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Expert Analysis

Use of Foreign Language Words and Phrases as Trademarks

The use of foreign language words or phrases can create strong impressions on English speakers, even English speakers who are not familiar with the particular language that they hear. This power of words and phrases from foreign languages brings with it a temptation to use foreign language words and phrases as trademarks. But words from foreign languages raise a peculiar issue for marketers; some but not all of the target audience might understand the language in which the mark is presented. Thus, for the attorney who counsels these clients, there is a threshold issue of when and under what conditions, the foreign words and phrases will be deemed generic or descriptive because, if translated literally, the English equivalent would be categorized as either generic or descriptive.

This past spring, in *In re Highlights for Children*, 118 USPQ 2d 1268, 2016 WL 1380729 (Trademark Tr. & App. Bd 2016) the children's magazine "Highlights for Children" was forced to confront this issue when it tried to register *Imagágenes Escondidas* for books and magazines for children. At the core, Highlights' goal was to obtain trademark rights in this Spanish phrase for use in



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connection with its Hidden Picture puzzles in its magazines. In doing so, it raised an issue of first impression: whether a foreign language equivalent of a mark can establish acquired distinctiveness based on the existence of a prior

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registration of the English language trademark.

Unfortunately, for Highlights, the U.S. Patent and Trademark Office (USPTO) held that the Spanish language mark did not establish acquired distinctiveness based on prior registrations of the English equivalent of the proposed trademark. The USPTO also rejected the trademark mark as descriptive, and the

Trademark Trial and Appeal Board (TTAB) affirmed these determinations.

Foreign Equivalents

Under the Doctrine of Foreign Equivalents, when an applicant applies for trademark rights in a foreign word or phrase, usually, the USPTO will translate the word(s) into English and then apply the same standards for registration that it would apply to other, English language, trademarks. *In re Spirits*, 563 F.3d 1347, 1351 (Fed. Cir. 2009). The purpose of this doctrine is to protect multilingual Americans from having businesses co-opt generic terms from foreign languages. *Zucrum Foods v. Marquez Brothers*, 2011 WL 2118653 (N.D. Cal. May 27, 2011).

However, there are two important caveats: (1) generally, the doctrine does not apply to words from dead or obscure languages; and (2) the doctrine only applies in those situations in which the ordinary consumer who is familiar with that language would "stop and translate" the mark into English. Thus, the doctrine of foreign equivalents is more of a guideline than a rule.

With respect to the obscurity of the language, the USPTO and courts have recognized that languages such as Afrikaans, French, Spanish, Italian, Portuguese, Chinese, Vietnamese and Japanese are not

obscure because of the number of people in the United States who speak those languages. By contrast Esperanto has been deemed an obscure language. *Abby Software v. Ectaco*, 2011 WL 1399235 (TTAB March 22, 2011).

The second caveat is more interesting. It can be significant when either assessing whether a mark is generic, descriptive, fanciful, or arbitrary; or analyzing the issue of the likelihood of confusion with another mark. For example, in *Otokoyama v. Wine of Japan*, 2001 WL 345188 (2d Cir. April 5, 2001), the U.S. Court of Appeals for the Second Circuit affirmed a finding that the term OTOKOYAMA was not entitled to protection under the Lanham Act because it is a generic term that in Japanese refers to a kind of sake. Similarly, the USPTO rejected a trademark application for the mark AYUMI for footwear because in Japanese it means “walking, a step” and thus was descriptive of the goods. *In re Tokutake Indus.*, 87 USPQ 2d 1697 (May 14, 2008).

Whether the USPTO or a court will conclude that an average American purchaser would stop and translate begs the question: What would cause someone to “stop and translate” a word? Among the factors that weigh in favor of finding that a person would stop and translate, are: (1) the simplicity of the word or phrase; and (2) there only being one recognized translation of the word or phrase as opposed to there being multiple meanings due to, e.g., a phrase being an idiom.

By way of example, the USPTO found that a person who is familiar with Italian would likely stop and translate the standalone Italian word fiore to flower. *In re Isabella Fiore*, 75 USPQ 2d 1564 (TTAB 2005). Similarly, the USPTO deemed an application for a design mark depicting a pony and the term cavalinho to be one that a Portuguese speaker would stop and translate because

the term cavalinho means pony, and it was next to an image of a pony. *In re Manuel Jacinto*, 2008 WL 4674597 (TTAB Sept. 29, 2008).

The motivation to stop and translate can arise in the context of newly created words that are based on roots and syntax from another language. Thus, the TTAB held that a Spanish speaker would stop and translate “futbolito,” to mean small soccer goals because “futbol” means soccer, “ito” means small in size, and the purported mark was intended to be used in connection with small soccer goals for use in, for example, table games. *In re Allen Batres Miranda*, 2009 WL 625571 (TTAB Feb. 11, 2009).

The TTAB held that in order to determine whether a prior registered English language mark is the same as a foreign language mark, one must ask if they are legal equivalents. Thus, the focus is on whether they create “the same, continuing commercial impression such that the consumer would consider them both the same mark.”

By contrast, one might be less likely to stop and translate a phrase when there exists both a literal meaning and an idiomatic one, such as in the case of the phrase “les cheveux du chien,” which may literally be translated in French as “hair of the dog,” but for which a French speaker in the United States would not necessarily stop and translate the French phrase because the English expression means a hangover cure. *In re Innovative Technologies Corp. of American*, 2008 WL 4354133 (Sept. 15, 2008).

