

# TEXAS INTELLECTUAL PROPERTY LAW JOURNAL

INTELLECTUAL PROPERTY LAW SECTION OF THE STATE BAR OF TEXAS  
THE UNIVERSITY OF TEXAS SCHOOL OF LAW

THE FOREIGN EQUIVALENTS DOCTRINE . . . IN ENGLISH?  
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VOL. 28, No. 1, PAGES 129 TO 156, 2019

# The Foreign Equivalents Doctrine . . . In English?

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## I. Introduction

“Foster’s, Australian for beer.” This slogan has been part of the “How to speak Australian” advertising campaign for the Miller Brewing owned brand for a number of years.<sup>2</sup> Assume for a minute that Australian actually is a completely different language than English, and that, in that language, “Foster’s” is a term for a category of beer. Under the foreign equivalents doctrine in trademark law, a company would not be able to register “Foster’s” for a brand of beer in the United States.<sup>3</sup>

Courts cancel trademarks like these for three main reasons. First, that trademark may confuse someone from another country that only one supplier sells the product the foreigner is used to.<sup>4</sup> Second, that trademark would prevent competition by allowing an early importer or manufacturer to have a monopoly on the generic term that accurately describes the product.<sup>5</sup> Additionally, out of the concern for international comity, we do not want other countries allowing their citizens to trademark generic terms from our country so we should not allow the generic foreign terms to be trademarked in the United States.<sup>6</sup>

On first glance, the above scenario seems completely fanciful. Australia is an English-speaking country, just like the United States, England, and Ireland.<sup>7</sup> And one might think that different categories of beers would be consistent between the different English-speaking countries. However, this fact pattern actually happened and the case was litigated through an appeal in the Eight Circuit.<sup>8</sup> In *Anheuser-Busch Inc. v. Stroh Brewery Co.*, Anheuser-Busch successfully defended its trademark for LA Beer.<sup>9</sup> The defendant unsuccessfully argued the term LA beer was a generic term used in bars across Australia simply to mean any low alcohol beer, just like Americans in bars ask for a light beer.<sup>10</sup> In contrast, the Ninth Circuit cancelled a trademark for a specific type of sake, in *Otokoyama Co. Ltd. v. Wine of Japan Import, Inc.*<sup>11</sup> In both cases, a term from another country was being used to designate a subcategory of alcoholic beverages. The only significant difference between these two cases was the national language where each disputed term came from.

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<sup>2</sup> Tom Cowie, *New York man sues Foster’s for not being brewed in Australia*, THE SYDNEY MORNING HERALD (Dec. 16, 2015, 10:04 AM), <https://www.smh.com.au/business/new-york-man-sues-fosters-for-not-being-brewed-in-australia-20151216-glohm4.html>.

<sup>3</sup> *Otokoyama Co. v. Wine of Japan Import, Inc.*, 175 F.3d 266, 272 (2d Cir. 1999) (“Defendant should have been allowed to introduce evidence of otokoyama’s meaning and usage in Japan to support its claim that the mark is generic and therefore ineligible for protection as a trademark.”).

<sup>4</sup> *Id.* at 270-71.

<sup>5</sup> *Id.* at 270.

<sup>6</sup> *Enrique Bernat F., S.A. v. Guadalajara, Inc.*, 210 F.3d 439, 443 (5th Cir. 2000).

<sup>7</sup> PETER TRUDGILL & JEAN HANNAH, *INTERNATIONAL ENGLISH: A GUIDE TO THE VARIETIES OF STANDARD ENGLISH* 4 (5th ed. 2008).

<sup>8</sup> *Anheuser-Busch Inc. v. Stroh Brewery Co.*, 750 F.2d 631, 642-43 (8th Cir. 1984).

<sup>9</sup> *Id.*

<sup>10</sup> *Id.* at 642.

<sup>11</sup> *Otokoyama Co. v. Wine of Japan Import, Inc.*, 175 F.3d 266, 272 (2d Cir. 1999).

This Note will examine whether the foreign equivalents doctrine should exclude generic terms that come from English-speaking countries. In Section I, this Note provides a basic overview of the purpose of trademark law and the major concepts that relate to the foreign equivalents doctrine. Section II examines the cases that created and helped expand the understanding of the foreign equivalents doctrine. Section III will look at how English spread as a language, the countries that use English, and the differences in the usage. Finally, in Section IV, this Note will examine the cases that have improperly narrowed the doctrine and excluded English-speaking countries.

## II. The Basics of Trademark Law

“Trademark law protects the public from confusion and deception and makes it easier for consumers to choose the products and services they want.”<sup>12</sup> The Lanham Act says the “term ‘trademark’ includes any word, name, symbol, or device, or any combination thereof . . . used by a person . . . to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods . . . .”<sup>13</sup> As such, a trademark can be nearly anything, including words, shapes, colors, sounds, or even smells, that allow a consumer to identify where a product came from.<sup>14</sup> Trademarks allow a consumer to quickly recognize a brand, distinguish one brand from another, and make purchasing decisions based on that recognition.<sup>15</sup> Relatedly, companies value their trademarks because of the previous effort put into establishing consumer trust as well as the direct costs of advertisement in spreading that trademark.<sup>16</sup>

### A. Genericness and the Classes of Trademarks

One of the core principles of trademark law is that generic terms cannot get trademark protection.<sup>17</sup> Relatedly, even if a term once had protection, the term loses its trademark protection once the term becomes generic to the public.<sup>18</sup> *Aspirin*, *Cellophane*, and *Escalator* are examples of terms that once had protection, until the public stopped identifying the terms as a source of the good and began identifying the terms as the name for the good itself.<sup>19</sup>

The Supreme Court explained this concept in *Kellogg Co. v. National Biscuit Co.*<sup>20</sup> In *Kellogg*, Nabisco and its predecessor had been selling its shredded wheat

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<sup>12</sup> ANNE GILSON LALONDE, GILSON ON TRADEMARKS § 1.03 (Matthew Bender).

<sup>13</sup> 15 U.S.C. § 1127 (2019).

<sup>14</sup> LALONDE, *supra* note 12, § 1.02, § 1.03.

<sup>15</sup> *Id.* at § 1.03.

<sup>16</sup> *Id.*

<sup>17</sup> *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 116 (1938). National Biscuit Co. subsequently became Nabisco. For simplicity, the name Nabisco will be used in this Note.

<sup>18</sup> *Id.*

<sup>19</sup> *Elliott v. Google, Inc.*, 860 F.3d 1151, 1156 (9th Cir. 2017).

<sup>20</sup> 305 U.S. at 116.

biscuits since 1893.<sup>21</sup> Nabisco patented its manufacturing process and was the sole manufacturer of the product for decades.<sup>22</sup> Nabisco sold its product under the name “Shredded Whole Wheat.”<sup>23</sup> Kellogg attempted to sell its own version of the product using the manufacturing process described in the expired patent and use the term “Shredded Wheat” on its packaging.<sup>24</sup>

The Court refused to provide Nabisco protection for the term “Shredded Wheat.”<sup>25</sup> The Supreme Court said,

[f]or that is the *generic term of the article, which describes it with a fair degree of accuracy*; and is the term by which the biscuit in pillow-shaped form is generally known by the public. Since the term is generic, the original maker of the product acquired no exclusive right to use it.<sup>26</sup>

The decision acknowledged Nabisco and its predecessors had spent over \$17,000,000 in advertising.<sup>27</sup> The Court further acknowledged Kellogg was sharing in the goodwill Nabisco had created “by vast expenditures in advertising persistently made.”<sup>28</sup> However, the Supreme Court went on to say, “that is not unfair. Sharing in the goodwill of an article unprotected by patent or trade-mark is the exercise of a right possessed by all—and in the free exercise of which the consuming public is deeply interested.”<sup>29</sup>

## B. Priority and Territoriality

In addition to the inability to protect generic marks, priority and territoriality are foundational principles in trademark law.<sup>30</sup> The Ninth Circuit described priority as the “first in time equals first in right.”<sup>31</sup> That court meant the first party to use a trademark has the right to use that mark and the right to exclude others from using that mark.<sup>32</sup> However, priority is balanced by the concept of territoriality which limits

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<sup>21</sup> *Id.* at 113.

<sup>22</sup> *See id.* at 113–114 (discussing how the “Shredded Wheat” term arose and became the subject of a dispute between Nabisco and Kellogg).

<sup>23</sup> *Id.* at 117.

<sup>24</sup> *Id.* at 114.

<sup>25</sup> *Id.* at 116.

<sup>26</sup> *Id.* (emphasis added).

<sup>27</sup> *Id.* at 119. Based on the U.S government’s inflation calculator, *Databases, Tables & Calculators by Subject*, UNITED STATES DEPARTMENT OF LABOR: BUREAU OF LABOR STATISTICS, [https://www.bls.gov/data/inflation\\_calculator.htm](https://www.bls.gov/data/inflation_calculator.htm) (last visited October 5, 2019), the \$17,000,000 in November 1938 would be worth \$306,942,285 in February 2019.

<sup>28</sup> *Kellogg Co.*, 305 U.S. at 122.

<sup>29</sup> *Id.* Although *Kellogg* is a pre-Lanham Act case, the Supreme Court reiterated that marks cannot receive or maintain trademark protection if the term is generic. *See Park ‘n Fly v. Dollar Park & Fly*, 469 U.S. 189, 194 (1985) (“Generic terms are not registrable, and a registered mark may be canceled at any time on the grounds that it has become generic.”).

<sup>30</sup> *Grupo Gigante S.A. de C.V. v. Dallo & Co.*, 391 F.3d 1088, 1093 (9th Cir. 2004).

