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SCHOOLS 1887 IMUA - N/A

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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 76/596501
76/596503

APPLICANT: Trustees of the Estate of Bernice Pauahi ETC.



**BEFORE THE
TRADEMARK TRIAL
AND APPEAL BOARD
ON APPEAL**

CORRESPONDENT ADDRESS:
ROBERT CARSON GODBEY
GODBEY GRIFFITHS REISS
1001 BISHOP STREET
PAUAHI TOWER, SUITE 2300
HONOLULU, HAWAII 96813

MARK: KAMEHAMEHA SCHOOLS 1887 IMUA
KAMEHAMEHA SCHOOLS 1887 ALUMNI

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.

EXAMINING ATTORNEY'S APPEAL BRIEF

This is a consolidated appeal regarding Application Serial Numbers 76596501 and 76596503, for the marks, KAMEHAMEHA SCHOOLS 1887 IMUA and KAMEHAMEHA SCHOOLS 1887 ALUMNI. The identification of goods in these applications are as follows: “clothing; namely, tshirts, polo shirts, sweatshirts, jackets, and shorts for men, women, and children; and baseball caps;” and “clothing; namely, tshirts and polo shirts for men, women, and children; and caps, namely, golf caps,” respectively.

STATEMENT OF THE CASE

Applicant has appealed the trademark examining attorney's final refusals to register the trademarks KAMEHAMEHA SCHOOLS 1887 IMUA and KAMEHAMEHA SCHOOLS 1887 ALUMNI, for "clothing; namely, tshirts, polo shirts, sweatshirts, jackets, and shorts for men, women, and children; and baseball caps; and clothing; namely, tshirts and polo shirts for men, women, and children; and caps, namely, golf caps" on the ground of likelihood of confusion, mistake or deception under Trademark Act Section 2(d), 15 U.S.C. §1052(d), with the mark in U.S. Registration Number 2035318, KAMEHAMEHA, 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." It is respectfully requested that these refusals be affirmed.

FACTS

Applicant filed Application Serial Numbers 76596501 and 76596503 on June 10, 2004, under Section 1(a), applying to register on the Principal Register the marks, KAMEHAMEHA SCHOOLS 1887 IMUA and KAMEHAMEHA SCHOOLS 1887 ALUMNI, for "clothing; namely, tshirts, polo shirts, sweatshirts, jackets, and shorts for men, women, and children; and baseball caps;" and "clothing; namely, tshirts and polo shirts for men, women, and children; and caps, namely, golf caps," respectively, in International Class 025. In the initial Office actions dated January 11, 2005, registrations were refused under Section 2(d) on the ground that the marks, when used in connection with the identified goods, so resemble the mark in U. S. Registration No. 2035318 as to be likely to cause confusion, to cause mistake, or to deceive. The applicant was also

required to clarify whether the name in the marks identified a particular living individual, clarify whether the portrait shown in the marks depicted a particular living individual, submit a drawing statement, and submit an English translation of all foreign wording in the marks.

On March 9, 2005, and March 15, 2005, the applicant argued against the refusals to register the marks under Section 2(d) likelihood of confusion with regard to U.S. Reg. No. 2035318, provided statements regarding whether the name in the marks identified a particular living individual and whether the portrait shown in the marks depicted a particular living individual, provided a drawing statement, and submitted a translation statement.

On May 18, 2005, the refusals to register under Section 2(d) likelihood of confusion with regard to U.S. Reg. No. 2035318 were continued and made FINAL. On September 8, 2005, the applicant submitted its Requests for Reconsideration. On September 30, 2005, the examining attorney denied the Requests for Reconsideration. On January 27, 2006, the applicant filed a Motion to Consolidate.

On July 21, 2006, the applicant filed its appeal brief, and the file was forwarded to the examining attorney for statement on August 16, 2006.

ISSUE

The issue on appeal is whether the marks, when used in connection with the identified goods, so resembles the mark in Registration No. 2035318 as to be likely to cause confusion, to cause mistake, or to deceive under Trademark Act Section 2(d).

