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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.¹ Kahele owned Aloha Poke Shop in Anchorage, Alaska and had just opened her shop in April.² Other native Hawaiians across the country received similar letters ordering them to cease the use of “aloha” or “aloha poke” in their businesses.³ 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 2016.⁴ As a result, Hawaiian-owned businesses were forced to change their names, including Aloha Poke Shop.⁵ Outraged, activist Kalamaokaaina Niheu launched a petition protesting not only Aloha Poke Co.’s actions but the branding itself.⁶ 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.”⁷ The petition has since received nearly 175,000 signatures.⁸

1. Emily Russell, *National Chain Forces Native Hawaiian to Drop “Aloha Poke” from Anchorage Restaurant*, ALASKA PUB. MEDIA (Aug. 1, 2018), <https://alaskapublic.org/2018/08/01/national-chain-forces-native-hawaiian-to-drop-aloha-poke-from-anchorage-restaurant/> [<https://perma.cc/W8NN-SPMX>].

2. *Id.*

3. *Id.*

4. ALOHA POKE, Registration No. 5,031,423; ALOHA POKE CO., Registration No. 5,123,102.

5. Breana Kerr, *Outrage as Aloha Poke Co Tells Hawaiians to Stop Using ‘Aloha’ with ‘Poke’*, THE GUARDIAN (July 31, 2018, 7:56 AM), <https://www.theguardian.com/us-news/2018/jul/31/aloha-poke-co-cease-and-desist-letter-hawaiians-aloha> [<https://perma.cc/L5F7-PHTH>]; Audrey McAvoy, *Hawaii Pushes Back After Chicago Restaurant’s ‘Aloha Poke’ Trademark: ‘They Need to Have Some Cultural Sensitivity’*, CHI. TRIB. (Apr. 19, 2019, 7:30 AM), <https://www.chicagotribune.com/business/ct-biz-hawaii-aloha-poke-trademark-20190419-story.html> [<https://perma.cc/A7ZW-GJB6>].

6. Kalamaokaaina Niheu, *Aloha Poke Co, Remove “Aloha” and “Poke” From Your Name*, CHANGE.ORG, <https://www.change.org/p/levy-family-partners-aloha-poke-co-remove-aloha-and-poke-from-your-name> [<https://perma.cc/HW5M-6H5S>].

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

9. Kerr, *supra* note 5.

10. *Id.*

11. Soleil Ho, *The Chicago Poke Chain That Tried to Stop Hawaiian Businesses from Using the Word “Aloha”*, THE NEW YORKER (Aug. 10, 2018), <https://www.newyorker.com/culture/annals-of-gastronomy/the-chicago-poke-chain-that-tried-to-stop-hawaiian-businesses-from-using-the-word-aloha> [<https://perma.cc/6A8Y-TEPF>].

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.”).

13. See Jenni Avins & Quartz, *The Dos and Don’ts of Cultural Appropriation*, THE ATLANTIC (Oct. 20, 2015), <https://www.theatlantic.com/entertainment/archive/2015/10/the-dos-and-donts-of-cultural-appropriation/411292/> [<https://perma.cc/9NM5-WVL7>].

14. See Dianne Lalonde, *Does Cultural Appropriation Cause Harm?*, 9 POL., GRPS., AND IDENTITIES 329, 331 (2021).

15. See Chih-Yun Chiang, *Diasporic Theorizing Paradigm on Cultural Identity*, 19 INTERCULTURAL COMM’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.”).

