

THIS OPINION IS  
NOT A PRECEDENT  
OF THE T.T.A.B.

Mailed:  
March 9, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Trustees of the Estate of Bernice  
Pauahi Bishop, dba Kamehameha Schools

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Serial Nos. 76596501 and 76596503<sup>1</sup>

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Robert Carson Godbey and Chad M. Iida of Godbey Griffiths  
Reiss Chong for Trustees of the Estate of Bernice Pauahi  
Bishop.

Steven W. Jackson, Trademark Examining Attorney, Law Office  
107 (J. Leslie Bishop, Managing Attorney).

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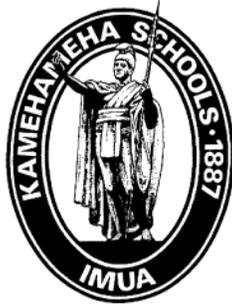
Before Quinn, Drost and Zervas, Administrative Trademark  
Judges.

Opinion by Zervas, Administrative Trademark Judge:

The Trustees of the Estate of Bernice Pauahi Bishop  
(dba Kamehameha Schools) seek registration on the Principal  
Register of the mark

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<sup>1</sup> On May 23, 2006, the Board consolidated these appeals for  
purposes of briefing.



in application Serial No. 76596501<sup>2</sup> ("IMUA application") for goods identified as "clothing; namely, t-shirts, polo shirts, sweatshirts, jackets, and shorts for men, women, and children; and baseball caps" in International Class 25;<sup>3</sup> and for the mark



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<sup>2</sup> Applicant claims first use anywhere and first use in commerce in January 1968.

<sup>3</sup> Applicant has entered the following description of the mark into the record:

The design of the mark is described as a graphical representation of King Kamehameha in a standing position with one arm outstretched forward and the other arm holding a spear in an upright position; the drawing is enclosed by two concentric ovals, within which is placed the words "KAMEHAMEHA SCHOOLS 1887 IMUA"; the space between the two ovals is shaded dark and the words are light.

Additionally, the record states that an English translation of the term IMUA is "go forward."

in application Serial No. 76596503<sup>4</sup> ("ALUMNI application") for goods identified as "clothing; namely, t-shirts and polo shirts for men, women, and children; and caps, namely, golf caps" in International Class 25.<sup>5</sup> Applicant states that it is a "charitable testamentary trust established by the last direct descendent of [Hawaii's] King Kamehameha I, Princess Bernice Pauahi Bishop." Brief at pp. 9 - 10. According to applicant, "a[t] the time of her death in 1884, Princess Pauahi Bishop was the largest landowner in Hawai'i, owning approximately one-tenth of the aggregate lands. Her will provided that the bulk of her estate should be placed in a charitable trust 'to erect and maintain in the Hawaiian Islands two schools ... to be known as, and called the Kamehameha Schools.'" Brief at p. 10. Applicant has stated that it is doing business as "Kamehameha Schools."

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<sup>4</sup> Applicant claims first use anywhere and first use in commerce in January 1980.

<sup>5</sup> Applicant has entered the following description of the mark into the record:

The design of the mark is described as a graphical representation of King Kamehameha in a standing position with one arm outstretched forward and the other arm holding a spear in an upright position; the drawing is enclosed by two concentric ovals, within which is placed the words "KAMEHAMEHA SCHOOLS 1887 ALUMNI"; the space between the two ovals is shaded dark and the words are light.

Registration has been refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's marks, when used with its identified goods, so resemble the registered mark KAMEHAMEHA (in typed form) for "clothing, namely, men's shirts, pants, shorts and T-shirts; women's shirts, pants, shorts, skirts, dresses, blouses and T-shirts; and children's shirts, pants, shorts, skirts, dresses, blouses and T-shirts; hats; and belts" in International Class 25<sup>6</sup> as to be likely to cause confusion, mistake or deception.

When the refusal was made final, applicant filed this appeal and requested reconsideration. The examining attorney denied the request for reconsideration and the appeal was resumed. Briefs have been filed. We affirm the refusal to register.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed.

