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

Proceeding	77921983
Applicant	Summit Entertainment, LLC
Applied for Mark	ECLIPSE
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Submission	Motion For Permission To File Appeal Brief Exceeding 25 Pages And In The Alternative Permission To File Conforming Appeal Brief Not Exceeding 25 Pages
Attachments	FINAL -- Motion for Leave to File Conforming Brief - ECLIPSE Class 9 (parent).pdf(243524 bytes)
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Date	02/04/2016

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Summit Entertainment, LLC
Serial No: 77/921983
Filed: January 28, 2010
Class: 9
Mark: ECLIPSE

Examining Attorney:

Priscilla Milton

Law Office: 110

**MOTION FOR PERMISSION TO
FILE APPEAL BRIEF
EXCEEDING 25 PAGES AND IN
THE ALTERNATIVE
PERMISSION TO FILE
CONFORMING APPEAL BRIEF
NOT EXCEEDING 25 PAGES**

Commissioner of Trademarks
Box TTAB – NO FEE
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Alexandria, VA 22313-1451

Applicant Summit Entertainment, LLC (“Applicant”) respectfully moves for leave to accept Applicant’s Appeal Brief exceeding 25 pages, filed on October 5, 2015. Alternatively, Applicant requests leave to file a conforming Appeal Brief not exceeding 25 pages. This motion is supported by the accompanying brief, and such other papers and argument as may be presented to the Board. Applicant’s proposed conforming brief is attached hereto as Exhibit A.

Respectfully submitted,

Dated: February 4, 2016

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BRIEF IN SUPPORT OF MOTION

I. FACTUAL BACKGROUND

Applicant appealed the Examining Attorney's refusal to register Applicant's trademark ECLIPSE under § 2(d) of the Trademark Act on the ground that it is likely to cause confusion, to cause mistake, or to deceive with the following ten marks ("Cited Marks"):

- U.S. Registration No. 799,454 for ECLIPSE for "magnets" in Class 9 owned by Neill Tools Limited ("Neil Tools");
- U.S. Registration No. 1,526,584 for ECLIPSE for "mobile sound equipment and accessories, namely, am-fm tuners, cassette, CD and speakers, amplifiers and equalizers" in Class 9 owned by Fujitsu Ten Limited ("Fujitsu");
- U.S. Registration No. 1,581,195 for

ECLIPSE

for "mobile sound equipment and accessories, namely, am-fm tuners, cassette, CD and speakers, amplifiers and equalizers" in Class 9 owned by Fujitsu;

- U.S. Registration No. 2,109,357 for SOLAR ECLIPSE for "sunglasses" in Class 9 owned by Lantis Eyewear Corporation ("LEC");
- U.S. Registration No. 3,503,154 for

 **ECLIPSE**

for "audio and visual equipment, namely, radios, CD players, DVD players, hard disc players, and audio equipment for vehicles, namely, equalizers, amplifiers, speakers, and combination CD/DVD players; navigation apparatus for automobiles in the nature of on-board computers" in Class 9 owned by Fujitsu;

- U.S. Registration No. 3,544,541 for ECLIPSE DOGGY for "Action figures; action figures and accessories therefor; aero-dynamic disk for use in playing catching games; baby multiple activity toys; baby rattles; baby rattles incorporating teething rings; baby swings; balloons; bath toys; bathtub toys; battery operated action toys; beach balls; bean bag dolls; bean bags; bendable toys; bingo cards; bingo game playing equipment; bingo markers; board games;

bobble head dolls; bubble making wand and solution sets; card games; cases for action figures; cases for play accessories; checker sets; children's multiple activity toys; children's multiple activity toys sold as a unit with printed books; children's play cosmetics; Christmas tree decorations; Christmas tree ornaments; collectable toy figures; costume masks; crib toys; decorative wind socks; dice games; disc toss toys; doll accessories; doll cases; doll clothing; doll costumes; doll furniture; doll house furnishings; doll houses; dolls; dolls and accessories therefor; dolls and playsets therefor; dolls for playing; dominoes; Easter egg coloring kits; electronic action toys; electronic educational game machines for children; electronic learning toys; equipment sold as a unit for playing a memory game; equipment sold as a unit for playing board games; equipment sold as a unit for playing card games; fantasy character toys; flying discs; flying saucers; furniture for doll's houses; furniture for dolls' houses; hand puppets; infant action crib toys; infant development toys; infant toys; infant's rattles; inflatable bath toys; inflatable bop bags; inflatable ride-on toys; inflatable swimming pools; inflatable toys; inflatable toys showing decorative pictures; jack-in-the-boxes; jigsaw puzzles; jump ropes; kites; manipulative games; manipulative puzzles; marbles; marionette puppets; mechanical action toys; mechanical toys; memory games; mobiles for children; modeled plastic toy figurines; musical toys; paper dolls; party favors in the nature of crackers and noisemakers; party favors in the nature of small toys; party games; pinatas; plastic character toys; play figures; play houses; playing cards; playsets for dolls; plush toys; pop up toys; positionable printed toy figures for use in games; positionable printed toy figures for use in puzzles; positionable three dimensional toys for use in games; positionable toy figures; pull toys; puppets; push toys; puzzles; rag dolls; sand toys; sandbox toys; soft sculpture dolls; soft sculpture plush toys; soft sculpture toys; spinning tops; squeezable squeaking toys; squeeze toys; stacking toys; stuffed dolls and animals; stuffed puppets; stuffed toy animals; stuffed toy bears; stuffed toys; talking toys; teddy bears; tossing disc toys; toy action figures; toy action figures and accessories therefor; toy airplanes; toy animals and accessories therefor; toy balloons; toy boxes; toy building blocks; toy building blocks capable of interconnection; toy buildings and accessories therefor; toy figures; toys, namely children's dress-up accessories; trading card games; water wing swim aids for recreational use; wind-up toys; wind-up walking toys; yo-yos” in Class 28 owned by Mark Der Marderosian (“Marderosian”);

- U.S. Registration No. 3,986,292 for ECLIPSE for “Computer keyboards; Computer game joysticks; Computer mice; Mouse pads; Wireless presenter in the nature of a wireless remote pointer” in Class 9 owned by Mad Catz, Inc. (“Mad Catz”);
- U.S. Registration No. 3,986,293 for



for “Computer keyboards; Computer game joysticks; Computer mice; Mouse pads; Wireless presenter in the nature of a wireless remote pointer” in Class 9 owned by Mad Catz;

- U.S. Registration No. 4,150,483 for MIDNIGHT ECLIPSE for “gaming machines, namely, devices which accept a wager” in Class 9 owned by IGT; and
- U.S. Registration No. 4,202,676 for CASH ECLIPSE for “gaming devices, namely, slot machines, with or without video output” in Class 9 owned by Bally Gaming, Inc. (“Bally”).

