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**THIS DISPOSITION  
IS NOT CITABLE AS PRECEDENT  
OF THE T.T.A.B.**

Paper No. 8  
EJS/rlg

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**  
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**Hasbro, Inc.**  
v.  
**Mattel, Inc.**  
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Opposition No. 116,736  
to application Serial No. 75/544,983  
filed on **August 13, 1998**  
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**Donald R. Steinberg, Barbara A. Barakat and Keum J. Park  
of Hale and Dorr LLP for Hasbro, Inc.**

**Laura Genao and Adrian M. Pruetz of Quinn, Emanuel,  
Urquhart, Oliver and Hedges, LLP for Mattel, Inc.**  
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Before **Seeherman, Quinn and Bottorff**, Administrative  
Trademark Judges.

Opinion by **Seeherman**, Administrative Trademark Judge:

Mattel, Inc. filed an application to register the  
mark HIDDEN CLUES for "board games and jigsaw puzzles."<sup>1</sup>

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<sup>1</sup> Application Serial No. 75/544,983, filed August 13, 1998, and  
asserting a bona fide intention to use the mark in commerce.

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Hasbro, Inc. filed an opposition to registration of the mark under Section 2(d) of the Trademark Act.

As grounds for opposition, opposer has alleged, inter alia, that it has used, through its predecessors-in-interest, the mark CLUE in connection with board games, jigsaw puzzles and related games since long prior to the filing date of applicant's intent-to-use application; that opposer is the owner of trademark registrations for various forms of the mark CLUE for such goods; that the mark CLUE has acquired fame; that the mark has been licensed for use on a variety of other goods, including a motion picture, books, T-shirts, sweatshirts, mugs, watches and ties; and that applicant's mark so resembles opposer's previously used and registered marks that, if used on applicant's goods, confusion is likely.

In its answer, applicant denied the salient allegations in the notice of opposition.<sup>2</sup>

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<sup>2</sup> Applicant also asserted five "affirmative defenses", two of which are merely further explanations of its denial of the allegation of likelihood of confusion, namely: that there is no likelihood of confusion between the marks; and that opposer's mark is weak because there are other registered compound marks including the word CLUE. The affirmative defenses are: that opposer has waived its right to contest and is estopped from contesting applicant's registration "due to its failure to oppose the application for registration of 'clue' as part of a compound mark for similar goods"; and that "[t]he Opposition is premature because Applicant has not yet developed the products

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The record includes the pleadings and the trial testimony depositions, with exhibits, taken by opposer of Holly Riehl, the Director of Global Marketing for opposer, and of Philip E. Orbanes, President of Winning Moves, Inc.<sup>3</sup>

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that will bear the mark." Applicant's Answer at 3. The Board notes that applicant has not properly made of record any evidence or argument in support of these affirmative defenses; therefore, the Board considers these defenses waived. The Board further notes that such are not valid defenses to an opposition proceeding. With respect to applicant's argument that the opposition is premature because it has not yet decided which products will bear the mark, applicant is directed to Trademark Rule 2.101(c), which, in fact, mandates that an opposition be filed within thirty days after publication of the application being opposed.

<sup>3</sup> The Board notes that the registrations pleaded in the notice of opposition and referred to in the testimony depositions are not properly of record. In order to make a party plaintiff's registrations properly of record, the party must either (1) submit timely status and title copies of such registrations with the notice of opposition, (2) submit timely status and title copies of such registrations with a notice of reliance during the testimony period, or (3) appropriately identify and introduce such registrations during the taking of testimony, that is, by introducing copies of the registrations as exhibits to testimony, made by a witness having knowledge of the current status and title of the registrations, establishing that the registrations are still subsisting and are owned by the offering party. Trademark Rule 2.122(d). See also TBMP Section 703.02(a). The copies of opposer's registrations submitted with opposer's notice of opposition are not status and title copies. Opposer's status and title copies submitted as exhibits to the deposition of Holly Riehl are not timely because they were certified on April 27, 1998. In order to be timely, the issuance date of status and title copies must be reasonably contemporaneous with the filing date of the complaint, or thereafter. TBMP Section 703.02(a). The 1998 status and title copies were not issued "reasonably contemporaneously" with the filing date of the notice of opposition, January 4, 2000. Nor is the testimony of Holly Riehl sufficient to make the registrations properly of record because she did not testify as to the current status of the registrations, i.e., that they are still subsisting. TBMP Section 703.02(a).

