

No. 25-215

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IN THE  
**Supreme Court of the United States**

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VETEMENTS GROUP AG,

*Petitioner,*

*v.*

COKE MORGAN STEWART, ACTING  
UNDER SECRETARY OF COMMERCE  
FOR INTELLECTUAL PROPERTY AND  
ACTING DIRECTOR, UNITED STATES  
PATENT AND TRADEMARK OFFICE,

*Respondent.*

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ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED  
STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

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**REPLY BRIEF OF PETITIONER**

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TERENCE J. LINN  
*Counsel of Record*  
CATHERINE S. COLLINS  
KARL T. ONDERSMA  
GARDNER, LINN, BURKHART  
& ONDERSMA LLP  
2900 Charlevoix Drive SE,  
Suite 300  
Grand Rapids, MI 49546  
(616) 975-5500  
linn@gardner-linn.com

*Attorneys for Petitioner*



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## REPLY BRIEF OF PETITIONER

The categorical application by the court of appeals of a judicially generated concept to overcome an Act of Congress warrants this Court's review. The Trademark Act provides that no trademark by which the goods of an applicant may be distinguished from those of others shall be refused registration unless an exclusion applies. It is therefore the burden of Respondent to establish the basis for refusal, which determination is to be predicated on the perception of the trademark by the American consuming public. Whether to attempt translation of a term is part of that burden, rather than first translating and then fitting the translation to the particular situation in order to arrive at an unwarranted conclusion that the consuming public would likely undertake such a translation. Further, this case presents an outcome-determinative circuit conflict that this Court should resolve.

The questions presented are recurring and important and the Court should grant the petition in order to clarify the statutory mandate for registration of a trademark.

### **A. The Court should review and reverse the court of appeals' decision applying a categorical translation of foreign language words in application of Section 1052**

Respondent (at 7) admits that "the determination whether a word is distinctive for purposes of registrability is guided by consumer perception." The court of appeals, however, departed from an analysis based on consumer perception and undertook translation of the trademark without evidentiary basis to do so. The court of appeals

wrongly changed the burden from Respondent to Petitioner, finding that the trademark would be translated unless Petitioner proved that translation by the average American consumer was *unlikely*: “We hold that unless it is unlikely that the ordinary American purchaser would stop and translate the word into its English equivalent, the doctrine of foreign equivalents applies.” Decision at Pet.App.15a. This is a return to the approach by the Federal Circuit’s predecessor in which a rote translation of a foreign term was made as the first step of the analysis. *E.g., Nestle’s Milk Products v. Baker Importing Co.*, 182 F.2d 193, 196 (C.C.P.A. 1950).

The statute 15 U.S.C. § 1052 assigns the burden to the Patent and Trademark Office to establish a basis for refusal of registration:

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it — :

To change the burden and impose it on an applicant in the first instance removes valuable rights from the American public, and promotes the potential for public confusion to arise through copying and unscrupulous practices.

Rather than basing its determination on the admittedly controlling factor of consumer perception of the mark, the court below asserted the word would be translated by American purchasers based on (a) a strict number of Americans purportedly familiar with the French language amounting to significantly less than 1%

of the population, and (b) an American observer knowing the translation of the word in advance of considering whether to undertake translation. Applying this predestined analysis of point (b) (Decision at Pet.App.22a), the court of appeals found that taking the marks at face value was unlikely “because the context is clothing and the proposed marks mean clothing” and the word “vêtement” is closely associated with clothing because it is the French word for clothing.” This “translate first” approach is the result of the burden shifting approach now undertaken by the Federal Circuit.

Respondent contends the present petition presents a textbook case for application of the doctrine of foreign equivalents, despite the court of appeals decision being based solely on evidence that less than one percent of the American public speak the French language and a pre-analysis translation of the term. Respondent (at 7) characterizes the court of appeals’ decision as not in conflict with any decision of this Court or another court of appeals and cites to denial of a petition for a writ of certiorari in *Australian Leather Pty. Ltd. v. Deckers Outdoor Corp.*, 142 S. Ct. 587 (2021) (No. 21-513). To the contrary, the decision of the court of appeals is in conflict with this Court’s precedent of *Menendez v. Holt*, 128 U.S. 514 (1888) as discussed in the Petition. Pet. at 16-18. Moreover, *Australian Leather* and this Court’s denial of certiorari in that matter supports Petitioner’s position and registration of a foreign term without resorting to a translation.

