

## Internationalized Domain Names - Intellectual Property Considerations

### ANNEX IV

#### Multilingual Trademarks Trademark Office Practice and Procedure

The following extracts from selected trademark offices' manuals of trademark examination practice and procedure demonstrate the variety of issues that are considered relevant to applications for registration of multilingual and foreign character trademarks and the different approaches adopted by these administrations in various parts of the world. The procedures relate to the trademark offices of: Australia, Canada, European Community (Office for Harmonization in the Internal Market), Japan, United Kingdom and the United States of America.

#### **I. Australia**

The Australian Trademark Office, incorporated in the Federal agency IPAustralia, maintains a Manual of Practice and Procedure<sup>1</sup> that provides for the registration of marks in languages other than English, *inter alia*, as follows:

“Part 10 (Details of Formality Requirements)

#### 10. 4 Translation/transliteration of foreign words and non-Roman characters

Where a trade mark includes words in a language other than English and/or characters other than Roman characters, the applicant must file an English translation and/or transliteration in support of the trade mark application (subregs 4.3(5) and 4.3(6)).

#### 10.4.1 Translation/transliteration endorsement

An endorsement must be entered on the Register for all trademarks containing words in a language other than English and/or characters other than Roman characters.

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<sup>1</sup> See IP Australia's TMO Manual of Practice and Procedure available at <http://xeno.ipaustralia.gov.au/D:/Exmanual/cnts-num.htm>.

10.4.1.1 An application will ultimately be rejected unless the translation/transliteration is provided in support of the application.

10.4.1.2 Where an applicant has advised of the translation/transliteration, an endorsement will be entered on the system.

10.4.1.3 Where no translation/transliteration has been provided, the examiner should request one and enter the appropriate endorsement on the system when the information has been received. Where Chinese or Japanese characters appear in the trade mark the applicant should be requested to provide their transliteration in the Pinyin system in the case of Chinese characters and the Hepburn system in the case of Japanese characters.

10.4.1.4 In the case of the trade mark containing words not in English, the form the endorsement should take is as follows:

*The applicant has advised that the translation of the (NATIONALITY) words \_\_\_\_\_ appearing in the trade mark is \_\_\_\_\_.*

Where the trade mark contains words in characters that are not Roman characters the form the endorsement should take is as follows:

*The applicant has advised that the (NATIONALITY) characters appearing in the trade mark may be transliterated as \_\_\_\_\_ which may be translated into English as \_\_\_\_\_.*

10.4.1.5 The information provided by applicants should be accepted at face value unless research during normal examination indicates otherwise.”

Part 22 (Trademarks Capable of Distinguishing)

Section 41 - Capable of Distinguishing

41.11 Foreign words

The same principles apply to trade marks consisting of foreign words as with English words. Trade marks in a foreign language well known in Australia that contain or consist of a word or words, which if in English would not be sufficiently capable of distinguishing the applicant's goods or services, would similarly not be sufficiently capable of distinguishing the applicant's goods or services. Many languages other than English are understood in Australia as a significant number of the population come from a non-English speaking background or have studied a foreign language. It must therefore be determined whether the foreign language trade mark has a meaning which is likely to be required for use by other traders. Examiners should refer to foreign language dictionaries as well as the translation which must be provided by the applicant.

If the foreign word is in a language that is not likely to be known by a significant proportion of the Australian population then no ground for rejecting the application exists. In a United Kingdom case - *Burgoyne's Trade Mark*, 6 RPC 227, - the word *OOMOO*, subject of an application for wines and spirits, was held to designate 'choice' in an Australian Aboriginal language. Nevertheless Chitty J was of the opinion that the trade mark signified nothing to the ordinary Englishman. Similarly in the '*Kiku*' case, ([1978] F.S.R. 246 (Supreme Court of Ireland), the Japanese word for chrysanthemum - KIKU - was found to be registrable in Ireland for perfumes and cosmetic preparations, under provisions similar to the Australian provisions, as the ordinary person would need to have the word translated from the Japanese in order to know its meaning. Where the elements are taken from more than one language, the result will almost invariably be registrable (see for example, '*Smitsvonk*' case 72 RPC 117, '*Simplug*' case, (1957) RPC 173 and '*Wacker-chemie*' case, (1957) RPC 278.

#### 41.11.1 Trade marks in foreign characters or letters

A ground for rejecting an application exists if the trade mark applied for is rendered in foreign characters and the characters are translations of English words which are not capable of distinguishing. Examiners should ascertain the meaning of the characters and consider translations and transliterations provided by the applicant.

