

10-1-2010

# The Doctrine of Foreign Equivalents at Death's Door

Serge Krimnus

Follow this and additional works at: <http://scholarship.law.unc.edu/ncjolt>Part of the [Law Commons](#)

## Recommended Citation

Serge Krimnus, *The Doctrine of Foreign Equivalents at Death's Door*, 12 N.C. J.L. & TECH. 159 (2010).  
Available at: <http://scholarship.law.unc.edu/ncjolt/vol12/iss1/5>

This Article is brought to you for free and open access by Carolina Law Scholarship Repository. It has been accepted for inclusion in North Carolina Journal of Law & Technology by an authorized administrator of Carolina Law Scholarship Repository. For more information, please contact [law\\_repository@unc.edu](mailto:law_repository@unc.edu).

**THE DOCTRINE OF FOREIGN EQUIVALENTS AT DEATH'S DOOR**

*Serge Krimnus\**

*The Federal Circuit, the Patent Office, and several regional circuits apply the trademark law doctrine of foreign equivalents. Under the doctrine, marks in foreign languages are translated into English and tested for the statutory bars to registration, instead of being tested in their original form. The doctrine is applied even in cases where only a negligible percentage of the purchasing public would be able to translate the foreign mark.*

*I argue that the Federal Circuit should abolish the doctrine of foreign equivalents from trademark law for two reasons. First, the doctrine violates directly applicable Supreme Court precedent, which rejects the doctrine. Second, the doctrine makes little sense as a matter of policy. It contravenes the basic goal of trademark law—to protect a substantial portion of the public—by allowing courts to refuse registration of marks where only a minuscule portion of the public would be confused, deceived, or otherwise affected by a mark. Moreover, the doctrine is unworkable because it lacks reasoning, creates confusion and is inconsistently applied by the courts.*

**I. INTRODUCTION**

Imagine a state of the law where a trademark can be refused registration where less than a mere 0.01% of the purchasing public

---

\* Adjunct Assistant Professor of Law, Brooklyn Law School (serge.krimnus@brooklaw.edu); Associate, The Farrell Law Firm, LLP (admission pending). The idea for this article emerged from work I did with Anthony Lo Cicero. I would like to thank Derek Bambauer, Filana Silberberg, Vera Krimnus, Larry Solan, and Patrick Mirville for their helpful comments. I would also like to thank Jonathan Askin, Michael Cahill, Suzanne Dennis, Philip Wallach, Paul Farrell, Brian Volk and my friends and family for their support and encouragement. Finally, I would like to thank Heather Williams of the North Carolina Journal of Law & Technology for outstanding editorial support.

is confused by the mark.<sup>1</sup> Such a rule seems antithetical to the basic purpose of trademark law—“to protect the public’s expectation regarding the source and quality of goods.”<sup>2</sup> Unfortunately, this is exactly the current state of affairs under the doctrine of foreign equivalents.

In trademark proceedings before the United States Patent and Trademark Office (the “USPTO” or the “Patent Office”) and in trademark infringement actions in federal courts, the judicially created doctrine of foreign equivalents generally applies to marks containing foreign words.<sup>3</sup> Under the doctrine, words from common foreign languages are translated into English prior to being tested for the statutory bars to registration.<sup>4</sup>

---

<sup>1</sup> See *infra* note 184.

<sup>2</sup> *Miller v. Glenn Miller Prods., Inc.*, 454 F.3d 975, 993 (9th Cir. 2006).

<sup>3</sup> See 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:34 (4th ed. 2010). The doctrine is occasionally referred to as “the doctrine of foreign *equivalence*.” *E.g.*, *Horn’s Inc. v. Sanofi Beaute Inc.*, No. 95 Civ. 2994 (CSH), 1995 WL 360131, at \*2 (S.D.N.Y. June 13, 1995) (emphasis added) (internal quotation marks omitted) (citing *Ex parte Odol-Werke Wien Gesellschaft M.B.H.*, 111 U.S.P.Q. (BNA) 286 (Comm’r Pat. 1956)); *In re Hans Merensky Holdings (PTY) Ltd.*, No. 76528639, 2005 WL 1787233, at \*3 (T.T.A.B. June 28, 2005) (referring to the doctrine using both variations); *In re Armour and Co.*, 220 U.S.P.Q. (BNA) 76, 78 n.2 (T.T.A.B. 1983). The doctrine’s full name appears to have been coined in *Rosenblum v. George Willsher & Co.*, 161 U.S.P.Q. (BNA) 492 (T.T.A.B. 1969), although the term “foreign equivalent” was used by the Patent Office in a trademark context as early as 1911. See *Ex parte Julius Wile Sons & Co.*, 1911 Dec. Comm’r Pat. 81, 82.

<sup>4</sup> 2 MCCARTHY, *supra* note 3, § 11:34; see generally 2 MCCARTHY, *supra* note 3, § 11:83 (discussing the doctrine of foreign equivalents as it applies to a distinctiveness analysis). In *ex parte* trademark registration proceedings, the Patent Office may refuse to register trademarks, primarily based on Section 2 of the Lanham Act. See 15 U.S.C. § 1052 (2006); 3 MCCARTHY, *supra* note 3, § 19:75 (discussing statutory bars to registration).

The most common grounds for refusal of registration are likelihood of confusion and lack of distinctiveness. See Philip J. Greene, *Trademark Counsel in the Federal Government—A Practitioner’s Perspective*, 86 J. PAT. & TRADEMARK OFF. SOC’Y 361, 381 (2004); Christopher C. Larkin, *Section 2(d) and (e)(1) Refusals and Substantive Issues in Ex Parte Appeals: the Applicant’s Perspective*, 959 PLI/Pat 45, 49 (2009). Refusals for likelihood of confusion (confusing similarity) with existing marks are “by far the most common.” 3

I argue that in the Federal Circuit's recent *In re Spirits International*<sup>5</sup> decision, the court *sub silentio* abolished the doctrine as it applies to one specific bar to registration—primarily geographically deceptively misdescriptive marks under subsection 2(e)(3) of the Lanham Act.<sup>6</sup> Although the *Spirits* court expressly limited its analysis to primarily geographically deceptively misdescriptive marks,<sup>7</sup> courts cannot justify refusing to extend *Spirits*' reasoning to other bars to registration.

I further argue that the doctrine of foreign equivalents should be abolished for two reasons. First, I argue that a nineteenth century Supreme Court decision—*Menendez v. Holt*<sup>8</sup>—rejects the doctrine of foreign equivalents.<sup>9</sup> *Menendez* has not been overruled or revisited by the Supreme Court, and no other court has questioned its validity in discussing the doctrine.<sup>10</sup> Despite this fact, the Federal Circuit ignores *Menendez* and continues to apply the doctrine. The Federal Circuit must, under *stare decisis*, faithfully apply *Menendez* and abolish the doctrine.

Second, I argue that the doctrine makes little sense on policy grounds.<sup>11</sup> Since the goal of trademark law is to protect the public,<sup>12</sup> courts have long recognized the requirement of proportionality—that a substantial portion of the public must be confused, deceived, or consider a mark non-distinctive—for the

---

MCCARTHY, *supra* note 3, § 19:75.

Other grounds for refusal, which are less common but relevant to this article, are geographic deceptiveness refusals. Under subsections 2(a) and 2(e)(3) of the Lanham Act, marks which deceive consumers as to the geographic source of the goods are not registrable. See 15 U.S.C. §§ 1052(a), 1052(e)(3) (2006); *In re Spirits Int'l, N.V.*, 563 F.3d 1347, 1353 (Fed. Cir. 2009).

<sup>5</sup> 563 F.3d 1347 (Fed. Cir. 2009).

<sup>6</sup> 15 U.S.C. § 1052(e)(3).

<sup>7</sup> See *Spirits*, 563 F.3d at 1356 n.5.

<sup>8</sup> 128 U.S. 514, 520 (1888).

<sup>9</sup> See *infra* Part VI.A.

<sup>10</sup> One court, however, implicitly suggested, without explanation, that *Menendez* may be an exception to the doctrine. See *infra* note 165.

<sup>11</sup> See *infra* Part VI.B.

<sup>12</sup> See, e.g., *Miller v. Glenn Miller Prods., Inc.*, 454 F.3d 975, 993 (9th Cir. 2006).

relevant statutory bar to registration to apply.<sup>13</sup> The doctrine of foreign equivalents disregards this long-standing principle and allows a mark to be refused registration where only an insignificant portion of the public can understand the mark and thus, consider it confusing, deceiving, or non-distinctive.<sup>14</sup> Moreover, the doctrine is unworkable since nearly every aspect of it is confusing or unreasoned, and *Spirits* has caused the Patent Office to apply the doctrine differently depending on the bar to registration at issue.<sup>15</sup>

I conclude that the Federal Circuit should continue what it started in *Spirits* and apply *stare decisis* as well as policy considerations to abolish the doctrine of foreign equivalents in its entirety. In Part II, I discuss the development of the doctrine, including its history beginning in the late nineteenth century. In Part III, I focus on the modern doctrine. In Part IV, I discuss the

---

<sup>13</sup> See *In re Spirits Int'l, N.V.*, 563 F.3d 1347, 1356 (Fed. Cir. 2009) (“[I]t is clear that section (e)(3)—like subsection (a), the false advertising provision of the Lanham Act, and the common law requires that a significant portion of the relevant consuming public be deceived.”); see also *Bayer Aktiengesellschaft v. Stamatios Mouratidis*, No. 77208071, 2010 WL 2191893, at \*3 (T.T.A.B. May 21, 2010) (recognizing that a mark is misdescriptive if “the misdescription [is] likely to affect a significant portion of the relevant consumers’ decision to purchase” (citing *In re Budge Mfg. Co. Inc.*, 857 F.2d 773 (Fed. Cir. 1988))); *In re Zuffa, LLC*, No. 76/273,529, 2003 WL 22055674, at \*6 (T.T.A.B. Aug. 29, 2003) (holding that a mark is descriptive if a “significant portion” of the purchasing public would consider it so).

Other bars to registration also apply the requirement of proportionality. See, e.g., *In re RK Netmedia, Inc.*, Nos. 77060742, 77060766, 2009 WL 1713998, at \*2 (T.T.A.B. May 21, 2009) (“[T]he determination of whether a proposed mark will be perceived as scandalous or immoral [under Section 2(a)] is ascertained from [the standpoint of] ‘a substantial composite of the general public.’” (quoting *In re Mavety Media Grp. Ltd.*, 33 F.3d 1367, 1371 (Fed. Cir. 1994))); *Toro Co. v. ToroHead Inc.*, 61 U.S.P.Q.2d (BNA) 1164, 1183 (T.T.A.B. 2001) (“[Dilution by] blurring occurs when a substantial percentage of consumers . . . associate the junior party’s use with the owner of the famous mark . . .”). The one exception is the bar on disparaging marks under Section 2(a), which is ascertained “from the standpoint of a substantial composite of the *referenced group*.” *In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d (BNA) 1215, 1218 (T.T.A.B. 2010) (citing *In re Heeb Media LLC*, 89 U.S.P.Q.2d (BNA) 1071, 1074 (T.T.A.B. 2008)).

<sup>14</sup> See *infra* Part VI.B.1.a.

<sup>15</sup> See *infra* Part VI.B.2.

Federal Circuit's recent *Spirits* decision. In Part V, I discuss the aftermath of *Spirits* in the Patent Office, and in Part VI, I argue that both policy considerations as well as Supreme Court precedent mandate the abolition of the doctrine of foreign equivalents.

## II. DEVELOPMENT OF THE DOCTRINE

### A. *Development of the Doctrine in the Patent Office*

Since the very inception of the doctrine of foreign equivalents, the Patent Office has been inconsistent in its application.<sup>16</sup> In 1876, the Patent Office applied the doctrine for the first time. In *Lawrence & Co.*,<sup>17</sup> the applicant attempted to register trademarks consisting of German words, which would be descriptive<sup>18</sup> of the goods to a German speaker.<sup>19</sup> The Commissioner, relying on the Supreme Court's seminal decision in *Delaware & Hudson Canal Co. v. Clark*,<sup>20</sup> explained that a mark may only be registered if it is "distinctive in its original signification."<sup>21</sup> The Commissioner interpreted the Supreme Court's "original signification" language to mean that a mark containing foreign words should be translated and then tested for the bars to registration.<sup>22</sup> Accordingly, the Commissioner translated the marks, held them to be descriptive,

---

<sup>16</sup> The doctrine had no formal name at the time. See *supra* note 3.

<sup>17</sup> 1876 Dec. Comm'r Pat. 155, cited with approval in *Ex parte Henderson*, 1898 Dec. Comm'r Pat. 647, 648.

<sup>18</sup> *Id.* at 156–57. Under nineteenth century trademark law, a mark was not registrable if it was "merely descriptive of an article of trade, of its qualities, ingredients, or characteristics." *Del. & Hudson Canal Co. v. Clark*, 80 U.S. (13 Wall.) 311, 323 (1871). Under modern trademark law, however, descriptive marks may be registered if they have acquired "secondary meaning." See 2 MCCARTHY, *supra* note 3, § 11:25. That is, descriptive marks may be registered if consumers consider "such marks as denoting only one seller or source." *Id.*; see 15 U.S.C. § 1052(f) (2006).

<sup>19</sup> *Lawrence*, 1876 Dec. Comm'r Pat. at 156.

<sup>20</sup> 80 U.S. (13 Wall.) 311.

<sup>21</sup> *Lawrence*, 1876 Dec. Comm'r Pat. at 156 (quoting *Clark*, 80 U.S. (13 Wall.) at 323). Under the 1870 Act, marks could only be registered if they were distinctive, i.e., not generic or merely descriptive. See *Clark*, 80 U.S. (13 Wall.) at 317.

<sup>22</sup> *Lawrence*, 1876 Dec. Comm'r Pat. at 156–57.

and affirmed the examiner's refusal of registration.<sup>23</sup>

But in at least one early case, foreign words were considered registrable by the Patent Office. In 1894, in *Ex parte Grove*,<sup>24</sup> the Commissioner explained that the mark at issue is not registrable since it "is not a fanciful term, *nor is it a foreign word*,"<sup>25</sup> suggesting that all foreign words are *per se* registrable.<sup>26</sup> In 1902, however, the Patent Office inexplicably changed course and again applied the doctrine.<sup>27</sup> The Patent Office, without mentioning *Grove* or *Lawrence*,<sup>28</sup> and instead relying on one of the first federal cases to apply the doctrine, adopted the federal case's reasoning and applied the doctrine.<sup>29</sup> The Patent Office has not looked back

---

<sup>23</sup> *Id.* at 157. *Lawrence*, however, was not the first case to consider the doctrine. At least one earlier state case had considered and rejected the doctrine. See *Rillet v. Carlier*, 61 Barb. 435 (N.Y. Sup. 1870) (syllabus) ("Where one has adopted a word from the French language . . . he acquires, by such adoption, a property in the use of the word as applied to the article he has made and introduced into the market, although the article was previously sold in France by the same name," even if the mark would be generic to French consumers.).