In *Australian Leather* the respondent had obtained federal registration of the mark UGG for footwear items and successfully sued the petitioner for infringement,

which decision was affirmed by the Federal Circuit. There the petitioner and the Australian government as amicus curiae argued the term “ugg” in Australia was a generic term and should not be an enforceable trademark in the United States. The district court had accepted the term “ugg” to be generic in Australia, but found that generic usage in Australia was not enough on its own to infer generic meaning in the United States. Petition for a Writ of Certiorari, *Australia Leather Pty. Ltd. v. Deckers Outdoor Corp.*, at page 4 (No. 21-513) (October 2021). This Court did not grant certiorari and left intact the district court’s determination of enforceability of the UGG trademark and affirmance by the Federal Circuit. In *Australian Leather* as in the present case, it is the consumer perception of the trademark in the United States that governs, and not whether the mark would be considered generic in another country.

Respondent (at 7-8) characterizes the doctrine as having been applied by the Federal Circuit and other circuits to translate foreign-language trademarks into English “*at least when*” an ordinary American consumer would likely translate the mark upon encountering it in commerce. Respondent’s argument states the problem. The qualification “at least” eviscerates any limitation on the doctrine in that circuit courts also translate a foreign term regardless of whether it was shown likely an American consumer would so translate the term.

Respondent (at 8) bolsters its argument with the unsupported contention that “[a] large proportion of consumers would be particularly likely to translate the marks in the context of petitioner’s clothing business, since ‘clothing’ is the direct translation of ‘vetements’ *and*



*French terms are widely used in the fashion industry.”* (Emphasis added.) The cited passage of the court of appeals decision (Pet.App.20a-22a) makes no such finding or observation that French terms are widely used in the fashion industry. The cited decision *Chaussures Bally Societe Anonyme de Fabrication v. Dial Shoe Co.*, 345 F.2d 216, 217 (C.C.P.A. 1965) likewise does not even observe that French terms are widely used in the fashion industry. In *Chaussures Bally* it was the appellant that argued the mark LA VALLI included a definite article from the French and Italian languages, “La”, which was well known in the fashion industry and thus could not be given weight in an analyzing similarity of competing trademarks. The court of appeals disagreed and declined to dissect terms of the subject marks. In dissent Judge Rich observed, not that the term “La” was known in the fashion industry, but that the definite article “La” would be recognized by “most people,” which to the extent relevant is analogous to a foreign word that has been adopted into the English language, such as café or boutique.

Respondent (at 10) argues that case authorities that predate the Lanham Act are in some manner limiting, because Congress is assumed to be aware of relevant judicial precedent when a new statute is enacted. By this rationale Congress would have been aware of this Court’s *Menendez v. Holt* decision, and its clear precedence over the subsequent lower court decisions cited by Respondent. As also noted by Respondent, in *Menendez* this Court noted that the term La Favorita “evidenced, that the skill, knowledge and judgment of [the trademark holder] had been exercised in ascertaining that the particular flour so marked was possessed of a merit rendered certain by their examination and of a uniformity rendered certain by

their selection.” This, however, is the modern definition of the functions of a trademark<sup>1</sup> and a determination that the term La Favorita in and of itself served as a trademark, not a finding the mark only merited protection based on acquired distinctiveness. The *Menendez* decision does not reference a translation of La Favorita, and Respondent’s argument the Court “implicitly” translated the term is bald supposition and no more.