<sup>31</sup> *Id.*

<sup>32</sup> *See id.* (“A fundamental principle of trademark law is first in time equals first in right.”).

the ability to claim priority to the regions where the mark was actually used.<sup>33</sup>

The Lanham Act minimized the overall importance of territoriality for trademark law because publication at the United States Patent and Trademark Office (USPTO) creates a nationwide notice of that trademark.<sup>34</sup> However, territoriality continues to be important to trademark law because it applies to marks from other countries.<sup>35</sup>

In *Person's Co. v. Christman*, the Federal Circuit applied these two principles in a dispute over the mark “Person’s.”<sup>36</sup> A Japanese company used the name for a line of apparel it exclusively sold in Japan.<sup>37</sup> An American, who worked for a sportswear wholesaler, saw the Japanese product line and brought samples back with him when he returned home.<sup>38</sup> Once home, the American had his lawyers verify “Person’s” was available to be registered, and then he began using “Person’s” for his own clothing line based on the products he had bought in Japan.<sup>39</sup> He applied for and obtained a trademark from the Trademark Office after sales began. The Japanese company gained success in its own country, then began looking to expand to the United States. The Japanese company began selling in the United States and applied for an American trademark after the American company’s sales began but before the American trademark issued. However, the USPTO also issued a trademark to the Japanese company.<sup>40</sup>

The two companies sold their clothing lines in the United States for a number of years, but the American company eventually petitioned the USPTO to cancel the Japanese company’s trademark.<sup>41</sup> The Board found in favor of the American company, finding the American company was the first to use the mark for sales in the United States, and, even if the American company deliberately copied the foreign mark, the Board found the American company’s actions to be in “good faith.”<sup>42</sup>

On review, the Federal Circuit affirmed the Board’s decision.<sup>43</sup> The Federal Circuit explained that a party must show the mark was “used in commerce” to be eligible for protection under the Lanham Act.<sup>44</sup> Citing the Act and the Commerce Clause of the Constitution, the court said this means “sale or transportation of goods bearing the mark in or having an effect on: (1) United States interstate commerce; (2) United States commerce with foreign nations; or (3) United States commerce with

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<sup>33</sup> *Id.*

<sup>34</sup> 15 U.S.C. § 1057(c) (2010).

<sup>35</sup> *See Grupo*, 391 F.3d at 1093.

<sup>36</sup> 900 F.2d 1565, 1569 (Fed. Cir. 1990).

<sup>37</sup> *Id.* at 1566–67.

<sup>38</sup> *Id.* at 1567.

<sup>39</sup> *Id.* The American company also directly copied some of the clothing items, but the case does not mention any copyright infringement claims.

<sup>40</sup> *Id.*

<sup>41</sup> *Id.*

<sup>42</sup> *Id.* at 1567–68.

<sup>43</sup> *Id.* at 1572.

<sup>44</sup> *Id.* at 1568.

the Indian Tribes.”<sup>45</sup> The Federal Circuit agreed with the Board’s finding that the American Company had established sales in the U.S. before the Japanese company had; therefore, the American company had priority.<sup>46</sup> Citing the territoriality principle, the appeals court agreed the sales in Japan did not impact priority because those sales did not impact U.S. commerce.<sup>47</sup>

The Federal Circuit also rejected the argument that the American company had acted in bad faith by copying the mark and using it as its own in violation of the requirements for registration under the Lanham Act.<sup>48</sup> The court recognized a previous Board decision where a junior user attempted to register a mark nationally despite knowing and copying the senior user’s mark.<sup>49</sup> That Board denied the junior user’s registration because the Board found the junior user had copied the mark in bad faith.<sup>50</sup> However, the Federal Circuit contrasted that earlier Board decision with the facts of the instant case. Specifically, the Federal Circuit found that the Japanese company “had no goodwill in the United States” and the Japanese use of the mark “had no reputation here.”<sup>51</sup> The Japanese company was not the senior user in the U.S.; as such, the American company could not have acted in bad faith by copying the mark.<sup>52</sup>

### III. Development of the Foreign Equivalents Doctrine

The general idea behind the foreign equivalents doctrine is fairly simple. A common term from another country used to describe an item from that same country should not be given trademark protection in this country.<sup>53</sup> The general concept of the rule goes back to at least 1900.<sup>54</sup> Despite its continued application, the doctrine has not been codified into the Lanham Act.

This Section will explore the development of the foreign equivalents doctrine, review the historical context behind the issues the cases, and explain how this doctrine fits in with the other trademark rules discussed in Section I above.

#### A. Cheese and Wine

In 1900, the First Circuit described the basic principle of the foreign equivalents doctrine in the case *Dadirrian v. Yacubian*.<sup>55</sup> The trademark owner had been using the word “Matzoon” since 1885, and had registered the mark with the Federal

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<sup>45</sup> *Id.*

<sup>46</sup> *Id.* at 1569.

<sup>47</sup> *Id.* at 1568–69.

<sup>48</sup> *Id.* at 1569–70.

<sup>49</sup> *Id.* at 1569.

<sup>50</sup> *Id.*

<sup>51</sup> *Id.* at 1569–70.

<sup>52</sup> *Id.* at 1570.

<sup>53</sup> *See Dadirrian v. Yacubian*, 98 F. 872, 879 (1st Cir. 1900).

<sup>54</sup> *See id.*

<sup>55</sup> *Id.*

Government under one of the earlier trademark statutes.<sup>56</sup> The individual sold the product as a medical supplement to the invalid and other sick individuals.<sup>57</sup> The registration included the name, but also included the phrase “or Fermented Milk Food” along with the drawing of a mountain, an ark, and a dove used on the product’s label.<sup>58</sup> The court acknowledged that both the public at large and members of the medical profession directly associated the name with the product, and that those same individuals believed only one supplier produced that product under that name.<sup>59</sup> Therefore, the trademark holder in this case had a “very strong prima facie case for the complaint.”<sup>60</sup>

The First Circuit recognized that “Matzoon” was “not an arbitrarily selected word symbol,” but instead the “proper Armenian descriptive word” for “a historically and locally well-known Armenian healthful beverage, containing certain medicinal qualities.”<sup>61</sup> The trademark holder attempted to distinguish the Armenian term from the term used for his product.<sup>62</sup> First, he argued the proper translation was “Madzoon” and not his “Matzoon.”<sup>63</sup> The court rejected that argument because the two words, despite a slight spelling or pronunciation variation, were still essentially the same. As such, it refused to give the trademark holder a monopoly on the term or slight variation on the term.<sup>64</sup>

The trademark holder also argued his product was a liquid and that “Matzoon” referred to the “a preparation of milk curdled . . . having the consistency of custard.” Further, trademark holder presented expert testimony that the Armenian preparation used the term “Taan” for the associated liquid created by diluting the solids in water.<sup>65</sup> The First Circuit acknowledged the experts’ testimony, but found sufficient evidence showing “Madzoon” and “Taan” still described “the same thing” with “no chemical nor molecular differences between [the terms].”<sup>66</sup>

Finally, the First Circuit found the alleged infringer had not actually infringed on the trademark holder’s product because the trademark holder did not have a monopoly on the term “Matzoon.”<sup>67</sup> The court further found the alleged infringing labeling lacked the mountain shown in the original product, and that second label sufficiently differentiated itself from the trademark holder. As such, the trademark holder lacked a claim.<sup>68</sup>

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<sup>56</sup> *Id.* at 873.

<sup>57</sup> *Id.* at 874.

<sup>58</sup> *Id.*

<sup>59</sup> *Id.* at 873.

<sup>60</sup> *Id.* at 873.

<sup>61</sup> *Id.* at 874.

<sup>62</sup> *See id.* (“It is insisted, however, in reply, that ‘Matzoon’ is a word symbol . . .”).

<sup>63</sup> *Id.*

<sup>64</sup> *Id.* at 875.

<sup>65</sup> *Id.*

<sup>66</sup> *Id.* at 876.

<sup>67</sup> *Id.* at 875.

<sup>68</sup> *Id.* at 880.



In *Holland v. C. & A. Import Corp.*, two companies fought over the right to import their wines from Italy.<sup>69</sup> C. & A. Import Corp. had been importing its wine under the label “Est Est Est” since 1908 and had obtained a trademark from the Patent office in 1910. The importer claimed it sold around 1,000,000 bottles of the wine prior to prohibition.<sup>70</sup> Holland also produced affidavits showing American customers did not associate “Est Est Est” with any particular type of wine or location the wine came from.<sup>71</sup> However, the importer sold its wine with a booklet telling the story of a Medieval German bishop asking if the wine was good. His servant responding “Est Est Est,” which translated from Latin means “It is, It is, It is.” The booklet further claimed, “[t]o perpetuate the name of this wine our company adopted it for its firm name. Italian law forbids the use of the Latin word ‘Est’ so we have patented, the world over, the words ‘It is It is It is.’”<sup>72</sup>

Holland, the newer importer, attempted to import its own wines under the label “It is It is It is,” but C. & A. had customs impound those wines because of a trademark infringement claim.<sup>73</sup> The district court acknowledged the historical story of the German Bishop. The court also cited “A History and Description of Modern Wines, by Cyrus Redding, published in London in 1836,” other books about wine, and even recent pamphlets issued by the Italian government. All of those references mention “Est Est Est” referred to wines coming from areas around Montefiascone, Italy.<sup>74</sup>

The district court ultimately found that neither party had an exclusive right to either “Est Est Est” or “It is It is It is.” The court said,

By the weight of authority, a word commonly used in other countries to identify a kind of product and there in the public domain as a descriptive or generic name may not be appropriated here as a trademark on that product, even though the person claiming the word was the one who introduced the product here and the word then had no significance to our people generally. The rule is a just one. Why should the first comer be given a monopoly of the word when he knew all along that he had no better right to it than any one else? *If others who may bring the same product here later cannot sell it under its real name, fair competition would be greatly impeded.*<sup>75</sup>

C. & A. cited a case where a domestic perfume manufacturer copied the word

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<sup>69</sup> *Holland v. C. & A. Imp. Corp.*, 8 F. Supp. 259, 260 (S.D.N.Y. 1934).

