

Blog Post

Foreign Equivalents: Ricardo and Richard

September 9, 2019

In a precedential decision involving the “doctrine of foreign equivalents,” the Board found no likelihood of confusion between the mark RICHARD MAGAZINE for a website in the field of fashion and lifestyle and the mark RICARDO for goods and services, including publications, in the culinary field. *Ricardo Media Inc. v. Inventive Software, LLC*, Opposition No. 91235063 (August 21, 2019) [precedential]

Related Work

Intellectual Property
Intellectual Property
Litigation
Trademarks

The doctrine of foreign equivalents directs the United States Patent and Trademark Office to translate marks in foreign languages into English to test for the statutory bars to registration. The doctrine can be used to deny registration based on descriptiveness and likelihood of confusion. When applying the doctrine of foreign equivalents, the key question is whether the ordinary American purchaser would “stop and translate” the mark in question.

Opposer Ricardo Media, Inc. (Opposer) is a “culinary culture and lifestyle company” which produces television shows and publishes a magazine and companion website covering food, recipes, and “other lifestyle topics.” Opposer also sells various cooking tools.

Applicant runs a website/online magazine focusing largely on fashion and, to a lesser degree, beauty and lifestyle. Opposer challenged Applicant’s trademark

RICHARD MAGAZINE based on its alleged confusing similarity with Opposer's RICARDO.

In any likelihood of confusion analysis, the Board first considers the similarity of the parties' marks and the similarity of their respective goods and services. In this case, the evidence established that both "lifestyle" and culinary content are offered by some media, and that was sufficient to persuade the Board that the parties' services were related. Similarly, the overlap in channels of trade and classes of consumers provided slight support for a finding of likely confusion. The key issue, then was the similarity of the parties' respective marks.

On their faces, the Board found that the marks were somewhat similar in appearance but different in sound. The dispositive issue in this case concerned whether the doctrine of foreign equivalents should apply. The Board observed that the doctrine "should generally not apply to first names such as RICHARD and RICARDO that are widely recognizable to American consumers, unless there is evidence that consumers would 'translate' the names." The Board found no such evidence.

The seminal foreign equivalents case is *Palm Bay Import[s], Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 73 USPQ2d 1689, 1696 (Fed. Cir. 2005). In that case, the opposer owned numerous marks for "Veuve Cliquot" (meaning "the Widow Cliquot") in various formatives, as well as the translations "The Widow" and "La Viuda." The applicant in that case sought to register its mark "Veuve Royale" (meaning "the Royal Widow"). The Federal Circuit found that the relevant consumers would not stop and translate "Widow" to "Veuve" and experience source confusion between the opposer's "The Widow" mark and the applicant's "Veuve Royale" mark. The "stop and translate" standard does not always extend to all words, even in otherwise "common languages" in the United States.

In this case, the chief point of dispute concerned whether ordinary American purchasers would “stop and translate” Opposer’s mark RICARDO to RICHARD and experience source confusion with the applied-for RICHARD MAGAZINE.

While, the Board noted that “Richard” and “Ricardo” are each recognized personal names, there was no evidence that owners of personal name trademarks use translations of their personal names, or that consumers translate them. Indeed, “[i]nconsistent use of a personal name trademark, including by using it in more than one language, such that its spelling or pronunciation changes, could risk, and perhaps make inevitable, consumer confusion as to the true source of a product or service.” In fact, consumers would be unlikely to “stop and translate” personal name marks, because doing so would point to not only a different person (whether real or fictional), but also to a different source, and to the mark losing any “instant recognizability.”

Finally, the Board noted, Applicant’s content appears to be only in English, with no indication that its services are related to the Spanish language. Thus there was no reason to think that consumers would translate RICHARD to RICARDO.

In sum, the record evidence did not support a finding that consumers would be likely to translate Ricardo to Richard, or vice versa. Instead, they would “take each name as it is, in its own language, as identifying the person named, whether real or fictional, known or anonymous.” Thus, the marks, when considered in their entireties, are dissimilar.

* * *

There has been a movement away from applying the doctrine of equivalents. In *Palm Bay Imports*, the Federal Circuit warned: “Although words from modern languages are generally translated into English, the doctrine of foreign equivalents is not an absolute rule and should be viewed merely as a

guideline.” 73 USPQ2d at 1696. The Board has avoided applying the doctrine where the translation is inexact (REPECHAGE was not confusingly similar to SECOND CHANCE because the French word was ambiguous and therefore not a direct translation; ALLEZ FILLES was not confusingly similar to GO GIRL because it was idiomatically incorrect in French). The Board’s application of this trend in Richard Magazine is consistent with that.

This information is intended to inform firm clients and friends about legal developments, including recent decisions of various courts and administrative bodies. Nothing in this Practice Update should be construed as legal advice or a legal opinion, and readers should not act upon the information contained in this Practice Update without seeking the advice of legal counsel. Prior results do not guarantee a similar outcome.