.¹⁴¹ Likewise, Tokutake, a Japanese shoe firm, was unable to register “AYUMI” for footwear because the TTAB found that its translation, “walking,” was merely descriptive.¹⁴² In yet another case, the TTAB rejected an application for “MARCHE NOIR” for jewelry on the grounds that it was confusingly similar to the mark “BLACK MARKET” in the same class of goods.¹⁴³ The Board stated that although the marks are “decidedly different in sound and appearance, [they] have the same connotations.”¹⁴⁴

The law currently fails to recognize the costs of such barriers to registration and the benefits of creative and communicative branding to both firms and consumers. As a result, firms are often prevented from using marks with strong sound symbolism to distinguish the source or qualities of their products,¹⁴⁵ and consumers lose the opportunity to make more knowledgeable purchasing decisions based on trademarks that communicate information about elements of the product and assurances of quality.¹⁴⁶

¹³⁸ *Our Story*, HÄAGEN-DAZS, <http://www.haagendazs.us/Learn/History/> (last visited Feb. 13, 2017) (“Mr. Mattus, supported by his wife Rose, decided to form a new company dedicated to his ice cream vision. He called his new brand Häagen-Dazs, to convey an aura of the old-world traditions and craftsmanship, values which he held close to his heart.”).

¹³⁹ Alix M. Freedman, *Rolls-Royces of Ice Cream*, N.Y. TIMES, Feb. 22, 1981, <http://www.nytimes.com/1981/02/22/business/rolls-royces-of-ice-cream.html>.

¹⁴⁰ See Linford, *supra* note 127 (manuscript at 29).

¹⁴¹ *In re Geo. A. Hormel & Co.*, 227 U.S.P.Q. 813 (T.T.A.B. 1985).

¹⁴² *In re Tokutake Indus.*, 87 U.S.P.Q.2d 1697 (T.T.A.B. 2008).

¹⁴³ *In re Thomas*, 79 U.S.P.Q.2d 1021, 1028 (T.T.A.B. 2006).

¹⁴⁴ *Id.* at 1025.

¹⁴⁵ See discussion *supra* Part I.A.1.

¹⁴⁶ Griffiths, *supra* note 20, at 240. *But see* Ralph S. Brown, Jr., *Advertising and the Public Interest: Legal Protection of Trade Symbols*, 57 YALE L.J. 1165, 1186 (1948) (“Since the user of the symbol probably guarantees by it nothing more than his hope that the buyer will come back for more, the term smacks strongly of the ad-man’s desire to create the illusion of a guarantee

III REEVALUATING THE DOCTRINE AND PROPOSING SOLUTIONS

This section argues that the doctrine of foreign equivalents has merit and should continue to guide the registration of foreign-language marks. However, Congress or the USPTO ought to refine the doctrine so that it may provide optimal results for both producers and consumers. First, this section will argue that the doctrine should apply as a rule rather than as a guideline. Currently, the doctrine is applied only when it is likely that the “ordinary American purchaser would ‘stop and translate the foreign word into its English equivalent.’”¹⁴⁷ Examiners and courts should apply the doctrine in *all* cases involving a non-English word absent from a trusted and recognized English-language dictionary; words with foreign origins that have entered the American lexicon such as “sombbrero” and “carte blanche” should be treated as English words.¹⁴⁸ Second, Congress or the USPTO must reconsider the doctrine’s ability to assess informational gains or losses to the marketplace by taking as the defined demographic not only those bilingual consumers who might stop and translate a non-English mark, but the entire American market for the product.¹⁴⁹ As it stands, the doctrine’s application leads to instances in which words from uncommon foreign languages are barred from registration, despite the fact that not many consumers would take the mark as non-distinctive of source. While its stated purpose—the protection of immigrant and tourist populations from confusion in the marketplace—is laudable, its consequences are entirely inconsistent with the typical registration standards and impose high costs on firms and other consumers. This note proposes that as a compromise, the doctrine allow greater flexibility for non-English descriptive marks to be registered in the United States, while still barring generic non-English words.¹⁵⁰ There exists both foreign and domestic precedent for such an approach, one that would better respect the balance of interests involved in the registration process while also simplifying the registration and review process. Third, and relatedly, although the justifications and purposes of trademark law are primarily consumer-based, trademark law ought to acknowledge the potential benefit to trademark holders stemming from a mark’s ability to signal

without in fact making more than the minimum warranty of merchantable quality.”). *See also* discussion *supra* Part II.B.