#### Part 26 (Conflict with Other Signs – Section 44)

##### 26.6.10 Trade marks in a foreign language

The usual tests for comparing word trade marks are applied when deciding whether words rendered in a foreign language are deceptively similar to trade marks already on the Register and whether there is a reason for rejection under section 44. This applies whether the trade marks being compared are both rendered in Roman characters or in the letters or characters of any system of writing, such as Arabic or Chinese.

The visual or aural comparisons described in, for example, *Pianotist Co's Application* (33 RPC 774) should be made, together with considerations as to the nature of the goods or services specified and the way in which they are marketed. Most importantly, an assessment should be made of the likelihood that the ordinary purchasers of the goods or services will understand the meaning of the foreign words constituting the trade mark. This will vary with the nature of the particular goods or services as indicated by the following examples:

- If the goods are mass marketed, for example, clothing or foodstuffs, the purchase may be made largely on the basis of visual selection. The trade mark may be part of packaging which displays other similar textual material and the purchaser may be part of the general monolingual Australian public. In such a case the meaning of the respective trade marks would be irrelevant, so the main tests would be visual and phonetic (if verbalisation of the trade mark is possible). In so far as Arabic and Asian characters are concerned consumers who are not literate in these languages would be expected to pay particular attention to the graphics involved.

- Newspapers, books and similar publications, or professional services, such as medical or legal services, for which a trade mark comprised wholly of a foreign language is to be used, are unlikely to be purchased by the general Australian public. They will be targeted towards a particular sector familiar with that language. The meaning of the word or words comprising the trade mark must therefore be taken into account, as well as the visual and phonetic similarities. If the meanings are quite different, it is much less likely that visual or phonetic similarities will lead to deception.
- If the goods or services are very specialised and/or, expensive, considerable care would be exercised in their selection and purchase. In such circumstances even minor difference between trade marks might serve to differentiate the goods or services.

When the comparison is between a foreign language trade mark and an English trade mark, the same principles apply. In general, except where the words are visually or aurally similar, the English equivalent of a foreign language trade mark will not be cited as the basis for rejecting an application under section 44. For example, RED MAN will not be cited against ROUGE HOMME or the Chinese or Arabic characters meaning ‘red man’.”

## **II. Canada**

### “IV. 4.6 Deceptively Misdescriptive

The principle which underlies a paragraph 12(1)(b) objection as it concerns deceptive misdescriptiveness is that a mark which is the subject matter of an application must not mislead the public by ascribing a quality to wares that they do not possess. For example, in *Deputy Attorney-general of Canada v. Biggs Laboratories (Canada) Limited* (1964), 42 C.P.R. 129, the trade-mark SHAMMI, as applied for in relation to a transparent polyethylene glove, was denied registration. The glove did not contain one scintilla of chamois or shammy. In finding the mark SHAMMI deceptively misdescriptive of the character or quality of the wares, Dumoulin J. stated at p.130:

“An article advertised for sale as containing certain components which, in truth, it does not have, surely must be considered as deceptively misleading to the purchasing public.”

However, in *Lake Ontario Cement Ltd. v. Registrar of Trade Marks* (1976), 31 C.P.R. (2d) 103, Dubé J. held that the word PREMIER was not deceptively misdescriptive as applied to the wares “sand and gravel and ready-mixed concrete” and “concrete blocks and bricks ordinarily used in the construction of buildings and homes.” Dubé J. found that the word PREMIER denotes a degree of quality that might be attained by the wares and, insofar as the wares did not meet that quality, the word PREMIER would be misdescriptive of the quality of the wares. However, ordinary dealers in or purchasers of the wares would perceive PREMIER, as applied for, as an indirect reference to, the quality of the wares and would not be led to believe that the wares being purchased were of the best quality. The word PREMIER was held not to be deceptively misdescriptive, but it was found to be clearly descriptive and therefore had to be disclaimed. *See reference to this case in section IV:4.2 of this chapter.*

#### IV. 4.7. In the English or French Languages

A word in a language other than English or French which is clearly descriptive of the character or quality of the wares or services is not prohibited by paragraph 12(1)(b), the prohibition being limited to words in the English or French languages. In *Gula v. Manischewitz Co.* (1947), 8 C.P.R. 103, it was held that even though the word “tam” meant “taste or taste” to a Hebrew- or Yiddish-speaking person, the mark TAM TAM was a good subject of a trade-mark being neither in the English nor the French languages.

