

TRADEMARK LAW AS AN ACCESSORY TO LANGUAGE DEATH

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I. INTRODUCTION

Chicago native Susan Edwards and her husband, Varsay Sirleaf, a Liberian citizen, launched a haircare line primarily because dermatologist-recommended products robbed Ms. Edwards' hair of moisture.¹ The pair selected the brand name "uhai," which means "life" in Swahili, for their Black woman-owned and celebrated business.²

On November 9, 2015, Edwards' company, S Squared Ventures, LLC, filed a federal trademark application to register the mark UHAI based on an intent to use the mark in commerce.³ The application covered "[h]aircare, namely shampoo, conditioner, oil, gel, foam, spray, regrowth kit, [and] custard."⁴ On March 4, 2016, an examining attorney issued an Office Action, or an initial refusal to register the mark,⁵ because of a likelihood of confusion⁶ with three previously registered marks.⁷ None of

1. Susan Edwards, *Our Story*, UHAI (Nov. 2, 2024), <https://web.archive.org/web/20241102142931/https://uhaihair.com/pages/our-story>.

2. *See id.*

3. *See In re S Squared Ventures, LLC*, No. 86813357, 2017 WL 4154963, at *1 (T.T.A.B. 2017).

4. U.S. Trademark Application Serial No. 86813357 (filed Nov. 9, 2015).

5. *See* Non-Final Office Action dated Mar. 4, 2016, U.S. Trademark Application Serial No. 86813357 (filed Nov. 9, 2015) [hereinafter UHAI Office Action], <https://tsdr.uspto.gov/documentviewer?caseId=sn86813357&docId=OOA20160304154754>. If an examining attorney determines that there are defects in the application, the examiner will issue an office action, or a letter outlining the issues that the applicant must address before the application can mature to registration. *See* TMEP § 704.01 (Nov. 2024). Minor defects, such as an inadequate description of goods or services, require minor revisions. *See id.* Major defects typically require the submission of legal arguments, as in the case of merely descriptive or likelihood of confusion refusals. *See id.* §§ 713, 713.03.

6. UHAI Office Action, *supra* note 5. Marks that are likely to be confused with prior marks are ineligible for trademark registration. 15 U.S.C. § 1052(d) ("No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it . . . (d) Consists of or comprises a mark which 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 . . .").

7. UHAI Office Action, *supra* note 5. The Office Action also requested a translation of the word "uhai," noted that the identification of goods or services would need to be clarified,

the prior marks cited as grounds to deny registration contained the word “uhai.”⁸ However, each of the marks contained the word “life” and the filings covered related products as follows:



- “LIFE” and design,  registered for use with “[d]ietary and nutritional supplements; [d]ietary supplements; [f]ood supplements, namely, anti-oxidants; [v]itamins” in International Class 005 (U.S. Registration No. 3786987);



- “LIFE” and design,  registered for use with “[d]ietary and nutritional supplements; [d]ietary supplements; [f]ood supplements; [v]itamin supplements; [v]itamins” in International Class 005 (U.S. Registration No. 4169934); and



- “LIFE FOR HAIR” and design,  registered for use with “[h]air care product, namely, shampoo used to strengthen the hair” in International Class 003 (U.S. Registration No. 4402733).⁹

The examining attorney’s reasoning was based on the U.S. trademark Doctrine of Foreign Equivalents (or the “Doctrine”),¹⁰ which

and suggested that the application be modified to cover “[h]aircare products, namely, shampoo, conditioner, oil, gel, foam, spray, styling custard, hair regrowth kits *comprised primarily non-medicated gels [sic] and containing shampoos, and conditioners for promoting hair growth*” in Class 3 and “[h]air regrowth kits comprised primarily of hair growth stimulants and also containing cotton applicators; vitamins” in Class 5, if applicable. *Id.* (alteration in original).

8. *Id.*

9. *Id.*

10. *See id.*

states that “words from common languages are translated into English to determine genericness, descriptiveness, as well as similarity of connotation in order to ascertain confusing similarity with English word marks.”¹¹

Edwards’ attorney filed a response, unsuccessfully arguing that the Doctrine of Foreign Equivalents did not apply because Swahili is not a common language and U.S. consumers are not likely to stop and translate the mark into English.¹² Moreover, “uhai” and “life” were dissimilar in sight, sound, and connotation.¹³ After the examiner issued a Final Office Action denying S Squared Ventures’ request for reconsideration, the couple filed an appeal with the Trademark Trial and Appeal Board (“TTAB”).¹⁴

In affirming the examining attorney’s decision, the TTAB relied solely on the LIFE FOR HAIR and design registration and offered two arguments in support of its decision.¹⁵ First, the TTAB rejected the argument that Swahili is not a common language or that an appreciable number of people do not speak or know Swahili in the United States.¹⁶ Relying on global numbers, the court noted that Swahili is the primary or secondary language of approximately 80 to 100 million individuals around the world, including immigrants to the United States.¹⁷ The court also referenced U.S. universities that offer classes and programs covering Swahili and others that have Swahili clubs.¹⁸ Beyond classrooms, U.S radio and other media programs offered content in Swahili.¹⁹ Second, the court reasoned that the words “uhai” (as translated in English) and “life” were similar in sight, sound, and connotation.²⁰ Specifically, “the wording ‘FOR HAIR’ and the leaves [designs] are of little significance rendering the word ‘LIFE’ the dominant part of the registered mark.”²¹ “A mark presented in stylized characters, with (or without) a design element, like Registrant’s mark, generally will not avoid a likelihood of confusion with a standard character mark, like Applicant’s mark, because the marks

11. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 396 F.3d 1369, 1377 (Fed. Cir. 2005).

12. *See In re S Squared Ventures, LLC*, No. 86813357, 2017 WL 4154963, at *5 (T.T.A.B. 2017).

13. *See id.* at *4.

14. *Id.* at *1.

15. *See id.* at *4, *9.

16. *Id.* at *8–9.

17. *Id.* at *6.

18. *Id.*

19. *Id.*

20. *Id.* at *4, *9.

21. *Id.* at *9.

could be presented in the same manner, i.e., in the same font, style, size and color as Registrant's mark.”²²

Although the TTAB's refusal to register does not prevent Edwards from using the mark in the United States,²³ it does make it more difficult to enforce her trademark rights in the brand name. Enforcement is more difficult because marks that are not registered lack the legitimacy afforded to federally registered marks.²⁴ A federal registration certificate serves as *prima facie* evidence that the owner has exclusive rights to the mark in every U.S. state and territory.²⁵ Without a federal registration, an owner must otherwise collect evidence to prove any rights in the mark.²⁶ So long as the brand is not registered, Edwards will also be deprived of other key protections afforded to marks on the Principal Register.²⁷

The UHAI branding experience is familiar to any entrepreneur or small business that has sought to register a trademark in any language other than English. However, Ms. Edwards' experience may have been more fortunate than others, particularly applicants who lack sufficient financial and other resources. Edwards, a Stanford-trained chemical engineer,²⁸ had the resources to hire an attorney for the Office Action responses and appeal to the TTAB.²⁹ Similarly, the language Ms. Edwards chose to honor her family's culture and heritage, Swahili, is not yet endangered,³⁰ but many other languages are nearly extinct.³¹ Applicants from smaller language communities with fewer resources face

22. *Id.*

23. *Trademark FAQs*, U.S. PAT. & TRADEMARK OFF., <https://www.uspto.gov/learning-and-resources/trademark-faqs> (last visited Nov. 30, 2025).

24. See *Unregistered Trademarks Under Federal and State Laws*, JUSTIA, <https://www.justia.com/intellectual-property/trademarks/unregistered-trademarks/> (last visited Nov. 30, 2025).

25. 15 U.S.C. § 1057(b).

26. See *Unregistered Trademarks Under Federal and State Laws*, *supra* note 24.

27. *Id.* In addition to serving as *prima facie* evidence of the registrant's exclusive rights, registration on the Principal Register creates a presumption that the registered mark is valid, serves as constructive notice of claim of ownership (eliminating good faith as a defense to infringement), becomes incontestable after five years of registration, and can be used as a basis to stop importations of counterfeit or otherwise infringing products into the United States. See 2 J. THOMAS McCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 19:36 (5th ed. 2025).

28. Edwards, *supra* note 1.

29. See *In re S Squared Ventures, LLC*, No. 86813357, 2017 WL 4154963, at *1 (T.T.A.B. 2017).

30. See *Swahili, World Atlas of Languages*, UNESCO, <https://en.wal.unesco.org/languages/swahili> [<https://perma.cc/P3VZ-Z5V5>] (last visited Nov. 26, 2025).

31. UNESCO, ATLAS OF THE WORLD'S LANGUAGES IN DANGER 6 (2011), <https://unesdoc.unesco.org/ark:/48223/pf0000192416/PDF/192416eng.pdf.multi>.

more challenges in having their arguments in favor of registration heard, and ultimately, their marks registered at all.³²

A brief survey of Office Actions issued between 2017 and 2021 reveals that of the ten to twelve thousand likelihood of confusion refusals issued during each of those five years, roughly two thousand referenced the Doctrine of Foreign Equivalents.³³ While the overall percentage of Doctrine-related refusals may seem insignificant, it is the nature and quality of the refusals that pose harm to languages that may not exist at the turn of the next century.

Optimistic estimates suggest that at least [fifty] percent of today's spoken languages will be extinct or seriously endangered by 2100. More pessimistic, but also [equally] realistic estimates claim that [ninety to ninety-five] percent will become extinct or seriously endangered by the end of this century. Most of these languages are Indigenous languages. Humanity may well have only 300–600 oral languages left that are unthreatened by the end of this century.³⁴

The United States is not exempt from the effects of losing spoken languages. A 2024 *New York Times* article exposed language death as a domestic problem:

All told, there are more endangered languages in and around New York City than have ever existed anywhere else, says [Ross] Perlin, who has spent 11 years trying to document them. And because most of the world's languages are on a path to disappear

32. See Ross Perlin, *Disappearing Tongues: The Endangered Language Crisis*, THE GUARDIAN (Feb. 22, 2024), <https://www.theguardian.com/science/2024/feb/22/disappearing-tongues-the-endangered-language-crisis>; cf. Ung Shen Goh, *Translating Trademarks: Towards the Equal Treatment of Foreign-Language Marks* (Mar. 2018) (York University Library) (manuscript at 60–63) (discussing the difficulty of Aboriginal languages to receive trademarks in Canada due to their small size).

33. This survey was independently conducted by the author using publicly available USPTO records, supplemented by private trademark search platforms. Because Office Actions are not published in an easily searchable format, the data reflected here required manual review of application files accessed through the USPTO's TESS and TSDR systems, as well as proprietary tools not maintained by the USPTO.

34. *International Decade of Indigenous Languages 2022 – 2032*, U.N., <https://www.un.org/development/desa/indigenouspeoples/indigenous-languages.html> (last visited Nov. 30, 2025).

within the next century, there will likely never be this many in any single place again.³⁵

Moreover, the United States Patent and Trademark Office (“USPTO”)’s publicly available databases³⁶ contain examples of registration refusals for marks that contain words in Hawaiian—a language at risk of extinction and primarily spoken in the United States.³⁷ Not only is Hawaiian recognized as one of the official languages of the State of Hawaii, but it was also identified as an endangered language as early as 2011.³⁸ In this Article, I argue that the Doctrine threatens the preservation of languages, like Hawaiian and many others, that are not commonly spoken in the United States.

Arguments for the Doctrine are based upon two main premises. First, immigrants, particularly those who are multilingual or bilingual, must be protected from the likelihood of confusion between options for products or services with similar names.³⁹ Second, the Doctrine is necessary to maintain international comity because avoiding confusion is also important in other jurisdictions around the world.⁴⁰

To be clear, the USPTO bears no legal or other official responsibility for worldwide language preservation.⁴¹ This Article raises the unexplored

35. Alex Carp, *The Endangered Languages of New York*, N.Y. TIMES (Feb. 22, 2024), <https://www.nytimes.com/interactive/2024/02/22/magazine/endangered-languages-nyc.html>.

36. Two platforms are frequently used for reviewing application data and filing history. The Trademark Search platform (formerly known as Trademark Electronic Search System or “TESS”) provides any user access to all marks that have been subjects of applications, regardless of current registration status. This means that marks that are subjects of abandoned or pending applications, as well as active or cancelled registrations, are searchable. The Trademark Status and Document Retrieval (“TSDR”) is searchable by application serial or registration number. Users may view full application prosecution history, including the current status, documents filed by the applicant or register, and any Office Actions or refusals to register issued by trademark examining attorneys. *Trademarks*, U.S PAT. & TRADEMARK OFF., <https://www.uspto.gov/trademarks> (last visited Nov. 30, 2025).

37. *Id.*; *Hawaiian, ENDANGERED LANGUAGES PROJECT*, <http://elcat.colo.hawaii.edu/lang/125> (last visited Nov. 30, 2025).

38. CHRISTOPHER MOSELEY, *ATLAS OF THE WORLD’S LANGUAGES IN DANGER* 78 (3d ed. 2010); *see also Hawaiian, World Atlas of Languages*, UNESCO, <https://en.wal.unesco.org/languages/hawaiian> (last visited Apr. 10, 2025).

39. *The Trademark Doctrine of Foreign Equivalents*, L. OFF. OF NIKKI SIESEL, <https://www.ny-trademark-lawyer.com/the-trademark-doctrine-of-foreign-equivalents.html> (last visited Nov. 30, 2025).

40. *See, e.g.*, Albert Simonyan, *International Implementation of the Doctrine of Foreign Equivalents: How to Save Foreign Generic Terms from Appropriation*, 13 N.Y.U. J. INTELL. PROP. & ENT. L. 135, 138 (2023).

41. *See About Us*, U.S. PAT. & TRADEMARK OFF., <https://www.uspto.gov/about-us> (last visited Nov. 30, 2025).

question of whether the United States, as one of the largest contributors to the global economy and marketplace,⁴² unnecessarily interferes with language preservation by prioritizing the English language in branding, or trademark registration, decisions.

To illuminate the connections between language preservation and trademark registration, I begin Part II by highlighting the key tenets of federal trademark registration practice—that marks are registrable only if they are distinctive or serve as source indicators and are not likely to confuse consumers when used in commerce. I then explain how the Doctrine bolsters the scope of protection enjoyed by registered English-language marks by blocking registrations of foreign equivalents, even when the marks at issue are markedly different aurally and visually. Part III examines how the Doctrine intersects with language loss and international trademark registration practice in a manner that constitutes what I refer to as *trademark liguicide*. Part IV concludes that we should limit the Doctrine to assessing distinctiveness only, and not likelihood of confusion analysis, because it fails to fulfill its policy goals and contributes to the marginalization of non-native English speakers.

II. TRADEMARK LAW, THE UNUSUAL SUSPECT

Words mean more than what is set down on paper. It takes the human voice to infuse them with the shades of deeper meaning.

—Maya Angelou⁴³

Trade and service marks⁴⁴ play a significant role in the exchange of goods or services on a large scale. Trademarks, like ordinary language, communicate important messages to consumers and garner what is often referred to as goodwill.⁴⁵ Goodwill is a “value that reflects the basic human propensity to continue doing business with a seller who has

42. See Avery Koop, *Top Heavy: Countries by Share of the Global Economy*, VISUAL CAPITALIST (Dec. 29, 2022), <https://www.visualcapitalist.com/countries-by-share-of-global-economy/>.

43. MAYA ANGELOU, I KNOW WHY THE CAGED BIRD SINGS 95 (1969).

44. For the purposes of this article, the term “trademark,” or “mark” is used for words, symbols, or designs used in connection with either goods (or products) or services. This convention is commonly used by trademark practitioners in the United States. See *What Is a Trademark?*, U.S. PAT. & TRADEMARK OFF., <https://www.uspto.gov/trademarks/basics/what-trademark> (last visited Nov. 30, 2025). However, it is not uncommon to make the distinction more prominent by using the term “Trade Mark” and “Service Mark” in other jurisdictions. See *id.*

45. See *Ritter v. Farrow*, 955 N.W.2d 122, 128 (Wis. 2021).

offered goods and services that the customer likes and has found adequate to fulfill her needs.”⁴⁶ How a word is used or perceived (or not) may enhance a consumer’s ability to readily determine whether a product or service emanates from a single source, even if the consumer has no idea who or what entity provides the products or services.

The Lanham Act⁴⁷ seeks to protect dual interests by protecting consumers from confusion and mark owners from unfair competition.⁴⁸ As a part of the “broader law of unfair competition,” it forbids the “passing off” of one’s goods or services as the goods or services of another.⁴⁹ The intent of the Lanham Act is to

regulate commerce within the control of Congress by making actionable the deceptive and misleading use of marks in such commerce; to protect registered marks used in such commerce from interference by State, or territorial legislation; to protect persons engaged in such commerce against unfair competition; to prevent fraud and deception in such commerce by the use of reproductions, copies, counterfeits, or colorable imitations of registered marks; and to provide rights and remedies stipulated by treaties and conventions respecting trademarks, trade names, and unfair competition entered into between the United States and foreign nations.⁵⁰

Trademarks

“[S]ecure to the owner of the mark the goodwill of his business and . . . protect the ability of consumers to distinguish among competing producers,” as well as . . . source accurately goods, services and commercial activities . . . [I]t is intended to protect “merchants against unfair competition and . . . the public against deceptive advertising and marketing.”⁵¹

46. MCCARTHY, *supra* note 27, § 2:17.

47. The 1946 Trademark Act, also known as the Lanham Act, became effective on July 5, 1947. ROGER E. SCHECHTER & JOHN R. THOMAS, PRINCIPLES OF TRADEMARK LAW 9–10 (2020). It provides the basis for modern federal trademark law recognized today. *Id.* at 9. This Act sought to address the failures of prior trademark statutes by expanding the types of marks eligible for registration and addressing procedural issues. *Id.* at 9–10.

