

This Opinion is not a
Precedent of the TTAB

Mailed: December 7, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board

—
In re Ai

—
Serial No. 86842205

—
James C. Wray of James C. Wray,
for Olana Margaret Ai, Howard K. Ai, and Shelsea Lilia M.L. Ai

Khanh M. Le, Trademark Examining Attorney, Law Office 116,
Christine Cooper, Managing Attorney.

—
Before Quinn, Goodman and Lynch,
Administrative Trademark Judges.

Opinion by Goodman, Administrative Trademark Judge:

Olana Margaret Ai, Howard K. Ai, and Shelsea Lilia M.L. Ai (“Applicants”) seek
registration on the Principal Register of the mark OLANA (in standard characters)
for

Jewelry in International Class 14;

Clothing, namely, tops, bottoms and skirts; dance costumes in
International Class 25; and

Entertainment, education and cultural services, namely dance, vocal and instrument instructions and presentation of live show performances in International Class 41.¹

The Trademark Examining Attorney has refused registration of Applicants' mark in Classes 14 and 25 on the basis that the specimen does not show the applied-for mark in the drawing in use in commerce because the mark in the drawing is not a substantially exact representation of the mark as it appears on the specimens of record. Trademark Act Sections 1 and 45, 15 U.S.C. §§ 1051, 1127.

When the refusal was made final, Applicants appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed. We affirm the refusal to register.

It is the Examining Attorney's position that the drawing, which is for the word OLANA, is not a substantially exact representation of the mark as used in connection with the goods, because the specimens depict the mark as "HULAOLANA," "HALAUHULAOLANA" or "HALAU HULA OLANA."

Applicants, on the other hand, argue that the mark OLANA presents a separate and distinct commercial impression, and is separate from the other words HALAU and HULA.

The specimens of use are shown below:

¹ Application Serial No. 86842205 was filed on December 08, 2015, based upon Applicants' claim of first use anywhere and use in commerce since at least as early as September 2004 for jewelry; September 1985 for clothing; and December 1970 for entertainment, educational and cultural services.







Trademark Rule 2.51(a), 37 C.F.R. § 2.51(a) provides that, in an application under Section 1(a) of the Trademark Act, “the drawing of the mark must be a substantially exact representation of the mark as used on or in connection with the goods and/or services.” The regulation’s term “substantially” permits only inconsequential variation from the mark as it appears on the drawing. *In re Hacot-Colombier*, 105 F.3d 616, 620, 41 USPQ2d 1523, 1526 (Fed. Cir. 1997). Nonetheless, it is well settled that an applicant may apply to register any element of a composite mark if that element, as shown in the record, presents a separate and distinct commercial impression which indicates the source of applicant’s goods or services and distinguishes applicant’s goods or services from those of others. *See, e.g., In re*

Chemical Dynamics Inc., 839 F.2d 1569, 5 USPQ2d 1828 (Fed. Cir. 1988) (in considering whether a designation that appears with other matter is separately registrable, “It all boils down to a judgment as to whether that designation for which registration is sought comprises a separate and distinct ‘trademark’ in and of itself.”) (quoting *McCarthy*, Trademarks and Unfair Competition, citation omitted). Among the circumstances relied on in cases where a portion of a composite mark was found to create a separate commercial impression are the following:

(1) The two components include a corporate name or house mark along with another trademark or a descriptive term. *See In re Servel, Inc.*, 181 F.2d 192, 85 USPQ 257, 260 (CCPA 1950) (SERVEL functions as a mark apart from the descriptive term INKLINGS).

(2) The other component is a surname. *In re Emco, Inc.*, 158 USPQ 622, 623 (TTAB 1968) (“RESPONSER’ is registrable without addition of the surname ‘MEYER’”).

(3) The component is a non-descriptive element that is part of a phrase. *In re Barry Wright Corp.*, 155 USPQ 671, 672 (TTAB 1967) (“notation ‘8-48’ stands out as a distinguishable element separate and apart from the statement ‘ANOTHER 8-48 FROM MATHATRONICS’”).

(4) The other component is a part number. *In re Raychem Corp.*, 12 USPQ2d 1399, 1400 (TTAB 1989) (TINEL-LOCK registrable, although displayed with TRO6AI-TINEL-LOCK-RING on the specimen since TRO6AI is a part number and RING is the name of the goods).

