LOOKING FOR A NEEDLE IN A HAYSTACK: LIMITATIONS OF SEARCHING FOREIGN TRADEMARK ON TESS

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I. Introduction

Every element of a design mark in a US federal trademark application is assigned a design search code, a numerical classification index that codifies design figurative elements into categories, divisions and sections. There are 29 categories with hundreds of sub divisions and sections per category. Design search codes act as the equivalent of a filing system by which all possible design elements can be searched. However, symbol-based foreign languages are classified in one of only five categories. Since all syllable-based logographies (Chinese, Japanese, etc.) are assigned only five design search codes, an Examiner's ability to search the mark as a design is extremely limited. To avoid approval of similar marks, an Examiner would have to compare the foreign mark to every other existing mark in the same category–an impracticality given that there are tens of thousands of logographic marks that exist. As such, an Examiner can search only the literal translation and phonetic translation of a foreign mark, so confusingly similar marks may be very well approved by the USPTO. This paper draws attention to the problem and investigates the abilities of other foreign trademark offices to perform comparable searches for foreign words. This paper begins by discussing how lingual communication functions in trademark and the difference between trademark in alphabetic language and logographic language. Next, it introduces functionality and limitation of USPTO for searching for foreign trademarks. By showing an example of foreign trademark search, it visualizes the problem of the TESS (Trademark Electronic Search System) database, from which reason of failure from linguistic perspective is also discussed. Ultimately, it suggests that technology of search system should be exchanged for the improvement on the reliability of TESS which would reduce the possibility of similar foreign marks being approved.

II. Language and Trademark

Language is the principal vehicle for transmission of cultural knowledge, and the primary means by which we gain access to the contents of others' mind.[1] With interactive conversations and correspondence, people are able not only to express what they think but also receive what others think. They talk, deliver speeches, or write letters, with the assistance of words and phrases, to convert an abstract idea into a vivid expression. Similarly, trademarks, in forms of a specified word or a visual picture, they carry an implicit message that is received and processed by the recipient, and such fall into the realm of linguistic pragmatics,[2] meaning that people understand trademarks not only relying on the meaning of the words or pictures per se, but how words or pictures associate with the goods or services. For example, MAC as a symbol may represent a short version of MacBook to tech geeks, but it may also mean MAC Cosmetics to fashion lovers. Based on their previous knowledge, people link the symbol of the trademark to the goods or services that they are familiar with. In this sense, trademark as a sign representing objects as representative, turns upon all the inferential process.[3] Additionally, trademarks which serve as a form of communication deliver two-fold messages. On the surface, trademarks with common semantic meanings enable consumers immediately understand the meaning and link the meaning to the products. In deeper sense, trademarks as indicators represent the quality and reputation of goods and services, so consumers can quickly make their purchasing decision. This is easily understood that you may choose a Burberry tote because you resonate with its luxury and Burberry using its trademark takes a shortcut to straightforwardly deliver this feature to you.

Ideally, the communicative purpose of trademarks should deliver only one fold message and merely indicate the source of goods or services. The best marks are those that solely indicate the source of the product or service at issue.[4] Such marks are known as fanciful, coined or arbitrary marks, which are either totally unknown in the language or are completely out of common usage at the time.[5] Fanciful or arbitrary marks are the best because the semantic detachment from the source makes them unique and distinctive, another's use of which may confuse consumers the most[6] so that those marks are entitled with the strongest protection. If trademarks also carry semantic meanings which suggest, describe or even embody the associated goods or services, the strength of trademarks as indicators gradually weakens. Those are suggestive, descriptive and generic marks.

Foreign trademarks, the semantic meanings of which are meaningless to

[1] Robert M. Krauss & Chi-Yue Chiu, *Language and Social Behavior*, *in* The Handbook of Social Psychology 42 (Daniel T. Gilbert, Susan T. Fiske & Gargner Lindzey eds., 1998).

[2] Martin Solly, *'Once a Trademark, Not Always a Trademark': Using Language to Avoid Legal Controversy*, *in* Conflict and Negotiation in Specialized Texts: Selected Papers of the 2nd CERLIS Conference 215 (Maurizio Gotti, Dorothee Heller & Marina Dossena eds., vol. 32002).

[3] *Id.*

[4] Karol A. Kepchar, *Selecting and Searching Trademarks*, SH085 ALI-ABA 13, 15 (April 10-11, 2003).

[5] Anderson v. Upper Keys Business Group, Inc., 61 So.3d 1162, 1168 (Fla. Dist. Ct. App. 2011).

[6] Entrepreneur Media, Inc. v. Smith, 279 F.3d 1135, 1141 (9th Cir. 2002).

naïve readers (people who do not speak the language), therefore, are able to serve as pure indicators of goods and services as well. In this regard, foreign trademarks have equivalent functions as fanciful trademarks. In this section, I will explain the communicative function of language, show how the communicative function differs when it comes to trademarks and foreign marks, and reveal the impact of foreign trademarks in alphabetic and in logographic languages to the public recognition.

A. Function of language: communication

1. *Linguistic function and dysfunction of communication*

The primary function of language is communication; it is a means of conveying information to another.[7] Communication is about giving and receiving of signs which have meanings attached to them.[8] Letters, alphabets, punctuation marks, ideograms, logos and words are examples of signs,[9] which contain information. With different signs, people are able to understand the outside world and eventually accomplish the purpose of communication. For example, STOP as a sign to stop people from crossing the street can be manifested as either a red light, a repeated audio sound, or a board writing STOP on it. People who speak English normally understand the sign in a similar way and agree that STOP is a sign for halt, so the communication is meaningful. A sign can only be a sign if we assign meaning to it, or it will be useless if one does not know the meaning.[10] This is true especially for foreign languages that we have never exposed to, with which communication will fail because signs lose their meanings to us.

