

September 20, 2019

Bridgett G. Smith
Trademark Examining Attorney
United States Patent and Trademark Office
Law Office 115

Dear Ms. Smith:

Applicant's Mark: FU XIONG MAO
Serial No. 88273058
Applicant: Design Works Studios, LLC
Cited Mark: PANDA RICHES, Registration No. 3793918.
Response to Office Action dated March 20, 2019

Applicant respectfully responds to the Office Action filed by the Examining Attorney with respect to the above referenced trademark application. The Examining Attorney refused registration based upon purported likelihood of confusion between an English translation of the Applicant's Mark and the Cited Mark. This refusal is based upon a legal doctrine entitled the "doctrine of foreign equivalents" which allows an Examining Attorney, in certain circumstances, to evaluate a trademark of foreign words against marks bearing the English translation of those foreign words. As explained in more detail below, Applicant believes that the Examining Attorney should not find a likelihood of confusion because: (1) the doctrine of foreign equivalents is not applicable; and (2) the commercial impression created by the Applicant's Mark is substantially different and distinctive from the commercial impression created by the Cited Mark.

1. The Doctrine of Foreign Equivalents is Not Applicable to Applicant's Mark.

A. American Consumers are Unlikely to Translate Fu Xiong Mao into English.

Under the doctrine of foreign equivalents, foreign words from common languages may be translated into English to determine genericness, descriptiveness, as well as similarity of connotation in order to ascertain confusing similarity with English word marks. *See In re Sarkli, Ltd.*, 721 F.2d 353 (Fed.Cir.1983); *In re Am. Safety Razor Co.*, 2 U.S.P.Q.2d 1459, 1460 (T.T.A.B.1987). That being said, the doctrine of foreign equivalents is not an absolute rule and should be viewed merely as a guideline. *In re N. Paper Mills*, 20 C.C.P.A. 1109, 64 F.2d 998, 999 (1933); *McCarthy on Trademarks*, at § 11:34. The doctrine should be applied only when it is likely that the ordinary American purchaser would "stop and translate [the word] into its English equivalent." *In re Pan Tex Hotel Corp.*, 190 U.S.P.Q. 109, 110 (T.T.A.B.1976). *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1377 (Fed. Cir. 2005). There are foreign expressions that even those familiar with the language will not translate, accepting the term as it is, and situations arise in the marketplace which make it unfeasible or even unlikely that purchasers will translate the names or labels. *In re Spirits Int'l, N.V.*, 563 F.3d 1347, 1352 (Fed. Cir. 2009). When it is unlikely that an

American buyer will translate the foreign mark and will take it as it is, then the doctrine of foreign equivalents should not be applied. *In re Tia Maria, Inc.*, 188 U.S.P.Q. 524 (T.T.A.B.1975).

An American consumer is unlikely to translate FU XIONG MAO, a transliteration of Chinese characters and not actual Chinese characters into English words in connection with the goods and services for which registration is sought. Instead, the American consumer is likely to simply see the words and recognize only that they reflect an English transliteration of Chinese words. The words, as written, do not translate into Chinese. They are letters that, when combined, sound like Chinese words.

B. The English Translation of Fu Xiong Mao is not Exact, Literal, or Direct.

If evidence shows that the English translation is unambiguously literal and direct, with no other relevant connotations or variations in meaning, the doctrine is applicable. See, e.g., *In re Ithaca Industries, Inc.*, 230 USPQ 702 (TTAB 1986). However, where the evidence shows that the English translation is not exact, literal, or direct, the doctrine of foreign equivalents has generally not been applied to find two marks to be confusingly similar. See *In re Sarkli*, 220 USPQ2d at 112-13 (holding REPECHAGE for various skin-products, and SECOND CHANCE for face creams and other toiletries, not likely to cause confusion, where the evidence failed to show that the terms were direct foreign equivalents); see also *In re Buckner Enterprises*, 6 USPQ2d 1316 (TTAB 1987) (holding DOVE (with design) for stoves and furnaces, and PALOMA for various forms of gas heating apparatus, not likely to cause confusion, because, *inter alia*, the Spanish word “paloma” and the English word “dove” are not exact synonyms in that “paloma” can be translated into either “dove” or “pigeon”) *In Re Dark Horse Distillery, LLC*, No. 85104448, 2012 WL 4832274, at *4 (Sept. 30, 2012).

Here, the phrase XIONGMAO is generally recognized as meaning “panda.” Applicant does not contest this. But, the word “FU” has many different meanings in Chinese and cannot be translated literally and exclusively as “Rich”—notwithstanding the translation in the Applicant’s application.¹ The Office Action does not include any independent evidence of the meaning of the transliterated terms in the Applicant’s Mark. A review of Chinese to English translations reveal that the word “FU” has numerous meanings. See printout from <https://chinese.yabla.com/chinese-english-pinyin-dictionary.php?define=Fu> attached hereto as Exhibit A. Because the phrase can have numerous meanings, the doctrine of foreign equivalents should not be applied and the Applicant’s Mark should be permitted to proceed to registration.