16. See *supra* note 4.

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.¹⁷ 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.¹⁸ 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.¹⁹ While it would be impossible to solve cultural misappropriation in one written piece, this Note

17. For example, in 2019, Kim Kardashian attempted to launch her lingerie and shapewear line under the name "KIMONO" as a play on her name. She registered eight trademarks under the name. Kardashian faced swift backlash, including a petition from the Japanese community expressing outrage over her use of the word for the traditional Japanese garment to sell underwear. The petition accused Kardashian of cultural misappropriation and disrespect for Japanese culture. By August 2019, all eight trademarks were marked "dead" on the United States Patent and Trademark Office's Trademark Database, and the petition branded a "victory." Vanessa Friedman, *Kim Kardashian West and the Kimono Controversy*, N.Y. TIMES (June 27, 2019), <https://www.nytimes.com/2019/06/27/fashion/kim-kardashian-west-kimono-cultural-appropriation.html> [https://perma.cc/3EF3-P3G9]; Sono Fukunishi, *Say No to Kim Kardashian's "KIMONO" #KimOhNo*, CHANGE.ORG (June 27, 2019), <https://www.change.org/p/kim-kardashian-west-say-no-to-kim-kardashian-s-kimono-kimohno> [https://perma.cc/H6Q4-B6U4]; Sono Fukunishi, *Kim Announced New Name/Trademarks Withdrawn*, CHANGE.ORG (Aug. 27, 2019), <https://www.change.org/p/kim-kardashian-west-say-no-to-kim-kardashian-s-kimono-kimohno/u/24999533> [https://perma.cc/J5PN-2SDP].

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.doi.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.”²⁰ 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.²¹ Cultural products refer to both the tangible and intangible objects belonging to a culture.²² This taking occurs without permission, “improperly recontextualiz[ing]” the product by removing it from its original context.²³ While cultural appropriation technically spans a spectrum from respectful cultural borrowing to manipulative profiteering, the use of the term often refers to the latter.²⁴

20. Sally Engle Merry, *Law, Culture, and Cultural Appropriation*, 10 YALE J.L. & HUMANS. 575, 585 (1998); Sari Sharoni, *The Mark of Culture: The Efficacy and Propriety of Using Trademark Law to Deter Cultural Appropriation*, 26 FED. CIR. B.J. 407, 409 (2017).

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

22. Sharoni, *supra* note 20, at 410.

23. *Id.* at 409-10 (quoting Rosemary J. Coombe & Nicole Alywin, *The Evolution of Cultural Heritage Ethics via Human Rights Norms*, in DYNAMIC FAIR DEALING: CREATING CANADIAN CULTURE ONLINE 201, 201-02 (Rosemary J. Coombe, Darren Weshler & Martin Zeilinger eds., 2014)).

24. See Interview with Professor Susan Scafidi, in Nadra Nittle, *The Cultural Appropriation Debate Has Changed. But is it For the Better?*, VOX (Dec. 18, 2018, 4:10 PM), <https://www.vox.com/the-goods/2018/12/18/18146877/cultural-appropriation-awkwafina-brunomars-madonna-beyonce> [<https://perma.cc/UY98-R5HX>]. This Note will use “cultural misappropriation” to avoid confusion.

Cultural misappropriation is particularly harmful to communities in the United States that do not belong to the dominant culture. This harm is multi-level.²⁵ 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].”²⁶ 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.²⁷ 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.”²⁸

Groups are marginalized when they are “treated as insignificant, unimportant, and unworthy of respect.”²⁹ 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.³⁰ 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.³¹ This is one reason cultural misappropriation is so harmful. These marginalized groups also consist heavily of members of diasporic communities.³² 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.³³ As such, members of the

25. Sharoni, *supra* note 20, at 413-15.

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.

32. Diaspora means “people settled far from their ancestral homelands.” *Diaspora*, MERRIAM-WEBSTER, <https://www.merriam-webster.com/dictionary/diaspora> [<https://perma.cc/Z6BD-4L4Y>]. People of Chinese descent living in America are members of the Chinese diaspora.

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

appropriation [<https://perma.cc/BHU3-A8CL>]; Chiang, *supra* note 15 (“Through the attachment to homeland, cultural traditions, and shared history of displacement, diasporas establish a collective symbolic community and identity, contributing to cultural solidarities.”).

34. See Creatrix Tiara, *Asians in Asia View Cultural Appropriation Differently Than You Realize*, THE ESTABLISHMENT (June 19, 2018), <https://theestablishment.co/cultural-appropriation-isnt-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.”).