<sup>70</sup> *Id.* Prohibition occurred between 1920 and 1933. See U.S. CONST. amend. XVIII (1920), *repealed* by U.S. CONST. amend. XXI (1933).

<sup>71</sup> *Holland*, 8 F. Supp. at 260.

<sup>72</sup> *Id.* at 261.

<sup>73</sup> *Id.* at 260.

<sup>74</sup> *Id.*

<sup>75</sup> *Id.* at 261 (emphasis added) (citing *Dadirrian*, 98 F. at 872; *Burke v. Cassin*, 45 Cal. 467, 479 (Cal. 1873)) (holding “schnapps” could not be a trademarked because the term was commonly used in the Netherlands as a type of gin).

“L’Origan” for a type of perfume.<sup>76</sup> Similar to *Person’s* in Section I above, the district court distinguished “L’Origan” as a foreign brand name, which American companies were allowed to copy and trademark, unlike a foreign generic class of goods as at issue before the court, which could not be a protected trademark.<sup>77</sup>

### B. Children’s Toys

In *Donald F. Duncan, Inc. v. Royal Tops Mfg. Co.*, the parties fought over a series of trademarks relating to the term “Yo-Yo.”<sup>78</sup> The plaintiff, Duncan, owned the trademark for Yo-Yo, and had licensed the defendant to use the term as well. However, the license agreement fell through, and the lawsuit followed.<sup>79</sup> As part of its defense, the defendant argued the term Yo-Yo was a generic Filipino term when the trademark issued, and had become generic in the United States since that time.<sup>80</sup>

Although not fully described within the case, Pedro Flores, an immigrant from the Philippines, initially popularized the Yo-Yo as we know it today.<sup>81</sup> He was the first one to not have the string fully attached to the toy; instead, his version only looped around the shaft of the solid object.<sup>82</sup> This improvement allowed the Yo-Yo to “sleep” and allowed for the tricks associated with the toy today.<sup>83</sup> Flores started the Flores Yo-Yo Corporation to manufacture the toys. He and a group of other Filipinos traveled across California to demonstrate the toys in search of sales.<sup>84</sup> On a business trip in San Francisco, Donald Duncan saw one of these demonstrations, and recognized the potential of the toy.<sup>85</sup> Duncan copied the toy<sup>86</sup> and began manufacturing in 1929.<sup>87</sup>

Flores obtained the first trademark for “Flores Yo-Yo” on July 22, 1930.<sup>88</sup> Duncan initially attempted to get the trademark in “Yo-Yo” by itself early on, but the patent office initially rejected his first request based on the Flores trademark in 1931.<sup>89</sup> Duncan ended up buying out Flores’s corporation and all of his rights to the

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<sup>76</sup> Holland, 8 F. Supp. at 261 (citing *Le Blume Import Co. v. Coty*, 293 F. 344, 347 (2d Cir. 1923)).

<sup>77</sup> *Id.* at 261.

<sup>78</sup> *Donald F. Duncan, Inc. v. Royal Tops Mfg. Co.*, 343 F.2d 655, 656 (7th Cir. 1965).

<sup>79</sup> *Id.* at 656-57.

<sup>80</sup> *Id.* at 659.

<sup>81</sup> See Jay C. Grelen, *Yo-yo heir puts a spin on toy history*, CHICAGO TRIBUNE (Sept. 4, 2001), <https://www.chicagotribune.com/news/ct-xpm-2001-09-04-0109040230-story.html>.

<sup>82</sup> Valerie Oliver, *History of the Yo-Yo*, MUSEUM OF YO-YO HISTORY, [http://www.yoyomuseum.com/museum\\_view.php?action=profiles&subaction=yoyo](http://www.yoyomuseum.com/museum_view.php?action=profiles&subaction=yoyo) (last visited Apr. 30, 2019).

<sup>83</sup> *Id.*

<sup>84</sup> Craig A. Orr, *Yo Yo Ups and Downs*, LEMELSON CENTER FOR THE STUDY OF INVENTION AND INNOVATION: SMITHSONIAN INSTITUTION, (Apr. 1, 2003), <https://invention.si.edu/yo-yo-ups-and-downs>.

<sup>85</sup> Grelen, *supra* note 81.

<sup>86</sup> See *id.*

<sup>87</sup> *Duncan*, 343 F.2d at 659.

<sup>88</sup> *Id.* at 660.

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

toy and trademark by October 1932.<sup>90</sup> Duncan eventually received a trademark for “Genuine Duncan Yo-Yo” on November 1, 1932 and subsequently received a trademark for just the word “Yo-Yo” on January 24, 1933.<sup>91</sup> According to Duncan’s son, the company sold an average of five to six million yo-yos a year with a peak of 18 million in a single year in the early 1950s.<sup>92</sup>

Returning to the case itself, the trial court upheld each of Duncan’s trademarks.<sup>93</sup> The lower court made no finding regarding whether the term Yo-Yo was generic at the time it was trademarked, essentially accepting the plaintiff’s claims that Duncan had coined the term as an arbitrary mark.<sup>94</sup> Further, the district court dismissed the defendant’s arguments that Yo-Yo at the time of the trial was generic in the U.S., and instead found that the generic terms for the toy over the years were a *return top*, *bandalore*, *emigrette*, and *quiz*.<sup>95</sup> The Seventh Circuit found the district court had erred on both grounds, and both grounds independently justified the term Yo-Yo losing protection.<sup>96</sup>

Regarding the origin of the term, the circuit court found ample evidence in the record showing Duncan had not independently come up with the term.<sup>97</sup> The defendant’s founder and president testified.<sup>98</sup> He was born in 1909 and grew up in the Philippines prior to becoming one of the Duncan’s predecessor’s demonstrators in 1931.<sup>99</sup> He attested to the fact that Yo-Yo was the Filipino term for the toy in each of the Filipino dialects.<sup>100</sup> The Seventh Circuit noted the general distrust of testimony by interested parties, but found the defendant’s testimony to be just the start of the body of evidence.<sup>101</sup> The court also found Duncan’s response to the 1931 application rejection to be informative.<sup>102</sup> In his response, he argued yo-yo translated to “come back” or “springy” but then said it was not being used as descriptive.<sup>103</sup> The appeals court found this to be a concession by Duncan that yo-yo was “a generic term incapable of exclusive appropriation.”<sup>104</sup> The defendant’s introduced as an expert the

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<sup>90</sup> Orr, *supra* note 84.

<sup>91</sup> Duncan, 343 F.2d at 659.

<sup>92</sup> Grelen, *supra* note 81.

<sup>93</sup> Duncan, 343 F.2d at 662.

<sup>94</sup> *Id.* at 660.

<sup>95</sup> *Id.* at 662.

<sup>96</sup> *Id.* at 661.

<sup>97</sup> *See Id.* at 660 (“[P]laintiff also places much reliance upon a contention that ‘Yo-Yo’ is an arbitrary mark, a word which originated with Donald F. Duncan, Sr., and coined by him. No finding was made by the trial court on this point and, for reasons subsequently shown, we think the contention is fallacious.”).

<sup>98</sup> *Id.*

<sup>99</sup> *Id.*

<sup>100</sup> *Id.*

<sup>101</sup> *Id.*

<sup>102</sup> *See id.* (using the response to the 1931 application rejection to corroborate the defendant’s founder’s testimony).

<sup>103</sup> *Id.*

<sup>104</sup> *Id.*

Chairman of the Department of Anthropology and Linguistics from the State University of New York at Buffalo.<sup>105</sup> He produced evidence of a newspaper article from 1933 that quoted the assistant director of the Philippine National Library as a game known throughout that country and another article from 1916 that identified a “yo-yo” as a Filipino toy.<sup>106</sup>

The Seventh Circuit quoted *Holland* and cited *Dadirrian* as well.<sup>107</sup> The court also cited *Selchow et al. v. Chaffee & Selchow Mfg. Co.*, in which the Second Circuit denied an injunction for “Parcheesi” because that name was the “phonetic equivalent of the name of the game in India.”<sup>108</sup> The Seventh Circuit ultimately found Yo-Yo unprotectable because of its generic origin from the Philippines.<sup>109</sup>

The appeals court went on to also find the mark was already seen as generic by people in the United States.<sup>110</sup> Although the full reasoning is not as important for this Note, as will be seen in Section IV below, the plaintiff’s actions were not unique. In one promotional document, the plaintiff wrote, “yo-yo had its origin in the Philippine Islands over 300 years ago and was used at that time as a weapon” acknowledging the terms origin. Earlier on, the plaintiff used the term yo-yo generically, and would add descriptors onto the term such as “Junior Yo-Yo, Beginner’s Yo-Yo, Tournament Yo-Yo, Satellite Yo-Yo, Butterfly Yo-Yo and Imperial Yo-Yo.”<sup>111</sup> However, Duncan began changing its language to use “returning top” as the generic term once litigation began.<sup>112</sup> After it had been published in earlier versions, the plaintiff convinced Merriam-Webster Dictionary and the American College Dictionary to acknowledge Duncan’s rights in those terms.<sup>113</sup>

### C. Sake and Suckers

In 1984, Congress amended the Lanham Act including making amendments to the genericness test.<sup>114</sup> Some courts questioned whether the rulings of *Dadirrian*, *Holland*, and *Duncan* still applied.<sup>115</sup> However, both the Second and the Fifth Circuits have applied this common law principle since that codification occurred.<sup>116</sup>

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<sup>105</sup> *Id.*

<sup>106</sup> *Id.* at 660–61.

<sup>107</sup> *Id.* at 661–62.

<sup>108</sup> *Id.* at 661–62 (citing *Selchow et al. v. Chaffee & Selchow Mfg. Co.*, 132 F. 996, 1000 (S.D.N.Y. 1904), *Holland v. C. & A. Import Corp.*, 8 F. Supp. 259, 261 (S.D.N.Y. 1934), *Dadirrian v. Yacubian*, 98 F. 872, 874 (1st Cir. 1900)).