ARGUMENT

BECAUSE THE MARKS WILL BE APPLIED TO IDENTICAL AND SUBSTANTIALLY RELATED GOODS, REGISTRATION OF “KAMEHAMEHA SCHOOLS 1887 IMUA” and “KAMEHAMEHA SCHOOLS 1887 ALUMNI,” WHICH CREATE A HIGHLY SIMILAR COMMERCIAL IMPRESSION AS THE REGISTERED MARK, “KAMEHAMEHA,” IS LIKELY TO CREATE CONSUMER CONFUSION AS TO SOURCE.

I. SIMILARITY OF THE MARKS

THE MARKS CREATE A HIGHLY SIMILAR COMMERCIAL IMPRESSION

Trademark Act Section 2(d) bars registration where an applied-for mark so resembles a registered mark that it is likely, when applied to the goods, to cause confusion, mistake or to deceive the potential consumer as to the source of the goods. TMEP §1207.01. The Court in *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973), listed the principal factors to consider in determining whether there is a likelihood of confusion. Among these factors are the similarity of the marks as to appearance, sound, meaning and commercial impression, and the relatedness of the goods. The overriding concern is to prevent buyer confusion as to the source of the goods. *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, 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).

A. The Marks, Taken in Their Entirety, are Confusingly Similar

In its Appeal Brief, the applicant relies on *In Re Hearst Corporation*, 982 F.2d 493, 25 USPQ2d 1238 (Fed. Cir. 1992) in which the Court reversed the Board's decision, holding that the marks "Varga Girl" and "Vargas" were sufficiently different in sound, appearance, connotation, and commercial impression, to negate any likelihood of confusion. Applicant's Brief, page 11. Applicant avers that there is a distinction between KAMEHAMEHA and the "KAMEHAMEHA SCHOOLS" marks similar to the distinction that the Court found between "Vargas" and "Varga Girl." The applicant contends that consumers will easily know the difference between KAMEHAMEHA and the "KAMEHAMEHA SCHOOLS" marks. Applicant's Brief, page 13.

The examining attorney respectfully disagrees. KAMEHAMEHA is the dominant feature of the marks. Unlike in *Hearst*, this wording is identical in sound, appearance, and meaning. In its brief, the applicant provides the historical significance of the word, KAMEHAMEHA: "King Kamehameha I is a well known historical figure, both in the Hawaiian Islands and throughout the United States." Applicant's Brief, page 8. Both registrant and applicant are located in Hawaii. If the applicant's statement were correct, then residents of Hawaii and throughout the United States would recognize the registrant's mark. KAMEHAMEHA is the first word in registrant's mark and the applicant's marks. As a general rule, consumers are more inclined to focus on the first word in any trademark or service mark. *Palm Bay Imports, Inc. v. Veuve Clicquot*, 396

F.3d 1369, 73 USPQ2d 1689, 1690 (Fed. Cir. 2005); *Presto-Products Inc. v. Nice-Pak Products Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("It is often the first part of a mark that is most likely to be impressed upon the mind of a purchaser and remembered"); *Mine Safety Appliances Co. v. Management Science America, Inc.*, 212 USPQ 105, 108 (TTAB 1981). Here it is of particular importance because KAMEHAMEHA not only comes first but it stands out in projecting the connotation and commercial impression in the marks. When students and graduates of applicant's schools are asked, "What school do you go to?" or "Where did you go to school?," the answer is just as likely to be "Kamehameha" as it is to be "Kamehameha Schools." Thus, the commercial impression of the word used by similar marks with identical and highly related goods would be the same.

Accordingly, unlike in *Hearst*, even when given fair weight with additional wording, confusion between KAMEHAMEHA and the "KAMEHAMEHA SCHOOLS" marks becomes more likely.