Applicant did not properly submit any evidence.<sup>4</sup>

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<sup>4</sup> Applicant, with its brief, filed excerpts taken from a website and a notice of reliance accompanied by its own responses to opposer's discovery requests. Opposer's objection to the admissibility of this evidence is sustained and the evidence will not be considered. Exhibits and other evidentiary materials attached to a party's brief on the case can be given no consideration unless they were properly made of record during the time for taking testimony. TBMP Section 705.02. Applicant's evidence was filed with its brief and not during its time for taking testimony. Moreover, even if timely submitted, these materials would not be acceptable. With respect to applicant's own responses to opposer's discovery requests, such responses are not admissible under Trademark Rule 2.120(j)(5); with respect to the excerpts taken from a website, see *Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368 (TTAB 1998). In any event, even if such evidence was of record, we would not come to a different result because the internet evidence does not show significant third-party use of the term CLUE and because applicant's discovery responses serve only to show that applicant is not using the mark.

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The parties have fully briefed the case, but an oral hearing was not requested.<sup>5</sup>

The testimony of Holly Riehl demonstrates that opposer, its predecessors and/or licensees have used the mark CLUE continuously in connection with board games since 1949; in connection with jigsaw puzzles since 1995; in connection with electronic games since "the 1980's"; and in connection with numerous other goods, including, books, figurines, mugs, t-shirts and watches, since 1995/1996. It was also used in connection with a movie which came out in 1985 and which aired again in 1998 or 1999, and in connection with a musical which debuted in 1996. The Riehl testimony also shows that with these goods opposer has used various forms of the mark CLUE, such as CLUE; CLUE JR.; CLUE JR. TRAVEL; CLUE LIMITED GIFT EDITION; CLUE FRANKLIN MINT EDITION; CLUE SIMPSONS EDITION; CLUE THE GREAT MUSEUM CAPER; THE CASE OF THE HIDDEN TOYS CLUE JR. GAME; CLUE FOR KIDS MYSTERY JIGSAW PUZZLE; CLUE MYSTERY PUZZLE; and CLUE MURDER AT BODDY MANSION.

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<sup>5</sup> The Board notes that opposer attached a Westlaw printout of a TTAB decision to its reply brief. This decision is not citable as precedent of the TTAB and has not been considered in making our determination.

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With respect to opposer's advertising and marketing of its goods, the Riehl testimony and exhibits show that opposer, over the last ten years, has spent between \$700,000 and \$1,000,000 per year promoting the CLUE board games through television, catalogs and brochures; that, in multiple game advertising for, inter alia, the game CLUE, opposer has engaged in, from 1998-2000, a "multi-million-dollar campaign"; that, in 1997 though 1999, opposer placed cross-sell brochures for CLUE in two to four million of its other games, namely, Monopoly, Deluxe Monopoly, Scrabble, Yahtzee and Boggle; that, in awareness studies carried out in the years 1992, 1997 and 2000, approximately 80% of the households within the United States were found to be aware of the CLUE mark; and that, in the 2000 awareness study, 24% of the households were found to own a CLUE game and 5% of all games purchased within a household were found to be CLUE games. The December 1997 issue of Games Magazine placed CLUE in its "Games Hall of Fame" and a 1998 issue of Parenting magazine gave "Hall of Fame honors" to the CLUE game.

With respect to sales, the Riehl testimony and exhibits show that between 1,000,000 and 1,500,000 CLUE board games have been sold nationally each year for the

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last ten years; that between 40,000 and 50,000 jigsaw puzzles have been sold nationally each year since 1995 (200,000 each year from 1995 through 1997); that approximately 75,000 electronic games have been sold nationally each year since their introduction; and that, since 1995, the annual retail sales of licensed CLUE products has been \$1,000,000 per year. The Riehl testimony also establishes that board games, electronic games and puzzles, and specifically opposer's CLUE games and puzzles, are generally played by children and families, and purchased by mothers through a variety of retail means, including in toy stores and by mail order. The basic CLUE board game typically sells for \$15.99, the CLUE JR. board game typically sells for \$9.99, the CLUE puzzles typically sell for between \$4.99 and \$9.99; and the CLUE electronic games typically sell for between \$19.99 and \$29.99.