The goods at issue in Applicant’s application are “Backpacks adapted for holding computers, camera cases, decorative magnets sold in sheets, decorative wind socks for indicating wind direction and intensity, eyeglasses and eyeglass cases, laptop carrying cases, magnets, mousepads, slot machines, sunglasses and sunglass cases, computer storage devices, namely, flash drives; covers for cell phones, portable and handheld electronic digital devices for playing music, namely, MP3 and MP4 players, laptop computers, personal digital assistants, namely, PDAs, and gaming devices, namely, gaming machines, all relating to motion pictures and entertainment” in Class 9.

Applicant filed its Appeal Brief on October 5, 2015, comprising 47 pages of substantive argument addressing the ten Cited Marks and 7 pages of caption page, table of contents and table of authorities.

The Examining Attorney filed her Examining Attorney’s Appeal Brief on December 7, 2015.

Applicant filed its Reply Brief on December 21, 2015.

On January 28, 2016, the Board issued an Order stating that Applicant’s Appeal Brief numbered 54 pages and exceeded 25 pages in length. The Board stated that it would give no consideration to the Appeal Brief, although the Board would treat the Appeal Brief as timely filed. Applicant received the Board’s order on February 2, 2016. As soon as Applicant received

the Board's order, Applicant immediately acted upon the order, filed this motion, and prepared the Conforming Appeal Brief.

Applicant respectfully requests that the Board accept Applicant's appeal brief filed on October 5, 2015, which exceeded 25 pages. In the alternative, Applicant respectfully moves for leave to file a conforming appeal brief not exceeding 25 pages.

II. THE MOTION FOR LEAVE TO ACCEPT APPLICANT'S APPEAL BRIEF SHOULD BE GRANTED

37 CFR §2.142(b)(2) provides that, "[w]ithout prior leave of the Trademark Trial and Appeal Board, a brief shall not exceed twenty-five pages in length in its entirety, including the table of contents, index of cases, description of the record, statement of the issues, recitation of the facts, argument, and summary." 37 CFR §2.142(b)(2).

Section 1203.01 of the TBMP provides in relevant part:

Most appeal briefs are far less than the twenty-five pages allowed by the rule and, given the limited issues and record in an appeal, the Board will rarely grant a motion for leave to exceed the twenty-five page limit. If an applicant files a brief that exceeds the twenty-five page limit without prior leave of the Board, the brief will not be considered, although the failure to file a conforming brief will not be treated as a failure to file a brief which would result in the dismissal of the appeal. In such a situation, the examining attorney will still file his or her brief, and the applicant may file a reply brief, although the reply brief must be limited to arguments that reply to the arguments made in the examining attorney's brief; it may not be used as a substitute for a main brief, and any arguments that are not properly the subject of a reply brief will not be considered.

TBMP § 1203.01 (citations omitted).

Applicant profusely apologizes to the Board for filing its Appeal Brief on October 5, 2015 that exceeded 25 pages in length. Applicant's submission was inadvertent and an

unfortunate oversight, because, as the TBMP notes, it is normally rare for the issues and arguments in an appeal to require more than 25 pages in length. Applicant was focused on the ten Cited Marks in preparing its Appeal Brief and should have reviewed the TTAB rules again for the applicable page limitation.

Applicant's error was in good faith and not intentional. Applicant respectfully notes that the Examiner refused registration based on ten trademarks. The Cited Marks are each different from one another, are registered for different goods, and are owned by different entities. Applicant's desire to address each Cited Mark separately in a clear and concise manner resulted in an excess number of pages. Accordingly, Applicant respectfully seeks the Board's retroactive permission to accept Applicant's Appeal Brief filed on October 5, 2015.

Alternatively, Applicant conformed its Appeal Brief to meet the 25 page limit and Applicant respectfully moves the Board, in the alternative, to accept the conforming appeal brief. Applicant respectfully submits that its October 5, 2015 Appeal Brief lays out the facts and arguments in a much easier-to-read format than either the conforming appeal brief or Applicant's collective responses to office action, request for reconsideration, and reply brief, which require the Board's review and consideration. *See In re Thomas*, 79 USPQ.2d 1021, 1023 (TTAB 2006) (Board did not consider the applicant's appeal brief, but did consider the applicant's responses to Office actions and the reply brief). Further, the Examining Attorney already responded to Applicant's Appeal Brief in the Examining Attorney's Brief, and therefore, there is no prejudice to the Examining Attorney.

Applicant believes that its October 5, 2015 Appeal Brief should be accepted for the convenience of the Board.

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III. THE MOTION TO FILE A CONFORMED APPEAL BRIEF SHOULD BE GRANTED

In the alternative, Applicant respectfully moves the Board for leave to file a conforming Appeal Brief, which is 25 pages in length. Attached hereto as **Exhibit A** is a true and correct copy of the proposed Conforming Appeal Brief.

Applicant respectfully submits that leave to file the Conforming Appeal Brief is appropriate. First, the Conforming Appeal Brief does not add any new facts, case law or arguments, but merely deletes headings and portions of Applicant's October 5, 2015 Appeal Brief to reduce its size. Second, the Examining Attorney is not prejudiced by the Conforming Appeal Brief because no new facts, case law or arguments have been added, and the Examining Attorney has no need to address any new issues. Finally, the Examining Attorney and the Board are not prejudiced by the Conforming Appeal Brief because it summarizes the various office actions and office action responses and evidence contained in the bulky prosecution file history for this application and hopefully will streamline the argument for the oral hearing set for February 10, 2016.

IV. CONCLUSION

For the reasons stated above, Applicant respectfully requests that the Board enter an order accepting Applicant's Appeal Brief filed on October 5, 2015, or in the alternative, grant Applicant leave to file the attached Conforming Appeal Brief not exceeding 25 pages.

Respectfully submitted,

Dated: February 4, 2016

/Jill M. Pietrini/
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CERTIFICATE OF E-FILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451, on this 4th day of February, 2016.

/LaTrina A. Martin

LaTrina A. Martin

SMRH:474896862.1

EXHIBIT A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Summit Entertainment, LLC

Serial No: 77/921983

Filed: January 28, 2010

Class: 9

Mark: ECLIPSE

Examiner:

Priscilla Milton

Law Office: 110

**APPLICANT'S CONFORMING
APPEAL BRIEF**

TABLE OF CONTENTS

	<u>Page</u>
A. STATEMENT OF FACTS	2
1. INFORMATION ABOUT THE PARTIES	3
2. PROCEDURAL BACKGROUND.....	3
B. THE EXAMINER’S REFUSAL TO REGISTER APPLICANT’S MARK ON THE BASIS OF LIKELIHOOD OF CONFUSION SHOULD BE WITHDRAWN.....	7
1. THE STANDARD FOR DETERMINING LIKELIHOOD OF CONFUSION.....	7
2. THE OFFICE HAS A HISTORY OF REGISTERING NUMEROUS ECLIPSE AND ECLIPSE-RELATED MARKS	7
3. THE MARKS ARE DISTINGUISHABLE.....	11
A. APPLICANT’S MARK AND THE CITED MARKS ARE ENCOUNTERED IN DIFFERENT CONTEXTS	11
B. APPLICANT’S MARK AND THE CITED MARKS ARE DIFFERENT IN APPEARANCE, SOUND, CONNOTATION AND COMMERCIAL IMPRESSION.....	12
4. APPLICANT’S GOODS AND THE GOODS IN REGISTERED IN CONNECTION WITH THE CITED MARKS ARE NOT RELATED.....	18
5. REGISTRANTS’ CUSTOMERS EXERCISE CARE	19
6. THERE IS NO EVIDENCE THE CITED MARKS ARE FAMOUS.....	20
C. CONCLUSION.....	21
CERTIFICATE OF E-FILING	21