Language, especially in its written form, is thought to contain special powers, which only the initiated are allowed to understand or control.[11] This idea was deemed highly in ancient times when law makers preserved the ultimate right to interpret laws and rules. It is also the case in modern time because the speaker knows better than anyone else about what he says and what he means. Communication will break down if there is no continuity or coherence to a speaker's discourse.[12] For example, in a dialogue, the speaker needs to use similar vocabulary, refer to what the previous speaker just said and develop the topic to keep the conversation going.[13] Mutually, if lack of comprehension falls on the listener, communication cannot continue as well. The dysfunction of communication happens because the message delivered by the sender is either purposefully covert[14] or unconditionally incomprehensible. When message be-

[7] Elizabeth Armstrong & Alison Ferguson, *Language, Meaning Context and Functional Communication*, 24 Aphasiology 480, 482 (May 18, 2010).

[8] Richard Dimbleby & Graeme Burton, More Than Words: An Introduction to Words 27 (3rd ed. 1998).

[9] Solly, *supra* note 2.

[10] Dimbleby & Burton, *supra* note 8.

[11] Solly, *supra* note 2, at 214.

[12] Armstrong & Ferguson, *supra* note 7.

[13] *Id.* at 482.

[14] Dimbleby & Burton, *supra* note 8, at 24.

ing purposefully covert in a piece of communication, it is possible that within this communication there are more messages included.[15] Semantic meaning is on the surface, but the receiver of the hidden messages is expected to decode the meanings behind, so the communication is ideally effective. For example, a cosmetic commercial could expressly introduce functions of a facial cleanser but the covert message might be that consumers using the product are able to have the same flawless skin as the actress in this commercial. It is risky for sellers to promote the idea of flawless skin, but the actress in commercial can hint this exaggerated function. However, consumers as the recipients, if they are not aware of the hidden meanings delivered in this commercial, the communication is not fully successful. Another reason for dysfunction of communication is when the message is unconditionally incomprehensible. One possibility is that the recipient is incapable of command of the language that the sender uses to deliver the message, so the receipt of the message is meaningless. For example, a monolingual who speaks French cannot talk with another monolingual who speaks Chinese. They need a bilingual interpreter to help switch the codes and bridge the gap, otherwise dysfunction of communication is unavoidable.

In short, language can assist communication, but purposefully covert and unconditionally incomprehensive messages will possibly destroy the flow of communication.

2. *ALPHABETIC LANGUAGE VS. LOGOGRAPHIC LANGUAGE*

The number of languages in this world is estimated from 5,000 to 7,000, but writing systems are mainly classified into three c ategories: logographic characters, syllabic characters and alphabetic characters. Chinese or Japanese Kanji (the adopted Chinese characters) is logographic characters. Japanese Kana, the character of which corresponds to one sound in the Japanese language, is syllabic characters. English letters are alphabetic characters.[16]

Characters in different writing systems have their own features. For logography, it compasses both ideography and phonography.[17] Ideography means that the graphic sign contains meanings. Chinese character "虫" is a graphic sign, the meaning of which is insect and usually used in other characters to imply the meaning of insect or animal. Phonograph indicates a phoneme or a syllable.[18] The same phonograph can be used in different characters to represent the same sound but words that it constitutes have different meanings. Take "下" in Chinese, whose pronunciation is Xia, as an example. "虫" and "下" can constitute another character "虾", whose pronunciation is Xia and meaning is "shrimp". In this character, "虫" indicates the meaning while "下" represents the sound.

Chinese characters have traditionally been considered to be made up of

[15] *Id.* at 25.

[16] Hsuan-Chih Chen & James F. Juola, *Dimensions of Lexical Coding in Chinese and English*, 10 Memory & Cognition 216 (1982).

[17] Taro Kogure, *Dynamics of Logography*, 37 Sophia Linguistica 103, 105 (1994).

[18] *Id.* at 104.

three elements: graphic forms, phonic forms, and meaning,[19] a combination of phonography and ideography, since ideography includes both aspects of meaning and graphic form. Early studies show that the visual aspects of Chinese characters are particularly important in terms of helping to differentiate and identify a character among other,[20] therefore confusion often happens when two characters look similar. One stroke might cause a huge difference in meanings. Compare "人" and "入": the first character means "people" while the second one means "enter". They look confusingly similar but meanings of both are hugely different. Regularly, pupils in elementary school are tested to distinguish characters with similar forms in order to strengthen fundamental skills of Chinese writing. Since ideography serves the purpose of delivering messages based its graphic forms, visual aspect is a significant element to logographic language.

Unlike logographic writing systems which demand a greater dependence on visual strategies, phonetic-based writing systems tend to depend more on phonological strategies.[21] The appearance of Chinese characters is more focused whereas English concentrates more on the sound of a word. This is because alphabetic languages and logographic languages have different levels of phonological transparency and morphological transparency, as they provide more or less phonological and morphological information.[22] English is more phonologically transparent than Chinese while Chinese is more morphologically transparent than English. An interesting example is child learners of alphabetic writing systems need the ability to segment spoken language into phonemes, whereas Chinese children need the ability to identify morphemes.[23] Another example is that it is impossible for readers to pronounce a coined Chinese character with random combination of strokes, or even an unfamiliar character. In contrast, rules of pronunciation in alphabetic language enable readers to pronounce a made-up word, the meaning of which may be unknown or nonexistent. It is safe to say that the sound of a word is essential to alphabetic languages.

