

TTAB

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

WHAM-O, INC., )  
)  
Petitioner, )  
)  
v. )  
)  
COLECO INDUSTRIES, INC., )  
)  
Registrant. )  
\_\_\_\_\_ )

31,943

Cancellation No. \_\_\_\_\_

03 JUN -6 AM 9:03

Assistant Commissioner for Trademarks  
Box TTAB  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

05-12-2003  
U.S. Patent & TMO/TM Mail Rpt Dt. #11

Sir:

**PETITION FOR CANCELLATION OF REG. NO. 796,701**

In the matter of trademark Reg. No. 796,701 for SNO-JET for snow vehicles—namely, sleds, toboggans, coasters and skis, registered on September 28, 1965 to Coleco Industries, Inc. of 266 Pearl St., Hartford, Connecticut (registrant), Wham-O, Inc., a Delaware corporation located and doing business at 5903 Christie Avenue, Emeryville, California 94608, believes it will be damaged by Reg. No. 796,701, and hereby petitions for cancellation thereof.

The grounds for the cancellation are as follows:

1. On March 23, 2001, Wham-O filed trademark application Serial No. 78/054,809 for the mark SNOW JET for snow recreational devices and accessories, namely,

06/05/2003 KGIBBONS 00000148 796701

01 FC:6401

300.00 DP

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inflatable snow saucers, sleds, and toboggans. A copy of Wham-O's application is attached as Exhibit 1.

2. By Office action dated November 7, 2002, Trademark Examining Attorney John M. Gartner refused registration of Wham-O's application on the ground that Wham-O's mark SNOW JET, as applied to snow recreational devices and accessories, namely, inflatable snow saucers, sleds, and toboggans, so resembles the mark SNO-JET, which is the subject of Reg. No. 796,701, as to be likely to cause confusion, or to cause mistake, or to deceive. A copy of the Office action is attached as Exhibit 2, and a copy of Reg. No. 796,701 is attached as Exhibit 3.

3. To the best of Wham-O's knowledge, registrant is listed in the records of the PTO as the current owner of Reg. No. 796,701.

4. On information and belief, Wham-O alleges that registrant has not used the mark SNO-JET for at least three consecutive years prior to the filing of this Petition for Cancellation, and registrant has, therefore, abandoned the mark.

5. The continued existence of Reg. No. 796,701 is inconsistent with the right Wham-O possesses in its mark SNOW JET for snow recreational devices and accessories, namely, inflatable snow saucers, sleds, and toboggans, and therefore, Wham-O is damaged by the continued presence of Reg. No. 796,701 with the presumptions afforded registrant under the Lanham Act Section 7(b).

6. Wham-O will be damaged by the continued registration of Reg. No. 796,701 because the registration prevents publication and registration of Wham-O's mark SNOW JET.

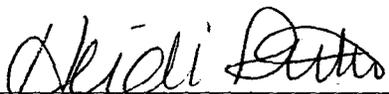
WHEREFORE, Wham-O prays that Reg. No. 796,701 be canceled, and that the Board grant such other relief as it deems applicable.

A duplicate copy of this Petition and the petition fee of \$300.00 are enclosed herewith. Please charge our Deposit Account No. 11-1540 for any additional fees which may be required.

DATED this 6<sup>th</sup> day of May, 2003.

CERTIFICATE OF MAILING

I hereby certify that this Petition for Cancellation and accompanying exhibits 1-3 are being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Trademarks, Box TTAB, 2900 Crystal Drive, Arlington, Virginia 22202-3513 on May 6, 2003.

  
\_\_\_\_\_  
Heidi Dutro

Respectfully submitted,

KOLISCH HARTWELL, P.C.