<sup>24</sup> 1894 Dec. Comm'r Pat. 69.

<sup>25</sup> *Id.* at 70 (emphasis added). "Arbitrary or fanciful marks are ones that do not communicate any information about the product either directly or by suggestion." *Star Indus., Inc. v. Bacardi & Co. Ltd.* 412 F.3d 373, 385 (2d Cir. 2005) (citation omitted). Arbitrary and fanciful marks receive the highest degree of protection. *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976) ("Arrayed in an ascending order which roughly reflects their eligibility to trademark status and the degree of protection accorded, these classes are (1) generic, (2) descriptive, (3) suggestive, and (4) arbitrary or fanciful."), *cited with approval* in *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992).

<sup>26</sup> *Grove*, 1894 Dec. Comm'r Pat. at 70. Some 40 years later, the applicant's successor was finally able to register the mark under the ten-year clause of the 1905 Trademark Act. See *Ex parte Paris Med. Co.*, 20 U.S.P.Q. (BNA) 164 (Comm'r Pat. 1934) (citing Act of Feb. 20, 1905, ch. 592, § 5, 33 Stat. 724, 725 (the "1905 Act") (declaring that descriptive marks are registrable if used exclusively "ten years next preceding the passage of this Act")); see also *Thaddeus Davids Co. v. Davids*, 233 U.S. 461 (1914) (discussing ten-year clause).

<sup>27</sup> *Ex parte Grocers Specialty Mfg. Co.*, 1903 Dec. Comm'r Pat. 10, 11–12.

<sup>28</sup> The Patent Office generally follows *stare decisis*. See *McCormick v. Cleal*, 1897 Dec. Comm'r Pat. 55, 63 ("[S]tare decisis must prevail here, as in the courts . . ."), *rev'd on other grounds*, 12 App. D.C. 335 (D.C. Cir. 1898).

<sup>29</sup> *Grocers Specialty*, 1903 Dec. Comm'r Pat. at 11–12 (citing *Dadirrian v.*

since and, with few exceptions,<sup>30</sup> has continued to apply the doctrine.<sup>31</sup> However, it was not until fifteen years after *Grove* that a court reviewing a decision of the Office would discuss the doctrine of foreign equivalents.<sup>32</sup>

*B. Development of the Doctrine in the D.C. Circuit and C.C.P.A.*

Under the first modern federal trademark registration act (the “1905 Act”),<sup>33</sup> Congress vested the Court of Appeals for the District of Columbia with appellate jurisdiction over trademark-related appeals from the Commissioner of Patents of the USPTO (the “Commissioner”).<sup>34</sup> In *In re Hercules Powder Co.*,<sup>35</sup> the applicant argued to the D.C. Circuit that the mark at issue would

---

Yacubian, 98 F. 872 (1st Cir. 1900)).

<sup>30</sup> The doctrine is not applied when it is “[un]likely that the ordinary American purchaser would ‘stop and translate [the word] into its English equivalent.’” *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1377 (Fed. Cir. 2005) (quoting *In re Pan Tex Hotel Corp.*, 190 U.S.P.Q. (BNA) 109, 110 (T.T.A.B. 1976)); see *infra* Part IV. This exception is quite limited, however, since the Patent Office has interpreted “ordinary American purchaser” to mean a purchaser “knowledgeable in the foreign language.” *In re Thomas*, 79 U.S.P.Q.2d (BNA) 1021, 1024 (T.T.A.B. 2006); *infra* Part IV.A. Such purchasers would “ordinarily be expected to translate words into English.” *In re Spirits Int’l, N.V.*, 563 F.3d 1347, 1352 (Fed. Cir. 2009).

<sup>31</sup> See, e.g., *In re Marchesi de Frescobaldi Societa Agricola S.p.A.*, No. 79021733, 2008 WL 3917506, at \*4 (T.T.A.B. Aug. 11, 2008) (“[I]t is accepted that [under the doctrine of foreign equivalents] ‘words from modern languages are generally translated into English.’” (quoting *Palm Bay*, 396 F.3d at 1377)).

<sup>32</sup> *In re Hercules Powder Co.*, 46 App. D.C. 52 (D.C. Cir. 1917).

<sup>33</sup> See the 1905 Act, ch. 592, 33 Stat. 724; see also 1 MCCARTHY, *supra* note 3, § 5:3 (discussing the 1870, 1881 and 1905 trademark acts). Although Congress had previously enacted interstate trademark registration legislation, it was struck down as unconstitutional in *The Trade-Mark Cases*. See Act of July 8, 1870, ch. 230, §§ 77–84, 16 Stat. 198, 210–212, *invalidated by The Trade-Mark Cases*, 100 U.S. 82 (1879). Two years after the 1870 Act was struck down by the Supreme Court, Congress passed another trademark registration act. See Act of March 3, 1881, ch. 138, 21 Stat. 502. This act, however, only provided for registration of marks used in commerce with foreign nations and Indian tribes, thus, excluding marks used in interstate commerce. See *id.* § 1.

<sup>34</sup> See the 1905 Act § 9 (vesting in the D.C. Circuit appellate jurisdiction over decisions of the USPTO Commissioner of Patents).

<sup>35</sup> 46 App. D.C. 52 (D.C. Cir. 1917).



not be descriptive to a large percentage of consumers and therefore was registrable.<sup>36</sup> The court, however, held that if a word is descriptive, it may not be registered, even if a large percentage of consumers would not consider it so.<sup>37</sup> To further illustrate its point, the court extended its analysis to the use of descriptive words in foreign languages, and marked the first time a USPTO primary reviewing court<sup>38</sup> recognized the doctrine of foreign equivalents, albeit in dicta:

A descriptive word in a foreign language, though meaningless to the public generally, would fall within the statute, since it is the real signification of the word or device, and not the idea which it may, or may not, convey to the general public, which brings it within the [descriptiveness bar of the 1905 Act].<sup>39</sup>

In 1929, Congress renamed the United States Court of Customs Appeals to the United States Court of Customs and Patent Appeals (the “C.C.P.A.”) and vested in it the D.C. Circuit’s former USPTO

---

<sup>36</sup> *Id.* at 54. Unlike the Lanham Act, under the 1905 Act, only fanciful and arbitrary marks were capable of registration. See *Standard Paint Co. v. Trinidad Asphalt Mfg. Co.*, 220 U.S. 446, 453 (1911) (“[N]o one can appropriate as a trademark a generic name or one descriptive of an article of trade, its qualities, ingredients, or characteristics, or any sign, word, or symbol which, from the nature of the fact it is used to signify, others may employ with equal truth.” (quoting *Trinidad Asphalt Mfg. Co. v. Standard Paint Co.*, 163 F. 977, 979 (8th Cir. 1908))); 1 MCCARTHY, *supra* note 3, § 5:3 (stating that, under the 1905 Act, “[o]nly ‘technical common-law trademarks’ could be registered. That is, only purely fanciful and arbitrary, not descriptive, marks could be registered.”).

<sup>37</sup> *Hercules Powder*, 46 App. D.C. at 54.

<sup>38</sup> The term “primary reviewing court” refers to the D.C. Circuit, the C.C.P.A. or the Federal Circuit in their respective periods of USPTO appellate jurisdiction. See, e.g., *In re Pharmavite LLC*, 91 U.S.P.Q.2d (BNA) 1778, 1780 (T.T.A.B. 2009) (referring to the Federal Circuit as the T.T.A.B.’s “primary reviewing court”); *In re Parkway Mach. Corp.*, 51 U.S.P.Q.2d (BNA) 1201, 1205 (T.T.A.B. 1999) (referring to the former C.C.P.A. as the T.T.A.B.’s “primary reviewing court”). Decisions of the Patent Office may also be reviewed by district courts. See 15 U.S.C. § 1071(b) (2006); 3 MCCARTHY, *supra* note 3, § 21:20.

<sup>39</sup> *Id.* Shortly thereafter, the D.C. Circuit decided its first true foreign equivalents case. In *In re Bradford Dyeing Ass’n*, 46 App. D.C. 512 (D.C. Cir. 1917), the court relied on *Hercules Powder* to hold that the French word “E’clatant,” meaning “brilliant, shining, glittering,” was descriptive of goods with a satin finish. *Id.* at 313, 315.

appellate jurisdiction.<sup>40</sup> The C.C.P.A. first addressed the issue of foreign equivalents in the highly influential case of *In re Northern Paper Mills*,<sup>41</sup> in which the court discussed whether a foreign word could be descriptive despite the fact that “the English language is the language of the people” of this country.<sup>42</sup> The C.C.P.A. surveyed the state of foreign equivalents law and held that the doctrine applies.<sup>43</sup> *Northern Paper Mills* also added an important exception to the doctrine—that it only applies to the “modern languages of the principal nations of the world.”<sup>44</sup>

Although the doctrine has been a part of trademark law for well over a century, most of its confusing exceptions and nuances have been developed over the past several decades by the Federal Circuit and the Patent Office’s trademark tribunal, the Trademark Trial and Appeal Board (the “T.T.A.B.” or the “Board”).<sup>45</sup>

---

<sup>40</sup> See Act of March 2, 1929, ch. 488, 45 Stat. 1475, 1475.

<sup>41</sup> 64 F.2d 998 (C.C.P.A. 1933), cited with approval in *In re Spirits Int’l*, N.V., 563 F.3d 1347, 1351 (Fed. Cir. 2009).

<sup>42</sup> *Id.* at 998.

<sup>43</sup> *Id.* *Northern Paper Mills* relies on Judge Learned Hand’s decision in *Coty, Inc., v. Le Blume Imp. Co.*, 292 F. 264 (S.D.N.Y.), *aff’d*, 293 F. 344 (2d Cir. 1923), for the proposition that “[a] foreign word used in the country of its origin, in a descriptive way, cannot be used as a trade-mark in this country.” *N. Paper Mills*, 64 F.2d at 999. *Coty*, however, stands for the opposite proposition. See *Coty*, 292 F. at 267 (“In [other] countries the name would be generic and no maker could monopolize it, but its meaning there does not affect its meaning here.”). On appeal, the Second Circuit agreed with Judge Hand and rejected the doctrine. See *Coty*, 292 F. at 358–59 (“[A] word which is not in general or common use, and is unintelligible and non-descriptive to the general public, although it may be known to linguists and scientists, may properly be regarded as arbitrary and fanciful, and capable of being used as a trade-mark.”). The Second Circuit’s rejection of the doctrine was recognized by the Fourth Circuit in *Pizzeria Uno Corp. v. Temple*, 747 F.2d 1522, 1531 n.7 (4th Cir. 1984) (quoting *Coty*, 292 F. at 358–59).

<sup>44</sup> *N. Paper Mills*, 64 F.2d at 999.

<sup>45</sup> Prior to 1958, the Commissioner of Patents of the USPTO heard appeals of final decisions of trademark Examiners. See the 1905 Act, ch. 592, § 8, 33 Stat. at 726–27. On August 8, 1958, Congress created the Trademark Trial and Appeal Board (the “T.T.A.B.” or the “Board”), which decides *inter partes* proceedings in the first instance as well as appeals from trademark examiners. See Act of Jan. 7, 1958, Pub. L. No. 85-609, 72 Stat. 540, 540.

### III. THE MODERN DOCTRINE

#### A. *In General*

During the second half of the twentieth century, the doctrine of foreign equivalents was developed in the Federal Circuit<sup>46</sup> on appeal from refusals of registration and *inter partes* proceedings in the USPTO,<sup>47</sup> as well as in the T.T.A.B.<sup>48</sup> The doctrine is, in almost every respect, poorly reasoned, confusing, and inconsistently applied.

The leading foreign equivalents case, often cited by the Patent Office and district courts,<sup>49</sup> is *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*.<sup>50</sup> In *Palm Bay*, the Federal Circuit summarized the doctrine as follows: “Under the doctrine of foreign equivalents, foreign words from common

---

<sup>46</sup> In 1982, Congress established the Court of Appeals for the Federal Circuit, which acquired the jurisdiction of the C.C.P.A. See The Federal Courts Improvement Act of 1982, Pub. L. No. 97-164, 96 Stat. 25. In its first opinion, the Federal Circuit held that decisions of its predecessor, the C.C.P.A., are binding precedent. See *S. Corp. v. United States*, 690 F.2d 1368, 1370 n.2 (Fed. Cir. 1982) (en banc).

<sup>47</sup> See, e.g., *In re Spirits Int'l, N.V.*, 563 F.3d 1347, 1350 (Fed. Cir. 2009) (appeal from *ex parte* refusal to register); *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1377 (Fed. Cir. 2005) (appeal from *inter partes* proceeding).

<sup>48</sup> Although district courts and regional circuits have applied the doctrine, these courts generally defer to the Federal Circuit and the T.T.A.B. For example, in *Sutter Home Winery, Inc. v. Madrona Vineyards, L.P.*, No. C 05-0587 MHP, 2005 WL 701599 (N.D. Cal. Mar. 23, 2005), the Northern District of California noted that although “[t]he Ninth Circuit has yet to opine on the applicability of the doctrine of foreign equivalents . . . the doctrine is well-established in trademark registration proceedings.” *Id.* at \*6 (citing *Palm Bay*, 396 F.3d at 1377; *In re Consol. Cigar Corp.*, 13 U.S.P.Q.2d (BNA) 1481, 1484 (T.T.A.B. 1989); *In re Am. Safety Razor Co.*, 2 U.S.P.Q.2d (BNA) 1459, 1460 (T.T.A.B. 1987)).

<sup>49</sup> See, e.g., *RE/MAX Int'l, Inc. v. Trendsetter Realty, LLC*, 655 F. Supp. 2d 679, 714 n.14 (S.D. Tex. 2009); *Habeeba's Dance of the Arts, Ltd. v. Knoblauch*, 430 F. Supp. 2d 709, 716 (S.D. Ohio 2006); *In re Unidos Fin. Servs., Inc.*, No. 77126814, 2010 WL 667922, at \*3 (T.T.A.B. Jan. 27, 2010); *In re Le Chateau De Ma Mere, Societe Anonyme*, No. 78624761, 2010 WL 3597250, at \*3 (T.T.A.B. Sept. 3, 2010).

