TTAB: Doctrine of Foreign Equivalents Not Applicable to Personal Names

By Michael J. Antonucci

***Ricardo Media Inc. v. Inventive Software LLC*, 2019 USPQ2d 311355 (T.T.A.B. 2019)**

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In a recent precedential opinion, the Trademark Trial and Appeal Board ("TTAB") declined to apply the Doctrine of Foreign Equivalents to recognizable personal names, holding that consumers generally would be unlikely to stop and translate such personal name marks. This decision sheds light on how personal name marks should be treated under the Doctrine of Foreign Equivalents.

In *Ricardo Media Inc. v. Inventive Software LLC*, Inventive Software LLC ("Inventive") applied to register RICHARD MAGAZINE for a fashion, beauty, lifestyle, and e-commerce website. Ricardo Media Inc. ("Ricardo Media") filed an opposition alleging that Inventive's mark was likely to cause confusion with Ricardo Media's own registration for RICARDO for magazines and books in the culinary field. Ricardo Media is named after its co-founder Ricardo Larrivée, a world-renowned celebrity chef, and registered the mark RICARDO for its television cooking show and culinary magazine. Meanwhile, Inventive selected the mark RICHARD MAGAZINE based on the name of the owner and founder of the magazine, Richard Wojtach.

While the TTAB noted that the marks are somewhat similar in appearance and that the terms RICHARD and RICARDO only differ by two letters, it held that the marks were sufficiently different to

prevent consumer confusion. In doing so, the TTAB rejected Ricardo Media's argument that the marks were confusingly similar under the Doctrine of Foreign Equivalents.

Under the Doctrine of Foreign Equivalents, foreign words from common languages are translated into English before a likelihood of confusion or descriptiveness analysis is conducted. When applying this doctrine, the U.S. Patent and Trademark Office treats differently-spelled words as having the same connotation where the foreign word, when translated, means the same as the English word.

Although the TTAB acknowledged that RICARDO is the Spanish equivalent of the English name RICHARD and that the Doctrine of Foreign Equivalents is routinely applied to Spanish-language marks, it found 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 TTAB found no such evidence.

The TTAB reasoned that, even if some people go by their English name in some circumstances and by the Spanish version in other contexts, owners of personal name marks would not be likely to do so, nor would consumers be likely to "stop and translate" common personal name marks. The TTAB further emphasized that the very purpose of trademarks is to indicate the source of goods and/or services and to distinguish such goods and/or services from those of others. Therefore, the TTAB held that "generally consumers would be unlikely to 'stop and translate' personal name marks, because doing so would point to not only a different person or people (whether real or fictional), but also to a different source, and to the mark losing any 'instant recognizability.'"

The marks at issue in this case—RICHARD and RICARDO—are each recognizable personal names, and thus, the TTAB found that consumers would not translate such marks but would instead "take each name as it is, in its own language, as identifying the person named, whether real or fictional, known or anonymous."

Finally, the TTAB noted that Inventive'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 American consumers, even Spanish speakers, would translate RICHARD to RICARDO.

In sum, the TTAB held that, in cases involving “two first names that will be recognizable as such to ordinary American consumers − it is unlikely that an American buyer will translate the foreign mark, but instead will take it as it is.”

This decision applies to first names that are recognizable as such to ordinary American consumers. It leaves open the question of whether the Doctrine of Foreign Equivalents applies to names that are not immediately recognizable as such to consumers in the U.S.