48. *See* 15 U.S.C. § 1127 (defining terms used in the Act); *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 767–68 (1992).

49. *Am. Steel Foundries v. Robertson*, 269 U.S. 372, 380 (1926).

50. 15 U.S.C. § 1127.

51. 1 ALEXANDRA DARRABY, DARRABY ON ART LAW § 8:2 (2024) (quoting S. REP. NO. 1333, 79th Cong., 2d Sess. 3–5 (1946)).

This Article considers whether the U.S. Doctrine of Foreign Equivalents further harms persons who often have less political or social power—those whose first or primary language is not English. The question is whether a propensity towards English language preferences is so interwoven into our interpretation of the Lanham Act that the Doctrine covertly contributes to the death of languages that are no longer thriving.

A. Federal Trademark Rights in the United States

Generally, any device that serves as an indicator of the source of goods or services in commerce can be considered a trademark in the United States.⁵² Consumers are likely most familiar with trademarks, or brands, comprised of words, designs, or symbols.⁵³ However, courts have construed the phrase “any device” broadly to recognize sounds,⁵⁴ smells,⁵⁵ and specific colors⁵⁶ as registrable marks, provided that the device is distinctive, not functional, and otherwise capable of serving as an indicator of source.⁵⁷

52. See § 1127. A trademark can include “any word, name, symbol, or device, or any combination thereof[] (1) used by a person, or (2) which a person has a bona fide intention to use in commerce . . . to identify and distinguish . . . goods . . . from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.” *Id.* Similarly, a “service mark” can be anything that would count as a trademark, but is used “to identify and distinguish the services . . . from the services of others and to indicate the source of the services, even if that source is unknown.” *Id.*

53. See MCCARTHY, *supra* note 27, § 3:1.

54. See § 1127 (defining trademark); *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162 (1995) (summarizing application of trademarks to novel devices). Another type of non-traditional trademark includes the protection of sound. See *Qualitex Co.*, 514 U.S. at 162. This is because a trademark can be any word, name, symbol, or device that serves as a source indicator, is distinctive, and is not functional. See *id.* at 162–65. For example, the three-chime tone that has been in use by the National Broadcasting Company is a registered trademark. See *id.* at 162.

55. See *In re Clarke*, 17 U.S.P.Q.2d 1238, 1239–40 (T.T.A.B. 1990). Scent or fragrances can also be registered as trademarks, but the scent cannot be functional. See *id.* This means that perfumed items are not entitled to protections. See *id.* at 1239. The use of smell would have to be distinctive. See *id.* at 1239–40. One example is a “high impact, fresh, floral fragrance reminiscent of Plumeria blossoms” for “sewing thread and embroidery yarn.” See *id.* at 1238.

56. See *Qualitex Co.*, 514 U.S. at 162–65 (holding that no legal obstacle exists to the use of color alone as a trademark provided that the color had already achieved a secondary meaning and was not functional).

57. See *id.* These nontraditional trademarks are not particularly relevant to the discussion concerning the intersection of language and trademarks and will not be addressed in any further detail.

Commercial use, distinctiveness, and source identification without confusion provide the foundation for understanding how words from any language can achieve trademark status.⁵⁸

1. Use in Commerce

Unlike many jurisdictions around the world, registration alone does not confer trademark rights in the United States.⁵⁹ Anyone can establish common law trademark rights by using a mark as a source indicator in connection with offering products or services.⁶⁰ Common law rights are limited to the geographic area in which the mark is used in commerce⁶¹

58. See U.S. PAT. & TRADEMARK OFF., PROTECTING YOUR TRADEMARK 1–9 (2015).

59. See *First to File Versus First to Use*, CORSEARCH (Nov. 16, 2019), <https://corseearch.com/content-library/blog/first-to-file-versus-first-to-use/>. The following countries provide trademark rights to the first individual or entity to file an application meeting the requirements of the relevant jurisdiction: Algeria, Anguilla, Argentina, Austria, Belarus, Belize, Benelux, Bolivia, Botswana, Brazil, Chile, China, Colombia, Croatia, Curacao, Czech Republic, Dominican Republic, Ecuador, El Salvador, Estonia, European Union, Finland, France, Germany, Greece, Guatemala, Hungary, Iran, Japan, Jordan, Kazakhstan, Kuwait, Kyrgyzstan, Lithuania, Mexico, Moldova, Montenegro, Nicaragua, Nigeria, Norway, Peru, Philippines, Poland, Qatar, Romania, Russian Federation, Slovenia, South Korea, Spain, Syria, Taiwan, Uganda, Ukraine, United Kingdom, Venezuela, Vietnam, and Zambia. *See id.*

60. *Why Register Your Trademark?*, U.S. PAT. & TRADEMARK OFF., <https://www.uspto.gov/trademarks/basics/why-register-your-trademark> (last visited Nov. 30, 2025); *Common Law Trademark Rights*, BITLAW, <https://www.bitlaw.com/trademark/common.html> (last visited Nov. 30, 2025).

61. 3 RUDOLF CALLMANN ET AL., CALLMANN ON UNFAIR COMPETITION, TRADEMARKS AND MONOPOLIES § 20:34 (4th ed. 2024). The phrase “in commerce” does not necessarily require the exchange of money or any other financial transaction. *See Trademark Applications – Intent-to-Use (ITU) Basis*, U.S. PAT. & TRADEMARK OFF., <https://www.uspto.gov/trademarks/apply/intent-use-itu-applications> (last visited Nov. 30, 2025). Consumers regularly encounter trademarks used in connection with “free” products or services. Access to websites, whether designed for shopping, providing entertainment, or general information, are free. Although less so than in the past, certain types of media remain free, like local radio and television stations that provide news and weather. *How to Watch Your Local News for Free*, THE FREE TV PROJECT, <https://www.thefreetvproject.org/how-watch-local-news-free/> (last visited Nov. 30, 2025). Nonprofit organizations offer free services, ranging from youth mentorship programs by Big Brothers and Big Sisters of America to conducting blood drives and providing disaster relief by The American Red Cross. *What We Do*, AM. RED CROSS, <https://www.redcrossblood.org/biomedical-services/what-we-do.html> (last visited Nov. 30, 2025); *Be A Part of Something Big*, BIG BROS. BIG SISTERS OF AM., <https://www.bbbs.org/donate/> (last visited Nov. 30, 2025). Libraries, museums, and parks are often free. *Free/Pay What You Wish Museums in NYC*, NYC FOR FREE, <https://www.nycforfree.co/free-museums> (last visited Nov. 30, 2025); Nadine Kramarz, *Why Do We Think Library Services are Free?*, PUB. LIBR. ASS’N (June 10, 2021), <https://publiclibrariesonline.org/2021/06/why-do-we-think-library-services-are-free/>; *Entrance Passes*, NAT'L PARK SERV., <https://www.nps.gov/planyourvisit/passes.htm> (last

with the particular goods or services.⁶²

Although common law rights can be acquired automatically, statutory trademark rights resulting from state⁶³ or federal registration⁶⁴ systems expand a common law user's right to the entire jurisdiction in which the registration is granted.⁶⁵ For example, if an entrepreneur offers a widget under a certain mark via wholesalers in Los Angeles and New York City, the widget manufacturer can likely establish exclusive common law rights to use the mark, or brand, in each city absent any record of filings for, or third-party use of, confusingly similar marks under California or New York state law.⁶⁶ The manufacturer can opt to register the mark with California and New York and gain exclusive rights to use the mark in connection with widgets anywhere within the two states.⁶⁷ However, provided that the manufacturer can attest to using the mark in connection with the widgets in interstate commerce, it would be entitled to federal registration, which would provide exclusive

visited Nov. 30, 2025). In each instance, consumers benefit from knowing that any brands or marks encountered during these experiences reliably refer to the same source.

62. See CALLMANN ET AL., *supra* note 61, § 20:34 ("Under common-law rules, mark rights are created by use and exist only where the mark is used.").

63. *Why Register Your Trademark?*, *supra* note 60. Each of the fifty states and Puerto Rico also provides mechanisms for securing exclusive rights by maintaining separate trademark registries, apart from other states, and apart from the USPTO. *Id.* However, any exclusive rights under state statute are limited to the state of registration and do not extend to any other geographic location. *Id.*

64. *Id.* There are similarities and differences between the federal registration process and the process offered by states. Puerto Rico follows the federal model with a period of thirty days for any third party to oppose an application. 2 KARLA G. VENEGAS-BIGAS & LETICIA L. BERMUDEZ-BENITEZ, TRADEMARKS THROUGHOUT THE WORLD § 130:18 (2025) ("Any person who believes they would be harmed by the registration of a mark may oppose the registration by filing a notice of opposition with the Puerto Rico Trademark Office stating the grounds therefor within 30 days after the date of publication of the mark in the PRTC *Official Gazette*."). Most U.S. states do not provide an opposition period. This means that in most jurisdictions, the registration process is arguably less rigorous than the federal option. Like the federal system, the duration of a state trademark registration is between five and ten years before the registration must be renewed. Matthew E. Connors, *When Does a Trademark Expire?*, GESMER UPDEGROVE LLP, <https://www.gesmer.com/publications/when-does-a-trademark-expire> (last visited Nov. 30, 2025).

65. *Why Register Your Trademark?*, *supra* note 60.

66. See *id.*; *State Trademark Information Links*, U.S. PAT. & TRADEMARK OFF., <https://www.uspto.gov/trademarks/basics/state-trademark-information-links> (last visited Nov. 30, 2025).

67. See *Why Register Your Trademark?*, *supra* note 60; *State Trademark Information Links*, *supra* note 66.

rights to the use of the mark in connection with widgets throughout all fifty states and U.S. territories.⁶⁸

Federal trademark applicants, who, if foreign-domiciled, must be represented by a U.S.-licensed attorney,⁶⁹ have several filing options, all of which ultimately require evidence of use in commerce.⁷⁰ Applicants seeking to register marks that are already in use must sign a verification statement attesting to use at the time of filing.⁷¹ An applicant may also apply to register a mark that is not already in use, provided that the applicant has a bona fide intent to use the mark in interstate commerce.⁷² However, the USPTO will not issue a registration for marks filed on an intent-to-use basis until the applicant files an Allegation of Use before approval of the application by the Examiner.⁷³

Whether an applicant files a federal application based on actual use or intent, the phrase “use in commerce” means the “bona fide use of [a] mark . . . in the ordinary course of trade and not merely to reserve a right

68. *See Why Register Your Trademark?*, *supra* note 60. If this sounds like somewhat of a patchwork system, that is because intellectual property laws are not exempt from our system of federalism. *See generally* Homayoon Rafatijo & Dennis D. Crouch, *States Can Infringe upon Your Intellectual Property Rights with Impunity in the Era of “New Federalism”*, 50 AIPLA Q.J. 161 (2022). State, federal, and international options provide mark owners with a considerable degree of flexibility when deciding how best to protect the goodwill associated with their goods or services. Owners can effectively seek as broad or as narrow a scope of exclusive rights as best fits their situation and budget. *See Why Register Your Trademark?*, *supra* note 60. For example, if an owner can establish use in multiple states, then it is often more cost-effective to file a federal application rather than file a patchwork of applications in different states while paying separate filing fees for each state. *See id.* Similarly, if an owner can meet the registration requirements of more than one country, then in some instances, it is often more cost-effective to file an application pursuant to the Madrid Protocol rather than file a patchwork of national applications in different states while paying separate filing fees in each jurisdiction. *See Benefits of the Madrid System*, WORLD INTELL. PROP. ORG., https://www.wipo.int/en/web/madrid-system/madrid_benefits (last visited Nov. 30, 2025).

69. *Do I Need an Attorney?*, U.S. PAT. & TRADEMARK OFF., <https://www.uspto.gov/trademarks/basics/do-i-need-attorney> (last visited Nov. 30, 2025).

70. *Application Filing Basis*, U.S. PAT. & TRADEMARK OFF., <https://www.uspto.gov/trademarks/basics/application-filing-basis> (last visited Nov. 30, 2025).

71. *Basis*, U.S. PAT. & TRADEMARK OFF., <https://www.uspto.gov/trademarks/apply/basis#use> (last visited Nov. 30, 2025).

72. *Intent To Use (ITU) Forms*, U.S. PAT. & TRADEMARK OFF., <https://www.uspto.gov/trademarks/apply/intent-use-itu-forms> (last visited Nov. 30, 2025). The benefit of filing an application before use in commerce commences is that the priority of use date is recognized as the date of filing instead of the date actual use in commerce commences. *Trademark Applications – Intent-to-Use (ITU) Basis*, *supra* note 61.

73. *Application Filing Basis*, *supra* note 70.

in a mark.”⁷⁴ This means that one cannot file an application for the sole purpose of preventing others from using a mark. However, use in commerce does not necessarily mean that goods or services must be sold, or money ever exchanged.⁷⁵ The product or service simply must be available and offered to consumers under the mark claimed.⁷⁶ Provided that the owner can attest to using the mark in commerce in more than one state, the owner is eligible for a federal registration.⁷⁷ Federally registered trademarks grant the registrant exclusive rights to use the mark in commerce in connection with the identified goods or services in every state and in U.S. territories.⁷⁸

2. Must Be Distinctive

Not all marks are entitled to registration as a trademark.⁷⁹ For a mark to be eligible for registration, the mark must have the capacity to identify the source of goods or services in commerce.⁸⁰ The mark must be able to stand out, or otherwise be different from other marks in the marketplace, to the extent necessary for consumers to be able to tell that a product or service is offered from a different source than others available to the consumer.⁸¹ This ability is conceptualized in levels of distinctiveness.⁸² Distinctiveness measures “the primary significance of the mark to the purchasing public.”⁸³

Eligibility for trademark registration is reflected by four different categories: (1) generic, (2) descriptive, (3) suggestive, and (4) arbitrary or fanciful.⁸⁴ While there are technically categories, Judge Friendly highlighted key issues trademark attorneys and scholars still struggle with today:

74. 1 JAMES E. HAWES & AMANDA V. DWIGHT, TRADEMARK REGISTRATION PRAC. § 2:12 (2025).

75. *See id.*

76. *See id.*

77. *Id.*; *Trademark Applications – Intent-to-Use (ITU) Basis*, *supra* note 61.

78. *See Why Register Your Trademark?*, *supra* note 60. Although this rule applies to both goods and services, the analysis is approached a bit differently when the mark has been used in connection with services, but the scope of actual use is somewhat limited. *See Trademark Applications – Intent-to-Use (ITU) Basis*, *supra* note 61.

79. *See U.S. PAT. & TRADEMARK OFF.*, *supra* note 58, at 6–8.

80. *USPTO v. Booking.com B. V.*, 591 U.S. 549, 555, 559 (2020).

81. *See Zobmondo Ent., LLC v. Falls Media, LLC*, 602 F.3d 1108, 1113 (9th Cir. 2010).

82. *Id.*

83. *Id.* at 1113.

84. *Id.*

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. The lines of demarcation, however, are not always bright. Moreover, the difficulties are compounded because a term that is in one category for a particular product may be in quite a different one for another, because a term may shift from one category to another in light of differences in usage through time, because a term may have one meaning to one group of users and a different one to others, and because the same term may be put to different uses with respect to a single product.⁸⁵

Modern cases have sought to further clarify the characteristics of each category of marks. The distinctiveness of a mark depends on the circumstances.⁸⁶ A mark is distinctive and eligible for trademark status “if it either (1) is inherently distinctive or (2) has acquired distinctiveness through secondary meaning.”⁸⁷ “Acquired distinctiveness, i.e., ‘[s]econdary meaning,’ is a term of art which denotes that there is an association formed in the minds of the consumers between the mark and the source or origin of the product.”⁸⁸ Secondary meaning, which is “required to register a descriptive mark, ‘occurs when, in the minds of the public, the primary significance of a mark is to identify the source of the product rather than the product itself.’”⁸⁹ Secondary meaning refers to “significance added to the original meaning of the term . . . [and] exists only if a significant number of” consumers recognize the term “as an indication of association with a particular, even if anonymous, entity.”⁹⁰ “[T]he applicant’s burden of showing acquired distinctiveness increases with the level of descriptiveness; a more descriptive term requires more evidence of secondary meaning.”⁹¹

Generic names are not inherently distinctive, and there is nothing a brand owner can do to make a generic word mark distinctive. A generic name is one that refers to “the name of a class of products or services.”⁹² The word “apple” could never serve as a trademark for the

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

86. *See generally* *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992).

87. *Id.* at 769 (emphasis omitted).

88. *Real Foods Pty Ltd. v. Frito-Lay N. Am., Inc.*, 906 F.3d 965, 978 (2018) (alteration in original) (quoting *Tone Bros., Inc. v. Sysco Corp.*, 28 F.3d 1192, 1201 (Fed. Cir. 1994)).

89. *Id.* at 972.

90. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 13 (AM. L. INST. 1995).

91. *Real Foods Pty Ltd.*, 906 F.3d at 972 (alteration in original).

92. *USPTO v. Booking.com B. V.*, 591 U.S. 549, 551 (2020).

fruit most people imagine when hearing the word. Another example of a generic mark would be “tomato sauce” for jars of pureed plum tomatoes. If either “apple” or “tomato sauce” is used as proposed here, neither word could, or would ever, distinguish one apple or jar of pureed plum tomatoes from another.

