When All Else Fails: The Doctrine of Foreign Equivalents as a Bar to Cultural Misappropriation

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WHEN ALL ELSE FAILS: THE DOCTRINE OF FOREIGN EQUIVALENTS AS A BAR TO CULTURAL MISAPPROPRIATION

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INTRODUCTION

In May 2018, Native Hawaiian restaurateur Tasha Kahele was shocked to find a cease-and-desist letter in her mailbox. Kahele owned Aloha Poke Shop in Anchorage, Alaska and had just opened her shop in April. Other native Hawaiians across the country received similar letters ordering them to cease the use of “aloha” or “aloha poke” in their businesses. These letters originated from Chicago-based restaurant Aloha Poke Co. who had retained trademark protection in the wordmark “ALOHA POKE” and its logo “ALOHA POKE CO.” since 2016. As a result, Hawaiian-owned businesses were forced to change their names, including Aloha Poke Shop. Outraged, activist Kalamaokaaina Niheu launched a petition protesting not only Aloha Poke Co.’s actions but the branding itself. The petition charged that Aloha Poke Co. was “capitalizing on an Indigenous traditional dish [it had] no rights to” and trying to “bar [Hawaiians] from using a word in [their] language that has deep cultural meaning and symbolism.” The petition has since received nearly 175,000 signatures.

2. Id.
3. Id.
4. ALOHA POKE, Registration No. 5,031,423; ALOHA POKE CO., Registration No. 5,123,102.
7. Id.
8. Id.
“Aloha” is a native Hawaiian word that is used both as a greeting meaning “hello” and a farewell meaning “goodbye.”\(^9\) Notably, the word also holds cultural significance as a representation of the islands’ way of life.\(^10\) Poke, a cubed fish dish native to the islands, is culturally important to Hawaii as well, ubiquitous in Hawaii before it made its way to the mainland as a foodie fad.\(^11\) Hawaiians have expressed deep frustration at Aloha Poke Co. for commodifying Hawaiian culture and using trademark law to gain legal ownership over Hawaiian cultural products, accusing the Chicago-based chain of cultural misappropriation.\(^12\)

Cultural misappropriation is a pervasive issue in the United States. Though often written off as a “woke” issue and dismissed as oversensitivity, cultural misappropriation remains a latent problem for marginalized communities.\(^13\) Marginalized communities are those that have historically faced discrimination and exclusion.\(^14\) Many members of these communities also belong to diasporic populations who have faced systemic oppression from dominant culture.\(^15\) As such, the misappropriation of their cultural products represents a history of oppression and loss of control.

It should be noted that as of February 2024, Aloha Poke Co. still retains a federal trademark for the wordmark “ALOHA POKE” and a logo including the words “ALOHA POKE CO.”\(^16\) While the forces

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9. Kerr, supra note 5.
10. Id.
12. See Kerr, supra note 5 (quoting Kaniela Ing, Hawaii state representative, “It’s bad enough that [aloha] has been used and commodified over time. But this is next level. To think that you have legal ownership over one of the most profound Hawaiian values - it’s just something else.”).
15. See Chih-Yun Chiang, Diasporic Theorizing Paradigm on Cultural Identity, 19 INTERCULTURAL COMM’C’N STUD, 29, 38 (2010) (“Considered collectively, diasporas refer to displaced populations who usually remain in subordinate positions by established social structures such as racial exclusion or subordinated ethnic status in the new land.”).
of public pressure have been adequate to stop cultural misappropriation before, the case of Aloha Poke Co. suggests that social influence may not always be sufficient. In fact, American law currently does not provide sufficient protections against cultural misappropriation for most cultural communities. While there are legal mechanisms in place to protect certain communities’ cultural products, such as the Indian Arts and Crafts Act, many other cultural communities in the United States remain undefended from registered cultural misappropriation. However, with some alterations to its strictures, the doctrine of foreign equivalents in trademark law may provide some recourse to prevent cultural misappropriation. This doctrine provides a framework for analyzing foreign-language marks and may serve a useful purpose in supporting the protection of marginalized groups’ cultural products in the United States.

This Note argues that under trademark law, the doctrine of foreign equivalents can be utilized to prevent some aspects of legally enforced cultural misappropriation. While it would be impossible to solve cultural misappropriation in one written piece, this Note


18. The United States has mechanisms to protect the cultural products of certain cultures, such as the Indian Arts and Crafts Act of 1990. This is a truth-in-advertising law that prohibits false advertising in the making of Native American art and crafts products in the United States. Individuals and businesses cannot falsely claim that their work is “Indian-produced, an Indian product, or the product of a particular Indian or Indian tribe or Indian arts and crafts organization.” The Indian Arts and Crafts Act of 1990, U.S. DEP’T OF THE INTERIOR, https://www.do.gov/iacb/act [https://perma.cc/EQ2J-2DJT].

19. This Note primarily uses examples of cultural misappropriation against the East Asian community because the author is Chinese American.
proposes that the doctrine can serve to prevent applicants from obtaining trademark protections for certain foreign words.

Part I of this Note provides background on cultural misappropriation and the doctrine of foreign equivalents. Part II argues why the doctrine of foreign equivalents is poised to solve some of the harms of cultural misappropriation both in its structure and purpose. Part III proposes changes to the application of the doctrine that will aid not only in its consistency but also in its prevention of cultural misappropriation. Finally, Part IV discusses potential challenges and limitations to this proposed structure.

