

Wolfson

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

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: August 7, 2008

Opposition No. 91168038

THE GOLD CORPORATION

v.

HAWAII KINE INC.

**Before Seeherman, Rogers and Taylor,
Administrative Trademark Judges.**

By the Board:

This case now comes before the Board for consideration of opposer's motion for summary judgment on its pleaded claim that applicant's mark, HAWAII KINE,¹ is "primarily geographically descriptive and lacking in secondary meaning, and is thus unregistrable under Section 2(e)(2) of the Lanham Act, 15 U.S.C. § 1052(e)(2)." *Amended Notice Of Opposition*, para. 35. The motion has been fully briefed.

A motion for summary judgment is a pretrial device, intended to save the time and expense of a full trial when a party is able to demonstrate, prior to trial, that there is no genuine issue of material fact, and that it is entitled to judgment as a matter of law. See Fed. R. Civ. P. 56(c);

¹ Trademark application serial no. 78429184 for "beverages, namely, coffee," filed June 3, 2004 on the basis of applicant's bona fide intent to use the mark in commerce.

TBMP § 528.01 (2d ed. rev. 2004). To prevail on the motion, the moving party must establish that there is no genuine issue of material fact in dispute, thus leaving the case to be resolved as a matter of law. See *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986); *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); and *Sweats Fashions Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). The Board may not resolve issues of material fact, but can only ascertain whether genuine disputes exist regarding such issues. The Board views the evidence in a light most favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); *Opryland USA, supra*.

There is no question but that, since Hawaii is one of the fifty states of the United States, the primary meaning of HAWAII to the relevant (American) public is as a geographic term. Applicant argues that opposer has not met its burden to show that the relevant public associates Hawaii with coffee, but opposer has shown that applicant's coffee originates from Hawaii. *Exhibit E to Opposer's Motion For Summary Judgment*. Accordingly, were the mark HAWAII alone, it would be unregistrable as a primarily geographically descriptive mark. See the Trademark Manual

of Examining Procedure ("TMEP") § 1210.04 ("When the geographic significance of a term is its primary significance and the geographic place is neither obscure nor remote, for purposes of §2(e)(2) the goods/place or services/place association may ordinarily be presumed from the fact that the applicant's goods or services originate in the place named in the mark.").

Here, however, the burden is on opposer to show that the mark as a whole is primarily geographically descriptive, not merely that one component thereof has geographical significance. To meet this burden, opposer has presented evidence of the meaning of the word "kine." Opposer has submitted a declaration of its counsel, authenticating an entry from Wikipedia² entitled "Hawaiian Pidgin," another entry from Wikipedia entitled "Da kine," and copies of two pages from the book "Da Kine Talk"³ containing an entry for "kind, da kine vs. this kind of."

While opposer has not provided a reference to the word "kine" alone, the Wikipedia entry for "da kine" provides a description: "[Da Kine:] a word in Hawaiian Pidgin that usually functions grammatically as a placeholder name

² Wikipedia is an inter-active on-line encyclopedia. There are inherent problems regarding the reliability of Wikipedia entries because it is a collaborative website that permits anyone to edit the entries. We consider opposer's Wikipedia evidence with the recognition of the limitations inherent therein.

(compare to English "whatsit"), but can also take the role of a verb, adjective, or adverb. 'Da kine' may be related to the word 'kine', which is used variously as an intensifier, short for 'kind of' in the sense of 'type of', and for many other purposes (perhaps almost as much variety as 'da kine'). "Hawaiian Pidgin" is explained as follows: "While most linguists agree that Hawai'i[an] Pidgin is a full-fledged language with its own grammar, pronunciation, intonation, and domains of use, it is viewed by some to be 'substandard', or as a 'corrupted' form of English, or even as broken English."

The book "Da Kine Talk" adds: "kind, da kine vs. this kind of - Used in innumerable ways, this is one of the most popular of all terms in Hawaii's nonstandard speech. The following examples show some of its patterns: . . . *Suffix*: "I see the Oahu-kine surfboard and the over-here-kine" [on Kauai]."

Opposer contends, based on the above, that "kine" is an English word, meaning "kind or type" in Hawaiian pidgin English, and that applicant's mark, being comprised of a geographic term plus a "designation of a particular style or grade of product" is "thus merely descriptive." *Opposer's Memorandum in Support of Opposer's Motion for Summary Judgment*, page 6. Opposer cites TMEP § 1210.02(c)(ii) for

³ *Da Kine Talk, From Pidgin to Standard English in Hawaii*, by

the proposition that "the addition of a highly descriptive or generic term to the name of a geographic place does not alter its primary geographic significance." According to opposer, "kine" is such a term.