TABLE OF AUTHORITIES

	<u>Page(s)</u>
<u>Cases</u>	
<i>Brown Shoe Co. v. Robbins</i> , 90 USPQ.2d 1752 (TTAB 2009)	15
<i>Colgate-Palmolive Co. v. Carter-Wallace, Inc.</i> 167 USPQ 529 (CCPA 1970)	14
<i>Continental Plastic Containers v. Owens Brockway Plastic Products, Inc.</i> 141 F.3d 1073 (Fed. Cir. 1998).....	19
<i>In re E.I. Du Pont de Nemours & Co.</i> 177 USPQ 563 (CCPA 1973)	7, 12, 19
<i>Edom Laboratories Inc. v. Lichter</i> , 102 USPQ.2d 1546 (TTAB 2012)	15
<i>Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.</i> 954 F.2d 713 (Fed. Cir. 1992).....	19
<i>Estate of P.D. Beckwith, Inc. v. Commissioner of Patents</i> 252 U.S. 538 (1920).....	14
<i>First Sav. Bank, F.S.B. v. First Bank Sys.</i> 101 F.3d 645 (10th Cir. 1996)	8
<i>General Mills, Inc. v. Kellogg Co.</i> 824 F.2d 622 (8th Cir. 1987)	8, 14
<i>In re Digirad Corp.</i> , 45 USPQ.2d 1841 (TTAB 1998)	19
<i>In re Sears, Roebuck & Co.</i> , 2 USPQ.2d 1312 (TTAB 1987)	11
<i>In re Thor Tech, Inc.</i> 113 USPQ.2d 1546, 1549 (TTAB 2015)	10, 11
<i>Kangol, Ltd. v. KangaROOS U.S.A., Inc.</i> 974 F.2d 161 (Fed. Cir. 1992).....	14
<i>Kayser-Roth Corp. v Morris & Company, Inc.</i> USPQ 153 (TTAB 1969)	14

<i>Keebler Co. v. Associated Biscuits, Ltd.</i> 207 USPQ 1034 (TTAB 1980)	8, 10, 11
<i>L’Oreal S.A. v. Marcon,</i> 102 USPQ.2d 1434	15
<i>Local Trademarks, Inc. v. Handy Boys Inc.</i> 16 USPQ.2d 1156, 1158 (TTAB 1990)	11, 13
<i>Murray Corp. of America v. Red Spot Paint & Varnish Co.</i> 280 F.2d 158 (CCPA. 1960)	14
<i>Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772</i> 396 F.3d 1369 (Fed. Cir. 2005).....	15
<i>Recot, Inc. v. Becton</i> 214 F.3d 1322 (Fed. Cir. 2000).....	7, 20
<i>Sand Hill Advisors, LLC v. Sand Hill Advisors, LLC</i> 680 F. Supp.2d 1107 (N.D. Cal. 2010)	8
<i>Shen Mfg. Co. v. Ritz Hotel Ltd.</i> 393 F.3d 1238 (Fed. Cir. 2004).....	11
<i>Sweats Fashions Inc. v. Pannill Knitting Co. Inc.</i> 833 F.2d 1560 (Fed. Cir. 1987).....	10
<i>In re Sydel Lingerie Co., Inc.</i> 197 USPQ 629 (TTAB 1977)	11, 12
<i>Top Tobacco LP v. North Atlantic Operating Co.,</i> 101 USPQ.2d 1163 (TTAB 2011)	10
<u>Other Authorities</u>	
J. Thomas McCarthy, <i>McCarthy on Trademarks and Unfair Competition</i> (Fourth Ed.) § 19:75 at 19-230	7
Lanham Act § 1(b)	3
Lanham Act § 2(d)	1, 7, 14
TMEP § 1207.01	7
TMEP § 1207.01(a)(i).....	11, 18, 19

Applicant Summit Entertainment, LLC (“Applicant”) hereby submits this brief in support of its appeal of the Examiner’s refusal to register Applicant’s trademark ECLIPSE under § 2(d) on the ground that it is likely to cause confusion, to cause mistake, or to deceive with the following **ten** marks (“Cited Marks”):

- U.S. Reg. No. 799,454 for ECLIPSE for “magnets” in Class 9 owned by Neill Tools Limited (“Neil Tools”);
- U.S. Reg. No. 1,526,584 for ECLIPSE for “mobile sound equipment and accessories, namely, am-fm tuners, cassette, CD and speakers, amplifiers and equalizers” in Class 9 owned by Fujitsu Ten Limited (“Fujitsu”);
- U.S. Reg. No. 1,581,195 for
 ECLIPSE
for “mobile sound equipment and accessories, namely, am-fm tuners, cassette, CD and speakers, amplifiers and equalizers” in Class 9 owned by Fujitsu;
- U.S. Reg. No. 2,109,357 for SOLAR ECLIPSE for “sunglasses” in Class 9 owned by Lantis Eyewear Corporation (“LEC”);
- U.S. Reg. No. 3,503,154 for
 ECLIPSE
for “audio and visual equipment, namely, radios, CD players, DVD players, hard disc players, and audio equipment for vehicles, namely, equalizers, amplifiers, speakers, and combination CD/DVD players; navigation apparatus for automobiles in the nature of on-board computers” in Class 9 owned by Fujitsu;
- U.S. Reg. No. 3,544,541 for ECLIPSE DOGGY for a variety of toys in Class 28 owned by Mark Der Marderosian (“Marderosian”);
- U.S. Reg. No. 3,986,292 for ECLIPSE for “Computer keyboards; Computer game joysticks; Computer mice; Mouse pads; Wireless presenter in the nature of a wireless remote pointer” in Class 9 owned by Mad Catz, Inc. (“Mad Catz”);
- U.S. Reg. No. 3,986,293 for
 Eclipse
for “Computer keyboards; Computer game joysticks; Computer mice; Mouse pads; Wireless presenter in the nature of a wireless remote pointer” in Class 9 owned by Mad Catz;

- U.S. Reg. No. 4,150,483 for MIDNIGHT ECLIPSE for “gaming machines, namely, devices which accept a wager” in Class 9 owned by IGT; and
- U.S. Reg. No. 4,202,676 for CASH ECLIPSE for “gaming devices, namely, slot machines, with or without video output” in Class 9 owned by Bally Gaming, Inc. (“Bally”).

The goods at issue are: “Backpacks adapted for holding computers, camera cases, decorative magnets sold in sheets, decorative wind socks for indicating wind direction and intensity, eyeglasses and eyeglass cases, laptop carrying cases, magnets, mousepads, slot machines, sunglasses and sunglass cases, computer storage devices, namely, flash drives; covers for cell phones, portable and handheld electronic digital devices for playing music, namely, MP3 and MP4 players, laptop computers, personal digital assistants, namely, PDAs, and gaming devices, namely, gaming machines, **all relating to motion pictures and entertainment**” in Class 9 (emphasis added).

