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CEW

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Mattel, Inc.
v.
Leonard Stitz

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Opposition No. 91117536
to Application No. 75773292
filed on August 10, 1999

Jill M. Pietrini and Andrew Klungness of Manatt, Phelps &
Phillips for Mattel, Inc.

Leonard Stitz, Pro Se.

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Before Quinn, Walters and Bottorff, Administrative Trademark
Judges.

Opinion by Walters, Administrative Trademark Judge:

Mattel, Inc. filed its opposition to the application of
Leonard Stitz to register the mark COOLWHEELS.COM for
"computerized on-line retail services in the field of
automobile accessories," in International Class 35.¹

¹ Application Serial No. 75773292, filed August 10, 1999, based upon use
of the mark in commerce, alleging dates of first use and first use in
commerce as of December 1, 1998.

As grounds for opposition, opposer asserts that applicant's mark, when applied to applicant's services, so resembles opposer's previously used and registered HOT WHEELS marks and family of HOT marks, listed below, for toy vehicles and other associated goods and services, as to be likely to cause confusion, under Section 2(d) of the Trademark Act.²

Applicant, in its answer, denied the salient allegations of the claim.³

The Record

The record consists of the pleadings; the file of the involved application; certified status and title copies of opposer's asserted registrations and application files; and excerpts from publications, all properly made of record by opposer's notices of reliance.⁴ Opposer did not take testimony. Applicant did not submit evidence or take testimony. Both parties filed briefs on the case but a hearing was not requested.

² Opposer also alleged ownership of a pending application for the mark COOL WHEELS (Serial No. 75526562). However, the records of the USPTO show that this application has been abandoned. Therefore, the application has not been considered.

³ Applicant asserted affirmative defenses pertaining to opposer's then-pending application to register COOL WHEELS. In view of the abandonment thereof, such defenses have not been considered. Applicant's references to an interference as the proper method for resolution of the issues herein are incorrect and inapposite and have not been considered further.

⁴ Applicant's objections to the admissibility of this evidence are not well taken and are overruled.

Factual Findings

Opposer established its ownership and the status of the following pleaded registrations⁵:

<p>2,124,334 Registered 12/23/97</p>	<p>HOT WHEELS COLLECTIBLES</p>	<p>"Toy vehicles" Disclaimer of COLLECTIBLES</p>
<p>2,310,162 Registered 1/25/00</p>	<p>HOT WHEELS</p>	<p>"On-line retail stores services featuring toys," and "entertainment, educational and information services, namely, providing data and information concerning collectible toy vehicles, professional automobile racing cars, professional automobile races, and standard, custom and classic automobiles, providing general interest stories directed toward toy vehicle collectors and enthusiasts, and providing multi-user interactive computer games, all of which are provided via a global computer network"</p>

⁵ Several registrations alleged in the notice of opposition, and for which status and title copies were submitted, have since been cancelled. These cancelled registrations are of no evidentiary value and have not been listed or considered.

<p>884,563</p> <p>Registered 1/20/70; Renewed; §§8 & 15</p>		<p>"Toy miniature automobiles and accessories therefor"</p>
<p>2,112,667</p> <p>Registered 11/11/97</p>	<p>HO! HO! HOT ROD</p>	<p>"Toy vehicle and accessories"</p> <p>Disclaimer of HOT ROD</p>
<p>1,961,774</p> <p>Registered 3/12/96; §§8&15</p>		<p>"Clothing, namely tee shirts"</p>
<p>2,186,501</p> <p>Registered 9/1/98</p>	<p>HOT WHEELS CRAZY CLASSICS</p>	<p>"Toy vehicles"</p> <p>Disclaimer of CLASSICS</p>
<p>2,182,667</p> <p>Registered 8/18/98</p>	<p>HOT WHEELS CUSTOM RODS</p>	<p>"Toy vehicles and accessories therefor"</p>
<p>1,906,461</p> <p>Registered 7/18/95; §§8&15</p>	<p>HOT WHEELS</p>	<p>"Watches and clocks"</p>
<p>2,152,705</p> <p>Registered 4/21/98</p>	<p>HOT WHEELS</p>	<p>"Prerecorded computer storytelling software, audio and video cassettes featuring games and storytelling, musical sound recordings featuring games and storytelling, audio sound recordings featuring games and storytelling and video sound recordings featuring games and storytelling,</p>