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<sup>6</sup> Registration No. 2035318, issued February 4, 1997. Office records reflect registrant filed an application for renewal on January 23, 2007 - they do not reflect that the application for renewal has been acted upon.

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Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We first consider the *du Pont* factor regarding the similarities between the goods as set forth in the applications and registration. Applicant's two applications and the registration each include t-shirts for men, women and children in the identifications of goods. Further, both the IMUA application and the registration include shorts for men, women and children in the identifications of goods. Thus, applicant's and registrant's goods are in part identical. Further, three of the items listed in applicant's identifications of goods, i.e., polo shirts in both applications, and baseball caps in the IMUA application and golf caps in the ALUMNI application, are encompassed within the shirts and hats listed in registrant's identification of goods. As for the remaining items in applicant's identifications of goods, i.e., sweatshirts and jackets listed in the IMUA application, they are otherwise related to the clothing

items in registrant's identification of goods. Thus, the first *du Pont* factor is resolved against applicant.<sup>7</sup>

Next, we consider the first *du Pont* factor, i.e., whether applicant's marks and registrant's mark are similar or dissimilar when compared in their entireties in terms of appearance, sound, connotation and commercial impression. The analysis is not whether the marks can be distinguished when compared side-by-side. Rather, we must determine whether the marks are sufficiently similar that there is a likelihood of confusion as to source and, in making this determination, we must consider the recollection of the average purchaser who normally retains a general, rather than specific, impression of trademarks. *Sealed Air Corp.*

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<sup>7</sup> In its brief at p. 20, applicant concedes "some modest overlap" between applicant's and registrant's goods, but maintains that "the goods appear on this record to be different." According to applicant, it "seeks registration for 'clothing' to sell in association with its highly esteemed school" while registrant "appears to sell its KAMEHAMEA 'clothing' in association with a clothing business." Applicant's argument is unpersuasive because neither applicant's nor registrant's identifications of goods contain any limitations regarding marketing or trade channels. See *Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods [or services]."). See also *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); and *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1987). Both applicant's and registrant's identifications of goods must be construed to encompass all goods of the type described, and as moving in all channels of trade that would be normal for such goods. See *In re Elbaum*, 211 USPQ 639 (TTAB 1981).

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*v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Further, "[w]hen marks would appear on virtually identical goods ... the degree of similarity [of the marks] necessary to support a conclusion of likely confusion declines."

*Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992), cert. denied, 506 U.S. 1034 (1994). The same is likewise true with respect to closely related goods. See *In re J.M. Originals Inc.*, 6 USPQ2d 1393 (TTAB 1987); *ECI Division of E-Systems, Inc. v. Environmental Communications Inc.*, 207 USPQ 443 (TTAB 1980).

The examining attorney argues that the dominant component of applicant's marks is the term KAMEHAMEHA, which is identical to registrant's mark. Applicant responds as follows:

The marks claimed by Applicant herein are composite marks comprised of the words KAMEHAMEHA SCHOOLS 1887 IMUA and KAMEHAMEHA SCHOOLS 1887 ALUMNI together with a drawing of a man wearing a cape and helmet and holding a spear in his left hand with his right hand gesturing forward. The words "1887 IMUA/ALUMNI" in the marks are of equal size and emphasis as the words "KAMEHAMEHA SCHOOLS," and the design element is closely associated with, and larger than, the word elements. In addition, the term "KAMEHAMEHA SCHOOLS" appears together without any separation, as a single phrase, visually reinforcing the fact discussed above that Kamehameha Schools is a unique and well known institution quite distinct from the historical personage of King Kamehameha, which is further emphasized by its founding date,

"1887". The terms "IMUA" and "ALUMNI" are found at the bottom of the respective designs, separate and apart from "KAMEHAMEHA SCHOOLS 1887." The mark as a whole is tightly integrated, and no portion of the mark clearly dominates over any other portion. No portion or aspect of the mark is descriptive of the identified goods or of any characteristic or feature of the identified goods. As such, each element of the marks is equally strong. (Brief at p. 15.)