<sup>50</sup> 396 F.3d 1369 (Fed. Cir. 2005).

languages are translated into English to determine the genericness, descriptiveness, as well as similarity of connotation in order to ascertain confusing similarity with English word marks.”<sup>51</sup> The Federal Circuit also explained the circumstances in which the doctrine should be applied. Relying on an influential T.T.A.B. decision, *In re Pan Tex Hotel Corp.*,<sup>52</sup> the court explained that the doctrine should only be applied “when it is likely that the ordinary American purchaser would ‘stop and translate [the word] into its English equivalent.’”<sup>53</sup> The *Palm Bay* court, however, neither defined “ordinary American purchaser,” nor explained the circumstances in which such a purchaser would translate the foreign mark.<sup>54</sup>

#### B. *The Common Language Requirement*

As mentioned above, the doctrine only applies in cases in which the foreign language is “common.”<sup>55</sup> The doctrine does not apply to “obsolete, dead, or obscure languages.”<sup>56</sup>

---

<sup>51</sup> *Id.* at 1377 (citing *In re Sarkli, Ltd.*, 721 F.2d 353 (Fed. Cir. 1983); *In re Am. Safety Razor Co.*, 2 U.S.P.Q.2d at 1460). Although the Federal Circuit only mentioned likelihood of confusion and distinctiveness, the doctrine applies to other bars. See, e.g., *In re Manufactura de Tabacos (Matasa) S.A.*, No. 07/090,638, 1999 WL 320873, at \*3 (T.T.A.B. May 12, 1999) (applying the doctrine in the primarily geographically descriptive bar context).

<sup>52</sup> 190 U.S.P.Q. (BNA) 109, 110 (T.T.A.B. 1976).

<sup>53</sup> *Palm Bay*, 396 F.3d at 1377 (alteration in original) (citing *Pan Tex Hotel*, 190 U.S.P.Q. at 110).

<sup>54</sup> *Id.*

<sup>55</sup> *Id.* (“Under the doctrine of foreign equivalents, foreign words from common languages are translated into English . . .”).

<sup>56</sup> *Enrique Bernat F., S.A. v. Guadalajara, Inc.* 210 F.3d 439, 443 (5th Cir. 2000) (citing 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:34 (4th ed. 1999)); see 3 LOUIS ALTMAN & MALLA POLLACK, CALLMANN ON UNFAIR COMPETITION, TRADEMARKS AND MONOPOLIES § 18:16 (4th ed. 2010) (“[W]ords which trace their ancestry to Latin, Greek or archaic Anglo-Saxon roots, and are not in common use . . . are fanciful.”). Judge Augustus Hand, writing for the Second Circuit, explained that, for the purposes of the doctrine, a foreign mark in Spanish “stands on quite a different footing from words taken from the language of Hottentots or Patagonians which might be so unfamiliar as to be in effect fanciful or arbitrary terms.” *McKesson & Robbins, Inc. v. Charles H. Phillips Chem. Co.*, 53 F.2d

Notwithstanding this rule, the Patent Office applies the doctrine to some very uncommon languages. Perhaps the most egregious example of this is the doctrine's application to Esperanto, a rarely used language invented in Poland in the late nineteenth century.<sup>57</sup> Another example is Afrikaans, which is spoken by a mere 0.007% of Americans.<sup>58</sup> The doctrine's common language requirement in theory protects the rights of would-be registrants by barring application of the doctrine to marks in obscure languages. In reality, however, courts and the Patent Office have arbitrarily chosen which languages are considered "common." Thus, would-be registrants cannot anticipate the languages to which the doctrine will apply, causing significant confusion.

C. *Words with Multiple Meanings—"Exact" Translations Required*

The Federal Circuit has held that, under the doctrine, foreign and English marks are only considered equivalents where they are exact, unambiguous equivalents of each other.<sup>59</sup> The T.T.A.B. has

---

1011, 1011 (2d Cir. 1931).

Other languages excluded from the doctrine include the Taino Language of the Indians of the Dominican Republic, *Gen. Cigar Co., Inc. v. G.D.M. Inc.*, 988 F. Supp. 647 (S.D.N.Y. 1997), the Native American Miwok tribal language, *In re Spirits of New Merced, LLC*, 85 U.S.P.Q.2d (BNA) 1614, 1618 (T.T.A.B. 2007), and the language of the Choctaw Native Americans, *Dadirrian v. Theodorian*, 37 N.Y.S. 611, 612 (N.Y. Sup. 1895).

<sup>57</sup> See *Ex parte Sanitary Knitting Co.*, 1911 Dec. Comm'r Pat. 220, 221; THE WORLD ALMANAC & ENCYCLOPEDIA 1908, 530 (1907), available at <http://books.google.com/> (search for "the world almanac" and "esperanto" and choose selection subtitled "Facts on File, Inc.—1907"). It was "almost unknown in the United States until 1905." *Id.*

<sup>58</sup> See U.S. Census Bureau, *Detailed Languages Spoken at Home and Ability to Speak English for the Population 5 Years and Over for the United States: 2006–2008*, CENSUS.GOV (Apr. 2010), <http://www.census.gov/population/www/socdemo/language/detailed-lang-tables.xls>.

<sup>59</sup> See *In re Sarkli, Ltd.*, 721 F.2d 353, 354–55 (Fed. Cir. 1983). The applicant in *Sarkli* attempted to register the French mark "repêchage." *Id.* at 353. The examiner and the T.T.A.B. applied the doctrine and refused registration based on a likelihood of confusion with the previously registered "second chance" mark. *Id.* On appeal, the Federal Circuit noted that "repêchage" translates to,

interpreted this ruling to stand for the proposition that words are not foreign equivalents where a foreign word has multiple English meanings.<sup>60</sup> In developing this element of the doctrine, however, neither the Board nor the Federal Circuit has attempted to explain why a consumer who speaks both English and a foreign language would not be confused if the foreign word has multiple English meanings. Indeed, the Board did not attempt to explain why a foreign language speaker would not be confused between a foreign word and *all* of its English equivalents.

*D. The Heart of the Doctrine—The Likelihood of Translation Requirement*

The likelihood of translation requirement—that an ordinary purchaser “stop and translate” the foreign mark—is the threshold requirement for application of the doctrine.<sup>61</sup> Neither the Federal

---

among other things, “reprieve,” and “make up or second chance examination” in the academic world. *Id.* at 354. The court explained that although “[e]ach of these meanings in a broad sense connotes giving a second chance[.] . . . this is not the same as saying that ‘repêchage’ is equivalent to ‘second chance.’” *Id.* The court in *Sarkli* held that marks, under the doctrine, must be exact equivalents. *Id.* at 354–55. The court noted, however, that marks may not have to be exact synonyms if they are similar in sight and sound. *Id.*

<sup>60</sup> *In re OpBiz*, No. 77055011, 2009 WL 873127, at \*6 (T.T.A.B. Mar. 19, 2009) (citing *In re Buckner*, 6 U.S.P.Q.2d (BNA) 1316, 1317 (T.T.A.B. 1987)). In *OpBiz*, the applicant attempted to register the mark “heart.” *Id.* at \*1. The examiner, applying the doctrine, refused registration on the ground that “heart” is confusingly similar to the registered trademark “kokoro,” the Japanese word for heart. *Id.* at \*1–2 (citation omitted). On appeal to the T.T.A.B., the examining attorney argued that “heart” and “kokoro” are foreign equivalents, relying on a listing from a Japanese-English dictionary as well as the translation statement from the “kokoro” registration. *Id.* at \*2. The applicant argued, however, that “the Japanese word ‘kokoro’ has multiple English meanings besides ‘heart,’ including ‘mind,’ ‘spirit,’ ‘mentality,’ ‘thought,’ ‘will’ and ‘intention.’” *Id.* at \*3. The T.T.A.B. agreed with the applicant and concluded that the “Japanese term has multiple English translations, only one of which is ‘heart.’ While the translations may be somewhat similar, they are not exact. Based on the dictionary evidence, we agree with applicant that ‘kokoro’ has a broader meaning than just ‘heart,’ thereby rendering the two words not foreign equivalents.” *Id.* at \*6.

<sup>61</sup> See *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1377 (Fed. Cir. 2005); see also *In re Optica Int’l*, 196

Circuit nor the T.T.A.B. has explained the exact criteria to determine whether a mark is unlikely to be translated. However, case law has recognized the following instances in which a consumer would be unlikely to translate a foreign mark: (1) foreign words which have entered the English vernacular; (2) grammatically incorrect foreign phrases; (3) marks on canned goods; and (4) goods encountered in an environment associated with the relevant foreign culture.

1. *Foreign Words Which Have Entered the English Vernacular*

Perhaps the most commonly recognized instance of unlikely translation is a foreign mark which has entered the English vernacular. The leading case on the matter is *Continental Nut Co. v. Le Cordon Bleu*,<sup>62</sup> in which the court examined whether "Cordon Bleu" was the equivalent of its literal French translation, "Blue Ribbon."<sup>63</sup> The court, agreeing with the T.T.A.B., explained that "[t]he French term is not so unusual to the American public because it is defined in American Dictionaries."<sup>64</sup> Indeed, English dictionaries define the term as "a person regarded as entitled to a badge of eminent distinction; specif., a first class cook, particularly a woman cook."<sup>65</sup> Therefore, despite their literal equivalence, the marks "would not have the same significance to the American public," since "'BLUE RIBBON' and 'CORDON BLEU' create different commercial impressions."<sup>66</sup> For this reason, the Federal Circuit held the doctrine inapplicable where the word has entered the English vernacular and changed meanings.<sup>67</sup>

---

U.S.P.Q. (BNA) 775, 777 (T.T.A.B. 1977) (citing *Le Cordon Bleu, S.A.R.L. v. Cont'l Nut Co.*, 177 U.S.P.Q. (BNA) 734 (T.T.A.B. 1973) ("*Cont'l Nut I*"), *aff'd*, 494 F.2d 1395 (C.C.P.A. 1974)); *In re Pan Tex Hotel Corp.*, 190 U.S.P.Q. (BNA) 109, 110 (T.T.A.B. 1976)); *In re Tia Maria, Inc.*, 188 U.S.P.Q. (BNA) 524, 525-26 (T.T.A.B. 1975).

<sup>62</sup> 494 F.2d 1395 (C.C.P.A. 1974) ("*Cont'l Nut II*"); *see also* *Cont'l Nut Co. v. Le Cordon Bleu*, 494 F.2d 1397 (C.C.P.A. 1974) ("*Cont'l Nut III*").

<sup>63</sup> *Continental Nut II*, 494 F.2d at 1396.

<sup>64</sup> *Id.* (quoting *Cont'l Nut I*, 177 U.S.P.Q. at 735).

<sup>65</sup> *Id.* (quoting *Cont'l Nut I*, 177 U.S.P.Q. at 735).

<sup>66</sup> *Id.* (quoting *Cont'l Nut I*, 177 U.S.P.Q. at 735).

<sup>67</sup> *Id.* at 1396 n.6 ("Such a finding precludes application of the doctrine of foreign equivalents." (citation and internal quotation marks omitted)).

However, the court did not explain why an American purchaser fluent in a foreign language would fail to translate a foreign mark even if it has a second non-literal meaning in English. For example, many foreign language speakers who are not native English speakers may be unaware of English idioms and may, for this reason, translate foreign marks literally.

## 2. *Grammatically Incorrect Phrases*

The Board has also noted that consumers may not “stop and translate” a grammatically incorrect foreign phrase.<sup>68</sup> In *In re Trimarchi*,<sup>69</sup> the applicants attempted to register a French mark “Allez Filles!” and provided the literal translation “go girls!”<sup>70</sup> The examiner refused registration on the ground of confusing similarity with the previously registered “go girl” mark.<sup>71</sup> In reversing the examiner’s decision, the T.T.A.B. held that “it is not clear that French speakers would even stop and translate this phrase because it is grammatically incorrect and they may simply ‘take it as it is.’”<sup>72</sup>

The Board, however, gave absolutely no reason why a French speaker would not translate two very simple words even if they are grammatically incorrect. This rule is also confusing in that it does not provide a clear standard—there is no indication of whether all grammatically incorrect phrases would be excepted from translation or where the bar would be set.

## 3. *Marks on Canned Goods*

The T.T.A.B. has held that a consumer is not likely to translate a foreign mark where the mark is on a canned food label. In the oft-cited *In re Tia Maria, Inc.*<sup>73</sup> case, the applicant attempted to

---

<sup>68</sup> *In re Trimarchi*, No. 77222086, 2009 WL 1692509, at \*3 (T.T.A.B. May 14, 2009).

<sup>69</sup> No. 77222086, 2009 WL 1692509 (T.T.A.B. May 14, 2009).

<sup>70</sup> *Id.* at \*4.

<sup>71</sup> *Id.* at \*2.

<sup>72</sup> *Id.* at \*6 (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1377 (Fed. Cir. 2005)).

<sup>73</sup> 188 U.S.P.Q. (BNA) 524 (T.T.A.B. 1975), cited with approval in *In re Spirits Int’l, N.V.*, 563 F.3d 1347, 1352 (Fed. Cir. 2009); *Palm Bay*, 396 F.3d at



register “Tia Maria” for restaurant services.<sup>74</sup> The examiner refused registration based on a likelihood of confusion with the registered mark “Aunt Mary’s,” for canned fruits and vegetables.<sup>75</sup> The Board reversed the examiner, holding that despite the literal equivalence of the “Tia Maria” and “Aunt Mary’s” marks, there are foreign marks which “even those familiar with the language will not translate, accepting the term as it is, and situations arise in the marketplace which make it unfeasible or even unlikely *that purchasers will translate the brand names or labels appearing on canned foods and other like products.*”<sup>76</sup>

The Board did not explain why a purchaser would not translate brand names or labels on canned foods. Nor did it explain exactly what a “like product” is. Would-be registrants, therefore, are left to guess as to when something is similar enough to a label appearing on canned food so as to make the doctrine of foreign equivalents inapplicable.

#### 4. *Goods Encountered in an Environment Associated with the Relevant Foreign Culture*

In *Tia Maria*, the Board also implied that a purchaser is unlikely to translate a foreign mark where the environment in which he encounters the mark is saturated with décor associated with the foreign language.<sup>77</sup> The Board explained that “upon dining at the ‘TIA MARIA’ restaurant in Mexican decor and surrounded by a menu of Mexican delicacies,” it is unlikely that a purchaser would translate the mark.<sup>78</sup> The Board, again, gave no reasoning as to why someone fluent in English and a foreign language would not translate the foreign mark simply because of the type of restaurant in which they encounter the mark. It is thus difficult for a would-be registrant to predict whether the context in

---

1377; *In re Thomas*, 79 U.S.P.Q.2d (BNA) 1021, 1025–27 (T.T.A.B. 2006); *In re Am. Safety Razor Co.*, 2 U.S.P.Q.2d (BNA) 1459, 1459 (T.T.A.B. 1987).