Paragraph 12(1)(b) also does not preclude the registration of a trade-mark comprised of a combination of French and English words individually descriptive of the wares. In *Coca-Cola Co. v. Cliffstar Corp.* (1993), 49 C.P.R. (3d) 358, the applicant applied to register the trade-mark LE mIcE for juices. The word “juice” was disclaimed. The opponents alleged the mark was the name of the wares and unregistrable pursuant to paragraph 12(1)(c) of the *Trade-marks Act* and that the mark was clearly descriptive or deceptively misdescriptive of the character or quality of the wares, contrary to paragraph 12(1)(b). The opposition was

rejected and the following was stated at p.360: “The opponents’ own evidence establishes that the word ‘le’ is a French language definite article and ‘juice’ is an English language word referring to fluid naturally contained in plant or animal tissue. Thus, the trade mark as a whole cannot be said to be the name of anything in the English language nor can it be said to be the name of anything in the French language”.

And further at p.361:

“The applicant’s proposed mark is comprised of the French word ‘le’ and the ordinary English word ‘juice’. The former word is a definite article in the French language. The latter word is clearly descriptive in the English language of the character of the wares ‘fruit juices’ and the applicant has conceded this by including a disclaimer in its application. The combination of the two words, however, does not offend the provisions of 12(1)(b) of the Act which precludes registration of a trade-mark that is

(b) ...whether depicted, written or sounded, either clearly descriptive or deceptively misdescriptive in the English or French language...

Section 12(1)(b) of the Act does not preclude the registration of a trade mark comprised of a combination of French and English words individually descriptive of the wares.”

#### IV. 4.8. Character or Quality

A trade-mark is not registrable if it is clearly descriptive or deceptively misdescriptive in the English or French languages of the character or quality of the wares or services in association with which it is used or proposed to be used. As to what constitutes the character of the wares or services, the examiners may be guided by the words of Cattnach J. in *Drackett Co. of Canada Ltd. v. American Home Products Corp.* (1968), 55 C.P.R. 29 at p.34, where he states that “...the word ‘character’ as used in s.12(1)(b) must mean a feature, trait or characteristic of the product”.

Words descriptive of the function or result of using wares have also been refused. The marks STA-ZON, a distortion of “stays on,” and SHUR-ON, a distortion of “sure on,” as applied to eyeglass frames, were held not to be proper trade-marks. In *Kirstein Sons & Co. v. Cohen Bros., Limited* (1907), 39 S.C.R. 286 at p.288, Mr. Justice Davies stated: “He could not pre-empt nor claim the exclusive use of the idea descriptive of some merit in the article”.

In the ULTRA FRESH decision, *Thomson Research Associates Ltd. v. Registrar of Trade Marks* (1982), 67 C.P.R. (2d) 205, the function of the wares was held to be clearly descriptive of their character. Mahoney J. stated at p.208:

“I agree with the respondent that ‘ultra fresh’ is clearly descriptive. It is not descriptive of the bacteriostats and fungistats themselves but it does clearly describe, or deceptively misdescribe, the condition of the products, e.g., the underwear, after treatment with those bacteriostats and fungistats.”

And further:

“‘Ultra fresh’ does not merely suggest a characteristic of the bacteriostats and fungistats at all; it clearly suggests the principal, if not only, effect of their application to other wares, in other words, their function.”

#### 11.5.7 Applicant's Statement of Claim of Entitlement - Paragraph 10 of Form 1 -Paragraph 30(i)

A final consideration is whether or not the applicant is satisfied “that he is entitled to use the mark in Canada in association with the wares or services described in the application.” This can be looked at as a type of contract between the applicant and the public, establishing that all information and supporting evidence, including revisions or additions of same, have been submitted in good faith, and that the application as it stands is approved by the applicant. The examiners can then proceed with the examination of the mark.

## 11.6 Content Appearing in Some Applications

### 11.6.1 Predecessor in Title -Paragraphs 30(b), (c) and (d) - Paragraphs 4 and 5 of Forms

In order to establish use of a trade-mark prior to the actual use by the applicant, a list of all predecessors in title covering the time from the date of first use to the present must be provided.

### 11.6.2 Drawings- Paragraph 30(h) and Rules 27(1) and 28

Paragraph 30(h) stipulates that a trade-mark application shall contain a drawing of the trade-mark and such number of accurate representations of the trade-mark as may be prescribed unless the application is only for the registration of a word or words not depicted in a special form.

