

Hearing:
March 3, 2011

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

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September 1, 2011
Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Harajuku Lovers, LLC

Serial No. 77474909

Jill M. Pietrini and Paul A. Bost of Manatt Phelps &
Phillips, LLP for Harajuku Lovers, LLC.

Heather Biddulph, Trademark Examining Attorney, Law Office
104 (Chris Doninger, Managing Attorney).

Before Bucher, Holtzman and Kuhlke, Administrative
Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Harajuku Lovers, LLC seeks registration on the
Principal Register of the following composite mark:



for goods identified as follows:

"cosmetics, namely, lip pencils, eye shadow, eyeliner, eyebrow pencil, eye pencil, lip gloss, lipstick, non-medicated lip balm, mascara, nail polish, blush, concealer, compacts, artificial eyelashes, artificial fingernails, nail polish top coat, nail polish base coat, lip foundation, and eyebrow gloss; skin care products, namely, astringent for cosmetic purposes, bath gel, bath oil, bath powder, beauty mask, body cream, body lotion, bubble bath, eye cream, skin moisturizer, essential oils for personal use, eye make-up remover, facial scrubs, make-up remover, shower gel, hand cream, massage oil, shaving cream, skin clarifiers, skin soap, skin emollients, sun screen preparations, suntanning preparations, depilatory creams, after-shave lotion, and anti-wrinkle cream; personal fragrances; hair care products, namely, hair dyes, hair conditioners, non-medicated hair care preparations, hair waving lotion, hair rinses, hair color removers, and hair shampoo; and incense" in International Class 3.¹

In the application papers, as amended, applicant proffered the following statement: "The non-Latin characters in the mark transliterate to 'baby,' and this means 'baby' in English."

¹ Application Serial No. 77474909 was filed on May 15, 2008, based upon applicant's allegation of a *bona fide* intention to use the mark in commerce. Color is not claimed as a feature of the mark. Applicant describes the mark as consisting of "a girl with an exaggerated large head, with curly hair and two hair ribbons, over a background of intermingled circles."

The Trademark Examining Attorney refused registration on the ground that inasmuch as the non-Latin characters in the mark are the equivalent of the term "baby," the designation is merely descriptive of a subset of the above listed goods under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), and hence the equivalent, unregistrable word "Baby" must be disclaimed as to a subset of the above listed goods under Section 6(a) of the Act, 15 U.S.C. Section 1056(a). The subset of goods are those that encompass goods that may also be intended for babies.² According to a dictionary entry proffered by the Trademark Examining Attorney, the term "baby" is defined as "an extremely young child; especially infant."

After the Trademark Examining Attorney made final the refusal to register based upon applicant's failure to comply with her requirement to disclaim the non-Latin characters that are the equivalent of the word "baby" apart from the mark as shown, applicant appealed to this Board.

We affirm the refusal to register.

² We note that during the prosecution of this application, the Trademark Examining Attorney suggested that applicant might want to amend its application to limit the broad identification of goods.

This refusal raises the question of whether the doctrine of foreign equivalents applies under the facts of this case. The Court of Appeals for the Federal Circuit has discussed the applicability of the doctrine of foreign equivalents in trademark cases as follows:

Under the doctrine of foreign equivalents, foreign words from common languages are translated into English to determine genericness, descriptiveness, as well as similarity of connotation in order to ascertain confusing similarity with English word marks ...

Although words from modern languages are generally translated into English, the doctrine of foreign equivalents is not an absolute rule and should be viewed merely as a guideline...

The doctrine should be applied only when it is likely that the ordinary American purchaser would "stop and translate [the designation] into its English equivalent." *In re Pan Tex Hotel Corp.*, 190 USPQ 109, 110 (TTAB 1976).

Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1696 (Fed. Cir. 2005).

In the *Pan Tex Hotel* case referred to by the Court of Appeals for the Federal Circuit, the Board held that "there can be no doubt that the notation 'LA POSADA' and its English equivalent 'the inn' create different commercial impressions. That is because of the setting in which applicant uses 'LA POSADA,' it is not likely that purchasers would stop and translate said notation into its

English equivalent." 190 USPQ at 110. The Board pointed out that the Spanish term had an "added implication of a home or dwelling, and thus has a connotative flavor which is slightly different from that of the words, 'the inn.'" *Id.* Similarly, we have had occasion to apply the doctrine of foreign equivalents to marks containing Asian characters. *In re Oriental Daily News, Inc.*, 230 USPQ 637, 638 (TTAB 1986) ["[W]e see no reason why descriptive words represented by Chinese characters should be treated any differently from descriptive words in other contemporary languages"]. Furthermore, "[t]he Board has determined that the 'ordinary American purchaser' in a case involving a foreign language mark refers to the ordinary American purchaser who is knowledgeable in English as well as the pertinent foreign language." *In re Peregrina Ltd.*, 86 USPQ2d 1645 (TTAB 2008); see also *In re Thomas*, 79 USPQ2d 1021, 1025 (TTAB 2006). In this case, the foreign language is Japanese - a modern language spoken by hundreds of thousands of persons in the U.S., according to information placed into the record. See also *In re Ithaca Industries, Inc.*, 230 USPQ 702, 703 (TTAB 1986) ["[I]t does not require any authority to conclude that Italian is a common, major language in the world and is



spoken by many people in the United States."]; and *In re Thomas*, 79 USPQ2d at 1024 [French is a common foreign language spoken by an appreciable segment of the population].