<sup>74</sup> *In re Tia Maria, Inc.*, 188 U.S.P.Q. (BNA) 524, 525 (T.T.A.B. 1975).

<sup>75</sup> *Id.* at 525.

<sup>76</sup> *Id.* at 525–26 (emphasis added).

<sup>77</sup> *Id.* at 526.

<sup>78</sup> *Id.*

which his mark is used would make it unlikely for it to be translated.

In sum, neither the Board nor the Federal Circuit have delineated exactly in which cases an American consumer would refuse to translate a mark, taking it as is. Further, both the Board and the Federal Circuit have failed to provide any reasoning as to why a foreign language speaking consumer would not translate a mark in any of their cases. This complete lack of guidance forces the would-be registrant to guess whether the doctrine will be applied in their case and undermines the predictability which is critical to the trademark system.

#### E. *Burden of Proof*

The Federal Circuit and the regional circuits have yet to squarely consider whether the burden of proof of likelihood of translation—the threshold limitation to application of the doctrine of foreign equivalents—falls on the party attempting to use the doctrine or the party against whom it is used. However, the Federal Circuit has implied, without discussion, that the applicant has the burden of proving that a consumer who speaks the foreign language would not translate the mark.<sup>79</sup> In *In re Spirits International, N.V.*<sup>80</sup>, the Federal Circuit explained that since the “applicant does not contend that the specific context of the mark is such that an ordinary American purchaser sufficiently familiar with Russian would nonetheless take the mark at face value,” the doctrine applies.<sup>81</sup> The T.T.A.B. has also failed to consider the issue directly. However, in practice, the Board requires the applicant to prove a lack of likelihood of translation.<sup>82</sup> In contrast,

---

<sup>79</sup> *In re Spirits Int'l, N.V.*, 563 F.3d 1347, 1352 (Fed. Cir. 2009).

<sup>80</sup> 563 F.3d 1347 (Fed. Cir. 2009)

<sup>81</sup> *Id.* (emphasis added).

<sup>82</sup> See e.g., *In re La Peregrina Ltd.*, 86 U.S.P.Q.2d (BNA) 1645, 1648 (T.T.A.B. 2008). Although the Board in *Peregrina* did not explicitly explain which party bears the burden of proof, it held that because “[t]here is no compelling evidence in the record to establish that the mark would not be translated,” the doctrine applies. *Id.* This, of course, implies that, in an *ex parte* proceeding, the burden is on the applicant to prove that a consumer would not translate the foreign mark.

several district courts have considered the issue and, unlike the T.T.A.B., concluded that the proponent of the doctrine bears the burden of proof.<sup>83</sup> A New Jersey district court held that since the party attempting to use the doctrine of foreign equivalents has “offered no evidence to support an inference that U.S. consumers are likely to translate the mark[,] . . . the predicate condition for application of the doctrine of foreign equivalents has not been satisfied,” and thus, the doctrine does not apply.<sup>84</sup> Similarly, an Ohio district court noted “some doubts about whether the ordinary American purchaser would stop and translate [the foreign mark] into its English equivalent,” and that “[d]iscovery is needed to test the [proponent of the doctrine’s] argument on this issue.”<sup>85</sup>

Neither the Federal Circuit, the T.T.A.B., nor any regional circuit has squarely addressed who has the burden of proving likelihood of translation—the threshold to application of the doctrine of foreign equivalents. This is yet another point of confusion and unpredictability in the doctrine.

#### IV. THE ORDINARY AMERICAN PURCHASER AND *IN RE SPIRITS INTERNATIONAL*

As discussed, the doctrine is only applied when the “ordinary American purchaser” would likely translate the mark into English.<sup>86</sup> However, what seems to be a relatively straightforward rule becomes murky when one considers the definition of “ordinary American purchaser.” The Federal Circuit recently attempted to clarify this important point in *In re Spirits International* but only created more uncertainty in the T.T.A.B. and the trademark world in general.

---

<sup>83</sup> See *Habeeba's Dance of the Arts, Ltd. v. Knoblauch*, 430 F. Supp. 2d 709, 716 (S.D. Ohio 2006); *Lazzaroni USA Corp. v. Steiner Foods*, No. Civ. 05-4476 (JAG), 2006 WL 932345, at \*4 (D.N.J. Apr. 11, 2006).

<sup>84</sup> See *Lazzaroni*, 2006 WL 932345, at \*4.

<sup>85</sup> *Habeeba's Dance of the Arts*, 430 F. Supp. 2d at 716.

<sup>86</sup> *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1377 (Fed. Cir. 2009) (alteration in original) (citing *In re Pan Tex Hotel Corp.*, 190 U.S.P.Q. (BNA) 109, 110 (T.T.A.B. 1976)).

A. *In re Thomas: The Ordinary American Purchaser in the T.T.A.B.*

In the seminal foreign equivalents case, *Palm Bay*, the Federal Circuit held that the doctrine of foreign equivalents should only be applied “when it is likely that the *ordinary American purchaser* would stop and translate the word into its English equivalent.”<sup>87</sup> The court, however, never defined “ordinary American purchaser.”

Shortly after *Palm Bay* was decided, the T.T.A.B. purported to define “ordinary American purchaser” in *In re Thomas*.<sup>88</sup> In *Thomas*, the applicant attempted to register the French mark, “marche noir,” meaning “black market.”<sup>89</sup> The applicant argued that the doctrine of foreign equivalents should not apply because only 0.6% of the U.S. population speaks French, making it unlikely that the average American consumer would translate the mark.<sup>90</sup>

Disagreeing with the applicant, the Board noted that according to a leading trademark treatise, “[t]he test is whether, to those American buyers *familiar with the foreign language*, the word would denote its English equivalent.”<sup>91</sup> It explained that although “the doctrine is not an absolute rule . . . the applicant’s interpretation of it would write the doctrine out of existence.”<sup>92</sup> The *Thomas* Board held that “[t]he ‘ordinary American purchaser’ in this context refers to the ordinary American purchaser who is *knowledgeable in the foreign language*.”<sup>93</sup> In subsequent cases, the T.T.A.B. has consistently applied the *Thomas* definition of “ordinary American purchaser” to include only those purchasers familiar with both English and the foreign language at issue.<sup>94</sup>

---

<sup>87</sup> *Palm Bay*, 396 F.3d at 1377 (emphasis added) (quoting *Pan Tex Hotel*, 190 U.S.P.Q. (BNA) at 110) (internal quotation marks and alteration omitted).

<sup>88</sup> 79 U.S.P.Q.2d (BNA) 1021 (T.T.A.B. 2006).

<sup>89</sup> *Id.* at 1024.

<sup>90</sup> *Id.*

<sup>91</sup> *Id.* (emphasis added) (quoting 4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23:26 (4th ed. 2006)).

<sup>92</sup> *Id.*

<sup>93</sup> *Id.* (emphasis added) (citing *Nestle’s Milk Prods., Inc. v. Baker Importing Co., Inc.*, 182 F.2d 193 (C.C.P.A. 1950); 4 MCCARTHY, *supra* note 91, § 23:26).

<sup>94</sup> See, e.g., *In re La Peregrina Ltd.*, 86 U.S.P.Q.2d (BNA) 1645, 1647–48 (T.T.A.B. 2008); *In re OpBiz, LLC*, No. 77055011, 2009 WL 873127, at \*5

B. *In re Spirits International: Thomas Abrogated and the Doctrine Partially Abolished*

The Federal Circuit's recent *In re Spirits International* decision seemed to abrogate *Thomas* and at least partially abolish the doctrine—but not without creating the usual confusion associated with the doctrine's application.<sup>95</sup> In *Spirits*, the applicant attempted to register the Russian language mark “Moskovskaya,” meaning “of or from Moscow,” for vodka.<sup>96</sup> The T.T.A.B. affirmed the examiner's refusal of registration under subsection (2)(e)(3) of the Lanham Act<sup>97</sup> for being primarily geographically deceptively misdescriptive<sup>98</sup> of the goods, since the vodka was not

---

(T.T.A.B. Mar. 19, 2009); *In re Manuel Jacinto, LDA*, No. 78905244, 2008 WL 4674597, at \*3 (T.T.A.B. Sept. 29, 2008).

<sup>95</sup> See Elizabeth J. Rest, *Lost in Translation: A Critical Examination of Conflicting Decisions Applying the Doctrine of Foreign Equivalents*, 96 TRADEMARK REP. 1211, 1211 (2006) (noting that courts have reached “irreconcilable holdings” in applying the doctrine); John L. Welch, *TTAB Clarifies Doctrine of Equivalents, Affirms 2(e)(3) Refusal of “MOSKOVSKAYA” for Vodka*, THE TTABLOG (Feb. 19, 2008), <http://thettablog.blogspot.com/2008/02/precedential-no-6-ttab-clarifies.html> (“*Palm Bay* [was] more confusing than enlightening.”).

<sup>96</sup> *In re Spirits Int'l, N.V.*, 563 F.3d 1347, 1349–50 (Fed. Cir. 2009).

<sup>97</sup> “[T]he Lanham Act is the paramount source of trademark law in the United States, as interpreted almost exclusively by the federal courts.” *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 782 n.16 (1992) (Stevens, J., concurring) (internal quotation marks omitted) (quoting Trademark Review Commission, 77 TRADEMARK REP. 375, 377 (1987)). Under the Lanham Act, a mark's registration on the principal register is “prima facie evidence of the validity of the registered mark and of the registration of the mark, of the owner's ownership of the mark, and of the owner's exclusive right to use the registered mark.” 15 U.S.C. § 1057(b) (2006); see also 3 MCCARTHY, *supra* note 3, § 19:9 (discussing advantages of registration).

<sup>98</sup> This bar prevents registration of marks that deceive consumers as to the geographic source of the goods. See 2 MCCARTHY, *supra* note 3, § 14:31. Specifically:

the PTO must deny registration under [15 U.S.C.] § 1052(e)(3) if (1) the primary significance of the mark is a generally known geographic location, (2) the consuming public is likely to believe the place identified by the mark indicates the origin of the goods bearing the mark, when in fact the goods do not come from that place, and (3) the misrepresentation was a material factor in the consumer's decision.

*In re Cal. Innovations, Inc.*, 329 F.3d 1334, 1341 (Fed. Cir. 2003).

actually from Moscow.<sup>99</sup>

The applicant's primary argument to the Federal Circuit on appeal was that *Thomas* and its progeny misinterpreted the Federal Circuit's "ordinary American purchaser" language in *Palm Bay*.<sup>100</sup> Specifically, the applicant argued that "the Board erroneously held that [a mark must be considered] from the perspective of consumers of vodka who speak the foreign language, not of vodka consumers in general," as required by Federal Circuit precedent.<sup>101</sup> The court agreed with the applicant and abrogated *Thomas*, holding that "[t]he 'ordinary American purchaser' . . . includes all American purchasers, including those proficient in a non-English language who would ordinarily be expected to translate words into English."<sup>102</sup> In other words, the relevant purchaser is simply the ordinary purchaser of the goods, irrespective of whether he speaks the relevant foreign language.<sup>103</sup>

Later in the opinion, however, the Federal Circuit applied the threshold limitation to the doctrine—the likelihood of translation analysis. The court held that the doctrine applied, since "in this

---

<sup>99</sup> *Cal. Innovations*, 329 F.3d at 1350–51; see 15 U.S.C. § 1052(e)(3) (2006).

<sup>100</sup> Brief of Appellant at 10–15, *In re Spirits International N.V.*, 563 F.3d 1347 (Fed. Cir. 2009) (No. 2008-1369), 2008 WL 2967606. Commentators have also criticized *Thomas*' holding as being in tension with *Palm Bay*. See Jordan S. Weinstein, *Ex Parte Cases*, 99 TRADEMARK REP. 17, 34 (2009) ("[I]t is difficult to reconcile how *In re Thomas* and *Palm Bay Imports* apply the foreign equivalents doctrine."); John L. Welch, *TTAB Attempts to Clarify Doctrine of Foreign Equivalents in Affirming 2(d) Refusal of "MARCHE NOIR,"* THE TTABLOG (May 3, 2006), <http://thettablog.blogspot.com/2006/05/citable-no-25-ttab-attempts-to-clarify.html> ("Is the Board's ruling [in *In re Thomas*] at odds with *Palm Bay* when it says that the 'ordinary American purchaser' means someone *knowledgeable in French*? [In *Palm Bay*, t]he CAFC and the TTAB seemed to say that the average American purchaser would be unlikely to translate VEUVE into 'widow' because he or she is unlikely to be aware of the French word. In other words, the average American purchaser does not know French.").

<sup>101</sup> Brief of Appellant, *supra* note 100, at 9–10.

<sup>102</sup> *Spirits*, 563 F.3d at 1352 (emphasis added).

<sup>103</sup> See *id.*; see also Anthony L. Fletcher and Steven M. Weinberg, *The Thirty-Eighth Year of Administration of the Lanham Trademark Act of 1946*, 75 TRADEMARK REP. 573, 590 n.103 (1985) ("[T]he focus [of the doctrine of foreign equivalents] should be on the public to whom the product is marketed.").

case the applicant does not contend that the specific context of the mark is such that an ordinary American purchaser *sufficiently familiar with Russian* would nonetheless take the mark at face value.”<sup>104</sup> The court appeared to use the *Thomas* definition of “ordinary American purchaser,” despite repudiating it earlier in the opinion.<sup>105</sup> Even though the court held that the doctrine of foreign equivalents applies, the court did not utilize the English equivalent of the mark as required under the doctrine. Instead, the court—without explanation—treated the mark as foreign throughout the rest of the opinion.<sup>106</sup>

After finding the doctrine applicable, the court explained that “[o]nce the word or phrase is translated [under the doctrine of foreign equivalents], its impact must be ‘material’ under subsection 2(e)(3). The question here is the scope of the materiality requirement.”<sup>107</sup> The court held that subsection 2(e)(3) of the Lanham Act, embodies a requirement that “a substantial portion of the relevant consumers is likely to be deceived, not whether any absolute number or *particular segment of the relevant consumers (such as foreign language speakers)* is likely to be deceived.”<sup>108</sup>

The *Spirits* court’s holding essentially disavowed any use of the doctrine, since consumers who do not speak the foreign language would generally be unable to translate the foreign mark, and thus the doctrine would not apply.<sup>109</sup> *Spirits* is, therefore,

---

<sup>104</sup> *Spirits*, 563 F.3d at 1352 (emphasis added).