<sup>109</sup> *Id.* at 661–62.

<sup>110</sup> *See id.* at 663 (“There is much documentary proof, the authenticity of which is not in dispute, that plaintiff for more than twenty years employed the term ‘Yo-Yo’ in its descriptive and generic sense.”).

<sup>111</sup> *Id.* at 663–64.

<sup>112</sup> *Id.* at 662.

<sup>113</sup> *Id.* at 665.

<sup>114</sup> Vincent N. Palladino, *Genericness and the Trademark Clarification Act of 1984: Five Years Later*, 79 TRADEMARK REP. 657, 657 (1989).

<sup>115</sup> *Otokoyama Co. v. Wine of Japan Import, Inc.*, 175 F.3d 266, 271 n.3 (2d Cir. 1999).

<sup>116</sup> *See id.*; *Enrique Bernat F., S.A. v. Guadalajara, Inc.*, 210 F.3d 439, 443–44 (5th Cir. 2000).

In *Otokoyama Co. v. Wine of Japan Import, Inc.*, the Second Circuit reviewed an issued injunction based on the trademark “Otokoyama” against a competing brand of sake.<sup>117</sup> The plaintiff had sold its product in the U.S. since 1984 under the label Otokoyama, and the USPTO granted a trademark for that label in 1988.<sup>118</sup> The plaintiff subsequently obtained trademarks in the two Kanji and two other writing systems for the term as well as the transliteration of those symbols.<sup>119</sup> However, the plaintiff in its sales in Japan labeled its product as “Hokkai Otokoyama.”<sup>120</sup> In 1997, the plaintiff sent the defendant a cease and desist letter over the marketing, import, and sales of the defendant’s “Mutsu Otokoyama.”<sup>121</sup> The circuit court reviewed whether the district court had improperly excluded evidence and whether the injunction was warranted.<sup>122</sup>

The court started its decision by citing *Kellogg*, and saying,

[i]t is a bedrock principle of the trademark law that no trader may acquire the exclusive right to the use of a term by which the covered goods or services are designated in the language. Such a term is “generic.” Generic terms are not eligible for protection as trademarks; everyone may use them to refer to the goods they designate.”<sup>123</sup>

As with many of the cases already mentioned above, the Second Circuit agreed prohibiting trademarks on generic terms allows competitors to accurately describe their products.<sup>124</sup> It went on to state that the foreign equivalents doctrine was an “extension” of the genericness doctrine.<sup>125</sup> The court continued its analysis and cited terms previous courts had found to be unprotectable for species of a genus, but, of note, these cases included terms of English and other languages.<sup>126</sup> The appeals court also made clear that *Holland* still was good law even after the passing of the 1984 Amendments to the Lanham Act.<sup>127</sup>

During the district court litigation, the defendants presented evidence of the plaintiff’s attempt to register “Hokkai Otokoyama,” the denial of the trademark, and ultimately a Japanese Patent Office board decision.<sup>128</sup> The district court, generally referring to ideas of the territoriality principle, found that the decision of the foreign government regarding a party’s trademark had no impact on the ability to gain

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<sup>117</sup> *Otokoyama*, 175 F.3d at 268.

<sup>118</sup> *Id.*

<sup>119</sup> *Id.* at 269.

<sup>120</sup> *Id.* at 268.

<sup>121</sup> *Id.* at 269.

<sup>122</sup> *Id.*

<sup>123</sup> *Id.* (citing *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 116-17 (1938)).

<sup>124</sup> *Id.*

<sup>125</sup> *Id.* 270–71.

<sup>126</sup> *Id.* at 271.

<sup>127</sup> *Id.* at 271 n.3.

<sup>128</sup> *Id.* at 271–72.

protection in this country.<sup>129</sup> The Second Circuit said,

[i]t is true that a claimant's rights (or lack of rights) to a trademark in the United States cannot be established by the fact that the claimant was found by a foreign court to have (or not to have) rights over the same mark in a foreign country. . . . It does not follow, however, that foreign court decisions are *never* relevant or admissible for any purpose in a U.S. trademark dispute.<sup>130</sup>

Although not binding on the U.S., the circuit court found the Japanese decision was relevant to showing the genericness of the term as well as showing the plaintiff had been dishonest in claiming the term was "arbitrary" and "fanciful" in its application to the USPTO.<sup>131</sup> The Second Circuit vacated the injunction and remanded the case for the district court to review its decision in light of the additional evidence.<sup>132</sup>

In *Enrique Bernat F., S.A. v. Guadalajara, Inc.*, two competing candy manufacturers fought over the right to use the term "chupa" for their products.<sup>133</sup> The plaintiff sold a product called "Chupa Chups" and convinced the district court to issue an injunction against the defendant's "Chupa Gurts."<sup>134</sup> The plaintiff was a Spanish company that sold its candy to both Mexico and the U.S.; whereas, the defendant was a Mexican company that also sold its products to the U.S.<sup>135</sup>

The case rested on the translation of the term "chupa."<sup>136</sup> The district court accepted the plaintiff's analysis that "chupa" was the term "meaning 'to lick' or 'to suck'" and the direct translation of lollipop to Spanish was "paleta."<sup>137</sup> However, the circuit court found this to be the starting point of the analysis, not the end, as the district court had done.<sup>138</sup> The Fifth Circuit then looked to other products in Mexico including the Mexican version of the Tootsie Roll Pop called the "Tutsi Chupa Pop."<sup>139</sup> The appeals court continued its analysis into other Spanish dialects noting as "chupatinos" means 'lollipop' in Argentina.<sup>140</sup> The Fifth Circuit noted that the Spanish to English dictionary used by the district court did not translate "chupa" into "lollipop;" however, the court found the "interpretive task" of creating a translating

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<sup>129</sup> *Id.* at 272.

<sup>130</sup> *Id.*

<sup>131</sup> *Id.* at 273.

<sup>132</sup> *Id.* Subsequently, the district court found in favor of the defendants, cancelling the plaintiff's trademarks. The Second Circuit again reviewed the decision and upheld the invalidity of the trademarks. *Otokoyama Co. v. Wine of Japan Imp., Inc.*, 7 F. App'x 112, 115 (2d Cir. 2001).

<sup>133</sup> *Enrique Bernat F., S.A. v. Guadalajara, Inc.*, 210 F.3d 439, 441 (5th Cir. 2000).

<sup>134</sup> *Id.*

<sup>135</sup>

<sup>136</sup> *Id.*

<sup>137</sup> *Id.* at 443.

<sup>138</sup> *Id.*

<sup>139</sup> *Id.* at 444.

<sup>140</sup> *Id.*

dictionary not controlling on our courts.<sup>141</sup>

Another important aspect of this decision was the Fifth Circuit's focus on international comity.<sup>142</sup> As described, "U.S. companies would be hamstrung in international trade if foreign countries granted trademark protection to generic English words, the U.S. reciprocates and refuses trademark protection to generic foreign words."<sup>143</sup> The circuit court refused to provide protection to the plaintiff in this case because it wanted ensure "Mexican candy makers' ability to compete effectively in the U.S. lollipop market. Just as we do not expect Mexico to interfere with Tootsie's ability to market its product in Mexico by granting trademark protection in the word 'pop to another American confectioner . . . ."<sup>144</sup>

#### IV. An International Look at the English Language

Taking a step back from the legal precedent, the foreign equivalents doctrine should be viewed in light of the history and the current state of the English language throughout the world. *The Story of English* starts its introduction with a quote from Ralph Waldo Emerson: "The English language is the sea which receives tributaries from every region under heaven."<sup>145</sup> As the quote suggests, English has spread across the globe, but that expansion has also affected the evolution of the language.

##### A. The Development of the English Language

Unlike the romantic languages of French, Spanish, and Italian that all derive from Latin, English has a more tumultuous background.<sup>146</sup> The language owes itself to the long series of groups that conquered the people of a western island in Europe. As far back as 400 B.C.E. the Celts spread out to the British Isles.<sup>147</sup> In the fifth century C.E., the Germanic tribes of the Angles, Saxons, and Jutes violently conquered the island to their west.<sup>148</sup> St. Augustine then brought Christianity along with the languages of the church, Latin and Greek, in 597 C.E..<sup>149</sup> From 750 through 1000 C.E., the Vikings raided the region leaving influences of their Norse language.<sup>150</sup> In 1066, the Normans from the western coast of modern day France

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<sup>141</sup> *Id.* at 444-45.

<sup>142</sup> *Id.* at 445.

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

<sup>144</sup> *Id.* at 445.

<sup>145</sup> ROBERT MCCRUM, WILLIAM CRAN & ROBERT MACNEIL, *THE STORY OF ENGLISH* XIII (Penguin Books, new and rev. ed. 1993) (quoting RALPH WALDO EMERSON, *SOCIETY AND SOLITUDE*, TWELVE CHAPTERS, 182 (1871)).

<sup>146</sup> *Id.* at 34.

<sup>147</sup> *Id.* at 37.

<sup>148</sup> *Id.* at 43.

<sup>149</sup> *See Id.* at 49; *Saint Augustine of Canterbury*, *ENCYCLOPEDIA BRITANNICA*, <https://www.britannica.com/biography/Saint-Augustine-of-Canterbury> (last visited Oct. 10, 2019) ("The first archbishop of Canterbury was St. Augustine of Canterbury . . . who was sent from Rome . . . to convert the Anglo-Saxons in England. Augustine arrived in 597 . . . .").