¹⁴⁷ *E.g.*, *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1377 (Fed. Cir. 2005).

¹⁴⁸ *See, e.g.*, MERRIAM-WEBSTER’S COLLEGIATE DICTIONARY (11th ed. 2014); OXFORD ENGLISH DICTIONARY, <http://www.oed.com/>. The TMEP already offers this step. TMEP § 809.01(b)(i) (Jan. 2017).

¹⁴⁹ Rest, *supra* note 5, at 1244.

¹⁵⁰ This refers to marks that would otherwise be “descriptive” on the *Abercrombie* spectrum.

particular qualities of their goods via foreign-language words. Such imaginative product differentiation would be an additional benefit from allowing registration of some descriptive non-English terms.

A. A Rule is Preferable to the Current Guideline

One might question why it is necessary to keep the doctrine of foreign equivalents at all. Why translate a word to English when it is possible to assess its distinctiveness independently, that is, as the word appears on the packaging? The importance of the doctrine relates to the international comity rationale,¹⁵¹ but extends further than that. Some application of the doctrine is necessary to prevent truly harmful consumer confusion.

While it is possible to justify the protection of descriptive terms in some cases, there is a legitimate public interest in preventing the registration of generic terms in *all* cases. This is because removing a generic word from the public commons to the sole possession of a trademark holder unduly inhibits speech and poses a high likelihood of confusion in the marketplace.¹⁵² The only way to prevent registration of generic foreign-language terms is to translate the words to a language understood by trademark examiners and judges before assessing their distinctiveness. Moreover, in infringement claims where the plaintiff's mark is both conceptually strong (i.e., arbitrary or fanciful) and famous, there is compelling reason to prevent registration of marks that will confuse bilingual speakers.

“MANZANA,” the Spanish equivalent of “APPLE,” for computers and technology products, would be one such example. Consumers who understand both the Spanish word “manzana” and the English word “apple” might be confused as to the source of the products, especially because “APPLE” is a conceptually strong, arbitrary mark.¹⁵³ Employing the mark “MANZANA” for computers would be a cheeky attempt to free-ride on the goodwill encapsulated by “APPLE.” Of course, the overall ceiling of potential confusion in such cases may still be extremely low; that is where substantive rethinking of the doctrine is necessary.¹⁵⁴

Ultimately, a rule is better suited to focus trademark examiners and courts on the core issues the doctrine of foreign equivalents aims to address. Trademark law

¹⁵¹ See discussion *supra* Part I.B.2.

¹⁵² Jared Stipelman, *A Failure to Communicate: How Linguistics Can Inform Trademark Law*, 42 AIPLA Q.J. 69, 99 (2014) (offering the example of an immigrant consumer purchasing a branded product based on a generic trademark on the false assumption that it is cheaper).

¹⁵³ It is conceptually strong per the *Abercrombie* spectrum because “APPLE” is arbitrary for the computers and technology classes of goods.

¹⁵⁴ See discussion *infra* Part III.B.

must rein in application of the doctrine of foreign equivalents and use it to invalidate mark registrations only when necessary in order to strike the proper balance between confusion and information.¹⁵⁵ Therefore, a rule is preferable to the current guideline, which allows for over-application of the doctrine in some instances.

1. Benefits of Adopting a Foreign Equivalents Rule

Treating the doctrine of foreign equivalents as a mandatory rule, rather than a guideline, would eliminate misinterpretation and the disparate results by making the doctrine easier to apply, and therefore more predictable for firms or individuals registering marks. A mandatory rule must apply to every scenario in which stated conditions are met.¹⁵⁶ A guideline, on the other hand, invites interpretation by examiners and judges. While this may offer versatility for considering unique features of individual cases, the costs of uncertainty are high.¹⁵⁷ An alternative to making the doctrine a strict rule would be to keep the doctrine a guideline while creating more consistent definitions and standards.¹⁵⁸ However, this still leaves a significant, unpredictable decision to the examiner or judge: whether the doctrine should apply in the first place, based on whether consumers are likely to stop and translate a mark. By confining the universe of easily recognizable English-language words to those found in selected dictionaries and translating *all* marks absent from them, registrants can determine whether their mark will be translated before the mark is assessed for distinctiveness or likelihood of confusion. Registrants can then predict whether their marks will gain protection based on the clarified positions explained next.

