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UNITED STATES: Board Leaves Applicant Singing the Blues

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In a precedential decision, the Trademark Trial and Appeal Board (the Board) upheld the refusal of the USPTO to register the trademark MARAZUL for fish and seafood products on grounds that it was likely to be confused with a prior registration for the trademark BLUE SEA for fish products. *In re Aquamar, Inc.*, Serial No. 85861533 (June 25, 2015) [precedential].

Aquamar, Inc. (applicant) sought registration of the mark MARAZUL for frozen and fresh processed fish, seafood and imitation crab meat in Class 29. The examining attorney refused registration of the mark on grounds that the mark was likely to be confused with a prior registration for BLUE SEA for fish and frozen fish in Class 29 and because the applicant refused to comply with the examining attorney's request to provide a translation of the non-English words in the mark. The examining attorney produced evidence that "mar azul" means "blue sea" in Spanish.

In its response to the office action, the applicant denied that the term MARAZUL had any meaning, arguing that the name was an arbitrary designation and a coined term with no direct English translation. The examining attorney issued a final refusal and the applicant appealed to the Board.

The Board found that the translation requirement "also applies to compound word marks comprised of two or more distinct words ... that are represented as one word, in which one or more of the words in the mark appears to be non-English." The Board also found that combining the Spanish words "mar" and "azul" into a single term did not result in creating a commercial impression different from "mar azul." Further "mar azul" had specific meaning to the applicant's goods because the applicant's marketing:

- (a) expressly targeted the U.S. Hispanic market;
- (b) employed bilingual packaging; and
- (c) incorporated a logo featuring wavy blue lines presumably meant to represent a blue sea.

In any likelihood of confusion analysis, two key considerations are (1) the similarities between the marks and (2) the similarities between the goods. Under the doctrine of foreign equivalents, foreign words are translated into English to determine similarity of the marks. The Board found that, although the marks MARAZUL and BLUE SEA were distinct in appearance and sound, their meaning was identical because "mar azul" means "blue sea" and this equivalency in meaning or connotation outweighs the differences in the marks because ordinary purchasers of fish would stop and translate the applicant's mark into English. As the Board noted, "When consumers view Applicant's MARAZUL packaging they will see several Spanish words displayed next to their

English equivalents, increasing the likelihood that they will translate MARAZUL.” Because the applicant’s goods and the registrant’s goods were in part identical, the Board presumed them to be sold in the same channels of trade to the same classes of purchases.

The Board affirmed the refusal to register based on the applicant’s failure to comply with the requirement to include an English translation and a likelihood of confusion under Section 2(d).

Although every effort has been made to verify the accuracy of items in the *INTA Bulletin*, readers are urged to check independently on matters of specific concern or interest.

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