For the reasons given in Applicant’s Office Action Responses dated November 5, 2010 and August 18, 2014, its Request for Reconsideration dated March 20, 2015, and all other filings Applicant has made for this application, all of which are expressly incorporated herein by reference, Applicant respectfully maintains that the refusal to register Applicant’s ECLIPSE mark is misplaced. When one also considers the weakness of the Cited Marks and the different contexts in which the parties’ marks are encountered, among other factors, it is clear that consumers are unlikely to confuse Applicant’s mark with the Cited Marks, and the refusal to register should be reversed.

A. STATEMENT OF FACTS

For the Board’s convenience, the facts are summarized below.

1. Information About The Parties

Applicant is the well-known producer and distributor behind the enormously successful motion pictures *Twilight*; *The Twilight Saga: New Moon*; *The Twilight Saga: Eclipse*; *The Twilight Saga: Breaking Dawn - Part 1*; and *The Twilight Saga: Breaking Dawn - Part 2* (collectively, the “*Twilight Motion Pictures*”). (Office Action Response (“OAR”), August 18, 2014 at 8.) In connection with its successful franchise, Applicant seeks registration of the mark ECLIPSE for various goods in Class 9. Indeed, Applicant’s use of its ECLIPSE mark refers to the third of these films and is often used with imagery from that film. (Request for Reconsideration (“Reconsideration”), March 20, 2015, Ex. B.)

In contrast, Registrant Neill Tools is a UK-based magnet manufacturer. (OAR, November 5, 2010 at 7.) Registrant Fujitsu is a Japanese-based consumer electronics company. (*Id.* at 7.) Registrant LEC is a sunglass manufacturer. (*Id.* at 7.) Registrant Marderosian is an illustrator who has created a canine character for kids called “Eclipse Doggy.” (*Id.* at 38.) Registrant Mad Catz is a gaming and computer accessory electronics company (OAR, August 18, 2014 at 41.) Registrant IGT is a manufacturer of gambling devices which accept a wager. (*Id.* at 49.) Registrant Bally is a seller of slot machines to casinos and other gambling institutions. (*Id.* at 51.)

2. Procedural Background

Applicant filed its application to register ECLIPSE on January 28, 2010. Applicant filed its application under Section 1(b) of the Lanham Act for “Backpacks adapted for holding computers, camera cases, cases for mobile phones, cases for PDAs, cell phones, computer games, decorative charms for cell phones, decorative magnets sold in sheets, decorative wind socks, digital trading cards, disposable cameras, downloadable computer wallpapers and screen savers, downloadable files and recordings featuring music, downloadable widgets, electric door

bells, electronic diaries, eyeglasses and eyeglass cases, headphones and earphones, juke boxes, laptop carrying cases, magnets, motion picture films in the fields of drama and romance, mousepads, musical sound recordings, neon signs, slot machines, sunglasses and sunglass cases, switch plate covers, tape measures, television programs and documentaries, trading cards in the form of CDs, video game software, and video games; pre-recorded DVDs, videotapes, and other audiovisual recordings featuring motion pictures; computer storage devices, namely, flash drives; covers for cell phones, portable music players, laptops, PDAs, and gaming devices; and downloadable software that provides access to movie and entertainment-related content and allows users to socialize and interact with other users” in Class 9.

On May 6, 2010, the Examiner issued an office action (“OA”) refusing registration of Applicant’s ECLIPSE mark on the ground that it was likely to be confused with U.S. Reg. Nos. 799,454, 1,526,584, 1,581,195, 1,827,339, 2,109,357, 3,026,454, 3,094,455, 3,503,154, 3,515,398, 3,544,541. The Examiner also provided information about seven prior pending applications, noting that the prior applications could be cited as a bar to registration should those applications eventually mature into registration: Application Serial Nos. 77/708,443, 77/731,919, 77/763,490, 77/763,499, 77/882,752, 77/913,990, and 77/914,002.

Applicant filed its response to the Office Action on November 5, 2010 arguing that Applicant’s mark was distinguishable from the ten registrations and reserving its right to address a refusal to register based on a likelihood of confusion with any prior pending application that matured into registration. (OAR, November 5, 2010.)

On December 14, 2010, the Examiner suspended this application pending the disposition of the prior pending applications and continued and maintained the refusal to register based on Reg. Nos. 799,454, 1,526,584, 1,581,195, 1,827,339, 2,109,357, 3,026,454, 3,094,455, 3,503,154, 3,515,398 and 3,544,541. (Notice of Suspension, December 14, 2010 at 1.)

Application Serial No. 77/708,443 for MIDNIGHT ECLIPSE owned by IGT matured into Reg. No. 4,150,483. Application Serial No. 77/731,919 for CASH ECLIPSE owned by Bally matured into Reg. No. 4,202,676. Application Serial No. 77/763,490 for ECLIPSE owned by Mad Catz matured into Reg. No. 3,986,292. Application Serial No. 77/763,499 for ECLIPSE & Design owned by Mad Catz matured into Reg. No. 3,986,293. Application Serial No. 77/913,990 for ECLIPS owned by Ellison matured into Reg. No. 4,080,585. Application Serial No. 77/914,002 for ECLIPS & Design owned by Ellison matured into Reg. No. 4,080,586.

On February 27, 2014, the Examiner issued a second Office Action refusing registration of Applicant's mark based on a likelihood of confusion with newly registered Reg. Nos. 4,150,483, 4,202,676, 3,986,292, 3,986,293, 4,080,585, and 4,080,586 and continuing the refusal to register Applicant's mark based on a likelihood of confusion with U.S. Reg. Nos. 799,454, 1,526,584, 1,581,195, 1,827,339, 2,109,357, 3,094,455, 3,503,154, 3,515,398 and 3,544,541.¹ (OA, February 27, 2014 at 1.)

Applicant filed its response to the second Office Action on August 18, 2014. (OAR, August 14, 2014.)

On September 22, 2014, the Examiner issued a Final Office Action withdrawing the refusal to register based on Reg. Nos. 4,080,585 and 4,080,586, but refusing registration of Applicant's mark on likelihood of confusion grounds based on Reg. Nos. 799,454, 1,526,584, 1,581,195, 1,827,339, 2,109,357, 3,094,455, 3,503,154, 3,515,398, 3,544,541, 3,986,292, 3,986,293, 4,150,483 and 4,202,676. (OA, September 22, 2014.) The Examiner's refusal to register only applied to the following goods ("Refused Goods"): Backpacks adapted for holding computers, camera cases, decorative magnets sold in sheets, decorative wind socks for indicating

¹ The Examiner withdrew the refusal to register based on Reg. No. 3,026,454 because the registration was canceled and withdrew the potential refusal to register based on Application Serial No. 77/882,752 because the application was abandoned.

wind direction and intensity, eyeglasses and eyeglass cases, laptop carrying cases, magnets, mousepads, slot machines, sunglasses and sunglass cases, computer storage devices, namely, flash drives; covers for cell phones, portable and handheld electronic digital devices for playing music, namely, MP3 and MP4 players, laptop computers, personal digital assistants, namely, PDAs, and gaming devices, namely, gaming machines. (OA, September 14, 2014 at 5.)