3. *IMPACT OF FOREIGN LANGUAGES*

As mentioned before, signs are useless if no meanings are assigned to them. Foreign languages can be useless signs to people who cannot speak the language. Visual aspect of signs, however, is the only element among sight, sound and meaning of a word that can make some sense to naïve readers due to its nature of display. Though readers have no idea of the sound and the meaning of a foreign word or character, they tend to focus on how it looks. In their eyes, foreign words or characters are basically pictorial. This is worth the attention because foreign languages cannot compete against native languages to

[19] *Id.* at 105

[20] Chen & Juola, *supra* note 16, at 223.

[21] *Id.* at 217.

[22] Benedetta Bassetti, *Bilingualism and Writing Systems*, *in* Handbook of Bilingualism and Multilingualism 1 (2nd ed. 2012).

[23] *Id.*

well serve the purpose of communication to naïve readers. No meaning is attached to foreign word or character without translation, so it is almost impossible for naïve readers to understand what the word or character means. Under this circumstance, foreign languages fall into the unconditional incomprehension category of the dysfunction of communication. Without meaning, foreign words or characters reduce to sheer visual signs.

B. WORD TRADEMARK AND FOREIGN WORDS AS TRADEMARKS

1. *COMMUNICATION THROUGH TRADEMARKS*

Although trademarks are traditionally viewed as identifying the origin or source of the goods to which it is affixed, another function of which in recent years is assuring the purchaser of a certain degree of uniformity or quality.[24] For consumers, trademarks should be able to identify those particular producers with whom they desire to contract and those they choose to avoid.[25] The communication between consumers and products or services is, therefore, accomplished through trademarks.

The communication through trademarks, however, is different from language. The only reason for society to afford a seller exclusive rights in a trade emblem is to foster accurate associative and denominative messages.[26] More messages other than source and quality of goods or services bring the risk of predomination in market communication,[27] which is detrimental to both sellers and consumers because the strength of source identification is undermined and expressions related to products and services are monopolized. Language, in contrast, expects clear and specific semantic meanings for the purpose of communication.

2. *WORD MARK AND LINGUISTIC INTERPRETATION OF ITS DISTINCTIVENESS IN LAW*

There are various forms of trademarks: words constitute most form of trademarks, while stylized logos, artistic signs, and graphic symbols are also commonly used.[28] However, word marks are different from logos, artistic signs and graphic symbols because words may contain semantic meanings. Therefore, besides quality and source, word marks also deliver information contained in words themselves. For example, the word "Juicy" has its own meaning of "the food is full of juice and enjoyable to eat". To be compatible with functions of trademarks aforementioned, words as trademarks should have essentially only two potential functions: the ability to communicate qualities, and the function

[24] Szajna v. General Motors Corp., 115 Ill.2d 294, 319 (1986).

[25] Chad M. Smith, *Undressing Abercrombie Defining When Trade Dress is Inherently Distinctive*, 87 TRADEMARK REP. 160, 164 (1997).

[26] John T. Cross, *Language and the Law: The Special Role of Trademarks, Trade Names, and Other Trade Emblems*, 76 NEB. L. REV. 95, 117 (1997).

[27] *Id.*

[28] Solly, *supra* note 2.

of communicating source.[29] I have discussed in previous section that once signs are attached with meanings, messages can be conveyed so communication is formed. When the information is purposefully hidden or unconditionally incomprehensive in the messages, the failure of communication may occur. For word marks, however, the more hidden or incomprehensive the meaning of the word is, the stronger the word mark can be. This is because meaningless word marks are purely associative and denominative, the qualities of which cater to the purpose of trademarks.

In legal perspective, the well-known Abercrombie spectrum offers a dimension to determine distinctiveness of trademarks by categorizing them as: fanciful/arbitrary, suggestive, descriptive and generic,[30] with which the degree of trademark protection also declines. Abercrombie spectrum focuses on the correlation between word and product:[31] the closer the correlation is, the less protection the mark could obtain. This is because the close correlation between the word and the product, mainly linguistically, other than the purpose of source or quality identification may bring the risk of predomination of the market communication.[32]

A fanciful mark, as a coined word with no meaning assigned to it, is deemed as the strongest trademark. This is because meaningless words, as mentioned before, well serve the purpose of trademarks as indicators of source and qualities. An arbitrary mark has a significance recognized in everyday life, but the thing it normally signifies is unrelated to the product or service to which the mark is attached.[33] The correlation between the word and the product is incredibly distant.

In contrast, suggestive, descriptive and even generic marks reflect the function of language for communication, because it takes almost little efforts for consumers to correlate the word used in trademark and the goods or services.

A suggestive mark "suggests, rather than describes, some characteristic of the goods to which itapplie[s] and requires the consumer to exercise his imagination to reach a conclusion as to the nature of the goods. "[34] The imagination is triggered by the choice of the word. Suggestive mark, though it has some correlation with the goods or services, is still good enough as a source identifier, because a person still would have difficulty in ascertaining the nature of the products that the marks represent.[35]

A descriptive mark is descriptive of the intended purpose, function or use of the goods, the size of the goods, the class of users of the goods, a desirable characteristic of the goods, or the end effect upon the user.[36] The description effect derives from the semantic meaning of words.