We now turn to our analysis. To determine whether the drawing OLANA is a substantially exact representation of the mark as actually used on the specimens, we consider whether OLANA is a separate and distinct mark in and of itself or merely part of a larger mark. In other words, are “HALAU” and “HULA” essential and integral subject matter missing from the drawing? *Institut Nat’l Des Appellations D’Origine v. Vinters Int’l Co.*, 958 F.2d 1574, 22 USPQ2d 1190, 1197 (Fed. Cir. 1992) (determining “what exactly is the ‘trademark?’” “all boils down to a judgment as to whether the designation for which registration is sought comprises a separate and distinct ‘trademark’ in and of itself.”) (citation omitted).

In this case, OLANA does not appear by itself on the specimens, but is preceded by HALAU HULA or, HULA², with all of the words (except in one instance) shown in the same type size and font. On the jewelry specimens, the words are integrated together and appear connected; on the clothing specimen, which includes two displays of HALAU HULA OLANA, the words are in all capital block letters and are either consecutive, being next to each other, or are vertically stacked. In the instance where the words are vertically stacked, the word HULA is in a larger type size than HALAU and OLANA. Applicant argues that separation of the words on the clothing, and the capitalization of the letter “O” in OLANA on the jewelry provides OLANA with a distinct commercial impression. However, on the jewelry, the letter “H” in the words HALAU and HULA are also capitalized such that the terms are equally emphasized,

² The jewelry ring specimen does not show the complete band, but it appears that a word ending in “LA” (likely HULA) precedes the word OLANA on the band.

and although the words on the clothing are not physically connected, they are displayed as a single phrase in similar size and font.

As for the terms HALAU and HULA, they are not suggestive or descriptive of Applicants' goods. As Applicant points out, HULA is a Hawaiian term for a Hawaiian dance, while HALAU HULA is a Hawaiian term for "Hula School."³ The evidence shows that a common naming convention for hula schools is the use of HALAU HULA, with the addition of a term which identifies the kuma hula, who is the equivalent of a headmaster (in this case kuma hula Olana).⁴ Thus, prospective purchasers would view the terms here together as a reference to a particular hula school, as opposed to separating OLANA from the other terms. Applicant submits that there are "a hundred uses" of HALAU HULA and, as evidence, Applicant provided an entity and tradename search of HULA HALAU and HALAU HULA on hbehawaii.gov.⁵ However, we do not know the nature of the goods and services these entities provide, but in any event, these listings do not constitute technical service mark use or show suggestive or descriptive use in connection with the jewelry and clothing at issue. *Cf. Primrose Retirement Communities, LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030, 1036 (TTAB 2016) (evidence of third-party use in the

³ March 30, 2016 Office Action, Wikipedia ("Halau Hula"); pp. 7-9, September 30, 2016 Response to Office Action, Wikipedia ("Halau Hula") pp. 10-13. Page references to the application record refer to the PDF version of the Trademark Status and Document Retrieval System (TSDR).

⁴ *Id.* Some schools use the converse, HULA HALAU. *Id.*

⁵ 7 TTABVUE 3, September 30, 2016 Response to Office Action, pp. 14-18. Reference to the brief refers to the Board's TTABVUE docket system.

relevant context may show that a term “may have a normally understood and well-recognized descriptive or suggestive meaning”).

Applicant also argues that “OLANA is widely known as a unique, individual and family group ... and widely known and respected for Hawaiian dance,” and that “people want to relate to the respected OLANA by wearing clothing and jewelry” with the mark OLANA.⁶ However, Applicant has not provided any evidence showing OLANA is used alone or used in a manner in which consumers would identify OLANA separate and apart from the phrase HALAU HULA OLANA or HULA OLANA, and there is nothing in the record to suggest that customers and prospective purchasers of Applicant’s goods separate the phrase into component parts and utilize OLANA alone to call for and refer to the goods.

We conclude that in view of the omission of the words HALAU HULA or HULA in the drawing, it is not a substantially exact representation of the mark as actually used on jewelry and clothing.

Decision: The refusal to register Applicant’s mark OLANA is affirmed.

⁶ 7 TTABVUE 8-9.