\_\_\_\_\_  
John M. McCormack  
Registration No. 26,948  
of Attorneys for Petitioner  
520 S.W. Yamhill Street, Suite 200  
Portland, Oregon 97204  
Telephone: (503) 224-6655  
Facsimile: (503) 295-6679

PTO Form 1478 (Rev. 9/98)  
 OMB Control #0651-0009 (Exp. 08/31/2001)

**\*Trademark/Service Mark Application\***

**\* To the Commissioner for Trademarks \***

<DOCUMENT INFORMATION>  
 <TRADEMARK/SERVICEMARK APPLICATION>  
 <VERSION 1.22>

<APPLICANT INFORMATION>  
 <NAME> Wham-O, Inc.  
 <STREET> 182 Second Street, 3rd Floor  
 <CITY> San Francisco  
 <STATE> CA  
 <COUNTRY> USA  
 <ZIP/POSTAL CODE> 94105  
 <TELEPHONE NUMBER> 415-357-4200

<APPLICANT ENTITY INFORMATION>  
 <CORPORATION: STATE/COUNTRY OF INCORPORATION> Delaware

<TRADEMARK/SERVICEMARK INFORMATION>  
 <MARK> SNOW JET  
 <TYPED FORM> Yes

~ Applicant requests registration of the above-identified trademark/service mark in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq., as amended). ~

<BASIS FOR FILING AND GOODS/SERVICES INFORMATION>  
 <INTENT TO USE: SECTION 1(b)> Yes  
 ~ Applicant has a bona fide intention to use or use through a related company the mark in commerce on or in connection with the below-identified goods/services. (15 U.S.C. Section 1051 (b), as amended.) ~

<INTERNATIONAL CLASS NUMBER> 028  
 <LISTING OF GOODS AND/OR SERVICES> snow recreational devices and accessories

<ATTORNEY INFORMATION>  
 <NAME> Owen W. Dukelow  
 <STREET> 200 Pacific Building,  
 <CITY> Portland  
 <STATE> OR  
 <COUNTRY> USA  
 <ZIP/POSTAL CODE> 97204  
 <E-MAIL ADDRESS> owen@khdmh.com  
 <FIRM NAME> Kolisch Hartwell Dickinson McCormack & Heuser  
 <TELEPHONE NUMBER> 503-224-6655  
 <FAX NUMBER> 503-295-6679  
 <ATTORNEY DOCKET NUMBER> WMO 810  
 <OTHER APPOINTED ATTORNEY(S)> J. Pierre Kolisch, Reg. No. 15,802; Jon M. Dickinson, Reg. No.

Exhibit 1

22,820; John M. McCormack, Reg. No. 26,948; Peter E. Heuser, Reg. No. 27,902; David P. Cooper, Reg. No. 33,372; David A. Fanning, Reg. No. 33,233; Pierre C. Van Rysselberghe, Reg. No. 33,557; Walter W. Karnstein, Reg. No. 35,565; Charles H. DeVoe, Reg. No. 37,305; Stephen F. Gass, Reg. No. 38,462; David S. D'Ascenzo, Reg. No. 39,952; Owen W. Dukelow, Reg. No. 41,002; James R. Abney, Reg. No. 42,253; Mark D. Alleman, Reg. No. 42,257; Michael M. Hall, Reg. No. 43,653; and Christopher S. Tuttle, Reg. No. 41,357; Barbara Anna McCoy Reg. No. 46,077 and Ellen M. Gonzales, Reg. No. 44,128

**<FEE INFORMATION>**

<TOTAL FEES PAID> 325

<NUMBER OF CLASSES PAID> 1

<NUMBER OF CLASSES> 1

**<LAW OFFICE INFORMATION>**

<E-MAIL ADDRESS FOR CORRESPONDENCE> N/A

**<SIGNATURE AND OTHER INFORMATION>**

**~ PTO-Application Declaration:** The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true. ~

<SIGNATURE> /owen dukelow/

<DATE> 03/23/2001

<NAME> Owen W. Dukelow

<TITLE> Attorney

The information collected on this form allows the PTO to determine whether a mark may be registered on the Principal or Supplemental register, and provides notice of an applicant's claim of ownership of the mark. Responses to the request for information are required to obtain the benefit of a registration on the Principal or Supplemental register. 15 U.S.C. §§1051 et seq. and 37 C.F.R. Part 2. All information collected will be made public. Gathering and providing the information will require an estimated 12 or 18 minutes (depending if the application is based on an intent to use the mark in commerce, use of the mark in commerce, or a foreign application or registration). Please direct comments on the time needed to complete this form, and/or suggestions for reducing this burden to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, Washington D.C. 20231. Please note that the PTO may not conduct or sponsor a collection of information using a form that does not display a valid OMB control number.