I. BACKGROUND

A. Cultural Misappropriation

Cultural appropriation, broadly, refers to the “taking” of intellectual property from a social group that is not one’s own and “replaying it in another with different meanings or practices.” More specifically, in modern parlance, it is discussed more as misappropriation, particularly when dominant groups take and profit from the cultural products of nondominant groups. Cultural products refer to both the tangible and intangible objects belonging to a culture. This taking occurs without permission, “improperly recon-textualiz[ing]” the product by removing it from its original context. While cultural appropriation technically spans a spectrum from respectful cultural borrowing to manipulative profiteering, the use of the term often refers to the latter.


21. Merry, supra note 20, at 586; Sharoni, supra note 20, at 411.

22. Sharoni, supra note 20, at 410.


Cultural misappropriation is particularly harmful to communities in the United States that do not belong to the dominant culture. This harm is multi-level. At the surface, the misappropriation of a cultural product alters the meaning of the product, leading to “both a dilution or misrepresentation of the meaning of [the] cultural product, and a loss of control over that meaning [for the source community].” Moreover, when dominant cultures use cultural products commercially, source communities—the communities from which the cultural products originate—are rarely compensated and may find that the dominant culture’s use is destructive to the significance of that cultural product. Ultimately, the dominant culture’s misappropriation of the subordinate group’s cultural products creates a shift in control over those products and “entrench[es] ‘systems of dominance and control that have been used to colonize, subdue and destroy’ the source community.”

Groups are marginalized when they are “treated as insignificant, unimportant, and unworthy of respect.” As such, these groups have already been denied the types of resources and recognition that majority groups receive and are more susceptible to cultural misappropriation as a result. As will be discussed later in this Note, recognition is an important part of personhood, and the lack of it leads to a sense of “self-negation” and emptiness. This is one reason cultural misappropriation is so harmful. These marginalized groups also consist heavily of members of diasporic communities. While members of the diaspora may not have lived in their “ancestral homeland,” they often still hold sacred the language and culture belonging to that homeland. As such, members of the

26. Id. at 413-14.
27. Id. at 413.
28. Id. at 414 (quoting Rebecca Tsosie, Reclaiming Native Stories: An Essay on Cultural Appropriation and Cultural Rights, 34 Ariz. St. L.J. 299, 311 (2002)).
29. Lalonde, supra note 14, at 331.
30. Id.
31. Id. at 333; see infra Part II.A.3.
33. Id.; see, e.g., Colleen Murphy, What is Cultural Appropriation?, HEALTH (last updated Oct. 25, 2023), https://www.health.com/mind-body/health-diversity-inclusion/what-is-cultural-
diaspora experience simultaneous connection and distance from their cultures in conjunction with the marginalization they experience in their day-to-day lives, leading to greater outrage in response to cultural misappropriation.34 Notably, this explains why Chinese Americans protested when a white eighteen-year-old girl wore a *qipao*35 to her senior prom while those from mainland China viewed it as an act of cultural appreciation.36 For those in mainland China, the dress held no real sacred meaning.37 However, to members of the Asian American community, the traditional Chinese dress was donned atop decades of oppression and marginalization of the Asian American community.38

While cultural misappropriation is a significant problem, it is also one without much solution in the law. There is currently no legal definition for “cultural appropriation,” nor is there one for “cultural misappropriation.”39 As such, there is little to no guidance for identifying when such misappropriation has occurred nor guidance on how to remedy the problem.40 In most instances, the problem is identified and solved by the weight of public influence and opinion.41

34. See Creatrix Tiara, *Asians in Asia View Cultural Appropriation Differently Than You Realize*, THE ESTABLISHMENT (June 19, 2018), https://theestablishment.co/cultural-appropriation-isn't-just-a-western-thing-8e9f9f929237/index.html [https://perma.cc/B4WT-FLY4] (“I think it may offend ‘Australians with Chinese descent’ who have been very much Australianized for several generations. It seems to be a pattern with us [people of color]—that the less connected to our culture we are, the more defensive we get if someone seemingly appropriates an element of it.”).


36. Qin, supra note 35. See also Tiara, supra note 34 (discussing the multitude of views on cultural appropriation across the Asian continent and among the Asian diaspora).

37. Qin, supra note 35.

38. See id.


40. Id.

41. See, e.g., Friedman, supra note 17.
But as the case of Aloha Poke Co. makes uncomfortably clear, public opinion may not be sufficient to prevent or stop cultural misappropriation.

B. Insufficiencies of Intellectual Property Law to Prevent Cultural Misappropriation

There is currently no dedicated legal remedy for cultural misappropriation. Because of this, many have turned to intellectual property law for solutions, particularly copyright and trademark law. However, the existing frameworks for copyright and trademark protection do not quite fit the remedial needs of cultural misappropriation. Most instances of cultural misappropriation occur with regards to broader cultural practices that do not fit into the constraints of trademark or copyright law. Moreover, it is unclear who and what the law should protect. Unfortunately, because these questions are unanswered, intellectual property law provides a tricky fit.