		<p>screensaver programs, CD-ROM featuring directories of toy vehicles, all for informational, educational and entertainment uses; and merchandising kiosks for use with computer software, audio sound and video sound recordings, and the like for informational, educational and entertainment uses," "coin-operated arcade games, prerecorded computer game cartridges, cassettes, cards, discs and programs for informational, educational and entertainment uses; electronic hand-held games; computer game joysticks, adapters, connectors and controllers for use with prerecorded computer software, audio and video cassettes, CD-ROM, game cartridges, game cassettes, game cards and game discs, all for informational, educational and entertainment uses," and "providing access to interactive computer on-line services featuring games, stories and directories for toys, games and sporting goods"</p>
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<p>2,309,697 Registered 1/18/00</p>		<p>"Toy vehicles and accessories therefor" Disclaimer of "30 YEARS" and "1968-1998" "The lining is a feature of the mark and does not indicate color. The lining is for shading purposes only and does not indicate color."</p>
<p>2,259,568 Registered 7/6/99</p>	<p>HOT WHEELS ... LEADING THE WAY!</p>	<p>"Toy vehicles and accessories therefor"</p>
<p>2,131,224 Registered 1/20/98</p>	<p>HOT DRIVIN'</p>	<p>"Toy vehicles"</p>
<p>2,242,325 Registered 5/4/99</p>	<p>HOT RODS</p>	<p>"Activity toys, namely, snap together construction toys"</p>
<p>907,266 Registered 2/2/71; Renewed; §§8&15</p>	<p>HOT WHEELS</p>	<p>"candy"</p>
<p>2,164,633 Registered 6/9/98</p>	<p>HOT WHEELS</p>	<p>"Flying discs"</p>
<p>2,152,706 Registered 4/21/98</p>		<p>"Prerecorded computer storytelling software, audio and video cassettes featuring games and storytelling, musical</p>

		<p>sound recordings featuring games and storytelling, audio sound recordings featuring games and storytelling and video sound recordings featuring games and storytelling, screensaver programs, CD-ROM featuring directories of toy vehicles, all for informational, educational and entertainment uses; and merchandising kiosks for use with computer software, audio sound and video sound recordings, and the like for informational, educational and entertainment uses," "coin-operated arcade games, prerecorded computer game cartridges, cassettes, cards, discs and programs for informational, educational and entertainment uses; electronic hand-held games; computer game joysticks, adapters, connectors and controllers for use with prerecorded computer software, audio and video cassettes, CD-ROM, game cartridges, game cassettes, game cards and game discs, all for informational, educational and entertainment uses,"</p>
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		and "providing access to interactive computer on-line services featuring games, stories and directories for toys, games and sporting goods"
2,019,877 Registered 11/26/96; §§8&15	HOLIDAY HOT WHEELS	"Toy vehicles"
2,084,614 Registered 7/29/97	HOT WHEELS WORLD	"Toy vehicles"
1,810,905 Registered 12/14/93; Renewed; §§8&15		"Toy vehicles and raceset; namely, launcher, tracks, building structures, and accessories therefore"
2,105,646 Registered 10/14/97; §§8&15	HOT WHEELS	"Clothing, namely jackets, coats, vests, sweatshirts, shirts, T-shirts, pants, belts, suspenders, ties, scarves, mittens, gloves and undergarments such as boxer shorts; footwear; and headwear"
2,287,008 Registered 10/19/99	HOT SEAT	"Toy vehicles and accessories therefor"
2,205,918 Registered 11/24/98	HOT WHEELS	"Plastic dinnerware, and acrylic tumblers"

Opposer also established that it filed 18 applications for various HOT WHEELS and HOT marks for a variety of goods and services.⁶ Opposer's statements in its brief (pp. 2, 5-6) that these applications establish its "ownership, priority of use, show the goods offered by [opposer], and provide presumptions of validity and ownership" or that these applications establish opposer's "intent to expand into products used for 'real' vehicles" are incorrect. Opposer's status and title copies of its applications establish only that the applications were filed at the USPTO.