2. The Applicant’s Mark and the Cited Mark Create Materially Different Commercial Impressions.

Even if the doctrine of foreign equivalents is applied, such an application is only part of the determination of whether the marks being compared are confusingly similar. See *In re L’Oreal S.A.*, 222 USPQ 925, 926 (TTAB 1984) (noting that “similarity in connotation of the marks must be viewed as but a single factor in the

An Examining Attorney may not solely rely on the translation statements in the application, as they are not proof of the truth of the matter asserted. *In Re Dark Horse Distillery, LLC*, No. 85104448, 2012 WL 4832274, at *5 (Sept. 30, 2012) citing *British Seagull Ltd. v. Brunswick Corp.*, 28 USPQ2d 1197, 1200 (TTAB 1993). In addition, the translation statement is not included in the presumptions listed under Section 7(b) of the Act. *Id.*

overall evaluation of likelihood of confusion”). As noted earlier, appearance, sound, meaning and commercial impression are factors to be considered when comparing marks. Similarity of the marks in one respect, *e.g.* meaning, does not automatically result in a finding of likelihood of confusion even if the services are identical or closely related.

The Trademark Trial and Appeal Board was faced with a similar question in *In Re Les Collines, LLC*, No. 77871104, 2011 WL 3871944 (Aug. 19, 2011). There, an Examining Attorney had refused to register the mark "LES COLLINES" for vineyard and winery services on the ground that there was a likelihood of confusion with an existing registered mark "HILLS VINEYARD." LES COLLINES are French words that, when translated to English, mean THE HILLS.

In *In re Les Collines, LLC*, the examining attorney maintained that while the marks LES COLLINES and HILLS VINEYARD do not look or sound alike, the words “LES COLLINES” and “HILLS” have the same meaning to individuals who are proficient in both English and French. Because the English term “HILLS” or “THE HILLS” is a literal and exact translation of the French term “LES COLLINES,” the examining attorney insisted that the doctrine of foreign equivalents applied and prevented registration.

The Trademark Trial and Appeal Board found that the doctrine of foreign equivalents applied in that instance but also found, notwithstanding the application of the doctrine, there the commercial impression created by LES COLINES and THE HILLS were completely different. *In Re Les Collines, LLC*, No. 77871104, 2011 WL 3871944, at *6 (Aug. 19, 2011) *Id. at 6*. The TTAB found that "the differences between the marks in sound, appearance and overall commercial impression clearly outweigh the similarity in meaning when the doctrine of foreign equivalents is applied." *Id.*

In the present case, FU XIONG MAO and PANDA RICHES have a similar meaning when the doctrine of foreign equivalents is applied. But, as to commercial impression, FU XIONG MAO and PANDA RICHES engender overall commercial impressions that are completely different. The differences between the Marks in sound, appearance and overall commercial impression outweigh the similarity in meaning if the doctrine of foreign equivalents is applied.

3. **Conclusion.**

Based upon the arguments above, the Applicant respectfully requests that the Applicant's Mark be published and proceed towards registration. Applicant's counsel is happy to discuss the matters raised in this correspondence with the Examining Attorney.

Bridgett G. Smith
September 20, 2019
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Very truly yours,

GALLAGHER & KENNEDY, P.A.

A handwritten signature in black ink, appearing to read "JSB", written over a light blue horizontal line.

By:

Joshua S. Becker

JSB

EXHIBIT A
ENGLISH TRANSLATION OF CHINESE WORD "FU"

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Chinese English Pinyin Dictionary

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副

fù

secondary

auxiliary

deputy

assistant

vice-

abbr. for 副詞 | 副词 adverb

classifier for pairs, sets of things & facial expressions

[Example Usage](#) [Show Strokes](#)

付

fù

to pay

to hand over to

classifier for pairs or sets of things

[Example Usage](#)

付

Fù

surname **Fu**

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富

fù

rich

abundant

wealthy

 Example Usage  Show Strokes

富 

Fù

surname **Fu**

 Show Strokes

服 

fú

clothes

dress

garment

to serve (in the military, a prison sentence etc)

to obey

to convince

to admire

to acclimatize

to take (medicine)

mourning clothes

to wear mourning clothes

 Example Usage  Show Strokes


服 

fù

dose (measure word for medicine)

Taiwan pr. [fu2]

 Show Strokes

幅 

fú

width

roll

classifier for textiles or pictures


 Example Usage

附 

fù

to add
to attach
to be close to
to be attached


 Example Usage

福 

fú

good fortune
happiness
luck

 Example Usage  Show Strokes

福 

Fú

surname **Fu**
abbr. for Fujian province 福建省[Fu2 jian4 sheng3]