2. Features of the Proposed Rule: Standardizing Translation Methods and Adopting a Confusion Threshold

To treat the doctrine as a rule, it is necessary to solidify the terms of the doctrine and how to apply them. First, if the doctrine is to apply, then it is desirable, for the sake of predictability and consistency, that a defined list of references assist in the determination of whether a word is part of the English lexicon, and subsequently, in the translation of non-English words to English. While one might

¹⁵⁵ *But see* MCCARTHY, *supra* note 67, at § 11:35 (“A rigid, unthinking application of the “doctrine” of foreign equivalents can result in a finding quite out of phase with the reality of customer perception.”).

¹⁵⁶ *Rule*, BLACK’S LAW DICTIONARY (10th ed. 2014).

¹⁵⁷ Stipelman, *supra* note 152, at 86 (“The DFE is thus meant to vindicate ambivalent policies, governed by a vague standard, and is applied by judges who, by and large, are not privy to special insights regarding what constitutes translation. The problem is emblematic of issues in trademark law writ large.”).

¹⁵⁸ Rest, *supra* note 5, at 1223.

argue that granting examiners and judges a broad ability to consult myriad sources encourages exhaustive research for word meaning, the reality is that such wide latitude in choosing translation references results in dependence on often unreliable sources and overly-restrictive registration decisions. For example, the Second Circuit held on remand that the Southern District of New York should consider the popular meaning of the mark “OTOKOYAMA” for sake in Japan.¹⁵⁹ However, considering popular meaning opens possibilities for introduction of just about any evidence to prove use of the word without reliable, verifiable support from a dictionary or translation service.¹⁶⁰ Examiners and judges should consult dictionaries and translation services that are reputable for their accuracy.¹⁶¹ Even slang words and formerly trademarked words that have entered the American lexicon by ‘genericide’ are now present in dictionaries such as The Oxford English Dictionary and The Merriam-Webster Dictionary.¹⁶² As such, trademark examiners should consult only trusted dictionaries and translation services to determine whether a word is part of the American lexicon or inherently distinctive. The TMEP can specify exactly which references an examiner may cite.¹⁶³ Creating a specific list of translation references will guide registrants and assist them to predict more accurately whether their marks may gain registration.

Next, the law would benefit from a clear statement of the acceptable threshold of potential confusion to enable examiners and courts to make more consistent decisions on which trademark applications are eligible for protection. The Board has explained correctly that to require infringement-level confusion of ten percent or more effectively “would write the doctrine out of existence.”¹⁶⁴ Nevertheless, it is crucial for the integrity of the rule to establish a minimum percentage of the national

¹⁵⁹ *Otokoyama Co. v. Wine of Japan Imp., Inc.*, 175 F.3d 266, 272 (2d Cir. 1999).

¹⁶⁰ While one may argue that this places too much emphasis on dictionaries, dictionaries remain the most reliable reference for what constitutes a word in a given language. *Cf.* Landes & Posner, *supra* note 14, at 294 (suggesting that dictionaries are “accurate inventor[ies] of words in general use by the relevant publics” to determine whether a word has become generic).

¹⁶¹ For translation functions, services such as “Gengo” offer a far more reliable and professional translations than free online translators, and at extremely low prices – often less than ten cents per word.

¹⁶² Examples include “aspirin,” “cellophane,” “twerk,” and “selfie.” OXFORD ENGLISH DICTIONARY, <http://www.oed.com/>.

¹⁶³ Although some courts have looked beyond reputable dictionaries such as Merriam-Webster’s and the Oxford English Dictionary to sources such as “Urban Dictionary,” this practice has obvious shortcomings. Leslie Kaufman, *For the Word on the Street, Courts Call Up an Online Witness*, N.Y. TIMES, May 21, 2013, at A1.

¹⁶⁴ See *In re Thomas*, 79 U.S.P.Q.2d 1021, 1024 (T.T.A.B. 2006). Indeed, at least one commentator believes that for this very reason the doctrine should cease to exist. Krimnus, *supra* note 79, at 161.

population that speaks the foreign language to warrant translation. Determining the minimum population percentage could induce debate, but even an arbitrary figure would be better than no figure at all for the doctrine's consistency and registrants' ability to predict outcomes.