[29] Smith, *supra* note 25, at 186.

[30] Abercrombie & Fitch Co. v. Hunting World, 537 F.2d 4 (2d Cir. 1976) (Friendly, J.).

[31] Greame B. Dinwoodie, *Reconceptualizing the Inherent Distinctiveness of Product Design Trade Dress*, 75 N.C. L. Rev. 471, 509 (1997).

[32] Cross, s*upra* note 26.

[33] Champions Golf Club, Inc. v. The Champions Golf Club, Inc., 78 F.3d 1111, 1116 (6th Cir. 1996).

[34] Streamline Production Systems, Inc. v. Streamline Manufacture, Inc., 851 F.3d 440, 452 (5th Cir. 2017) (quoting Soweco, Inc. v. Shell Oil Co., 617 F.2d 1178, 1184 (5th Cir. 1980)).

[35] Sara Lee Corp. v. Kayser-Roth Corp., 81 F.3d 455, 464 (4th Cir. 1996).

[36] Anderson v. Upper Keys Business Group, Inc., 61 So.3d 1162, 1169 (Fla. Dist. Ct. App. 2011).

Generally speaking, the distinctiveness of word marks in law is mainly from linguistic standpoint that the closer correlation is between the word and the product, the less protection the word mark obtains. Semantic meanings of a word debilitates the strength of a word mark.

3. *FOREIGN WORDS AS TRADEMARKS*

Foreign words, without assistance of translation, to naïve readers are unconditionally incomprehensive, the nature of which enables foreign words to serve the purpose of trademarks because they are semantically meaningless to naïve consumers (who cannot speak the language in which trademark is written) and purely associative and denominative.

Foreign words are equivalent to fanciful marks in a sense that both of them fail to reveal semantic meanings of the words. For example, Kodak is a combination of five letters created with no meaning being assigned to except that consumers considered it as trademark. The well-known mark in China "五粮液" is a trademark used on classy white wine, but it is only a sign to those con-sumers who cannot speak Chinese. The meaning of "五粮液" is unknown to naïve consumers.

C. UNIQUENESS OF FOREIGN WORDS AS TRADEMARKS

The distinctiveness of a trademark can be influenced from the selection of a particular shape of word, spelling, and lettering or punctuation, with the use of modality and stylistic techniques, such as rhyme, alliteration, assonance and consonance.[37] I have discussed the difference between logographic language and alphabetic language in the previous section that the sight of a word is important to logographic languages while the sound is essential to alphabetic languages, so distinctiveness vests in different elements of a word in terms of different writing systems as w ell. For trademarks written in logographic language, the sight of a mark takes priority so distinctiveness is more found in shape of word, spelling, and lettering in logographic words. When it comes to trademarks written in alphabetic words, sound is crucial so the spelling of a word, punctuation, rhyme, alliteration, assonance and consonance need to be considered for distinctiveness.

These linguistic characteristics works fine if the trademark written in a languages the same as which consumers speak. In logographic language speaking countries, such as China, consumers may confuse two marks with similar shapes that are combined with similar characters, especially when the mark is a meaningless coined word. For example, "花中王" and "花中玉" are considered as similar enough to cause confusion among consumers.[38] If the sound of two marks are similar as well as the sight, they are also confusingly similar; however, if the sight of two marks is distinctive, they are not confusingly similar even with similar sounds. For example, "高太丝" and "高泰斯"[39] are

[37] Solly, *supra* note 2 at 222.

[38] Trademark Examination Standard, the State Administration of Industry and Commerce of China at 62 (2005).

[39] *Id.* at 64

two marks with the same pronunciation but they look different, so they are not considered to be confusingly similar in China. The two examples from Trademark Examination Standard issued by the State Administration of Industry and Commerce of China indicate that sight of a word mark is vital not only because of its linguistic trait but also it helps Chinese consumers to distinguish marks.

However, this differentiation mechanism of consumers also influences their habit when an English trademark appears, so they may habitually and essentially distinguish the sight of the English words. For example, "Marc O'Polo" and "MACAO POLO" are considered as confusingly similar in China[40] because of similar sights and pronunciations, though the two marks are effortlessly distinguishable for English speakers. In this foreign word mark scenario, characteristics of alphabetic language are not the elements influencing Chinese consumers' recognition, but their native language Chinese does, or broadly speaking, the characteristics of logographic languages do.

Similarly, for English-speaking consumers, they incline to look for the sound of a word. When it comes to Chinese trademarks, they view Chinese characters as meaningless signs because the sound of marks is unknown to them. This results from the influence of their native language as well.

The observance of linguistic characteristics and consumers' psychology proves the uniqueness of foreign words as trademarks, which is consumers view marks following a habitual cognitive pattern and this pattern is decided by the writing system to which consumers' native language belong. Due to this reason, the distinctiveness of foreign marks should cater to consumers' cognitive habit instead of following the linguistic characteristics of the language in which foreign marks are written. This discovery should be incorporated in the trademark search systems and trademark examinations. I will explain the reason in later chapters.

III. Limitations of TESS to Search Foreign Trademarks

TESS, in its full name of Trademark Electronic Search System, is a USPTO trademark search database which allows people to search the USPTO's database of registered trademarks and prior pending applications to find marks that may prevent registrations due to a likelihood of confusion refusal. It is a thorough and complicated system with various database serving different search approaches and purposes. However, when searching for foreign marks, one cannot always successfully achieve the results as searching for English marks. This is section will describe the function of TESS on searching English marks, how it fails regarding foreign words, and why the failure happens.