Opposer submitted by notice of reliance twenty-one excerpts from various publications dated between 2000 and 2002 and retrieved from the LEXIS/NEXIS database. Each article contains references to opposer's mark HOT WHEELS in connection with toy vehicles and several other products. Several excerpts discuss nostalgia among adults for HOT WHEELS toy vehicles; several excerpts discuss other products for which the HOT WHEELS mark is licensed; and several excerpts characterize opposer's HOT WHEELS toy car as a top seller in the industry. In its brief, opposer stated that this evidence "demonstrates strength of HOT WHEELS,"

⁶ In its brief, opposer asserted that one of its applications has matured to registration. However, opposer did not submit a status and title copy of the registration or seek to amend its notice of opposition to add this registration to its claim. Nor is there any indication that applicant consents to its inclusion in the record. Therefore, any such

"establishes continuous use of HOT WHEELS," "shows [opposer's] channels of trade and sales," "shows [opposer's] brand extension through licensing," and "shows [opposer's] relationship with automobiles." However, these excerpts from publications indicate, at most, that the authors of the articles and the public reading the articles were exposed to the information contained in the excerpts. The articles constitute hearsay as to the truth of the statements contained therein and, thus, while this evidence has been considered as part of the record, it has not been considered for the truth of such statements.⁷

Analysis

Inasmuch as certified status and title copies of opposer's registrations are of record, there is no issue with respect to opposer's priority. *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Our determination of likelihood of confusion under Section 2(d) must be based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA

additional registration is not part of the record and has not been considered.

⁷ Applicant's objection to opposer's publications evidence as hearsay is granted to the extent noted, but otherwise applicant's objections are denied because, as noted *supra*, the objections are without merit.

1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [and services] and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

Opposer contends that its HOT WHEELS marks are famous and asks the Board to take judicial notice thereof. Opposer also contends that it owns a family of HOT or HOT WHEELS marks; and that the parties' marks are similar in sound, appearance and meaning. Opposer argues that the ".COM" portion of applicant's mark is merely a top level Internet domain name and, as such, is of no source-indicating significance; that both marks consist of a word denoting temperature followed by the same word "WHEELS"; that the terms "HOT" and "COOL" have opposite literal meanings, but are associative terms; and that the slang meanings of the two terms "HOT" and "COOL" are similar. With its brief, opposer submitted dictionary definitions⁸ of "cool" as,

⁸ *The American Heritage Dictionary of the English Language*, 4th ed., 2000.

inter alia, "Slang. a. Excellent; first-rate. b. Acceptable; satisfactory," and of "hot" as, *inter alia*, "Slang. Very good or impressive."

Opposer also contends that the parties' goods and services are related or overlapping; that applicant's services are within opposer's "demonstrated zone of natural expansion"; and that the trade channels are overlapping.

Applicant's contentions are inapposite or, at best, obtuse. However, it is clear that applicant contends that opposer has not proven facts sufficient to establish its case.

The first *du Pont* factor we consider is the fame of opposer's marks. Opposer submitted absolutely no evidence establishing the fame of its marks. The publications submitted by opposer do demonstrate, as opposer argues, that "the HOT WHEELS marks have generated significant unsolicited publicity in major newspapers and trade publications."

(Reply Brief, p. 7.) However, although evidence of widespread unsolicited publicity may lend "confirmatory context" to competent evidence of fame such as sales and advertising numbers, see *Bose Corp. v QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1309 (Fed. Cir. 2002), no such competent evidence of fame has been presented by opposer in this case. As noted above, the statements contained in the articles are hearsay, and the articles

therefore are not evidence of the truth of the matters asserted in the statements. Moreover, we decline to take judicial notice of the asserted fame of opposer's marks because opposer has failed to demonstrate that such fame is a matter of which judicial notice might properly be taken. See Fed. R. Evid. 201(b). The case before us is distinguishable from the cited case of *B.V.D. Licensing Corp. v. Body Action Design, Inc.*, 846 F.2d 727, 6 USPQ2d 1719 (Fed. Cir. 1988), wherein plaintiff had submitted several dictionary excerpts showing entries and definitions for "BVD" therein and it is well established that the Board and Court may take judicial notice of entries in dictionaries.