The point is best illustrated with numbers. Spanish is the most popular language after English in the United States, and the current Spanish-speaking population comprises approximately thirteen percent of the American population.¹⁶⁵ Chinese is the second-most popular non-English language after Spanish;¹⁶⁶ yet Chinese speakers comprise only about one percent of the population.¹⁶⁷ This means that other "common" languages are recognizable by less than one percent of the total population, and by extension, generic or descriptive foreign-language words in those languages are capable of causing a maximum of one percent confusion for products with a national market.¹⁶⁸ Instead of granting each individual examiner or reviewer the ability to determine whether a language is sufficiently common to warrant translation, a census-based threshold should be stated to provide trademark reviewers with a fixed guidance for what constitutes a "common" language. This note suggests that even a threshold that is by all accounts arbitrary—for example, 0.2 percent—would provide all parties with a set standard by which to predict the outcome of a foreign-word mark registration.

Another alternative would be to eliminate the "common language" requirement completely and simply translate all non-English words to English. There appears to be no material difference between a language recognized by 0.19 percent of the population as opposed to one recognized by 0.2 percent of the population that warrants differential treatment. Therefore, the advantage of this position is that there would be no claims of discrimination over minor differences in population percentages. However, note that the same problem arises whether we set a bright-line threshold for the number of speakers required to constitute a "common language" or we eliminate the "common language" requirement altogether. In either case the law would be refusing protection to foreign-language marks that are intelligible to, and consequently pose a maximum likelihood of confusion for, percentages of the American population that fall well below what is normally

¹⁶⁵ CAMILLE RYAN, U.S. CENSUS BUREAU, LANGUAGE USE IN THE UNITED STATES: 2011, at 3 (2013).

¹⁶⁶ *Id.* Note that the Census statistics group Mandarin and Cantonese into the same category, "Chinese."

¹⁶⁷ *Id.*

¹⁶⁸ This assumes, of course, that the relevant market for a particular product spans the entire country.

required for infringement claims.¹⁶⁹ This is where substantive changes to the doctrine of foreign equivalents are necessary.

B. Permitting Registration of Foreign Descriptive Terms

Beyond refining the doctrine of foreign equivalents by tightening its application, this section advocates for a significant substantive change to the doctrine: permitting the registration of foreign descriptive terms. If, as Part II of this note suggests, trademark law should focus on the present-day American marketplace and not on a future or hypothetical marketplace, then one improvement would grant a presumption of registrability for descriptive foreign-language marks. The only exception would be for cognates from common modern languages, which would lose the presumption but be eligible for registration with a showing of secondary meaning. Currently, the doctrine of foreign equivalents so overprotects consumers as to reject potential information gains, and inhibits mark holders' abilities to communicate features of their products through their marks. Extending protection to descriptive foreign-language marks would recalibrate the information-confusion balance and open avenues for effective, communicative branding.

1. Informational and Branding Advantages from Protecting Descriptive Foreign-Language Marks

The American doctrine would benefit from protection of descriptive foreign-language marks for two reasons. First, extending protection to descriptive foreign words would encourage registration of marks that provide high net informational gains to the marketplace, and would not bar from protection many marks that are inherently distinctive to a vast majority of the population.¹⁷⁰ Because in many instances non-English marks are understood by minute percentages of the American marketplace, even descriptive foreign-language marks are likely to cause negligible consumer confusion, and consequently offer information to consumers in the form of strong source identifiers.¹⁷¹ The only descriptive foreign-language marks that would lose the presumption of registrability are cognates from common languages.¹⁷² Such words so closely resemble their English counterparts that they ought to be included under the 'misspellings' rule, which the TMEP states as, "[a] slight misspelling of a word will not turn a descriptive or generic word into a non-

¹⁶⁹ See MCCARTHY, *supra* note 104, at § 23:2 (showing that a minimum of eleven percent confusion is typically necessary to win an infringement claim).

¹⁷⁰ See discussion *supra* Part II.B.

¹⁷¹ See discussion *supra* Part II.B.

¹⁷² Recall that languages would be deemed common if they meet an established threshold. See discussion *supra* Part III.A.2.

descriptive mark.”¹⁷³ The rationale behind this rule is that consumers will treat the marks as the correctly-spelled word, and when that happens, there is a potential for information loss or confusion. One may think of common cognates in the same way as misspelled words. In effect, the doctrine would treat cognates as misspelled English words for the purposes of a distinctiveness analysis because they are phonetic equivalents.¹⁷⁴ If the descriptive mark is clearly a cognate and loses the presumption of registrability, then the mark registrant must show secondary meaning as with any other descriptive mark in order to gain protection.