Similarly, merely descriptive marks are not inherently distinctive and generally not afforded legal protection.⁹³ A term is merely descriptive if it conveys an immediate idea of the ingredients, qualities, or characteristics of the goods.⁹⁴ For example, the term “cushiony” for pillows would likely be deemed descriptive because most types of bedding, including pillows, serve as a cushion by design. However, some descriptive marks can acquire distinctiveness. Acquired distinctiveness, or “secondary meaning,” refers to the existence of an association that has developed over time in the minds of the consumers that mentally connects the mark, on one hand, and the source or origin of the product, on the other.⁹⁵ An example of a mark that could have originally been held descriptive at the outset is CHICK FIL A. This is because the mark was used in connection with filets of chicken, and the nontraditional spelling of the word “fillet” would arguably be phonetically equivalent. However, over time, due in no small part to the brand owner’s product, marketing, and quality control, a word that would ordinarily be merely descriptive of the underlying goods or services becomes an intangible asset because of how the mark is viewed by the consuming public.⁹⁶

The last two categories of marks, suggestive and arbitrary or fanciful, are considered inherently distinctive or sufficient to serve as source indicators without a showing of acquired distinctiveness or secondary

93. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 769 (1992).

94. *Zobmondo Ent., LLC v. Falls Media, LLC*, 602 F.3d 1108, 1114 (9th Cir. 2010). There are two tests to determine whether a mark is merely descriptive. The imagination test considers whether “a mental leap is required” to understand the mark’s relationship to the product but it is not necessary that the mark “describe the ‘essential nature’ of a product; it is enough that the mark describe some aspect of the product.” *Id.* at 1116 (quoting *Rudolph Int’l, Inc. v. Realys, Inc.*, 482 F.3d 1195, 1198 (9th Cir. 2007)). Alternatively, “the ‘competitors’ needs’ test, ‘focuses on the extent to which a mark is actually needed by competitors to identify their goods or services.’” *Id.* at 1117 (quoting *Rodeo Collection, Ltd. v. W. Seventh*, 812 F.2d 1215, 1218 (9th Cir. 1987)). “The competitors’ needs test is related to the imagination test, ‘because the more imagination that is required to associate a mark with a product or service, the less likely the words used will be needed by competitors to describe their products or services.’” *Id.*

95. *Real Foods Pty Ltd.*, 906 F.3d at 978.

96. *See id.* These intangibles often loosely referred to as “goodwill” can be the most valuable aspect of trademark rights. Because consumers have come to associate a quality product, fast service, and other factors like a clean environment with Chick Fil A restaurants over time, there is tremendous value in exercising and policing exclusive rights over the CHICK FIL A brand.

meaning.⁹⁷ “A term is suggestive if it requires imagination, thought, and perception to reach a conclusion as to the nature of goods.”⁹⁸ Examples of suggestive marks include CHICKEN OF THE SEA for tuna, which is not descriptive because the product isn’t technically chicken, but the reference to chicken provides the purchasing public with general aspects or qualities of the product (a white meat protein that comes from the ocean). “[T]he term ‘fanciful’, as a classifying concept, is usually applied to words invented solely for their use as trademarks.”⁹⁹ EXXON, VERIZON, and STARBUCKS are all fanciful marks because they are not words that otherwise possess a particular meaning in the English language. Similarly, when a common word is “applied in an unfamiliar way, [then] the use is called ‘arbitrary.’”¹⁰⁰ The mark APPLE for computers is an example of an arbitrary trademark.

Marks comprised of English words that are merely descriptive of the goods or services offered under the trade or service mark may be barred from registration.¹⁰¹ However, if over time the mark has acquired secondary meaning, or there is sufficient evidence that consumers have encountered the trademark for a sufficient period of time, and as a result, associate the particular mark as an indicator of source (and not simply words describing the product or service), then the mark is eligible for registration on the Principal Register under Section (f).¹⁰² This simply means that a mark has acquired distinctiveness through use.¹⁰³ Similarly, English words that are descriptive, but capable of becoming

97. *See Real Foods Pty Ltd.*, 906 F.3d at 973.

98. *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 11 (2d Cir. 1976) (quoting *Stix Prods., Inc. v. United Merchs. & Mfrs., Inc.*, 295 F. Supp. 479, 488 (S.D.N.Y. 1968)).

99. *Id.* at 11 n.12.

100. *Id.*

101. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 769 (1992) (“Marks which are merely descriptive of a product are not inherently distinctive. When used to describe a product, they do not inherently identify a particular source, and hence cannot be protected.”).

102. 15 U.S.C. § 1052(f) (“Except as expressly excluded in subsections (a), (b), (c), (d), (e)(3), and (e)(5) of this section, nothing in this chapter shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant’s goods in commerce. The Director may accept as *prima facie* evidence that the mark has become distinctive, as used on or in connection with the applicant’s goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made. Nothing in this section shall prevent the registration of a mark which, when used on or in connection with the goods of the applicant, is primarily geographically deceptively misdescriptive of them, and which became distinctive of the applicant’s goods in commerce before December 8, 1993.”).

103. *See id.*

distinctive through continued use, may be registered on the Supplemental Register.¹⁰⁴ Of course, registration based on acquired distinctiveness or the probability of acquiring distinctiveness also mandates that the mark is not likely to cause confusion with a mark that is the subject of a prior pending application or registration.¹⁰⁵

3. Not Likely to Confuse

“[I]f (and only if) the plaintiff’s trademark is ‘distinctive’ within the meaning of trademark law and is therefore valid and protectable, we must then determine ‘whether [the] defendant’s use of a similar mark is likely to cause consumer confusion.’”¹⁰⁶ The TTAB utilizes a thirteen-factor test to determine whether a newer or potential mark is likely to cause confusion with a mark with prior rights.¹⁰⁷ The thirteen federal circuit courts utilize similar tests, with usually about eight factors to consider.¹⁰⁸

In *In re E. I. DuPont DeNemours & Co.*,¹⁰⁹ the Court of Customs and Patent Appeals¹¹⁰ listed thirteen factors to be considered in determining if a likelihood of confusion exists under Section 2(d), including: (1) “[t]he similarity or dissimilarity of the marks in their entirieties as to appearance, sound, connotation and commercial impression”; (2) the similarity or dissimilarity and nature of the goods or services in question; (3) “the similarity or dissimilarity of established, likely-to-continue trade channels”; (4) “the conditions under which, and buyers to whom, sales are made, i.e., ‘impulse’ vs. careful, sophisticated purchasing”; (5) “the fame of the prior registered mark (sales, advertising, length of use)”; (6) “the number and nature of similar marks in use on similar goods”; (7) “the nature and extent of any actual confusion”; (8) “the length of time during and conditions under which there has been concurrent use without

104. *In re Bush Bros. & Co.*, 884 F.2d 569, 570 (Fed. Cir. 1989).

105. See § 1052(f).

106. Christian Louboutin S.A. v. Yves Saint Laurent Am. Holdings, Inc., 696 F.3d 206, 217 (2d Cir. 2012).

107. See 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 24:43 (5th ed. 2025).

108. *Id.*; see *Trademark Infringement: How U.S. Circuit Courts Determine the Likelihood of Confusion*, COHN LEGAL, PLLC, <https://www.cohnlg.com/trademark-infringement-how-u-s-circuit-courts-determine-the-likelihood-of-confusion/> (last visited Nov. 30, 2025).

109. *In re E. I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973).

110. The Court of Customs and Patent Appeals had jurisdiction over all decisions from the U.S. Patent and Trademark Office until Congress transferred its jurisdiction to the U.S. Court of Appeals for Federal Claims in 1982. *Court of Customs and Patent Appeals*, CORNELL L. SCH. LEGAL INFO. INST., https://www.law.cornell.edu/wex/court_of_customs_and_patent_appeals (last visited Nov. 30, 2025).

evidence of actual confusion”; (9) “the variety of goods on which the mark is or is not used (house mark, ‘family’ mark, product mark”); (10) “the market interface between the applicant and the owner of a prior registered mark”; (11) “the extent to which the applicant has a right to exclude others from use of its mark on its goods”; (12) “the extent of potential confusion, i.e., whether *de minimis* or substantial”; and (13) “any other established fact probative of the effect of use.”¹¹¹

The list of factors should be viewed as more of a balancing test than a checklist. This is because each *DuPont* factor may not be a relevant consideration, or of equal weight, in every case, so courts can consider only the factors of significance.¹¹² The first factor, which refers to appearance (how a mark looks), sound (how a mark is heard when pronounced),¹¹³ and connotation (what the mark means, if it means anything), is often the most relevant consideration.¹¹⁴ This is because the totality of the three leads to what is referred to as the “overall commercial impression.”¹¹⁵ This does not mean that the similarity of the marks in any one respect—sight, sound, or meaning—will automatically result in a finding of likelihood of confusion even if the goods are identical or closely related.¹¹⁶ Rather, the rule is that, in consideration of the relevant facts of a particular case, similarity as to one factor (sight, sound, or meaning) alone “may be sufficient to support a holding that the marks are confusingly similar.”¹¹⁷ The Doctrine of Foreign Equivalents plays a role in the first *DuPont* factor, the similarity or dissimilarity of two marks

111. *In re E. I. DuPont DeNemours & Co.*, 476 F.2d at 1361 (holding RALLY for polishing and cleaning agent not likely to be confused with RALLY for all-purpose detergent).

112. *E.g., In re Mighty Leaf Tea*, 601 F.3d 1342, 1346 (Fed. Cir. 2010); *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315 (Fed. Cir. 2003).

113. *See StonCor Grp., Inc. v. Specialty Coatings, Inc.*, 759 F.3d 1327, 1331–32 (Fed. Cir. 2014) (“There is no correct pronunciation of a trademark that is not a recognized word.”). Accordingly, the Trademark Examining Attorney will take into consideration all potential pronunciations in the likelihood of confusion analysis. TMEP § 1207.01(b)(iv) (Nov. 2024).

114. TMEP § 1207.01(b)(iv) (Nov. 2024).

115. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 396 F.3d 1369, 1371–72 (Fed. Cir. 2005) (“[T]he phrase ‘commercial impression’ is occasionally used as a proxy for the ultimate conclusion of similarity or dissimilarity of marks resulting from a comparison of their appearance, sound, and meaning.”).

116. *Id.*

117. *Eveready Battery Co. v. Green Planet, Inc.*, 91 U.S.P.Q.2d 1511, 1519 (T.T.A.B. 2009) (quoting *In re White Swan Ltd.*, 8 U.S.P.Q.2d 1534, 1535 (T.T.A.B. 1988)) (“[S]imilarity in any one of the elements of sound, appearance or meaning is sufficient to support a determination of likelihood of confusion.”); *see also In re Lamson Oil Co.*, 6 U.S.P.Q.2d 1041, 1042 (T.T.A.B. 1987).

in their entirety as to appearance, sound, connotation, and commercial impression.¹¹⁸

In comparing the marks, the TTAB warns against engaging in a side-by-side comparison. The question of likelihood of confusion turns “not [on] the *nature* of the mark but [on] its *effect* ‘when applied to the goods of the applicant.’”¹¹⁹ Moreover, Trademark Examining Attorneys can only rely upon the details provided within the four corners of the relevant application or registration.¹²⁰ They cannot refer to market conditions or examples of how the marks are actually used in commerce.¹²¹

Trademark attorneys perform trademark clearance searches¹²² in order to counsel clients on both distinctiveness and the likelihood of confusion, ideally before the owner implements use in commerce, and perhaps before marks are officially adopted.¹²³ The search parameters typically take into consideration the same factors a trademark examining attorney is likely to consider while reviewing an application.¹²⁴

118. Alexandra Johnson, *Don't Get Lost in Translation: How Google Translate and Other AI Tools Are Transforming Trademark Law*, ACC DOCKET (Sept. 1, 2017), <https://docket.acc.com/dont-get-lost-translation-how-google-translate-and-other-ai-tools-are-transforming-trademark-law> (“Since a trademark’s meaning is considered in the context of its overall appearance, the Doctrine of Foreign Equivalents requires that trademarks in different languages be compared if consumers are likely to translate them in their heads, even if the trademarks do not share visual or phonetic similarities.”).

119. *In re E. I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1360 (C.C.P.A. 1973) (quoting 15 U.S.C. § 1052) (holding RALLY for polishing and cleaning agent not likely to be confused with RALLY for all-purpose detergent).

120. See TMEP §§ 1207.01(a)(iii), (c) (Nov. 2024).

121. TMEP § 1207.01(d)(iii) (Nov. 2024).

122. For additional guidance regarding trademark searching, see generally GLENN A. GUNDERSEN, TRADEMARK SEARCHING: A PRACTICAL AND STRATEGIC GUIDE TO THE CLEARANCE OF NEW MARKS IN THE UNITED STATES (2d ed. 2000) (explaining the best practices for trademark searching).

123. See *Trademark Applications – Intent-to-Use (ITU) Basis*, *supra* note 61. While a preliminary, or knock-out, search can be performed to uncover identical marks that may already be used or registered, experienced trademark attorneys utilize professional third-party search firms to prepare comprehensive search reports for review. These third-party search firms can conduct searches of federal and state trademark offices for registered marks, and hundreds of databases for common law marks, more efficiently than any single attorney or law office. See generally *Comprehensive Clearance Search for Similar Trademarks*, U.S. PAT. & TRADEMARK OFF., <https://www.uspto.gov/trademarks/search/comprehensive-clearance-search-similar-trademarks> (last visited Nov. 30, 2025).

124. TMEP § 704.01 (Nov. 2024) (“The initial examination of an application by the examining attorney must be a *complete* examination. A complete examination includes a search for conflicting marks and an examination of the written application, any voluntary amendment(s) or other documents filed by applicant before an initial Office action is issued (see TMEP § 702.01), the drawing, and any specimen(s) or foreign registration(s), to determine whether the mark is eligible for the type of registration requested, whether amendment is necessary, and whether all required fees have been paid.”).

B. The Doctrine of Foreign Equivalents

In the United States, marks can be registered on the Principal Register so long as they are valid indicators of source or distinctive and are not likely to confuse consumers.¹²⁵ In fact, combinations of letters that have no significance in any language can be registered as trademarks provided that they are distinctive and not likely to confuse consumers when used in interstate commerce.¹²⁶

Although any combination of symbols or letters can be registered, the examination process for English words and words from other languages is procedurally different.¹²⁷ All marks are subject to a (1) distinctiveness¹²⁸ and (2) likelihood of confusion¹²⁹ analysis. The question of distinctiveness relates to whether a mark can function as a source identifier, or something consumers can use to find a specific product or service again and again.¹³⁰ Likelihood of confusion considers whether marks are so similar and the products and/or services for which they are used are so related that consumers may unintentionally select the wrong product.¹³¹ There are subtle differences in the examination processes of English language words and words from other languages.¹³² English words will be compared to their English counterparts, whereas words from other languages will first be translated into English and then compared to an English counterpart.¹³³

The table below illustrates how words of any language are evaluated and how the Doctrine adds an additional layer of analysis when a mark lacks any English words.

125. *See generally* 15 U.S.C. § 1052(d) (indicating that the statute does not explicitly restrict such word usage, implying an omission in its limitations).

126. *See* Sandra M. Virtue & Darren S. Cahr, *Trademarks and the Brain: Neuroscience and the Processing of Non-Literal Language*, 112 TRADEMARK REP. 695, 696–97 (2022).

127. *See* *In re S Squared Ventures, LLC*, No. 86813357, 2017 WL 4154963, at *4 (T.T.A.B. 2017).

128. *See* USPTO v. Booking.com B. V., 591 U.S. 549, 556 (2020).

129. *See* *In re S Squared Ventures, LLC*, 2017 WL 4154963, at *4.

130. *See* Booking.com B. V., 591 U.S. at 553, 556.

131. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1314–15 (Fed. Cir. 2003).

132. *See* *In re S Squared Ventures, LLC*, 2017 WL 4154963, at *4.

133. *See id.*

Table 1. U.S. Eligibility for Federal Trademark Registration

		Distinctiveness Test	Likelihood of Confusion Test	Doctrine of Foreign Equivalents Test
		Mark is not generic or descriptive of goods/services. ¹³⁴	Mark is not likely to be confused with prior mark whether registered or subject of pending application. ¹³⁵	The English translation is not likely to be confused with prior mark whether registered or subject of pending application. ¹³⁶
Mark Contains	English Words Only	X	X	
	English and Other Language Words	X	X	
	No English Words (Language Dead or Not Common/Modern)	X	X	
	No English Words (Common/Modern Language + Ordinary American)	X	X	X

134. See *Booking.com B. V.*, 591 U.S. at 556, 562.

135. See *In re E. I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1360 (C.C.P.A. 1973).

136. See *In re S Squared Ventures, LLC*, 2017 WL 4154963, at *4.

	Purchaser + Likely to Stop and Translate)			
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This is the framework the TTAB utilized when evaluating the application to register the mark UHAI, which means “life” in Swahili.¹³⁷ UHAI was not compared to LIFE, but the translation “life” was compared to the registered mark LIFE.¹³⁸

There are several problems with this framework. The framework lacks clarity and places greater burdens on applicants seeking to register marks that are not derived from the English language in a way that seems far less than equivalent or equitable. This is a problem because arguments against refusals to register often require legal arguments, and often, the assistance of an attorney.¹³⁹ Although the USPTO does not collect fees for responses to office actions, applicants are often responsible for the professional fees incurred in drafting a response.¹⁴⁰ Unless an applicant appears pro se, responses to refusals to register increase the overall costs of obtaining a trademark registration. Some applicants may find the registration process cost-prohibitive, which is a systemic challenge the USPTO has attempted to mitigate with a number of initiatives.¹⁴¹

137. *See id.* (applying the Doctrine of Foreign Equivalents).