A drawing is required if a trade-mark is presented for registration in other than capital letters or block letters throughout. Drawings will be required in the following instances:

- a) The mark is a word composed of any lower case letters.
- b) The word(s) appears in any special arrangement other than on horizontal lines.
- c) A claim to specific colour or colours is made in respect of the whole or part of the mark.
- d) The word(s) includes foreign language accents other than French accents. (Because Canada recognizes both French and English as its official languages, accents used in the French language are not considered to be design characteristics although accents in other languages are.)
- e) The mark is comprised of foreign characters. NOTE: Pursuant to Rule 29, both a translation and transliteration must be furnished and will be included in the particulars of the application when advertised.

See sections II.5.1 and II.7.1.1 of this manual.

Furthermore, the Office no longer considers that an application for the registration of a word or words is in special form merely because it includes any of the following punctuation marks:

period, question mark, exclamation mark, comma, semicolon, colon, ellipsis, parentheses, brackets, quotation marks, single quotation marks, inverted commas, dash, asterisk, diagonal and underscore.

Accordingly, the inclusion of any of the foregoing punctuation marks will not render the trade-mark to be in special or design format as was the previous practice.

All word marks must be typed on the application form in upper-case letters with no space left between the letters of each word, unless, of course, that is a feature of the mark.

#### 11.6.2.1 Form and Size -Rule 27(1)

Where a drawing of a trade-mark is required, it shall be no larger than 2 3/4 inches by 2 3/4 inches (7 cm by 7 cm), and may be smaller as long as it is clear. The size is limited so as to meet the space requirements for reproduction in the *Trade-mark Journal*. The drawing should not include any matter that is

Therefore, these words are still part of the trade-mark, but the applicant is not claiming exclusive rights for these specific words.

## **Words in other languages**

Words that constitute the name of the wares or services in another language – such as “gelato,” Italian for ice cream; “anorak,” Inuktitut for parka; or “Wurst,” German for sausage – cannot be registered.

## **CAUSING CONFUSION**

Beware of words, symbols, sounds and ideas that suggest someone else’s trade-mark. If is confusingly similar to a registered trade-mark or a pending mark, it will be refused. This prohibition makes sense when you recall that the whole point of registering a trademark is to protect your corporate identity from imitation or confusion with others. Trade-mark examiners take into account various factors when determining whether trademarks are confusing. For example, they determine:

- A** whether a trade-marks look or sound alike and whether they suggest similar idea; and
- B** whether they are used to market similar wares or services.

Let’s go back to the example of “Northpole” and “Southpole” products are manufactured and sold by the same company. They might expect the trade-marks to be owned by the same entity. Hence your application to register “Northpole” might be turned down on the grounds of causing confusion with the registered mark “Southpole” owned by another company.

Other hypothetical examples of confusing trade-marks would be “King Dog Food” vs. “King Cat Food” (two companies, two different product lines, but the same trade-mark and the same general area – pet food); and “Glitter” for mineral water could probably co-exist as a registered trade-mark with “Glittering Dry Cleaners” as a registered trade-mark for dry cleaning services, because the wares and services in this example are quite different.

## **PROHIBITED MARKS**

Subsection 9(1) of the *Trade-marks Act* lists various kinds of marks that are expressly prohibited. You may not register a trade-mark that resembles certain official symbols unless you have the consent of the authority in question. These official symbols include:

- official government symbols, e.g., the Canadian flag;
- coats of arms of the Royal Family;
- badges and crests of the Armed Forces and the letters R.C.M.P.;
- emblems and names of the Red Cross, the Red Crescent, the United Nations;
- armorial bearings, flags and symbols of other countries; and
- symbols of provinces, municipalities and public institutions.

These prohibitions are designed to prevent people from “cashing in” on the prestige and authority of the above-mentioned institutions and misleading the public.

Subsections 9(1) of the *Trade-marks Act* also prohibits subject matter that is obscene, scandalous or immoral. For example your trade-mark may not include profane language, obscene visuals or racial slurs.

Another prohibition covers the use of portraits or signatures of living persons or persons who have died within the preceding 30 years. For example, using the photo of an existing rock group to promote your record store would be prohibited unless you had formal consent to do so.

## **FURTHER PROHIBITIONS**

A trade-mark will not be registered if it consists of a plant variety denomination or is a mark so nearly resembling a plant variety denomination as to be likely to be mistaken therefore, and the application covers the plant variety or another plant variety of the same species.

A trade-mark will not be registered if it is, in whole or in part, a protected geographical indication for wines or spirits, and the application covers a wine or spirit not originating in the territory indicated by the geographical indication.