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/054809

APPLICANT: Wham-O, Inc.

CORRESPONDENT ADDRESS:

Owen W. Dukelow  
Kolisch Hartwell Dickinson McCormack & H  
200 Pacific Building,  
520 S.W. Yamhill Street  
Portland OR 97204

JMM  
WMO 810

RETURN ADDRESS:

Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3513  
ecom102@uspto.gov

NOV - 7 10

MARK: SNOW JET

CORRESPONDENT'S REFERENCE/DOCKET NO: WMO 810

CORRESPONDENT EMAIL ADDRESS:

N/A

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.

OFFICE ACTION

*Final & To Appeal Due - May 7, 2003.*  
TO AVOID ABANDONMENT, WE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF OUR MAILING OR E-MAILING DATE.

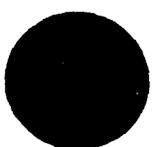
RE: Serial Number 78/054809

This final Office action responds to applicant's communication filed January 17, 2002.

STATUS

In a first Office action dated July 12, 2001, the examining attorney refused registration of the mark SNOW JET under Trademark Act Section 2(d) because the mark, when used in connection with the identified goods, so resembles the mark shown in U.S. Registration No. 079701 as to be likely to cause confusion, or to cause mistake, or to deceive. Additionally, the examining attorney required applicant to amend the identification of goods and disclaim the descriptive term SNOW. The examining attorney also advised applicant of a potentially confusing prior pending application. In its response, applicant: 1) Noted that a cancellation proceeding had been filed against the cited registration; 2) Amended the identification of goods; 3) Disclaimed SNOW; and 3) Set forth reasons why the prior pending refusal should be withdrawn. Applicant did not present arguments as to why the Section 2(d) refusal should be withdrawn. In addition, applicant filed on that same date an Amendment to Allege Use. In a suspension letter dated April 11, 2002, the examining attorney suspended action on this application pending the disposition of the cancellation proceeding. The examining attorney accepted the amended identification, the disclaimer, and the

Exhibit 2



Amendment to Allege Use, and noted as well that the prior pending application had been abandoned.

The examining attorney notes that the cancellation proceeding filed against the cited registration was terminated on April 29, 2002, leaving the Section 2(d) refusal as the only outstanding issue.

### **REFUSAL UNDER TRADEMARK ACT SECTION 2(d) IS MADE FINAL**

With respect to the substantive refusal under Trademark Act Section 2(d), the examining attorney remains of the opinion that the applicant's mark is confusingly similar to the registered mark, and notes again that applicant has presented no arguments or evidence in opposition to the Section 2(d) refusal. For that reason and for the reasons given below, the refusal under Section 2(d) is maintained and made **FINAL**.

### **ANALYSIS OF THE LIKELIHOOD OF CONFUSION**

Section 2(d) of the Trademark Act bars registration where a mark so resembles a registered mark, that it is likely, when applied to the goods, to cause confusion, or to cause mistake or to deceive. 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 similarity of the goods. The overriding concern is to prevent buyer confusion as to the source of the goods. *Miss Universe, Inc. v. Miss Teen U.S.A., Inc.*, 209 USPQ 698 (N.D. Ga. 1980). Therefore, any doubt as to the existence of a likelihood of confusion must be resolved in favor of the registrant. *Lone Star Mfg. Co. v. Bill Beasley, Inc.*, 498 F.2d 906, 182 USPQ 368 (C.C.P.A. 1974).

### **SIMILARITY OF THE MARKS**

In this case, applicant has applied to register the mark SNOW JET. The registered mark is SNO-JET. With the exception of a hyphen and the misspelling of SNO in registrant's mark, the literal portions of the applicant's mark and that of the registrant are identical in appearance, sound, connotation and commercial impression, and therefore, are likely to cause confusion as to the origin of the goods.