138. *See id.* (“The English translation of “UHAI” in the mark is Swahili for “LIFE.” Applicant has not argued or demonstrated that UHAI is anything other than a direct translation for the word ‘life.’”).

139. *See* TMEP § 1207.01 (Nov. 2024).

140. *See id.*

141. *See generally* *Summary of 2025 Trademark Fee Changes*, U.S. PAT. & TRADEMARK OFF., <https://www.uspto.gov/trademarks/fees-payment-information/summary-2025-trademark-fee-changes> (last visited Nov. 30, 2025). The USPTO has advanced a number of initiatives to address the issue of affordability, including the USPTO’s Law School Clinic Program, comprised of an amazing community of over sixty practicing law professors that teach students lawyering skills while representing individuals and small businesses that would not otherwise have access to counsel. In addition, the Patent Pro Bono Program provides access to a network of independently operated regional programs that matches under resourced inventors and businesses with patent attorneys and agents offering pro bono legal sources. *See generally Patent Pro Bono Program: Free Patent Legal Assistance*, U.S. PAT. & TRADEMARK OFF., <https://www.uspto.gov/patents/basics/using-legal-services/pro-bono/patent-pro-bono-program> (last visited Nov. 30, 2025).

1. Presumably Good Intentions

Although not officially referred to as The Doctrine of Foreign Equivalents until much later, its origins date back to 1876.¹⁴² The Lanham Act makes no reference to the Doctrine of Foreign Equivalents, but it has been incorporated as a set of guidelines in the USPTO's Trademark Manual of Examining Procedure ("TMEP").¹⁴³

Courts frequently provide two main policy reasons for the Doctrine of Foreign Equivalents. One concern relates to unfair competition and the international movement of goods in commerce.¹⁴⁴ Although trademark rights are territorial in nature, American trademark owners have an interest in protecting their registered U.S. marks from being translated into another language and registered in translated form internationally.¹⁴⁵ This is because the rightful owner has already developed the goodwill associated with the trademark.¹⁴⁶ Anyone adopting a mark after the fact is, or would be, trading on the original owner's goodwill.¹⁴⁷ In fact, federal law prohibits the importation of any merchandise into the United States of any products bearing the registered trademark of any U.S. citizen or entity without written consent.¹⁴⁸

There is also an interest in protecting multilingual consumers,¹⁴⁹ particularly those fluent in English and another language.¹⁵⁰ This policy, among other things, has "created tension between (1) applying the [doctrine] less rigorously in order to allow immigrants access to favored

142. See Serge Krimnus, *The Doctrine of Foreign Equivalents at Death's Door*, 12 N.C. J.L. & TECH. 159, 163 (2010) ("In 1876, the Patent Office applied the doctrine for the first time.").

143. See TMEP § 1207.01(b) (Nov. 2024). See generally 15 U.S.C. § 1051–1141.

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

145. See *ITC Ltd. v. Punchgini, Inc.*, 482 F.3d 135, 156–57 (2d Cir. 2007).

146. USPTO v. *Booking.com B. V.*, 591 U.S. 549, 552 (2020).

147. *World Carpets, Inc. v. Dick Littrell's New World Carpets*, 438 F.2d 482, 488 (5th Cir. 1971).

148. 19 U.S.C. § 1526(a).

149. See *Otokoyama Co.*, 175 F.3d at 270–71 ("This [protection] rests on the assumption that there are (or someday will be) customers in the United States who speak that foreign language. Because of the diversity of the population of the United States, coupled with temporary visitors, all of whom are part of the United States marketplace, commerce in the United States utilizes innumerable foreign languages. No merchant may obtain the exclusive right over a trademark designation if that exclusivity would prevent competitors from designating a product as what it is in the foreign language their customers know best.").

150. See MCCARTHY, *supra* note 27, § 12:41 ("[A] term should not be dubbed a 'generic name' in the United States unless a significant part of the relevant group of customers recognize it as the name of a product or service, regardless of the language used.").

brands and (2) applying the [doctrine] more rigorously in order to protect immigrants from confusing a trademark that happens to be generic or descriptive in a foreign language with the generic or descriptive foreign word itself.”¹⁵¹

When a trademark application contains a term that is obviously not an English word, trademark examining attorneys are tasked with deciding whether to apply an additional set of rules to (1) determine whether a mark is distinctive, i.e., serves as an indicator of source in interstate commerce, and (2) is likely to confuse consumers as to the source of the goods or services offered under the proposed mark.¹⁵² The additional set of rules, or the Doctrine of Foreign Equivalents, is deceptively succinct: “[W]ords from common languages are translated into English to determine genericness, descriptiveness, as well as similarity of connotation in order to ascertain confusing similarity with English word marks.”¹⁵³

In addition to the guidelines regarding when the Doctrine should apply, there are three exceptions, or situations where the doctrine should not be applied.¹⁵⁴ These exceptions include: (1) when the ordinary American purchaser would not stop and translate the foreign term; (2) when the foreign term is from a dead¹⁵⁵ or obscure language; and (3) when the foreign term is combined with an English term and the overall commercial impression of the mark, when the terms are read together, is different than the overall commercial impression of the two English words.¹⁵⁶ The second and third exceptions are somewhat straightforward. The Doctrine should not apply to dead languages such as Latin.¹⁵⁷ Similarly, “[c]ourts and the Board frequently have found that consumers would not ‘stop and translate’ marks comprised of terms in multiple languages, often finding that the marks combine the different languages for suggestive purposes to create a certain commercial impression.”¹⁵⁸

Applicants are required to provide translations or transliterations of words at the time of filing, and will be requested to do so if the attorney

151. Jared Stipelman, *A Failure to Communicate: How Linguistics Can Inform Trademark Law*, 42 AIPLA Q.J. 69, 79 (2014) (footnotes omitted).

152. See *Palm Bay Imp., Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 396 F.3d 1369, 1372–73, 1375 (Fed. Cir. 2005) (applying the *DuPont* factors to a foreign mark).

153. *Id.* at 1377.

154. See TMEP § 1209.03(g) (Nov. 2024).

155. See generally *id.* (“The determination of whether a language is ‘dead’ must be made on a case-by-case basis, based upon the meaning that the term would have to the relevant purchasing public.”).

156. *Id.*

157. *See id.*

158. *In re Taverna Izakaya LLC*, No. 88612441, 2021 WL 5411210, at *5 (T.T.A.B. 2021).

doubts the mark contains only English-language words.¹⁵⁹ “If [a] question arises as to the proper translation of a mark, the examining attorney may consult the Trademark Library or Translations Branch of the USPTO” or other external sources.¹⁶⁰ The determination of the appropriate translation often requires consideration of the meaning in relation to the goods and/or services.¹⁶¹

2. Lack of Clarity

Decisions regarding the registration of non-English terms routinely state that the Doctrine is “not an absolute rule and should be viewed merely as a guideline.”¹⁶²

Determining whether a language is a common one is done on a case-by-case basis by the Trademark Examining Attorney during the examination of an application.¹⁶³ Although the Board has issued various decisions as to whether a particular language is common and/or modern,¹⁶⁴ the basis upon which examining attorneys (or judges) arrive at the conclusion that a language is common/modern is rarely articulated to any meaningful degree. Moreover, the USPTO’s TMEP does not publish a listing or otherwise identify which languages are subject to the Doctrine.¹⁶⁵ Accordingly, one must refer to case law for guidance, which is not always consistent. Although the Doctrine is a guideline and not a rule, it has been applied to languages that are arguably uncommon in the United States.¹⁶⁶ Conflicting decisions exist because Examiners are

159. See TMEP § 809 (Nov. 2024) (citing 37 C.F.R. § 2.32(a)(9)–(10) (2025)).

160. See TMEP § 809.02 (Nov. 2024); see also *id.* §1209.03(g).

161. See TMEP §1207.01(b)(vi) (Nov. 2024) (using the Doctrine of Foreign Equivalents in determining likelihood of confusion under 15 U.S.C. §1052(d)); *id.* at §1209.03(g) (using the Doctrine of Foreign Equivalents in determining questions of descriptiveness under 15 U.S.C. §1052(e)(1)); *id.* at §1211.01(a)(vii) (using the Doctrine of Foreign Equivalents in determining whether a term is primarily merely a surname under 15 U.S.C. §1052(e)(4)).

162. *Palm Bay Imp., Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 396 F.3d 1369, 1377 (Fed. Cir. 2005).

163. TMEP § 1209.03(g) (Nov. 2024).

164. See, e.g., *In re Spirits Int’l N.V.*, 86 U.S.P.Q.2d 1078, 1085 (T.T.A.B. 2008) (holding that Russian is a “common, modern language”).

165. See TMEP § 1209.03(g) (Nov. 2024).

166. See, e.g., *In re Steed Co., LLC*, No. 98002385, 2025 WL 985452, at *8 (T.T.A.B. 2025) (holding Doctrine applies to Portuguese because it is the eleventh most spoken non-English language in the U.S.); *In re Shenzhen Airsmart Tech. Co., Ltd.*, No. 87427315, 2021 WL 462034, at *4 (T.T.A.B. 2021) (“This evidence establishes that Dutch is a common modern language spoken by an appreciable number of consumers in the United States.”); *In re S Squared Ventures, LLC*, No. 86813357, 2017 WL 4154963, at *9 (T.T.A.B. 2017) (“Swahili is a common modern language used in several East African countries as well as in the United States.”); *In re Yousef Saleh Alreshidi*, No. 86457267, 2016 WL 7010629, at *4 (T.T.A.B. 2016) (holding that Persian is not an obscure language in connection with the

provided broad discretion in determining what constitutes a common or modern language.¹⁶⁷ The concept of a “common, modern language” has become meaningless¹⁶⁸ given that in practice the Doctrine is routinely applied unless the language is no longer spoken.¹⁶⁹

Unlike the “common or modern language” phrase, there have been some attempts to clarify or otherwise define what it means to be an “ordinary American purchaser” under the Doctrine of Foreign Equivalents.¹⁷⁰ The phrase has been understood as only “the ordinary American purchaser who is knowledgeable in the foreign language.”¹⁷¹ However, it has also been defined to include “all American purchasers, including those proficient in a non-English language who would ordinarily be expected to translate words into English.”¹⁷² Naturally, the definition of “ordinary purchaser” would bear some relationship to the

services at issue); *In re Savisa (Pty) Ltd.*, No. 78154196, 2005 WL 548058, at *4 (T.T.A.B. 2005) (holding the doctrine of foreign equivalents applies because Afrikaans is a modern language which is not obscure).

167. TMEP § 1207.01(b)(vi) (Nov. 2024) (“Whether an examining attorney should apply the doctrine of foreign equivalents turns upon the significance of the foreign mark to the relevant purchasers, which is based on an analysis of the evidence of record, including, for example, dictionary, *Internet*, and LexisNexis® evidence.”) (emphasis added).

168. Anne Gilson LaLonde, *Far from Fluent: Making Sense of the Doctrine of Foreign Equivalents*, 112 TRADEMARK REP. 771, 806–07 (2022) (“All that is needed to find a language ‘common’ is an examining attorney or petitioner with the ability to search the Internet to find Swahili clubs at American universities, the language on road signs in South Africa, and Facebook groups meeting to practice Dutch. Remember, the relevant question is whether the language is ‘from a language familiar to an appreciable segment of American consumers’ commonly spoken in the United States. Certainly, evidence of the language being spoken around the world is relevant to how much it is spoken in the United States, but surely ‘significant numbers in ten countries’ does not automatically mean that it is a common language *in the United States*.); *see, e.g.*, *In re Ithaca Indus., Inc.*, 230 U.S.P.Q. 702, 704–05 (T.T.A.B. 1986) (reasoning that “[i]t does not require any authority to conclude that Italian is a common, major language in the world and is spoken by many people in the United States.”).

169. *See* TMEP § 1207.01(b)(vi)(B) (Nov. 2024) (“[I]f . . . applicant argues that the foreign language is rare, obscure, or dead, then the examining attorney will need to provide evidence that the foreign language is a common, modern language.”); *see also* Enrique Bernat F., S.A. v. Guadalajara, Inc., 210 F.3d 439, 443 (5th Cir. 2000) (“[C]ourts need not concern themselves with words from obsolete, dead, or obscure languages, . . . because one policy undergirding the doctrine is ‘the assumption that there are (or someday will be) customers in the U.S. who speak that foreign language.’”).

170. *See In re Thomas*, No. 78334625, 2006 WL 1258862, at *3 (T.T.A.B. 2006); *In re Spirits Int'l N.V.*, 563 F.3d 1347, 1352 (Fed. Cir. 2009).

171. *In re Thomas*, 2006 WL 1258862, at *3 (“French is a common foreign language spoken by an appreciable segment of the population. Indeed, applicant’s own evidence shows that of the foreign languages with the greatest number of speakers in the United States, French is ranked second only to Spanish.”).

172. *In re Spirits Int'l N.V.*, 563 F.3d at 1352.

likelihood that said purchaser would “stop and translate” the applied-for mark.¹⁷³

The TTAB has held, in a precedential decision, that the phrase “ordinary American purchaser” includes only “the ordinary American purchaser who is knowledgeable in the foreign language.”¹⁷⁴ In *Thomas*, the applicant sought to register the mark MARCHE NOIR (in standard character form) for “jewelry” in International Class 14, also providing an English translation of MARCHE NOIR as “black market.”¹⁷⁵ The Examining Attorney initially cited three registrations as grounds for refusing to register MARCHE NOIR, each covering either clothing, jewelry, or retail sales of jewelry and mineral store services.¹⁷⁶ The Board quickly disposed of marks used in connection with clothing and jewelry.¹⁷⁷ In considering whether MARCHE NOIR would likely be confused with BLACK MARKET MINERALS, the Board rejected the applicant’s evidence in support of the argument that the ordinary American consumer would not stop and translate the mark because only 0.6% of individuals in the United States speak French “very well” or “well.”¹⁷⁸ Ultimately, the court held “not only that the French term MARCHE NOIR is the exact translation of ‘black market,’ but further that the mark would be translated by those who are familiar with the French language.”¹⁷⁹

Neither the TMEP nor the Federal Circuit has provided significant guidance on how to determine when the public is likely to translate, or not, terms from a common foreign language.¹⁸⁰

3. The Equivalent but Unequal Process

The Doctrine, and its trifecta of indeterminate phrases, makes it difficult to predict the nature or amount of evidence an applicant must submit to support its position that a mark without English words is registerable and not likely to be confused with its English equivalent. Moreover, unless a prior administrative or court decision provides defined terms upon which examining attorneys can rely upon, which is

173. *See id.* at 1351–52.

174. *In re Thomas*, 2006 WL 1258862, at *3.

175. *Id.* at *2.

176. *Id.* at *2–3.

177. *Id.* at *3.

178. *Id.* at *3–4.

179. *Id.* at *5.

180. CALLMANN ET AL., *supra* note 61, § 18:8.

rare, examining attorneys are responsible for gathering evidence to support their reasoning.¹⁸¹

The table below provides a representative sampling of relatively recent refusals to register (all within the past twenty-five years), citing marks that were initially refused registration on the grounds that they were likely to be confused with prior English marks under the Doctrine of Foreign Equivalents.¹⁸²

Table 2. U.S. Office Actions Issued Citing Likelihood of Confusion and Applying the Doctrine of Foreign Equivalents

 SN: 79182210	Inuktitut [Endangered]	POLAR BEAR
ABBALLE SN: 88705467	Sicilian [Potentially vulnerable]	DANCE
NOAT SN: 97262193	Western Frisian [Potentially vulnerable]	NOTES
ANAR SN: 86767416	Persian [Potentially vulnerable]	GO!
BRÈAGHA SN: 97895939	Scottish Gaelic [Definitely endangered]	PRETTY

181. See TMEP § 710.01 (Nov. 2024) (“In general, the examining attorney’s refusal or requirement must ultimately be supported with relevant evidence. The examining attorney must ensure that an Office action makes proper citations to any supporting evidence.”).

182. While the data contained in Table 2 and all of the tables contained herein contain publicly available data accessible on the USPTO Trademark Search database (<https://tmsearch.uspto.gov/search/search-information>), it is not published in a readily accessible format. Unlike administrative decisions issued by the TTAB, or a reviewing state or federal court, legal platforms such as Westlaw and Lexis do not provide a mechanism for searching office actions. Similarly, the USPTO does not offer a platform for searching multiple office actions at once, although it is possible to view office actions issued in connection with a filing, one by one, provided that the user knows the application serial number or U.S. registration number and is familiar with the TEAS or TSDR platforms. Accordingly, the author relied heavily on private trademark search platforms that are designed to make trademark searching and clearance more efficient.