The applicant's marks, KAMEHAMEHA SCHOOLS 1887 IMUA and KAMEHAMEHA SCHOOLS 1887 ALUMNI, and the registered mark, KAMEHAMEHA, all share the wording, KAMEHAMEHA. This Board has repeatedly held that marks may be confusingly similar in appearance where there are similar terms or phrases or similar parts of terms or phrases appearing in both applicant's and registrant's mark. *See e.g.*, *Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689 (TTAB 1986), *aff'd* 1 USPQ2d 1813 (Fed. Cir. 1987) (COMMCASH and COMMUNICASH); *In re Phillips-Van Heusen Corp.*, 228 USPQ 949 (TTAB 1986) (21 CLUB and "21" CLUB (stylized)); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (CONFIRM and

CONFIRMCELLS); *In re Collegian Sportswear Inc.*, 224 USPQ 174 (TTAB 1984) (COLLEGIAN OF CALIFORNIA and COLLEGIENNE); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983) (MILTRON and MILLTRONICS); *In re BASF A.G.*, 189 USPQ 424 (TTAB 1975) (LUTEXAL and LUTEX); TMEP §§1207.01(b)(ii) and (b)(iii). Here, the shared term in the applicant's marks and registrant's mark is identical. It is the dominant feature of the marks. The addition wording in applicant's marks does nothing to alter the dominance of KAMEHAMEHA in the marks. If anything, it reinforces the impression. Applicant's marks may even be regarded as a variation on the theme of the registered mark.

The applicant contends that consumers will distinguish between the marks due to the context of applicant's use in conjunction with its primary business, namely, a school. Applicant's Brief, page 14. This contention assumes the average consumer's knowledge of applicant as a school. Although the applicant states that its institution is historical and well known, the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. *See In re Decombe*, 9 USPQ2d 1812 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983); TMEP §1207.01(d)(vii). Consumers are likely to encounter applicant's and registrant's marks, applied to identical and highly related clothing goods, without any knowledge of registrant and its primary products. Accordingly, the connotations and commercial impressions of the marks of applicant and registrant are highly similar.

B. The Terms, “SCHOOLS,” “1887,” “IMUA,” and “ALUMNI,” are not Indicators of Source

In its Appeal Brief, the applicant avers that because of the inclusion of the terms, “SCHOOLS,” “1887,” “IMUA,” and “ALUMNI,” the marks are sufficiently different that, even when used in connection with highly related goods, confusion will not result. Applicant’s Brief, pages 14-16. Regarding the issue of likelihood of confusion, the question is not whether people will confuse the marks, but whether the marks will confuse people into believing that the goods they identify come from the same source. *In re West Point-Pepperell, Inc.*, 468 F.2d 200, 175 USPQ 558 (C.C.P.A. 1972). For that reason, the test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The question is whether the marks create the same overall impression. *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1890 (Fed. Cir. 2000); *Visual Information Inst., Inc. v. Vicon Indus. Inc.*, 209 USPQ 179 (TTAB 1980). The focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975); TMEP §1207.01(b).

Not all words, designs, symbols or slogans used in the sale or advertising of goods or services function as marks, even if they may have been adopted with the intent to do so. A designation cannot be registered unless ordinary purchasers would regard it as a source-indicator for the goods. *In re Manco, Inc.*, 24 USPQ2d 1938 (TTAB 1992);

TMEP §§1202 *et seq.* Here, the addition of the terms “schools,” “1887,” and the terms “IMUA” and “ALUMNI,” incorporated within a design element are merely informational matter that do not function as indicators of source. Applicant states that 1887 is the founding date of the schools. Applicant’s Brief, page 14, 15. The term “IMUA,” which translates to mean, “go forward,” is the applicant’s motto encouraging education. Applicant’s 3/15/05 Response, page 2. The terms “SCHOOLS” and “ALUMNI” are commonly used words that provide information about the wearer of the clothing goods. The use of these terms, each contained in a common geometric carrier, an oval, simply convey useful information to consumers but do not function as trademarks for clothing. Backgrounds consisting of common geometric shapes are of little trademark significance because they are viewed as "carriers" of the mark. *See Seabrook Foods, Inc., v. Bar-Well Foods Ltd.*, 568 F.2d 1342, 196 USPQ 289 (CCPA 1977); *Guess? Inc. v. Nationwide Time Inc.*, 16 USPQ2d 1804 (TTAB 1990); *In re Anton/Bauer Inc.*, 7 USPQ2d 1380 (TTAB 1988); *see also In re Decombe*, 9 USPQ2d 1812 (TTAB 1988) (simple designs are not remembered).