Copyright law, governed by the Copyright Act of 1976, protects only “original works of authorship fixed in any tangible medium of expression.” Cultural products often fail to meet the necessary standards for copyright protection. The cultural product at issue is often not fixed, precluding it from protection as an idea, rather than an expression. Furthermore, copyright protection is offered only for a limited period—the life of the author plus seventy years. Not only are cultural products often very old—lapsing any term of protection—but they often also lack a defined author, as they are usually developed over years of cumulative knowledge. For example, when a white Oregonian woman named Karen Taylor claimed the title “Queen of Congee” and promoted her “improved”

43. Id.
44. See id.
45. Id.
47. Sharoni, supra note 20, at 417.
49. Sharoni, supra note 20, at 417.
rendition of the Asian dish, there was little legal recourse that could be taken against her.\textsuperscript{50} Congee, while a staple in Asian culture, is little more than an idea—a white rice porridge.\textsuperscript{51} Congee originated in China and has been around since at least the Zhou dynasty, around 1,000 B.C., and as such it is nearly impossible to define its “author.”\textsuperscript{52} Because of its historical roots, lack of fixation, and ambiguous authorship, copyright law provided no defense against Karen Taylor’s misappropriation of the Asian dish.\textsuperscript{53}

Cultural products also struggle to fit under trademark protection. Trademark law’s main purpose is to prevent consumer confusion and the “appropriation of a producer’s good will.”\textsuperscript{54} Trademarks ensure authenticity and accuracy, allowing consumers to purchase confidently without research and allowing sellers to invest in their brands without fear of appropriation.\textsuperscript{55} The lack of registration does not prevent the use of a mark, nor does it preclude protection.\textsuperscript{56} However, registration provides significant advantages, particularly in proving distinctiveness.\textsuperscript{57} For source communities, registration may not be appropriate or even possible. Cultural products subject to cultural misappropriation are rarely concretely defined enough to have a mark to register.\textsuperscript{58} Furthermore, trademark laws exist to promote dissemination, which is the exact ill source communities

\textsuperscript{50} Lauren Frias, A White Woman Who Claimed to Be the ‘Queen of Congee’ Apologized Following Criticism of Cultural Appropriation But Continues to Sell Her ‘Improved’ Version of the Asian Dish, INSIDER (July 22, 2021, 9:54 PM), https://www.insider.com/white-woman-dubbed-queen-of-congee-apologized-for-cultural-appropriation-2021-7 [https://perma.cc/VTZ5-ZJX7].

\textsuperscript{51} See id.


\textsuperscript{53} See 17 U.S.C. §§ 102, 302(a).

\textsuperscript{54} Sharoni, supra note 20, at 421.

\textsuperscript{55} Id.


\textsuperscript{57} Sharoni, supra note 20, at 426. Trademark law assesses the distinctiveness of marks according to the Abercrombie scale, which categorizes marks as: (1) generic; (2) descriptive; (3) suggestive; or (4) arbitrary or fanciful. Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4, 9 (2d Cir. 1976). Generic marks are generally given no trademark protection and arbitrary or fanciful marks are given the greatest level of protection. Id. Notably, the lines between these categories are “not always bright.” Id.

\textsuperscript{58} See Sharoni, supra note 20, at 417.
may be trying to defeat.59 While encouraging source communities to obtain registration for cultural products seems to create a legal remedy at the outset, the framework is likely too awkward to truly target the problem.

It should be noted that prior to 2017, the Lanham Act provided a bar to trademark registration for marks that “may disparage” and those that are “immoral ... or scandalous.”60 However, in Matal v. Tam, the Supreme Court declared the Disparagement Clause of the Lanham Act unconstitutional as a violation of free speech under the First Amendment.61 Similarly, in Iancu v. Brunetti, the Supreme Court invalidated the prohibition of “immoral or scandalous” marks on First Amendment grounds as well.62 The removal of these statutory bars, while consistent with the Constitution, removed perhaps the only existing stop block to legally-enforced cultural misappropriation. Notably, the decision in Matal v. Tam enabled the Washington “Redskins” to reinstate their trademark registration, despite their mark including a racial slur against Native Americans.63

However, a possible legal solution for a small subset of cultural misappropriation may lie in a unique, unsolidified test within trademark law—the doctrine of foreign equivalents.

C. The Doctrine of Foreign Equivalents

The doctrine of foreign equivalents, put simply, prevents putative trademark registrants from obtaining protection over foreign language marks that, when translated to English, are merely generic or descriptive.64 This is also used to determine whether the proposed mark is too similar to an existing registered mark.65 For

59. See id. at 427.
64. See 4 McCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23:36 (5th Ed.) [hereinafter “McCARThY”].
example, in *Otokoyama Co. v. Wine of Japan Import, Inc.*, the court held that “otokoyama” was a generic Japanese term that referred to a type of sake, a Japanese rice wine.66 This genericness, the court said, precluded “otokoyama” from trademark protection because under the Lanham Act, there is no protection for generic marks.67

This doctrine is not a rigid rule applied by courts, but only “a guideline.”68 As such, trademark examiners and judges have rather wide discretion whether they apply the test at all.69 The test exists as a method of assessing the potential for consumer confusion, particularly in an increasingly multilingual United States.70

1. Application of the Doctrine

The test is essentially applied in three steps. The first step is to decide whether the foreign language at issue is a common language.71 If it is a common language, the examiner or judge considers whether the ordinary American consumer familiar with the language would be likely to “stop and translate” the mark.72 If the mark passes these first two steps, the doctrine applies, and the examiner must determine whether the English translation is “distinctive according to the Abercrombie spectrum, ... whether it is confusingly similar to any other registered marks,” and whether it passes the tests for “descriptiveness, geographic descriptiveness, and mis-descriptiveness.”73 If the mark is found to lack the requisite distinctiveness, the mark will not be registrable.74 This means that if a foreign-language mark is “arbitrary or fanciful,” bearing no