 Show Strokes

夫 

fū

husband
man
manual worker
conscripted laborer (old)

 Example Usage  Show Strokes

夫 

fú

(classical) this, that
he, she, they
(exclamatory final particle)
(initial particle, introduces an opinion)


 Show Strokes

父 

fù

father

 Example Usage  Show Strokes

府 

fǔ

seat of government
 government repository (archive)
 official residence
 mansion
 presidential palace
 (honorific) Your home
 prefecture (from Tang to Qing times)

 Example Usage  Show Strokes

赴 

fù

to go
 to visit (e.g. another country)
 to attend (a banquet etc)

 Example Usage

负 

Trad. 負

fù

to bear
 to carry (on one's back)
 to turn one's back on
 to be defeated
 negative (math. etc)

 Example Usage

扌 

fú

Japanese variant of 拂[fu2]

复 

Trad. 復

fù

to go and return
 to return
 to resume
 to return to a normal or original state
 to repeat

again
 to recover
 to restore
 to turn over
 to reply
 to answer
 to reply to a letter
 to retaliate
 to carry out

 [Show Strokes](#)

复 

Trad. 複

fù

to repeat
 to double
 to overlap
 complex (not simple)
 compound
 composite
 double
 diplo-
 duplicate
 overlapping
 to duplicate


 [Example Usage](#)  [Show Strokes](#)

腹 

fù

abdomen
 stomach
 belly

 [Example Usage](#)

佛 

Trad. 佛

fú

seemingly

辐 

Trad. 輻

fú

spoke of a wheel

麸 

Trad. 麩

fū

bran


辅 

Trad. 輔

fǔ

to assist
to complement
auxiliary

 Example Usage

俘 

fú


to take prisoner
prisoner of war

覆 

fù

to cover
to overflow
to overturn
to capsize

 Example Usage

浮 

fú

to float
superficial
floating
unstable
movable
provisional
temporary
transient
impetuous
hollow
inflated
to exceed
superfluous
excessive
surplus

 Example Usage
茯苓 

fú líng

Wolfiporia extensa (a wood-decay fungus)

fu ling

tuckahoe

妇 

fù

woman

Trad. 婦

 Show Strokes
功夫 

gōng fu

skill

art

kung fu

labor

effort

 Example Usage  Show Strokes
孵 

fū

breeding

to incubate

to hatch

脯 

fǔ

dried meat

preserved fruit

甫 

fǔ

(classical) barely

just

just now

杜甫 


Dù Fǔ

Du **Fu** (712-770), great Tang dynasty poet釜 

fǔ

kettle
cauldron馥 

fù

fragrance
scent
aroma Example Usage福 

fú

full up
classifier for items of clothing (old)弗 

fú

not

 Example Usage扶 

fú

to support with the hand
to help sb up
to support oneself by holding onto something
to help Example Usage傅 

Fù

surname **Fu**

俯 


fǔ

to look down
to stoop

敷 


fū

to spread
to lay out
to apply (powder, ointment etc)
sufficient (to cover)
enough

蝠 

fú

bat

市 

fú

see 鞞[fu2]

縛 

fù

to bind
to tie
Taiwan pr. [fu2]

Trad. 縛

仿佛 

fǎng fú

variant of 彷彿 | 仿佛[fǎng fú]

Trad. 彷彿

李开复 

Lǐ Kāi fù

Lee Kai-Fu (1961-), Taiwanese computer scientist and IT executive, from 2005 Vice president of Google and president of Google China

Trad. 李開復

 Show Strokes伏羲 

Fú Xī

Fuxi or **Fu Hsi**, legendary Chinese emperor, trad. 2852-2738 BC, mythical creator of fishing, trapping and writing

拂 

fú

to brush away

 Example Usage

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Browse Dictionary

剪枝 | jianzhi | jian zhi

剪草除根 | jiancaochugen | jian cao chu gen

剪贴簿 | jiantiebu | jian tie bu

剪头发 | jiantoufa | jian tou fa

副主任 | fuzhuren | fu zhu ren

副伤寒 | fushanghan | fu shang han

副国务卿 | fuguowuqing | fu guo wu qing

副州长 | fuzhouzhang | fu zhou zhang

剪纸 | jianzhi | jian zhi

剪裁 | jiancai | jian cai

剪辑 | jianji | jian ji

刷 | gua | gua

副主席 | fuzhuxi | fu zhu xi

副刊 | fukan | fu kan

副地级市 | fudijishi | fu di ji shi

副市长 | fushizhang | fu shi zhang

剪草机 | jiancaoji | jian cao ji

剪贴板 | jiantieban | jian tie ban

剪除 | jianchu | jian chu

副 | fu | fu

副作用 | fuzuoyong | fu zuo yong

副司令 | fusiling | fu si ling

副将 | fujiang | fu jiang

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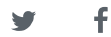
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