

**This Opinion is Not a
Precedent of the TTAB**

Hearing: February 10, 2016

Mailed: April 11, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Summit Entertainment, LLC
—

Serial No. 77921983
—

Jill M. Pietrini and Paul Bost of Sheppard Mullin Richter & Hampton LLP,
for Summit Entertainment, LLC.

Priscilla Milton, Trademark Examining Attorney, Law Office 110,
Chris A. F. Pedersen, Managing Attorney.¹

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Before Kuhlke, Taylor and Goodman,
Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Summit Entertainment, LLC (“Applicant”) seeks registration on the Principal Register of the mark ECLIPSE (in standard characters) for goods ultimately identified as:

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

¹ Trademark Examining Attorney Deborah Meiners argued on behalf of the USPTO at oral hearing.

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 International Class 9.²

The Trademark Examining Attorney refused registration of Applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark, when used in connection with the identified goods, so resembles the registered marks shown below, as to be likely to cause confusion, mistake or deception:³

ECLIPSE (in typed form)⁴ for "magnets," in International Class 9;⁵

² Application Serial No. 77921983 was filed on January 28, 2010, under Section 1(b) of the Trademark Act, based upon Applicant's allegation of a *bona fide* intention to use the mark in commerce. The original application included several other goods discussed, *infra*.

³ The Examining Attorney also cited the following registrations that cancelled under Section 8 during prosecution of the application:

 for backpacks especially adapted for holding laptops; backpacks especially adapted for holding laptops and notebook computers; laptop carrying cases; messenger bags especially adapted for holding laptops (Reg. No. 3515398); and

ECLIPSE DOGGY for, *inter alia*, Decorative wind socks; Electronic action toys; Electronic educational game machines for children; Electronic learning toys; (Reg. No. 3544541).

⁴ Prior to November 2, 2003, "standard character" drawings were known as "typed" drawings. A typed mark is the legal equivalent of a standard character mark. TMEP § 807.03(i) (October 2015).

⁵ Registration No. 799454, issued on November 30, 1965, renewed. The registration also includes the following goods that were not cited as a bar to registration "magnetic chucks, magnetic holders, magnetic holdfasts, magnetic bases, magnetic v-blocks, magnetic positioners, magnetic adjustable links, magnetic floaters, [magnetic racks, magnetic door

ECLIPSE (in typed form) for “mobile sound equipment and accessories, namely, am-fm tuners, cassette, cd and speakers, amplifiers and equalizers”;⁶

ECLIPSE for “mobile sound equipment and accessories, namely, am-fm tuners, cassette, cd and dat players, speakers, amplifiers and equalizers”;⁷

SOLAR ECLIPSE (in typed form) for “sunglasses”;⁸

 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”;⁹

ECLIPSE (in standard characters) for “computer keyboards, computer mice; mouse pads; wireless presenter in the nature of a wireless remote pointer”;¹⁰

 for “computer keyboards computer mice; mouse pads; Wireless presenter in the nature of a wireless remote pointer”;¹¹

MIDNIGHT ECLIPSE (in standard characters) for “gaming machines, namely, devices which accept a wager”;¹² and

catches, magnetic quick lifters, magnetic vices and magnetic conveyors,] and all the parts of the aforesaid goods,” in International Class 7. (The bracketed text indicates goods that have been deleted from the registration.)

⁶ Registration No. 1526584, issued on February 8, 1989, renewed.

⁷ Registration No. 1581195, issued on February 6, 1990, renewed.

⁸ Registration No. 2109357, issued on October 28, 1997, renewed.

⁹ Registration No. 3503154, issued on September 16, 2008, Sections 8 and 15 combined declaration accepted and acknowledged.

¹⁰ Registration No. 3986292, issued on June 28, 2011.

¹¹ Registration No. 3986293, issued on June 28, 2011.

¹² Registration No. 4150483, issued on May 29, 2012.