<sup>105</sup> *See id.*

<sup>106</sup> *See id.* at 1352–57.

<sup>107</sup> *Id.* at 1352; *see In re Cal. Innovations, Inc.*, 329 F.3d 1334, 1341 (Fed. Cir. 2003) (“[T]he PTO must deny registration under § 1052(e)(3) if (1) the primary significance of the mark is a generally known geographic location, (2) the consuming public is likely to believe the place identified by the mark indicates the origin of the goods bearing the mark, when in fact the goods do not come from that place, and (3) the misrepresentation was a material factor in the consumer’s decision.”).

<sup>108</sup> *Spirits*, 563 F.3d at 1353 (emphasis added).

<sup>109</sup> *See In re Thomas*, 79 U.S.P.Q.2d (BNA) 1021, 1024 (T.T.A.B. 2006) (recognizing that an interpretation of the Federal Circuit’s “ordinary American purchaser” language which includes purchasers who do not understand the foreign language “would write the doctrine out of existence” (citing *Palm Bay*

completely incompatible with *Thomas*, which held that the doctrine is applicable “despite the fact that [a mark] may be meaningless to the public generally.”<sup>110</sup>

The court in *Spirits* criticized the Board for applying the doctrine and “reject[ing] a requirement of proportionality,”<sup>111</sup> that is, the requirement that a substantial percentage of the relevant consuming public be deceived.<sup>112</sup> The court vacated the Board’s decision because the Board failed to consider whether Russian speakers were a “substantial portion of the intended audience.”<sup>113</sup> The court noted that a mere 0.25% of the U.S. population speaks

---

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

Note, Spanish speakers, who constitute approximately 12% of the population, may be considered a “substantial portion” under *Spirits*. See *infra* notes 178–180, 188 and accompanying text. However, *Spirits* does not consider the likelihood that some foreign language speakers would not be confused. Moreover, a large percentage of Spanish speakers in the United States do not speak English very well and thus would not be confused between a Spanish and English mark. See *infra* Part VI.B.1.a.ii. Hence, even if the proportion of Spanish speakers is “substantial,” the combination of these two factors would likely lower the proportion of consumers likely to be confused by a Spanish language mark to an insubstantial portion of the public.

Aside from Spanish, no foreign language is spoken by Americans at a rate of greater than 1% of the population, which would certainly not be considered a “substantial portion” under *Spirits*. See U.S. Census Bureau, *supra* note 58. I note that Census data only considers people who speak the foreign language *at home*, not in general. Although there appears to be no data regarding the percentage of Americans who speak each foreign language without speaking it at home, any difference this might make is ignored by the Patent Office and the courts. Indeed, the Patent Office instructs its examiners to rely on census data in refusing registration under the doctrine of foreign equivalents. See TMEP § 1207.01(b)(vi)(B) (6th ed. Rev. 1, Oct. 2009). Similarly, the Federal Circuit in *Spirits* also relied on this census data in a foreign equivalents context. *Spirits*, 563 F.3d at 1357; see also *In re Tokutake Indus. Co., Ltd.*, 87 U.S.P.Q.2d (BNA) 1697, 1699–1700 & n.1 (T.T.A.B. 2008) (citing U.S. Census language statistics in foreign equivalents context).

<sup>110</sup> *Thomas*, 79 U.S.P.Q.2d at 1024 (quoting *Nestle’s Milk Prods., Inc. v. Baker Importing Co., Inc.*, 182 F.2d 193, 196 (C.C.P.A. 1950)).

<sup>111</sup> *Spirits*, 563 F.3d at 1357 (citing *In re Spirits Int’l N.V.*, 86 U.S.P.Q.2d (BNA) 1078, 1085 (T.T.A.B. 2008)).

<sup>112</sup> *Id.* at 1356; see also *infra* Part VI.B.1.a.i.

<sup>113</sup> *Spirits*, 536 F.3d at 1356.



Russian, which “would not be, by any measure, a substantial portion.”<sup>114</sup> The court did leave room for the possibility that Russians may be overrepresented in the vodka consuming public or that non-Russian speakers may nevertheless understand the Russian mark to suggest that the vodka comes from Moscow, and it remanded to the Board for a determination of whether there is “material deception under the correct legal test.”<sup>115</sup>

The “correct legal test,” according to *Spirits*, then seems to be *not* to apply the doctrine of foreign equivalents, at least in cases involving geographical deception. The Board essentially had two choices on remand. First, if it determined that Russians are significantly overrepresented in the vodka consuming public or that a large percentage of the non-Russian speaking consuming public will understand the mark to suggest that the vodka is associated with Moscow, then the Board could have found prima facie materiality, since a “substantial portion of the intended audience” would be materially deceived whether or not the doctrine is applied.<sup>116</sup> Second, if the Board determined that few consumers other than Russian speakers would understand the meaning of the mark, then the Board would have been required to hold that subsection 2(e)(3) did not bar registration. In either instance, there was no place for the doctrine of foreign equivalents in the Board’s analysis. Because the court’s reasoning was not limited to the facts of this case, but instead would apply to all subsection 2(e)(3) cases, *Spirits* effectively abolished the doctrine in cases concerning primarily geographically deceptively misdescriptive marks under subsection 2(e)(3).

---

<sup>114</sup> *Id.*

<sup>115</sup> *Id.*

<sup>116</sup> *Id.* at 1355. A prima facie case may be rebutted if the applicant can “establish that the presumption of materiality is not, in fact, valid.” *Spirits*, 86 U.S.P.Q.2d (BNA) at 1090 n.20. For example, the applicant may rebut the prima facie case by survey evidence. *Id.* In its vacated opinion, the Board held that “the survey does not serve to rebut the examining attorney’s prima facie case.” *See id.* at 1088. The Federal Circuit noted, however, that “the Board’s rejection of the survey as rebutting the prima facie case . . . was heavily influenced by its incorrect view of materiality.” *Spirits*, 563 F.3d at 1357.

## V. *SPIRITS*' AFTERMATH

### A. *The Board's Decision on Remand*

After the remand from the Federal Circuit in *Spirits*, the Board acknowledged that it applied an “incorrect test for materiality in determining that the mark was geographically deceptive.”<sup>117</sup> The Board recognized that the proper test is “whether a *substantial portion* of the relevant consumers is likely to be deceived, not whether any absolute number *or particular segment of the relevant consumers (such as foreign language speakers)* is likely to be deceived.”<sup>118</sup> In effect, the Board acknowledged that the doctrine of foreign equivalents is inapplicable in subsection 2(e)(3) cases.<sup>119</sup> Instead of analyzing the issue, however, the Board remanded to the examiner to give him “an opportunity to apply the new test to this case.”<sup>120</sup> Following the remand from the Board, the examiner simply allowed the application without comment.<sup>121</sup>

### B. *The Examination Procedures and the Trademark Manual of Examining Procedure*

In examining trademark applications, examiners rely on the Trademark Manual of Examining Procedure (the “TMEP”).<sup>122</sup> Shortly after the Federal Circuit decided *Spirits*, the Patent Office issued “Examination Procedures for § 2(a) and § 2(e)(3) Deceptiveness Refusals for Geographic Marks” (the “Examination

---

<sup>117</sup> *In re Spirits Int'l N.V.*, No. 74382759, at \*2 (T.T.A.B. July 29, 2009), <http://ttabvue.uspto.gov/ttabvue/v?pno=74382759&pty=EXA&eno=24> (quoting *Spirits*, 563 F.3d at 1349).

<sup>118</sup> *Id.* (emphases added) (quoting *Spirits*, 563 F.3d at 1353).

<sup>119</sup> *See id.*

<sup>120</sup> *Id.* at \*2–3.

<sup>121</sup> *See* United States Patent and Trademark Office, Notice of Allowance, No. 74382759, *Spirits International N.V.* (Feb. 2, 2010), <http://tportal.uspto.gov/external/portal/tow> (search by Number 74382759; then follow “Notice of Allowance” hyperlink).

<sup>122</sup> “The Manual contains guidelines for Examining Attorneys and materials in the nature of information and interpretation, and outlines the procedures which Examining Attorneys are required or authorized to follow in the examination of trademark applications.” TMEP, foreword (6th ed. Rev. 2, May 2010).

Procedures”)<sup>123</sup> to supplement the TMEP. The Patent Office, relying on *Spirits*, explained that in a primarily geographically deceptively misdescriptive analysis under subsection 2(e)(3), refusal is only proper if “misdescription in the mark would affect a *substantial portion* of the relevant consumers’ decision to purchase the goods/services.”<sup>124</sup> Further, the Patent Office explained that—contrary to *Thomas*—either: (1) the foreign words must be “recognizable as such to consumers who *do not speak the foreign language*”; or (2) consumers who speak the foreign language must be the “target audience.”<sup>125</sup> These procedures effectively abolished the doctrine of foreign equivalents in the Patent Office with respect to geographic deceptiveness refusals.<sup>126</sup>

In the likelihood of confusion<sup>127</sup> section, the TMEP now explains, quoting *Spirits*, that “[t]he ‘ordinary American purchaser’ includes ‘all American purchasers, including those proficient in a non-English language who would ordinarily be expected to translate words into English.’”<sup>128</sup> At least according to the writers

<sup>123</sup> *Examination Guide 2-09, Examination Procedures for § 2(a) and § 2(e)(3) Deceptiveness Refusals for Geographic Marks*, UNITED STATES PATENT AND TRADEMARK OFFICE, (May 11, 2009), <http://www.uspto.gov/web/offices/tac/notices/examguide2-09.htm>. Between updates of the TMEP, the Patent Office issues interim examination procedures which supplement it. See *Trademarks—Manuals, Guides, Official Gazette*, UNITED STATES PATENT AND TRADEMARK OFFICE (Mar. 17, 2010), <http://www.uspto.gov/trademarks/resources/index.jsp>.

<sup>124</sup> *Examination Guide 2-09*, *supra* note 1233 (emphasis added) (citing *In re Spirits*, Int’l, N.V., No. 2008-1369, slip op. at 9 (Fed. Cir. Apr. 29, 2009)).

<sup>125</sup> *Id.* (emphasis added) (quoting *Spirits*, No. 2008-1369, slip op. at 15–16).

<sup>126</sup> Following the publication of the Examination Procedures, the Patent Office incorporated the procedures into the new edition of the TMEP. See TMEP § 1209.03 (6th ed. Rev. 1, Sept. 2009).

<sup>127</sup> A mark may be refused registration under the likelihood of confusion bar if it:

so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.

15 U.S.C. § 1052(d) (2006).

<sup>128</sup> See TMEP § 1207.01(b)(vi)(A) (6th ed., Rev. 2, May 2010) (quoting *In re Spirits* Int’l, N.V., 563 F.3d 1347, 1352 (Fed. Cir. 2009)).

of the TMEP, which is generally followed by examiners,<sup>129</sup> *Spirits*' definition of "ordinary American purchaser" is not only limited to geographic deceptiveness refusals but also to refusals for likelihood of confusion.

However, in the following section entitled "When an Ordinary American Purchaser Would 'Stop and Translate,'" the TMEP states that if "the English translation is 'literal and direct,' with no contradictory evidence of other relevant meanings or shades of meaning, then the doctrine should be applied, barring unusual circumstances."<sup>130</sup> Essentially, examiners are instructed to always apply the doctrine "barring unusual circumstances." This part of the TMEP ignores *Spirits*' holding that the ordinary American purchaser includes all purchasers, not just those familiar with the relevant foreign language (who would generally be likely to "stop and translate" the foreign mark).<sup>131</sup> Thus, in one section, the TMEP appears to extend *Spirits*' reasoning to likelihood of confusion cases making its application much less likely. In another section, to the contrary, examiners are instructed to simply apply the doctrine "barring unusual circumstances." This glaring contradiction, of course, adds to the confusion associated with the doctrine.

### C. The Board's Current Approach

Several weeks after the Federal Circuit decided *Spirits*, the Board discussed *Spirits*' impact for the first time.<sup>132</sup> In *In re Trimarchi*, a likelihood of confusion case, the Board applied the doctrine of foreign equivalents but noted that the Federal Circuit "explicitly reserved judgment as to 'the scope of the doctrine of

---

<sup>129</sup> See *supra* note 1222.

<sup>130</sup> See TMEP § 1207.01(b)(vi)(B). The "other relevant meanings" language appears to be a reference to the holding of *In re Buckner*, 6 U.S.P.Q.2d (BNA) 1316 (T.T.A.B. 1987), and its progeny. See *supra* note 60 and accompanying text.

<sup>131</sup> See TMEP § 1207.01(b)(vi)(B). Not using *Spirits*' much broader definition of the ordinary American purchaser all but guarantees that the doctrine will be applied. See *supra* note 102 and accompanying text.

<sup>132</sup> See *In re Trimarchi*, No. 77222086, 2009 WL 1692509, at \*6 n.7 (T.T.A.B. May 14, 2009).

foreign equivalents in other contexts [than geographically misdescriptive marks].”<sup>133</sup> The Board recognized that had the Federal Circuit not included language in *Spirits* limiting its applicability to primarily geographically deceptively misdescriptive marks, the Board would have to consider “the potential number of consumers of these general consumer products who speak or understand French in terms of proportion to all consumers of these goods.”<sup>134</sup> However, since *Spirits* did include the limiting language, the Board relied on *Thomas* for the familiar proposition that “[t]he ‘ordinary American purchaser’ in this context refers to the ordinary American purchaser who is knowledgeable in the foreign language,” and the Board applied the doctrine under this standard.<sup>135</sup>

Under the Board’s new reasoning, when analyzing a foreign mark for geographic deceptiveness, the Board will consider the mark from the standpoint of the ordinary American purchaser, including the majority of purchasers who do not speak the pertinent foreign language.<sup>136</sup> For all other bars to registration, however, the Board will continue to apply *Thomas* and only consider the mark’s effect on purchasers who speak the foreign language.<sup>137</sup> Thus, according to the Board’s apparent reasoning, the ordinary American purchaser changes depending on the bar to registration at issue. This interpretation is quite unreasonable because the ordinary American purchaser does not actually change depending on the bar to registration at issue.

The Board’s new splintered approach of applying the doctrine

---

<sup>133</sup> *Id.* at \*6 n.7 (quoting *In re Spirits Int’l, N.V.*, 563 F.3d 1347, 1356 n.5 (Fed. Cir. 2009)).