Applicant responded to the Examiner's September 22, 2014 final refusal by filing a Request for Reconsideration on March 20, 2015, in which Applicant requested amendment of the identification of goods to add the limitation "all relating to motion pictures and entertainment" to the Refused Goods. (Reconsideration, March 20, 2015.)

Applicant filed a Request to Divide concurrently with its Request for Reconsideration, requesting the PTO to divide out the non-refused goods into a child application. (Request to Divide, March 20, 2014.) Finally, to preserve its rights, Applicant also filed a Notice of Appeal concurrently with its Request for Reconsideration.

On May 13, 2015, the Intent to Use Division of the PTO granted the Request to Divide and the Board notified Applicant that the non-refused goods were approved for publication on June 15, 2015 in child Application Serial No. 77/975668. (TTAB Docket No. 7.)

On June 15, 2015, the newly-assigned Examiner accepted amendment to Applicant's identification of goods and withdrew the refusal to register based on Reg. Nos. 1,827,339, 3,094,455 and 3,515,398. However, the Examiner denied Applicant's Request for Reconsideration on the ground that Applicant's mark was likely to be confused with the Cited Marks Reg. Nos. 799,454, 1,526,584, 1,581,195, 2,109,357, 3,503,154, 3,544,541, 3,986,292, 3,986,293, 4,150,483 and 4,202,676. As a result on August 6, 2015, the Board ordered that proceedings before the Board resume, allowing Applicant sixty days to file its appeal brief. (TTAB Docket No. 7.) This appeal brief is timely filed.

B. THE EXAMINER’S REFUSAL TO REGISTER APPLICANT’S MARK ON THE BASIS OF LIKELIHOOD OF CONFUSION SHOULD BE WITHDRAWN

The Examiner’s refusal to register Applicant’s mark is based solely on the ground that it is likely to be confused with the Cited Marks. Applicant respectfully maintains that there is no likelihood of confusion between Applicant’s mark and the Cited Marks.

1. The Standard for Determining Likelihood of Confusion

To determine whether likelihood of confusion exists, the Examiner must consider *all* of the *DuPont* factors that are relevant to a particular case. *See In re E.I. Du Pont de Nemours & Co.*, 177 USPQ 563, 567 (CCPA 1973); *see also Recot, Inc. v. Becton*, 214 F.3d 1322, 1326 (Fed. Cir. 2000) (whether likelihood of confusion exists is determined “on a case-specific basis” using the *DuPont* factors). An analysis of these factors demonstrates that there is no likelihood of confusion between Applicant’s mark and the Cited Marks.

The Office bears the burden of showing that a mark falls within the statutory bars of Section 2(d). J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* (Fourth Ed.) § 19:75 at 19-230. To refuse registration under Section 2(d), the Examiner “must present sufficient evidence and argument that the mark is barred from registration.” *Id.* § 19:128 at 19-383. Here, and respectfully, the Examiner has not met her burden.

2. The Office Has a History of Registering Numerous ECLIPSE and ECLIPSE-Related Marks

DuPont and TMEP § 1207.01 advise that the nature and number of similar marks must be considered as a factor in determining likelihood of confusion. Indeed, the relative strength or weakness of a mark is “a very important element” in determining likelihood of confusion. *See McCarthy* § 23:48 at 23-203 (“If the common element of conflicting marks is a word that is ‘weak’ then this reduces the likelihood of confusion.”). The Board and courts routinely hold

that, “[t]he greater the number of identical or more or less similar marks already in use on different kinds of goods, the less is the likelihood of confusion between any two specific uses of the weak mark.” *First Sav. Bank, F.S.B. v. First Bank Sys.*, 101 F.3d 645, 653-54 (10th Cir. 1996); *see also Keebler Co. v. Associated Biscuits, Ltd.*, 207 USPQ 1034, 1038 (TTAB 1980) (citing the plethora of marks registered by the Office and incorporating the term CLUB as evidence supporting the Board’s finding that such marks were “entitled to only a very circumscribed scope of protection limited to essentially the same mark for essentially the same goods.”); *Sand Hill Advisors, LLC v. Sand Hill Advisors, LLC*, 680 F. Supp.2d 1107, 1119 (N.D. Cal. 2010) (citation omitted) (“Where [, as here,] the market is inundated by products using the particular trademarked word, there is a corresponding likelihood that consumers ‘will not likely be confused by any two in the crowd.’”). Indeed, “[d]etermining that a mark is weak means that consumer confusion has been found unlikely because the mark’s components are so widely used that the public can easily distinguish slight differences in the marks, even if the goods are related.” *General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 626 (8th Cir. 1987).

Applicant maintains that the Cited Marks are weak and thus that consumer confusion with Applicant’s mark is unlikely. Supporting this conclusion is the fact that the Office has a history of registering and publishing numerous ECLIPSE and ECLIPSE-related marks, including the very co-existence of no less than ten Cited Marks in Class 9.

Applicant owns nine other standalone ECLIPSE registrations for a variety of goods and services, including cosmetics, toys, bags and other merchandise:

Reg. No.	Mark	Class and Goods/Services
4,525,997	ECLIPSE	16: Art pictures, bookmarks, calendars, decals, decorative paper centerpieces, dry erase boards, erasers, greeting cards, money clips, note cards, notebooks, paper napkins, paper party decorations, pencil cases, pencils, pens, postcards, posters, sheet music, songbooks, stationery, stickers, and trading cards; kits containing party supplies, namely, paper napkins, plastic

Reg. No.	Mark	Class and Goods/Services
		utensils, and paper or plastic plates, cups, table covers and decorations
4,372,815	ECLIPSE	3: Body shimmer powder, cosmetics, fragrances, nail polish, bath gel, body lotion, shower gel, and skin moisturizer
4,324,707	ECLIPSE	28: Balloons and golf balls
4,161,659	ECLIPSE	28: Action figures, action skill games, bendable toys, board games, card games, Christmas stockings, Christmas tree ornaments, dolls, party favors in the nature of small toys, plush toys, and puzzles.
4,123,470	ECLIPSE	45: Licensing of merchandise associated with motion pictures.
4,230,352	ECLIPSE	26: Armbands, ornamental novelty buttons and ornamental cloth patches.
4,143,128	ECLIPSE	22: Multi-purpose cloth bags
4,172,090	ECLIPSE	20: non-metal dog tags, pillows, plastic banners, wood boxes; and vinyl appliques for attachment to windows, mirrors and other solid surfaces
4,198,901	ECLIPSE	5: Bandages for skin wounds

(OAR, August 18, 2014, Ex. G.)