With respect to the goods and services of the parties, we note that the majority of opposer's registrations are for HOT WHEELS and various other HOT marks for toys. There is nothing in the record to warrant a conclusion that there is any relationship between applicant's "computerized on-line retail services in the field of automobile accessories," and toys, even toy automobiles, or that purchasers would believe that such goods and services, if identified by confusingly similar marks, come from the same source. We also find that opposer has not established that purchasers would believe that applicant's services and the other goods and services enumerated in opposer's many registrations would, if

identified by confusingly similar marks, come from the same source. Opposer's Registration No. 2,310,162 for the mark HOT WHEELS for, *inter alia*, "entertainment, educational and information services, namely, providing data and information concerning collectible toy vehicles, professional automobile racing cars, professional automobile races, and standard, custom and classic automobiles, providing general interest stories directed toward toy vehicle collectors and enthusiasts, and providing multi-user interactive computer games, all of which are provided via a global computer network" pertains to various types of non-toy automobiles, and the services are rendered via the Internet. However, there is no evidence in the record that would lead us to conclude that, if identified by confusingly similar marks, purchasers would believe that these services and applicant's retail services selling automobile accessories come from the same or a related source.

Thus, we conclude that opposer has not established that the goods and services of the parties are sufficiently related that confusion would be likely if identified by confusingly similar marks.

We next consider the similarity of the involved marks. We conclude, first, that opposer has not established its pleaded and argued contention that it has a family of HOT or HOT WHEELS marks. Merely submitting multiple registrations

owned by opposer for marks including the term "HOT" or "HOT WHEELS" does not establish a family of marks. Our primary reviewing court, in *J & J Snack Foods Corp. v. McDonalds' Corp.*, 932 F.2d 1460, 1463 18 USPQ2d 1889 (Fed.Cir. 1991), stated the following about establishing a family of marks:

A family of marks is a group of marks having a recognizable common characteristic, wherein the marks are composed and used in such a way that the public associates not only the individual marks, but the common characteristic of the family, with the trademark owner. Simply using a series of similar marks does not of itself establish the existence of a family. There must be a recognition among the purchasing public that the common characteristic is indicative of a common origin of the goods. (*Citations omitted.*)

Recognition of the family is achieved when the pattern of usage of the common element is sufficient to be indicative of the origin of the family. It is thus necessary to consider the use, advertisement, and distinctiveness of the marks, including assessment of the contribution of the common feature to the recognition of the marks as of common origin.

See also, Land-O-Nod Co. v. Paulison, 220 USPQ 61, 65-66 (TTAB 1983). Opposer has submitted no evidence in this regard.

With respect to the marks, we note that while we must base our determination on a comparison of the marks in their entireties, we are guided, equally, by the well established principle that, in articulating reasons for reaching a conclusion on the issue of confusion, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark,

provided the ultimate conclusion rests on consideration of the marks in their entireties." *In re National Data Corp.*, 732 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

A number of opposer's marks include the term HOT with other wording (not WHEELS). We find no basis for concluding that there is any similarity between these marks and applicant's mark. Regarding opposer's HOT WHEELS marks, we agree with opposer that both parties' mark include a temperature designation as an adjective to the identical work WHEELS. However, WHEELS is a highly suggestive, if not descriptive, term in connection with automobiles, toy or otherwise, and, it is preceded in each mark by words that are quite different. It is clear from the dictionary definitions of which we have taken judicial notice that HOT and COOL have numerous informal and slang meanings and that one meaning of each is, as indicated *supra*, similar. However, this similarity in slang meanings, to the extent that purchasers perceive it, is outweighed by the differences in sight and sound between the marks. Moreover, the record contains no evidence that purchasers would ascribe anything other than their common, rather than slang or informal, meanings to these terms. Thus, when considered in their entireties, we find that opposer has not established that applicant's mark COOLWHEELS.COM is confusingly similar to its marks.

In conclusion, we find that the cumulative differences in the marks and the goods and services compel us to conclude that opposer has not established, on this record that there is a likelihood of confusion between applicant's mark, COOLWHEELS.COM, and registrant's various HOT and HOT WHEELS marks for the respectively identified goods and services.

Decision: The opposition is dismissed.