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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	76596501
Applicant	Trustees of the Estate of Bernice Pauahi
Applied for Mark	KAMEHAMEHA SCHOOLS 1887 IMUA
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Date	04/05/2007

TRADEMARK

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In Re Applications of: **Trustees of the
Estate of Bernice Pauahi Bishop**

Marks: **KAMEHAMEHA SCHOOLS
1887 IMUA and design (Serial No.
76/596501)**

and

**KAMEHAMEHA SCHOOLS
1887 ALUMNI and design (Serial No.
76/596503)**

Filed: **6/10/2004**

Trademark Attorney: **Steven W. Jackson**

Trademark Law Office: **107**

ON APPEAL
(Consolidated Proceedings)

**APPLICANT'S REQUEST FOR
RECONSIDERATION**

APPLICANT'S REQUEST FOR RECONSIDERATION

Pursuant to Trademark Rule 2.144, Applicant respectfully requests reconsideration of the Trademark Trial and Appeal Board's Opinion in the matters captioned above, mailed March 9, 2007. As grounds for such reconsideration applicant request consideration of the recent Ninth Circuit Court of Appeals *en banc* opinion in *Doe v. Kamehameha Schools/Bernice Pauahi Bishop Estate*, 470 F.3d 827 (9th Cir., December 5, 2006) (*en banc*), issued subsequent to the briefing in this appeal. This case provides additional judicial recognition of Kamehameha Schools as an entity separate and distinct from the historical figure of King Kamehameha and as

the outstanding educational institution created over a century ago by the will of the last direct descendent of King Kamehameha I, Princess Bernice Pauahi Bishop.

I. ANALYSIS OF THE MARK “KAMEHAMEHA SCHOOLS” AS A WHOLE MUST REFLECT CONSUMER RECOGNITION OF THE INSTITUTION

Applicant agrees that the issue in this case “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.” Opinion at 14. Applicant respectfully disagrees with the TTAB’s analysis that follows, however. The registrant cannot trade upon the reputation and goodwill of Kamehameha Schools, despite its registration, and therefore its mark KAMEHAMEHA must be recognized for what it is, a historical allusion to King Kamehameha. Applicant’s marks in this case, in contrast, explicitly include KAMEHAMEHA SCHOOLS, and by the additional elements of the marks emphasize the association with Kamehameha Schools. *See, e.g.* Reply Brief at 3. Accordingly, whether a consumer will easily distinguish between Kamehameha and Kamehameha Schools becomes the central issue as to whether the consumer will likely confuse the source of applicant’s goods, believing them to be those of registrant.

The TTAB’s opinion in this case also holds that “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.” Opinion at 13. But the first term in both marks in *Hearst* was also essentially “identical in sound, appearance, and meaning,” with the first term in VARGAS GIRLS essentially identical to the entire mark VARGA. The Federal Circuit said “undoubtedly ‘varga’ and ‘vargas’ are similar, [but] the marks must be considered in

the way they are used and perceived.” *Hearst*, 25 USPQ2d at 1239. So, the Federal Circuit, at least, did not consider “Varga” and “Vargas” to be different in a way that makes a difference. Surely the teaching of *Hearst* is not that adding an “s” to a word makes a critical difference. Instead, applicant respectfully submits that the teaching of *Hearst* is that the marks should be viewed as a whole, and all the elements of the mark given fair weight. In this case, to disregard or minimize the importance of the “Schools” element of applicant’s mark is to fail to give it fair weight. Analysis of the mark KAMEHAMEHA SCHOOLS as a whole must therefore reflect consumer recognition of the institution. The Ninth Circuit’s decision illustrates by its discussion of the history of Hawaii, the role of King Kamehameha, and the history and role of Kamehameha Schools in the islands, that those familiar with Hawaii will readily identify applicant’s marks with the institution. Thus the fame of the institution, and analysis of the marks as a whole, indicate that consumers will not be likely to confuse the source of applicant’s goods with someone other than the institution, or believe them to be those of registrant.

Applicant respectfully suggests that this additional judicial recognition of the history and significance of Kamehameha Schools, as an institution separate and apart from the historical figure of King Kamehameha I, should be weighed more heavily by the TTAB in evaluating this issue. Accordingly, applicant respectfully requests reconsideration of the TTAB’s narrow construction of the case of *In re Hearst*, 982 F.2d 493, 25 USPQ2d 1238 (Fed. Cir. 1992), in light of the Ninth Circuit’s recent judicial recognition of the history of Hawaii and of Kamehameha Schools.

