

Ce what, monsieur? Application for French phrase invites wrinkles in trademark law

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Primarily geographically deceptively misdescriptive. Say that three times fast.

It's quite a mouthful. And for trademark practitioners, it's a difficult objection to overcome.

If your client's trademark application is deemed primarily geographically deceptively misdescriptive, your chances of successfully registering that mark get a whole lot slimmer. Until just recently, the Board would reject it faster than it takes to repeat that phrase three times.

Until, that is, the Board recently ruled the opposite in *In re Luvanis S.A.*, Serial No. 86/294,633 (January 26, 2015) [not precedential], going against typical past precedent and reversing a refusal to register the mark *Aux Etats Unis* for luggage and related carrying cases. The Board found that, although the French phrase refers to a generally known geographical place—that is, the United States—the USPTO's examiner had failed to prove that a substantial portion of the relevant consuming public would likely be deceived by the place name.

To establish a *prima facie* case that a mark is primarily geographically deceptively misdescriptive, an examiner must meet four requirements, to wit:

1. That the primary significance of the mark is a generally known geographic place;
2. That the applied-for goods do not originate in the place identified in the mark;
3. That purchasers would likely believe that the applied-for goods originate in the geographic place identified in the mark; and,
4. That the misrepresentation would be a material factor in a substantial portion of the relevant consumers' decision to buy the applied-for goods.

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In this case, the applicant argued that *aux Etats Unis* would be translated from French as "to the United States," but the Board found that the phrase could also mean "in the United States." (Why and how it found so best belongs to a French class.) The Board therefore ruled that, under the first of the above-referenced requirements, the primary significance of the mark is a known geographic place, namely, the United States. *Voila!*

The second requirement was also met: The applicant conceded that its goods would not originate in the United States. And, as to the third and fourth requirements, the Board held that none of the examiner's evidence addressed whether a substantial portion of the relevant consuming public would likely be deceived by a non-English place name.

This turned the argument to the doctrine of foreign equivalents, another frequently confusing concept in the arena of trademark prosecution. Under this doctrine, a foreign word from a language familiar to an appreciable segment of American consumers and its English equivalent may be held to be confusingly similar.

Whether an examiner should apply the doctrine of foreign equivalents turns upon the significance of the foreign mark to relevant purchasers, which in turn is based on analyzing the evidence of record, including, for example, dictionary definitions or the Internet. If evidence shows that the relevant English translation is literal and direct, and no contradictory evidence of shades of meaning or other relevant meanings exists, the doctrine is generally applied.

Although words from modern languages are generally translated into English, the doctrine of foreign equivalents has evolved into a guideline, not an absolute rule. It is applied only when an ordinary American purchaser would stop and translate the foreign wording in a mark into its English equivalent. The ordinary American purchaser is taken to include all American purchasers, including those proficient in a non-English language who would ordinarily be expected to translate words into English.

In cases under the doctrine of foreign equivalents, where the place name in the mark appears in a foreign language, the requirement that a substantial portion of the relevant consuming public would likely be deceived raises special issues. To make a determination about a substantial portion of the relevant consuming public in such cases, the Board has in past practice tasked the examiner with considering whether the foreign place name would be recognizable as such to consumers who do not speak that language, and/or whether consumers who speak that foreign language could constitute a substantial portion of the relevant consumers.

In *In re Luvanis S.A.*, the Board found nothing in the record from which to determine whether, first, U.S. customers who do not speak French would recognize *aux Etats Unis* as referring to "in the United States" or "to the United States," or, secondly, U.S. consumers who speak French are a substantial portion of the relevant consuming public, and would be deceived by the asserted misrepresentation in the mark. Thus, noted the Board, the examiner failed to prove that the third requirement of the above-referenced four-part test had been fulfilled.

With regards to the fourth requirement, the Board also noted that the examiner had failed to show that the misrepresentation would be a material factor in the purchasing decisions of a substantial portion of the relevant consuming public. And with that, the Board reversed the refusal.

In the aftermath of *In re Luvanis S.A.*, I am not confident that overcoming a primarily geographically deceptively misdescriptive refusal is likely. At least the TTAB's determination in this case gives applicants hope. But because each case is considered on its own specific facts, the applicability of the decision is likely limited—even in *Les Etats Unis. Alors!*

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