<sup>134</sup> *See id.*

<sup>135</sup> *Id.* at \*3 (quoting *In re Thomas*, 79 U.S.P.Q.2d (BNA) 1021, 1024 (T.T.A.B. 2006)).

<sup>136</sup> *See id.* at \*6 n.7.

<sup>137</sup> *See id.* at \*3; *see also In re Unidos Fin. Servs., Inc.*, No. 77126814, 2010 WL 667922, at \*3 (T.T.A.B. Jan. 27, 2010) (applying the *Thomas* definition of “ordinary American purchaser” in a likelihood of confusion rejection); *Marquez Bros. Int’l, Inc. v. Zucrum Foods, L.L.C.*, No. 92048266, 2009 WL 4956033, at \*3 (T.T.A.B. Dec. 11, 2009) (applying the *Thomas* definition of “ordinary American purchaser” in a genericness rejection).

of foreign equivalents to some bars but not others is completely unreasoned and has no basis in foreign equivalents law. Indeed, the Board has not even attempted to explain why the doctrine would apply to some bars but not others, beyond stating summarily that *Spirits* was a limited holding.<sup>138</sup> For the sake of uniformity and predictability, the Federal Circuit should extend *Spirits* and abolish the doctrine at its next opportunity.

## VI. THE DOCTRINE SHOULD BE ABOLISHED

Until *Spirits*, the Federal Circuit and its predecessors had unwaveringly applied the doctrine of foreign equivalents for nearly a century. I argue, however, that the doctrine should be abolished for two reasons. First, the Supreme Court's decision in *Menendez v. Holt* forecloses the doctrine's application.<sup>139</sup> Second, the doctrine is inconsistent with the basic policy goal of trademark law and is unworkable.<sup>140</sup>

### A. *The Doctrine is Contrary to Binding Supreme Court Precedent*

The doctrine runs afoul of binding United States Supreme Court precedent. Indeed, the Supreme Court has rejected the doctrine, albeit in the nineteenth century. In *Holt v. Menendez*,<sup>141</sup> the trademark owner sued to enjoin the use of its registered mark "La Favorita."<sup>142</sup> The Circuit Court held that the trademark was valid and infringed,<sup>143</sup> and the alleged infringer appealed to the Supreme Court.<sup>144</sup>

On appeal in *Menendez v. Holt*, the alleged infringer urged the

---

<sup>138</sup> See *Spirits*, 563 F.3d at 1356 n.5 ("In this case we address only subsection (e)(3) and its materiality requirement. We have no occasion here to decide the scope of the doctrine of foreign equivalents in other contexts.").

<sup>139</sup> See *infra* Part VI.A.

<sup>140</sup> See *infra* Part VI.B.

<sup>141</sup> 23 F. 869 (C.C.S.D.N.Y. 1885), *aff'd*, 128 U.S. 514 (1888).

<sup>142</sup> *Id.* at 869. The trademark owner also sued for money damages, which the court held was barred due to laches. *Id.* at 870–71 (citing *McLean v. Fleming*, 96 U.S. 245 (1877)).

<sup>143</sup> *Id.* at 870.

<sup>144</sup> See *Menendez v. Holt*, 128 U.S. 514 (1888).

Supreme Court to translate the mark prior to analyzing it for distinctiveness, arguing that “[t]he term ‘La Favorita’” is descriptive since “[i]t indicates that it is the ‘favorite’ brand of [the trademark owner],” which signifies only quality.<sup>145</sup> The Supreme Court rejected the alleged infringer’s argument, holding that the mark was not merely descriptive because it “did not, of course, in itself indicate quality, for it was *merely a fancy name, and in a foreign language.*”<sup>146</sup>

Although the Supreme Court could have been more explicit in stating that the mark was fanciful *because* it was in a foreign language, it is clear that the mark “The Favorite”—the English equivalent of “La Favorita”—would not have been registrable since it is self-laudatory and descriptive.<sup>147</sup> Thus, the Supreme

---

<sup>145</sup> Brief of Appellants at 22, *Menendez v. Holt*, 128 U.S. 514 (1888) (Nos. 76, 77) (emphasis added). Note, it is proper to consider the briefs when construing Supreme Court decisions. See *Cantor v. Detroit Edison Co.*, 428 U.S. 579, 587–92 (1976) (plurality opinion).

<sup>146</sup> *Menendez*, 128 U.S. at 520 (emphasis added). In the nineteenth and early twentieth centuries, the terms “fancy” and “fanciful” were interchangeable. Compare *id.* at 515 (declaring that the mark “consisted of the fanciful words ‘La Favorita.’”) with *id.* at 520 (“[F]or it was merely a fancy name, and in a foreign language.”); see also *United States v. Forty Barrels and Twenty Kegs of Coca Cola*, 241 U.S. 265, 286 n.3 (1916) (“A ‘distinctive name’ is a trade, arbitrary, or fancy name.”) (citation omitted); *Walter Baker & Co. v. Baker*, 77 F. 181, 189 (C.C. Va. 1896) (recognizing that “an arbitrary or fancy name” is not descriptive of the quality of the good).

<sup>147</sup> See generally *Del. & Hudson Canal Co. v. Clark*, 80 U.S. (13 Wall.) 311, 324 (1871) (“[One] has no right to the exclusive use of [marks], which have no relation to the origin or ownership of the goods . . . but are only meant to indicate . . . quality. He has no right to appropriate a [mark which] others may employ with equal truth, and therefore have an equal right to employ for the same purpose.” (quoting *Amoskeag Mfg. Co. v. Spear*, 2 Sandf. 599, 606–07 (N.Y. Super. 1849))); 2 MCCARTHY, *supra* note 3, § 11:17 (recognizing that self-laudatory marks—such as “speedy,” “friendly,” “best,” “premier,” “deluxe,” “greatest,” and “number one”—are not registrable).

Indeed, the word “favorite” is considered self-laudatory and descriptive. See *Cooke & Cobb Co. v. Miller*, 62 N.E. 582, 583 (N.Y. 1902) (recognizing that the word “Favorite” is “in common use [and] is not the subject of exclusive appropriation as a trade-mark by any one”), cited with approval in *Hughes v. Alfred H. Smith Co.*, 205 F. 302, 310 (S.D.N.Y.) (finding that the word “favorite” is descriptive since it “indicate[s], in a way, a grade [of goods], that

Court must have held the mark to be fanciful because it was in a foreign language. Accordingly, since the Supreme Court held that foreign language marks should not be translated, application of the doctrine is foreclosed. Although the Federal Circuit and its predecessors have applied the doctrine for almost a century, *Menendez* plainly rejected the doctrine, and so must the Federal Circuit.<sup>148</sup>

### 1. *Recognition of Menendez's Rejection of the Doctrine*

Several years after the Supreme Court decided *Menendez*, the Patent Office acknowledged the Court's rejection of the doctrine. In *Ex parte Lewis Pattberg & Bros.*,<sup>149</sup> the applicant attempted to register the mark "The Favorite." In affirming the examiner's refusal of registration, the Commissioner acknowledged that in *Menendez*, the Supreme Court upheld the validity of "La Favorita,"

---

grade regarded with particular favor and preferred by users"), *aff'd*, 209 F. 37 (2d Cir. 1913); *In re* 800-Gifthouse, Inc., No. 75/016,128, 1999 WL 612964, at \*2 (T.T.A.B. Aug. 11, 1999) (holding that "World's Favorite Florist" is laudatory and merely descriptive); *In re* Winner Int'l Royalty Corp., No. 75/082,025, 1999 WL 149824, at \*2 (T.T.A.B. Mar. 17, 1999) (finding that "America's Favorite" is laudatory and merely descriptive); *In re* Wileswood, Inc., 201 U.S.P.Q. (BNA) 400, 404 (T.T.A.B. 1978) (acknowledging that "America's Favorite Popcorn" is laudatory and merely descriptive).

In the period *Menendez* was decided, the Patent Office also refused registration of laudatory marks, including "the favorite." See *Ex parte* Lewis Pattberg & Bros., 53 Ms. Dec. 49 (Comm'r Pat. Aug. 1, 1893) (Manuscript Decisions, Commissioner of Patents) (on file with author) (recognizing that "'The Favorite'" comes within the Supreme Court's prohibition of marks that "indicate the character, kind, quality and composition of the article [and] cannot be exclusively appropriated by any one" (citing *Clark*, 80 U.S. at 324)); see also *Ex parte* Peerless Carbon Black Co., Ltd., 1897 Dec. Comm'r Pat. 791, 791-92 ("The word 'peerless' is such a word as is ordinarily used by merchants in a laudatory sense to extol their goods. . . . This word falls within that class of words, such as 'incomparable,' 'sterling,' 'standard,' 'wonderful,' 'superior,' 'most excellent,' 'famous,' 'splendid,' 'unrivaled,' etc. which have been properly refused registration.").

<sup>148</sup> Although *Menendez* was decided over 120 years ago, under vertical *stare decisis*, lower courts are bound to follow it irrespective of its age. See *infra* note 162 and accompanying text.

<sup>149</sup> 53 Ms. Dec. 49 (Comm'r Pat. Aug. 1, 1893) (Manuscript Decisions, Commissioner of Patents) (on file with author).



the foreign equivalent of the mark at issue.<sup>150</sup> The Commissioner, however, explained that the Supreme Court only held “La Favorita” to be registrable because it was “‘in a foreign language,’ thereby drawing a clear line of distinction between that case and the present one.”<sup>151</sup> Thus, the Patent Office recognized that *Menendez* stands for the proposition that marks “in a foreign language” are fanciful.<sup>152</sup>

Similarly, in *Ex parte Qualitas Patent Leather Corp.*,<sup>153</sup> the applicant attempted to register “Qualitas,” the Latin foreign equivalent of “Quality.”<sup>154</sup> The Commissioner first explained that “quality” is generally refused registration as descriptive.<sup>155</sup> However, citing *Menendez*, the Commissioner held that “courts have frequently upheld descriptive words in a foreign language,” and allowed the mark.<sup>156</sup>

---

<sup>150</sup> *Id.* at \*1.

<sup>151</sup> *Id.* at \*\*1–2 (quoting *Menendez*, 128 U.S. at 520).

<sup>152</sup> *See id.*

<sup>153</sup> 131 Ms. Dec. 399, (Comm’r Pat. July 30, 1919) (Manuscript Decisions, Commissioner of Patents), *reprinted in* 9 TRADEMARK REP. 517 (1919)).

<sup>154</sup> *Id.*

<sup>155</sup> *Id.* (citing *Ex parte Brackett, Shaw & Lunt Co.*, 124 Ms. Dec. 215 (Comm’r Pat. Sept. 28, 1917) (Manuscript Decisions, Commissioner of Patents), *reprinted in* 7 TRADEMARK REP. 601 (1917)). At least one commentator has also recognized *Menendez*’s rejection of the doctrine with respect to a mark’s distinctiveness. The commentator noted that *Menendez* “held that a foreign language term functioned, in the U.S., as a protect[a]ble ‘fanciful’ or ‘arbitrary’ mark.” Gerard F. Rogers, Note, *From Eveready to Park ‘N Fly: Has a Decade of Development for the Lanham Act Re-charged Trademark Law or Left the Customer Without a Place to Park*, 22 NEW ENG. L. REV. 165, 182 n.160 (1987) (citing *Menendez*, 128 U.S. 514). Interestingly, the commentator is now Acting Chief Administrative Trademark Judge of the T.T.A.B. and author of several opinions applying the doctrine of foreign equivalents. *See, e.g., In re Andin International Inc.*, No. 77142267, 2009 WL 625572 (T.T.A.B. Feb. 27, 2009) (Rogers, J.); *In re Manufactura de Tabacos (Matasa) S.A.*, No. 75/150,300, 1999 WL 1211685 (T.T.A.B. Dec. 9, 1999) (Rogers, J.); *Trademark Trial and Appeal Board—About the Trademark Trial and Appeal Board*, UNITED STATES PATENT AND TRADEMARK OFFICE, <http://www.uspto.gov/trademarks/process/appeal/index.jsp> (last visited Nov. 4, 2010). Judge Rogers was also on the T.T.A.B. panel that decided *Spirits*. *See In re Spirits Int’l N.V.*, 86 U.S.P.Q.2d (BNA) 1078, 1079 (T.T.A.B. 2008).

<sup>156</sup> *Qualitas*, 131 Ms. Dec. 399 (citing *Menendez v. Holt*, 128 U.S. 514

Aside from these early cases, the Board and virtually all courts<sup>157</sup> considering the doctrine of foreign equivalents have inexplicably failed to address the holding of *Menendez*. By ignoring Supreme Court precedent and continuing to apply and develop the doctrine, the Patent Office, the Federal Circuit and its predecessors have created a complex and confusing body of law that should never have existed.

## 2. *The Scope of Menendez*

Since so few courts have addressed *Menendez* in a doctrine of foreign equivalents context, its scope must be determined before its reasoning can be properly applied. There are two ways to interpret the scope of *Menendez*. A broader reading of *Menendez* would prohibit translation of foreign marks to test them for any bar to registration, recognizing the Supreme Court's total rejection of the doctrine of foreign equivalents. A narrower reading of *Menendez*, however, would limit its holding to prohibiting application of the doctrine only when testing marks for distinctiveness, the specific bar at issue in *Menendez*.

The former approach, abolishing the doctrine in its entirety, is preferable. No court has ever held or suggested that the doctrine should be applied to some bars but not others.<sup>158</sup> Making this

---

(1888)); *see also* Ad. Richter & Co., 135 Ms. Dec 84, (Comm'r Pat. June 5, 1920) (Manuscript Decisions, Commissioner of Patents), *reprinted in* 10 TRADEMARK REP. 414, 414–15 (1920) (citing *Menendez*, 128 U.S. 514).

<sup>157</sup> The one modern court to briefly mention *Menendez* in a doctrine of foreign equivalents context implied, without explanation, that *Menendez* is merely an exception to the doctrine. *See Pizzeria Uno Corp. v. Temple*, 747 F.2d 1522, 1534 & n.9 (4th Cir. 1984) (quoting *Menendez*, 128 U.S. at 520); *infra* note 165.