Similarly, the use of foreign language words in a manner that is

not grammatically correct in that language would be suggestive that a person would not stop and translate. Thus, the TTAB determined that an American who speaks French would not translate “allez filles” into the literal words “go girl,” because “allez filles” is not grammatically correct in French. *In re Helen Trimarchi and Michael Merr*, 2009 WL 1692509 (TTAB May 14, 2009).

‘In re Highlights for Children’

In *In re Highlights for Children*, the applicant filed an intent-to-use trademark application for registration on the Principal Register for IMAGÁGENES ESCONDIDAS for books and magazines. With the application, Highlights submitted a statement that provided an English translation for the phrase: “hidden pictures.” Highlights had been using the English translation HIDDEN PICTURES as a mark since at least 1946, and owned three federal registrations for that mark.

In a unique twist, Highlights also alleged in the alternative that its mark for IMAGÁGENES ESCONDIDAS was entitled to recognition of acquired distinctiveness. The benefit of a recognition of acquired distinctiveness is that it would allow an otherwise descriptive mark to be registered on the Principal Register, which is reserved for arbitrary and fanciful marks or marks that would otherwise be descriptive but for their having acquired distinctiveness and been recognized as source identifying.

During ex parte prosecution, the USPTO examiner deemed IMAGÁGENES ESCONDIDAS to be merely descriptive, and thus not entitled to registration on the Principal Register. The examiner also rejected the claim for acquired distinctiveness. The examiner reasoned that because the wording at issue was equivalent to the phrase HIDDEN PICTURES, the mark IMAGÁGENES

ESCONDIDAS was no more registerable on the Principal Register than the English wording would be.

On appeal, the TTAB focused on whether an ordinary purchaser would stop and translate the mark into its English equivalent. Highlights argued that because of the manner in which it proposed to use the mark, there would be no need for translation. This proposal was for the mark to be used on bilingual puzzle books that built upon the fame of the Highlights' HIDDEN PICTURES books, and to appear in conjunction with the English HIDDEN PICTURES mark. Thus, Highlights argued that the reader would not need to translate the mark because the translation was already provided.

The TTAB found two fatal flaws in the Highlights' argument. First, in its application, Highlights did not seek to register the Spanish and English phrases together. Consequently, the examiner was correct not to consider the English phrase. Second, by providing the translation, the person seeing the mark would have that translation in mind when seeing the Spanish phrase. Thus, Highlights weakened its case by taking the position that it would juxtapose the phrases. The TTAB emphasized that as a matter of policy, the Doctrine of Foreign Equivalents applies "whenever a translation is made by or provided to the purchaser; the results are the same." Highlights at *3. Therefore, the question is not as Highlights asked: whether the consumer who is exposed to the mark actively translates a word or phrase. Instead, the issue is whether the consumer comes to think of the translation, which is the reason that the courts and the USPTO embark on the stop to translate inquiry.

Highlights also made the argument that neither the phrase HIDDEN PICTURES, nor the phrase IMAGÁGENES ESCONDIDAS should be deemed descriptive because the

images would be located within pictures that are presented to readers and thus not hidden. Thus, according to Highlights, the phrases were ironic. Unfortunately Highlights' three existing registrations for HIDDEN PICTURES suggested that it acknowledged that the phrase was descriptive.

One of those registrations was on the Supplemental Register, which is for descriptive marks, and the other two were registered under section 2(f) of the Lanham Act, based on their acquired distinctiveness, which typically comes about only after a descriptive mark is used for a sufficient period of time. The TTAB considered both the effect of the existence of these prior registrations and the issue of descriptiveness independent of those prior registrations. Ultimately, the TTAB agreed with examiner that the intent-to-use mark was descriptive.

Perhaps the most interesting argument that Highlights made was that its Spanish mark would have acquired distinctiveness based on the registered English marks. Under Trademark Rule 2.41(a)(1), an applicant can establish acquired distinctiveness of a mark if the same mark has been registered on the Principal Register and the goods or services are sufficiently similar. This allows an applicant to establish acquired distinctiveness in an intent-to-use application.

Not finding any precedent for this issue, the TTAB held that in order to determine whether a prior registered English language mark is the same as a foreign language mark, one must ask if they are legal equivalents. Thus, the focus is on whether they create "the same, continuing commercial impression such that the consumer would consider them both the same mark." *In re Highlights* at *4 (quoting *Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1345-46 (Fed. Cir. 2001)).

Here, the TTAB concluded that the marks were not the same for purposes of the Spanish mark benefiting from the long history of the English language mark. The TTAB emphasized that the marks were different aurally and visually. With respect to the issue of whether there would be a similar commercial impression, the TTAB concluded that Highlights had not provided any such evidence. Consequently, the TTAB affirmed the *ex parte* examiner.

Conclusion

Under *In re Highlights for Children*, the asymmetry for an applicant who tries to obtain or to enforce trademark rights in foreign words is clear. A mark can be rejected as generic or descriptive under the Doctrine of Foreign Equivalents based on its translation and the proposed use. However, translation alone and proposed use will not be enough to entitle the applicant or owner of a purported trademark to benefit from any acquired distinctiveness of the English (or other language) equivalent of that mark.

Consequently, before embracing a foreign language word as part of a marketing strategy, one should consider how that mark will be perceived by speakers of that language. Further, if adoption of the foreign language mark is a corollary to an already existing English language mark, one should consider whether that foreign language equivalent is sufficiently strong on its own that it would not need to benefit from the goodwill associated with its English language equivalent.