C. The Term KAMEHAMEHA is the Dominant Portion of the Applicant’s Marks

While the applicant contends that its marks represent a well-known academic institution, the applicant has not submitted any evidence that its marks are well known in the clothing industry. Applicant has not submitted any evidence of any third-party use or registrations of other “KAMEHAMEHA” marks in connection with the same or similar goods. Thus, it must be concluded that the word “KAMEHAMEHA” is an arbitrary and strong mark as applied to registrant's clothing goods, and hence entitled to a wider scope

of protection than less distinctive, weaker, suggestive or descriptive marks. *See, e.g., In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566, 223 USPQ 1289, 1290 (Fed. Cir. 1984) (when word marks are identical but neither suggestive nor descriptive of the goods, the first Dupont factor weighs heavily against the applicant); *E. & J. Gallo Winery v. Gallo Cattle Co.*, 967 F.2d 1280, 1292 (9th Cir. 1992) (strong marks are given the highest degree of trademark protection); *Time, Inc. v. Petersen Publ'g Co.*, 173 F.3d 113, 118, 50 USPQ2d 1474 (2d Cir. 1999) ("The strongest marks are arbitrary or fanciful marks, which are entitled to the fullest protection against infringement."); *In re Emulex*, 6 USPQ2d 1312, 1314 (TTAB 1987).

Applicant avers that the design elements of its marks are significant such that consumers are not more than likely to remember any one aspect of its marks but are likely to recall its marks in their entirety. Applicant's Brief, page 18. The word portion is dominant over the design portion. This Board has held that where applicant's mark consists of a word portion and a design portion it is appropriate to give more weight to the literal portion of applicant's mark because it is the part that will be most easily remembered and used to call for or to recommend the goods. *See CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983) ("[T]he verbal portion of the mark is the one most likely to indicate the origin of the goods to which it is affixed"); *see also In re Appetito Provisions Co.*, 3 USPQ2d 1553, 1554 (TTAB 1987) ("[I]f one of the marks comprises both a word and a design, then the word is normally accorded greater weight because it would be used to request the goods or services"); *Ceccato v. Manifattura Lane Gaetano Marzotto Figli S.p.A*, 32 USPQ2d 1192, 1197 (TTAB 1994) ("[I]t is appropriate to give greater weight to the word portions of the mark, because it is by the words that

purchasers will refer to the goods, and the words, rather than the design feature or the stylized lettering, will therefore have a greater impression on them.”); *Helene Curtis Indus. Inc., v. Suave Shoe Corp.*, 13 USPQ2d 1618, 1621 (TTAB 1989) (“[I]t has consistently been held that where a mark comprises a word portion and a design portion it is the word feature that is controlling.”); *Kabushiki Kaisha Hattori Tokeiten v. Scutto*, 228 USPQ 461, 462 (TTAB 1985) (same).

For example, the design element of a mark would probably not be used by word-of-mouth, and may probably not be used in textual material such as catalogs, alphabetical listings or media stories. *CBS Inc. v. Morrow*, 218 USPQ at 200. Rather, it is the words in the mark that generally are used in such instances. *Id.* Hence, in general, the additional of a design element does not eliminate the similarity between marks that have common literal portions. *Coca-Cola Bottling Co. v. Joseph E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (CCPA 1975). For this reason, in the present case, greater weight has been given to the literal portions of the marks in determining whether there is a likelihood of confusion. TMEP §1207.01(c)(ii). As discussed, the dominant feature of the marks, KAMEHAMEHA, is identical in appearance, sound, meaning, and commercial impression. The addition of the design element does not obviate the similarity between the marks in this case.

Applicant also contends that since the registrant’s mark does not incorporate any design element, it is not likely to cause confusion. Applicant’s Brief, page 16. However, registration of a mark in typed or standard character form means that the mark may be

displayed in any lettering style. 37 C.F.R. §2.52(a). The rights associated with a mark in typed or standard character form reside in the wording itself, and registrant is free to adopt any style of lettering, including lettering identical to that used by applicant.