Second, opening the opportunity for registration of descriptive foreign language marks would promote imaginative branding efforts and recognize the current status of trademarks as communicative tools. As one scholar noted, “[t]he descriptive or near-descriptive sign has accordingly a kind of condensed power: it triggers mental effects that, if suitably guided, significantly enrich its resonance and make it more effective as a means of communication.”¹⁷⁵ Firms could use foreign-language marks to communicate characteristics of their products via linguistic sights and sounds, and consumers would perceive such marks as both indicators of source and quality communicators. Current highly-visible examples of firms that employ foreign-language marks as descriptors include the restaurant chains “PRET A MANGER” (“ready to eat” in French)¹⁷⁶ and “AU BON PAIN” (roughly translated to “place of good bread” in French),¹⁷⁷ as well as clothing retailer “SUPERDRY”¹⁷⁸ (in Japanese characters: 極度乾燥(しなさい)). The French names convey an aura of fine quality, while the Japanese characters and “SUPERDRY” name communicate high-performance clothing bearing “Japanese-inspired graphics.”¹⁷⁹

¹⁷³ TMEP § 1209.03(j) (Jan. 2017).

¹⁷⁴ See Stipelman, *supra* note 152, at 100–08 (explaining how an understanding of phonetic dissimilarities ought to permit the registration of descriptive foreign-language trademarks).

¹⁷⁵ Durant, *supra* note 28, at 131.

¹⁷⁶ Kim Bhasin, *Here’s What Pret A Manger’s President Thinks Every Time You Pronounce The Name Wrong*, BUSINESS INSIDER (Mar. 8, 2013, 4:38 PM), <http://www.businessinsider.com/how-to-pronounce-pret-a-manger-2013-3>.

¹⁷⁷ Leeann Cannon, *Au Bon Pain: Bakery-Café Weighs in on Diet Fads, Offers More Healthful Fare to Concerned Customers*, 39 NATION’S RESTAURANT NEWS, Jan. 31, 2005, at 28, available at EBSCO.

¹⁷⁸ James Hall, *How Superdry Became 2010’s £1bn Fashion Success Story*, THE TELEGRAPH (Dec. 27, 2010, 5:45 AM), <http://www.telegraph.co.uk/finance/newsbysector/retailandconsumer/8221598/How-Superdry-became-2010s-1bn-fashion-success-story.html>.

¹⁷⁹ *About Us*, SUPERDRY, <http://www.superdry.com/about-us> (last visited Apr. 6, 2016).

2. Precedent for Protecting Descriptive Foreign-Language Marks

Precedent exists for extending trademark protection to descriptive foreign-language marks. Two major foreign courts have demonstrated direct openness to offering such protection, and one could reasonably extend principles in existing American case law to cover descriptive foreign-language marks. While foreign cases have no binding effect on any American court, they remain theoretically instructive and offer an attractive alternative to the current application of the doctrine of foreign equivalents.¹⁸⁰ First, the European Court of Justice has supported protection for descriptive foreign-language marks, going so far as to uphold protection for a *generic* foreign-language mark. In *Matratzen Concord AG v. Hukla Germany*,¹⁸¹ Hukla, a German company, held the registration for the “MATRATZEN” mark in Spain for bedding products. “MATRATZEN” translates to “mattresses” in German.¹⁸² When a competitor attempted to gain a Community Trade Mark for “MATRATZEN CONCORD,” Hukla opposed.¹⁸³ Seeking to turn the tables, Matratzen Concord attempted to cancel Hukla’s “MATRATZEN” mark in Spain.¹⁸⁴ The Court of First Instance rejected Matratzen Concord’s effort,¹⁸⁵ and the European Court of Justice affirmed the lower court, holding,

Article 3(1)(b) and (c) of the Directive does not preclude the registration in a Member State, as a national trade mark, of a term borrowed from the language of another Member State in which it is devoid of distinctive character or descriptive of the goods or services in respect of which registration is sought, unless the relevant parties in the Member State in which registration is sought are capable of identifying the meaning of the term.¹⁸⁶

Because the average Spanish consumer would not take “MATRATZEN” to be merely descriptive of the products to which the mark was attached, it could gain trademark protection. This holding was confirmed by *Bimbo SA v. OHIM* in 2012, a case involving the registration of “DOUGHNUT” in Spain.¹⁸⁷ Although there was

¹⁸⁰ See Roger P. Alford, *Federal Courts, International Tribunals, and the Continuum of Deference*, 43 VA. J. INT’L L. 675, 677 (2003).