Opposer's CLUE board games and puzzles are sold nationally in toy stores such as Toys R Us, mass merchandisers such as Wal-Mart, specialty stores such as FAO Schwartz, general department stores such as Lord and Taylor, and through the internet.

Philip E. Orbanes, president of Winning Moves, Inc., testified that his company manufactures the deluxe board

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game, CLUE LIMITED GIFT EDITION, and that his company obtained a license for "Clue because of its longevity and its very distinct image and reputation." Mr. Orbanes also testified that his company has spent approximately \$40,000 in advertising the CLUE LIMITED GIFT EDITION.

Both Ms. Riehl and Mr. Orbanes testified that they are unaware of any unrelated games using the term CLUE in their title.

The evidence shows that opposer has priority. Although opposer's registrations are not properly of record, see supra at fn. 3, opposer has shown through the testimony deposition of Holly Riehl that it has used its marks in connection with board games since 1949 and in connection with jigsaw puzzles since 1995. Because we find that CLUE is an inherently distinctive mark for these goods, opposer established trademark rights in CLUE with its earliest uses of the mark. These dates are prior to the August 13, 1998 filing date of applicant's intent-to-use application, which is its constructive use date, and the earliest date on which applicant is entitled to rely. As applicant repeatedly stresses, applicant has not yet begun to use the HIDDEN CLUES mark.

Turning to the issue of likelihood of confusion, in making such a determination we must consider all relevant

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factors as set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Although we have considered all factors, we will concentrate our discussion on the factors most relevant to this case.

The fame of opposer's CLUE mark is a key factor in our decision. We find that opposer has proven by sales and advertising figures, as well as proof of recognition of its mark by 80% of U.S. households, the fame of its CLUE mark, as used in connection with board games. To the extent that applicant contends that a mark must be fanciful or arbitrary in order to be famous, applicant's argument is not supported by the relevant case law. The law in fact is contrary to applicant's position; there is no requirement that a mark be arbitrary or fanciful in order to be famous. See e.g. *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 223 USPQ 1281 (CA FC 1984) (finding that the mark SPICE ISLANDS, registered on the Principal Register under Trademark Act Section 2(f), was famous).

The cases on which applicant relies in support of its position that CLUE is not a famous mark are not persuasive. In *Hasbro v. Clue Computing, Inc.*, 66 F.Supp.2d 117, 52 USPQ2d 1402 (D. Mass. 1999), aff'd 56 USPQ2d 1766 (1<sup>st</sup> Cir. 2000), the court discussed fame only

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in relation to trademark dilution under the Federal Trademark Dilution Act. The test for fame under the FTDA is different from the test for the *du Pont* factor of fame. *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164 (TTAB 2001). Therefore, *Hasbro* is not applicable to this proceeding.

In *Colgate-Palmolive Company v. Carter-Wallace, Inc.*, 432 F.2d 1400, 167 USPQ 529 (CCPA 1970), the court stressed that "[t]here is nothing of record to indicate the slightest transformation of the word "peak" into a strong or highly distinctive mark by reason of advertisement, volume of sales or market place acceptance and public recognition." *Id.* at 530. The *Colgate-Palmolive* court's finding was, therefore, based in part upon its finding that there was no evidence of fame in the record.

*Nabisco Brands, Inc. et al. v. The Quaker Oats Company*, 547 F. Supp. 692, 216 USPQ 770, 776 (DC NJ 1982), involved a motion for temporary injunctive relief, and is distinguishable on its facts. Suffice it to say that, contrary to *Nabisco*, the evidence in this proceeding demonstrates that CLUE is a strong mark which has achieved a substantial degree of recognition.

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Famous marks are afforded a greater degree of trademark protection under the Lanham Act than non-famous marks. See e.g. *Kenner Parker Toys Inc. v. Rose Art Industries Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992), cert. denied, 506 US 862 (1992), finding that “[f]amous or strong marks enjoy a wide latitude of legal protection... [t]hus, a mark with extensive public recognition and renown deserves and receives more legal protection than an obscure or weak mark” and *Recot Inc. v. M.C. Becton*, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000), emphasizing that “[w]hen an opposer's trademark is a strong, famous mark, it can never be ‘of little consequence.’ The fame of a trademark may affect the likelihood purchasers will be confused inasmuch as less care may be taken in purchasing a product under a famous name.”