Therefore, applicant's presentation of its marks in special form will not avoid likelihood of confusion with a mark that is registered in typed or standard character form because the marks could be used in the same manner of display. *See In re Melville Corp.*, 18 USPQ2d 1386, 1387-88 (TTAB 1991); *In re Pollio Dairy Prods. Corp.*, 8 USPQ2d 2012, 2015 (TTAB 1988); *Sunnen Prods. Co. v. Sunex Int'l Inc.*, 1 USPQ2d 1744, 1747 (TTAB 1987); *In re Hester Indus., Inc.*, 231 USPQ 881, 882, n.6 (TTAB 1986); *United Rum Merchants, Ltd. v. Fregal, Inc.*, 216 USPQ 217, 220 (TTAB 1982); *Frances Denney, Inc. v. Vive Parfums, Ltd.*, 190 USPQ 302, 303-04 (TTAB 1976); TMEP §1207.01(c)(iii).

D. The Elements of Applicant's Marks do not Serve to Distinguish the Marks from the Registered Mark

The applicant avers that the additional elements found in its marks serve to reinforce the source of the goods as the applicant's primary business and not the registered mark. The applicant contends that the examining attorney's evidence, illustrating various academic institutions using SCHOOLS and UNIVERSITY with dates of establishment, submitted in his actions Denying Request for Reconsideration, actually serve to support the applicant's argument that these elements serve to distinguish the applicant's marks from the registered mark. Applicant's Brief, pages 19-20.

The examiner's evidence attached to the actions Denying Request for Reconsideration of September 29, 2005 shows that the additional elements, such as dates of establishment and "alumni," are commonly used for informational purposes but do not serve as source indicators. The following website captions taken from the examining attorney's actions Denying Request for Reconsideration of September 29, 2005, illustrate the common use of such terms:

www.campustraditionsusa.com: a Tee-shirt of MISSISSIPPI STATE with the school's team name, "BULLDOGS," with "athletics" and "est. 1876;" and

a long sleeve Tee shirt VIRGINIA with the school's team name, "CAVALIERS," with "athletics" and "the school's logo" along with "est. 1819."

www.collegegear.com: a hooded sweatshirt of INDIANA with "1820."

store.fansonly.com: an alumni T-shirt and sweatshirt of NOTRE DAME with "alumni" and "est. 1842."

bookstore.ucdavis.edu: an alumni T-shirt of UC DAVIS with "the school's logo," "alumni," and "est. 1905."

www.efollett.com: an alumni sweatshirt of CAL LUTHERAN UNIVERSITY with "the school's logo," and "est. 1933."

www.thorntonites.com: a sweatshirt of THORNTON TOWNSHIP HIGH SCHOOL with "the school's motto," "alumni," and "1899."

The applicant contends that without the additional terms, consumers would not know that the clothing items they were purchasing were from the particular school or university. As an example, the applicant contends that purchasers of a T-shirt with "VIRGINIA" and nothing more would assume that it referenced the State of Virginia and not the University of Virginia. Applicant's Brief, pages 19-20. The examining attorney finds this contention unpersuasive. "Virginia" is a commonly used term that is not arbitrary.

“Kamehameha” is an arbitrary term that is based on a specific individual. If consumers purchased a T-shirt that had, as examples, the arbitrary words, “HARVARD,” “YALE,” or “BRIGHAM YOUNG,” they are likely to believe that the T-shirt comes from the university or school of the same name. Similarly, purchasers of KAMEHAMEHA clothing items are just as likely to believe that the clothing comes from the school of the same name.

The Trademark Act not only guards against the misimpression that the senior user is the source of the junior user’s goods, but it also protects against “reverse confusion,” that is, that the junior user is the source of the senior user’s goods. *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993); *Banff Ltd., v. Federated Department Stores*, 6 USPQ2d 1187 (2d Cir. 1988); *Fisons Horticulture v. Vigor Industries*, 31 USPQ2d 1592 (3d Cir. 1994).

Thus, when compared in their entireties, the marks are similar in both connotation and commercial impression in light of the common term, “KAMEHAMEHA.” Accordingly, the marks are sufficiently similar that if they were contemporaneously used on related goods, confusion as to the source or sponsorship of such goods would be likely.