35. A *qipao* is a traditional Chinese dress. Amy Qin, *Teenager’s Prom Dress Stirs Furor in U.S.—but Not in China*, N.Y. TIMES (May 2, 2018), <https://www.nytimes.com/2018/05/02/world/asia/chinese-prom-dress.html> [<https://perma.cc/9XKG-5RAK>].

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.*

39. Brigitte Vézina, *Cultural Appropriation Keeps Happening Because Clear Laws Simply Don’t Exist*, CTR. FOR INT’L GOVERNANCE INNOVATION (Dec. 24, 2019), <https://www.cigionline.org/articles/cultural-appropriation-keeps-happening-because-clear-laws-simply-dont-exist/> [<https://perma.cc/B2XW-EE5R>].

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.⁴² Because of this, many have turned to intellectual property law for solutions, particularly copyright and trademark law.⁴³ 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.⁴⁴ Moreover, it is unclear *who* and *what* the law should protect.⁴⁵ 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.”⁴⁶ 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.⁴⁷ Furthermore, copyright protection is offered only for a limited period—the life of the author plus seventy years.⁴⁸ 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.⁴⁹ For example, when a white Oregonian woman named Karen Taylor claimed the title “Queen of Congee” and promoted her “improved”

42. Lauren M. Ingram, *Cultural Misappropriation: What Should the United States Do?*, 111 TRADEMARK REP., 859, 861 (2021).

43. *Id.*

44. *See id.*

45. *Id.*

46. *See* 17 U.S.C. § 102.

47. Sharoni, *supra* note 20, at 417.

48. *See* 17 U.S.C. § 302(a).

49. Sharoni, *supra* note 20, at 417.

rendition of the Asian dish, there was little legal recourse that could be taken against her.⁵⁰ Congee, while a staple in Asian culture, is little more than an idea—a white rice porridge.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.”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.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.”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.⁵⁵ The lack of registration does not prevent the use of a mark, nor does it preclude protection.⁵⁶ However, registration provides significant advantages, particularly in proving distinctiveness.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.⁵⁸ Furthermore, trademark laws exist to promote dissemination, which is the exact ill source communities

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>].

51. *See id.*

52. Tim Carman, *Congee: The Chinese Super Bowl*, WASH. POST (Nov. 29, 2011, 11:42 AM), https://www.washingtonpost.com/lifestyle/food/congee-the-chinese-super-bowl/2011/11/23/gIQAbaWy8N_story.html [<https://perma.cc/E4VT-BQ55>].

53. *See* 17 U.S.C. §§ 102, 302(a).

54. Sharoni, *supra* note 20, at 421.

55. *Id.*

56. *See* 1 FED. UNFAIR COMPETITION: LANHAM ACT 43(a) § 3:1 (2023).

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.*

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.

60. 15 U.S.C. § 1052(a).

61. 582 U.S. 218, 223 (2017).

62. 139 S. Ct. 2294, 2302 (2019).

63. Danielle Weitzman, *Washington Redskins' US Trademark Registrations Reinstated by the Fourth Circuit*, JD SUPRA (Feb. 13, 2018), <https://www.jdsupra.com/legalnews/washington-redskins-us-trademark-80591/> [<https://perma.cc/J7GX-EE2W>].

64. *See* 4 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23:36 (5th Ed.) [hereinafter “MCCARTHY”].

65. Thomas Merante, *Tomato, Tamatie? Revising the Doctrine of Foreign Equivalents in American Trademark Law*, 6 N.Y.U. J. INTELL. PROP. & ENT. L. 310, 322-23 (2017).

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

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 Fondée En 1772*, 396 F.3d 1369, 1377 (Fed. Cir. 2005).

69. *Merante*, *supra* note 65, at 322-23.