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66. 7 Fed. App’x. 112, 115 (2d Cir. 2001).
67. Id. at 114-15.
68. Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772, 396 F.3d 1369, 1377 (Fed. Cir. 2005).
71. Merante, *supra* note 65, at 324.
72. Id.
73. Id.; McCarthy, *supra* note 64, at § 11:34 (internal citations omitted); see *supra* note 57 and accompanying text.
74. See Merante, *supra* note 65, at 323.
clear relationship with the product it applies to, it will likely be registrable.\footnote{75 See Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4, 9 (2d Cir. 1976).}

\textit{i. Is It a Common Language?}

Under the doctrine of foreign equivalents, “common” language refers to modern languages.\footnote{76 See Merante, supra note 65, at 323.} Courts have held that it is not disqualifying if only a small percentage of Americans speak that language.\footnote{77 See In re Thomas, 79 U.S.P.Q. 2d 1021 (T.T.A.B. 2006).} In \textit{In re Thomas}, the applicant was applying to register the mark “MARCHE NOIR” and contended that the doctrine of foreign equivalents did not apply because the 1990 U.S. Census showed that only 0.6 percent of the United States population spoke French “very well” or “well.”\footnote{78 Id.} This, the applicant reasoned, meant that the “average American buyer [did] not speak French.”\footnote{79 Id.} The Trademark Trial and Appeal Board (“TTAB” or “the Board”) rejected that reasoning, pointing to a prior case in which the TTAB refuted the same argument, stating that “it [did] not require any authority to conclude that Italian is a common, major language ... spoken by many people in the United States.”\footnote{80 Id. (quoting In re Ithaca Industries Inc., 230 U.S.P.Q. 702, 703 (T.T.A.B. 1986)).} Examples of these common, modern languages include Chinese, French, German, Greek, Hungarian, Italian, Japanese, Polish, Russian, Serbian, Spanish, and Yiddish.\footnote{81 2 M CCARTHY, supra note 64, § 11:34.}

\textit{ii. Is It Likely that the Ordinary American Purchaser Would “Stop and Translate” the Word into Its English Equivalent?}

This step in the process has the weakest established standard. Ultimately, the issue turns on “whether, to those American buyers familiar with the modern foreign language, the word would denote its English equivalent.”\footnote{82 Id. § 23:36.} However, this standard has been applied
inconsistently. For example, in Continental Nut Co. v. Le Cordon Bleu, appellee, Le Cordon Bleu, S.A.R.L., opposed Continental Nut Co.’s registration of the mark “CORDON BLEU” for edible, shelled nuts. Continental Nut Co. argued that because they already had the registered mark “BLUE RIBBON,” they were entitled to protection for its direct French translation, “Cordon Bleu.” However, despite this direct translation, the court decided that “Cordon Bleu” had an independent meaning to the American public, creating a separate commercial impression. As such, it was unlikely that the American public would stop to translate “LE CORDON BLEU” to “Blue Ribbon” because “Cordon Bleu” was already a phrase in the English dictionary. This meant that Continental Nut Co. was not entitled to the translation of its existing mark. In contrast, in In re American Safety Razor Company, the Board decided that American consumers were likely to stop and translate the mark “BUENOS DIAS” soap to “good morning.” In that case, the same argument was made that “buenos dias” was such a common phrase that those familiar with the phrase would not even translate it to English. Despite using similar reasoning, the Board reached opposite results.

iii. Is It Distinctive?

Once the Trademark Examiner or the Board has established whether the average American consumer is likely to stop and translate the foreign language word, the next step is an analysis of whether the phrase is sufficiently distinctive according to the

83. Le Cordon Bleu is a French company that provides cooking educational services. 494 F.2d 1395, 1395-96 (C.C.P.A. 1974).
84. Id.
85. Id. at 1396.
86. Id.
87. Id. at 1397.
88. Id. Compare with In re Tia Maria, Inc., 188 U.S.P.Q. 524 (T.T.A.B. 1975) (holding that in distinguishing “TIA MARIA” and “AUNT MARY’S” there would be no likelihood of confusion because “[i]t there are foreign expressions that those familiar with language will accept without translating”).
90. Id.
91. See id.
If the Board or court finds that the foreign-language mark is merely generic or descriptive in that language, the Board will bar the mark from registration as a trademark. Moreover, in infringement cases, courts also decide whether, when translated, the foreign-language mark is likely to cause consumer confusion with an existing English-language mark. This analysis also applies in the inverse—whether a putative English mark will cause consumer confusion with an existing foreign-language mark.

II. THE DOCTRINE OF FOREIGN EQUIVALENTS AS A BAR TO CULTURAL MISAPPROPRIATION

The doctrine of foreign equivalents, if defined more clearly and applied more strictly, can be used as a bar against certain types of legally enforced cultural misappropriation in trademark registration. This Part outlines the specific problems that cultural misappropriation scholarship identifies and how the purposes behind the doctrine of foreign equivalents fit comfortably in solving some of those issues.

A. Identified Problems with Cultural Misappropriation

“Love our people like you love our food.” Similar sentiments adorned protest signs as anti-Asian violence soared during the COVID-19 pandemic. For centuries, Asian Americans have watched as their cultural products, from Chinese food to yoga, have transformed from being “other” and foreign to novel and mainstream.
For over a century, Chinese food has been seen as cheap and convenient, all the while losing its original features and assimilating to fit American palates. Meanwhile, members of dominant culture like Karen Taylor are able to “discover[]” the value of Chinese-originated congee and profit off of it while Asian Americans are assaulted for simply being Asian.