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AASOO SN: 97198227	Latin [Extinct]	HORIZON
 Reënboog SN: 97270347	Afrikaans	RAINBOW*
GULABI SN: 97237094	Hindi	PINK
HIMAWARI SN: 90816676	Japanese	SUNFLOWER
DOODHWALA SN: 97213259	Urdu or Hindi	MILKMAN
L'IGNOTO SN: 97068693*	Italian	THE UNKNOWN
MISCATI SN: 97005117	Romanian	MOVE

These applications reveal the hidden inequities of the Doctrine of Foreign Equivalents and the potential for trademark linguicide. The word “hidden” in this context refers to the fact that the arguments in favor of or against registration are less accessible because the decisions made by Examining Attorneys are not published in the same manner as decisions by the TTAB.¹⁸³ Only persons knowledgeable of the USPTO’s Trademark Status & Document Retrieval (“TSDR”) platform, primarily trademark attorneys and related professionals, are likely to delve into the prosecution history of an application that never matured to registration.

Knowledge of TSDR alone does not obviate the potential veil of trademark linguicide. This is because none of the available platforms for accessing the USPTO’s database allows a user to search for applications that contain words from languages at risk of language death in the

^{183.} See *Examination of Your Application*, U.S. PAT. & TRADEMARK OFF., <https://www.uspto.gov/trademarks/basics/examination-application> (last visited Nov. 30, 2025). Of course, this is reasonable because the applicant did not appeal the examining attorney’s refusal and the matter was never considered by the TTAB.

aggregate. While there are options for searching for marks that have translations, there is no option for searching for specific languages of origin, presumably because the application itself does not require that the language of origin be disclosed.¹⁸⁴ Only the English meaning of the mark must be disclosed.¹⁸⁵

What does this mean for applicants? This means that applicants are automatically placed in a defensive position at the time of filing.¹⁸⁶ For example, upon review of the 2023 application to register the mark BRÈAGHA, the examining attorney issued an Office Action, requiring that the “applicant must submit an English translation of the foreign wording.”¹⁸⁷ As is customary, the examiner provided a suggested translation statement: “The English translation of ‘BRÈAGHA’ in the mark is ‘pretty.’”¹⁸⁸ And how did the examiner conclude that the mark applied for was equivalent to the word “pretty” in English? Per TMEP §809.03, “[N]on-English wording in a mark must be translated into English and the translation (and transliteration, if applicable) must be published in the *Trademark Official Gazette* and included on the registration certificate.”¹⁸⁹ Here, the examining attorney attached “translation evidence from *Google Translate*.¹⁹⁰ In this instance, the refusal only required a translation, which may or may not seem significant to a pro se applicant.¹⁹¹ However, the applicant’s attorney not only provided a translation, but correctly directed the examining attorney’s attention to evidence demonstrating that Scottish Gaelic is at risk of extinction.¹⁹²

For the remaining applications in the Table above, each applicant was required to overcome the examiner’s position that the differences in the appearances of the marks when viewed, and the sound of the marks

184. See Taylor Tieman, *What Trademark Attorneys Need to Know about Marks in Foreign Languages*, ALT LEGAL (Apr. 26, 2022), <https://www.altlegal.com/blog/foreign-language-trademarks/>.

185. *Id.*

186. See generally *id.*

187. Non-Final Office Action dated Jan. 17, 2024, U.S. Trademark Application Serial No. 97895939 (filed Apr. 19, 2023), <https://tsdr.uspto.gov/documentviewer?caseId=sn97895939&docId=FTK20230422102449&linkId=12#docIndex=12&page=1> [hereinafter BRÈAGHA Office Action].

188. *See id.*

189. TMEP § 809.03 (Nov. 2024).

190. BRÈAGHA Office Action, *supra* note 187.

191. *See id.*

192. Response to Office Action dated Apr. 17, 2024, U.S. Trademark Application Serial No. 97895939 (filed Apr. 19, 2023), <https://tsdr.uspto.gov/documentviewer?caseId=sn97895939&docId=ROA20240418130834>.

when spoken, were insufficient to distinguish one mark from the other.¹⁹³ While the same burden is theoretically placed upon applicants seeking to register connotatively similar English words used in connection with similar goods or services, overcoming the burden appears more difficult.¹⁹⁴

The English language, particularly as used in the United States, provides numerous opportunities to convey a single message using a near-infinite number of different words that mean the same thing.¹⁹⁵ Of course, these words are synonyms. Applicants seeking to register English synonyms, provided that the words themselves are not generic or descriptive of the underlying goods or services, are more likely to successfully overcome the similar connotation argument.¹⁹⁶ This is true even if the goods or services at issue are nearly identical.

Consider the words “peak” and “summit.” The words themselves likely evoke images of mountains or are suggestive of achieving great heights. Yet, marks that contain these words coexist in the marketplace in connection with similar products or services offered by different owners.

Table 3. Connotatively Similar English Language Marks Registered for Use in Connection with Similar Goods or Services by Different Owners

Mark Registration Number	Class/ Goods/Services	Owner/Registrant Name
SUMMIT RN: 4733332	Class 34: Smokeless cigar vaporizer pipes; Smokeless cigarette vaporizer pipe	Vapium Inc.
PEAK RN: 5656606	Class 34: Electrically-powered oral vaporizers for vaporizing dry herbs, oils, concentrates and other chemical flavorings for personal inhalation	Puff Corp.

193. See *supra* Table 2. See generally Tieman, *supra* note 184.

194. See generally Tieman, *supra* note 184.

195. See *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 11 (2d Cir. 1976).

196. *Id.* at 11–12.

Mark Registration Number	Class/ Goods/Services	Owner/Registrant Name
PEAK RN: 1933492	Class 5: agricultural herbicide	Gowan Company, LLC
SUMMIT RN: 5565909	Class 5: pesticides for domestic use	Summit Chemical Company
PEAK RN: 6907699	Class 2: penetrating water-borne coatings for roof coverings for commercial and residential use	Colorbiotics, LLC
SUMMIT RN: 2497546	Class 2: [clear and] pigmented coatings in the nature of [interior and] exterior paints	Swimc, LLC
PEAK RN: 2126039	Class 4: motor oils and all-purpose lubricants	Old World Industries, LLC
SUMMIT RN: 1917561	Class 4: synthetic, partially synthetic, and petroleum-based lubricants for gears, bearings, compressors, gas engines, turbines, and oven conveyor chains	KI Texas, LP, d/b/a Summit Industrial Products

The words “peak” and “summit” are merely representative of any number of synonymous pairs of English-language words that consumers encounter in connection with the same or similar goods or services on a regular basis. The aural and visual connotations are sufficient to overcome confusion in these cases. Under the Doctrine, connotatively similar words derived from different languages appear to undergo a more rigorous review, even when the words lack any aural or visual similarities.

III. THE ANATOMY OF TRADEMARK LINGUICIDE

There is nothing like returning to a place that remains unchanged to find the ways in which you yourself have altered.

—Nelson Mandela¹⁹⁷

The Doctrine of Foreign Equivalents was purportedly designed to protect bilingual and multilingual speakers. Nevertheless, the Doctrine creates a separate layer of analysis that does not necessarily protect, but rather conceals the needless death of words or languages, in a form of linguicide. “Linguicide is the extermination of languages, usually caused by an outside force.”¹⁹⁸ Here, the Doctrine is an outside force that should not have any effect on languages or language preservation. The question of whether the Doctrine has had any impact does not appear to have even been considered, until now.

It would seem that there are multiple legal, market, and socio-linguistic realities that create a fertile environment for *trademark linguicide*.¹⁹⁹ These realities include the dearth of existing protections for language and culture, international trademark application filing processes like the Madrid Protocol, and the role of the United States in the worldwide economy and its contributions to trademark portfolio management and strategy.²⁰⁰

A. Culture and Language Protection

There is no universally accepted definition of the word “culture.” The proposition that culture describes the characteristics or features of a group or society that fosters unity, including shared values and traditions relating to “arts, lifestyle, human rights, value systems, traditions, and

197. NELSON MANDELA, *LONG WALK TO FREEDOM* 73 (1994).

198. Karen E. Lillie, *Returning Control to the People: The Native American Languages Act, Reclamation, and Native Language Teacher Certification*, 71 BUFF. L. REV. 289, 295 n.19 (2023) (citing Tove Skutnabb-Kangas & Robert Phillipson, *Linguicide*, in THE ENCYCLOPEDIA OF LANGUAGE AND LINGUISTICS 2211, 2211 (1994) (“Linguicide, by contrast, implies that there is an agent involved in causing the death of languages.”)).

199. Moriom Islam, *Causes and Consequences of Language Death: A Comprehensive Analysis*, 6 RSCH. & REV'S: J. ENV'T. SCIS. 11, 13 (2024) (discussing the economic, political and cultural factors contributing to linguicide).

200. See *Madrid Protocol for International Trademark Registration*, U.S. PAT. & TRADEMARK OFF., <https://www.uspto.gov/ip-policy/international-protection/madrid-protocol> (last visited Nov. 30, 2025); see also *Trademark Policy*, U.S. PAT. & TRADEMARK OFF., <https://www.uspto.gov/ip-policy/trademark-policy> (last visited Nov. 30, 2025).

beliefs” is sufficient here.²⁰¹ Within the construct of culture resides the concepts of traditional knowledge,²⁰² traditional cultural expressions,²⁰³ and language.²⁰⁴

1. International Protections

There is no international right in or to language itself. However, there is some degree of international consensus that language cannot serve as a basis for discrimination. For example, the International Covenant on Civil and Political Rights (“ICCPR”) prohibits language discrimination by requiring each party to respect economic, social, and cultural rights “without discrimination of any kind as to race, colour, sex, language, religion, political or other opinion, national or social origin, property, birth or other status.”²⁰⁵ Similarly, the International Labor Organization (“ILO”) Convention 169 on Indigenous and Tribal Peoples recognizes that there can be coexistence between a national language and indigenous languages.²⁰⁶

Conversations around language death and its intersection with intellectual property are still in their infancy and do not focus specifically on trade and service marks.

The World Intellectual Property Organization (“WIPO”) is one of the world’s largest agencies dedicated to informing intellectual property law and policy.²⁰⁷ WIPO recognizes the intersection between culture and intellectual property: “Innovations based on [traditional knowledge] may benefit from patent, trademark, and geographical indication protection,

201. *About the Culture Sector*, UNESCO, <https://www.unesco.org/en/culture/about> (last visited Nov. 30, 2025).

202. *Traditional Knowledge*, WORLD INTELL. PROP. ORG., <https://www.wipo.int/tk/en/tk/> (last visited Nov. 30, 2025) (“Traditional knowledge (TK) is knowledge, know-how, skills and practices that are developed, sustained and passed on from generation to generation within a community, often forming part of its cultural or spiritual identity.”).

203. *Traditional Cultural Expressions*, WORLD INTELL. PROP. ORG., <https://www.wipo.int/tk/en/folklore/> (last visited Nov. 30, 2025) (“Traditional cultural expressions (TCEs), also called ‘expressions of folklore,’ may include music, dance, art, designs, names, signs and symbols, performances, ceremonies, architectural forms, handicrafts and narratives, or many other artistic or cultural expressions.”).

204. *Oral Traditions and Expressions Including Language as a Vehicle of the Intangible Cultural Heritage*, UNESCO, <https://ich.unesco.org/en/oral-traditions-and-expressions-00053> (last visited Nov. 30, 2025).

205. G.A. Res. 2200A (XXI), art. 2, ¶ 2 (Dec. 16, 1966).

206. See Int’l Lab. Org. [ILO], *Indigenous and Tribal Peoples Convention*, art. 28 (June 27, 1989).

207. See *About WIPO*, WORLD INTELL. PROP. ORG., <https://www.wipo.int/about-wipo/en/> (last visited Nov. 30, 2025).

or be protected as a trade secret or confidential information. However, traditional knowledge as such - knowledge that has ancient roots and is often oral - is not protected by conventional (IP) systems.”²⁰⁸ Similarly, “traditional knowledge and associated genetic resources form part of a single integrated heritage. Yet, because [traditional cultural expressions] raise some particular legal and policy questions in [IP], they receive a distinct focus in many national and regional IP laws and in WIPO’s work.”²⁰⁹ Accordingly, WIPO maintains a database of laws, treaties, and regulations on the protection of traditional knowledge, traditional cultural expressions, and genetic resources.²¹⁰ Similarly, Kenya,²¹¹ New Zealand,²¹² and Panama²¹³ have developed systems for protecting traditional knowledge and cultural expression.

2. The United States – Federal Protections

In the United States, conversations regarding the intersection between language and intellectual property exist within larger conversations regarding social justice advocacy, scholarship, and local initiatives.²¹⁴ The U.S. government does not currently recognize rights in traditional knowledge, traditional cultural expressions, and genetic resources.²¹⁵

208. *Traditional Knowledge*, *supra* note 202.

209. *Traditional Cultural Expressions*, *supra* note 203.

210. See *Traditional Knowledge, Traditional Cultural Expressions & Genetic Resources Laws*, WORLD INTELL. PROP. ORG., <https://www.wipo.int/tk/en/databases/tklaws/> (last visited Nov. 30, 2025).

211. See *Traditional Knowledge Laws: Kenya*, WORLD INTELL. PROP. ORG., https://www.wipo.int/tk/en/databases/tklaws/articles/article_0081.html (last visited Nov. 30, 2025).

212. See *Traditional Knowledge Laws: New Zealand*, WORLD INTELL. PROP. ORG., https://www.wipo.int/tk/en/databases/tklaws/articles/article_0013.html (last visited Nov. 30, 2025).

213. *Traditional Knowledge, Traditional Cultural Expressions & Genetic Resources Laws*, *supra* note 210.

214. See generally Christopher Hutton, *Who Owns Language? Mother Tongues as Intellectual Property and the Conceptualization of Human Linguistic Diversity*, 32 LANGUAGE SCIS. 638 (2010).

215. See *United States of America*, WORLD INTELL. PROP. ORG., <https://www.wipo.int/wipolex/en/members/profile/US> (last visited Nov. 30, 2025); see also *Tribal Consultation on the WIPO Treaty on Intellectual Property, Genetic Resources and Associated Traditional Knowledge*, U.S. PAT. & TRADEMARK OFF., <https://www.uspto.gov/ip-policy/tribal-consultation-wipo-treaty-intellectual-property-genetic-resources-and-associated> (last visited Nov. 30, 2025).

English is the language most widely spoken in the United States.²¹⁶ While it is not the official language, there are language protections for some bilingual and multilingual speakers. The federal government recognizes language rights for some linguistic groups, including speakers residing in, or who are descendants of, Native American sovereigns, the Commonwealth of Puerto Rico, and the island of Guam.²¹⁷ The absence of an official language in the United States does not protect languages spoken by language communities' mother tongue, or the speaker's first language of adoption.²¹⁸

Efforts to adopt English as a national language could further frustrate language preservation. Proponents argue that adopting English as an official language would benefit taxpayers:²¹⁹

By declaring English the official language, federal government agencies would no longer be required to provide documents and services in languages other than English—saving valuable taxpayer money, which could then instead be used to create more opportunities for immigrants to learn English. Even more importantly, operating in one official language sends a clear message to newcomers to the United States: learning English is essential to success.²²⁰

216. See *United States*, MIGRATION POL'Y INST., <https://www.migrationpolicy.org/data/state-profiles/state/language/US> (last visited Nov. 30, 2025).

217. See 25 U.S.C. § 2904 ("The right of Native Americans to express themselves through the use of Native American languages shall not be restricted in any public proceeding, including publicly supported education programs."); see also 25 U.S.C. § 2902(1) ("The term 'Native American' means an Indian, Native Hawaiian, or Native American Pacific Islander."); Chad Hunter, *President Biden Signs Native Language Acts into Law*, CHEROKEE PHOENIX (Jan. 10, 2023), https://cherokeephoenix.org/news/.../article_ad89d41c-9062-11ed-9a41-ef5db4d921fc.html ("The Durbin Feeling Native American Languages Act, also signed into law, will direct the president to review federal agencies' compliance with the Native American Language Act requirements and make recommendations to improve interagency coordination in support of Native American languages. It will also authorize a federal survey of Native language use and the unmet needs of language-revitalization programs every five years."); Dimary Hernández Soto, *What Language is Spoken in Puerto Rico (2025)*, <https://www.puertorico.com/what-language-is-spoken-in-puerto-rico> (last visited Nov. 30, 2025). See generally 1 GUAM CODE ANN. § 706 (2024).

218. See generally Hutton, *supra* note 214.

219. The implication here that immigrants do not pay federal income taxes is not only incorrect but does not address the justification for not providing necessary services for taxpayers that do not speak, or have not yet learned, English.

220. Mauro E. Mujica, *Why an Official Language is Needed Now More Than Ever*, THE HILL (Feb. 20, 2015, 4:00 PM), <https://thehill.com/blogs/congress-blog/233159-why-an>

There are potentially negative consequences for communities marginalized based on perceived or actual differences in language and culture. Negative consequences may be felt broadly due to otherism²²¹ and social exclusion,²²² or individually through loss of employment²²³ or life.²²⁴

Existing intellectual property policies and practices in the United States could provide a foundation for broader protections. For example, the USPTO maintains the Native American Tribal Insignia Database, which is a collection of insignia that the USPTO uses as a reference when deciding whether trademarks in pending applications falsely suggest connections to the insignia of Native American tribes.²²⁵ Under the

official-language-is-needed-now-more-than-ever/; *see also* K.C. McAlpin, *Why English*, PROENGLISH, <https://proenglish.org/why-english/> (last visited Nov. 30, 2025) (“Having English as our official language simply means that for the government to act officially, or legally, it must communicate in English. It means the language of record is the English language, and that no one has a right to demand government services in any other language. Official English would also reinforce America’s historic message to new immigrants — that we expect them to learn English as the first step in their assimilation — and that we are committed to ensuring that all Americans share in the economic, social and political benefits of having a common language.”).