70. 4 MCCARTHY, *supra* note 64, § 23:36. According to U.S. Census data, over 45 percent of the U.S. population reported speaking a language other than English at home. Sandy Dietrich & Erik Hernandez, *Language Use in the United States: 2019*, AM. CMTY. SURVEY REPS. (Aug. 2022), <https://www.census.gov/content/dam/Census/library/publications/2022/acs/acs-50.pdf> [<https://perma.cc/4UCN-BHTG>].

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.⁷⁵

i. Is It a Common Language?

Under the doctrine of foreign equivalents, “common” language refers to modern languages.⁷⁶ Courts have held that it is not disqualifying if only a small percentage of Americans speak that language.⁷⁷ In *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.”⁷⁸ This, the applicant reasoned, meant that the “average American buyer [did] not speak French.”⁷⁹ 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.”⁸⁰ Examples of these common, modern languages include Chinese, French, German, Greek, Hungarian, Italian, Japanese, Polish, Russian, Serbian, Spanish, and Yiddish.⁸¹

*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.”⁸² However, this standard has been applied

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

76. See *Merante*, *supra* note 65, at 323.

77. See *In re Thomas*, 79 U.S.P.Q. 2d 1021 (T.T.A.B. 2006).

78. *Id.*

79. *Id.*

80. *Id.* (quoting *In re Ithaca Industries Inc.*, 230 U.S.P.Q. 702, 703 (T.T.A.B. 1986)).

81. 2 MCCARTHY, *supra* note 64, § 11:34.

82. *Id.* § 23:36.

inconsistently. For example, in *Continental Nut Co. v. Le Cordon Bleu*, appellee, Le Cordon Bleu, S.A.R.L.,⁸³ opposed Continental Nut Co.'s registration of the mark "CORDON BLEU" for edible, shelled nuts.⁸⁴ 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."⁸⁵ However, despite this direct translation, the court decided that "Cordon Bleu" had an independent meaning to the American public, creating a separate commercial impression.⁸⁶ 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.⁸⁷ This meant that Continental Nut Co. was not entitled to the translation of its existing mark.⁸⁸ 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."⁸⁹ 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.⁹⁰ Despite using similar reasoning, the Board reached opposite results.⁹¹

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 "[t]here are foreign expressions that those familiar with language will accept without translating").

89. 2 U.S.P.Q. 2d 1459, 1460 (T.T.A.B. 1987).

90. *Id.*

91. *See id.*

Abercrombie spectrum.⁹² 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.⁹³ 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.⁹⁴ This analysis also applies in the inverse—whether a putative English mark will cause consumer confusion with an existing foreign-language mark.⁹⁵

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.”⁹⁶ Similar sentiments adorned protest signs as anti-Asian violence soared during the COVID-19 pandemic.⁹⁷ 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.⁹⁸

92. See *supra* note 57 and accompanying text.

93. Merante, *supra* note 65, at 323.

94. *Id.* at 322.

95. See *In re Fahey*, No. 86250337, at 2 (T.T.A.B. 2015).

96. Angelina X. Ng, *More than Meets the Eye: Looking to the Past to Understand the Cultural Appropriation of Asian Food*, THE HARVARD CRIMSON (Nov. 1, 2022), <https://www.the crimson.com/article/2022/11/1/culturalappropriation-in-asian-food-thinkpiece-always-be-my-maybe/> [<https://perma.cc/Q7HS-7DBJ>]; Associated Press, *More Than 9,000 Anti-Asian Incidents Have Been Reported Since the Pandemic Began*, NPR (Aug. 12, 2021, 6:02 PM), <https://www.npr.org/2021/08/12/1027236499/anti-asian-hate-crimes-assaults-pandemic-incidents-aapi> [<https://perma.cc/FW8K-55RQ>].