Cultural misappropriation scholars have identified significant problems with cultural misappropriation, including (1) the severe imbalance of power between those who appropriate and the source communities whose cultures they are appropriating; (2) the exploitation and commodification of source communities’ cultural products; and (3) the lack of source community recognition.

1. Imbalance of Power

A major problem with cultural misappropriation is the way in which it exacerbates the existing imbalances of power between dominant and marginalized groups. Marginalized groups already lack the same privileges of self-expression that dominant groups enjoy. While dominant groups benefit from the use of cultural products without loss of their own culture, marginalized groups are forced to assimilate to dominant culture and continue to face greater and greater loss of their culture over time. Thus, the use of their culture by dominant groups further erodes opportunities for self-expression and removes ownership from the source community.

2. Commodification and Exploitation

Another issue with cultural misappropriation is the way in which dominant groups exploit and commodify marginalized groups’ cultural products. This occurs when a dominant culture takes the cultural product of a marginalized community and utilizes it for the
dominant culture’s financial benefit. 112 Through this process of exploitation, source communities’ cultures are distorted and misrepresented. 113 An example of this distorting commodification can be found in Disney’s commercial use of the Swahili phrase “hakuna matata.” Disney Enterprises, Inc. registered the Swahili language phrase in 2003 and has retained trademark protection for its use on T-shirts. 114 “Hakuna matata” means “no worries” in Swahili and is a commonly-used phrase in East African communities. 115 Members of those communities have expressed outrage over the monetization of the phrase, as the saying is as common in Swahili as “good morning” is in English. 116 And yet, a Burbank, California-based corporation is able to claim ownership of and profit off of this mainstay of East African culture. 117 As outlined in this Part, a stricter application of the doctrine of foreign equivalents could have prevented Disney from obtaining registration over “hakuna matata” in the first place. 118

3. Lack of Recognition

A third major ill of cultural misappropriation is the lack of recognition for the source culture. Dianne Lalonde divides recognition harms into two types: non-recognition and mis-recognition. 119 According to political and social theorists, our identities are partly shaped by recognition, and as such, the absence of that recognition can cause real harm. 120 When cultural misappropriation occurs,
cultural property ownership claims are ignored and source communities are denied recognition.121 Furthermore, misappropriation exacerbates the problem of invisibility that marginalized groups already experience.122 While members of dominant and majority groups enjoy abundant representation in media and culture, marginalized groups do not have that same luxury.123 As such, when marginalized groups have their cultural products misappropriated by dominant groups, they watch their culture and recognition fade more and more.124

B. The Aid of the Doctrine

The stated purposes of the doctrine of foreign equivalents suggest that the doctrine may be well-suited to prevent some instances of cultural misappropriation in trademark law. Some of these purposes include (1) the promotion of diversity in the marketplace; (2) respect for an increasingly multilingual American public; and (3) international comity.125

As outlined in Part I, one of the doctrine of foreign equivalents’ central purposes is respect for and the promotion of diversity in the commercial marketplace.126 Trademark law seeks to prevent merchants from obtaining exclusive ownership over generic words in English.127 Otherwise, merchants could exclude competitors from the market. For example, trademark law would preclude an apple grower from registering “APPLE” as a mark because it does nothing more than indicate the product the merchant is selling.128 Furthermore, it would prevent other apple growers from entering the market because “apple” is a necessary word for apple growers to market apples.129

121. Id.
122. See id.
123. Id.
124. See Merante, supra note 65, at 324-25.
125. See supra Part I.
126. See supra Part I.
127. See Otokoyama Co. v. Wine of Japan Import, Inc., 175 F.3d 266, 271 (2d Cir. 1999).
128. See Vision Ctr. v. Opticks, Inc., 596 F.2d 111, 115 (5th Cir. 1979) (defining generic marks as those that are “the name of a particular genus or class of which an individual article or service is but a member”).
129. See Union Carbide Corp. v. Ever-Ready, Inc., 531 F.2d 366, 379 (7th Cir. 1976).
The doctrine of foreign equivalents extends this logic to foreign-language marks as well. In Otokoyama, the Second Circuit emphasized that this purpose was necessary because of the diversity of customers in the United States, resting on the assumption that “there are ... customers in the United States who speak that foreign language.”\(^{130}\) This focus on the multilingual public helps to resolve some of the power imbalance that plagues cultural misappropriation.\(^{131}\) By ensuring that foreign-language marks are given the same credence as English-language marks and not simply given blanket protection as “fanciful” marks, the doctrine demonstrates significant respect for the communities from which these languages originate.\(^{132}\) The doctrine also provides recognition to foreign language speakers, many of whom belong to marginalized communities.\(^{133}\)

Another important and useful purpose behind the doctrine of foreign equivalents is the principle of international comity, offering fair international treatment to foreign-language marks.\(^{134}\) Historically, the United States has attempted to bar foreign registration of English generic marks because “U.S. companies would be hamstrung in international trade if foreign countries granted trademark protection to generic English words.”\(^{135}\) As such, the United States reciprocates by barring generic foreign-language marks from obtaining trademark protection.\(^{136}\) In Enrique Bernat F., S.A. v. Guadalajara, Inc., the plaintiff who owned the lollipop brand Chupa Chups attempted to enjoin the defendant from the use of its mark “CHUPA GURTS.”\(^{137}\) The issue surrounding the marks was the use of the word “chupa,” which translates to “lollipop” in Spanish, though it is also a form of the verb “chupar,” which means “to lick” or “to suck.”\(^{138}\) Although the word has multiple possible translations into English, that court held that “chupa” was a general designation of “lollipops” because that is what the average Spanish-speaking