With respect to a comparison of the goods of the parties, opposer uses its mark in connection with, inter alia, board games and jigsaw puzzles. In its application, applicant has identified its goods as “board games and jigsaw puzzles”. Applicant argues at length that, because applicant “has not yet determined the goods for which the mark will be used”, the goods cannot be shown to be identical. See Applicant’s Brief at 7.

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Applicant's position is contrary to law. The law is clear that the registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application. See e.g. *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 1 USPQ2d 1813 (Fed. Cir. 1987). Because applicant's identification has no limitation on the type or nature of its board games and puzzles, they would encompass the board games and puzzles opposer sells under the mark CLUE. Accordingly, we find that the parties' goods are legally identical. Further, because the goods are legally identical, the channels of trade and potential purchasers are legally identical.

We now compare the similarity between the marks CLUE and HIDDEN CLUES, giving appropriate weight to our finding that the mark CLUE has acquired fame. See *Kenner Parker Toys Inc. v. Rose Art Industries Inc.*, supra, at 1456, in which the court stated that the "Lanham Act's tolerance for similarity between competing marks varies inversely with the fame of the prior mark." We also take into consideration that "when marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate Corp. v.*

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*Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992), cert. denied, 506 US 1034 (1992).

Applicant argues that the marks, when viewed as a whole, are not confusingly similar. Opposer argues that the dominant feature of applicant's mark is essentially identical to opposer's mark, and that, therefore, the commercial impression of the marks is highly similar.

Applicant's mark is the plural form of opposer's mark CLUE, with the addition of the term HIDDEN. As applicant correctly argues, when assessing the similarity between the marks, the marks must be considered in their entireties. However, it is also well established that it is permissible, when comparing marks, to accord more weight to particular features of the marks, as long as the marks are still considered as a whole. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). While there are certain differences in the appearance and pronunciation of the marks CLUE and HIDDEN CLUES, due primarily to the additional term HIDDEN in applicant's mark, the overall commercial impression of the marks is highly similar. The dominant feature of applicant's mark is CLUES, which is the plural form of opposer's famous mark. The term HIDDEN merely modifies CLUES and does not take away from the look, sound or

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meaning of this word. The connotation of the marks, that the board games and jigsaw puzzles feature discoverable clues, is also highly similar. This connotation is bolstered by the evidence of record which shows that opposer's jigsaw puzzles are marketed with the statement "[d]iscover the hidden clues" and that opposer's board games have titles such as "THE CASE OF THE HIDDEN TOYS CLUE JR. GAME" and many of the games include box packaging statements relating to clues or items which are hidden. Opposer has also introduced evidence of its use of the mark CLUE as part of numerous other compound word marks in connection with board games and jigsaw puzzles.

With respect to the number and nature of similar marks in use on similar goods, opposer has introduced the testimony of two deponents who state that they are unaware of any unrelated third-party use of the term CLUE in titles for games. Applicant has not properly introduced any evidence to the contrary.

Because of the similarity of the marks, if they are used on identical goods consumers are likely to believe that HIDDEN CLUES is a variant of opposer's famous CLUE mark, used to identify another version of opposer's CLUE game.

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Turning now to the *du Pont* factor of the conditions under which and buyers to whom sales are made, the testimony establishes that the purchase price of the CLUE board games and jigsaw puzzles ranges from \$4.99 to \$15.99, and that those are typical purchase prices for such games. Moreover, the games and puzzles are purchased by the general public, often by mothers for their children. Because the price of these goods is relatively low, we find that the games are likely purchased on impulse rather than after careful deliberation.

Applicant has argued that opposer has failed to establish "actual confusion" between the marks. However, the lack of such evidence is not meaningful in this case because applicant has not yet begun to use its mark, and therefore we would not expect to find evidence of actual confusion. See e.g. *Gillette Canada, Inc. v. Ranir Corp.*, 23 USPQ2d 1768 (TTAB 1992).

Accordingly, we find that all of the *du Pont* factors on which there is any evidence favor opposer, with the exception of evidence of actual confusion, which is neutral, and that opposer has met its burden of proving likelihood of confusion.

Decision: The opposition is sustained.