While we must consider the marks in their entirety, the Federal Circuit has noted that "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entirety. Indeed, this type of analysis appears to be unavoidable." *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). Upon consideration of the marks in their entirety, the evidence of record and the arguments of the examining attorney and applicant, we agree with the examining attorney that the marks have a dominant component and that KAMEHAMEHA is the dominant component.

We first consider the term KAMEHAMEHA. This term appears in the top portion of applicant's marks and is the first term a consumer would read when perceiving the marks. The marks also prominently feature a depiction of King Kamehameha, and applicant maintains that "King Kamehameha I

is a well known historical figure, both in the Hawaiian islands and throughout the United States." Brief at p. 8. Both the depiction of King Kamehameha and his status as a former king of Hawaii highlight KAMEHAMEHA in the marks.

The terms SCHOOLS, ALUMNI and IMUA, as well as the date 1887, do not create the same or equivalent impression that KAMEHAMEHA does in applicant's marks. The webpages submitted by the examining attorney with her September 30, 2005 Office action depict t-shirts and sweatshirts of various schools which include the terms "alumni," "university" and/or the year that each school was established.<sup>8</sup> Of particular relevance is the excerpt from thornntonites.com, reproduced below:

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<sup>8</sup> At p. 19 of its brief, applicant states that this evidence must be "ignored in the likelihood of confusion analysis" because it is "insufficient ... to establish that the KAMEHAMEHA SCHOOLS portion of the applicant's mark and the 1887 IMUA/ALUMNI portion of the marks are likely to be viewed by the public as 'weak'..." We disagree. The evidence cannot be ignored and is sufficiently probative of the examining attorney's contentions regarding the terms SCHOOLS and ALUMNI, and the date 1887.



The sweatshirt includes "Thornton Township High School" above the date 1899 and the word "Alumni," in essentially the same layout as comparable wording in the ALUMNI mark. The examining attorney's evidence suggests that clothing commonly bears the name of schools; and that the founding dates of schools, as well as terms such as "School" or "Schools" and "Alumni" commonly appear on clothing bearing the names of schools. Because such dates and terms are common, and because they provide information about the school identified in the article of clothing, we find that consumers will consider the date and such terms primarily as informational, and will accord them lesser significance than KAMEHAMEHA as a source indicator for the goods.

Additionally, IMUA, which applicant has stated translates into English as "go forward," does not form the same impression or have the same prominence as KAMEHAMEHA.

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First, the wording forms a slogan, akin to "Knowledge is Power," in the mark depicted in the thorntonites.com webpage. The slogan functions less as a source indicator than does KAMEHAMEHA, which is part of the name of applicant's school. Second, IMUA appears at the bottom portion of the mark - it is not placed in a position as prominent as the other terms in the mark. Third, IMUA appears in the same sized lettering as the remaining terms in the mark and is not featured in larger lettering or in a lettering style different from the other wording in the mark so as to draw the consumer's attention toward IMUA and away from, e.g., KAMEHAMEHA.

As for the design component of the marks, we consider the term KAMEHAMEHA to dominate over the design. The word component of a mark is normally accorded greater weight in determining the likelihood of confusion because the word portion is more likely to be impressed upon a purchaser's memory and used in calling for the goods. *In re Dakin's Miniatures Inc.* 59 USPQ2d 1593 (TTAB 1999). Also, the design component - featuring a representation of King Kamehameha - does not create a different commercial impression but rather reinforces KAMEHAMEHA as the dominant term in the mark.