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130. Otokoyama, 175 F.3d at 270-72.
131. See Arya, supra note 101, at 4.
132. See Otokoyama, 175 F.3d at 271.
133. See Lalonde, supra note 14, at 331 (noting that marginalized groups are “particularly susceptible to cultural appropriation” when they are denied recognition).
134. See Merante, supra note 65, at 324-25.
136. Id.
137. Id. at 441.
138. Id. at 443.
consumer would understand it to mean. Moreover, the court acknowledged that if it were to allow the plaintiff to monopolize “chupa,” it would inherently reduce competition by shutting out other Mexican candymakers in the United States, “[j]ust as [it did] 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.” This recognition and mutually-respectful treatment of foreign-language marks inherently serves an equalizing purpose, helping to resolve one of the ills of cultural misappropriation.

Although registration is not required for someone to use a mark, it is socially valuable to bar registration of marks that misappropriate culture. Not only does it send a message to putative registrants that culturally exploitative marks will not be legally endorsed, but it also communicates to source communities that their cultural products are worthy of protection.

III. PROPOSED MODIFICATIONS TO THE DOCTRINE

As it currently stands, the doctrine of foreign equivalents is merely a guideline that courts, trademark examiners, and the Trademark Trial and Appeal Board have discretion to follow. However, because it is a guideline and not a rule, the doctrine is applied very inconsistently. For the doctrine of foreign equivalents to not only be a more useful legal doctrine but also more effectively prevent cultural misappropriation in trademark registration, the doctrine must be modified. This includes modifying not only Supreme Court and legislative guidance but also refining the relevant section of the Trademark Manual of Examining Procedure (TMEP).

139. Id. at 444.
140. Id. at 445.
141. TMEP § 1207.01(b)(vi)(A) (July 2022). The Trademark Manual of Examining Procedure (TMEP) is a manual that provides guidelines and procedures that trademark examining attorneys are to follow when examining trademark applications. TMEP Foreword (July 2022).
143. See TMEP § 1207.01(b)(vi) (July 2022).
more clearly outlining the definitional contours of the doctrine. This includes clearly defining “common language,” requiring a consideration of foreign-language words in their cultural context, and applying a more generous understanding of confusion.

A. Define “Common Language” and the “Ordinary American Purchaser”

The first necessary modification is creating a clear definition for “common language,” thus establishing when the doctrine should apply. The Board in In re Thomas defined the “ordinary American purchaser” as a person who is familiar with the language.144 However, in In re Spirits International, N.V., the Federal Circuit indirectly abrogated the standard, changing it to any average American, regardless of whether that purchaser speaks the foreign language.145 In that opinion, the court made a point of emphasizing that the “ordinary American purchaser” was not limited to those unfamiliar with non-English languages but specifically that it included those proficient in non-English languages and “would ordinarily be expected to translate words into English.”146 However, a logical corollary of that argument is that to find the average of what American purchasers would be familiar with, courts would also necessarily need to include those unfamiliar with the non-English language, broadening the scope and reducing the resulting average familiarity with that language.147 As such, it would become less likely that the standard would apply.148 The standard should revert to the one outlined in In re Thomas, assessing whether the average American who speaks the foreign language would stop to...

145. 563 F.3d 1347, 1352 (Fed. Cir. 2009) (holding that the “ordinary American purchaser ... includes all American purchasers’’); Krimnus, supra note 142, at 178. Decisions by the Trademark Trial and Appeal Board are precedential if they establish or modify existing rules of law and are controlling legal authority “unless modified or overruled by a later statute, regulation, or TTAB precedent or upon judicial review.” Designation of TTAB Decisions as Precedential, USPTO (Nov. 2018), https://www.uspto.gov/sites/default/files/documents/Designation%20Precedential_Public_Nov2018_Final.pdf [https://perma.cc/ZFV4-PZ7D].
146. In re Spirits N.V., 563 F.3d at 1352.
147. See id.
148. See id.
translate the mark.  

This change not only accounts for the increasing linguistic diversity in the United States, but from a policy perspective, it demonstrates equal respect to all foreign-language speakers. Notably, this generous definition of “common language” can provide essential protection to more cultural products. For instance, in a non-precedential case, the TTAB decided that Hawaiian was not common enough for the doctrine of foreign equivalents to be invoked.  

In that case, In re Fahey, the trademark examiner found that the putative mark, “SUNRISE,” for guitar picks was confusingly similar to a Hawaiian-language registered mark for guitar picks, “PUKANA LA,” which translates to “sunshine, sunrise.”  

The Board rejected that argument, holding that Hawaiian was not spoken by a significant enough portion of the population to cause confusion between the two marks. While this opinion is not TTAB precedent, it demonstrates the rather wide discretion the Board has and how potentially detrimental this discretion can become. The decision that Hawaiian is not a “common” language is inconsistent with the rationale behind the doctrine and also disregards the importance of the language to its speakers. Restricting the doctrine to only languages that an appreciable number of the U.S. population speaks ignores the United States’ linguistic and cultural diversity. It also allows the exploitation of foreign language words that otherwise would not be entitled to trademark protection. For example, if Hawaiian had been found to be a common language and the doctrine been applied to “Aloha Poke,” it is unlikely that Aloha Poke Co. could have registered their mark. “Aloha Poke” is merely descriptive of the Hawaiian cuisine, akin to “Texas BBQ.”