### **SIMILARITY OF THE GOODS AND TRADE CHANNELS**

Applicant's goods are identified as "snow recreational devices, namely, inflatable snow saucers, sleds, and toboggans," in International Class 28. Registrant's goods comprise "snow vehicles, namely, sleds, toboggans, coasters, and skis," in International Class 28. Both marks identify identical goods, namely, sleds, toboggans, and saucers/coasters.

### **CONCLUSION**

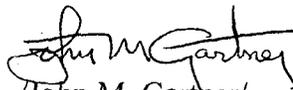
Given the identical marks and identical goods, there is a likelihood of confusion as to the source of the goods. Having conformed to both steps in the Section 2(d) analysis, the examining attorney herein makes **FINAL** the refusal to register.

## APPLICANT'S OPTIONS

Please note that the only appropriate responses to a final action are either (1) compliance with the outstanding requirements, if feasible, or (2) filing of an appeal to the Trademark Trial and Appeal Board. 37 C.F.R. §2.64(a). If the applicant fails to respond within six months of the mailing date of this refusal, this Office will declare the application abandoned. 37 C.F.R. §2.65(a).

**PLEASE NOTE:** Because it delays processing, submission of duplicate papers is discouraged. Unless specifically requested to do so by the Office, parties should not mail follow up copies of documents transmitted by fax. 37 C.F.R. Section 1.4(b); TMEP section 306.04; *Cf. ITC Entertainment Group Ltd. V. Nintendo of America Inc.* 45 USPQ2d 2021 (TTAB 1998).

If the applicant has any questions or needs assistance in responding to this Office action, please telephone the assigned examining attorney.



/John M. Gartner/  
Trademark Examining Attorney  
Law Office 102  
(703) 308-9102 ext. 134  
ecom102@uspto.gov

### How to respond to this Office Action:

To respond formally using the Office's Trademark Electronic Application System (TEAS), visit <http://www.uspto.gov/teas/index.html> and follow the instructions.

To respond formally via E-mail, visit <http://www.uspto.gov/web/trademarks/tmelecresp.htm> and follow the instructions.

To respond formally via regular mail, your response should be sent to the mailing Return Address listed above and include the serial number, law office and examining attorney's name on the upper right corner of each page of your response.

To check the status of your application at any time, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at <http://tarr.uspto.gov/>

For general and other useful information about trademarks, you are encouraged to visit the Office's web site at <http://www.uspto.gov/main/trademarks.htm>

**FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY.**

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 01/11/2002 18:24:47 ET

Serial Number: 72209064

Registration Number: 796701

Mark

# SNO-JET

(words only): SNO-JET

**Current Status:** A cancellation proceeding has been filed at the Trademark Trial and Appeal Board and is now pending.

**Date of Status:** 2001-05-16

**Filing Date:** 1964-12-30

**Registration Date:** 1965-09-28

**Law Office Assigned:** Unknown

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### CURRENT APPLICANT(S)/OWNER(S)

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1. COLECO INDUSTRIES, INC.

**Address:**

COLECO INDUSTRIES, INC.  
266 PEARL ST.  
HARTFORD, CT  
United States

**Country of Citizenship:** United States

**Incorporated in State:** Connecticut

**Legal Entity Type:** Corporation

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### GOODS AND/OR SERVICES

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SNOW VEHICLES-NAMELY, SLEDS, TOBOGGANS, COASTERS AND SKIS

**U.S. Class:** 022 (International Class 028)

**First Use Date:** 19590831

**First Use in Commerce Date:** 19590831

**Basis:** 1(a)

Exhibit 3

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**ADDITIONAL INFORMATION**

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(NOT AVAILABLE)

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**PROSECUTION HISTORY**

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2001-05-16 - Cancellation instituted for Proceeding

1985-09-28 - Registration renewed - 20 year

1985-05-20 - Section 9 filed/check record for Section 8

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**CONTACT INFORMATION**

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**Correspondent (Owner)**

MICHAEL A. CORNMAN

SCHWEITZER CORNMAN GROSS & BONDELL LLP

292 MADISON AVENUE, 19TH FLOOR

NEW YORK, NY 10017

United States

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