For the foregoing reasons, we find that the term KAMAHAMEHA is the dominant portion of applicant's marks. Because the dominant component of applicant's marks is identical to registrant's mark, we find that the marks in their entireties are similar in sound, appearance, meaning, and commercial impression, and any differences due to the additional wording and design in applicant's marks are outweighed by such similarities. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). See, e.g., *In re Dixie Restaurants*, 41 USPQ2d at 1534 (Federal Circuit held that, despite the addition of the words "The" and "Café" and a diamond-shaped design to registrant's DELTA mark, there was a likelihood of confusion); *Wella Corp. v. California Concept Corp.*, 558 F.2d 1019, 194 USPQ 419, 422 (CCPA 1977) (CALIFORNIA CONCEPT and surfer design likely to be confused with CONCEPT for hair care products). See also *In re Denisi*, 225 USPQ 624, 624 (TTAB 1985) (if "the dominant portion of both marks is the same, then confusion may be likely notwithstanding peripheral differences.")

Applicant principally relies on *In re Hearst Corp.* 982 F.2d 493, 25 USPQ2d 1238 (Fed. Cir. 1992) in arguing in favor of registration of its mark. There, the Federal Circuit reversed the Board's decision refusing registration

of the mark VARGA GIRL for calendars on the ground of likelihood of confusion with the registered mark VARGAS for calendars and similar goods. In concluding that the Board erred in its analytical approach in finding that VARGA was the dominant component of VARGA GIRL, the Court stated that all components of a mark must be given their appropriate weight and that "[t]he appearance, sound, sight, and commercial impression of VARGA GIRL derive significant contribution from the component 'girl.' By stressing the portion 'varga' and diminishing the portion 'girl', the Board inappropriately changed the mark." *Id.* 25 USPQ2d at 1239.

Applicant's reliance on *Hearst* is misplaced. First, in *Hearst*, the terms VARGA and VARGAS were not identical, but in the case before us, the dominant term in applicant's marks (KAMEHAMEHA) is identical to registrant's entire mark. Second, the term SCHOOL in applicant's marks for articles of clothing is not the equivalent of GIRL in VARGA GIRL for calendars. The examining attorney's evidence shows that terms such as "school" and "university" are commonly used on clothing imprinted with the name of a school - this is different from the Board's finding in the underlying decision in *Hearst* that the term "girl" was merely descriptive of a feature of the applicant's

calendars. The "appropriate weight" to be accorded to GIRL in VARGA GIRL and SCHOOL in applicant's marks hence is different. As the Federal Circuit noted in *Hearst*, the appropriate weight to be given to a term is dependent on the facts and is "not entirely free from subjectivity." *Id.* Thus, the term SCHOOL in applicant's marks under this record cannot properly be considered in the same manner that the Federal Circuit considered GIRL in *Hearst*.

Applicant also maintains that "[j]ust as a reasonable consumer would easily know the difference between VARGAS the man and VARGA GIRLS the product, consumers will easily know the difference between KAMEHAMEHA the man and KAMEHAMEHA SCHOOLS the institution." Brief at p. 13. We are not persuaded by applicant's argument. First, applicant ignores that KAMEHAMEHA is a registered trademark owned by registrant, which is accorded all of the presumptions set forth in Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b), including the presumption of validity. Thus, the issue is not whether consumers will know the difference between King Kamehameha and Kamehameha Schools, but rather whether consumers will likely confuse the source of applicant's goods, believing them to be those of registrant. Also, applicant's own website, made of record by applicant with its request for reconsideration,

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refers to applicant as "Kamehameha." See ksbe.edu webpage stating, "The 600-acre Kapalama Campus is the largest and oldest of Kamehameha's three campuses"; and "The combined 6,550 preschool through grade 12 student enrollment make Kamehameha the largest independent school in the United States."

Thus, because both of applicant's marks are similar to registrant's marks, and applicant's goods are the same as, encompassed within or similar to registrant's goods, we find that there is a likelihood of confusion between applicant's and registrant's marks, and that the registration of applicant's marks is barred by Section 2(d). In reaching our decision, we have also carefully considered applicant's other arguments in support of its motion which are not explicitly discussed herein and do not find such arguments persuasive.

**Decision:** The refusal to register under Section 2(d) of the Trademark Act is affirmed in each application.