The evidence of record drawn from Census Bureau information establishes persons over the age of five who speak French in the home amount to less than one percent of the American public. Respondent (at 12) takes issue, without support, with the relationship between this figure and the American consuming public. Respondent speculates that the number of Americans who speak or comprehend French would be greater than this *de minimus* percentage. Such speculation ignores the fact that a child, such as one who would be between five and ten

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1. See 1 J. Thomas McCarthy, *McCarthy On Trademarks and Unfair Competition*, § 3:2 (Fifth Ed. Sept. 2025):

Trademarks perform four basic tasks that are deserving of protection in the courts:

- (1) To identify one seller’s goods and distinguish them from goods sold by others;
- (2) To signify that all goods bearing the trademark come from or are controlled by a single, albeit anonymous source;
- (3) To signify that all goods bearing the trademarks are of an equal level of quality; and
- (4) As a key part of advertising and selling the goods and services.

years old, would not be an average purchaser of clothing. One could legitimately speculate that if children under a recognizable purchaser-age were removed from the analysis, the number of average American purchasers who would comprehend French would be even less than the number of record. Such idle speculation, regardless of guessing at a number lower or higher, does not carry the burden of Respondent.

Respondent's characterization (at 12) of the term "vetements" to be a "relatively basic French word" does not find support from any evidence of record. There is no contention that the word "vetements" has been incorporated into the English language, that the term resembles the English word "clothing" visually or aurally, or that the term is "basic." The term "vetements" is relatively complex and not a fundamental term such as yes or no, me or you, please or thank you, hello or goodbye or any number of other basic phrases. It is mere supposition that is based upon first translating the French term "vetements" into English and then taking the position that "clothing" is a basic word, a conclusion which would mystify over ninety-nine percent of the American public.

In support of its position Respondent (at 5 and 9) argues purported "reciprocity" in that registering "Vetements" would be the equivalent of registering "clothing" abroad, to the "obvious" detriment of American firms that market clothing abroad. To the contrary, the trademark VETEMENTS, in either the word format or in the block letter format **VETEMENTS**, has been registered for clothing items in a number of English-language

speaking foreign countries.<sup>2</sup> The French Court of Appeal of Paris, Cour d’appel de Paris, 5-1 Chamber, June 25, 2025, no. 23/11623, recently transferred ownership to Petitioner of French trademark registration No. 4562968 of the block letter logo applied to a variety of goods, including footwear, hats and hosiery. The stated concerns of Respondent are illusory.

Respondent (at 9) likewise argues treating “Vetements” as unregistrable insures every provider may refer to his goods as to what they are. Once again such concerns are illusory. The trademark law provides that a trademark registration precludes a competitor’s usage of the term as a trademark or in a manner that is likely to confuse. A trademark registration does not preclude use by a competitor of an otherwise descriptive word in a descriptive manner. 15 U.S.C. § 1115(b)(4); *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 121-22 (2004). Despite registration of the mark VETEMENTS, another company for example could

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2. These VETEMENTS trademarks have been registered in English speaking foreign countries as follows:

Great Britain	Registration No. UK00003532412	(word format) registered April 3, 2022
Hong Kong	Registration No. 305307066	(word format) registered May 1, 2024
Hong Kong	Registration No. 305307057AB	(block letter format) May 1, 2024
Australia	Registration No. 2093917	(block letter format) May 6, 2020
New Zealand	Registration No. 1149954	(block letter format) April 6, 2020

use a sign in the French language that stated: “We alter clothing here.” The rationale of Respondent would negate and remove from the Trademark Statute the ability to register under 15 U.S.C. § 1052(f) what would otherwise be a descriptive term (as defined in 15 U.S.C. § 1052(e)(1)), upon a showing the mark has acquired distinctiveness through usage as a trademark. This judicially-created doctrine cannot overrule an Act of Congress.

Regardless of which standard recited by the Federal Circuit is applied, whether requiring Respondent to prove it likely purchasers would translate or Petitioner to prove it unlikely purchasers would not translate, there must be a basis to establish that purchasers would either translate the term or otherwise recognize it from commercial use in the United States.