## **II. European Community - Office for Harmonization in the Internal Market (OHIM)**

The Office of the European Union – Trademarks and Designs maintains Examination Guidelines<sup>2</sup> for trademarks that provide for the registration of marks in foreign characters, *inter alia*, as follows:

### “2. General Principles

2.3. When checking against the criteria in paragraphs 8.2 to 8.4 examiners must consider words in the mark and the description of the goods or services by reference to the Community as a whole. If, for example, a trade mark consists of a word in an application made in English and that word is in French the name of the goods or services then the examiner must object.

### 3. Receipt of Application and Formalities

3.11.1. Where a translation is required, namely where the application is not in one of the Office languages, its contents, to the extent that translation is required should be sent to the Translation Centre of the Bodies of the Union as early as possible. The translation will be submitted to the applicant by means of a 128, offering him a period of two months within which to propose changes in the translation. If he does not respond within this period or if the examiner considers any proposed changes to be inappropriate the translation proposed by the Office will stand. The examiner will communicate this to the applicant by means of a 129.

3.11.2. Once a decision has been made that an application is to be published its contents, to the extent that translation is required should be sent to the Translation Centre of the Bodies of

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<sup>2</sup> See OHIM Examination Guidelines (26/3/96) at  
<http://oami.eu.int/EN/marque/directives/exam.htm#Heading2>.

the Union so that all eleven language versions of the list of goods or services, description of the mark, disclaimers and colour claims are available.”

### III. Japan

The Japanese Patent Office (JPO) maintains a Trademark Examination Manual<sup>3</sup> that provides for the registration of foreign character marks, *inter alia*, as follows:

#### “25. Trademark Subject to Trademark Registration

##### 25.51 Handling of a Case in which a “Transliteration of Marks”, “Translation of the Mark” or “Description of the Mark” was indicated for an International Trademark Application

1. In a case in which a “transliteration of mark” or “translation of mark” is described, the examiner can use it as a reference for examination. Since the popular naming or concept of said trademark must be determined by considering the degree of recognition by Japanese consumers, the use of such description will be left to the judgement of the examiner.

2. In a case in which a “description of the mark” is described, the examiner confirms the description and follows the procedures below.

(1) When a description mentions that the claimed trademark is a “sound trademark,” “scent trademark” or “trademark consisting only of colors,” and is not treated as a trademark under the Japanese Trademark Law, said application is refused for not satisfying the requirement set forth in the main paragraph of Section 3(1) of the JTL.

(2) When there is a clear description that multiple trademarks are being filed in a single application (For example, the British Trademark Law adopts a series mark system where multiple trademarks can be filed in a single application, and the basic registration or basic application of said international trademark may be such series mark), the

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<sup>3</sup> See <http://www.jpo.go.jp/>.

application is judged to be filed for multiple trademarks. Thus, said application is refused for not satisfying the requirement set forth in Section 6 (1) of the JTL.

(3) When there is a description on the constituents or appearance of the trademark (e.g., an explanation of the three-dimensional trademark or an explanation of the combination of colors in the trademark), the information is referenced in examination as required.

(4) When there is a description that does not affect the essence of trademark protection in Japan, such as non-claim of right to a part of the trademark or claiming an associated trademark, the description is neglected.

(Note) Points to consider in case there is a description that does not demand right to a part of the trademark. When the applicant does not demand the right to a part of the trademark, that part is generally less capable of distinguishing the applicant's goods (or services) from the goods (or services) of others. Therefore, when examining such an application, it is necessary to consider that said part of the trademark is often incapable of distinguishing the designated goods (or services) or that it may lead the general public to misunderstand the quality of such goods (or services).

Also, there is sometimes a description of non-claim of right when the trademark includes a national flag and the applicant does not wish to acquire the right to the flag part. In this case, the examiner refuses the trademark pursuant to Section 4(1)(i) of the JTL if he or she recognized that the trademark noticeably comprises a national flag or the graphic of a foreign national flag.

## A2. Trademark Claimed in International Application

A.205 Handling of Transliteration of a Trademark Concerning an International Trademark Application (Notation in Alphanumerical Characters Others Than Roman Alphabet, and Arabic or Roman Numerals)

1. When the trademark concerning an international trademark application consists of characters other than Roman alphabet or includes the respective characters, the characters shall be transliterated into Roman alphabet, and also when a trademark concerning an international trademark application consists of numerals other than Arabic or Roman numerals or includes the respective numerals, the numerals are replaced with Arabic numerals, and that must be described in the item 9 (a) “Transliteration of the mark” (hereinafter referred to as transliteration of trademark”) in the request of an international trademark application
2. The JPO shall confirm the column of “transliteration of trademark” and urge the applicant to describe it when there is no description. In addition, when there is a distinctive mistake in the description such as using a character or a numeral other than Roman alphabet or Arabic or Roman numerals, the JPO shall urge the applicant to correct the description.