<sup>150</sup> MCCRUM, CRAN & MACNEIL, *supra* note 145, at 51.



dominated the land for the next two centuries.<sup>151</sup>

Although the conquests of Britain essentially ended after the Normans, the English language gradually changed by usage. As many high schoolers know, the Middle English language of Chaucer's *Canterbury Tales* from the 14<sup>th</sup> century is hardly recognizable to a modern student.<sup>152</sup> Although more approachable, Shakespeare's plays and sonnets still use terms and phrases beyond the common parlance of those same students. McCrum credits the *King James Bible*, published in 1611, as the foundation for the standardizing the English written word.<sup>153</sup> The invention of the printing press in the early 1500's further allowed this standardization to spread.<sup>154</sup>

#### B. The Spread of English to its Colonies

Just as the English language evolved as the British people interacted with outsiders, the English language continued to evolve after it crossed the Atlantic to North America.<sup>155</sup> The early English settlers needed words to describe the different lands and experiences on this unfamiliar continent, and in many cases they relied on words from other languages.<sup>156</sup> Words, such as *chipmunk*, *moccasin*, and *kayak* have origins from the Native Americans inhabiting the lands before the European settlers arrived.<sup>157</sup> The Spanish, who early on settled the South and the West, gave the country words such as *barbecue*, *chocolate*, *plaza*, *stampede*, and *tornado*.<sup>158</sup> Similarly, the French, who initially settled to the West and the North, gave us words such as *bayou*, *crevasse*, and *brioche*.<sup>159</sup>

In contrast with America, the English did not attempt to settle Australia until Captain James Cook's expedition in 1770.<sup>160</sup> Although not understood at the time, the native Aboriginal people had hundreds of languages prior to the arrival of the European colonists.<sup>161</sup> In 1788, the English established a penal colony, and the colony's inhabitants began picking up some Aboriginal words such as *billabong* and *boomerang*.<sup>162</sup> Early on, the majority of European inhabitants in Australia were the felons, ex-felons, and their descendants.<sup>163</sup> About a century later, a wave of people from across England, Scotland, and Ireland travelled to Australia due to poverty and

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<sup>151</sup> *Id.* at 56.

<sup>152</sup> *Id.* at 64–65.

<sup>153</sup> *Id.* at 92–96. The *King James Bible* was published concurrently as Shakespeare began writing *The Tempest*.

<sup>154</sup> *Id.* at 80.

<sup>155</sup> *Id.*, *supra* note 145, at 103.

<sup>156</sup> *Id.*

<sup>157</sup> *Id.*

<sup>158</sup> *Id.* at 106.

<sup>159</sup> *Id.*, *supra* note 145, at 106–07.

<sup>160</sup> *Id.* at 276.

<sup>161</sup> *Id.*

<sup>162</sup> *Id.* at 276–77.

<sup>163</sup> *Id.* at 280.



overcrowding in their hometowns.<sup>164</sup> Although the language had fewer influences than in America, by the mid-1800's Australia had its own distinct dialect. As described by an Australian school report sent back to England, "Little care is apparently taken to correct vicious pronunciation . . . this inattention has a tendency to foster an Australian dialect which bids fair to surpass the *American in disagreeableness*."<sup>165</sup>

### C. The State of English Today

The above two subsections are simply intended to provide a historical context to the use of the English language today and emphasize that the English language is not homogenous. Articles, books, and entire journals are dedicated to the study of English and the differences between regional and cultural variations.<sup>166</sup> According to *International English: A guide to the varieties of Standard English*, only fifteen percent of people in England speak what the authors consider to be "Standard English," and those in that category are "concentrated towards the top end of the social scale."<sup>167</sup>

As another article put it, "the English language needs to be viewed *not as a single, monolithic entity*, but as something that has multiple varieties and forms."<sup>168</sup> Linguists have categorized three types of countries that use English. The "Inner Circle" countries are those such as the UK, the United States, Australia, and Ireland that use English as its primary language.<sup>169</sup> The "Outer Circle" are countries that retain a native language but use English as an official or governmental language.<sup>170</sup> These include India, Singapore, Nigeria, and Kenya.<sup>171</sup> Finally, the "Expanding Circle" countries consist of countries that have a large population that chose to study English.<sup>172</sup>

Among the Inner Circle countries, distinct differences in accents, words, and phrases exist. These differences can easily be seen by between common terms in the United States compared to England. For example, flashlight/torch, outlet/socket, washcloth/face flannel, suspenders/braces, pharmacy/chemist's shop, and truck/lorry.<sup>173</sup> Although Australian English is closer to that spoken in England, Australians' use colorful slang terms.<sup>174</sup> Some of these terms include: a drongo/a fool, hard yakka/

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<sup>164</sup> *Id.*, *supra* note 145, at 280–81.

<sup>165</sup> *Id.* at 287 (emphasis added).

<sup>166</sup> See, e.g., MCCRUM, CRAN & MACNEIL, *supra* note 145.

<sup>167</sup> TRUDGILL & HANNAH, *supra* note 7, at 2. Interestingly, the cited sentence uses "15 per cent" instead of percent as would commonly be used in the United States.

<sup>168</sup> Burcu Ates et al., *Incorporating world Englishes into undergraduate ESL education courses*, 34 *WORLD ENGLISHES* 485, 485 (Sept. 2015) (emphasis added).

<sup>169</sup> TRUDGILL & HANNAH, *supra* note 7, at 4.

<sup>170</sup> *Id.* at 5.

<sup>171</sup> *Id.*

<sup>172</sup> Ates et al., *supra* note 168, at 485.

<sup>173</sup> TRUDGILL & HANNAH, *supra* note 7, at 90-92.

<sup>174</sup> *Id.* at 25–26.

hard work, a larrikin/a young ruffian, a chook/a chicken, tucker/food, and a sheila/a girl.<sup>175</sup> Australians too would look at an American oddly if the American asked for their eggs either “sunny-side up” or “over-easy.”<sup>176</sup> Even across the United States, people can have strong feelings whether you call a sweetened, carbonated beverage a pop or soda.<sup>177</sup>

In summary, the English language evolved over the course of centuries. The language has spread across the globe, and many countries use English as their primary language. However, the passage of time, the cultural experiences, and even the effects of nature have created unique words and phrases that may not be recognized by individuals from foreign English-speaking countries.

## V. The Constriction of the Foreign Equivalents Doctrine

Based on the various courts’ rulings in Section II and the historical context of Section III, applying the foreign equivalents doctrine to English-speaking countries should, in theory, be a straight forward application of the existing doctrine. However, a series of decisions have seemingly gone out of their way to constrict this doctrine by selectively looking at previous case law and narrowly reviewing their own fact patterns. This has created an unjustified exception to the foreign equivalents doctrine for English-speaking countries. This Section will explore these cases.

### A. A Grocery Store

*Carcione v. Greengrocer, Inc.* was one of the first decisions to create an exception for the foreign equivalents doctrine for English-speaking countries.<sup>178</sup> The plaintiff previously registered the trademark “Greengrocer” with the federal government for a grocery store, and in response, the defendant registered “The Greengrocer, Inc.” with the California Secretary of State.<sup>179</sup> The court acknowledged “Webster’s Third New International Dictionary entry for ‘greengrocer’ states, in toto (aside from its pronunciation guide): ‘Chiefly Brit.: a retailer of fresh vegetables(sic) and fruit.’”<sup>180</sup> Both parties acknowledged the term was generic in Britain.<sup>181</sup>

The defendant produced depositions of individuals referring to retailers selling fruits and vegetables as a greengrocer, but the court said the individuals being British cut against the finding of genericness.<sup>182</sup> The plaintiff produced its own depositions

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<sup>175</sup> *Id.* at 28.

<sup>176</sup> Elizabeth Christopher, *Communication across cultures*, 37 *WORLD ENGLISHES* 455, 457 (Sept. 2018).

<sup>177</sup> Melissa Dahl, *Soda or pop? Coo-pon or cyu-pon? Maps reveal how America speaks*, NBC NEWS (June 6, 2013, 1:34 PM), <https://www.nbcnews.com/health/body-odd/soda-or-pop-coo-pon-or-cyu-pon-maps-reveal-f6C10225517>.

<sup>178</sup> *See Carcione v. Greengrocer, Inc.*, No. CIVIL S-78-561, 1979 U.S. Dist. LEXIS 9188, at \*2-3 (E.D. Cal. Oct 12, 1979).

<sup>179</sup> *Id.* at \*1.

<sup>180</sup> *Id.* at \*3.

<sup>181</sup> *Id.*

<sup>182</sup> *Id.*

from individuals and testified the United States Department of Agriculture recognized him as “The Greengrocer.”<sup>183</sup> The district court issued an injunction against the defendant and cancelled the defendant’s state trademark. However, the decision said, “I believe that possible consumer confusion can be easily avoided if the defendant merely changes his signs and advertisements to identify the store as ‘Sherrill’s Greengrocery’, or in some other manner that clearly distinguishes himself from plaintiff.”<sup>184</sup>

This case made no mention of the foreign equivalents doctrine nor any case related to the doctrine.<sup>185</sup> The court’s sole focus was on how the local public viewed the term.<sup>186</sup> Unlike *Dadirrian, Holland, and Enrique Bernat* which identified foreigner confusion as a reason for not allowing the trademark, this court found comments by British customers in California supported the trademark’s enforceability.<sup>187</sup> Additionally, the decision’s suggestion that the plaintiff could keep the trademark in “Greengrocer” while allowing the defendant to also use that term, as long as it added another descriptor, seemingly contradicts whether or not greengrocer is a trademark.<sup>188</sup>

On review of the USPTO database, it is unclear which federal trademark this case refers to; however, the trademarks potentially associated with this case appear to be dead with an unknown cancelation date.<sup>189</sup> Further, in another trademark registration from 2002, BON MARCHE DINING & GREENGROCER, the registration disclaimed both dining and greengrocer.<sup>190</sup>

#### B. A Low Alcohol Beer

In *Anheuser-Busch Inc. v. Stroh Brewery Co.*, the Eight Circuit reviewed the trademark of “LA” for a low alcohol beer.<sup>191</sup> The majority of the decision focused on whether LA was generic, descriptive, or suggestive.<sup>192</sup> The district court concluded

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<sup>183</sup> *Id.* at \*4.