¹⁸¹ Case C-421/04, *Matratzen Concord AG v Hukla Germany SA*, 2006 E.C.R. I-2306.

¹⁸² *Id.*

¹⁸³ *Id.*

¹⁸⁴ *Id.*

¹⁸⁵ *Id.*

¹⁸⁶ *Id.*

¹⁸⁷ Case C-591/12, *Bimbo SA v. OHIM*, 2014 E.C.R. 305.

a proposal to overturn the *Matratzen* decision,¹⁸⁸ recent amendments to the Community Trade Mark Regulations in December 2015 opted not to do so.¹⁸⁹

In similar fashion, the Australian High Court recently accepted the registration and protection of descriptive foreign-language marks. The High Court stated that although a word mark should be “substantially different from any word in ordinary and common use...[it] need not be wholly meaningless and it is not a disqualification that it may be traced to a foreign source or that it may contain a covert and skilful allusion to the character or quality of the goods.”¹⁹⁰ In *Cantarella Bros. Pty Ltd. v. Modena Trading Pty. Ltd.*,¹⁹¹ Cantarella had registered the marks “ORO” and “CINQUE STELLE” for coffee products. The marks translate to “gold” and “five-star” in Italian, and approximately 1.5 percent of the Australian population speaks Italian.¹⁹² In analyzing the mark, the Court sought to ascertain the “ordinary significance” of the mark to Australian consumers and whether it was “inherently adapted to distinguish” the source of the goods – that is, whether it was distinctive. The High Court concluded that “ORO” and “CINQUE STELLE” are inherently adapted to distinguish the source of Cantarella’s coffee because they do not “convey a meaning or idea sufficiently tangible to anyone in Australia concerned with coffee goods as to be words having a direct reference to the character or quality of the goods.”¹⁹³

Beyond these foreign cases, there is a viable justification within the current American registration precedent to support registration of foreign descriptive terms. Recall that descriptive marks are not per se unprotectable. However, they typically

¹⁸⁸ *Commission Proposal for a Regulation of the European Parliament and of the Council Amending Council Regulation No. 207/2009 on the Community Trade Mark*, at 10, COM (2013) 161 final (Mar. 27, 2013); see also James Nurton, *EU Trade Mark Proposals Sound Wrong, In Any Language*, MANAGING INTELLECTUAL PROPERTY BLOG (June 25, 2013), <http://www.managingip.com/Blog/3223159/EU-trade-mark-proposals-sound-wrong-in-any-language.html>.

¹⁸⁹ Council Regulation 2015/2424 amending Council Regulation (EC) No. 207/2009 on the Community Trade Mark and Commission Regulation (EC) No. 2868/95 Implementing Council Regulation (EC) No. 40/94 on the Community Trade Mark, and Repealing Commission Regulation (EC) No. 2869/95 on the Fees Payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs), 2015 O.J. (L 341) 58.

¹⁹⁰ *Cantarella Bros Pty Ltd. v Modena Trading Pty. Ltd.* [2014] HCA 48 (Austl.) (internal quotations omitted).

¹⁹¹ *Id.*

¹⁹² Australian Bureau of Statistics, *2011 Census QuickStats*, http://www.censusdata.abs.gov.au/census_services/getproduct/census/2011/quickstat/0 (last updated Mar. 28, 2013).

¹⁹³ *Cantarella Bros* [2014] HCA 48.

require a showing of secondary meaning.¹⁹⁴ Despite the acquired distinctiveness restriction on descriptive marks, American trademark law has already on several occasions permitted the registration of multilingual terms or phrases that would certainly seem descriptive, and perhaps even generic, without such a showing. For instance, the USPTO granted the marks “LA YOGURT” and “LE CASE” for yogurt and briefcases, respectively.¹⁹⁵ Contrast these trademarks with “LA LINGERIE,” “LE SORBET,” and “LE CROISSANT SHOP,” to each of which the USPTO denied registration.¹⁹⁶ The primary difference between the first and second sets of marks are the correctness of the two-letter articles in each group. In French, the correct article for “yogurt” is “le,” not “la.”¹⁹⁷ Although the courts justified the registrations of “LA YOGURT” and “LE CASE” on the grounds that they presented unique commercial impressions, such findings are highly questionable for two reasons. First and most fundamentally, a mark is descriptive if it describes any feature of a product. Consumers will still glean from these marks the products to which they are attached: certainly, “LA YOGURT” is in some sense descriptive of the product to which it is attached. Indeed, these marks contain the *generic*, genus terms used to describe their respective products. Second, slight misspellings ought not to change the analysis per the TMEP.¹⁹⁸ Thus, in each of these instances the USPTO implicitly acknowledges that there is indeed something unique about marks employing a non-English term that warrants a distinct analysis, even when there is a significant chance that consumers will take the mark as descriptive or generic. Protecting wholly descriptive foreign-language marks does not require much of a step from such current TTAB precedent.