[40] *Id.* at 63

A. FUNCTIONALITY OF TESS

1. *REGULAR SEARCH FOR WORD MARKS*

One can search for a trademark using its various information including the filing date, the name of trademark holder and his address, or the name of the attorney who filed the application. The TESS system labels its database with fifty-two titles categorized by different types of information contained in trademarks,[41] such as [FD] for the filing date, [OW] for owner name and address, and [AT] for attorney of record. [BI] as "basic index" database is the mostly often used to search for English marks and marks written in other alphabetic languages. If there is a French mark, Examiner will not only search in [BI] database, but also [TI] "translation index" database, which contains English equivalents to foreign words or characters used in a trademark. For example, if one applies for registration of a French mark "espoir", he needs to submit the translation and transliteration (the phonetic equivalent) of the mark "espoir", the translation of which is "hope" in English and the transliteration of which could be "es-pwa". Examiner will search the [BI] and [TI] database to look for any existed trademarks similar to "espoir", "hope" and "es-pwa".[42]

2. *SEARCH FOR DESIGN MARKS*

Trademarks can also consist of images and signs, which are specifically referred as design marks. Design search code is established to search for design marks, which are stored in database labeled as [DC]. Design marks with similar sights can be found in this database. Each design search code is a numerical classification index that codifies design figurative elements into categories, divisions and sections. There are twenty-nine main categories of designs,[43] such as animals, plants, foodstuff and tobacco. Under each category, numerous divisions exist and under each division, each design element is assigned a six-digit number. In the category of animal coded as 03, for example, there are divisions like cats, horses, birds, or fish. In the division of cats coded as 0301 (dogs, wolves, foxes, bears, lions and tigers are also included in this division) , for example, six-digit number 030101 is assigned to refer to lions, 030102 is for lion insignia, 030103 is for Tigers and other large cats, and 030104 is for domestic cats.

To search design trademarks, one should first identify the significant design elements and look for the design code for those elements. Next, one should combine and put in different design codes to search for trademarks which contain the same and similar elements. If there is a mark composed of a swan and the word "espoir", Examiner will search database of [BI], [TI] and [DC] to find a similar mark by putting a string of instructions to the search window. A possible string could be like: "espoir [bi,ti] and 031506 [dc]", which means to search word marks containing letters of "espoir" in database of [BI] and [TI], and search for design marks under the division of Ducks (Geese and Swans

[41] Trademark Electronic Search System (TESS): http://tmsearch.uspto.gov/ (follow Word and/or Design Mark Search hyperlink).

[42] The transliteration may have more variations of "es-pwa".

[43] USPTO Design Search Code Manual: http://tess2.uspto.gov/tmdb/dscm/index.htm.

are also included in this division). In this way, the trademark which has both the elements of the word "espoir" and the image "swan" will show up.

In conducting a design search, one may focus on an extremely narrow group of similar design marks by using one or more six-digit codes for design codes. One may also look at broader categories or divisions of marks by using either two-digit or four-digits codes, such as 03 for animals or 0301 for cats. The quantity of trademarks searched by using the string of instructions varies according to Examiners' discretion. Different Examiners might come up with different search results, but they are trained similarly enough to locate valid trademarks as a comparison to the applying ones.

B. Dysfunctionality of TESS in search for foreign marks

TESS functions well when Examiners search for alphabetic word marks and design marks, but when it comes to logographic characters, the functionality is questionable. First of all, the workload for Examiners to search for foreign word is huge and it also increases the possibility of confusingly similar trademarks being approved. There is no such an isolated database as [BI] or [TI] established for logographic characters. Instead, in the design code search database [DC], Category 28 is titled with Inscriptions in various characters. Under Category 28, there five divisions relevant to logographic characters. They are 280101 for Arabic characters, 280103 for Chinese, Japanese, Korean, Vietnamese or other Asian characters, 280105 for Greek characters, 280107 for Hebrew characters, and 280105 for other non-Latin characters, including Cyrillic or hieroglyphic characters. Precisely speaking, logographic characters are deemed as design marks assigned with design codes but are put into roughly sketchy divisions. Division 280103, alone, has 34043 records[44] of trademarks written in Chinese, Japanese, Korean, Vietnamese or other Asian characters. This is a problem because if one applies a mark written in Chinese, Examiner has to go through all 34043 results shown up on 100 pages to find appropriate trademarks as references to approve or deny the application, which practically impossible.

Second, the submitted information of foreign marks is not enough to conduct a concise search in TESS. As mentioned before, one needs to submit both translation and transliteration of a foreign mark. If the foreign mark has no literal meaning, only transliteration is needed. Think about Chinese marks "康师傅" and "康帅傅" both seeking federal registration. The former mark means Uncle Kang or Professor Kang, the transliteration of which could be Kung-Xi-Fu. The latter mark, however, is meaningless in Chinese, the transliteration of which could be Kung-Chuai-Fu. Examiner uses design search code 280103 to search for Chinese marks, and also cross-search [BI] and [TI] database for similar translations and transliterations. Kung-Xi-Fu might not be found under [BI] and [TI] as a reference to Kung-Chuai-Fu because of their different pronunciations. Therefore, characters with similar sight cannot be found and compared, an opposite result of the fundamental idea of design code

[44] The record varies as time goes by. This record is conducted on September 8, 2018.

search database.

In conclusion, the dysfunctionality of TESS in search for foreign marks is two folds: foreign marks treated as design marks are roughly categorized in a way that search cannot be effectively conducted; search for translation and transliteration of foreign marks is unable to reveal marks with a similar sight.