97. Ng, *supra* note 96; Associated Press, *supra* note 96.

98. Ng, *supra* note 96; Associated Press, *supra* note 96.

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.⁹⁹ 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.¹⁰⁰

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;¹⁰¹ (2) the exploitation and commodification of source communities’ cultural products;¹⁰² and (3) the lack of source community recognition.¹⁰³

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.¹⁰⁴ 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.¹⁰⁵ Thus, the use of their culture by dominant groups further erodes opportunities for self-expression and removes ownership from the source community.¹⁰⁶

99. See Ng, *supra* note 96.

100. See *id.*; *supra* Part I.B; Frias, *supra* note 50; Frances Kai-Hwa Wang, *How Violence Against Asian Americans Has Grown and How to Stop It, According to Activists*, PBS NEWS HOUR (Apr. 11, 2022, 10:37 AM), <https://www.pbs.org/newshour/nation/a-year-after-atlanta-and-indianapolis-shootings-targeting-asian-americans-activists-say-we-cant-lose-momentum> [<https://perma.cc/E7TL-AJYC>] (outlining the history of violence against Asians in America and potential solutions to the problem).

101. See, e.g., Rina Arya, *Cultural Appropriation: What it is and Why it Matters?*, 15 SOCIO. COMPASS 10, Oct. 2021, at 1, 3; Mathias Siems, *The Law and Ethics of ‘Cultural Appropriation,’* 15 INT’L J.L. CONTEXT 408, 415 (2019).

102. See, e.g., Arya, *supra* note 101; Lalonde, *supra* note 14, at 337-39.

103. Lalonde, *supra* note 14, at 331.

104. Arya, *supra* note 101, at 4.

105. See Siems, *supra* note 101, at 415.

106. Arya, *supra* note 101, at 4.

In early 2021, three white women out of Dallas, Texas launched “The Mahjong Line,” a self-proclaimed “respectful refresh” of the traditional game of tiles that originated in China.¹⁰⁷ Mahjong emerged in the mid-to-late 1800s in southeastern China and made its way to the United States in the 1920s.¹⁰⁸ Notably, the game gained popularity in the United States at the height of anti-immigrant and anti-Chinese sentiment in America, just as the 1924 Johnson-Reed Act was signed into law, completely barring the entry of those born in “Asiatic Barred Zone[s].”¹⁰⁹ Chinese Americans watched in disbelief as history repeated itself, with three white women capitalizing off of a Chinese game that entered American culture at the height of anti-Chinese sentiment.¹¹⁰ Meanwhile, Asian Americans faced yet another avalanche of anti-Asian hate and violence that same year.¹¹¹

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

107. *About Us*, THE MAHJONG LINE (Jan. 4, 2021) <https://web.archive.org/web/20210104203209/https://themahjongline.com/pages/about-us> [<https://perma.cc/RC2V-72LM>]. The Mahjong Line’s “About Us” page has since been updated.

108. Cady Lang, *What the Surprising History of Mah-jongg Can Teach Us About America*, TIME (May 4, 2021, 3:22 PM), <https://time.com/6045817/mahjongg-history/> [<https://perma.cc/CFG4-LUZG>].

109. The law excepted those born in Japan and the Philippines. *The Immigration Act of 1924 (The Johnson-Reed Act)*, OFFICE OF THE HISTORIAN, <https://history.state.gov/milestones/1921-1936/immigration-act> [<https://perma.cc/JP9M-HVRS>]. This was also less than fifty years after the Chinese Exclusion Act was passed in 1882. *Chinese Exclusion Act (1882)*, NAT’L ARCHIVES, <https://www.archives.gov/milestone-documents/chinese-exclusion-act#:~:text=In%20the%20spring%20of%201882,immigrating%20to%20the%20United%20States> [<https://perma.cc/FY52-WXFJ>] (last visited Feb. 26, 2023).

110. THE MAHJONG LINE, *supra* note 107. The owners of The Mahjong Line have since issued an apology for not properly attributing the origins of the game and for their choice of words. The Mahjong Line, FACEBOOK (Jan. 5, 2021), <https://www.facebook.com/themahjongline/posts/250449109906506> [<https://perma.cc/44CC-ZKK3>]. As of November 22, 2023, The Mahjong Line still has over fifteen sets of mahjong tiles for sale, ranging in price from \$375 to \$425. *Tiles*, THE MAHJONG LINE, <https://themahjongline.com/collections/mahjong-tiles> [<https://perma.cc/CQ8S-SW6R>].