221. *See, e.g.*, Nick Romano, *Grammys Displays ‘Singing in Non-English’ for Bad Bunny Performance Instead of Closed Captions*, ENT. WKLY. (Feb. 6, 2023, 10:02 AM), <https://ew.com/awards/grammys/grammys-bad-bunny-closed-captions-singing-non-english>.

222. Valeria Macias, “*Speaking Non-English*”: *Not Worthy of a Grammy?*, USC ANNENBERG MEDIA (Feb. 15, 2023, 11:11 AM), <https://www.uscannenbergmedia.com/2023/02/15/speaking-non-english-not-worthy-of-a-grammy> (“Many USC students also felt strongly after the 2023 Grammys ceremony. When asked about their opinions on the closed captioning provided for Bad Bunny at the 2023 Grammys, Fiorella Sosa, a freshman majoring in business administration, said, ‘What is non-English — what does that even mean? It’s not like the only existing language is English. I think it’s just rude, disrespectful, and racist.’”).

223. *Cop Written Up for Violating NYPD’s “English-Only Workplace” Policy: Report*, NBC N.Y. (June 24, 2013, 12:48 PM), <https://nbcnewyork.com/news/local/english-only-workplace-policy-nypd-police-department-reprimand/2096859/> (“An NYPD officer who says she spoke briefly in Spanish to a co-worker who mentioned getting coffee as she walked by was written up for breaking a department rule that requires all department business to be conducted in English, according to a report.”).

224. *See* Audrey Claire Davis, *Lawsuit Claims Navajo Man Died Because Medical Staff Didn’t Give Him an Interpreter*, KRQE NEWS, <https://krqe.com/news/new-mexico/lawsuit-claims-navajo-man-died-because-medical-staff-didnt-give-him-an-interpreter/> (Mar. 6, 2023, 8:44 AM) (“The lawsuit claimed medical center staff assured her that he would be well cared for. However, according to medical records, they never considered his language needs or provided him with an interpreter. Williams was in an altered mental state — a symptom of a severe infection — but because of the language barrier, staff members missed this red flag.”).

225. *Native American Tribal Insignia*, U.S. PAT. & TRADEMARK OFF., <https://www.uspto.gov/trademarks/laws/native-american-tribal-insignia> (last visited Nov. 30, 2025).

Indian Arts and Crafts Act of 1935, third parties cannot misrepresent that products have been created by “recognized” Indian tribes.²²⁶ While the insignia database and the Indian Arts and Crafts Act are notable, the piecemeal approaches lack a cohesive strategy. The effectiveness of these approaches, and others, is beyond the scope of this Article. Here, it is sufficient to bear in mind that given the lack of acknowledgement of federal rights in culture, language, traditional knowledge, and traditional cultural expression, it is a matter of international record based on the World Intellectual Property Organization’s published data.²²⁷ To the smaller speaking communities that exist in the United States, the record is part of their lived experience.

B. The Madrid Protocol

The Madrid Protocol,²²⁸ which is administered by WIPO, provides a streamlined filing process for seeking international protection in member countries.²²⁹ The member countries, or contracting parties, comprise the Madrid Union.²³⁰ The Madrid Union currently has 115 members, covering 131 countries.²³¹ The United States became a member of the Madrid Protocol in 2003, nearly one hundred years after the doctrine was adopted.²³²

The Madrid process itself does not create trademark rights, but allows applicants to file an application in the member country and designate other countries for which it also seeks trademark protection.²³³ Any applicant who is a national of, or domiciled in, any of the 131 member

226. 18 U.S.C. § 1159(a) (“It is unlawful to offer or display for sale or sell any good, with or without a Government trademark, in a manner that falsely suggests it is Indian produced, an Indian product, or the product of a particular Indian or Indian tribe or Indian arts and crafts organization, resident within the United States.”).

227. See INTELLECTUAL PROPERTY STATISTICAL COUNTRY PROFILE 2023: UNITED STATES OF AMERICA, WORLD INTELL. PROP. ORG. 1 (2023), <https://www.wipo.int/edocs/statistics-country-profile/en/us.pdf>.

228. McCARTHY, *supra* note 27, § 19:31.80 (“The Madrid Agreement and the Madrid Protocol are independent treaty agreements but with overlapping nation memberships. Thus, there are three groups of nations: (1) nations that are members of *only* the Madrid Agreement (e.g. Vietnam); (2) nations that are members of *only* the Madrid Protocol (e.g. the United States); and (3) nations that are members of *both* the Agreement and the Protocol. (e.g. China and Germany.”).

229. *Benefits of the Madrid System*, *supra* note 68.

230. *Madrid System Members*, WORLD INTELL. PROP. ORG., <https://www.wipo.int/web/madrid-system/members/index> (last visited Nov. 30, 2025).

231. *Id.*

232. See Gary Duvall & Elizabeth Buckingham, *It’s a New World in Trademarks—The U.S. Joins the Madrid Protocol*, 3 INTELL. PROP. UPDATE 7 (2003).

233. *Madrid System: Frequently Asked Questions*, WORLD INTELL. PROP. ORG., <https://www.wipo.int/en/web/madrid-system/faq> (Sept. 2023).

countries may file an application.²³⁴ The member states represent more than eighty percent of world trade.²³⁵

A key benefit of the Madrid system is its efficiency. Any applicant need only file one application instead of filing an application in each national trademark office.²³⁶ Once filed, the Madrid member trademark office will then forward the application to the trademark offices which the applicant has designated.²³⁷ Although there is only one filing, the application will be reviewed separately by each trademark office, whereby the registration rules applicable to each country are applied.²³⁸

There are other benefits to using the Madrid system. There can be potential financial savings given that a Madrid extension may cost less than filing a separate national application in multiple countries.²³⁹ Another advantage is that the priority date recognized by the trademark office of origin is the priority date that will be recognized by the trademark offices of all designated countries.²⁴⁰

There are drawbacks to the Madrid Protocol. Because extensions of protection are based on the original filing, the original filing must be successful for any of the requested extensions of protection to remain viable.²⁴¹ If, for some reason, the original application does not mature to registration, none of the applications pending in member countries will mature to registration either.²⁴² Also, depending on the configuration of the applicant's business plan, specifically where the applicant plans to

234. *See id.*; *see also Madrid System Members*, *supra* note 230.

235. *Madrid System Members*, *supra* note 230.

236. *Madrid System – The International Trademark System*, WORLD INTELL. PROP. ORG., <https://www.wipo.int/en/web/madrid-system> (last visited Nov. 30, 2025).

237. *Madrid System: Filing International Trademark Applications – How to File*, WORLD INTELL. PROP. ORG., https://www.wipo.int/en/web/madrid-system/how_to/file/file (last visited Nov. 30, 2025).

238. *Id.*

239. *See* William M. Borchard & Jeffrey H. Epstein, *Update on Cost Savings Using International Trademark Filing Systems*, COWAN LIEBOWITZ & LATMAN (June 2, 2016), https://www.cll.com/OnMyMindBlog/Update_on_cost_savings_using_international_trade_mark_filing_systems.

240. WORLD INTELL. PROP. ORG., *GUIDE TO THE MADRID SYSTEM* 33 (2022) (“An international registration, which is cancelled at the request of the Office of origin, may be transformed into national or regional applications in the respective members in which the international registration had effect, each benefiting from the date of the international registration (or the subsequent designation) and, where applicable, its priority date.”).

241. *See id.* at 100, 140, 161, 235.

242. *See id.*

offer its products or services, the Madrid option may be more expensive.²⁴³

Trademark attorneys around the world have developed practices that enhance the benefits of the Madrid system for some applicants. One common practice in the industry is filing an application in a Madrid member trademark office that does not have a publicly available trademark application and registration database.²⁴⁴ These filings are often referred to as “stealth filings” because they allow an applicant, typically a large international corporation, to secure a priority date in the relevant jurisdictions without revealing the applicant’s broader intentions.²⁴⁵ A stealth filing aids brand owners (and their investors) by keeping new products, technology, or the launch of a completely new line of business a secret until the brand owner is ready to disclose its intentions to the public.²⁴⁶

There are only a few jurisdictions that do not have a publicly available trademark database.²⁴⁷ Even so, the value of filing in these jurisdictions cannot be understated, particularly if an applicant has the legal and financial resources. Stealth filings made possible by the Madrid Protocol disproportionately benefit large or otherwise wealthy corporations, many of which are based in the United States.²⁴⁸ And although English is not the official language of the United States, it has arguably become the lingua franca, or the language of business and trade, around the world.²⁴⁹ Any applicant seeking to do business around the world will, or in many instances should, consider obtaining a trademark registration in the United States. This is because even though

243. *eMadrid: File an Application for an International Trademark Registration*, WORLD INTELL. PROP. ORG., <https://www.wipo.int/web/emadrid/file-an-application> (last visited Nov. 30, 2025) (website allows the ability to test fees).

244. Annie Allison, *Trademark Food for Thought When Rebranding*, LAW360 (Oct. 24, 2024, 4:55 PM), <https://www.law360.com/articles/2251302/trademark-food-for-thought-when-rebranding>.

245. *Id.*

246. *See id.*

247. *See Keep It on the 44(D)ownlow: Filing Trademark Applications Abroad to Preserve Confidentiality and Priority*, ALT LEGAL (Jan. 26, 2021), <https://www.altlegal.com/blog/keep-it-on-the-44downlow/> (referencing the Kingdom of Tonga, Jamaica, Mauritius, and Azerbaijan as countries that do not have publicly available databases).

248. *See, e.g.*, Priya Vashishth & Nidhi, *How are American Multinational Technology Companies Strategizing Their Trademark Filing?*, GREYB, <https://www.greyb.com/blog/how-are-american-multinational-technology-companies-strategizing-their-trademark-filing/> (last visited Nov. 30, 2025).

249. *Why English is the Global Language of Business*, EDUSYNCH (Dec. 12, 2024), <https://edusynch.com/blog/english-in-business/2024/12/12/english-is-the-global-language-of-business>.

Americans “[c]onstitut[e] less than [five] percent of the world’s population, Americans generate and earn more than [twenty] percent of the world’s total income. America is the world’s largest national economy and leading global trader.”²⁵⁰ Historically, if a business intends to market to American consumers, it behooves the business to adopt and register marks derived from the English language.²⁵¹

While beneficial to large international corporations, the interrelationship between the Doctrine and stealth filings under the Madrid Protocol poses negative consequences for communities interested in registering marks that contain words from lesser-known languages. If an applicant seeks to register a word from a lesser-known language in the United States, and the English equivalent is already registered in the United States, registration under the current Doctrine’s framework is unlikely. There is also a potential ripple effect if both the U.S. registrant of an English equivalent and the would-be applicant seeking to register a mark from another language intend to or actually market their products and services internationally.

The Doctrine magnifies the connotative significance of the mark, such that translations are thought to also refer back to the English term itself, even if the brand owner itself does not use the translations in commerce in connection with the relevant goods or services.²⁵² In essence, brand owners can use the Doctrine as both a sword and a shield. On one hand, registration of the English term provides a layer of protection, or a shield, preventing third parties from using a mark that is similar in appearance, sound, and connotation. However, the same registered mark, when purportedly threatened by a connotatively similar mark, serves not only as a shield to maintain exclusive rights to use the English term in connection with the identified goods and services, but also a sword to forcefully parry and knock out a subsequent applicant’s option to register a non-English term, even if it is visually and aurally different.

The inability to register marks that lack English words in the United States likely has a profound effect on applicants seeking to register marks in their native language or mother tongue. It does not require a leap of logic to question the extent to which refusals to register based on Madrid extension serve not only as a barrier for international trademark registration, but also as a barrier for language communities to preserve

250. *Economy & Trade*, OFF. OF THE U.S. TRADE REPRESENTATIVE, <https://ustr.gov/issue-areas/economy-trade> (last visited Nov. 30, 2025).

251. See *Trademarking Common Foreign Words – Yes You Can*, SQUIRE PATTON BOGGS: GLOB. IP & TECH. L. BLOG (Mar. 3, 2021), <https://www.iptechblog.com/2021/03/trademarking-common-foreign-words-yes-you-can/>.

252. See *id.*

a word that would otherwise become extinct if the language itself cannot escape extinction.

C. U.S. Brands – International Influence and Practice

The United States “is the world’s largest national economy and leading global trader.”²⁵³ Words (English or otherwise) that are used as marks in the United States are increasingly used and protected around the world.²⁵⁴ Similarly, marks that are initially used or registered outside of the United States are displayed in connection with goods or services online, as well as in brick-and-mortar stores in America.²⁵⁵ Due to advances in the general technology and telecommunications industries, among others, the fundamentals of commercialization are not local and instead exist in a global marketplace.

Generally, U.S. brand owners with large international portfolios opt to register marks in other countries in a form identical to the way a mark is depicted in filings with the USPTO.²⁵⁶

There are many reasons brand owners are inclined to register identical marks internationally. The most obvious reason is that it is more logically efficient to offer the same products or services offered under the same brand elsewhere as they are offered in the United States.²⁵⁷ The use of identical marks enables brand owners the flexibility to use the same marketing mechanisms (for example, print and spoken advertisements such as commercials) and the same branding and marketing materials (for example, labels, product packaging, tags, user

253. *Economy & Trade*, *supra* note 250.

254. See *Trademarks Highlights*, WORLD INTELL. PROP. ORG., <https://www.wipo.int/web-publications/world-intellectual-property-indicators-2024-highlights/en/trademarks-highlights.html> (last visited Nov. 30, 2025) (“In 2023, there were an estimated 88.2 million active trademark registrations across 155 IP offices globally, representing an increase of 6.4% compared to 2022. This growth occurred despite an annual decline in trademark registrations at a number of offices.”).

255. See *America’s Favorite Foreign Retailers*, FORBES (Mar. 24, 2009, 4:00 PM), <https://web.archive.org/web/20230621132751/https://www.forbes.com/2009/03/24/foreign-retailer-favorites-lifestyle-style-foreign-retailer.html> (retailers such as H&M are originally from outside the U.S.).

256. See *Madrid Protocol*, U.S. PAT. & TRADEMARK OFF., <https://www.uspto.gov/ip-policy/trademark-policy/madrid-system-international-registration-marks-madrid-protocol> (last visited Nov. 30, 2025) (noting that “[t]he basic application or basic registration serves as a basis for filing an international application and obtaining an international registration from WIPO.”). There are exceptions, some of which are discussed herein. However, this Article does not attempt to capture every potential exception to this practice but highlights common reasons marks may be registered in a different form or language than used or registered in the United States. *See id.*

257. See *Madrid System – The International Trademark System*, *supra* note 236.

manuals, etc.).²⁵⁸ A less obvious reason for using the same marks internationally is that the continuity of use strengthens brand recognition.²⁵⁹ It is difficult to establish brand recognition if the brand owner uses different marks, or variations of the same mark, in settings where consumers encounter the underlying products or services. Brand owners want consumers to remember their brand, and from a consumer protection standpoint, we want consumers to be able to rely on their prior experiences with brands to make decisions on whether and how to find the same products or services again.

Using identical marks can also minimize a brand owner's expenses. In the United States, and around most of the world, trademark applicants are not entitled to list alternative or multiple marks on a single application.²⁶⁰ To the extent that an applicant seeks to register different versions or variations of a mark, a separate application must be filed.²⁶¹ From a cost perspective, it often doesn't make sense to register different variations or translations of a mark in each jurisdiction.²⁶² Doing so would require brand owners to create jurisdiction-specific advertising and marketing campaigns, which would also become very expensive.²⁶³

Nevertheless, there are reasons that U.S. brand owners may opt to offer the same product or service under a different mark outside of the United States.

A brand owner's decision to use different brand names in different jurisdictions may be a matter of choice.²⁶⁴ For example, Procter & Gamble markets some of the company's cleaning preparations under the mark MR CLEAN® in the United States, yet registers straight translations internationally, based on the local language.²⁶⁵ Similarly,

258. See, e.g., *Using WIPO's Madrid System to Protect Trademarks Abroad – A Trademark Lawyers' Perspective*, WORLD INTELL. PROP. ORG. (May 13, 2024), <https://www.wipo.int/web/ip-advantage/w/stories/using-wipo-s-madrid-system-to-protect-trademarks-abroad-a-trademark-lawyers-perspective>.

259. See *Benefits of the Madrid System*, *supra* note 68.

260. See HAWES & DWIGHT, *supra* note 74.

261. See *id.* § 3:5.

262. See, e.g., Josh Gerben, *How Much Does It Cost to Register an International Trademark?*, GERBEN IP, <https://www.gerbenlaw.com/blog/how-much-does-it-cost-to-register-an-international-trademark> (Feb. 13, 2025).

263. See *Going Global with Amazon Ads: The Ultimate Guide to Multi-Country Advertising*, ADVERT. WK., <https://advertisingweek.com/going-global-with-amazon-ads-the-ultimate-guide-to-multi-country-advertising/> (last visited Nov. 30, 2025).

264. Colleen Kane, *Brands Called by Different Names Outside U.S.*, CNBC, <https://www.cnbc.com/2014/09/26/brands-called-by-different-names-outside-us.html> (Sept. 29, 2014, 9:01 AM).