As of August 18, 2014, there were currently 415 “live” registered and pending marks in containing words identical or virtually identical to ECLIPSE. (Reconsideration, August 18, 2014, Ex. A.) Of those 415 marks, there were 77 registered ECLIPSE marks in Class 9. (*Id.* at Ex. B.) As of March 20, 2015, there were currently 340 “live” registered marks containing words identical or virtually identical to ECLIPSE, registered for a wide variety of goods and services. (OAR, March 20, 2015, Ex. A.)

The prevalence of so many ECLIPSE marks on the federal register is compelling evidence that such marks are weak and are not entitled to protection beyond the specific mark for the specific goods. The fact that the Office has registered other ECLIPSE marks, *including the very coexistence of the Cited Marks*, indicates that the Office considers this mark weak and only entitled to a narrow scope of protection. Applicant maintains that the ECLIPSE mark is weak and thus that consumer confusion is unlikely.

In response to this argument, the Examiner stated that evidence of third party registrations is not entitled to significant weight because the weakness or dilution of a particular mark is “generally determined in the context of the number and nature of similar marks *in use in the marketplace* in connection with *similar* goods. (OA, September 22, 2014 at 3, original emphasis.) The Examiner’s attempt to characterize Applicant’s goods as different from Registrants’ goods is without merit. There are numerous third-party registrations for marks consisting of or including ECLIPSE in the marketplace, including 77 alone in Class 9. This indicates that confusion is unlikely, particularly since Applicant’s ECLIPSE mark is associated with the third motion picture in Applicant’s *Twilight* Motion Pictures.

Second, the Federal Circuit has noted that third-party registrations incorporating a particular term can serve to negate a claim of exclusive rights in the term. *Sweats Fashions Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 1565 n.1 (Fed. Cir. 1987). Furthermore, “a pattern of registrations” by third parties can suggest that businesses in different industries “believe that their respective goods are distinct enough that confusion between even identical marks is unlikely.” *In re Thor Tech, Inc.*, 113 USPQ.2d 1546, 1549 (TTAB 2015); *Keebler*, 207 USPQ at 1038 (finding that “registrations tend to define fields of use and, conversely, the boundaries of use and protection surrounding the marks and marks comprising the same word ... for their various products. The mutual respect and restraint exhibited toward each other by the owners of the plethora of marks, evidenced by their coexistence on the Register, are akin to the opinion manifested by knowledgeable businessmen ...”) Furthermore, third-party registrations can show that a commonly registered term has a suggestive or descriptive significance for particular goods such that differences in the remaining portions of the marks may be sufficient to render the marks as a whole distinguishable. *See Top Tobacco LP v. North Atlantic Operating Co.*, 101 USPQ.2d 1163, 1173 (TTAB 2011).

Just as in *Thor Tech*, and *Keebler*, the fact that the Office has registered so many marks consisting of or incorporating ECLIPSE indicates that it considers Registrants' marks so widely used that the public easily distinguishes slight differences in the goods to which the marks are applied, even though the goods of the parties may be considered "related."

3. The Marks are Distinguishable

a. Applicant's Mark and the Cited Marks are Encountered in Different Contexts

The courts and the Board routinely hold that there is no likelihood of confusion "if the goods or services in question are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source" TMEP § 1207.01(a)(i) (emphasis added) (citing *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1244-45 (Fed. Cir. 2004) (cooking classes and kitchen textiles not related); *Local Trademarks, Inc. v. Handy Boys Inc.*, 16 USPQ.2d 1156, 1158 (TTAB 1990) ("[A]s far as the general public is concerned confusion would not be likely because the goods and services are sold through different channels of trade to different classes of consumers."); *In re Sears, Roebuck & Co.*, 2 USPQ.2d 1312, 1314 (TTAB 1987) (different meanings are projected by the identical mark CROSSOVER when used on brassieres and on ladies' sportswear, respectively, because they are different types of clothing, having different uses, and are normally sold in different sections of department stores); *In re Sydel Lingerie Co., Inc.*, 197 USPQ 629, 630 (TTAB 1977). In this case, confusion is unlikely because of the lack of similarity between the parties' commercial activities, as well as the absence of common ground between their channels of trade.

Applicant's mark ECLIPSE refers to the third film in the immensely popular epic romantic vampire *Twilight* movie franchise. (OAR, August 18, 2014, Exs. C-D.) The films are

based on the enormously successful series of novels written by the author Stephenie Meyer, including her third novel titled “Eclipse”. (*Id.*, Ex. E.) Applicant’s *Eclipse* film previously held the record for biggest midnight opening in the U.S. and Canada in box office history, grossing an estimated \$30 million. (*Id.*, Ex. D.) *Eclipse* is also the film with the widest independent release, playing in more than 4,416 theaters, surpassing its predecessor, *The Twilight Saga: New Moon*, also produced by Applicant. (*Id.*) Global revenues for the *Eclipse* motion picture are an estimated \$698,491,347, making it one of the most successful films of all time. (*Id.*) Applicant’s ECLIPSE mark is a globally recognized mark and well known as an integral part of the *Twilight* Motion Pictures.

It is not surprising, then, that goods bearing Applicant’s mark are related to the *Twilight* Motion Pictures and marketed through mass market retailers and other affordable channels of commerce. Goods marketed under Applicant’s ECLIPSE mark are often sold using imagery from the *Twilight* Motion Pictures in order to further distinguish those goods in the marketplace. (Reconsideration, March 20, 2015, Ex. B.) In recognition of this marketplace reality, Applicant’s identification of goods expressly contains a restriction, namely, they are all products “relating to motion pictures and entertainment”. The Cited Marks do not contain any association with Applicant’s *Twilight* Motion Pictures or the *Eclipse* film.

b. Applicant’s Mark and the Cited Marks are Different in Appearance, Sound, Connotation and Commercial Impression

When determining likelihood of confusion, marks are compared in their entireties based the similarity or dissimilarity in sight, sound, connotation and commercial impression. *See DuPont*, 177 USPQ at 567. Applicant’s mark is dissimilar from the Cited Marks in all respects.

Applicant’s mark is distinguishable from Neill Tools’ mark ECLIPSE. Even in cases where an applicant’s mark and a registrant’s mark are identical, a finding of likelihood of

confusion is unjustified if, as in this case, the goods in connection with which the marks are used are only distantly related. *Local Trademarks*, 16 USPQ.2d at 1158. Neill Tools, doing business as Eclipse Magnetics, is a UK-based company that purports to manufacture over 20,000 different products related to magnetics. (OAR, August 18, 2014, Ex. H.) According to Neill Tools' website, its products are only available at one place in the United States -- Magnetic Products, Inc. in Highland, Michigan. (*Id.*) Consumers who purchase Neill Tools' magnets do so because they want a magnet that can be used for any number of commercial or industrial purposes. (*Id.* at Ex. H.) Conversely, consumers who purchase Applicant's motion picture-related magnets do so because they are fans of the *Twilight* Motion Pictures and may be looking for Applicant's goods that include imagery from the *Twilight* Motion Pictures.

Applicant's mark is distinguishable from Fujitsu's mark ECLIPSE and ECLIPSE (Stylized). The Examiner virtually ignores the impact that Fujitsu's stylization has on the commercial impact of its mark. However, given the extreme weakness of the ECLIPSE mark, such a profound change in a mark's appearance (shown below) is sufficient to distinguish Fujitsu's ECLIPSE (Stylized) mark from Applicant's ECLIPSE mark.

