

Confusing Similarity in a Multilingual Market

by Chris M Neumeyer



Two years ago, the news and information portal *whatshappenin.com* sued its Spanish-language counterpart *quepasa.com* for infringing its trademark. By applying the doctrine of "foreign language equivalents", plaintiff's attorney claimed, defendant's domain name should be translated into English and found to be confusingly similar to plaintiff's mark. While that case (which settled without trial) may initially seem humorous, it presaged the increasing challenges we will face as we attempt to apply a confusing similarity standard to domain names on the Internet — a multilingual forum.

According to a study by Global Reach, a marketing communications consultancy firm, more Internet users were native speakers of English (45% of all users) than any other language as of June 2001. Japanese was second at 9.8%, Chinese third at 8.4%, followed by German, Spanish and Korean. But already, the study shows, no single language comprises the native tongue of a majority of Internet users. Moreover, the study predicts that by 2003 native English speaking

users will increase from 217.8 million to just 230 million, while Chinese speaking users will increase from 40.7 million to 160 million.

When determining whether a domain name infringes on the rights of a trademark holder, the laws and dispute resolution policies of most countries all ask the same question: Is the name confusingly similar to a protected mark? If Internet users all spoke the same language that question might be reasonable. But we don't. So the question is, who must find the names confusingly similar: speakers of the language where the complainant resides, the respondent resides, the domain name is registered, the trademark rights exist, or some other option? As will be shown below, there is no easy answer.

Confusing similarity can result from unfamiliarity with a language

So far, most domain name disputes are resolved under ICANN's Uniform Dispute Resolution Policy (UDRP),

which simply prohibits any name that is "identical or confusingly similar to a trademark or service mark in which complainant has rights". The UDRP does not specify who must find the marks confusingly similar. The Rules permit disputes to be resolved through application of any principles of law that the panel deems appropriate. Under US law, to establish trademark infringement, one must prove use of a mark that is likely to cause mistake or confusion, or to deceive concerning the origin or sponsorship of goods or services. Likelihood of confusion is generally determined based on the "reasonably prudent consumer". But who is the consumer of a domain name that is transmitted to the entire global population? What language does that consumer speak?

The fact that Internet users who speak different languages might be confused by a domain name was noted in several cases involving criticism websites. Regarding *adtsucks.com*, one panel held, "Although 'sucks' could make an English speaker consider that the name does not promote the

Internet: Confusing similarity in a multilingual forum

Complainant or its products, not every user of the Internet is well versed in the English language. Consequently, a user could be led to believe that any name using the world-famous mark is associated with the Complainant" (WIPO D2001-0213).

The same reasoning resulted in findings of confusing similarity and transfers of guinness-sucks (WIPO D2000-0996), accorsucks (WIPO D2001-0007), vivendiuniversalsucks (WIPO D2001-1121) and antiphilips (WIPO D2001-0163).

Two points should be noted about those cases. First, except possibly for accorsucks, whose registration agreement was in French, there was no particular reason to assume that any of the above domains was aimed at non-English speaking consumers. Second, although WIPO panels are authorised to apply any law that they see fit, the above cases all deviate from US case law in granting transfers not based on a likelihood of confusion, but instead based on a mere possibility of confusion. That lesser standard is not necessarily wrong, however, because neither the UDRP nor any other dispute policy specifies how one should ascertain confusing similarity.

Some confusion is inevitable in a multilingual market

In a decision similar to the above ones, the Spanish bank La Caixa was granted a transfer of lakaixa.com, which according to the panelist was linked to a website "used for a political anti-capitalist parody" of the complainant. The panelist explained that "in several Latin languages, it has become common to substitute the letter 'k' to the letter 'c' in order to express a left-wing or anarchist protest". In addition to its name, the website made a "liberal use of the letter 'k' in the above countercultural sense". Despite this apparent recognition of a legitimate interest, the panelist found not just confusing similarity but bad faith by the respondent, because the substitution of 'k's for 'c's is "part of a counterculture Latin jargon and is unlikely to be understood by most Internet users throughout the world" (WIPO D2001-0360). The UDRP, this panelist held,

"should, obviously, be interpreted with reference to the majority of the Internet users."

But how is that possible? If no single language is the mother tongue of a majority of users, what language should we assume that the "reasonably prudent consumer" speaks? With country code domains such as .de or .fr, one can ask whether the average German or French person would likely be confused, but that is not possible for generic domains. One could look for confusion among speakers of the primary language where the name was registered, but the above decisions implicitly reject that approach. One could look for confusion where the complainant resides; but if complainant is an international entity, then what? Or one could revert to asking whether native English speakers would likely be confused, because English is

the most widely spoken language on the Internet. But some would argue that is unfairly biased.