149. See In re Thomas, 79 U.S.P.Q.2d at 1024.
151. Id. at 1-2.
152. Id. at 3.
153. See generally id.
B. Consider “Shades of Meaning”

Another adjustment that should be made to solidify the doctrine of foreign equivalents is that words with “shades of meaning” should still trigger the doctrine. Furthermore, the potential genericness or confusion of a mark should be evaluated in the context of the cultures who speak that language. In the current TMEP, to determine if the doctrine applies to a putative foreign-language mark, the examiner must evaluate the word’s translation to English and whether that translation is literal and direct. The TMEP states that the doctrine does not apply if there is evidence of other “shades of meaning” or relevant meanings that exist. In contrast, the jurisprudence surrounding the issue has not adopted so narrow a standard. The court in *Otokoyama* held that “otokoyama,” despite literally meaning “man/mountain,” was a generic Japanese term for “sake.” The court reasoned that a Japanese-speaking consumer in America would be familiar with “otokoyama” being a designation of sake, and granting trademark protection for the term would hinder competing merchants seeking to enter the American sake market.

The TMEP standard is unreasonably strict and does not account for the nuance of language and culture. Even when there is no literal and direct translation of a foreign-language word to English, speakers of that foreign language may still stop and translate that word and become confused. As such, the TTAB should update the TMEP standard to consider “shades of meaning,” with the ultimate goal of finding the English translation that fully reflects the true meaning of the word. Furthermore, the rule generally should be that courts, examiners, and the Board alike should consider the nuances and cultural contexts of the mark to decide if and how the doctrine applies. In doing so, the updated rule will help prevent

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155. TMEP § 1207.01(b)(vi) (July 2022).
156. See id. § 1207.01(b)(vi)(B).
158. *Otokoyama*, 175 F.3d at 272.
159. See Krimnus, supra note 142, at 185.
marks that culturally misappropriate from escaping notice simply because they do not have a direct and literal translation.

It should be noted that as the doctrine currently stands, it cannot prevent the registration of arbitrary, fanciful, or suggestive foreign-language marks. This means that even when the doctrine applies, if the words are translated and are still found to bear “no relationship to the products or services to which they are applied,” they may be registered and receive protection. As such, the doctrine would prevent the registration of “MANZANA” as applied to apples but would not stop more egregious forms of cultural misappropriation. For this reason, socialite Kim Kardashian was able to register “KIMONO” and its variations for her lingerie brand: the mark, describing Japanese traditional clothing, bore no direct relationship with the products it was applied to—shapewear and undergarments. Therefore, despite the cultural and historical significance of the kimono in Japanese culture, Kardashian was able to co-opt the word to market and profit off her line of lingerie.

By modifying the doctrine to consider shades of meaning in their cultural context, instances of registered cultural misappropriation could be prevented. Furthermore, applying a more expansive understanding of when a term is “generic” to foreign-language marks could provide a solution as well. In the case of Kardashian’s mark, the examiner could have interpreted the class of product to be

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162. “Manzana” is the Spanish word for “apple.” Because it is simply descriptive of the product itself, it will likely be classified as “generic” under Abercrombie. See Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4, 9 (2d Cir. 1976).
163. See supra notes 74-75 and accompanying text; Zatarains, 698 F.2d at 791; see, e.g., KIMONO, Serial No. 88,479,867 (Abandoned); KIMONO BODY, Serial No. 88,468,425 (Abandoned); KIMONO INTIMATES, Serial No. 87,886,659 (Abandoned); KIMONO SOLUTIONWEAR, Serial No. 88,380,839 (Abandoned); KIMONO WORLD, Serial No. 88,331,282 (Abandoned). Kardashian has since changed the brand name to “SKIMS Solutionwear.” Mehera Bonner, Kim Kardashian Finally Changed Her Solutionwear Name, So It’s Not “Kimono” Anymore, COSMOPOLITAN (Aug. 26, 2019), https://www.cosmopolitan.com/entertainment/a28197739/kim-kardashian-kimono-trademark-backlash/[https://perma.cc/BY3E-GSXY](https://perma.cc/BY3E-GSXY) (quoting Kardashian) (“My fans and followers are a huge inspiration to me—I’m always listening to their feedback and opinions, and I am so grateful they shared their ideas for a new brand name.”).
“clothes” more generally. Thus, “kimono,” literally translated into “wearing thing” in Japanese, could have potentially been interpreted to be a generic term for what Kardashian’s mark applied to. As such, it would not require the examiner, the Board, or the courts to make a content-based moral judgment (as prohibited in Tam and Brunetti), but simply consider whether the term has a generic definition in its cultural context. While this example is perhaps an oversimplification and optimistic interpretation of the doctrine’s application, it demonstrates how the doctrine can be adapted to help prevent some instances of legally-enforced cultural misappropriation.