II. THE NINTH CIRCUIT'S DISCUSSION OF THE HISTORY OF HAWAII AND KAMEHAMEHA SCHOOLS

The Ninth Circuit begins its discussion of the case with the history of the islands of Hawaii, mentioning the role of King Kamehameha in the unification of the islands:

The islands of Hawaii are geographically isolated in the South Pacific Ocean and were originally settled sometime between 1 and 750 A.D. The Native Hawaiians developed a well-organized, efficient, and thriving civilization “based on a communal land tenure system with a sophisticated language, culture, and religion.” 20 U.S.C. § 7512. The land, abundant in natural resources, allowed the Native Hawaiians to thrive. Office of Hawaiian Affairs, *Native Hawaiian Rights Handbook 3* (Melody Kapilialoha MacKenzie ed. 1991) (hereinafter “*Rights Handbook*”).

The first Western contact with the Hawaiian islands occurred in 1778 when Captain James Cook landed on the island of Kauai. The immediate result of that first encounter was that Native Hawaiians were introduced to Western goods and Western diseases. “By 1919, the Native Hawaiian population had declined from an estimated 1,000,000 in 1778 to an alarming 22,600.” 20 U.S.C. § 7512(7). *But see Rice v. Cayetano*, 528 U.S. 495, 500, 120 S. Ct. 1044, 145 L. Ed. 2d 1007 (2000) (estimating the population in 1778 as between 200,000 and 300,000).

In 1810, Kamehameha I created a unified monarchy over all the Hawaiian Islands, becoming the first King of Hawaii and affording the islands a level of cohesion and security that they had not previously known. The United States officially recognized the sovereignty of the Kingdom of Hawaii in 1826 and, from 1843 until 1893, extended full diplomatic recognition to the islands. Other countries, too--including Great Britain, France, and Japan--recognized the Hawaiian Kingdom. 20 U.S.C. § 7512(1). Before 1893, the United States entered into a number of treaties for peace, friendship, and commerce with the Kingdom. U.S. Dep't of Justice & U.S. Dep't of the Interior, *From Mauka to Makai: The River of Justice Must Flow Freely* 1 (Oct. 23, 2000) (hereinafter “*From Mauka to Makai*”). The first treaty was signed in 1826, and additional treaties were signed in 1849, 1875, and 1887. *See Rice*, 528 U.S. at 504 (discussing the history of diplomatic relations between the United States and the Kingdom of Hawaii before the overthrow of the monarchy).

Doe v. Kamehameha Schools/Bernice Pauahi Bishop Estate, 470 F.3d 827, 830 (9th Cir. 2006).¹

The court then goes on to discuss Kamehameha Schools and its history:

The Kamehameha Schools were created under a “charitable testamentary trust established by the last direct descendent of King Kamehameha I, Princess Bernice Pauahi Bishop, who left her property in trust for a school dedicated to the education and upbringing of Native Hawaiians.” *Burgert v. Lokelani Bernice Pauahi Bishop Trust*, 200 F.3d 661, 663 (9th Cir. 2000). Princess Bernice Pauahi Bishop's will provided for the erection and maintenance of schools in the Hawaiian Islands, called the Kamehameha Schools, on the Hawaiian monarchy's ancestral lands, with the purpose of providing “a good education in the common English branches, and also instruction in morals and in such useful knowledge as may tend to make good and industrious men and women.” Will of Bernice Pauahi Bishop, reprinted in *Wills and Deeds of Trust* 17-18 (3d ed. 1957) (hereinafter “Pauahi Bishop Will”). The Pauahi Bishop Will also bestowed on the “trustees full power to make all such rules and regulations as they may deem necessary for the government of said schools and to regulate the admission of pupils.” *Id.* at 18.

¹ The case arose in the context of a challenge to Kamehameha Schools' admissions policies. As the court explains:

Plaintiff John Doe, a student who has no Hawaiian ancestry, applied for admission to Defendant Kamehameha Schools, a private, non-profit K-12 educational institution in Hawaii that receives no federal funds. He was denied entry. The Kamehameha Schools were created through a charitable testamentary trust, established by the last direct descendant of the Hawaiian monarchy, for the education and upbringing of Native Hawaiians. As a result, the Kamehameha Schools' admissions policy gives preference to students of Hawaiian ancestry. Plaintiff argues that he was denied admission because of his race in violation of 42 U.S.C. § 1981.

The majority of a three-judge panel held that the Kamehameha Schools' admissions policy, with its preference for Native Hawaiians, constituted unlawful race discrimination under 42 U.S.C. § 1981. n1 We took this case en banc to reconsider whether a Hawaiian private, non-profit K-12 school that receives no federal funds violates § 1981 by preferring Native Hawaiians in its admissions policy. We now answer “no” to that question and, accordingly, affirm the district court.

470 F.3d at 829, The historical discussion quoted here “set the stage” for the court’s “more particular consideration of the educational status of Native Hawaiian children.” 470 F.3d at 830 n. 2.

Under the direction of the original trustees, chaired by Pauahi Bishop's widower, Charles Reed Bishop, the Kamehameha Schools opened in the late nineteenth century. During a speech on the Schools' first Founder's Day, in December 1888, Charles Reed Bishop stated that Princess Bernice Pauahi Bishop had created the Kamehameha Schools, "in which Hawaiians have the preference," so that "her own people" could once again thrive. Charles R. Bishop, *The Purpose of the Schools*, Handicraft, Jan. 1889, at 3.