C. Linguistic reasons behind the dysfunctionality of TESS

The dysfunctionality of TESS in search for foreign marks is mainly linguistic. I will discuss the mechanism of TESS from linguistic perspective, explain how this mechanism differs from how consumers view foreign marks, and answer why TESS fails on foreign marks searching in this section.

1. *Analyze TESS from linguistic perspective*

When one files an application of a foreign trademark, the translation and transliteration of the foreign trademark should be submitted together as well. This requirement straightforwardly coveys two elements in a word: the meaning and the sound. It is in accordance with the way that Examiners search for English trademarks. Examiners write down the applied English trademark, change the spelling of several syllables and search for variations of the mark. If one applies "Zeitgeist" as a trademark, Examiner will switch all the vowels in this word. For example, "E" might be switched with "I" or "Y", because they could make similar sounds. As a result, the mark "Zeetgitst" might show up as a reference for Examiner to decide. Only several syllables are worth the change because letters in certain positions in words are privileged when it comes to recognition, which means that letters in certain positions are more important for recognition than other letters in a word.[45] The first syllable in a word, for example, is distinguishable: "Desire" and "Jesire", or "Relgan" and "Selgan". For Examiners, if the first letters of two words are different, they will not consider them as confusingly similar because consumers can effortlessly differentiate them.

This searching process also denotes the significant role that the sound of a word plays in English and US trademark world. The sight of a word, however, is not taken into consideration under US application system and the TESS. That is to say, TESS is in fact an alphabetically oriented system.

2. *Review psychology of consumers towards foreign marks*

English-speakers as consumers may not worry much about the appearance of an English word. This is mainly because alphabetic languages are more phonologically transparent. Even with a coined trademark, English-speaking consumers habitually memorize the sound of the word in their mind, though they

[45] Rebecca L. Johnson & Morgan E. Eisler, *The importance of the first and last letter in words during sentence reading*, 141 Acta Psychologica 336, 336 (2012).

are blinded to the meaning. The rules of pronunciation influence them to assign the sound to a word. If a consumer who can speak English but cannot speak French sees the mark "espoir", he will automatically pronounce the word as "es-pour" because of the English rules of pronunciation. If there is another mark "espur", a slight chance for consumer confusion between the two may exist, because "espur" has a different sound as " es-per". Though they might look similar, to English-speaking consumers, the similarity is not substantially close. As to logographic characters, English-speaking consumers would consider them as meaningless signs or images. When English-speakers read Chinese trademarks, it is impossible for their minds to process the meaning and the sound of the word due to the lack of knowledge, with sheer impression at the sight of the word. The appearance of characters are the only visible and direct element left in a word.

In contrast, Chinese-speaking consumers tend to memorize the sight of a word because Chinese characters are ideographical. They distinguish trademarks written in other languages from the visual aspect as well. For example, English marks "Carolflex" and "Carpoflex" are considered as confusingly similar in China[46], but it might not be the same case for Examiners in the United States, because they have different pronunciations.

No matter what writing systems a mark belongs to, when the mark is "foreign", the sight of a word is a crucial element for consumers to distinguish foreign trademarks. Especially when two foreign trademarks look confusingly similar, a precise distinction by consumers is unattainable. For example, Chinese characters consist of strokes; one missing stroke can transform the character into another one. In fact, sellers tend to utilize this feature to create confusingly fake brands to trick consumers. For example, "白猫" is a well-known trademark for dish soaps so someone creates brand "日猫" written in the same font also for dish soaps. The pronunciation of the two marks are different, but because the characters are confusingly similar, Chinese consumers are easily tricked. If "白猫" dish soap and "日猫" dish soap are both on the shelf of a market in the United States, American consumers may undoubtedly get confused. Confusion can also happen if Chinese consumers are asked to distinguish "chocolat" and "chacolat" written in the same font.

Briefly speaking, consumers focus on the sight of a foreign mark if the mark is written in a language that belongs to a different writing system and this results from their cognitive patterns as we discussed in the previous chapter.

3. *Explain the reason of TESS's failure on foreign marks*

TESS is an alphabetically oriented system, which means that the sound of a trademark is the fundamental element when one conducts a trademark search. The search for alphabetic marks or logographic marks all comes from this basic idea. For alphabetic marks, Examiners will add, omit or replace certain letters in a word to find trademarks with similar pronunciations. If two trademarks

[46] *supra* note 38 at 61.

used on similar products and services also sound similar, Examiners will not approve the junior application no matter whether the two-word marks look similar or not. For logographic marks, Examiners require the translation and transliteration of the applying mark. What they look for is whether the phonetic sound of the logographic mark is similar to the registered marks, and whether the meaning of the logographic mark is equivalent to a valid trademark. The process is typically equal to the search of English marks because the translation of an English mark is regularly unnecessary, and transliteration is a substitute means to phonetically examine a logographic mark as an English mark. Though logographic marks are put into the category of design marks in design code database, Examiners treat logographic marks the same as alphabetic marks, so the function of design codes for logographic characters is almost miniscule. More directly, the sight of logographic marks is not effectively evaluated under TESS system, the missing element of which, however, is crucial to logographic languages.

