

SWIFT (SN 86/425,725) – office action response

Dual filing basis

Applicant does not wish to rely on Section 44(e) as a filing basis for this application, but does wish to retain the priority date of its foreign application under Section 44(d).

Likelihood of confusion

The examining attorney has refused registration under Section 2(d) of the Trademark Act, asserting that confusion is likely with the prior registered mark KOHANA (Reg. No. 4628136), on the basis that the cited registration indicates that KOHANA translated in English means “swift.” Applicant Apple Inc. (“Apple”) respectfully disagrees with the basis for the refusal.

“Under the doctrine of foreign equivalents, a foreign word (***from a language familiar to an appreciable segment of American consumers***) and the English equivalent may be held to be confusingly similar.” (Emphasis added) TMEP 1207.01(b)(vi)

The TMEP specifies that the “doctrine of foreign equivalents has evolved into a guideline, not an absolute rule, and is applied only when the ‘ordinary American purchaser’ would ‘stop and translate’ the foreign wording in a mark into its English equivalent.” 1207.01(b)(vi)(A).

There is no evidence that KOHANA is a “foreign word from a language familiar to an appreciable segment of American consumers” or that an “ordinary American purchaser [would] ‘stop and translate’ the foreign wording in a mark into its English equivalent.”

In the TSDR file wrapper for Reg. No. 4628136, the translation of KOHANA as “swift” appears in an Examiner’s Amendment, but nothing in the Examiner’s Amendment or elsewhere in the file identifies the foreign language or otherwise documents that “kohana” is actually a word in another language that translates to “swift”.

This office action does not identify the language in which “kohana” is a word, and does not provide a dictionary translation showing that “kohana” means “swift.” Thus, there is no reason to conclude that “kohana” is a foreign word from a language familiar to an appreciable segment of American consumers or that an ordinary American purchaser would stop and translate it. The doctrine of foreign equivalents does not apply in this situation.

Several different passages in the TMEP specify that Trademark Office bears the burden of demonstrating that the doctrine applies in a particular situation:

“Whether an examining attorney should apply the doctrine of foreign equivalents turns upon the significance of the foreign mark to the relevant purchasers, which is based on an analysis of the evidence of record, including, for example, dictionary, Internet, and LexisNexis® evidence.” 1207.01 (b) (vi)

“After conducting a complete search, an examining attorney must then assess whether a refusal under §2(d) may be warranted. If so, the examining attorney should research the English translation further using available resources, such as dictionaries, the Internet, and LexisNexis®, to ascertain whether there is sufficient evidence to support applying the doctrine.” 1207.01 (b) (vi) (B)

“The doctrine applies to words or terms from common, modern languages, which encompasses all but dead, obscure, or unusual languages. See *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1377, 73 USPQ2d 1689, 1696 (Fed. Cir. 2005). Thus, an examining attorney should provide evidence to show that the foreign language is a common, modern language.” 1207.01 (b) (vi) (B)

In fact, there is no reason to believe that the translation provided in the cited registration is accurate. A web search reveals no clear or obvious translation of “kohana”. The top hits in a Google search of “kohana translation” are references to the registrant, in which “translate/translation” is a technical computer term. (See Exhibit A) If a web search does not readily generate a translation, the ordinary American purchaser is clearly not going to “stop and translate” KOHANA.

There is further reason to doubt the credibility of the translation in the cited registration - another federal trademark registration that incorporates the term KOHANA has translated the term as “little flower”. (See Exhibit B) In the absence of a single clear translation for “kohana”, there is no basis for assuming that the ordinary American purchaser will understand the word to mean “swift”.

The term “kohana” appears in baby name dictionaries with two possible meanings: Japanese for “little flower”, and Sioux for “swift”. (See Exhibits C and D)

It’s possible that the cited registrant was offering the latter meaning for KOHANA to the examiner, but the doctrine of foreign equivalents does not apply for two reasons. First, the doctrine of foreign equivalents does not apply when the foreign word has an alternate meaning in the relevant marketplace that differs from the translated meaning in English. TMEP 1207.01(b)(vi)(B). Second, Sioux is spoken by only 20,000-30,000 individuals, exclusively in the northern United States and southern Canada. (See Exhibit E) The TMEP specifies that the doctrine does not apply to “obscure, or unusual languages”, and Sioux clearly falls within that category.

Because the doctrine of foreign equivalents does not apply, the examining attorney must compare Applicant's mark SWIFT with the cited mark KOHANA on its face. The marks are plainly distinguishable in sight and sound, and confusion is unlikely to occur. Applicant therefore respectfully requests that the examining attorney withdraw the Section 2(d) refusal, and approve this application for publication.