The Trademark Examining Attorney has submitted an entry from www.excite.co.jp/world/english that translates the Japanese characters **ベイビー** into English as "baby." The Trademark Examining Attorney contends that these Japanese characters are "the literal and exact translation of the English word 'baby.'" Hence, she argues that prospective buyers of some of applicant's listed items in the U.S. who are familiar with the Japanese language "would stop and translate the Japanese characters to 'baby' because these characters transliterate and translate only to 'baby.'"

By contrast, applicant argues in its brief that the term may be seen as totally arbitrary, or that the transliterated term "BABY may be understood in light of its slang definition as a term meaning 'girl' or 'woman' ... [or] BABY may be otherwise interpreted as an exclamation of sorts, e.g., 'Yeah, baby!,' in which case, as applied to applicant's products, the term BABY

would connote the excitement or sexual appeal of the products." Under applicant's theory, the English-language word "baby," as also seen in dictionary entries of record, suggests usage like "yeah, baby!" -- the kind of thing that rambunctious boys on the streets of the Harajuku District of Tokyo may well be heard saying aloud to girls and young women. Applicant focuses in its brief on the popularity of Gwen Stefani and her backup singers, the Harajuku Girls, and the collateral success of her Harajuku Lovers line of cosmetics and bath and body care products involved herein. Applicant takes the position that the prominent design of a girl in this composite mark is a caricature of Mayuko Kitayama, the youngest of Gwen Stefani's four Harajuku Girls, whose stage name is "Baby."

In our view, this case turns on a factual query: Would persons fluent in the modern Japanese-language who see **ベイビー** used in connection with a line of bath and body care products view it as referring to an infant, on the one hand, or contrariwise, as a slang expression for a girl, a young woman, or even as the proper name for a musical performer?

In spite of applicant's arguments in its briefs and during the oral hearing held before this panel of the Board, we find no evidence in the record confirming that the Japanese term at issue suggests a slang definition of "baby" (i.e., as a term meaning "girl" or "young woman") or would be seen as a proper noun, a nickname, a stage name, etc. Despite applicant's arguments about the specific way in which Harajuku Lovers products are marketed, we find no evidence in the record that rebuts the showing of the Trademark Examining Attorney, namely, that the relevant American purchaser who is fluent in Japanese would understand this notation as having the connotative flavor of "an infant," when viewed in the context of goods intended for babies. In fact, applicant seems to concede the same with its statement of record that "The non-Latin characters in the mark transliterate to 'baby,' and this means 'baby' in English." These characters in *katakana* script help Japanese speakers to pronounce correctly a word borrowed from the English language. However, in addition to applicant's agreeing that the term transliterates to "baby," applicant also

adds that these Japanese characters at dispute herein, ベイビー, mean "baby" in English. If indeed, the Japanese speaker stops and translates these four Japanese characters into a usage of "baby" understood to mean an infant or young child, we must affirm the position of the Trademark Examining Attorney. That is, the matter at issue, when translated into English, is a merely descriptive term for a subset of these goods.³

In summary, we are convinced that consumers familiar with the Japanese language who see the characters ベイビー on any of the subset of goods, e.g., bath and body care products that could well be intended for babies, would conclude that the designation connotes a small child or infant, and hence, that such a designation would be merely descriptive for applicant's bath and body care products appropriate for use on small children or infants.

Decision: The refusal of the Trademark Examining Attorney to register applicant's mark for a subset of the goods on the ground that the Japanese characters ベイビー

³ We explicitly find that applicant's broadly-identified, non-cosmetic goods do encompass specific bath and body care products of the same generic categories intended for babies.

comprise the merely descriptive word, "baby," that must be disclaimed, is affirmed. Nonetheless, in accordance with Trademark Rule 2.142(g), this decision will be set aside, if applicant, no more than thirty days from the mailing date of this decision, submits an appropriately worded disclaimer, as follows:

No claim is made to the exclusive right to use the non-Latin characters that are the equivalent of the word "baby," apart from the composite mark as shown, as applied to the following goods: "non-medicated lip balm, bath gel, bath oil, bath powder, body cream, body lotion, bubble bath, skin moisturizer, essential oils for personal use, shower gel, hand cream, skin soap, skin emollients, skin clarifiers, massage oils, sun screen preparations; sun tanning preparations; hair conditioners, non-medicated hair care preparations, hair rinses and hair shampoo."

In the event that applicant does not submit such a disclaimer, after expiration of the appeal period, the subset of goods listed above will be deleted from the identification of goods, and the application will be forwarded to publication.