However, correction of deficiency in the description of the column “transliteration of trademark” should be made with note that the correction will have no effect on the international filing date (international registration date), and even when the deficiency in the description is not corrected, the JPO shall make a verification on the international trademark application and send it on to the International Bureau as long as other requirements are satisfied.

[Explanation]

(1) When a trademark concerning an international trademark application consists of characters other than Roman alphabet, for example Japanese characters (kanji, hiragana, katakana) etc., or contains some such characters, the characters must be transliterated according to the pronunciation in the language allowed for international trademark applications (“English” for Japan) and describes them in Roman alphabet. That is to say, in the case of Japan, transliteration shall be spelled in Roman characters according to English pronunciation.

<Example of transliteration of trademarks>

- 1) transliteration of the trademark “アップル” “APPURU”
- 2) transliteration of the trademark “硝子” “GARASU”

<Example not accepted as transliteration of trademarks>

transliteration of “特許庁” “TOKKYOCHÔ”

\* Pronunciation mark “^” is described with characters “CHO”

In addition, when a trademark contains Chinese numerals as a description of numbers, the numbers should be described by replacing them into Arabic numbers.

(2) “Transliteration of a trademark” is a matter of description in the request of an international trademark application, but not a matter of verification by the JPO. Therefore, even if there is a lack of deficiency, the JPO shall make a verification and send it to the International Bureau for ensuring the international registration date.

However, when there is a defect in the description of “transliteration of trademark,” the defect shall be reported by the International Bureau to the applicant and the JPO, and if the applicant does not correct the defect within three months after receiving the report on defect, the international trademark application shall be handled as abandoned. (Common Regulation 11(2)) (The JPO shall not take a specific measure corresponding to the report on deficiency in “transliteration of trademark”.)

For this reason, it has been decided that the JPO shall take into consideration that examination is conducted on the description of “transliteration of trademark” by the International Bureau and, from the view of applicant’s convenience, urge the correction when there is a deficiency or a distinctive mistake, as long as the correction has no effect on the securing of the international filing date.

“Distinctive mistakes” include cases in which “characters other than Latin (Roman) characters” are described in the column of transliteration.

#### A2.06 Handling of Translation of a Trademark Concerning an International Trademark Application

1. The applicant of an international trademark registration can describe translation of the trademark for which international registration is sought in the item 9(b) “Translation of the mark” (hereinafter referred to as “translation of trademark”) in the request concerning the international trademark application in English, French or both languages.

2. Since the description in the column “translation of trademark” is voluntary, the JPO shall not confirm whether or not the column has been filled out and the accuracy of the described content.

[Explanation]

(1) Since description of the “translation of trademark” is not obligated in the Protocol, it is a matter of voluntary description. A description can be made in English, French or both languages in accordance with the form of the request.

(2) Irrespective of whether or not there is the respective description, or whether or not there is a deficiency in the described content, the JPO shall make a verification on the respective request as an Office of origin and send it to the International Bureau.

The JPO shall not confirm the translation of a trademark on the basis of the following reasons.

1) The International Bureau shall not make a confirmation on the lack in the description of “translation of trademark” or the accuracy of the content.

2) “Translation of trademark” is not a matter of verification by the JPO.”

## IV. United Kingdom

The United Kingdom Patent Office maintains a Trade Marks Registry Work Manual,<sup>4</sup> that provides for the registration of foreign character marks, *inter alia*, as follows:

“Chapter 6

Trade Mark Examination and Practice

### 4. Section 3(1)(c) – “Consists exclusively of...”

If a mark does not consist exclusively of one of the signs listed in this subsection of the Act (and covered below), it cannot fall foul of Section 3(1)(c) or 3(1)(d). However, it may still be objectionable under Section 3(1)(b). The Registrar considers that the word “exclusively” refers to the content of the mark, and not to whether a sign serves more than one purpose. For example the word JUMPER with a distinctive device will be registrable *prima facie* for clothing because the sign does not consist exclusively of a sign which may be used in trade to designate a kind of clothing. However the word alone will not be registrable even though, apart from being a description of the goods, it is also a description of an athlete and is not therefore exclusively a description of the goods. See the decision of Simon Thorley QC acting as the Appointed Person in the FROOT LOOPS trademark case (see Application No. 1411150-unreported at the time of writing).