CASH ECLIPSE (in standard characters) for “gaming devices, namely slot machines, with or without video output.”¹³

When the refusal was made final, Applicant appealed, moved to divide the application and requested reconsideration.¹⁴ After the application was divided and the Examining Attorney denied the request for reconsideration, the appeal was resumed. Applicant and the Examining Attorney filed briefs. We affirm in part and reverse in part.

¹³ Registration No. 4202676, issued on September 4, 2012.

¹⁴ The request to divide was granted and Applicant’s child Application Serial No. 77975668 survived publication, without opposition, for:

(Based on Intent to Use) Cases for mobile phones, protective carrying cases for PDAS, cell phones, computer games, decorative charms for cell phones, digital trading cards in the nature of multimedia software recorded on magnetic media featuring films, music and entertainment, video game software, and video game cartridges and discs; disposable cameras, downloadable computer wallpaper software and screen saver software, digital media, namely, downloadable audio files featuring films, music and entertainment and video recordings featuring films, music and entertainment, electric door bells, electronic diaries, headphones and earphones, juke boxes, motion picture films in the fields of drama and romance, musical sound recordings, neon signs, decorative switch plate covers, tape measures, downloadable television programs and documentaries featuring drama, comedy, horror, romance, and variety provided via a global computer network or video-on-demand service, trading cards in the form of CDs, video game software, and video game cartridges and discs; pre-recorded DVDs, videotapes, and other audiovisual recordings, namely, DVDs featuring motion pictures, television programs, and documentaries; and downloadable software that provides access to movie and entertainment-related content and allows users to socialize and interact with other users; (Based on Use in Commerce) digital media, namely, downloadable multimedia files containing images relating to motion pictures, television programs, music and documentaries.”

Likelihood of Confusion

When the question is likelihood of confusion, we analyze the facts as they relate to the relevant factors set out in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See also In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). These factors and others are discussed below. *See M2 Software, Inc. v. M2 Commc'ns, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944 (Fed. Cir. 2006) (even within the *du Pont* list, only factors that are “relevant and of record” need be considered).

As a preliminary matter, we note that generally once likelihood of confusion is found as to one good in an International Class the entire Class fails. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986 (CCPA 1981) (it is sufficient for a finding of likelihood of confusion if relatedness is established for any item encompassed by the identification of goods within a particular class in the application); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1745 (TTAB 2014); *Baseball America Inc. v. Powerplay Sports Ltd.*, 71 USPQ2d 1844, 1847 n.9 (TTAB 2004). However, when a refusal is made specifically to certain goods, the remaining goods are not affected.

In this case, the Examining Attorney refused registration as to specific goods and indicated the application would proceed for the “remaining goods.”¹⁵ Applicant’s subsequent request to divide the application and place the “remaining goods” into a child application was granted on May 13, 2013. While the Examining Attorney did not explicitly state that the refusal to the other goods is directed to the goods individually, her approach, citing a multitude of registrations, each against a particular good in Class 9, and carving out other goods, effectively does just that. In addition, we find it to be an appropriate approach given the multitude of registrations (some cited, some not) with marks that contain the word ECLIPSE for various goods in Class 9 co-existing on the Principal Register, and the vast differences between goods in Class 9 (*e.g.*, magnets, wind socks and slot machines).

In addition, throughout the prosecution and briefing, the Examining Attorney and Applicant have misinterpreted the identification of goods.¹⁶ The original identification in the application reads as follows (emphasis added):

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

¹⁵ See September 22, 2014 Office action p. 1.

¹⁶ At oral hearing Applicant noted that the identification for MP3 players may be interpreted as covers for MP3 and MP4 players, rather than the actual players, as it comes after “covers for cell phones.” In fact, as discussed above, that is the only way it properly may be interpreted.