265. *Id.* ("The name Procter & Gamble's product takes internationally is generally a matter of straight translation into the local language: Don Limpio in Spain, Maestro Limpio

Frito-Lay North America, a subsidiary of PepsiCo, Inc., chose to market its potato chips and other snacks under regionally specific brand names sold alongside the LAYS® brand in the United States.²⁶⁶ Unlike Procter & Gamble, Frito-Lay may use brand names that aren't necessarily translations of "lays."²⁶⁷

Undoubtedly, there are other circumstances under which U.S. brand owners have no choice but to adopt a different mark when used in connection with the same products in other jurisdictions. One of the most common reasons for using an alternative brand name is that the name is not available or already owned by someone else.²⁶⁸ Another reason brand owners offer products or services under a different mark is that the U.S. brand may not be as well received in another country.²⁶⁹

in Mexico and Puerto Rico, Mastro Lindo in Italy and Malta, Meister Proper in Germany, Meneer Proper in Flanders and Belgium, Pan Proper in Poland, Mr. Proper in the Netherlands, Eastern Europe, and the Middle East, Monsieur Net in French Canada and Quebec, Monsieur Propre in Belgium and France, and Мистер Мускул in Russia. However, in the U.K. and Ireland, since a Mr. Clean already existed there, the product is called Flash, and goes without a mascot.”).

266. Lara Walsh, *8 Popular Packaged Foods that Go by Different Names Around the World*, BUS. INSIDER (Jan 23, 2019, 5:37 PM), <https://www.businessinsider.com/famous-foods-with-different-names-around-the-world-2019-1>.

267. Compare *id.*, with *10 Brands that Have Changed Their Names for Local Markets*, CLEAR WORDS TRANSLATIONS (Apr. 24, 2019), <https://web.archive.org/web/20201023052742/http://clearwordstranslations.com/10-brands-change-their-names-for-local-markets/> (“In the UK, the brand is called ‘Walkers’, [sic] while in Australia it uses the ‘Smith’s’ brand for marketing purposes. Also, Mexicans eat ‘Sabritas’ and, if you’re in Israel, you need to order a bag of ‘Tapuchips’ to get your favorite Lay’s.”).

268. *Brands Called by Different Names Outside U.S.*, *supra* note 264 (“In Australia, Burger King franchises operate under the name Hungry Jack’s. It’s been this way since 1971, when the first Hungry Jack’s opened in a suburb of Perth. At that time, the Burger King name was already a registered trademark of a small takeaway shop in Adelaide.”); see also Herrine Ro, *15 of Your Favorite Brands That Are Called Entirely Different Things Abroad*, BUS. INSIDER (July 13, 2016, 10:30 AM), <https://www.businessinsider.com/brands-with-different-names-abroad-2016-7> (“In order to avoid confusion with another retail chain, TJ Hughes, the American T.J. Maxx was subtly changed to T.K. Maxx when it crossed the Atlantic.”).

269. See, e.g., Amy Houston, *Lost in Translation: 10 Times Brands Got It Wrong When Going Global*, THE DRUM (Oct. 10, 2022), <https://www.thedrum.com/news/2022/10/10/lost-translation-10-times-brands-got-it-wrong-when-going-global> (Coors Brewing Company marketed its beer with the slogan “Turn it loose,” but when directly translated into Spanish, the phrase came out to mean to suffer from diarrhea.); Geoffrey James, *20 Epic Fails in Global Branding*, INC. (Oct. 29, 2014), <https://www.inc.com/geoffrey-james/the-20-worst-brand-translations-of-all-time.html> (“Mercedes-Benz entered the Chinese market under the brand name ‘Bensi,’ which means ‘rush to die’ and ‘Puffs’ marketed its tissues under that brand name in Germany even though ‘puff’ is German slang for a brothel.”).

D. Language Death

A language is considered dead when it is no longer spoken or lacks more than one speaker.²⁷⁰ Language death is “stark and final.”²⁷¹ Living “languages have no existence without people” or speakers.²⁷²

1. Language Death Around the World

Linguistic diversity, or the number of different languages spoken in homes and in commercial transactions, is decreasing.

Optimistic estimates suggest that at least fifty percent of today’s spoken languages will be extinct or seriously endangered by 2100. More pessimistic, but also realistic, estimates claim that ninety to ninety-five percent will become extinct or seriously endangered by the end of this century. Most of these languages are Indigenous languages. Humanity may well have only three hundred to six hundred oral languages left that are unthreatened by the end of this century.²⁷³

What is the harm of losing languages?

“Losing these languages means losing a great part of our human heritage, because languages are much more than spoken or written words and sentences – they are also the means through which cultures, knowledge, and traditions are preserved and transmitted between generations.”

—Mona Rishmawi, former Chief of the Rule of Law, Equality and Non-Discrimination Branch in the Office of the High Commissioner for Human Rights.²⁷⁴

“There is a growing awareness that indigenous languages do not simply serve as cultural artefacts Rather, they equip their users with an invaluable skillset and expertise in different fields, from the environment to education, the economy, social and political life, and family relations.”

270. DAVID CRYSTAL, LANGUAGE DEATH 14–15 (2014) (ebook).

271. *Id.* at 1.

272. *Id.*

273. *International Decade of Indigenous Languages 2022 – 2032*, *supra* note 34.

274. *Many Indigenous Languages Are in Danger of Extinction*, U.N. HUM. RTS. OFF. OF HIGH COMM'R (Oct. 17, 2019), <https://web.archive.org/web/20220628215415/https://www.ohchr.org/en/stories/2019/10/many-indigenous-languages-are-danger-extinction>.

—Irmgarda Kasinskaite, Advisor for Communication and Information at United Nations Educational, Scientific and Cultural Organization (“UNESCO”).²⁷⁵

In 2021, UNESCO²⁷⁶ launched the World Atlas of Languages, “an unprecedented initiative to preserve, revitalize and promote global linguistic diversity and multilingualism as a unique heritage and treasure of humanity.”²⁷⁷ It presents data on existing languages “spoken or signed in the world, in use and not in use.”²⁷⁸ More recently, the United Nations “launched what it calls the International Decade of Indigenous Languages—a ten-year ‘survival plan’ to protect global Indigenous languages from extinction, in response to predictions that more than half of all languages will be lost by the end of the 21st century.”²⁷⁹ This decade is being observed between 2022 and 2032,²⁸⁰ which suggests that now is a good time to consider whether our trademark laws in the United States potentially serve as a barrier to preserving languages other than English, especially in what some would argue is a less than hospitable environment for non-native English language speakers.²⁸¹

2. Language Death in the United States

In 2011, UNESCO identified multiple languages spoken by U.S. citizens on its list of endangered languages, notably Hawaiian.²⁸² The history of this indigenous language provides one example of how United States policies have and continue to contribute to the death of indigenous

275. *Id.*

276. UNESCO, like WIPO, is an agency of the United Nations. *Who We Are*, UNESCO, <https://www.unesco.org/en/brief> (last visited Nov. 30, 2025). It focuses on social, cultural and economic issues, including but not limited to education, human rights, and poverty. *See id.*

277. *UNESCO Launches the World Atlas of Languages to Celebrate and Protect Linguistic Diversity*, UNESCO, <https://www.unesco.org/en/articles/unesco-launches-world-atlas-languages-celebrate-and-protect-linguistic-diversity> (Apr. 20, 2023).

278. *Id.*

279. Athina Kontos, *UN Launches Ten-Year ‘Survival Plan’ for Endangered Languages*, LANGUAGE MAG. (Mar. 5, 2023), <https://www.languagemagazine.com/2023/03/05/un-launches-ten-year-survival-plan-for-endangered-languages/>.

280. *Indigenous Languages Decade (2022-2032)*, UNESCO, <https://www.unesco.org/en/decades/indigenous-languages> (last visited Nov. 30, 2025).

281. *See generally* Tamar Brandes, *Rethinking Equality: National Identity and Language Rights in the United States*, 15 TEX. HISP. J.L. & POL’Y 7 (2009).

282. *Endangered Languages: The Full List*, THE GUARDIAN: DATABLOG, <https://www.theguardian.com/news/datablog/2011/apr/15/language-extinct-endangered> (last visited Nov. 30, 2025).

languages. “The Hawaiian language, ‘Ōlelo Hawai‘i, is the indigenous language of Hawai‘i and official language of the state of Hawai‘i along with English” today.²⁸³ This recognition does not belie the fact that the United States government once banned the use of the language in public education in 1896.²⁸⁴ “Many students were punished for speaking ‘ōlelo Hawai‘i in school, and the number of Hawaiian language speakers dwindled from nearly 40,000 speakers in 1896 to just 2,000 in 1978.”²⁸⁵ Hawaiian had become a threatened language.²⁸⁶ “The law basically promoted the English language as the medium of education and teaching, but it effectively banned the use of ‘Olelo Hawai‘i in public, and it also had effects in private use as well”²⁸⁷ Ninety years after the ban, the state of Hawaii, through its Department of Education’s Hawaiian Language Immersion Program, reintroduced the language as the medium of instruction in public schools in 1987.²⁸⁸ Just three years ago, in 2022, the legislature passed a resolution apologizing to the Native Hawaiian people for banning the use of the Hawaiian language in state schools for ninety years.²⁸⁹ Even after the introduction of the Hawaiian Language Immersion Program, Hawaiian remains a critically endangered language.²⁹⁰

Despite this finding, applicants seeking to register Hawaiian marks continued to be denied registration due to the preexistence of marks comprised solely of English words. A representative sampling of Hawaiian marks that were initially refused registration on likelihood of

283. ‘Ōlelo Hawai‘i: Hawaiian Language, NAT’L PARK SERV., <https://www.nps.gov/havo/learn/historyculture/olelo-hawaii.htm> (May 4, 2023).

284. *Id.*; Act of June 8, 1896, No. 57, 1896 Haw. Sess. Laws 181, 189 (“The English language shall be the medium and basis of instruction in all public and private schools”).

285. Ku‘uwehi Hiraishi, *State Formally Apologizes for Banning Hawaiian Language in Schools for 90 Years*, HAW. PUB. RADIO (Apr. 28, 2022, 11:14 AM), <https://www.hawaiipublicradio.org/local-news/2022-04-28/state-formally-apologizes-for-banning-hawaiian-language-in-schools-for-90-years>.

286. See Stephanie Hall, *How Hawaiians Saved Their Language*, LIBR. OF CONG.: FOLKLINE TODAY (May 24, 2017), <https://blogs.loc.gov/folklife/2017/05/how-hawaiians-saved-their-language/>.

287. Ben Gutierrez, *Lawmakers Adopt Resolution Apologizing for Ban on Hawaiian Language in Schools*, HAW. NEWS NOW, <https://hawaiinewsnow.com/2022/04/28/lawmakers-adopt-resolution-apologizing-ban-hawaiian-language-schools/> (Apr. 28, 2022, 4:16 AM) (quoting Rep. Patrick Branco, who introduced House Concurrent Resolution 130).

288. *History of Hawaiian Education*, HAW. STATE DEPT. OF EDUC., <https://web.archive.org/web/20250206022515/https://www.hawaiipublicschools.org/TeachingAndLearning/StudentLearning/HawaiianEducation/Pages/History-of-the-Hawaiian-Education-program.aspx>.

289. Hiraishi, *supra* note 285.

290. See MOSELEY, *supra* note 38.

confusion grounds, while Hawaiian remains critically endangered, appears below.

Table 4. Office Actions Issued Against Hawaiian Language Marks

Hawaiian Language Mark App. Serial Number App. Status	Prior English Language Mark Registration Number	Office Action Date
NALU SN: 90827834 (Registered)	WAVE RN: 3036449	April 13, 2022
HANA SN: 87195707 (Abandoned)	HANNA'S RN: 1946218	August 31, 2017
MOKU SURF SN: 86559451 (Registered)	ISLAND SURF RN: 3213804	June 18, 2015
'TIWI SN: 77704933 (Abandoned)	ハニー クリー パー HONEY CREEPER	June 25, 2009
PANIOLA SN: 78828590 (Abandoned)	HAWAIIAN COWBOY RN: 2363034	August 14, 2006
PANILO SN: 78816516 (Abandoned)	HAWAIIAN COWBOY RN: 2363034	August 14, 2006
OIWI (Stylized) SN: 76610121 (Abandoned)	NATIVES RN: 2261301	March 30, 2005

In each instance, the trademark examining attorney made no mention of the critically endangered status of the Hawaiian language.²⁹¹ In some instances, applicants made successful arguments, whereas in others, the applicant abandoned the application or otherwise chose not to respond.²⁹² It is unclear to what extent the costs of filing a response played a role in the decision to abandon. Nevertheless, it is against this backdrop of disregard for critically endangered languages that we focus our lens on words that may be used to serve as indicators of source, otherwise known as trade and service marks.

In 2015, the Board appeared to acknowledge for the first time that although the Hawaiian language was modern, it was obscure.²⁹³

IV. AVOIDING LOSSES IN TRANSLATION

If we could change ourselves, the tendencies in the world would also change. As a man changes his own nature, so does the attitude of the world change towards him We need not wait to see what others do.

—Mahatma Gandhi²⁹⁴

Whether, and to what extent, trademark linguicide exists must become a subject of debate because people with policymaking authority have yet to incorporate a mechanism for protecting languages that are not thriving. Waiting for the TTAB, the USPTO, or judges to determine that the Doctrine should be eliminated has proven pointless.²⁹⁵ For U.S. trademark applicants, and the attorneys that represent them, waiting has been unnecessarily expensive and time-consuming. Given the

291. *See, e.g.*, Response to Office Action dated Aug. 27, 2015, U.S. Trademark Application Serial No. 86559451 (filed Mar. 10, 2015), <https://tsdr.uspto.gov/documentviewer?caseId=sn86559451&docId=ROA20150827171204> (applicant arguing that “[A]lthough an official language of the State of Hawaii, as of 2001, only 0.1% of the statewide population of Hawaii . . . were native speakers of the language. This minuscule silver of native speakers would seemingly constitute compelling evidence that Hawaiian is an obscure language for trademark purposes”).

292. Compare MOKU SURF, Registration No. 4,891,796 (trademark application for “MOKU SURF” accepted after applicant successfully argued the critically endangered status of Hawaiian language), with Notice of Abandonment dated Feb. 5, 2010, U.S. Trademark Application Serial No. 77704933 (filed Apr. 2, 2009), <https://tsdr.uspto.gov/documentviewer?caseId=sn77704933&docId=NOA20100206071133> (trademark application for “TIWI” abandoned due to lack of response to the office action).

293. *In re Fahey*, No. 86250337, 2015 TTAB LEXIS 549, at *3–4 (T.T.A.B. 2015).

294. 12 MAHATMA GANDHI, THE COLLECTED WORKS OF MAHATMA GANDHI 158 (1964).

295. Anne Gilson LaLonde, *Far from Fluent: Making Sense of the Doctrine of Foreign Equivalents*, 112 TRADEMARK REP. 771, 804–09 (2022).

anticipated rate of language death, we really don't have time to simply think about it. We must do something before our options for preserving words at risk of extinction run out. We need not wait.

In this Section, I propose several options for rehabilitating the Doctrine of Foreign Equivalents. To be clear, I join the chorus in advocating for eliminating its application altogether. Given the reluctance of the courts and the Office to address the inconsistencies in application generally, expecting such a bold move is unrealistic. My proposal consists of three major parts: reframing key terms in a way that deters othering, expressly prohibiting application of the Doctrine in instances where the language at issue is not thriving at the time of the application, and balancing the interests of brand owners and consumers with a rebuttable presumption that applications featuring marks from languages other than English are made in good faith. As a preview, the Table below outlines the core components of the proposal, which uses the existing framework for likelihood of confusion analysis for Doctrine of Equivalents.

Table 5. Proposed U.S. Eligibility for Federal Trademark Registrations

		Likelihood of Confusion Test	Doctrine of Foreign Equivalents Test
Mark Contains	English Words Only	X	
	English and Other Language Words	X	
	No English Words (Language at Issue Not Thriving)	X	

296. *In re E. I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361–62 (C.C.P.A. 1973).

	No English Words (Thriving Language, Mark as Applied for is aurally, connotatively, and visually similar)	X	X
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A. Change the Doctrine's Language to Deter Othering

“Historically, language has often been used pejoratively in the process of Othering marginalized groups, including women, people with disabilities, and homosexual people.”²⁹⁷ The framework for the Doctrine advances the idea of “othering,” which has been explained as follows:

[O]thering refers to “a set of dynamics, processes, and structures that engender marginality and persistent inequality across any of the full range of human differences based on group identities.” In this manner, othering results in the construction of an identity in reference to others, and is a manner of “propagating group-based inequality and marginality.” Through this process, a virtuous self and a lesser other are created. Othering thus operates to define and secure one’s identity by stigmatizing and distancing those who are different. This results in the exclusion, devaluation, and dehumanization of others from the self’s locus of concern.²⁹⁸

The other “is a construct, much like its conjoined twin, the stereotype, used to fix in place those designated as ‘different.’”²⁹⁹

The Doctrine, as currently outlined, advances the concept of othering in trademark registration practice. As defined, the Doctrine applies when an applicant seeks to register a word from a “common or modern

297. Angela Lee, *Telling Tails: The Promises and Pitfalls of Language and Narratives in Animal Advocacy Efforts*, 23 ANIMAL L. REV. 241, 251–52 (2017).

298. Bethany A. Corbin, *Digital Micro-Aggressions and Discrimination: Femtech and the “Othering” of Women*, 44 NOVA L. REV. 337, 353–54 (2020) (emphasis removed).