II. COMPARISON OF THE GOODS

APPLICANT’S GOODS ARE IDENTICAL AND SUBSTANTIALLY
RELATED TO REGISTRANT’S GOODS

The goods of the parties need not be identical or directly competitive to find a likelihood of confusion. Instead, they need only be related in some manner, or the conditions surrounding their marketing be such that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods come from a common source. *On-line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984); *Guardian Prods. Co., Inc. v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); *In re Int'l Tel. & Tel. Corp.*, 197 USPQ 910 (TTAB 1978); TMEP §1207.01(a)(i).

As provided above, the applicant's goods are "clothing; namely, tshirts, polo shirts, sweatshirts, jackets, and shorts for men, women, and children; and baseball caps; and clothing; namely, tshirts and polo shirts for men, women, and children; and caps, namely, golf caps." The registrant's goods are "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." The applicant's identification and the registrant's identification contain the following identical goods: "t-shirts" and "shorts." The remaining clothing goods are highly related.

The decisions in the clothing field have held many different types of apparel to be related under Section 2(d). *Cambridge Rubber Co. v. Cluett, Peabody & Co., Inc.*, 286 F.2d 623,

128 USPQ 549 (C.C.P.A. 1961) (“WINTER CARNIVAL” for women’s boots v. men’s and boys’ underwear); *Jockey Int’l, Inc. v. Mallory & Church Corp.*, 25 USPQ2d 1233 (TTAB 1992) (“ELANCE” for underwear v. “ELAAN” for neckties); *In re Melville Corp.* 18 USPQ2d 1386 (TTAB 1991) (“ESSENTIALS” for women’s pants, blouses, shorts and jackets v. women’s shoes); *In re Pix of America, Inc.*, 225 USPQ 691 (TTAB 1985) (“NEWPORTS” for women’s shoes v. “NEWPORT” for outer shirts); *In re Mercedes Slacks, Ltd.*, 213 USPQ 397 (TTAB 1982) (“OMEGA” for hosiery v. trousers); *In re Cook United, Inc.*, 185 USPQ 444 (TTAB 1975) (“GRANADA” for men’s suits, coats, and trousers v. ladies’ pantyhose and hosiery); *Esquire Sportswear Mfg. Co. v. Genesco Inc.*, 141 USPQ 400 (TTAB 1964) (“SLEEX” for brassieres and girdles v. slacks for men and young men).

Applicant contends that because it is presenting its clothing goods to the public under the purview of its primary service, a school, the channels of marketing the goods will differ from those of the registrant. Applicant’s Brief, page 20. The goods are related.

Although the applicant contends that its goods are to be sold in association with its school, neither the application nor the registration contain any limitations regarding trade channels for the goods and therefore it is assumed that registrant’s and applicant’s goods are sold everywhere that is normal for such items, i.e., clothing and department stores, websites. Thus, it can also be assumed that the same classes of purchasers shop for these items and that consumers are accustomed to seeing them sold under the same or similar marks. *See Kangol Ltd. V. KangaROOS U.S.A. Inc.*, 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992); *In re Smith and Mehaffey*, 31 USPQ2d 1531 (TTAB 1994).

CONCLUSION

The applicant's marks, KAMEHAMEHA SCHOOLS 1887 IMUA and KAMEHAMEHA SCHOOLS 1887 ALUMNI, on their face, are confusingly similar to the mark in U.S. Reg. No. 2035318, KAMEHAMEHA, in that the marks feature the wording KAMEHAMEHA. In addition, both the applicant's marks and registrant's mark are used in conjunction with identical and substantially related goods. Furthermore, the applicant has failed to properly demonstrate that the registrant's mark is undeserving of protection. As such, it is highly likely that the applicant's marks, KAMEHAMEHA SCHOOLS 1887 IMUA and KAMEHAMEHA SCHOOLS 1887 ALUMNI, and the registrant's mark, KAMEHAMEHA, will cause consumer confusion. Any doubt regarding a likelihood of confusion is resolved in favor of the prior registrant.

For these reasons, it is respectfully requested that the Refusal of Registration under Trademark Action Section 2(d), 15 U.S.C. Section 1052(d), be affirmed.

Respectfully submitted,

/Steven Jackson/
Steven W. Jackson
Trademark Attorney
Law Office 107
Phone: 571-272-9409
Fax: 571-273-9107

J. LESLIE BISHOP
Managing Attorney
Law Office - 107