<sup>184</sup> *Id.* at \*7.

<sup>185</sup> *See generally id.*

<sup>186</sup> *See generally id.*

<sup>187</sup> *Id.* at \*3.

<sup>188</sup> *Id.* at \*7.

<sup>189</sup> GREEN GROCER, Registration No. 0,995,381.

<sup>190</sup> BON MARCHE DINING & GREENGROCER, Registration No. 75,919,962. The USPTO defines a disclaimer as,

a statement that the applicant or registrant does not claim the exclusive right to use a specified element or elements of the mark. The purpose of a disclaimer is to permit the registration of a mark that is registrable as a whole but contains matter that would not be registrable standing alone, without creating a false impression of the extent of the registrant’s right with respect to certain elements in the mark.

*Glossary*, USPTO, <https://www.uspto.gov/learning-and-resources/glossary> (last visited Nov. 19, 2019).

<sup>191</sup> *Anheuser-Busch Inc. v. Stroh Brewery Co.*, 750 F.2d 631, 633 (8th Cir. 1984) (2-1 decision) (Bright, J., dissenting). This case was decided in St. Louis, Missouri, the longtime home of Anheuser-Busch.

<sup>192</sup> *See generally id.*

that LA was suggestive,<sup>193</sup> and the circuit affirmed.<sup>194</sup> Therefore, LA could be registered and protected without a showing of secondary meaning.<sup>195</sup> The circuit court then affirmed the district court's injunction preventing the defendant from using "Schaefer LA" because the consuming public did not see LA as descriptive.<sup>196</sup>

The majority's decision also evaluated the defendant's foreign equivalents argument.<sup>197</sup> The majority acknowledged an Australian company had previously registered the mark "Tooth LA."<sup>198</sup> The court mentioned the defendant's argument that "the 'bar call' for low alcohol beer in Australia ha[d] become 'Give me an L.A.,' that the term LA is generic or descriptive there, and that a word that is generic or descriptive in a foreign country should be accorded the same status in the United States."<sup>199</sup> However, the appeals court gave a cursory dismissal of these arguments saying, "[a] number of cases hold that a term may be generic in one country and suggestive in another."<sup>200</sup> The first case this circuit court relied on was the district court decision *Carcione* mentioned above.<sup>201</sup> The second case this court mentioned was *Seiko Sporting Goods U.S.A., Inc. v. Kabushiki Kaisha Hattori Tokeiten*.<sup>202</sup> In passing the court in *Seiko* mentioned "[w]hile plaintiff has sought to show that Seiko is a generic term in Japanese, it is not so recognized in this country."<sup>203</sup> However, *Seiko* does not mention what evidence the defendant put forward to show genericness, and, unlike the mark LA, Seiko was actively selling products in its native country under that mark.<sup>204</sup> The final case cited was *Abercrombie & Fitch Co. v. Hunting World, Inc.*<sup>205</sup> Although it is not totally clear which passage the *Anheuser* court was citing, the closest passage referred to a mark first being suggestive, then, becoming generic later on.<sup>206</sup> In dismissing the foreign equivalents argument, the Fifth Circuit

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<sup>193</sup> *Id.* at 634–35.

<sup>194</sup> *Id.* at 642.

<sup>195</sup> *Id.* at 643.

<sup>196</sup> *Id.*

<sup>197</sup> *Id.* at 642.

<sup>198</sup> *Id.* The Australian trademark for TOOTH LA has the disclaimer "[r]egistration of this trade mark shall give no right to the exclusive use of the letters LA." TOOTH LA, Austl. Registration No. 405,120.

<sup>199</sup> *Anheuser-Busch*, 750 F.2d at 642.

<sup>200</sup> *Id.* (citing *Carcione v. Greengrocer, Inc.*, No. CIVIL S-78-561, 1979 U.S. Dist. LEXIS 9188, at \*3 (E.D. Cal. Oct 12, 1979)).

<sup>201</sup> *Id.* at 642.

<sup>202</sup> *Id.* (citing *Seiko Sporting Goods U.S.A., Inc. v. Kabushiki Kaisha Hattori Tokeiten*, 545 F. Supp. 221, 226 (S.D.N.Y. 1982)).

<sup>203</sup> *Seiko Sporting Goods*, 545 F. Supp. At 226.

<sup>204</sup> *Seiko History*, THE SEIKO MUSEUM, [https://museum.seiko.co.jp/en/seiko\\_history/](https://museum.seiko.co.jp/en/seiko_history/) (Last visited May 2, 2019).

<sup>205</sup> *Anheuser-Busch*, 750 F.2d at 642.

<sup>206</sup> See *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 10 (2d Cir. 1975).

The pervasiveness of the principle is illustrated by a series of well known cases holding that when a suggestive or fanciful term has become generic as a result of a manufacturer's own advertising efforts, trademark protection will be denied save for those markets where the term still has not become generic and a secondary meaning has been shown to continue. A term may thus be generic in one market and descriptive or suggestive or fanciful in another.

failed to offer any real analysis of these three cases, nor did that court apply those rulings to the facts of the instant case.

The Fifth Circuit acknowledged Anheuser's desire to gain the rights to "bar call" and considered this desire to be admirable because it provided something of value for the company.<sup>207</sup> However, the dissent distinguished situations where a trademark holder admirably independently created and developed a trademark to this plaintiff's desire to monopolize a term it had copied from another country.<sup>208</sup> Though the dissent did not mention it, these are the same types of monopolies that *Dadirrian* and *Holland* warned against.

Interestingly, one of Anheuser's commercials for its LA Beer, starts out with the phrase "the idea came in on a cool wave from Australia."<sup>209</sup> The commercial shows the Sydney Opera House, a kangaroo, and people playing rugby.<sup>210</sup> It is also narrated in an Australian accent and has Australian sounding music using a didgeridoo.<sup>211</sup> Yet, the Australian manufacturer, with an Australian trademark for Tooth LA, would not have been able to import its beer to this country under this court's decision.<sup>212</sup>

### C. Oprah's Shoes

In 2003, Oprah included the Ugg Classic Short boots on her annual "Favorite Things List" helping "the brand obtain its immortal cult following."<sup>213</sup> The Ugg brand is currently owned by the Deckers Corporation, and that company has fought fervently to protect that trademark.<sup>214</sup> However, just like LA for beer, ugg is actually a generic term from Australia simply referring to sheepskin boots which have been sold in that country for over half a century.<sup>215</sup> Despite this fact, Deckers has litigated and successfully protected its trademark rights in the United States on at least three separate occasions.

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<sup>207</sup> See *Anheuser-Busch*, 750 F.2d at 643.

<sup>208</sup> *Id.* at 652 (Bright, J., dissenting). The dissent cited Judge Frank's, concurrence in *Standard Brands, Inc. v. Smidler* stating that "[s]ince plaintiff did not originate the symbol—which, as heretofore noted, had previously been utilized by others \* \* \* [in different contexts]—the scope of its monopoly should be peculiarly restricted." 151 F.2d 34, 43 (2d Cir. 1945).

<sup>209</sup> Jason Harder, *1984 LA Beer from Anheuser-Busch (low alcohol beer) commercial*, YOUTUBE (June 23, 2012), <https://www.youtube.com/watch?v=mrsHmuUcL20>.

<sup>210</sup> *Id.*

<sup>211</sup> *Id.*

<sup>212</sup> *Anheuser-Busch's trademark for LA Beer was subsequently cancelled by G. Heileman Brewing Co. v. Anheuser-Busch, Inc.*, 873 F.2d 985, 1000–01 (7th Cir. 1988). The G. Heileman Brewing decision found "LA Beer" to be a descriptive term without secondary meaning, but mentioned "[i]t would be unusual trademark policy" to protect the Australian term in the United States and allow the Anheuser-Busch "to preempt the low alcohol beer market in this country."

<sup>213</sup> Chavie Lieber, *Oprah Is the Original Celebrity Influencer*, RACKED (Mar. 6, 2018) <https://www.racked.com/2018/3/6/17081942/oprah-celebrity-influencer>.

<sup>214</sup> Jan Wolfe, *UGG boot maker Deckers wins trademark fight with small Aussie rival*, REUTERS (May 13, 2019, 4:18PM), <https://www.reuters.com/article/ip-trademark/ugg-boot-maker-deckers-wins-trademark-fight-with-small-aussie-rival-idUSL2N22P1JK>.

<sup>215</sup> See *Ugg boot makers battle US giant*, THE SYDNEY MORNING HERALD, (February 14, 2004) <http://www.smh.com.au/national/ugg-boot-makers-battle-us-giant-20040213-gdicpn.html>.

In 2005, Deckers litigated *UGG Holdings, Inc. v. Severn*.<sup>216</sup> The court briefly described the history of the company. For clarity, the full description follows:

Plaintiff's "UGG" trademark, which is the only mark Plaintiff claims Defendants are infringing, dates back to the 1970s, when Brian Smith, who had come to the United States from Australia, founded UHI, a company that imported and sold Australian sheepskin boots. Smith began using the trademark "UGG" in connection with UHI's boot business in December 1979. In May 1986, Smith applied to the United States Patent and Trademark Office (the "USPTO") for registration of a design logo incorporating the terms "ORIGINAL UGG BOOT" and "UGG AUSTRALIA," in addition to a graphic depiction of a ram's head (the "Ram's Head Logo"). In October 1987, the USPTO registered the Ram's Head Logo. In May 1995, UHI applied to the USPTO for registration of the term "UGG," and in May 1996, the mark was registered. The parties agree that the "UGG" trademark has become incontestable pursuant to 15 U.S.C. § 1065. In 1995, Deckers acquired UHI, along with all of UHI's trademarks.<sup>217</sup>

Early on, the decision noted that the sales associated with the brand exceeded \$100 million in the year prior,<sup>218</sup> and that the company had spent over \$8 million in advertisements.<sup>219</sup>

The defendant in this case sold its own sheep-skin shoes since 1989 and used the term "ug" in describing those boots in advertisements and its website.<sup>220</sup> The defendant's defense relied on UGG being a generic term.<sup>221</sup> The defendant presented testimony by a surfboard shop owner and a corporate footwear purchaser for Nordstrom, both saying they used the term generically.<sup>222</sup> The defendant also produced evidence of advertisements using the term generically.<sup>223</sup> The court said, "almost all of these advertisements were, in fact, placed by Brian Smith himself and therefore are evidence only of his early use of the 'UGG' trademark."<sup>224</sup> Finally, the defendants submitted "evidence of an entry from an edition of the Shorter Oxford English Dictionary ('OED') published in New York City, which defines the term 'ugg

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<sup>216</sup> *UGG Holdings, Inc. v. Severn*, No. CV 04-1137, 2005 U.S. Dist. LEXIS 45783, \*2-3 (C.D. Cal. Feb. 23, 2005). The asserted trademark in this case was for the word UGG for clothing including footwear, T-shirts, hats, and gloves. This mark was active at the time of this trial, but was subsequently cancelled. UGG, Registration No. 1,973,743 (cancelled Feb. 17, 2007).