<sup>158</sup> *See Lazzaroni USA Corp. v. Steiner Foods*, No. Civ. 05-4476(JAG), 2006 WL 932345, at \*4 (D.N.J. Apr. 11, 2006) (“[C]ourts apply the doctrine of foreign equivalents to treat words in a foreign language as if they are in English.” (citing *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardio Maison Fondée En 1772*, 396 F.3d 1369, 1377 (Fed. Cir. 2005))); *In re Manufactura de Tabacos (Mastasa) S.A.*, No. 75/090,638, 1999 WL 320873, at \*2 (T.T.A.B. May 12, 1999) (“It is well settled that normally no distinctions can be made between English terms and their foreign equivalents for purposes of registrability . . .” (citations omitted)); 2 MCCARTHY, *supra* note 3, §§ 11:34, 12:41 (discussing the doctrine as it applies to distinctiveness); 4 MCCARTHY, *supra* note 3, § 23:36 (discussing the doctrine as it applies to likelihood of

distinction simply has no basis, either in law or in logic. Indeed, there is no reason the doctrine's primary policy rationale of protecting multilingual Americans would apply to some bars but not others.

Construing *Menendez* narrowly would also lead to a convoluted and arbitrary procedure and results. Under such a narrow reading, the doctrine would be applied as follows. First, a court would translate a foreign mark and test it for all the statutory bars to registration. Second, upon translation, if a mark were unregistrable due to lack of distinctiveness, a court would then apply *Menendez* (narrowly construed), "un-translate" the mark, and allow registration. The same procedure would apply if the mark could only be refused registration as geographically deceptive under *Spirits*. This simply cannot be what the Supreme Court had in mind. Such a convoluted procedure would lead to added confusion for applicants and their attorneys and increase transaction costs. These transaction costs would then be passed down to the consuming public. Moreover, this confusion would lead to less predictable decision-making amongst trademark applicants since applicants would have to predict what bars may be at issue in order to know whether the doctrine may apply to their mark.<sup>159</sup>

On the other hand, under the complete abrogation approach, the process would be very straightforward. Foreign marks would simply never be translated prior to being tested for the bars to registration.

No court has ever held that the doctrine should apply only to certain bars.<sup>160</sup> It is thus highly unlikely that the Court meant to

---

confusion). Of course, the *Spirits* court did limit its analysis to primarily geographically deceptively misdescriptive marks, but the court reserved decision with respect to other contexts. See *In re Spirits Int'l*, N.V., 563 F.3d 1347, 1356 n.5 (Fed. Cir. 2009).

<sup>159</sup> Cf. *Citizens United v. Federal Election Comm'n*, 130 S. Ct. 876, 920 (2010) ("*Stare decisis* is the preferred course because it promotes the evenhanded, predictable, and consistent development of legal principles . . . ." (quoting *Payne v. Tennessee*, 501 U.S. 808, 827 (1991))).

<sup>160</sup> See *supra* note 158.

exempt from the doctrine the descriptiveness bar—one of the most common<sup>161</sup> grounds for refusal of registration—but apply the doctrine to all other bars without providing any reasoning for this difference in treatment. Hence, courts should interpret *Menendez* broadly by abolishing the doctrine in its entirety.

### 3. Lower Courts Must Follow *Menendez*

*Stare decisis* requires that the Federal Circuit abolish the doctrine of foreign equivalents. It is axiomatic that lower courts are bound by the decisions of the Supreme Court.<sup>162</sup> The Supreme Court has instructed that “lower courts should follow the case which directly controls, leaving to [the Supreme] Court the prerogative of overruling its own decisions.”<sup>163</sup> Any argument that *Menendez* fits within the likelihood of translation exception to the modern foreign equivalents doctrine<sup>164</sup>—that an American purchaser would not stop and translate the foreign mark—must fail.<sup>165</sup>

---

<sup>161</sup> See, e.g., Philip J. Greene, *Trademark Counsel in the Federal Government—A Practitioner's Perspective*, 86 J. PAT. & TRADEMARK OFF. SOC'Y 361, 381 (2004) (“[T]rademark applications are usually (at least preliminarily) refused by a Trademark Examiner for one of two reasons: (1) the mark is confusingly similar to a previously registered or pending mark, or (2) the mark is merely descriptive.”).

<sup>162</sup> See generally *Hutto v. Davis*, 454 U.S. 370, 375 (1982) (per curiam) (“[A] precedent of this Court must be followed by the lower federal courts no matter how misguided the judges of those courts may think it to be.”). Moreover, lower courts have a duty to follow *Menendez*, irrespective of the decision's considerable age. See Donald H. Zeigler, *Gazing into the Crystal Ball: Reflections on the Standards State Judges Should Use to Ascertain Federal Law*, 40 WM. & MARY L. REV. 1143, 1210–11 (1999) (recognizing that lower courts have no power to declare Supreme Court precedent dead, irrespective of its age); *id.* at 1211 (“The Supreme Court may take this position because it has the power to resuscitate apparently dead precedent and will occasionally choose to do so.” (citation omitted)).

<sup>163</sup> *Agostini v. Felton*, 521 U.S. 203, 207 (1997) (citing *Rodriguez de Quijas v. Shearson/Am. Exp., Inc.*, 490 U.S. 477, 484 (1989)); see also *State Oil Co. v. Khan*, 522 U.S. 3, 20 (1997) (“[I]t is [the Supreme] Court's prerogative alone to overrule one of its precedents.”).

<sup>164</sup> See *supra* note 30 and Part III.D.

<sup>165</sup> One court seemed to make such an argument implicitly. See *Pizzeria Uno Corp. v. Temple*, 747 F.2d 1522, 1534 & n.9 (4th Cir. 1984) (quoting *Menendez*

First and foremost, a lower court may not attempt to force the Supreme Court's holding into an exception to the modern doctrine, because such an exception was not considered by the *Menendez* court. In refusing to disregard century old, "defunct"<sup>166</sup> but directly applicable Supreme Court holdings, the Seventh Circuit recently opined:

Plaintiffs say that a decision of the Supreme Court has "direct application" only if the opinion expressly considers the line of argument that has been offered to support a different approach. Yet few opinions address the ground that later opinions deem sufficient to reach a different result. *If a court of appeals could disregard a decision of the Supreme Court by identifying, and accepting, one or another contention not expressly addressed by the Justices, the Court's decisions could be circumvented with ease. They would bind only judges too dim-witted to come up with a novel argument.*<sup>167</sup>

Thus, it would be improper to argue that *Menendez* may be reconciled with modern foreign equivalents doctrine because "it is [unlikely] that the ordinary American purchaser would 'stop and translate ['La Favorita'] into its English equivalent,'"<sup>168</sup> as this would be a novel argument not considered by the *Menendez* Court.

Second, *Menendez* would not fit within the Federal Circuit's "likelihood of translation" exception to the doctrine because it is clear that even a purchaser who does not speak Spanish could translate "favorita" to "favorite." Indeed, such an argument would

---

v. Holt, 128 U.S. 514, 520 (1888)). As an alternative to applying the doctrine of foreign equivalents, the *Pizzeria Uno* court held that the mark at issue—"Uno"—was registrable since it can be analogized to "La Favorita," which the Supreme Court held to be fanciful. *Id.* at 1534 (quoting *Menendez*, 128 U.S. at 520). The Fourth Circuit, however, gave no explanation as to why "La Favorita" is an exception to the doctrine of foreign equivalents instead of the rule.

<sup>166</sup> Nat'l Rifle Ass'n of Am. v. Chi., 567 F.3d 856, 858 (7th Cir. 2009) (Easterbrook, C.J.), *rev'd on other grounds sub nom.* McDonald v. Chi., 130 S. Ct. 3020 (2010).

<sup>167</sup> *Id.* at 857–58 (emphasis added); *see also id.* at 858 ("If a court of appeals may strike off on its own, this not only undermines the uniformity of national law but also may compel the Justices to grant certiorari before they think the question ripe for decision.").

<sup>168</sup> Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772, 396 F.3d 1369, 1377 (Fed. Cir. 2005) (citation omitted).

be untenable because “favorita” is nearly identical to “favorite.” Courts have long recognized that foreign words which are very similar to English words would be understood by consumers even if they do not speak the foreign language.<sup>169</sup> For example, the Second Circuit has held, “[t]here can be no doubt that the word which is the subject of the trade-mark—thermogene—whether it be spelled with or without the final ‘e,’ whether it be treated as having an English or a French derivation, is a word descriptive of [the goods].”<sup>170</sup> Thus, it is clear that even purchasers unfamiliar with Spanish would likely be able to translate “favorita” to “favorite.” Consequently, *Menendez* forecloses application of the doctrine, and it should therefore be abolished.

#### B. Policy Considerations

In addition to the Federal Circuit’s duty to abolish the doctrine of foreign equivalents under principles of *stare decisis*, policy considerations also militate toward abolition of the doctrine. Specifically, the doctrine impermissibly “protects” any group of multilingual Americans by refusing registration to marks that may confuse any group of foreign language speakers, even if that group is of a negligible size. This “protection” is, unfortunately, at the expense of the rest of the public (including other groups of multilingual Americans), which is deprived of the ability to distinguish goods in the marketplace through a registered trademark.<sup>171</sup> Moreover, the doctrine is so riddled with confusion, lack of reasoning and inconsistency that it is unworkable,<sup>172</sup> and trademark law would simply be more predictable without it.

---

<sup>169</sup> *Thermogene Co., Ltd. v. Thermozone Co., Inc.*, 234 F. 69, 70 (2d Cir. 1916); *In re Tricom Media Holdings, Inc.*, No. 76668320, 2008 WL 5417463, at \*1 (T.T.A.B. Dec. 18, 2008) (recognizing that “horas” is so similar to “hours” that it “may even be understood by even those with limited knowledge of Spanish”); *In re Bayer Aktiengesellschaft*, No. 78212751, 2005 WL 3395183, at \*4 (T.T.A.B. Dec. 1, 2005) (“The mere addition of the letter ‘A’ at the end of the generic term “aspirin” is simply insufficient to transform [the Spanish word] ASPIRINA into an inherently distinctive mark.”), *aff’d*, 488 F.3d 960 (Fed. Cir. 2007).

<sup>170</sup> *Thermogene*, 234 F. at 70.

<sup>171</sup> See *infra* Part VI.B.1.b.

<sup>172</sup> See *infra* Part VI.B.2.

# 1. *Protection of Multilingual Americans*

## a. *The Doctrine Is Antithetical to a Basic Goal of Trademark Law*

The principal goal of trademark law is to “protect the public's expectation regarding the source and quality of goods.”<sup>173</sup> Indeed, the public protection rationale has been called the “basic policy” of trademark law.<sup>174</sup> Of course, protecting the public does not mean protecting every single member thereof.<sup>175</sup> Instead, trademark law embodies a proportionality requirement.<sup>176</sup>

### i. *The Doctrine Violates the Proportionality Requirement*

Trademark law requires that an “appreciable” or “substantial” number of consumers be deceived, confused or otherwise affected by a mark in order for the relevant statutory bar to registration to apply.<sup>177</sup> The test is whether a “substantial portion” of the public is

---

<sup>173</sup> *Miller v. Glenn Miller Prods., Inc.*, 454 F.3d 975, 993 (9th Cir. 2006) (citation omitted); *see also* *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 782 n.15 (1992) (Stevens, J., concurring) (recognizing that a goal of trademark law is to “protect the public so it may be confident that, in purchasing a product bearing a particular trade-mark which it favorably knows, it will get the product which it asks for and wants to get” (quoting S. REP. NO. 1333, at 3 (1946))).

<sup>174</sup> *Zippo Mfg. Co. v. Rogers Imps., Inc.*, 216 F. Supp. 670, 694 (S.D.N.Y. 1963) (citing *Norwich Pharmacal Co. v. Sterling Drug, Inc.*, 271 F.2d 569, 570–71 (2d Cir. 1959)).

<sup>175</sup> *Scarves by Vera, Inc. v. Todo Imps., Ltd.*, 544 F.2d 1167, 1175 (2d Cir. 1976) (“A trademark owner need not prove that a junior user's conduct will mislead all customers . . .”).

<sup>176</sup> *See supra* note 13.

<sup>177</sup> *See, e.g.*, *Starbucks Corp. v. Wolfe's Borough Coffee, Inc.*, 588 F.3d 97, 114 (2d Cir. 2009) (appreciable number) (citation omitted); *Malletier v. Burlington Coat Factory Warehouse Corp.*, 426 F.3d 532, 534 (2d Cir. 2005) (substantial number); *Nautilus Group, Inc. v. ICON Health and Fitness, Inc.*, 372 F.3d 1330, 1338 (Fed. Cir. 2004) (appreciable number) (quoting *Entrepreneur Media, Inc. v. Smith*, 279 F.3d 1135, 1151 (9th Cir. 2002)). The “appreciable number” standard was first adopted by courts in the early twentieth century. *See, e.g.*, *Guth Chocolate Co. v. Guth*, 215 F. 750, 760 (D. Md. 1914), *aff'd*, 224 F. 932 (4th Cir. 1915). This standard was, in turn, adopted by the Restatement of Torts. *See* RESTATEMENT (FIRST) OF TORTS § 728 cmt. a (1938) (“[T]he issue [in a likelihood of confusion analysis] is whether an appreciable number of prospective purchasers of the goods or services” are confused.), *quoted with approval in* *Eastern Wine Corp. v. Winslow Warren Ltd., Inc.*, 137 F.2d 955, 960 (2d Cir. 1943). The similar “substantial number” standard was

affected by the relevant bar to registration.<sup>178</sup> Although the exact proportion of consumers to be considered “substantial” is not statutorily defined, “[f]igures below 20% [of the public] become problematic,”<sup>179</sup> with the lowest reported figure being 8.5%.<sup>180</sup>

The doctrine violates this basic requirement of trademark law. Under the doctrine, courts do not consider the proportion of the public that would be confused or otherwise affected by a statutory bar to registration.<sup>181</sup> Instead, the doctrine “presume[s] that a word in one of the common, modern languages of the world will be spoken or understood by an appreciable number of U.S. consumers for the goods at issue.”<sup>182</sup> Thus, instead of analyzing whether a significant portion of consumers are confused or otherwise affected by the mark at issue, the doctrine creates a legal fiction by

---

first used in a trademark infringement context in *Swarthmore Classics, Inc. v. Swarthmore Junior*, 81 F. Supp. 917, 920 (S.D.N.Y. 1949).

<sup>178</sup> *In re Spirits Int'l, N.V.*, 563 F.3d 1347, 1356 (Fed. Cir. 2009) (“[I]t is clear that section (e)(3)—like subsection (a), the false advertising provision of the Lanham Act, and the common law—requires that a significant portion of the relevant consuming public be deceived.”); see also *Entrepreneur Media*, 279 F.3d at 1151 (stating that in a likelihood of confusion analysis, the court must consider whether an “appreciable number,” which is equivalent to “a significant portion of the general public,” are likely to be confused (citing *Kendall-Jackson Winery, Ltd. v. E. & J. Gallo Winery*, 150 F.3d 1042, 1052 (9th Cir.1998); *Int'l Ass'n. of Machinists and Aerospace Workers v. Winship Green Nursing Ctr.*, 103 F.3d 196, 201 (1st Cir. 1996))); *In re Zuffa, LLC*, No. 76/273,529, 2003 WL 22055674, at \*6 (T.T.A.B. Aug. 29, 2003) (acknowledging that a mark is descriptive if a “significant portion” of the purchasing public would consider it so); *supra* note 13 and accompanying text.