C. Applying the Proposed Rule: “DELICIOSA” Versus “NÓSTIMA”

To envisage how this note’s proposal for a revised treatment of descriptive foreign-language marks would operate, consider two examples. First, imagine a brand of salsa marketed nationally under the trademark “DELICIOSA.” Assuming that this word is absent from the established list of English language dictionaries, under this note’s recommended analysis the examiner should assess the distinctiveness of the word based on the entire national market. Since many people in the United States speak Spanish, it will most certainly cross the threshold for

¹⁹⁴ *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 7, 9 (2d Cir. 1976).

¹⁹⁵ *In re Johanna Farms, Inc.*, 222 U.S.P.Q. 607 (T.T.A.B. 1984); *In re Universal Package Corp.*, 222 U.S.P.Q. 344 (T.T.A.B. 1984).

¹⁹⁶ Note, however, that even this part of the doctrine is sloppy, as the Board recently refused registration for “Uchi Sweets Café.” *In re Kabushiki Kaisha Lawson*, No. 79138995, 2015 WL 5579957 (T.T.A.B. Aug. 25, 2015).

¹⁹⁷ *In re Johanna Farms, Inc.*, 222 U.S.P.Q. at 607.

¹⁹⁸ TMEP § 1209.03(j) (Jan. 2017).

qualifying as a common language. This means that the examiner should translate the word to English using an accepted, established reference or translation service. “DELICIOSA” will translate to “delicious” in English, which is descriptive of salsa. This means that “DELICIOSA” would initially gain a presumption of registrability under this note’s framework; however, since “DELICIOSA” for salsa clearly is a cognate of “delicious,” it should lose the presumption. Now apply the same analysis to “NÓSTIMA,” which translates to “delicious” in Greek, as it applies to pita bread. The examiner here would have to determine whether Greek is a common language in the United States. If she does, and finds that “NÓSTIMA” translates to “delicious,” the mark will gain a presumption of registrability since the two words are not cognates.

D. Addressing Competition Concerns through Descriptive Fair Use and Reexamination

It is important at this stage to address an important critique that likely will arise in response to this note’s proposal. One might argue that the registration of descriptive foreign-language marks at the present time would, in the future, undercut the consumer protection purposes of trademark law. For example, one writer has critiqued the European Court of Justice’s *Matratzen* decision using the following hypothetical: “Under the current policy for Community trademarks, “Ha-Lush-Ka” could be registered in the European Union and retain trademark rights despite its generic nature after enlargement of the Union to include Hungary. Such an occurrence would seem to present problems for the free movement of goods in the future.”¹⁹⁹ Beyond the argument that the trademark law should focus on the *current* American market,²⁰⁰ which this section previously has addressed, this critique is inadequate for two reasons.

First, the descriptive fair use doctrine could apply to foreign-language marks.²⁰¹ Descriptive fair use functions as a defense to trademark infringement

¹⁹⁹ Eric E. Bowman, *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).

²⁰⁰ If the TTAB’s concern is that marks need to be distinctive for future American markets, then ‘genericide’ shows how to address the problem. If, for example, the Gaelic-speaking population of the United States increases to a point at which it comprises an appreciable portion of the purchasing public, then non-inherently-distinctive Gaelic marks could forfeit their registration just like English marks that have lost their protection to ‘genericide.’ Cf. Linford, *supra* note 56, at 110.

²⁰¹ Descriptive fair use is codified in 15 U.S.C. § 1115(b)(4). “[T]he right to use the registered mark . . . shall be subject to the following defenses or defects . . . That the use of the name, term, or device charged to be an infringement is a use, otherwise than as a mark, of the party’s individual