#### 4.13 Words in foreign languages

##### 4.13.1 Well known European languages

The following are likely to be known to a reasonable (and increasing) number of UK residents: French, German, Italian, Spanish

##### 4.13.2 Goods

Object if the words (in English) would be the subject of an objection under Section 3(1)(c) of the Act. Normally no need to object on the basis that the English equivalent would be devoid of any distinctive character without being descriptive e.g. TOUJOURS/ALWAYS.

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<sup>4</sup> See <http://www.patent.gov.uk/tm/reference/workman/index.htm>.

#### 4.13.3 Services

For international services or where it is common to use a foreign language in relation to particular services, e.g., French for restaurant or beauty care services, we should object to descriptive words excluded from registration by Section 3(1)(c), but not normally to words which in English would be devoid of any distinctive character without being descriptive. Where the services are essentially local in nature e.g. chimney sweeping, even the name of the services in a foreign language will normally be acceptable.

#### 4.13.4 Others less well known languages

Language such as Dutch, Swedish, Portuguese, Czech, Russian and Japanese are less well known in the UK.

#### 4.13.5 Goods

If the country has a reputation for any of the goods covered by the application treat as per French, German etc. Otherwise usually no need to object.

#### 4.13.6 Services

Object to foreign descriptive words for international services.

#### 4.13.7 Languages of ethnic minorities

Some of these languages are spoken by sizeable minorities of UK residents. They include: Chinese, Greek, Urdu, Gujarati, Arabic.

#### 4.13.8 Goods – in original script or transliteration

Consider whether the goods are likely to be destined for a particular ethnic market. This is likely to apply particularly to goods such as food and clothing. In such cases treat in the same way as the French, German etc. Object to words which, in English, would be open to objection under Section 3 (1)(c).

Where goods are unlikely to be aimed at the ethnic market, no objection.

#### 4.13.9 Services

Treat as goods. Bear in mind that some languages are associated with particular services, such as Chinese for healing or martial arts, and may be recognized phonetically by UK residents, whether members of the appropriate ethnic group or not.

4.13.10 Native languages other than English

Consider objecting to marks in Welsh, Gaelic etc. where the country or region concerned has a reputation for the goods/services, or where the goods/services (such as food and drink) may be specially associated with a particular culture.”

**V. United States of America**

The United States Patent and Trademark Office (USPTO) maintains a Trademark Manual of Examining Procedure (TMEP)<sup>5</sup> that provides for the procedure of registration of non-English marks, *inter alia*, as follows:

“8.9 Translation of Non-English Wording in Mark

The examining attorney should ascertain, if possible, through sources such as foreign language dictionaries or consultation with appropriate personnel in the Patent and Trademark Office Scientific Library, the meaning of wording in the mark which seems to be in a language other than English. If the examining attorney is not able to ascertain the meaning, the examining attorney should request the applicant to provide an English translation. Authority for the request is provided by Trademark Rule 2.61(b), 37 C.F.R. §2.61(b). Knowledge of the meaning of non-English words in marks is necessary for proper examination because a non-English term is regarded in the same way as its English equivalent in determining descriptiveness, requiring disclaimer, and citing marks under §2(d) of the Act.

An application to register a mark that comprises wording which is not in the English language should include a statement translating the non-English wording. Similarly, an application for a mark that comprises non-Latin characters should include a statement transliterating such characters. For this purpose, a transliteration is the phonetic spelling, in

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<sup>5</sup> (Second Edition, Revision 1.1). Available at the web site of the USPTO, at <http://www.uspto.gov/web/offices/tac/tmep/0800.htm>.

corresponding Latin characters, of the word or words in the mark which are in non-Latin characters. A transliteration is required for a mark that comprises non-Latin characters even if the wording has no English translation. An example of a statement translating and transliterating a word in non-Latin characters is the following: The non-Latin characters in the mark transliterate to ‘Asahi’ and this means ‘Rising Sun’.

#### 809.01 Equivalency in Translation

The translation that should be relied upon in examination is the English meaning which has real and specific significance in the United States as the equivalent of the meaning in the non-English language. A literal translation, although a proper one, is not necessarily a satisfactory one. The following are examples of equivalency in translation:

1. “Chat Noir”. The exact equivalent in English is “black cat,” and this translation would undoubtedly be recognized as the equivalent by the purchasing public in this country. In *Ex parte Odol-Werke Wien Gesellschaft M.B.H.*, 111 USPQ 286 (Comm’r Pats. 1956), the mark “Chat Noir” was refused registration because the words “Black Cat” were already registered for related goods.