ECLIPSE

Fujitsu is a Japanese-based consumer electronics company. (OAR, August 18, 2014, Ex. I.) Fujitsu uses its ECLIPSE mark in connection with "mobile sound equipment" – *i.e.*, in-dash and in-seat DVD players, radios, and navigational units. (*Id.*) Consumers encountering Fujitsu's products likely do so at electronics stores and other car audio system retailers. Conversely, consumers who encounter Applicant's motion picture-related goods do so in mass market retailers and other general channels of commerce. (*Id.* at 10.)

Applicant's mark is distinguishable from LEC's mark SOLAR ECLIPSE. In evaluating the similarity of Applicant's mark and U.S. Reg. No. 2,109,357 for SOLAR ECLIPSE, the

Examiner argues that the marks “share the same dominant feature, namely, ‘ECLIPSE’.” (*See, e.g.,* OA, February 27, 2014 at 3.) It is insufficient to suggest that Applicant’s ECLIPSE mark and the SOLAR ECLIPSE mark are likely to be confused simply because they both share the ECLIPSE element. *See Murray Corp. of America v. Red Spot Paint & Varnish Co.*, 280 F.2d 158, 161 (CCPA. 1960) (“[A]lthough appellee’s mark embodies appellant’s entire mark, when considering those marks in their entirety, as we must . . . we are of the opinion that the likelihood of confusion, mistake or deception contemplated by Section 2(d) of the Lanham Act does not exist.”); *see also General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 627 (8th Cir. 1987) (“The use of identical, even dominant, words in common does not automatically mean that two marks are similar.”). Indeed, such a result would violate the anti-dissection rule. *See Estate of P.D. Beckwith, Inc. v. Commissioner of Patents*, 252 U.S. 538, 545-46 (1920) (“The commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail.”). It also ignores the weakness of the ECLIPSE element in general, as mentioned above.

Applicant’s mark and LEC’s SOLAR ECLIPSE mark are dissimilar in appearance, sound and commercial impression. Applicant’s mark and LEC’s mark appear differently because of the addition of the distinctive word SOLAR to the front of LEC’s mark. Applicant’s mark and the SOLAR ECLIPSE mark also sound differently by the addition of the two-syllable word SOLAR to LEC’s mark. *See, e.g., Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 167 USPQ 529, 530 (CCPA 1970); *Kayser-Roth Corp. v Morris & Company, Inc.*, USPQ 153, 154 (TTAB 1969).

The dominant feature of a mark generally is entitled to greater weight in determining the issue of likelihood of confusion. *Kangol, Ltd. v. KangaROOS U.S.A., Inc.*, 974 F.2d 161, 163 (Fed. Cir. 1992). In identifying the dominant feature of a mark, it is often the first part of a mark that is most likely to be impressed upon the mind of a purchaser and remembered. Thus, if the

first word or element of the involved marks is the same or highly similar, this point can weigh heavily in favor of confusion being likely. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1372–73, 73 USPQ.2d 1689, 1692 (Fed. Cir. 2005); *Edom Laboratories Inc. v. Lichter*, 102 USPQ.2d 1546, 1551 (TTAB 2012) (noting that the first part of opposer’s mark is “most likely to be impressed upon the mind of a purchaser and remembered.”); *L’Oreal S.A. v. Marcon*, 102 USPQ.2d 1434, 1439 (TTAB 2012) (“purchasers in general are inclined to focus on the first word or portion in a trademark.”); *Brown Shoe Co. v. Robbins*, 90 USPQ.2d 1752, 1755 (TTAB 2009) (noting that it is the first portion of a mark that is more likely to make an impression on potential purchasers). Here, consumers will focus on the SOLAR portion of LEC’s mark because it is the first part of the SOLAR ECLIPSE mark.

Applicant’s mark and Fujitsu’s ECLIPSE & Design mark are dissimilar in appearance, sound and commercial impression. Applicant’s mark and the ECLIPSE & Design mark appear differently because of Fujitsu’s distinct design element (shown below):



Indeed, considering the high number of ECLIPSE marks already on the federal register, and the fact that Applicant’s mark is sometimes accompanied by imagery from the *Twilight* Motion Pictures, such significant changes are more than sufficient to distinguish Fujitsu’s ECLIPSE & Design mark from Applicant’s mark.

Applicant’s mark is visually and phonetically distinguishable from Mr. Marderosian’s mark ECLIPSE DOGGY because of the addition of the second, incongruous word DOGGY to the ECLIPSE DOGGY mark. Mr. Marderosian’s ECLIPSE DOGGY mark also creates a completely different commercial impression than Applicant’s ECLIPSE mark. Specifically, whereas Applicant’s mark brings to mind a lunar eclipse because of the well-known werewolf characters in the *Twilight* Motion Pictures, Mr. Marderosian’s ECLIPSE DOGGY mark brings to

mind a dog. This impression is confirmed by the way Mr. Marderosian uses his ECLIPSE DOGGY mark in the marketplace. (OAR, August 18, 2014, Ex. N.)

Contrary to the Examiner's statement about ECLIPSE being the dominant feature in this mark, it is actually the DOGGY element that would likely be considered the dominant feature, especially because the ECLIPSE mark is so weak. Such differences in appearance and sound indicate that confusion is unlikely.

Mr. Marderosian appears to be an illustrator who created a canine character for kids called "Eclipse Doggy." (OAR, August 18, 2014, Ex. N.) Whereas those customers of Mr. Marderosian may purchase his goods because they are looking for a children's plush toy doll, the people who are looking for and ultimately purchase Applicant's goods do so because they relate to the *Twilight* Motion Pictures. These differences indicate that Applicant's mark and Mr. Marderosian's mark are unlikely to be confused.

Applicant's mark is distinguishable from Mad Catz's ECLIPSE marks. The Examiner states that the marks "share the same dominant feature, namely, 'ECLIPSE'." (*See, e.g.,* OA, February 27, 2014 at 3.) Given the extreme weakness of the ECLIPSE mark, Mad Catz's use of stylized font and a design (shown below) is sufficient to distinguish Mad Catz's ECLIPSE (Stylized) mark from others in the marketplace, including Applicant's ECLIPSE mark.



Consumers are also likely to encounter Mad Catz's marks at different locations than they would encounter Applicant's ECLIPSE mark. At the present time it appears that consumers who wish to purchase Mad Catz's products can only do so through Mad Catz's online store at <store.madcatz.com>. (*Id.*) Conversely, consumers who encounter Applicant's merchandise do so in mass market retailers and other affordable channels of commerce.

Consumers also would purchase Applicant's goods and Mad Catz's goods for different reasons. Consumers who purchase Mad Catz's computer accessories do so because they are looking for special computer accessories for their computers. (*Id.*) Conversely, consumers who are interested in purchasing Applicant's computer products do so because they are fans of the *Twilight* Motion Pictures. These consumers will not confuse Applicant's computer products bearing the ECLIPSE mark with Mad Catz's computer accessories bearing the ECLIPSE mark and ECLIPSE & Design mark. These differences indicate that confusion is unlikely.