For consumers, foreign marks written in a language that belongs to a different writing system are meaningless signs or images. The meaning and the sound of a foreign mark are incomprehensive, so only the sight of a foreign mark is approachable for consumers to identify the products. Confusion, therefore, happens to two foreign marks with similar sights.[47] To avoid confusingly similar foreign marks being approved, the sight of foreign marks should be the element examined. However, Examiners can merely examine the translation (the meaning) and transliteration (the sound) of a foreign mark due to the dysfunctionality of TESS, which is unable to provide concise search results by roughly placing logographic marks into five divisions within the database of design marks.

As previously discussed, the distinctiveness of foreign trademarks reside in their sights and reflects consumers' cognitive habit. The key to the problem is that foreign marks can be thoroughly examined if the appearance of marks, or consumers' cognitive habit, is taken into consideration by TESS and Examiners.

D. Case study: "绵竹大曲" v. "锦竹大曲"[48]

I introduce a trademark infringement case in China as an example of how a confusingly similar mark can be infringing mark in China but might be approved under TESS system.

1. *CASE BRIEF*

The case is briefly about a well-known wine company as the holder of trademark "绵竹大曲" used on bottled wine brought the lawsuit against another wine company who holds the registered mark "锦竹". The latter uses "锦竹" together with Chinese word "大曲", which is a generic term of a type of wine

[47]This is not to say the confusion will not happen to marks with similar meanings or sounds, but even though meanings or sounds are similar, consumers would not know due to their lack of knowledge of the language.

[48]Shenzhen City Baosongli Industrial Co., Ltd. v. Sichuan Province Mianzhu Jiannan Chun Wine Plant Co., Ltd., Higher People's Court of Hunan Province, March 16, 2010, CLI.C.291859(EN).

made from wheat, as the name for bottled wines. As a consequence, "绵竹大曲" and "锦竹大曲" are used on bottled wheat wine in the market, with similar packages as well. The court found that "绵" and "锦" are similar in sight. The right side of "绵" and "锦" is the only difference: "纟" and "钅". There-fore, "绵竹大曲" and "锦竹大曲" are confusingly similar, in which ordinary con-sumers and sellers cannot recognize the difference.

2. *Hypothesis*

We assume that "绵竹大曲" has been approved by USPTO and registered as a valid trademark in the database, and now someone applies for the registration of "锦竹大曲". Since "大曲" is a generic term for wheat wine, we analyze the distinctive segments: "绵竹" and "锦竹".

"绵竹" is a place name in China, pronounced as "Mianzhu", but "锦竹" has no semantic meaning. If one files the application for "锦竹", he needs to submit the representation of "锦竹" written in Chinese characters and transliteration of it "Jinzhu". Examiner will search "Jinzhu" in the database of [BI] and [TI], or ideally [DC] using design code 280103 to look over all foreign marks written in Asian characters. "Mianzhu" and "Jinzhu" are considered as phonetically different, so even Examiner sees "Mianzhu" as a listed result, it might not be the reference to reject "Jinzhu". It is also impractical for Examiner to go through all the marks under 280103 section to pinpoint "锦竹" because there are hundreds of pages of results. High probability is "锦竹" bypasses the comparison with "绵竹" gets approved, appears on the market, and confuses consumers who purchase wheat wine because it has a different sound and "绵竹" is difficult to find in the database by using design codes.

3. *Conclusion*

The case discussed in this section is meant to show that though phonetic sound is important to search for trademarks written in alphabetic languages, visual aspects of foreign marks should be examined. The distinctiveness of foreign trademark rely on their visual aspects because of consumers' cognitive habits.

IV. Recommendations for Improving Reliability of TESS

A. A comparison to logographic-language country

Trademark search system in China is user-friendly. Unlike TESS divides information of a trademark application into different categories containing the filing date, the name of trademark holder and his address, or the name of the attorney who filed the application, trademark search system in China have four main portals[49] for users to search the information of a trademark, which includes

[49]Trademark Office of The State Administration for Industry & Commerce of the People's Republic of China: http://wsjs.saic.gov.cn/txnT01.do?y7bRbp=qmFFYCf.5EXcFNAiA3IzNfU.EiLhGEkOGC_XFBNs_5BR9AX1xrCK1TdozcNFKusA0WrgWkTsXXRUHYKh38xcugf.TXnjLQMPqtinSS5IpY6K7vR8Sglo5Hii6V.cUqEb8GHipS1i9HUmZ3iYLklLdK0kacR.

search for similar marks, search for marks based on application information, search for the status of marks, and search for trademark bulletins. Four search portals enable users to search with different p urposes. As an equivalent function of TESS when Examiners needs to make likelihood of confusion refusal, search for similar marks offers more convenient steps to o perate. Users have two options: quick search and complete search.

1. *QUICK SEARCH*

To use quick search, one should put in the number (between 1 to 45) of international trademark classes[50] in which area the trademark is used. For example, Class 15 represents musical instruments and Class 37 represents installation services. The number of international trademark classes is required to do quick search. Though there are sub-classes under each class also assigned with numbers, for example, under Class 37, there is a sub-class 370031 representing building construction and supervision, number of sub-classes is not necessary for quick search. Quick search allows users to search six types of marks: marks written in Chinese characters, marks written in Chinese phonetic alphabets (Pinyin), marks in English, marks written in numbers, marks written in initials, and design marks, among which a mark can only be labeled as one of the six types. For design marks, users should first identify the elements of the design and then put in numbers[51] that represent the elements. For example, 1.15.14 is the number for raindrop and 1.17.12 is the number for islands. If a mark has the two elements of raindrops and islands incorporated in its design, users can put in "1.15.14; 1.17.12" to the search box to search trademarks that carry the two elements. However, the search is merely available for a design mark with no more than five elements in its design.

