

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 76/596501

APPLICANT: Trustees of the Estate of Bernice Pauahi ETC.



CORRESPONDENT ADDRESS:

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RETURN ADDRESS:

Commissioner for Trademarks
P.O. Box 1451
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If no fees are enclosed, the address should include the words "Box Responses - No Fee."

MARK: KAMEHAMEHA SCHOOLS 1887 IMUA

CORRESPONDENT'S REFERENCE/DOCKET NO: N/A

CORRESPONDENT EMAIL ADDRESS:

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address..

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Applicant is requesting reconsideration of a final refusal dated May 18, 2005.

After careful consideration of the law and facts of the case, the examining attorney must deny the request for reconsideration and adhere to the final action as written since no new facts or reasons have been presented that are significant and compelling with regard to the point at issue.

When applicant's mark is compared to a registered mark, "the points of similarity are of greater importance than the points of difference." *Esso Standard Oil Co. v. Sun Oil Co.*, 229 F.2d 37, 40, 108 USPQ 161 (D.C. Cir. 1956) (internal citation omitted). In its request, the applicant contends that the examining attorney did not argue or show that SCHOOLS 1887 IMUA and the design element were weak or insignificant portions of the applicant's mark. As stated in the final refusal, the addition of the wording "SCHOOLS 1887 IMUA" serves only to identify the applicant's entity. Many schools and universities use similar wording on their perspective clothing goods. Please see the attached sample of web captions featuring clothing that includes the use of similar wording and "founding" or "established" dates for schools and universities along with design elements. It's quite common to put these types of words on clothing, and consumers are well aware of these terms on school clothing. Consumers will still recognize the applicant's goods and registrant's goods by the dominant term, KAMEHAMEHA, which remains the dominant feature of the marks.

The examining attorney notes that when a mark consists of a word portion and a design portion, the word portion is more likely to be impressed upon a purchaser's memory and to be used in calling for the goods or services. Therefore, the word portion is normally accorded greater weight in determining

likelihood of confusion. *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999); *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987); *Amoco Oil Co. v. Amerco, Inc.*, 192 USPQ 729 (TTAB 1976); TMEP §1207.01(c)(ii).

Any doubt regarding a likelihood of confusion is resolved in favor of the prior registrant. *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); TMEP §§1207.01(d)(i).

Accordingly, applicant's request for reconsideration is *denied*. The time for appeal runs from the date the final action was mailed. 37 C.F.R. Section 2.64(b); TMEP Section 715.03(c).

/Steven W. Jackson/
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