claims, even claims against marks that have achieved incontestable status. It permits Person X to use Person Y's trademark to describe Person X's goods, so long as Person X's use is not descriptive of Person Y's product, and is in good faith.²⁰² This is important because it means that if one trademarks a descriptive term from a foreign language, and a foreign competitor enters that market, the foreign competitor would not be subject to a claim of trademark infringement for the use of the descriptor. For example, imagine that under this note's framework, Hormel reapplies for the "SAPORITO" mark to apply to sausages.²⁰³ The examiner translates the mark from Italian to English, finding it means "tasty." "Tasty" undoubtedly is descriptive of sausage, yet under the proposed solution, foreign descriptive terms that are not cognates of English words may gain protection. Therefore, Hormel would gain rights in the "SAPORITO" mark for sausages. Soon after, an Italian firm begins to export its sausages to New Jersey under the mark "SALSICCIA DI MERANTE." On the side of the packaging, the Italian firm writes, "Il nostro prodotto è dolce, piccante e saporito."²⁰⁴ Under the descriptive fair use doctrine, since the Italian firm is not using the word "saporito" as a trademark, but as a descriptor, presumably in good faith, the Italian firm would not be liable for trademark infringement. Hormel would have the advantage of using the "SAPORITO" mark, but other firms are not prohibited from using the same descriptive term in good faith. Consumers would not be confused because they would understand one term, when seen with the Hormel house mark, as an indicator of source, and the other as descriptive.²⁰⁵

The critique is inadequate for a second reason. If a foreign-language mark wrongfully gains registration (that is, if it is generic, yet passes examination in the USPTO) it may, like any other mark in the Register, face cancellation and lose its registration. In fact, the TTAB applied the doctrine of foreign equivalents in 2009 for this very purpose.²⁰⁶ It found the registered mark "AZUCAR MORENA" to be

name in his own business, or of the individual name of anyone in privity with such party, or of a term or device which is descriptive of and used fairly and in good faith only to describe the goods or services of such party, or their geographic origin."

²⁰² *E.g.*, *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 118 (2004).

²⁰³ Hormel has since claimed common law rights in the mark. *See Saporito Prosciutto, Boneless, 2-1/2 PC*, HORMEL, <http://www.hormelfoodservice.com/products/saporitotm-prosciutto-ham-bone-out-2half-pc/> (last visited Apr. 3, 2016).

²⁰⁴ This translates to "Our product is sweet, spicy, and tasty."

²⁰⁵ This assumes that the Hormel house mark is prominent and recognized by consumers.

²⁰⁶ *Marquez Bros. Int'l, Inc. v. Zucrum Foods, LLC*, Cancellation No. 9204826, 2009 WL 4956033, at *7 (T.T.A.B. Dec. 11, 2009).

generic for brown sugar, and consequently cancelled the mark.²⁰⁷ This is an instance where the doctrine worked extremely well: Spanish is a common language, and many American consumers would understand “AZUCAR MORENA” to designate the genus of brown sugar. Therefore, it is likely that many consumers would translate “AZUCAR MORENA” to English and be confused as to whether it was a source designator or not. Moreover, it is not sensible to grant one producer of brown sugar a linguistic monopoly over the Spanish translation of its genus of goods.

CONCLUSION

As the world grows more connected and markets expand, products in the American marketplace increasingly bear foreign trademarks or domestic marks that seek to communicate ‘foreign’ characteristics. Despite this economic connectivity, trademark law must continue to operate on a localized level until the entire world comes to recognize the same terms as generic, descriptive, or distinctive. Excessive trademark protection holds the potential to inhibit competition, information, and even free speech rights; however, treating trademarks with an enhanced proprietary status does not necessarily require such an ill-fated result. Indeed, for the sake of intellectual honesty and practical necessity, the law ought to formally recognize the purpose and value of trademarks beyond their source-identification functions. The doctrine of foreign equivalents in particular is one area of the trademark law that calls for a more nuanced understanding of contemporary trademarks.

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. Thus, revising the doctrine of foreign equivalents in both form and substance would benefit consumers and firms alike. Consumers benefit from the source communicating information the newly registrable marks would offer and would gain new tools by which to distinguish products on the market. Firms such as Pret A Manger, Au Bon Pain, and Häagen-Dazs, among others, have shown that there is interest in employing foreign language terms that communicate their products’ qualities to consumers in creative ways. The law ought not inhibit these information exchanges as it does through its current doctrine.

²⁰⁷ Indeed, with the exception of a lack of a diacritical mark over the “U” in “AZUCAR,” this is a direct translation of brown sugar. The Board stated that this minor difference did not create a distinct commercial impression, and therefore was insignificant. *Id.* at *7 n.3.

Implementation of this note's proposal would require a focused effort by Congress or the USPTO to revisit the advantages of foreign-language marks in the American marketplace.