2. “Mais Oui”. The literal translation of the individual words does not result in a significant English term. A satisfactory translation is not a single precise term, but it must be some normal English expression which will be the equivalent in meaning of the term “Mais Oui” to the French. In *re Societe Des Parfums Schiaparelli, S.A.*, 122 USPQ 349 (TTAB 1959).

3. “Schwartzkopf”. The term can be literally translated as “black head” but, even to German-speaking persons, the primary significance of “Schwartzkopf” is most likely that of a surname. Neither English nor foreign surnames should be translated. Therefore, the issue of translation is not relevant and such a term is more appropriately treated as a surname. See TMEP §1211.

#### 809.02 Printing of Translations and Transliterations

Sometimes translations which are not precise, or which give a variety of meanings, are placed in the record. While all possible translations, and discussions relative to meaning, are

useful in the record for providing information for examination purposes, not all such matter is appropriate for printing in the Official Gazette when a mark is published or on the certificate of registration. Only that translation which is the clear and exact equivalent should be printed. This normally means only one translation, as the existence of a variety of alternative translations or general explanations usually indicates a lack of a clearly recognized equivalent meaning.

Translations which an applicant places in the record are often presented in a form which is too verbose or vague to be appropriate for printing in the Official Gazette and on the registration certificate. It is the duty of the examining attorney to indicate what translation, if any, is to be printed. The transliteration of non-Latin characters, if any, should be included in the statement to be printed. The examining attorney should rewrite the statement at the bottom of the application paper in an appropriate format, initial it, bracket it, and direct that it be printed. Language such as the following should be used for printing purposes whenever possible:

“The English translation of \_\_\_\_\_ in the mark is \_\_\_\_\_.” or “The non-Latin characters in the mark transliterate to \_\_\_\_\_ and this means \_\_\_\_\_ in English.”

All non-English wording in a mark must be translated into English and the translation (and transliteration, if applicable) must be printed in the Official Gazette and on the registration certificate. A word is not a non-English word, for translation purposes, if it appears in an English dictionary (e.g., croissant or flambe).

Although generally it is unnecessary to provide a translation of a term of foreign origin if the term appears in an English dictionary, such terms may appear in marks as part of foreign idiomatic phrases or other unitary expressions. When these terms appear in such a phrase, it would be illogical to break the phrase into its individual word elements and to translate only the individual words which do not appear in the English dictionary. The result most often would be a translation which would serve no useful purpose as it would fail to convey the true commercial impression of the phrase. In such a case, the record should include a translation of the entire unitary phrase including the English-dictionary term.

Thus, if the mark included the phrase “la fiesta grande,” an appropriate translation should read “the great celebration” or possibly “the great fiesta.” It would be inappropriate to translate only “la” and “grande.” The ultimate goal is to provide a translation which is a true rendering of the meaning of the non-English wording in the mark and one which conveys the commercial impression engendered by the entire phrase.

Also, generally it is unnecessary to provide a translation of foreign articles or prepositions, such as “de,” “le,” “la” or “il,” when combined with English terms, since their meaning is generally understood and, in this context, they are being used to convey an impression different from or in addition to their foreign meaning. For example, in the instance of the mark “LE CASE,” it is unnecessary to translate “Le.”

#### 809.02 (a) Examining Attorney’s and Applicant’s Approval

The examining attorney should inform the applicant if the examining attorney does not approve for printing any translation which is in the record or approves only part of the translation in the record. The examining attorney may propose a translation, if he or she desires to do so. If there is to be a variation from the translation statement as it appears in the record, it shall be through an amendment by the applicant or an examiner’s amendment. A translation which is to be printed should have the approval of both the applicant and the examining attorney. The desirability of such approval is illustrated in *Simon & Schuster, Inc. v. Hachette, Inc.*, 166 USPQ 159 (TTAB 1970).

To indicate approval, the examining attorney should include a marginal notation in the file indicating that the translation is to be printed (e.g., “PRINT” or “OK FOR PRINTING”) with the examining attorney’s initials. If the examining attorney determines that a translation of record is not to be printed, the examining attorney should include an initialed marginal notation to that effect (e.g., “DO NOT PRINT”).

#### 809.03 Cross-filing on Basis of Translation for Purpose of Searching

When a certificate of registration includes a translation, copies of the certificate are filed in the Trademark Search Library and information is entered in the Office automated search system according to both the mark as shown in the certificate and the English translation of the non-English wording of the mark. This is done to facilitate the locating of similar marks.

It is obvious that printing vague translations, or a series of alternative meanings, would not be helpful and indeed could be a hindrance, and would be an undue burden on the Search Library and automated search system.”

[End of Annex IV and of document]