C. Apply a More Generous Understanding of Confusion

Considering the issues outlined above, the doctrine should also apply a more generous standard for confusion. As the current standard for when a person would stop and translate the mark is vague and unclear, it should be broadened in light of an increasingly multilingual public. When foreign-language marks are submitted for registration, examiners should assume more often than not that American purchasers will stop to translate the mark. Moreover, the standard for confusion should be more lenient. For example, in the “TIA MARIA” case, the Board concluded that there are words and phrases “even those familiar with the language [would] not trans-

165. See supra note 163 and accompanying text.
166. See supra note 164 and accompanying text.
language marks. Not only does this fit within the stated purposes of the doctrine, but it also ensures that more potentially culturally misappropriative marks are barred from registration.  

IV. POTENTIAL CHALLENGES

Perhaps the most effective form of preventing cultural misappropriation in trademark registration would have been an expansion of the statutory bar against disparaging and offensive marks. In the wake of Tam and Brunetti, however, content-based evaluations of marks are all but written out of the Lanham Act. 

Although the doctrine of foreign equivalents is well-suited to prevent language-based cultural misappropriation, there are notable issues that likely will arise from this proposed solution.

A potential counterargument to this Note’s proposal is that a strict application of the doctrine would stifle creativity. Bringing foreign-language words into the registration analysis and applying a stricter standard to those potential marks could greatly limit the scope of potential marks. Notably, however, this proposal instead makes it harder to culturally misappropriate and forces putative registrants to work around potentially exploitative marks. While this change certainly limits the availability of words that can be used, it is perhaps a worthy price to pay if it protects and gives respect to marginalized communities.

A second potential issue with this proposal is the First Amendment issues that may come into play. By proposing a stricter assessment of foreign-language marks, it could be argued that in defiance of Tam and Brunetti, the proposal requires examiners to make decisions based on viewpoint and content. However, the alleged evaluations of “content” in this proposal fall within the bounds of trademark law generally. They do not recommend making moral judgments on marks but rather apply more generous understandings of when foreign-language marks lack the requisite distinctiveness that trademark law requires. By suggesting that

169. See supra Part II.B.
170. See generally Tam, 582 U.S. at 243-44; Brunetti, 139 S. Ct. at 2294.
171. See Merante, supra note 65, at 325.
172. See Tam, 582 U.S. at 243; Brunetti, 139 S. Ct. at 2299.
evaluators consider the contours of cultural understandings of foreign-language words to evaluate distinctiveness, this proposed solution simply ensures that these decisions are not merely made through an Anglo-centric lens.

Finally, a major question is whether this is an issue meant for the law to solve at all. In many instances of public cultural misappropriation, social pressures are usually enough, resolving the issue by shaming those accused of misappropriation into submission. Kim Kardashian abandoned her “KIMONO” line of trademarks after a Change.org petition accused her of disrespecting Japanese culture by linking underwear with the culturally symbolic garment.\textsuperscript{173} The creators of “The Mahjong Line” released a lengthy apology for neglecting to pay respect to Chinese culture after they received significant backlash for their attempts to capitalize off of a cultural product that was not of their own heritage.\textsuperscript{174} If the weight of societal influence has proven to be effective, is there a reason the law needs to step in at all?

While public outrage has been successful in the past, it is still clear that such a reactive solution is not enough. Chicago-based Aloha Poke Co. still holds its registered trademarks and in 2019, announced its plan to add an additional 100 locations by 2022.\textsuperscript{175} Furthermore, the company denounced any accusations of claiming ownership over the words “aloha” and “poke,” defending its actions as “attempt[ing] to stop trademark infringers in the restaurant industry from using the trademark ‘Aloha Poke’ without permission.”\textsuperscript{176} By leaning on the rights provided to it by the contours of

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\footnote{173. Fukunishi, \textit{Say No to Kim Kardashian’s “KIMONO” #KimOhNo}, supra note 17; Fukunishi, \textit{Kim Announced New Name/Trademarks Withdrawn}, supra note 17.}
\end{footnotesize}
trademark law, Aloha Poke Co. has been able to escape real accountability for its exploitation of Hawaiian culture. If trademark law still allows registrants to obtain protection for culturally misappropriative marks, there is little to no recourse for source communities. As such, the law ought to step in before such misappropriation even occurs, preventing more harm to marginalized communities.

CONCLUSION

While cultural misappropriation is a problem that certainly will not be solved overnight and perhaps not even by the law, the doctrine of foreign equivalents may serve to prevent at least a sliver of its ills. Cultural misappropriation is an issue that merits attention by the law and is an evil that should not be perpetuated by the law. Marginalized groups deserve to have their cultures protected, and crafting solutions to prevent the exploitation of their cultural products is just one small, but essential, step in dismantling the power imbalances that stand in the way. Tucked away in a loose and rarely used doctrine may hopefully be the beginnings of that solution.

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177. See id.

* J.D. Candidate, 2024, William & Mary Law School; B.A. Foreign Affairs and Media Policy & Ethics, 2019, University of Virginia. Writing this Note was a deeply personal affair—tackling an issue that seems small to most, but one that has held much significance in my experience as an Asian American. A special thank you to the staff of the William & Mary Law Review, including my Notes editor Peter Quinn, whose efforts made this possible. I am grateful also to Thomas Lingard for providing valuable feedback as well as Professor Laura Heymann whose brilliant insights sparked the idea for this Note. Thank you to my incredible sister, Joanna Soh, for being my biggest cheerleader. I am also eternally grateful for the unending support of my husband, Kyle Dalton, for reading draft after draft of this Note and for being by my side through the entire journey. And finally, thank you to my parents, Teck Eng Soh and Yiwei Wang, for courageously immigrating to this country, laying the groundwork for my future, and making me an Asian American.