<sup>217</sup> *UGG Holdings*, 2005 U.S. Dist. LEXIS 45783, at \*4.

<sup>218</sup> *Id.* at \*3-4.

<sup>219</sup> *Id.* at \*3 n.1.

<sup>220</sup> *Id.* at \*5.

<sup>221</sup> *Id.* at \*12.

<sup>222</sup> *Id.* at \*14.

<sup>223</sup> *Id.*

<sup>224</sup> *Id.*



boot’ as, ‘a kind of soft sheepskin boot, omitting any mention of the word’s trademark status.’<sup>225</sup> The plaintiff subsequently contacted the publisher and convinced the editor to “correct the oversight in future editions.”<sup>226</sup> This district court ultimately found the defendants failed to show “UGG” was generic in the United States.<sup>227</sup>

The findings in *UGG Holdings* contradict many of the earlier foreign equivalent cases overall, and even contradict many of the cases that court directly cited. First, this court mentioned the founder’s generic use of the term “ugg” in his marketing early on, but found this supported protecting the trademark.<sup>228</sup> In contrast, as mentioned in Section II *supra*, the court in *Duncan* used the nearly identical fact pattern to support its genericness conclusion.<sup>229</sup> Further, the reasoning even contradicts *UGG Holdings*’ own quotation that “[a] generic term ‘cannot become a trademark under any circumstances.’”<sup>230</sup> Also, similar to *Duncan*, the plaintiff used the acquiescence of a dictionary’s editor to try to show the strength of its mark, but, just like in *Duncan*, the more important fact was the editors, as experts in the language, initially saw the word as generic.

*UGG Holdings* also claimed to consider whether the term’s genericness in Australia should prevent its trademark here, and even cited many of the cases mentioned in Section II *supra*.<sup>231</sup> The court acknowledged the purposes of avoiding confusion and international comity from *Enrique Bernat* and *Otokoyama*, but then quoted the *Otokoyama* decision saying, the “doctrine ‘applies when the word designates the product in a language *other than English*.’”<sup>232</sup> The decision recognized that the plaintiff had three Australian trademarks: the footnote said, “the validity of Plaintiffs Australian trademarks has not been questioned in the courts of Australia.”<sup>233</sup>

*UGG Holdings* once again selectively cited the cases and ignored the actual reasoning of these cases and others. In the section of *McCarthy* cited by the court, the treatise went on to say:

***Precedent That Refuses to Look to Generic Significance Abroad.***

There is a line of cases which holds that, for determining the genericness issue, the meaning of the term in another nation is

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<sup>225</sup> *Id.* at \*15.

<sup>226</sup> *Id.*

<sup>227</sup> *Id.* at \*15–16.

<sup>228</sup> *Id.* at \*14.

<sup>229</sup> *Donald F. Duncan, Inc. v. Royal Tops Mfg. Co.*, 343 F.2d 655, 663 (7th Cir. 1965).

<sup>230</sup> *UGG Holdings*, 2005 U.S. Dist. LEXIS 45783, at \*12 (quoting *Filipino Yellow Pages, Inc. v. Asian Journal Publ’ns., Inc.*, 198 F.3d 1143, 1147 (9th Cir. 1999)).

<sup>231</sup> *Id.* at \*17-21 (citing 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 12:41 (5th ed. 2019)). The court relied on *McCarthy* to help articulate the doctrine, but then cited *Enrique Bernat*, *Otokoyama*, *Anheuser-Busch*, and *Carcione* to support its finding that foreign equivalents did not apply.

<sup>232</sup> *Id.* at \*19 (emphasis added) (quoting *Otokoyama Co. Ltd. v. Wine of Japan Import, Inc.*, 175 F.3d 266, 270 (2d Cir. 1999)).

<sup>233</sup> *Id.* at \*20 n.11.

completely irrelevant. This line of cases *ignores the policy of international comity and focuses only on a narrow version of the rationale of consumer perception in the United States.*<sup>234</sup>

The court also failed to mention IP Australia, the organization responsible for Australian trade marks, had issued trade mark registrations to at least two other companies using the term “Ugg” or “Uggs” prior to the district court’s decision.<sup>235</sup>

In *Deckers Outdoor Corp. v. Ozwear Connection Pty*, the plaintiff sued for trademark infringement, cybersquatting, and infringement of two design patents.<sup>236</sup> This court found the defendant in default of the trademark infringement, dilution of a famous mark, and infringement of a design patent claims but found the defendant not liable for the cybersquatting claims.<sup>237</sup> In addition to both using the term “Ugg,” the defendant also capitalized the term, had it in the center of the label, and included the term “Australian” in the label as well. The court used these additional similarities to support finding for the plaintiff for the trademark infringement claim.<sup>238</sup>

In the subsequent cybersquatting section, the decision upheld the defendant’s right to use the term “uggs” in its domain name.<sup>239</sup> The websites at issue were “ozwearuggs.com” and “ozwearuggs.com.au.”<sup>240</sup> In evaluating the cybersquatting claim, the decision said, “The word ‘uggs’ is a term for a type of sheepskin boot, while Deckers’ registered trademark, ‘UGG,’ is not a generic product term.”<sup>241</sup> The logic to this argument is strenuous at best. The decision acknowledges that generic terms are “*not capable of receiving protection*” in a footnote of the cybersquatting section, despite its earlier finding of trademark infringement and dilution of a famous mark.<sup>242</sup>

This court attempted to distinguish the two words based on the generic term ending in the letter “s.”<sup>243</sup> In the earlier *UGG Holdings* decision, the defendant’s used the term “ug” in its advertisements and labels.<sup>244</sup> Further that earlier court noted the

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<sup>234</sup> 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 12:41 (5<sup>th</sup> ed. 2019) (emphasis added).

<sup>235</sup> See ROUSABOUT UGGS, Austl. Registration No. 883,972; UGGS-N-RUGS, Austl. Registration No. 948,869. IP Australia uses the term “trade\_mark” rather than trademark.

<sup>236</sup> *Deckers Outdoor Corp. v. Ozwear Connection Pty*, No. CV 14-2307, 2014 U.S. Dist. LEXIS 132169, \*1 (C.D. Cal. Sept. 18, 2014).

<sup>237</sup> *Id.* at \*25.

<sup>238</sup> *Id.* at \*16-17.

<sup>239</sup> *Id.* at \*21.

<sup>240</sup> *Id.*

<sup>241</sup> *Id.*

<sup>242</sup> *Id.* at \*22 n.2 (quoting *Yellow Cab Co. of Sacramento v. Yellow Cab of Elk Grove, Inc.*, 419 F.3d 925, 927 (9<sup>th</sup> Cir. 2005)). The specific trademark being asserted in this case was only for the word “UGG” for men’s, women’s, and children’s footwear and clothing. UGG, Registration No. 3,050,925 (registered Jan. 24, 2006).

<sup>243</sup> *Ozwear*, 2014 U.S. Dist. LEXIS 123169, \*21–23. The court also used the use of the “ozwear” brand name to justify its finding of no cybersquatting.

<sup>244</sup> *UGG Holdings*, 2005 U.S. Dist. LEXIS 45783, at \*5.



other trademarks the plaintiff had registered included a stylized “UGG,” “BABY UGGS,” and “UGHS” in the U.S. and owned the Australian marks “UGH-BOOTS,” “UGH,” and a logo with the word “UGG.”<sup>245</sup> The court in 2005 ignored the spelling differences and the plural differences in its decision finding infringement, but in this more recent case adding an “s” somehow avoided confusion.

The most recent case involving these same plaintiffs was *Deckers Outdoor Corp. v. Australian Leather Pty Ltd.*<sup>246</sup> This decision went into even greater depth regarding the history of the type of shoe and of the company itself. The decision describes the general knowledge of the term *ugg* since at least the late 1960s.<sup>247</sup> The founder also had full knowledge of the genericness of the term before he started selling the boots in the U.S. in the early 1980s.<sup>248</sup> Other individuals had sold boots in the U.S. under either *ugg* or *ugh*.<sup>249</sup> The court also acknowledged someone had registered UGH-BOOTS in Australia in 1971, though that registration was purchased by the plaintiff in 1996.<sup>250</sup>

Despite the seemingly in depth description of the term and trademark’s history, this court focused on the lack of genericness in the United States in upholding the trademark.<sup>251</sup> Even though many of the cases from Section II *supra* were cited, the decision selectively picked portions of the cases but ignored the reasonings and overall holdings of those cases and references.