111. *See* Wang, *supra* note 100.

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,

112. Arya, *supra* note 101, at 4.

113. *Id.*

114. HAKUNA MATATA, Registration No. 2,700,605.

115. Malaka Gharib, *Swahili Speakers Debate Disney's Trademark of 'Hakuna Matata' for T-Shirts*, NPR (Dec. 14, 2018, 2:39 PM), <https://www.npr.org/sections/goatsandsoda/2018/12/14/676703629/swahili-speakers-horrified-by-disneys-trademark-of-hakuna-matata> [<https://perma.cc/S4QZ-9MDB>].

116. *Id.*

117. *Id.*

118. *See infra* Part II.

119. Lalonde, *supra* note 14, at 333-35 (defining nonrecognition as "voicelessness and invisibility" and misrecognition as "essentializ[ing]" culture and reducing culture to a set of stereotypes).

120. *See id.* at 334 (quoting philosopher Charles Taylor explaining that "[n]onrecognition or misrecognition can inflict harm, can be a form of oppression, imprisoning someone in a false, distorted, and reduced mode of being").

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 id.*

125. *See Merante, supra* note 65, at 324-25.

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

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.

135. *Enrique Bernat F., S.A. v. Guadalajara, Inc.*, 210 F.3d 439, 443 (5th Cir. 2000).

136. *Id.*

137. *Id.* at 441.

138. *Id.* at 443.

consumer would understand it to mean.¹³⁹ 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.”¹⁴⁰ 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.¹⁴¹ However, because it is a guideline and not a rule, the doctrine is applied very inconsistently.¹⁴² 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).¹⁴³ This Note proposes promoting the guideline to a rule and

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).

142. *See, e.g.,* Serge Krimnus, *The Doctrine of Foreign Equivalents at Death’s Door*, 12 N.C. J.L. & TECH. 159, 163-65 (2010) (discussing the U.S. Patent Office’s inconsistent application of the doctrine).

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

144. 79 U.S.P.Q.2d 1021, 1024 (T.T.A.B. 2006).

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 “[u]nless 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.¹⁴⁹ 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.¹⁵⁰ 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.”¹⁵¹ 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.¹⁵² While this opinion is not TTAB precedent, it demonstrates the rather wide discretion the Board has and how potentially detrimental this discretion can become.¹⁵³ 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.”¹⁵⁴

149. See *In re Thomas*, 79 U.S.P.Q.2d at 1024.

150. *In re Fahey*, No. 86250337, at 3 (T.T.A.B. 2015), <https://ttabvue.uspto.gov/ttabvue/ttabvue-86250337-EXA-10.pdf> [<https://perma.cc/3FHS-452Z>].

151. *Id.* at 1-2.

152. *Id.* at 3.

153. See generally *id.*

154. Sophie Lee, *The Aloha Poke Case: When Trademarks Facilitate Misappropriation*, COLUM. UNDERGRADUATE L. REV. (Jan. 29, 2020), <https://www.culawreview.org/journal/the-aloha-poke-case-when-trademarks-facilitate-misappropriation> [<https://perma.cc/GM8G-AD4B>].

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.¹⁵⁵ The TMEP states that the doctrine does not apply if there is evidence of other “shades of meaning” or relevant meanings that exist.¹⁵⁶ 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.”¹⁵⁷ 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.¹⁵⁸

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.¹⁵⁹ 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.¹⁶⁰ 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

155. TMEP § 1207.01(b)(vi) (July 2022).

156. *See id.* § 1207.01(b)(vi)(B).

157. Enrique Bernat F., S.A. v. Guadalajara, Inc., 210 F.3d 439, 443-44 (5th Cir. 2000); *Otokoyama Co. v. Wine of Japan Import, Inc.*, 175 F.3d 266, 271-72 (2d Cir. 1999).

158. *Otokoyama*, 175 F.3d at 272.