Similarly, trademarks written in foreign languages are considered as design marks so numbers are also assigned to them as TESS does. Number 28 is the general section for marks in foreign languages as well as 8 subsections containing marks in Arabic, Latin, Cyrillic, Japanese, Greek and Hebrew. For example, if a trademark is written in Japanese used on musical instruments, 15 indicating musical instruments should be put into the search box of international trademark classes and 28.3 representing marks in Japanese is put into the search box of design mark number, after which 50 search results[52] with images are shown up. Users can choose two or more marks for further comparison, so more detailed information about the trademark including name of the applicant, name of the agent, the date of application and the registration number can be reviewed.

[50] Nice Classification: http://www.wipo.int/classifications/nice/en/.
[51] Design Code: http://www.fzsbj.com/sbcx/tx.htm#.
[52] The record varies as time goes by. This record is conducted on September 8, 2018.

2. *Selective search*

This type of search offers more choices for users to conduct a search to enlarge or narrow the search scope. English marks, for example, can be changed by adding or deleting letters in word, or reversing the order of letters to embrace as many results as possible to avoid confusingly similar marks.

If a user intends to search all English trademarks used on musical instruments with similar phonetic sounds as "Good", he could use complete search by putting in Number 15 for music instruments, typing in word "Good" and clicking the function item of "similar phonetic sound". 18 search results are listed in chart, which comprises trademarks like "GWOOD", "GWTEE", "G-AID" or "GOODWAY."[53] The quantity of the search results is satisfying because it enables an Examiner to efficiently make the decision after a thorough review within a reasonable time. The quality of the search results seems questionable, though. If a USPTO Examiner searches TESS for similar marks as "Good", there are few chances for "GWTEE" and "G-AID" to be references because according to rules of pronunciation they are different in sound.

However, "GWTEE" or "G-AID" can sound similarly confusing for Chinese consumers. This is because it is possible for a Chinese consumer who cannot speak English pronounces "Good" as "GWTEE" or "G-AID", not from the standpoint of English pronunciation but out of the habit of Chinese pronunciation. Though those marks are considered as phonetically similar, they are not rejected as similar marks. As mentioned before, Chinese as logographic language influences consumers in a sense that visual aspects of mark takes priority. "G-AID" and "GWTEE" do not look the same, so consumers can distinguish the two marks. Additionally, Chinese consumers might not even pronounce the two marks since they are written in another language, so the sight of the two marks becomes the crucial element to decide likelihood of confusion.

Trademarks written in Chinese characters have the same procedure as the search of English marks. Words can be added or reduced with characters, the order of characters can be reversed, and characters with phonetically similar sound can also be found. If we want to find all marks that contain characters "白猫" used on electronic apparatus and instruments, we put in the number of international trademark classes which is 9 for electronic apparatus, type in the mark "白猫" and choose to search marks that contain the characters, 23 results come up.[54] All word marks contain characters of "白猫". Three of them are even the same marks using the word of "白猫" but on different products. The search results are still in a reasonable amount.

3. *Summary*

To conduct search of similar marks, trademark search system in China basically requires the following information: the number of international trademark classes to locate a certain kind of goods or services, the type of the marks

[53]The record varies as time goes by. This record is conducted on May 25 of 2017.

[54]The record varies as time goes by. This record is conducted on September 8, 2018.

(whether it is a mark written in Chinese characters, or in Chinese phonetic alphabets, English marks, or design marks), and the mark itself. If the mark is a design mark, one should break down the mark into pieces of elements, and find the numbers assigned to those elements. One can search five elements at a time. For marks in foreign languages except English, numbers are also assigned to represent different languages so that users can put in the number to search foreign marks as design marks. For English mark, in contrast, one can search the mark by adding or deleting letters in the word, changing the orders of the letters or finding the marks with similar phonetic sound. The search results are more linguistically prone to the habit of Chinese consumers.

B. Recommendation: technology exchange cross-borders

The study of the trademark search system in China is an example of how marks in foreign languages can be searched in a foreign language database. It does not indicate that the Chinese system is flawless but it on some level provides the idea that Chinese marks can be searched and compared without using the design mark code. Meanwhile, even English words can be searched the same way as USPTO Examiners by adding or deleting letters, but all users do is clicking the function item instead of writing down the string of instructions. That is to say, a trademark search can be conducted in a more convenient and direct way with the assistance of technology.

Therefore, it is recommended to consider an exchange of technology between countries with different writing systems. For example, USPTO can use the technology of Chinese trademark search system to conduct Chinese mark search instead of treating Chinese marks as design marks with a design code which is ineffective.

V. Conclusion

Though USPTO TESS could perform a well-functional search for word marks, it has limited functionality when searching for foreign marks. With more foreign business settling down in the US, it is important to establish a search system for foreign trademarks in order to avoid confusingly similar trademarks being approved, which would result in disorders and chaos in the consumers' market. The reason for the malfunction of the TESS is predominantly linguistic. The TESS is an alphabetically biased search system, in which only the sound and the meaning of a word is highly concerned. However, logographic language is a different writing system that requires the sight of a word to be taken into consideration. At the same time, consumers can only read foreign marks by its sight instead of its sound, where confusion will often happen, so the distinctive sight of foreign word is also a requirement of market. TESS needs to focus of the sight of foreign marks to cater to consumers' cognitive habits. More optimum options could be considered for a well-operated system and cooperation between countries might be a good solution. Technology of search system should be exchanged cross borders.