Several US Circuit Courts have established criteria to consider when ascertaining the likelihood of confusion in trademark infringement cases, such as the following factors employed by the Ninth Circuit:

- (1) strength of plaintiff's mark;
- (2) proximity of the goods;
- (3) similarity of the marks;
- (4) evidence of actual confusion;
- (5) marketing channels used
- (6) type of goods and degree of care likely to be exercised by purchasers;
- (7) defendant's intent in selecting the mark; and
- (8) likelihood of expansion of the product lines.

Unfortunately, those factors were developed before the Internet and they fail to mention language of the consumers. Perhaps the most pertinent factor is (5), the fact that domain names are transmitted worldwide to a multilingual market. But what does that mean when we ask if consumers are likely to be confused? If no language is the native tongue of a majority of users, one could argue that a majority of users is always likely to be confused. In *Brookfield Communications*, while the Ninth Circuit did not address the subject of

different languages, the court did explain that "we must be acutely aware of excessive rigidity when applying the [factors] in the Internet context; emerging technologies require a flexible approach."

Country code domains don't resolve the dilemma

In addition to generic domain names, many entities use country code domains in countries where they do business, to provide localised marketing and increased search engine performance in local languages. While country code domains lessen the dilemma, they do not resolve it. As noted above, if a dispute arises between a multinational trademark and a domain name ending in .de or .fr, one might ask whether a reasonably prudent speaker of German or French would likely be confused.

But there are currently about 250 country code domains throughout the world. What if the domain ends in .ch for Switzerland, where three official languages are spoken? Or .sg for Singapore, with four official languages? Or .in for India, whose constitution recognises 18 different languages? Or .pk for Pakistan, whose official language, Urdu, is spoken by only 10% of the population? What language does the reasonably prudent consumer speak in those countries? Won't there always be a significant portion of Internet users who may be confused?

Even if the UDRP did provide a reasonable mechanism for determining confusing similarity, fewer than 30 country code domains are governed by the UDRP. The majority of domain name registries do not offer dispute resolution services at all, but force complainants to rely exclusively on the courts to resolve their disputes, so the outcomes will vary with the laws of each country and the predilections of each judge.

The doctrine of foreign equivalents provides some guidance

When determining whether a trademark consisting of foreign words is an

Internet: Confusing similarity in a multilingual forum

unprotectible generic description, US courts have long applied the "doctrine of foreign equivalents". Under the doctrine, the foreign words are first translated into English before making that determination. Thus, in one case, the word Otokoyama and the Japanese characters from which it was transliterated were deemed unprotectible as a brand name for sake because they signify a generic word for sake.

More to the point, the US Trademark Trial and Appeal Board applied the doctrine in 1999 to find likelihood of confusion between the marks D'ORO and D'GOLD, on the grounds that 'oro' is both Spanish and Italian for gold (and due to stylistic similarities between the marks). The TTAB explained that under the doctrine, "marks which consist of or contain foreign words from modern languages are translated into English to ascertain, *inter alia*, whether they are confusingly similar to English word marks... . The rationale behind the rule is that a foreign word familiar to

an appreciable segment of American purchasers may be confusingly similar to its English equivalent, or vice versa." The decision fails to specify what is an "appreciable segment" of potential purchasers.

If one follows the *D'Oro* decision, one must probably conclude that quepasa.com infringes on whatshappenin.com, because they mean roughly the same thing. But is that reasonable? Is *pequenodulce* (Spanish) an infringement of Microsoft? What about *petitdoux* (French) and *kecilmanis* (Indonesian)? Already trademark owners have expanded their rights tremendously on the Internet, seizing exclusive world-wide rights to their marks and any confusing variations on the marks, often in all generic and country code domains. Should they also own the right to all translations of the mark — and variations on the translations? Many would argue that such a policy goes too far and unfairly suppresses speech around the globe. In any event, the *D'Oro* case is not

citable as precedent, and it should not be followed.

The foreign equivalents doctrine was applied more moderately by the UK Trademarks Office in 2000, regarding marks for AGUA FRESCA and COOL WATER toiletries. The hearing officer refused to find a likelihood of confusion because the evidence failed to show a single undisputed meaning for the words *agua fresca* (*fresca* could mean fresh as well as cool). Moreover, the officer explained that, as stated in the UK's 1938 Trademark Act, the foreign equivalent doctrine should not be applied too rigidly, and confusion requires that the two marks be visually or phonetically similar. For example, German *enkle* conflicts with English ankle; French *promesse* conflicts with English promise. On the other hand, German *dom* does not conflict with cathedral; French *chien* does not conflict with dog. Thus, *ciudadbanco.com* might be an infringement of Citibank, but the examples in the above paragraph would all be permitted.

Count on us. For the fourth year in a row,

the *LEXPERT/American Lawyer Guide to the Leading 500 Lawyers in Canada* has identified Smart & Biggar as having more leading lawyers in the areas of intellectual property law and intellectual property litigation than any other firm. We are proud of this recognition and congratulate all of our partners who are listed in this year's Guide.