Applicant's mark is distinguishable from IGT's MIDNIGHT ECLIPSE mark and Bally's CASH ECLIPSE mark. The Examiner argues that the marks "share the same dominant feature, namely, 'ECLIPSE'." (*See, e.g.,* OA, February 27, 2014 at 3.) Contrary to the Examiner's position, Applicant's mark and IGT's MIDNIGHT ECLIPSE mark and Bally's CASH ECLIPSE mark appear and sound differently because of the addition of the word MIDNIGHT to IGT's mark and the addition of the word CASH to Bally's mark. Consumers will focus on the MIDNIGHT portion of IGT's mark and on the CASH portion of Bally's mark because they are first part of the respective marks and because they are distinctive and fanciful words in connection with "gaming machines, namely devices which accept a wager."

Furthermore, IGT sells slot machines to casinos and other gambling institutions. (OAR, August 18, 2014, Ex. Q.) Applicant could not even access Bally's website further other than the main product page because Bally requires a user name and password to log in, suggesting that only casinos and other professional customers are allowed to buy Bally's products. Consumers are likely to encounter IGT's mark and Bally's mark at different locations than they would encounter Applicant's ECLIPSE mark, namely, casinos and other gambling locations. Notably, the gambling industry is regulated such that gaming can only take place in certain states and locations.

The Office has allowed IGT's MIDNIGHT ECLIPSE and Bally's CASH ECLIPSE to coexist on the federal register even though both are used in the gaming industry. This coexistence supports Applicant's positions that MIDNIGHT and CASH are the dominant features of the respective marks, and that ECLIPSE is a very diluted and therefore weak mark.

In sum, Applicant's mark is distinguishable from the Cited Marks based on differences between the appearance, sound, connotation, and commercial impression of the respective marks, as well as the different contexts in which the marks are encountered.

4. Applicant's Goods and the Goods in Registered in Connection with the Cited Marks Are Not Related

The Examiner has consistently suggested that Applicant's and Registrants' goods are identical or highly related (*See, e.g.*, OA, February 27, 2014 at 4-5.) However, the Board has made clear that this is insufficient to find likelihood of confusion. TMEP § 1207.01(a)(i) (there is no likelihood of confusion "if the goods or services in question are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source" .) Applicant has provided evidence sufficient to demonstrate that its and Registrants' goods are marketed in a manner that discourages consumers from identifying them with a single source. (*See, e.g.*, OAR, March 20, 2015, Ex. B.) Applicant's mark ECLIPSE refers to the third film in the immensely popular epic romantic vampire movie franchise *Twilight*. It is not surprising, then, that fans of the *Twilight* Motion Pictures often purchase goods bearing Applicant's mark. Such products are offered through mass market retailers and other affordable channels of commerce. Such fans tend to be female and the movies themselves are rated PG-13. In addition, goods marketed under Applicant's ECLIPSE mark are sometimes sold using imagery from the *Twilight* Motion Pictures. (*Id.*)

Simply put, Registrants' products have no affiliation with the *Twilight* Motion Pictures or Applicant's *Eclipse* film. Because each party's respective goods are "marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source," it is highly unlikely that consumers would confuse Applicant's and Registrants' goods. TMEP § 1207.01(a)(i) (citations omitted).

Finally, Applicant amended its identification of goods to expressly limit all the goods as those "relating to motion pictures and entertainment." In other words, Applicant identified its goods' connection and affiliation to the *Twilight* Motion Pictures and that the goods are marketed that way, thereby further distinguishing the respective products of Applicant and Registrants.

5. Registrants' Customers Exercise Care

The *DuPont* test also considers the conditions under which and the buyers to whom sales are made, i.e. "impulse" buys vs. careful, sophisticated purchasing. *See DuPont*, 476 F.2d at 1361. There is always less likelihood of confusion where goods are purchased after careful consideration. *See Continental Plastic Containers v. Owens Brockway Plastic Products, Inc.*, 141 F.3d 1073, 1080 (Fed. Cir. 1998); *Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 718 (Fed. Cir. 1992) ("([s]ophisticated consumers may be expected to exercise greater care."); *In re Digirad Corp.*, 45 USPQ.2d 1841, 1843 (TTAB 1998).

Customers of Neill Tools' products would exercise a high degree of care because they are looking for magnets for commercial and industrial purposes. Such goods are not purchased on impulse, but instead after careful consideration of a number of factors, including size, weight, magnetic strength, maximum temperature, coercivity, flexibility, durability, price and their ability to resist corrosion. (OAR, August 18, 2014, Ex. H.)

Customers of Fujitsu's goods would exercise a high degree of care because they are seeking in-dash and in-seat DVD players, radios, and navigational units. (OAR, August 18,

2014, Ex. I.) The decision to purchase these products is not made lightly, especially given the relatively high cost of such products. Many customers are also audiophiles and are very concerned about the sound quality of the system that goes into their cars.

Customers of Mr. Marderosian's goods would exercise a high degree of care. Parents, in general, are very cautious about what they expose to their very small children. Those parents who encounter goods bearing Mr. Marderosian's ECLIPSE DOGGY mark would be careful to make sure that such goods meet their child-specific needs and/or will not cause any harm to their children. (OAR, August 18, 2014, Ex. N.)

Customers of Mad Catz's goods would also exercise a high degree of care. Computer peripherals can be expensive products and used for a long time. Consumers who wish to invest in these products are likely to "do their homework" before making a purchase.

Customers of IGT's and Bally's goods would exercise a high degree of care. Casinos and other gambling institutions must follow strict laws and regulations on gambling. Each slot machine in a casino is intended for maximum revenue output. Therefore, those customers of IGT's gaming machines who encounter IGT's MIDNIGHT ECLIPSE mark and those customers of Bally's gaming machines who encounter Bally's CASH ECLIPSE mark will likely study the machines carefully before installing them in their casinos.

6. There is No Evidence the Cited Marks are Famous

The Examiner must also consider the fame of the Cited Marks. "Famous marks are accorded more protection precisely because they are more likely to be remembered and associated in the public mind than a weaker mark." *Recot*, 214 F.3d at 1327. In this case, the Examiner has offered no evidence that any of Registrants' ECLIPSE marks are famous or are likely to be remembered in the public mind, despite repeated opportunities to do so. This is unsurprising considering the weakness of Registrants' ECLIPSE marks in general and the very

fact that the Cited Marks are co-existing with each other. To the contrary, given the high number of ECLIPSE marks already on the federal register, it is likely that the opposite is the case. This further demonstrates that confusion between Applicant's mark and the Cited Marks is unlikely.

C. CONCLUSION

For the reasons stated above, and in all of Applicant's other documents and evidence, Applicant respectfully requests that the Board reverse the decision of the Examiner and allow the mark to proceed to publication. Oral argument is set for February 10, 2016.

Respectfully submitted,

Dated: February 4, 2016

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CERTIFICATE OF E-FILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451, on this 4th day of February, 2016.

/LaTrina A. Martin
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