<sup>179</sup> 6 MCCARTHY, *supra* note 3, § 32:188.

<sup>180</sup> See *Grotian, Helfferich, Schulz, Th. Steinweg Nachf. v. Steinway & Sons*, 365 F. Supp. 707, 716 (S.D.N.Y. 1973), *modified*, 523 F.2d 1331 (2d Cir. 1975). However, 8.5% was only “found to be ‘strong evidence’ of a likelihood of confusion where *other evidence was also strongly supportive*.” 6 MCCARTHY, *supra* note 3, § 32:188 (emphasis added).

<sup>181</sup> See generally *In re Thomas*, 79 U.S.P.Q.2d (BNA) 1021, 1024 (T.T.A.B. 2006) (“Foreign language words, not adopted into the English language, which are descriptive of a product, are so considered in registration proceedings despite the fact that the words may be *meaningless to the public generally*.” (emphasis added) (quoting *Nestle's Milk Prods., Inc. v. Baker Imp. Co., Inc.*, 182 F.2d 193, 196 (C.C.P.A. 1950))).

<sup>182</sup> *In re La Peregrina Ltd.*, 86 U.S.P.Q.2d (BNA) 1645, 1648 (T.T.A.B. 2008).



presuming that all common, modern languages are spoken by an appreciable number of American consumers.<sup>183</sup>

This presumption violates the proportionality requirement by ignoring the proportion of consumers who would be able to understand, and thus be able to translate (and be confused or deceived by) the foreign mark. The doctrine has been applied to languages that come nowhere close to meeting the proportionality requirement. For example, the Board has applied the doctrine to the Afrikaans language,<sup>184</sup> which is spoken by a mere 0.007% of American consumers.<sup>185</sup> Even relatively common languages such as French (spoken by 0.5% of U.S. residents)<sup>186</sup> and German (0.4%)<sup>187</sup> do not come close to meeting the 20% requirement or even the lower end 8.5% requirement. Spanish (12.2%)<sup>188</sup> may meet the lower end of the requirement, but, at least in likelihood of confusion cases, the doctrine does not consider whether the foreign language speakers also speak English.

ii. *The Doctrine Improperly Presumes that Foreign Language Speakers Also Speak English*

Even if the doctrine were correct in its assumption that all common, modern languages will be spoken or understood by an appreciable number of American consumers, the doctrine further improperly assumes that the consumer is “*knowledgeable in English* as well as the pertinent foreign language.”<sup>189</sup> Knowledge of English as well as the foreign language would be required in any likelihood of confusion analysis, since a consumer would need to understand both the English and foreign marks to be confused by

---

<sup>183</sup> See *id.*

<sup>184</sup> *In re Savisa (PTY) Ltd.*, No. 78154196, 2005 WL 548058, at \*4 (T.T.A.B. Feb. 24, 2005); see also *Consol. Cigar Corp. v. Rembrandt Tobacco Corp. (Overseas) Ltd.*, 176 U.S.P.Q. (BNA) 159, 159 (T.T.A.B. 1972).

<sup>185</sup> U.S. Census Bureau, *supra* note 58 (dividing B29 by B5).

<sup>186</sup> *Id.* (dividing B14 by B5).

<sup>187</sup> *Id.* (dividing B23 by B5).

<sup>188</sup> *Id.* (dividing B10 by B5).

<sup>189</sup> *In re Unidos Fin. Servs., Inc.*, No. 77126814, 2010 WL 667922, at \*3 (T.T.A.B. Jan. 27, 2010) (emphasis added) (citing *In re Thomas*, 79 U.S.P.Q.2d (BNA) 1021, 1024 (T.T.A.B. 2006)); *In re La Peregrina*, 86 U.S.P.Q.2d 1645, 1647–48 (T.T.A.B. 2008) (citing *Thomas*, 79 U.S.P.Q.2d at 1025).

their similarity.

Depending on the foreign language, however, there may be a large percentage of speakers who do not speak English very well.<sup>190</sup> According to the U.S. Census, speakers of many foreign languages in the United States do not speak English very well.<sup>191</sup> For example, with respect to the most widely spoken foreign language in the United States—Spanish—47% of speakers do not speak English very well.<sup>192</sup> Other commonly spoken foreign languages in America have similarly large percentages of speakers who do not speak English very well.<sup>193</sup> Therefore, in a confusing similarity analysis, the doctrine incorrectly assumes that all speakers of a foreign language would be able to translate a foreign mark to English and then compare it to an English mark.

This flaw in the doctrine further impedes its policy goal of protecting multilingual Americans. Consumers who only speak the pertinent foreign language, but speak English poorly or not at all, cannot be confused by equivalent foreign and English marks. Thus, for the large portion of foreign language speakers who do not speak English well, the doctrine provides little or no protection.

b. *The Doctrine Causes Affirmative Harm to the Public*

The primary policy rationale for the doctrine is the protection

---

<sup>190</sup> The U.S. Census considers households “linguistically isolated . . . in which no person aged 14 or over speaks English at least ‘[v]ery well.’” Hyon B. Shin & Rosalind Bruno, *Language Use and English-Speaking Ability: 2000*, U.S. CENSUS BUREAU, 10 (Oct. 2003), <http://www.census.gov/prod/2003pubs/c2kbr-29.pdf>.

<sup>191</sup> See, e.g., U.S. Census Bureau, *supra* note 58 (dividing D10 by B10) (47% of Spanish speakers do not speak English very well).

<sup>192</sup> *Id.* Spanish speakers are by no means outliers. For example, 49% of Asian and Pacific Island language speakers in the United States also do not speak English very well. *Id.* (row 93).

<sup>193</sup> See, e.g., *id.* (row 38) (Russian—51%); *id.* (row 94) (Chinese—56%); *id.* (row 104) (Korean—58%); *id.* (row 109) (Vietnamese—61%). Other common foreign languages have smaller but still significant percentages of people who do not speak English very well. See, e.g., *id.* (row 13) (French—22%); *id.* (row 18) (Italian—29%).

of multilingual Americans.<sup>194</sup> As the Federal Circuit has noted, “one policy undergirding the doctrine of foreign equivalents is the assumption that there are (or someday will be) customers in the U.S. who speak that foreign language.”<sup>195</sup> However, while protecting multilingual Americans may be a laudable goal, the doctrine does this at the expense of the rest of the public. 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.<sup>196</sup>

Furthermore, the absence of federal registration makes it much more difficult for the would-be registrant to use his mark exclusively and police it, since he would have to rely on state trademark protections to do so.<sup>197</sup> This nonexclusive use of a mark tends to confuse consumers due to the increased likelihood of multiple merchants selling the same good under the same name.

c. *The Doctrine Causes Prospective Harm*

Considering whether “someday [there] will be” an adequate

---

<sup>194</sup> See 2 MCCARTHY, *supra* note 3, § 12:41 n.5 (quoting RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 14 cmt. a (1995) (“The multilingual character of the purchasing public and the increasing exposure to foreign terms on imported goods justify general adherence to the ‘doctrine of foreign equivalents.’”)).

<sup>195</sup> *In re Spirits Int’l, N.V.*, 563 F.3d 1347, 1356 n.5 (Fed. Cir. 2009) (internal quotation marks omitted) (quoting *Enrique Bernat F., S.A. v. Guadalajara, Inc.*, 210 F.3d 439, 443 (5th Cir. 2000)).

<sup>196</sup> “The purpose of federal trademark registration and protection is to . . . protect the public from confusion regarding products and product sources.” Jack Achiezer Guggenheim, *Renaming the Redskins (and the Florida State Seminoles?): The Trademark Registration Decision and Alternative Remedies*, 27 FLA. ST. U. L. REV. 287, 292 (1999) (citing *Springfield Fire & Marine Ins. Co. v. Founders’ Fire & Marine Ins. Co.*, 115 F. Supp. 787, 791 (N.D. Cal. 1953)). The Lanham Act “confers a number of procedural and substantive legal advantages over reliance on common law rights.” 3 MCCARTHY, *supra* note 3, § 19:9 (discussing advantages of registration).

<sup>197</sup> Although some protection may be available under common law, federal registration gives a trademark owner significantly greater protection. See 3 MCCARTHY, *supra* note 3, § 19:9 (discussing advantages of registration).

number of speakers of a particular foreign language is an improper rationale for applying the doctrine.<sup>198</sup> Trademark law generally looks at the composition of the present day, not future, public.<sup>199</sup> For example, in reviewing a rejection based on immoral or scandalous matter,<sup>200</sup> the Board reversed the examiner's refusal of registration, explaining that the mark "involve[s] no threat to *present-day public* morals or sense of propriety."<sup>201</sup> Similarly, in a likelihood of confusion case, the Board noted that it looks to "the average *present day* consumer under the conditions and circumstances surrounding his purchases in the everyday market place."<sup>202</sup> Therefore, simply assuming there will someday be an adequate number of foreign language speakers is not a proper basis for continued application of the doctrine.

This prospective justification for the doctrine does not further the policy of the Lanham Act of "protect[ing] the public's expectation regarding the source and quality of goods."<sup>203</sup> Indeed, if the public does not presently speak a certain foreign language, there is no need to protect it from marks in that language in the hope that, one day, that protection may become necessary. Applying the doctrine based on this misguided policy subverts the policy goals of the Lanham Act by refusing registration to rightful trademark owners. This creates a situation in which the refused registrant's competitors can use the mark, confusing the public as to the "source and quality of goods."<sup>204</sup> Moreover, if a court is wrong about there someday being enough consumers who speak a relevant foreign language, a mark would needlessly be refused registration, preventing its owner from receiving the protections of

---

<sup>198</sup> See *supra* note 179 and accompanying text.

<sup>199</sup> See, e.g., *In re Thomas Labs., Inc.*, 189 U.S.P.Q. (BNA) 50, 52 (T.T.A.B. 1975); *Am. Can Co. v. Marcal Paper Mills, Inc.*, 152 U.S.P.Q. (BNA) 772, 777 (T.T.A.B. 1967).

<sup>200</sup> See generally 3 MCCARTHY, *supra* note 3, § 19:77 (discussing immoral or scandalous marks).

<sup>201</sup> *Thomas Labs.*, 189 U.S.P.Q. at 52 (emphasis added).

<sup>202</sup> *Am. Can Co.*, 152 U.S.P.Q. at 777 (emphasis added); see also *Henry Disston & Sons, Inc. v. Pa. Saw Corp.*, 72 U.S.P.Q. (BNA) 145 (Comm'r Pat. 1947) (referring to "present-day public" in a likelihood of confusion analysis).

<sup>203</sup> See *supra* note 173 and accompanying text.

<sup>204</sup> See *id.*

the Lanham Act in the meantime.<sup>205</sup>

## 2. *The Doctrine is Unworkable*

In addition to its failure to achieve its policy rationale as well as that of the Lanham Act, the doctrine is ridden with confusion<sup>206</sup> and, in many cases, an utter lack of reasoning. In particular, the Federal Circuit has never made clear what constitutes a common language,<sup>207</sup> in what cases consumers would be unlikely to translate foreign marks,<sup>208</sup> and on whom the burden of proof of likelihood of translation lies.<sup>209</sup> Perhaps most importantly, the Federal Circuit's decision in *Spirits*, aside from being confusing and internally inconsistent,<sup>210</sup> has forced the T.T.A.B. to unreasonably use a different definition of "ordinary American purchaser" for geographic deceptiveness refusals than all other bars to registration.<sup>211</sup>

As the Supreme Court has explained, case law should be overruled as unworkable if it creates "inherent confusion" or cannot be "coheren[tly] and consisten[tly]" applied.<sup>212</sup> The doctrine easily fits either of these characterizations and, consequently, must be abolished.

In sum, the doctrine of foreign equivalents violates directly applicable Supreme Court precedent, as well the requirement of proportionality, and is, in nearly every respect, unworkable. As such, the doctrine undercuts the policy of the Lanham Act to protect the public at the expense of the doctrine's policy of protecting an often negligible portion of multilingual Americans. For these reasons, the Federal Circuit should abolish the doctrine as a matter of precedent and policy.

---

<sup>205</sup> See 15 U.S.C. § 1057(b) (2006); 3 MCCARTHY, *supra* note 3, § 19:9 (discussing the advantages of registration).

<sup>206</sup> See *supra* note 95.

<sup>207</sup> See *supra* Part III.B.

<sup>208</sup> See *supra* Part III.D.

<sup>209</sup> See *supra* Part III.E.

<sup>210</sup> See *supra* Part V.B.

<sup>211</sup> See *supra* Part VI.C.

<sup>212</sup> *Patterson v. McLean Credit Union*, 491 U.S. 164, 173 (1989).

## VII. CONCLUSION

The Supreme Court squarely rejected the doctrine of foreign equivalents in *Menendez v. Holt* over a century ago. The Federal Circuit, and other courts considering the doctrine, must follow *stare decisis* and abolish the doctrine.

In the Federal Circuit's tortured *In re Spirits International* decision, the court signaled the beginning of the end of the doctrine of foreign equivalents by abolishing it *sub silentio* in the geographic deceptiveness context.<sup>213</sup> By doing so, the court only muddled the waters of an already confused body of law.

As the Board predicted, the Federal Circuit's insistence in *Spirits* that the "ordinary American purchaser" refers to the entire relevant public as opposed to the portion of the public knowledgeable in the foreign language, "write[s] the doctrine out of existence."<sup>214</sup> Although the Federal Circuit expressly limited its analysis to subsection 2(e)(3)'s prohibition of primarily geographically deceptively misdescriptive marks, the court cannot justify refusing to extend *Spirits*' reasoning to other bars to registration.

The Federal Circuit should speak decisively and abolish the doctrine of foreign equivalents in its entirety. Although the Federal Circuit chipped away at the doctrine in *Spirits* and held it effectively inapplicable to geographic deceptiveness cases, the court should finish what it started by following both *Menendez* and policy considerations to put the doctrine of foreign equivalents to rest *in toto*.

---

<sup>213</sup> See *supra* Part IV.B.

<sup>214</sup> *In re Thomas*, 79 U.S.P.Q.2d (BNA) 1021, 1024 (T.T.A.B. 2006).