For example, the decision quoted a phrase from *McCarthy on Trademarks* and emphasized the terms “another language” and “other than English” to justify the doctrine did not apply in the instant case.<sup>252</sup> The court then went on to say, “as applied here, the [foreign equivalents] doctrine is simply an expression of the prohibition on allowing a trademark to monopolize a generic term.”<sup>253</sup> However, the foreign equivalents doctrine cannot “simply [be] an expression” prohibiting monopolizing generic terms. *Kellogg* by itself established generic terms cannot be monopolized

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<sup>245</sup> *Id.* at \*4.

<sup>246</sup> 340 F. Supp. 3d 706, 708 (N.D. Ill. 2018). The decision does not identify any specific registered trademark being asserted but identifies the use of “all capital letters (UGG) when referring to the brand or companies Smith founded.” *Id.* at 710 n.4. The decision reviewed a cancelled trademark in Section II.B. for potential fraud before the Trademark Office, but the court found the evidence presented by the defendant to be irrelevant because that mark had already been cancelled and was not being asserted in the instant case. *Id.* at 716–718 (citing ORIGINAL UGG BOOT UGG AUSTRALIA, Registration No. 1,460,992 (cancelled May 30, 2012)).

<sup>247</sup> *See id.* at 712 (“John Arnold sold sheepskin boots (which he referred to as *ugg* boots) in the U.S. in the 1960s and early 1970s, selling thousands of pairs per week.”).

<sup>248</sup> *See id.* at 711 (“The Trademark Office rejected the application [to register UGG as a trademark] because the mark did not ‘serve to identify and distinguish applicant’s goods,’ and Smith did not reapply.”).

<sup>249</sup> *Id.* at 711–12.

<sup>250</sup> *Id.* at 710–13.

<sup>251</sup> *Id.* at \*13–16.

<sup>252</sup> *Id.* at 716.

<sup>253</sup> *Id.* at 715 (quoting 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 12:41 (5<sup>th</sup> ed. 2019)).

without any reference to foreign terms.<sup>254</sup> This court's statement would make the doctrine completely superfluous. Instead the purpose of the doctrine is to prevent *foreign* generic terms from gaining a monopoly in a term in this country.<sup>255</sup>

The decision also cited *Duncan*, referring to the passage that said “[w]hile we conclude that ‘Yo-Yo’ is a word which originated and was used in the Philippine Islands as the generic name of the toy and that the registration of such descriptive term was improper, *we think we should not rest our decision solely on that basis.*”<sup>256</sup> The court interpreted that phrase to mean showing genericness in the country of origin before adopting the mark was not enough to establish the foreign equivalent doctrine.<sup>257</sup> Reading the phrase in a vacuum could potentially lead to that conclusion. However, in the full context of *Duncan*, the earlier court was basically explaining it was taking a “belt and suspenders” approach to its analysis. The *Duncan* court found that the trademark should never have been registered AND Yo-Yo had also become generic in the United States.<sup>258</sup>

Contrary to *Otokoyama* which said, though not binding, foreign trademark decisions can provide strong evidence about genericness<sup>259</sup>, the *Australian Leather* also explicitly disregarded the “legal status of the word ugg in Australia.”<sup>260</sup> The court acknowledged Decker’s trademark had been challenged during a proceeding at the Australian Trade Mark Office<sup>261</sup>, but failed to mention that trade mark office had found the term UGG to be generic.<sup>262</sup> The Australian decision noted The Macquarie Dictionary (1981), The New Shorter Oxford Dictionary (1993), the Dinkum

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<sup>254</sup> See *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 112–23 (1938).

<sup>255</sup> See *Australian Leather*, 340 F. Supp. 3d at 715. (quoting *Otokoyama Co. Ltd. v. Wine of Japan Imp., Inc.*, 175 F.3d 266, 271 (2d Cir. 1999)) (“Under the doctrine of foreign equivalents, one cannot obtain a trademark over a foreign generic word if the trademark designation ‘would prevent competitors from designating a product as what it is in the foreign language their customers know best.’”).

<sup>256</sup> *Id.* at 715. (citing *Donald F. Duncan, Inc. v. Royal Tops Mfg. Co.*, 343 F.2d 655, 661–62 (7th Cir. 1965)) (emphasis added). The court also cited a footnote from *G. Heileman Brewing*, but ignored that decision’s hesitation to protect the Australian term as mentioned in footnote 212 *supra*. *Id.* (citing *G. Heileman Brewing Co. v. Anheuser-Busch, Inc.*, 873 F.2d 985, 1000 n.15 (7th Cir. 1988)).

<sup>257</sup> *Id.*

<sup>258</sup> See *Donald F. Duncan*, 343 F.2d at 661–62, 668.

<sup>259</sup> *Otokoyama*, 175 F.3d at 272–73.

<sup>260</sup> *Australian Leather*, 340 F. Supp. 3d at 716 n.18.

<sup>261</sup> *Id.* at 715.

<sup>262</sup> See *Deckers Outdoor Corporation v B&B McDougal* [2006] ATMO 5 (16 January 2006) 9 (Austl.), <http://www.austlii.edu.au/cgi-bin/viewdoc/au/cases/cth/ATMO/2006/5.html>. That decision said,

The evidence overwhelming supports the proposition that the terms UGH BOOT(S), UG BOOT(S) and UGG BOOT(S) are interchangeably used to describe a specific style of sheepskin boot and are the first and most natural way in which to describe these goods which should innocently come to the minds of people making this particular style of sheepskin boot.

Additionally, *Australian Leather* excluded evidence including telephone books, advertisements, and dictionaries cited by this foreign hearing as inadmissible hearsay and found the declaration to be improperly authenticated. *Australian Leather*, 340 F. Supp. 3d at 715.

Dictionary (1988), The Australian Concise Oxford Dictionary of Current English (1982), and the Oxford English Dictionary Online (2004) all independently recognized one or multiple spellings of *ugg* to be a generic, definable term.<sup>263</sup> Of note, the Macquarie Dictionary is generally held to be the authoritative source for Australian English.<sup>264</sup>

Despite citing *McCarthy on Trademarks*, the decision made no reference to international comity in applying the foreign equivalents doctrine. However, Nick Xenophon, a former Australian senator, began advocating for Australian manufacturers of these boots while still in office.<sup>265</sup> He even traveled to the United States to attend and participate in the jury trial for this case.<sup>266</sup> Though not determinative, the attention of a senior elected foreign officials should be highly informative of the importance to citizens of the associated country. As *Enrique Bernat* explained, companies from the United States expect the same freedom to use our common terms to accurately describe products from our country; therefore, we should not allow companies to monopolize terms from foreign countries.<sup>267</sup>

Finally, the decision's summary of the plaintiff corporation's history mentions, "Deckers spent tens of millions of dollars in advertising campaigns in fashion magazines during the early 2000s . . . and had over \$1 billion in global annual sales every year since 2011."<sup>268</sup> This decision, as with the previous decisions for this plaintiff, does not directly state that company's success and advertising expenses as reasons for upholding the trademark, but including these fact hovers just below the surface of this ruling. However, going all the way back to *Kellogg*, success and advertising expense do not justify continuing protection in a generic trademark.<sup>269</sup> As mentioned in footnote 27 *supra*, Nabisco had spent the equivalent of over 300 million of current U.S. dollars in advertising prior to the Supreme Court striking down that trademark. In the foreign equivalents context, the plaintiff in *Duncan*, sold millions of yo-yos each year for the decades prior to the Seventh Circuit striking down the

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<sup>263</sup> *Deckers Outdoor Corporation v B&B McDougal* [2006] ATMO 5 (16 January 2006) 4.

<sup>264</sup> Sara Tomevska, 'Cheeseslaw' to be immortalised in pages of Macquarie, ABC NEWS (May 9, 2019, 2:44 AM), <https://www.abc.net.au/news/2019-05-02/cheeseslaw-immortalised-in-pages-of-macquarie-dictionary/11062838> ("The Macquarie Dictionary is regarded as the standard reference on Australian English, and selects new words based on their prevalence in the Australian vernacular.").

<sup>265</sup> Anne Barker, *Nick Xenophon calls for law to protect Australian products like Ugg boots, barramundi*, AUSTRALIAN BROADCASTING CORPORATION NEWS, (Aug. 27, 2016, 6:30 PM), <https://www.abc.net.au/news/2016-08-28/nick-xenophon-calls-for-legislation-to-protect-ugg-boots-/7792096>.

<sup>266</sup> Rhett Burnie and Ben Nielsen, *Former senator Nick Xenophon heads to the US to defend Australian Ugg bootmaker*, ABC RADIO ADELAIDE (Apr. 30, 2019, 8:31 PM), <https://www.abc.net.au/news/2019-05-01/nick-xenophon-to-help-defend-ugg-bootmaker-in-trademark-case/11061162>.

<sup>267</sup> See *Enrique Bernat F., S.A. v. Guadalajara, Inc.*, 210 F.3d 439, 445 (5th Cir. 2000).

<sup>268</sup> *Australian Leather*, 340 F. Supp 3d at 712.

<sup>269</sup> *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 119 (1938).

associated trademarks.<sup>270</sup>

## VI. Conclusion

The foreign equivalents doctrine should apply to words and phrases from both English and non-English-speaking countries. Using varying degrees of effort, the decisions in Section IV *supra* each attempted to distinguish terms non-English-speaking countries from those we share a more direct lingual heritage. These decisions each ignore the basic, underlying purpose of the foreign equivalents doctrine. Companies should not be able to monopolize a generic term from a country outside of the United States. Just like generic terms originating in the United States, once a term is in the public domain, any company should be able to use the term to accurately describe their products. Similarly, no company should be able to get protection to exclude other companies from using that term.

Our language in the United States directly owes itself to the colonists that came from England. Nevertheless, our language has evolved based on the experiences and the people that molded this nation over a period of centuries. Similarly, the English language in Australia, Canada, and even England has similarly evolved based on the experiences and people of those nations. As such, the foreign equivalents doctrine should apply equally to terms from Australia as to terms from Japan.

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<sup>270</sup> See Section II.b *supra*, (citing Grelen, *supra* note 81).