299. Willajeanne F. McLean, *Who Are You Wearing? Avatars, Blackface and Commodification of the Other*, 61 IDEA 455, 473–74 (2021).

language” that the “ordinary American purchaser” is “likely to stop and translate.”³⁰⁰

The most problematic phrase in this author’s opinion is the “ordinary American purchaser” because it suggests a monolithic consumer population with a single identity.³⁰¹ Under what standards do we presume that a purchaser is an ordinary American? Ordinary to whom? What exactly would make a purchaser, the actual human being, extraordinary or an “other”? Is the purchaser extraordinary because he, she, or they speak more than one language? And if so, why should it matter? It should not matter. The Federal Circuit has already signaled that the ordinary American purchaser is “all American purchasers, including those proficient in a non-English language who would ordinarily be expected to translate words into English.”³⁰² Accordingly, the word “consumer” would suffice regardless of whether an individual is an American citizen, a visitor, or a person seeking permanent residence in the United States.

The word “consumer” avoids othering, and is still accurate, because whether a consumer translates or not is not necessarily a reflection of what language they speak or where they learned to speak it. The consideration of what language, when, and where, unnecessarily highlights differences when the presumed differences are rooted in stereotypes. There is no us or them when it pertains to the English language in the United States because membership in the “us” or “them” language group is not mutually exclusive. Someone can be an American citizen yet also consider a language other than English as their mother tongue. A non-citizen may consider, and indeed speak English as a first language, but also acquire a second language as a result of travel or job requirements. Citizens and non-citizens may be multilingual. Any indication that one speaks more than one language, or not, should not be a basis for othering.

Similarly, the reliance on the “common” or “modern” standard fails to acknowledge that what we consider, at any given time, modern may not necessarily be simultaneously common. English is arguably both common and modern. Yet the Hawaiian language is a perfect example of a language that is obviously spoken in modern times but is not

300. *In re Thomas*, No. 78334625, 2006 WL 1258862, at *3 (T.T.A.B. 2006). (“French is a common foreign language spoken by an appreciable segment of the population. Indeed, applicant’s own evidence shows that of the foreign languages with the greatest number of speakers in the United States, French is ranked second only to Spanish.”).

301. *Id.*

302. *In re Spirits Int’l, N.V.*, 563 F.3d 1347, 1352 (Fed. Cir. 2009).

necessarily common throughout the entirety of the United States.³⁰³ Moreover, there does not appear to be a set standard or source within current registration practice for assessing which languages may be neither modern nor common, despite the fact that there are multiple agencies and organizations around the world—like UNESCO—actively identifying areas of language loss and otherwise raising awareness of the issue.³⁰⁴

The Doctrine bolsters othering in general by perpetuating a narrative that bilingual and multilingual speakers must be protected in a society where words such as “immigrants” or “immigration” have been used to signal otherism or the idea of being less than.³⁰⁵ The emphasis on vulnerability and cultural differences can impede full acceptance of bilingual and multilingual speakers as members of the broader community. The imagery associated with the term “immigrant” contributes to the sentiment that immigrants drain resources and do not contribute or participate.³⁰⁶

When the term “immigrant” is compared to “citizen,” however, it becomes clear that the term immigrant can also elicit images of vulnerable outsiders. The term “immigrant” paints a picture of someone who is ethnically and culturally different, economically disadvantaged, inexperienced, and even “illegal.” This image appears explicitly and as a metaphor throughout modern discussions of immigration.³⁰⁷

Conversations about language and culture often devolve into conversations about immigration when different language communities enter the United States:

Immigrants, goes the argument, cannot claim a right to preserve their culture or language because they chose to leave their old

303. See *Hawaiian*, *supra* note 37.

304. See UNESCO, *supra* note 31, at 3.

305. The idea that multilingual consumers are incapable of distinguishing between brands in the 21st century seems a bit paternalistic. Similarly, the “common, modern language” and “average American consumer” components of the Doctrine are not only meaningless but are arguably inflammatory. Common and modern based on whose perspective? Who is the average American consumer in a country of 300 million people?

306. D. Carolina Núñez, *War of the Words: Aliens, Immigrants, Citizens, and the Language of Exclusion*, 2013 BYU L. REV. 1517, 1559–60; see also Leticia M. Saucedo, *Mexicans, Immigrants, Cultural Narratives, and National Origin*, 44 ARIZ. STATE L.J. 305, 339 (2012) (“Today’s public debate around immigration centers on the extent to which immigrants are taking American jobs, or are taking jobs Americans do not want.”). Ediberto Roman catalogues immigration-related rhetoric based on the idea that immigrants are a drain on resources and discusses several studies undermining these assumptions. See generally Ediberto Roman, *The Alien Invasion?*, 45 HOUS. L. REV. 841 (2008).

307. Núñez, *supra* note 306, at 1556.

culture. They knew before arriving at the new country that the public institutions of a particular society operate in a certain language, and by uprooting themselves and moving to a new state in spite of that knowledge, they either waived their right to language or expressed a choice to change their language. In addition, immigration is viewed as an individual rather than a collective process; therefore, immigrants are not perceived as a group in the communal sense in the political context. In the political arena, they are viewed, if anything, as a collection of people that happen to share similar characteristics. At most, it is recognized that due to these characteristics, the individual members of the group may have some similar interests.³⁰⁸

This analysis focuses on the extent to which a speaker's original language perpetuates othering by unnecessarily invoking cultural differences. "From a linguistic standpoint, culture and language are inseparable."³⁰⁹ Reliance on the word "American" as part of the Doctrine's framework, designed to protect consumers from unscrupulous merchants, is at odds with the concept of commercially fair competition.

B. Limit the Doctrine's Applicability to "Thriving" Languages

The Doctrine should not apply unless a language is considered thriving. A case involving a mark that is derived from a language other than English illustrates this point. On June 25, 2012, Uruguay-based corporation Zupely, S.A. filed an application to register the mark "TAntA" in stylized form for use in connection with "restaurant services" in Class 43.³¹⁰ Counsel for applicant indicated that the mark "means or signifies or is a term of art for bread made of maize in the relevant trade or industry or as applied to the goods/services listed in the application."³¹¹ The trademark examining attorney issued an office action, citing various grounds for refusal, including a prior pending application to register the word "bread" in connection with the same or similar services in Class

308. Brandes, *supra* note 281, at 21.

309. Paul Conor Hale, *Official, National, Common or Unifying: Do Words Giving Legal Status to Language Diminish Linguistic Human Rights?*, 36 GA. J. INT'L & COMP. L. 221, 226 (2007).

310. U.S. Trademark Application Serial No. 85660054 (filed June 25, 2012).

311. *Id.* This author suspects that counsel sought to avoid the inevitable application of the Doctrine of Foreign Equivalents by omitting the translation. However, the author would caution against any statements that suggest that the mark itself is relevant to the goods or services in the application to avoid immediately providing the trademark examining attorney with grounds for a merely descriptive refusal.

43.³¹² In counsel's response, the applicant added that “[t]he English translation of the Aymara word 'TANTA' in the mark is BREAD" and argued that the Doctrine of Foreign Equivalents should not apply:

As set forth in Wikipedia, Aymara is a language spoken by about 2.2 million speakers, about 2.05 million of whom are in the high Andes of Bolivia and Peru. The language is regularly only taught At [sic] the University of Chicago Center for Latin American Studies in alternate years with summer courses at the Graham School of Continuing Studies. On occasion, it has also been taught with Quechan at the University of Illinois in partnership with the University of Chicago at the Urbana-Champaign campus In view of the limited number of speakers of Aymara, and because the marks identify services and not products, it is submitted that the use of the doctrine of foreign equivalents is not appropriate.³¹³

The trademark examining attorney accepted counsel's arguments and approved the application for publication.³¹⁴ Yet approval of an application does not remove the underlying problems: lack of clarity and the equivalent but unequal outcomes for marks derived from languages other than English. Most importantly, there are no automatic protections for languages subject to extinction at the beginning of the application or examination process.³¹⁵ The current "common or modern language" inquiry does not require either party—the applicant or the trademark examining attorney—to determine whether the mark is derived from a language that is endangered or subject to extinction.³¹⁶ Second, if the language at issue is endangered, the burden and expense of establishing the fact rests with the applicant. Lastly, neither the TMEP nor the TEAS forms themselves allow the applicant, or the trademark examining attorney, to make the language of origin a key issue at the outset of the examination process.

312. Non-Final Office Action dated Oct. 22, 2012, U.S. Trademark Application Serial No. 85660054 (filed June 25, 2012), <https://tsdr.uspto.gov/documentviewer?caseId=sn85660054&docId=OOA20121022>.

313. Response to Office Action dated Jan. 9, 2013, U.S. Trademark Application Serial No. 85660054 (filed June 25, 2012), <https://tsdr.uspto.gov/documentviewer?caseId=sn85660054&docId=ROA20130109184844>.

314. Notice of Publication dated Feb. 13, 2013, U.S. Trademark Application Serial No. 85660054 (filed June 25, 2012), <https://tsdr.uspto.gov/documentviewer?caseId=sn85660054&docId=NOP20130213064020>.

315. *See In re Thomas*, No. 78334625, 2006 WL 1258862, at *3 (T.T.A.B. 2006).

316. *Id.*

Arriving at this conclusion earlier in the process would save both applicants and the USPTO precious time and money, but would also remove barriers for the remaining speakers of an endangered or vulnerable language, a way to preserve a word or phrase in a meaningful way. Similarly, early detection could mitigate the possibility that the USPTO's decisions reach the level of trademark linguicide.

There are several ways that the issue of linguistic preservation can be addressed earlier in the process. First, the USPTO must, to the extent that it does not do so already, encourage examining attorneys to consult translation sources that do not provide meanings of words or phrases in context. Second, the Office may wish to consider coordinating with the United Nations in its efforts to monitor and preserve endangered and vulnerable languages.³¹⁷ If a coordinated effort is inconsistent with policy, a simple, practical solution would be to include a section in the TMEP that explicitly brings attention to the issue of language death. The Office may also consider more public-facing efforts to minimize the likelihood of inaccurate application of the Doctrine. For example, any application, regardless of filing basis, should also contain a mandatory language of origin field. So if a translation or transliteration is offered, the applicant must disclose the language of origin before the applicant can submit the application.³¹⁸ Lastly, until the Office prioritizes this initial determination, trademark applicants and attorneys should be encouraged to add an additional statement,³¹⁹ indicating the language of origin and the extent of endangerment, along with the translation statement. The current application platform offers an additional statement option appropriate for this purpose: “I need to provide additional information about my trademark, such as use of the mark in another form, or some other miscellaneous statement.” Not only does the

317. See Kontos, *supra* note 279.

318. The USPTO's TEAS platform currently requires that an applicant indicate whether the mark contains any words in a language other than English. A “yes” or “no” response is required. If the applicant responds in the affirmative, two relevant questions are added to the application form: (1) “What is the non-English word or phrase?” and (2) “What is the language of the word or phrase you entered?” Although the disclosure of the word or phrase is required, the language of origin field remains optional.

319. Once an applicant completes the “trademark details” and “goods and services” sections of the application platform, the last section before the “review and sign” relates to “additional statements.” As the name suggests, it is often used to add notes to the trademark examining attorney that the form does not otherwise provide an option for. *See* TMEP § 807.07(a)(ii) (Nov. 2024) (“Example – The application includes a statement in the ‘Miscellaneous’ field that refers to the mark as a blue, red, and yellow ball and includes an accurate and properly worded color claim listing all colors in the mark, but omits the color yellow from the description of the mark. The examining attorney may enter an amendment of the description to accurately reflect all colors in the mark.”).

current platform provide ample space to provide additional information, but the selection also generates an option to upload up to five supporting files. These minor adjustments in the trademark application process would minimize the potential for trademark linguicide early in the application process and at no additional cost to applicants. Applicants should not have to bear the financial burden of responding with legal arguments about the application of the Doctrine when (1) information regarding endangered languages is readily available and (2) the Office also maintains a Trademark Library or Translations Branch in-house.

C. Rehabilitate with Guardrail for Language Protection and Preservation

Because trademark applications examined under the current Doctrine of Foreign Equivalents framework potentially threatens the preservation of languages at risk of extinction, there is a need for mechanisms that prevent reflexive application.³²⁰ One approach would be to establish a narrow rebuttable presumption that would favor applicants when marks are visually and aurally different, but connotatively similar.

The threshold question of the common or modern language inquiry could be replaced with an inquiry into whether the language of origin is thriving.³²¹ The concept of the ordinary American purchaser should also be retained, given that the phrase has been defined over time, but a reference to a “consumer” would suffice and avoid unnecessary othering.³²² The major contribution to the rehabilitative proposal is the abandonment of the “stop and translate” inquiry altogether.³²³

At least for likelihood of confusion analysis, the “stop and translate” inquiry should be recharacterized as a rebuttable presumption in favor of applicants because literal meanings may be less consequential when making the products/services to mark association. There is some support for this theory. “Neuroscience findings are consistent with and expand upon previous behavioral studies in that they demonstrate that non-

320. *See supra* Part III.

321. *See* discussion *supra* Section II.B.2 (as noted above, this would necessitate explicit guidance in the Trademark Manual of Examining Procedure).

322. *See In re Spirits Int'l N.V.*, 563 F.3d 1347, 1352 (Fed. Cir. 2009) (similar to the rule versus guidance suggestion for whether a language is subject to extinction, the Federal Circuit's clarification regarding what constitutes an ordinary American purchaser should, at minimum, be among the case guidance listed in the Trademark Manual of Examining procedure). An explanatory note should address the incongruency between the TTAB's analysis in *Thomas* (which is still followed) and the Federal Circuit Court of Appeals decision in *Palm Bay* (which the TTAB also follows in some instances).

323. *See supra* text accompanying note 12.

literal language is processed differently from literal language in the brain.”³²⁴

Consumers recognize trademarks or brands as indicia of source, which are arguably a form of non-literal language.³²⁵ For example, when consumers view the mark Apple® (or the arguably famous Apple logo®) on a phone or computer, it is unlikely that the consumer would expect the brand owner to also offer round, edible fruits that grow on trees. The same is true for a mark that is not arguably famous, like e.l.f.®, which is used in connection with cosmetics like eyeshadow and lip gloss. Even if a consumer believes in elves, the likelihood that the consumer would expect the brand owner to offer elves is low. The fact that consumers are unlikely to interpret a mark as having a singular, literal meaning is important because even if a prospective consumer translates a mark, the literal meaning of the mark is less consequential. For these reasons, we must consider better ways to assess likelihood of confusion when marks lack English words.

Trademarks are more akin to metaphors or idioms in that processing them requires an extra layer of thought. Rather than considering whether a consumer is likely to stop and translate the words in a mark, the question becomes whether an English equivalent is visually or aurally similar in its original language of origin.³²⁶ Framing the question in this manner creates a rebuttable presumption that foreign marks that are only connotatively similar are not likely to be confused with their English language equivalents.³²⁷

This approach does not entirely eliminate the need for translation. If an English language equivalent is visually or aurally similar, then the burden should shift to the applicant to demonstrate why confusion is unlikely even when translated.³²⁸

Using previous examples, ABBALLE’ (Sicilian equivalent of dance) and NOAT (Western Frisian for notes),³²⁹ one can envision how the rehabilitated framework would work in practice. Taking the facts as they are currently known, the Doctrine of Foreign Equivalents would not apply at the outset because both marks are derived from potentially vulnerable languages.

As an example, if we imagine that both Sicilian and Western Frisian are thriving languages, then clarity in the framework and equal

324. Virtue & Cahr, *supra* note 126, at 702.

325. *See id.* at 701.

326. *See* discussion *supra* Section III.B.

327. *See* discussion *supra* Section III.B.

328. *See* discussion *supra* Section II.B.3.

329. *See supra* Table 2.

application of the doctrine is conceivable. “Abballé” and “dance” are arguably connotative equivalents. However, they are neither visually nor aurally similar. Under the rehabilitated framework, the mark should not be translated to English, i.e., “dance,” for the purposes of comparing the similarities between it and a prior mark that may, in fact, be DANCE. Notably, the applicant’s burden would be no greater than if the same applicant had sought to register PEAK for use in connection with products or services already offered, and registered, under the mark SUMMIT.³³⁰

Conversely, “noat” and “notes” are not only connotatively similar, but visually and aurally similar. Under the rehabilitated framework, the mark NOAT should not be translated to English, i.e., “note,” for the purposes of comparing the similarities between it and a prior mark that may, in fact, be NOTES. In this instance, the burden would properly be on the applicant to overcome the examiner’s conclusion that the marks are similar in sight, sound, and connotation.³³¹ The similarities in these marks make confusion analysis no more tedious than the analysis of visually and aurally similar English language marks.

The rehabilitated framework could actually work. It would provide greater latitude for members of endangered or otherwise vulnerable languages to preserve words from their own languages as source indicators while responsibly minimizing the likelihood of confusion for consumers, including consumers who may be members of the relevant language community.

V. CONCLUSION

If my cup won’t hold but a pint and yours holds a quart, wouldn’t ye be mean not to let me have my little half-measure full?

—Sojourner Truth³³²

Even if well-intended, applying the Doctrine of Foreign Equivalents during the likelihood of confusion analysis, at worst, threatens trademark linguicide. At best, it unnecessarily obstructs a potential pathway to preserving language and culture in the United States and around the world. For these reasons, the Doctrine should be limited in the likelihood of confusion assessment in a manner that creates a

330. See discussion *supra* Section II.B.3.

331. See discussion *supra* Section II.B.3.

332. Frances D. Gage, *Sojourner Truth*, NAT’L ANTI-SLAVERY STANDARD, May 2, 1863, at 4.

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rebuttable presumption in favor of applicants seeking to give life, or *uhai*,³³³ to words that may otherwise be on the brink of language death.

333. *See supra* text accompanying notes 2–32.