Ottawa | Toronto | Montreal | Vancouver | Edmonton

SMART & BIGGAR
FETHERSTONHAUGH

Barristers & Solicitors • Patent & Trade-mark Agents

www.smart-biggar.ca

Internet: Confusing similarity in a multilingual forum

Multilingual domain names increase the confusion

If confusing similarity was uncertain before, the addition of multilingual domain names only complicates matters. Domain names using Chinese, Japanese, and Korean characters have been in use for about a year. Other characters will soon be available, with registrars now taking applications for names in characters ranging from Algonquin to Zulu.

While this internationalisation of the Internet is understandable given that most people do not speak English as a first language, it is causing increased uncertainty. The attention has focused primarily on technical difficulties and questions of who should be allowed to register names in new characters and resolve disputes between them. Admittedly, those issues are of primary significance. But even when those issues are resolved, questions regarding how to ascertain confusing similarity will multiply with the addition of new characters, as the following cases illustrate.

In one case, the publisher of a Japanese newspaper (Sankei Shimbun Co.) complained that a name consisting of Asian characters ending in .com, that was registered in the US by a Korean citizen allegedly infringed on its Japanese trademark. Despite finding that the characters in the name and the mark were different in shape, the panelist found confusing similarity and granted a transfer (WIPO D2001-0620). Two issues are troubling about the case. First, the Chinese sole panelist described complainant's Japanese trademark as "Chinese words". On the contrary, many Chinese and Japanese characters are identical, but the name of this Japanese newspaper uses Japanese, not Chinese, characters. Second, the panelist stated, "From Chinese users' point of view, the two words have just the same meaning and same pronunciation". But why consider confusion among Chinese users? The complainant and its mark were Japanese; the respondent Korean; the registrar American. Wouldn't it make more sense to ask if Japanese users might be confused?

In another case, Dow Chemical

Company alleged that a name consisting of Japanese Katakana characters ending in .com, that was registered in the US, infringed Dow's trademarks in Japan. That panelist also found confusing similarity and granted a transfer (E Resolution Decision AF-0747). The outcome was reasonable as Dow had wisely registered not only its English language trademark but also a Katakana version, to which the disputed name was identical. But, the decision is flawed. In addition to finding the two Katakana versions identical, the panelist stated that the domain name translates to 'daukemiaru', which he found "phonetically confusingly similar to Complainant's DOW and DOW CHEMICAL trademarks". That finding is clearly erroneous: it seems inconceivable that anyone could confuse daukemiaru for Dow.

But that's not the only problem with the decision. To find confusing similarity, the panelist first translated the Katakana domain name to Roman characters, then looked for similarity. Because Dow is a coined word, however, it cannot be translated. The Katakana actually translated to mean three movements in sumo wrestling; it only sounds vaguely similar to Dow Chemical when pronounced. This is a new application of the doctrine of foreign equivalents — to find confusing similarity because words in two different languages sound similar — and it is problematic. Given the more than 2,700 languages that are spoken on Earth, it is doubtful whether any trademark exists that does not sound similar to a word in some other language (See WIPO D2000-0376, where a German panelist describes the trademark TONSIL as an invented word, unaware that it is a common English word).

In stark contrast to the above cases, the panelist in another multilingual name dispute refused to apply the doctrine of foreign equivalents at all, coming to the straightforward conclusion that the name and the mark could not be confusingly similar because they were in different characters: "... Complainant registered its company name in Chinese characters form instead of in English character form... The Chinese name of the company looks very different than the domain name huangshan.com

which is in English character form" (E Resolution Decision AF-0202).

Practical implications

While the world's dispute resolvers are unlikely to reach a consensus on how best to ascertain confusing similarity in domain name disputes, the practical implications are clear. Given the costs and uncertainty of disputes, companies should develop comprehensive global intellectual property strategies, registering domain names and trademarks in all countries where the company does business or wishes to protect its rights.

Not only should each of the company's marks be registered as a domain name in all generic domains and relevant country code domains, but a translation of the mark should also be registered as a name in desired country code domains, including multilingual versions when applicable. In addition, although the decisions cited above found sucks.com names to be confusingly similar, many decisions rule otherwise, so companies wishing to prevent use of such domains should consider registering those names as well.

Before registering country code domain names, check the local requirements. Many jurisdictions require local registration of the trademark before a corresponding name may be registered; others require the domain name to be registered in English first before a translation may be registered. And, before issuing any press releases concerning mergers, acquisitions or new product developments, protect any new brand names through proper trademarks and domain names.

Finally, keep in mind that if your trademark/domain dispute ends up in litigation rather than before a dispute resolution panel, jurisdictions that offer a cause of action similar to a US claim for dilution, may not even require proof of confusing similarity so long as the other conditions are met.

© Chris M Neumeyer 2002.

The author is a California attorney living in Taipei.