159. *See* Krimnus, *supra* note 142, at 185.

160. Elizabeth J. Rest, *Lost in Translation: A Critical Examination of Conflicting Decisions Applying the Doctrine of Foreign Equivalents*, 96 TRADEMARK REP. 1211, 1215 (2006).

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.¹⁶¹ As such, the doctrine would prevent the registration of “MANZANA” as applied to apples but would not stop more egregious forms of cultural misappropriation.¹⁶² 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.¹⁶³ 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.¹⁶⁴

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

161. See *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 791 (5th Cir. 1983).

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://www.cosmopolitan.com/entertainment/a28197739/kim-kardashian-kimono-trademark-backlash/[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.”).

164. “Kimono” literally means “wearing thing” in Japanese, and the garment carries a rich history in Japanese culture. See generally Cynthia Green, *The Surprising History of the Kimono*, JSTOR DAILY (Dec. 8, 2017), <https://daily.jstor.org/the-surprising-history-of-the-kimono/> [https://perma.cc/Q8V2-KUZE].

“clothes” more generally.¹⁶⁵ 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.¹⁶⁶ 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.¹⁶⁷ 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 translate,” finding that there would be no likelihood of confusion between “TIA MARIA” and “AUNT MARY’S” for canned vegetables.¹⁶⁸ Assuming that there would be no translation is ignorantly presumptive and creates a generalization that can easily be proven untrue. As such, those evaluating trademark applications should assume that those familiar with the language *will* stop to translate the mark and that there will more likely be confusion than not. The multilingual culture of the United States is far too nuanced to assume that confusion will not occur when it comes to foreign

165. See *supra* note 163 and accompanying text.

166. See *supra* note 164 and accompanying text.

167. See generally *Matal v. Tam*, 582 U.S. 218 (2017); *Iancu v. Brunetti*, 139 S. Ct. 2294 (2019).

168. *In re Tia Maria, Inc.*, 188 U.S.P.Q. 524, 525 (T.T.A.B. 1975).

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.¹⁶⁹

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.¹⁷⁰ 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.¹⁷¹ 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.¹⁷² 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.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.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 2022.¹⁷⁵ 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.”¹⁷⁶ By leaning on the rights provided to it by the contours of

173. Fukunishi, *Say No to Kim Kardashian’s “KIMONO” #KimOhNo*, *supra* note 17; Fukunishi, *Kim Announced New Name/Trademarks Withdrawn*, *supra* note 17.

174. Mia Jankowicz, *Three White American Women Redesigned Mahjong Tiles to Sell for \$425 a Set, Saying the Game Needed a ‘Respectful Refresh,’ and Were Accused of Erasing Chinese Culture*, BUS. INSIDER (Jan. 6, 2021, 12:49 PM), <https://www.insider.com/women-accused-ignoring-china-culture-425-dollar-mahjong-redesign-2021-1> [<https://perma.cc/YL2T-2UXR>]; Tanya Chen, *Three Women Accused of Whitewashing Mahjong Said They’re Sorry For Not Paying Homage to Its Chinese Origins*, BUZZFEED NEWS (Jan. 6, 2021, 12:12 PM), <https://www.buzzfeednews.com/article/tanyachen/the-mahjong-line-criticism> [<https://perma.cc/QKE6-VAVK>].

175. Ashok Selvam, *Aloha Poke CEO Says Company Was Confused by Appropriation Backlash*, EATER CHI. (Sept. 30, 2019, 12:00 PM), <https://chicago.eater.com/2019/9/30/20891296/aloha-poke-co-expansion-appropriation-native-hawaiians> [<https://perma.cc/597X-P876>].

176. Aloha Poke Co., FACEBOOK (July 30, 2018), <https://www.facebook.com/Alohapokeco/posts/2162695770681984> [<https://perma.cc/5F2W-TUQK>].

trademark law, Aloha Poke Co. has been able to escape real accountability for its exploitation of Hawaiian culture.¹⁷⁷ 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.*

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