

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

Mailed:
July 12, 2007
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

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

Serial Nos. 76596501 and 76596503

Request for Reconsideration

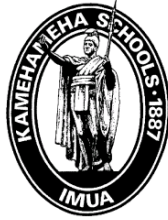
Robert Carson Godbey and Chad M. Iida of Godbey Griffiths
Reiss Chong for Trustees of the Estate of Bernice Pauahi
Bishop.

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

Before Quinn, Drost and Zervas, Administrative Trademark
Judges.

Opinion by Zervas, Administrative Trademark Judge:

On April 5, 2007, applicant filed a request for
reconsideration of our final decision mailed on March 9,
2007. In our final decision, we affirmed the examining
attorney's refusal under Section 2(d) of the Trademark Act
to register on the Principal Register (i) the mark



in application Serial No. 76596501 for "clothing; namely, t-shirts, polo shirts, sweatshirts, jackets, and shorts for men, women, and children; and baseball caps"; and (ii) the mark



in application Serial No. 76596503 for "clothing; namely, t-shirts and polo shirts for men, women, and children; and caps, namely, golf caps." The examining attorney refused registration of both marks in view of the previously registered mark KAMEHAMEHA (Registration No. 2035318) for "clothing; namely, t-shirts and polo shirts for men, women, and children; and caps, namely, golf caps."

Applicant seeks the Board's consideration of *Doe v. Kamehameha Schools/Bernice Pauahi Bishop Estate*, 470 F.3d 827 (9th Cir. December 5, 2006) (*en banc*), a Ninth Circuit decision involving a claim of unlawful racial

discrimination, which issued one month after applicant filed its reply brief and several months before the Board rendered its decision. According to applicant, the Ninth Circuit's decision "shows both the historical and contemporary importance of Kamehameha Schools"; and that "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." Brief at pp. 3 and 7.

Applicant relies on a court decision but does not refer to any point of law decided by the court. Rather, applicant relies on the court's discussion of certain facts. We therefore consider applicant's reliance on the decision as raising additional facts which the Board should consider and not as demonstrating that pursuant to the Ninth Circuit's decision (on the racial discrimination claim), the Board's decision is in error and requires appropriate change. A request for reconsideration, however, cannot be used to submit additional evidence. See TBMP § 543 (2d ed. rev. 2004).

Additionally, applicant argues that "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." Brief at p. 3. Applicant's argument is not persuasive because with the evidence of record, applicant has not established the fame of its mark. Even if it had, *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), lists "fame of the prior mark" as one of the factors to consider in a likelihood of confusion analysis, which in this situation would be the *registered* mark, even though applicant has a claimed first use date prior to the first use date claimed by registrant. Further, to the extent that applicant's argument is that consumers, when perceiving KAMEHAMEHA on articles of clothing will believe the source of registrant's goods to be applicant, applicant's argument is really one of reverse confusion. The Federal Circuit, our primary reviewing court, has recognized that reverse confusion is also prohibited by Section 2(d). See *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993).

Finally, even if applicant's argument is that there is no likelihood of confusion because its mark is better known than registrant's mark, or that applicant's mark is not widely known by the general consuming public, this is not a basis to deny registration: "[t]rademark rights are

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neither acquired nor lost on the basis of comparative popularity." *Wallpaper Mfrs., Ltd. v. Crown Wallcovering Corp.*, 680 F.2d 755, 214 USPQ 327 (CCPA 1982).

In view of the foregoing, applicant's request for reconsideration is denied, and the Board's March 9, 2007 decision stands.