#### **B. The Court should review and resolve the conflict between the Circuits**

In addressing the split between the circuits regarding analysis of foreign words as trademarks, Respondent (at 13) cites rulings by the Fifth Circuit in *Enrique Bernat F., S.A. v. Guadalajara, Inc.*, 210 F.3d 439 (5<sup>th</sup> Cir. 2000) and the Second Circuit in *Orto Conservia Cameranes Di Giacchetti Marino & C., S.N.C. v. Bioconserve S.R.L.*, 205 F.3d 1324 (Tbl.) 2000 WL 232108 (2d Cir. Feb. 8, 2000). Respondent argues these decisions negate the categorical application by these circuits of the doctrine of foreign equivalents without regard to consumer perception. To the contrary, these decisions establish the circuits’ categorical application of the doctrine to first translate the foreign language word and then embark on their analysis based on that translation.

As reflected in *Bernat*, 210 F.3d at 443, the first step in the Fifth Circuit's approach is a rote translation of the foreign term: "*The first step* in the analysis is translating the word 'chupa.'" (Emphasis added.) Once the first step of translation was completed in *Bernat* there was a factual dispute as to the proper translation, one translation being that of "lollipop" in Spanish slang while the other translation being "to lick" or "to suck." *Id.* It was only after translation of the term that an analysis was made of other factors in order to arrive at a determination that the term was a Spanish word that designates "lollipop" or "sucker." *Id.* at 443-45.

In *Orto Conservia*, the Second Circuit approved the district court's approach that found a foreign language phrase was a generic designation of a type of olive. That approach was based, "first, on the finding that this is how the phrase is used in Italy" and "correctly considered evidence as to the meaning of the phrase in Italian..." 2000 WL 232108 at \*1. I.e., the court considered the meaning to persons who spoke the relevant language, essentially a translation. The Second Circuit expressly denied the analysis was to be based on the perception of average American consumers. As there stated: "Nothing in [the case citations], suggests that evidence under the 'foreign equivalents doctrine,' as it is known, must be consumer-based. Rather, the relevant inquiry is, more generally, the meaning of the term or phrase in its country of origin." *Id.* The court did not then base its analysis on the perception of the average American consumer, but went on to confine its analysis to persons who would have dealt with the Italian language: "Under this analysis the 'relevant purchasing public' is not the population at large, but prospective purchasers of the product." *Id.* at \*2.

The Federal Circuit’s analysis likewise applied this rote initial translation of the mark. In the present case the Federal Circuit has now characterized the analysis as the mark will be translated unless it can be shown *unlikely* the ordinary American purchaser would stop and translate the word into its English equivalent.

Respondent (at 13) also argues the Fourth Circuit in *Pizzeria Uno Corp. v. Temple*, 747 F.2d 1522, 1533 (4<sup>th</sup> Cir. 1984) first translated the foreign word trademark to make its analysis of descriptiveness. To the contrary, the circuit court first considered the term “UNO” without translation and found it not to be a term in common use in English to describe or identify any product or its characteristics. *Id.* In reversing the district court the Fourth Circuit did necessarily consider the literal translation of the word, because in finding the term descriptive the district court had relied on an Italian dictionary translation to “one.” But the Fourth Circuit proceeded to determine the untranslated term “UNO” had not been used as a descriptive term to refer to the “best” product. The circuit court made it clear its determination was based on the untranslated term, and ruled: “‘Uno’ is better analogized to a term such as ‘Del Monte,’ instanced in *Park’N Fly, Inc. v. Park & Fly, Inc.* [cite], or as ‘La Favorita,’ described in *Menendez v Holt* [cite], as ‘merely a fanciful name and in a foreign language.’” *Id.* at 1534.

This potentially outcome determinative split between the circuits should be resolved.

**CONCLUSION**

The petition for a writ of certiorari should be granted.

Respectfully submitted,

TERENCE J. LINN  
*Counsel of Record*  
CATHERINE S. COLLINS  
KARL T. ONDERSMA  
GARDNER, LINN, BURKHART  
& ONDERSMA LLP  
2900 Charlevoix Drive SE,  
Suite 300  
Grand Rapids, MI 49546  
(616) 975-5500  
linn@gardner-linn.com

*Attorneys for Petitioner*

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