Applicant takes the position that "kine" is either a foreign word, requiring application of the doctrine of foreign equivalents, or an archaic term meaning "cow." Applicant has submitted a copy of an entry for "kine" from the American Heritage Dictionary of The English Language (4th ed.), which states: "noun: *Archaic* A plural of cow." As for "kine" being a foreign word, applicant argues that opposer has not carried its burden to show that a word in Hawaiian pidgin is not a foreign word. Finally, applicant contends that even if "kine" is an English word meaning "kind or type," only "those persons raised in Hawaii (a very small percentage of the U.S. population) who may possibly understand some Pidgin language words" would recognize the meaning of the term and they are not representative of the average American consumer of coffee.

In considering the evidence of usage submitted by the parties, and for purposes of deciding opposer's summary judgment motion, we start by noting the definition of "kine" suggested by opposer, that is, that "kine" means "kind or type" in the context of its usage in the mark HAWAII KINE.

Elizabeth Ball Carr, The University Press of Hawaii 1972.

We are not persuaded by applicant's argument that "kine" could take on the connotation of "nice" or "friendly" in the context of HAWAII KINE as a mark for coffee, because this is not a meaning ascribed to the term as a word in Hawaiian pidgin English.⁴ Nor is the fact that "kine" may have an archaic meaning relevant in this context.

However, opposer has not shown the absence of genuine issues of material fact on the question of whether "kine" is an English word meaning "kind or type" or a foreign term subject to the doctrine of foreign equivalents. Assuming "kine" to be an English word, opposer has not shown the absence of genuine issues of material fact as to its claim that "kine" is perceived as meaning "kind or type" and therefore is a mere style or grade designation such that, in the composite mark HAWAII KINE, the primary geographic significance of the word "Hawaii" has not been altered by the addition of the term "kine." On the other hand, if "kine" is taken as a foreign word, opposer has not shown the

⁴ Thus, the evidence presented by applicant of third-party marks that include the word "kind" are irrelevant. We are not concerned with connotations of the English word "kind" that do not carry over into Hawaiian pidgin. Further, we note that applicant has submitted copies of third-party marks that combine the word HAWAII with other non-English language (apparently Hawaiian) words, arguing that just as these combinations are distinctive, so should applicant's mark combining HAWAII with "kine" be considered distinctive. The argument is misplaced. It is axiomatic that the measure of distinctiveness of a mark is determined by the words or other elements used in the mark itself and not on the basis of elements found in other marks, even if such elements come from the same non-English language as the subject mark and may themselves be distinctive.

absence of genuine issues of material fact as to whether the relevant consumer would "stop and translate" the mark into "Hawaii type" or "Hawaii kind" and perceive this translation as a composite geographic term consisting of the geographic word HAWAII together with a product grade designation. See *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1696 (Fed. Cir. 2005).⁵

For these reasons, we find that opposer has not carried its burden to show the lack of any genuine issues of material fact on its pleaded claim under Section 2(e)(2) of the Trademark Act, and its motion for summary judgment is denied.⁶

Proceedings herein are resumed and trial dates, including the close of discovery, are reset as follows.

DISCOVERY PERIOD TO CLOSE:

October 1, 2008

30-day testimony period for party in
position of plaintiff to close:

December 30, 2008

⁵ The fact that we have identified only a few genuine issues of material fact as sufficient bases for denying the motion for summary judgment should not be construed as a finding that these are necessarily the only issues which remain for trial. At trial, opposer has the burden of introducing sufficient evidence to support all elements of its claim.

⁶ The parties should note that evidence submitted in connection with a motion for summary judgment is of record only for consideration of that motion. To be considered at final hearing, any such evidence must be properly introduced in evidence during the appropriate trial period. See *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993); *Pet Inc. v. Bassetti*, 219 USPQ 911 (TTAB 1983); *American Meat Institute v. Horace W. Longacre, Inc.*, 211 USPQ 712 (TTAB 1981).

30-day testimony period for party in
position of defendant to close:

February 28, 2009

15-day rebuttal testimony period for
plaintiff to close:

April 14, 2009

IN EACH INSTANCE, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within **thirty days** after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

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