

TTAB Shows Brands How To Avoid Getting Lost In Translation

The Trademark Trial and Appeal Board's recent precedent rejecting an Alibaba subsidiary's bid to register a trademark that sounds out a Chinese word illustrates the challenges that trademarks involving non-Latin languages may face at the board, attorneys told Law360.

On Jan. 12, the TTAB **affirmed** an examiner's refusal to register Advanced New Technologies Co. Ltd.'s trademark application for "Zhima" to cover a range of goods and services — including payer authentication software, mobile phones and insurance services — for failing to provide a translation statement because "Zhima" is a Chinese word that means "sesame" in English.

The proceeding isn't a typical case before the board, partly because the mark itself is a transliteration — or a phonetic spelling in Latin characters — of a non-English, non-Latin character word.

Under the doctrine of foreign equivalents, a trademark in a foreign language will be examined the same as its direct English equivalent to determine whether the mark is descriptive. An applicant's refusal to provide an English translation or transliteration of the foreign word mark, however, will lead to the application being rejected.

The TTAB's new ruling doesn't necessarily preclude applicants from attempting to register foreign transliterations as trademarks, but attorneys say there are considerations to be mindful of, especially if they're also seeking to register trademarks in foreign characters.

"The takeaway is [that] if a foreign word is defined as having a meaning, you should enter the transliteration and translation statement," said Brian B. Darville of [Oblon McClelland Maier & Neustadt LLP](#). "If it is a rare case where the transliteration is not defined, then you can make the argument [the] applicant attempted [to refuse to provide a translation] in this case, but it will be an uphill fight."

In rejecting ANT's application, the TTAB pointed out that ANT also filed a co-pending application for the Chinese characters pronouncing "zhima." In that filing, ANT had stated that the non-Latin characters translated to "zhima" and meant "sesame" in English. The company's refusal to do so in the present case — and its argument that "Zhima" was a "coined term without any meaning" — is a bit perplexing given its earlier statements, attorneys say.

ANT's position may have been a "strategic attempt" to avoid a refusal based on a likelihood of confusion or third-party challenges, according to Sharoni Finkelstein of [Venable LLP](#). She notes that ANT's co-pending applications had been opposed by other companies on the grounds of a likelihood of confusion.

But ANT's argument failed when the TTAB cited a number of instances where the word "zhima" was used and recognized as the Chinese translation for sesame — including that Alibaba's website marketed sesame powder as "zhima powder" and that multiple news reports said Alibaba's social credit system Sesame Credit was also known as Zhima.

"The decision is also a reminder to clients that the [[U.S. Patent and Trademark Office](#)] regularly looks beyond the application itself — e.g., at the applicant's website — when considering issues like foreign equivalents or descriptiveness, and will not take at face value an applicant's statement which is contradicted by their use of a mark," Finkelstein told Law360.

The TTAB also took note that "Zhima" is the official Pinyin romanization — a system for rendering foreign words into the Latin alphabet — and in light of this, as well as the examiner's other evidence, it was reasonable for the board to require that ANT provide a statement that "Zhima" translated to English as "sesame," says Karen Lim of [Fross Zelnick Lehrman & Zissu PC](#).

"Otherwise, a loophole would be created whereby an applicant could evade the doctrine of foreign equivalents by claiming exclusive rights to a transliteration that relevant U.S. consumers would directly translate to an English word that might be descriptive of the claimed goods [or] services, or that might cause likelihood of confusion with a prior English mark," Lim said.

Examples include seeking a trademark for "Molihua" — the transliteration of the Chinese word for "jasmine" — that covers tea, or for "Resham" — the transliteration of the Hindi word for "silk" — that covers dresses.

The TTAB decision can further be seen as a reminder that the lack of translation makes an examiner's work more difficult, says Kenneth L. Wilton of [Seyfarth Shaw LLP](#), who notes that the case seems to be part of a recent line of opinions that focus on procedural rules not being followed by the parties — including one **penned by the same judge** in December.

The case "highlights one of the inherent challenges of prosecution, namely that statements made in one application might have then-unforeseen consequences in later applications or litigation," Wilton told Law360.

Counsel for ANT did not respond to a request for comment.