470 F.3d at 831. The court notes,

The Pauahi Bishop Will established two separate schools, one for boys and one for girls. The boys' school opened in 1887 and the girls' school in 1894. During the 1965-1966 school year, the two schools were consolidated.

Id. "Today, the Kamehameha Schools operate three K-12 campuses: Kapalama on the island of Oahu, Pukalani on the island of Maui, and Keaau on the island of Hawaii." *Id.*

The case indicates the importance of Kamehameha Schools in Hawaii and its broad significance to the people of Hawaii. The court also notes that the panel's decision, reversed by the court *en banc*, "generated strong public opposition" –

Eleven amicus briefs were filed by diverse political and social interests in Hawaii supporting rehearing *en banc*. These amicus briefs were filed by: (1) the State of Hawaii; (2) the entire Hawaiian congressional delegation; (3) the Mayor of the City and County of Honolulu, and the City and County of Honolulu; (4) the Hawaii Business Roundtable, the Hawaii Korean Chamber of Commerce, the Public Schools of Hawaii Foundation, and the Hawaii Association of Independent Schools; (5) the National Association of Independent Schools; (6) the Parent-Teacher Association of Kamehameha Schools, and the Alumni Association of Kamehameha Schools; (7) the Native Hawaiian Legal Corporation, the Native Hawaiian Bar Association, and Na'A'ahuhiwa; (8) various Hawaiian service organizations; (9) 'Ilio'ulaokalani Coalition, an organization of Hawaiian master teachers and cultural experts; (10) the Japanese American Citizens League of Hawaii-Honolulu Chapter and other civic groups; and (11) the National Indian Education Association and the Alaskan Federation of Natives. Additionally, the current governor of Hawaii and a prominent former governor both submitted declarations to the district court on the importance of maintaining the Kamehameha Schools' admissions policy.

470 F.3d at 835 n. 6. Judge Fletcher’s concurring opinion reflects that the reputation of Kamehameha Schools goes beyond the state of Hawaii, and was sufficiently great that Congress passed two laws that “directed Kamehameha Schools – by name – to provide educational benefits to Native Hawaiians.” 470 F.3d at 854.

The court eloquently concludes:

King Kamehameha I, on his death bed, is reported to have said, “Tell my people I have planted in the soil of our land the roots of a plan for their happiness.” *Princess Pauahi Bishop and Her Legacy* at 122. His great granddaughter, Princess Bernice Pauahi Bishop, echoed that sentiment when she established, through her will, the Kamehameha Schools.

470 F.3d at 849.

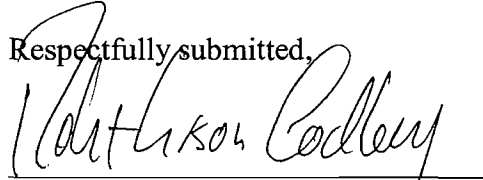
Applicant agrees that the issue in this case “is not whether consumers will know the difference between King Kamehameha and Kamehameha Schools, but rather whether consumers will likely confuse the source of applicant’s goods, believing them to be those of registrant.” Opinion at 14. But applicant respectfully submits that the teaching of *Hearst* is that marks should be viewed as a whole, and all the elements of the mark given fair weight. To do that, in this case, requires an analysis of whether consumers will likely confuse the source of applicant’s goods, and that, in turn, depends in significant part on whether they will perceive a difference between King Kamehameha and Kamehameha Schools. The Ninth Circuit’s recent *en banc* decision is important to this analysis because it shows both the historical and contemporary importance of Kamehameha Schools. That, in turn, should weigh heavily on the evaluation of the consumer’s recognition of Kamehameha Schools as an institution, and thus the commercial impact of applicant’s marks when viewed as a whole, with all the elements of the marks given fair weight.

III. CONCLUSION

As the *en banc* decision of the Ninth Circuit reflects, Kamehameha Schools is an institution with more than a century of history and tradition, and is quite distinct from the historical personage of King Kamehameha. Hence applicant's marks including KAMEHAMEHA SCHOOLS are not likely to be confused with the KAMEHAMEHA mark owned by the registrant. Because there is no likelihood of confusion between the marks at issue here, applicant respectfully requests that the TTAB reconsider its decision in this matter and that the refusals to register be reversed.

DATED: Honolulu, Hawaii, April 5, 2007.

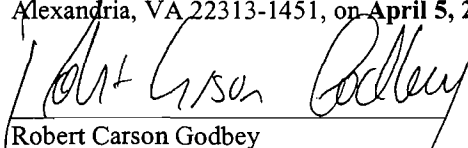
Respectfully submitted,



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Robert Carson Godbey