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

We must interpret an identification of goods as written and, here, the listing for “covers” is set off by a semicolon and all goods following it are divided by commas. The only way to read this identification is that the category of “covers” is created by the preceding semicolon and the items set off by commas within that category define the type of cover. *In re Midwest Gaming & Entertainment LLC*, 106 USPQ2d 1163, 1166 (TTAB 2013). *See also* TMEP § 1402.01(a) (October 2015) (semicolons are used to separate distinct categories of goods or services within a single class and commas are used in the identification to separate items within a particular category of goods or services).¹⁷

The final identification of goods includes the following:

; covers for cell phones, portable and handheld electronic digital devices for playing music, namely, MP3 and MP4 players, laptop computers, personal digital assistants,

¹⁷ By contrast, use of the commas in the beginning of the identification sets off different categories of goods (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 ... mousepads, ... slot machines, sunglasses and sunglass cases,...”). However, once the semicolon is used at the end of the prior list it serves to create a distinct category.

namely, PDAs, and gaming devices, namely, gaming machines,

The identification, as amended, correctly continues to divide “covers” as a separate category of goods and lists the types of covers with further modifying language to clarify, for example, that the covers for a “portable music player” are covers for an “MP3 player.” To interpret it otherwise would be outside the scope of the original identification, which clearly creates a category of “covers.” Trademark Rule 2.71(a), 37 CFR § 2.71(a). *See also* TMEP § § 1402.06(b), 1407 (October 2015).

The Examining Attorney argued that Applicant’s MP3 and MP4 players and gaming machines are related to audio equipment and gaming devices in the cited registrations. However, this argument was based on the apparent misunderstanding that Applicant’s identification included such devices, which it does not. We address the relatedness of goods issue as to these goods **as they are identified, i.e., as various types of “covers,”** *infra*.

We note that the wording “all relating to motion pictures and entertainment” is only separated by a comma within this “covers” category. However, the wording is no longer part of a list of types of covers and the stated intent in Applicant’s request for reconsideration is to restrict all of the goods in the identification by this limiting language.¹⁸ In view thereof, we apply the wording “all relating to motion pictures and entertainment” to all of the goods in the identification.

¹⁸ March 25, 2015, Req. for Recon. p. 2 (“Applicant wishes to divide its application to divide the Approved Goods into a child application to proceed to publication and to keep the Refused Goods in the present parent application for amendment and reconsideration by the Examining Attorney. ... Applicant has amended the identification of the remaining goods to restrict them to those relating to motion pictures and entertainment.”)

Applicant is the producer and distributor behind the Twilight motion picture franchise and ECLIPSE refers to the third film in the Twilight saga. 8 TTABVUE 11.¹⁹ Applicant has obtained several registrations for the mark ECLIPSE for various goods (cosmetics, action figures, cloth bags, pillows and bandages for skin wounds) and for “licensing of merchandise associated with motion pictures.”²⁰ It is, of course, common practice for companies to use the title of a film on various merchandising goods. *L.C. Licensing Inc. v. Berman*, 86 USPQ2d 1883, 1889 (TTAB 2008) (the licensing of commercial trademarks on “collateral products” has become a part of everyday life). The USPTO routinely registers such marks even if the use is ornamental because it serves as collateral use or secondary source. *In re Paramount Pictures Corp.*, 213 USPQ 1111, 1112 (TTAB 1982) (MORK & MINDY registrable for decals and primary significance was to indicate television series). *See also* TMEP § 1202.03(c) (October 2015).

In making our determination, we first consider three issues highlighted by Applicant: (1) what effect, if any, does the addition of the wording “all relating to motion pictures and entertainment” to Applicant’s identification of goods have on the likelihood of confusion equation in this case; (2) do the relevant consumers exercise care in purchasing the various goods; and (3) how narrow is the scope of protection for the ECLIPSE marks for the various goods in Class 9.

¹⁹ Citations to TTABVUE refer to the docket history system for the Trademark Trial and Appeal Board by entry and page number.

²⁰ August 21, 2014 Response, pp. 219-227.

Effect of Wording “all relating to motion pictures and entertainment”

Applicant argues that:

[Its goods are] marketed through mass market retailers and other affordable channels of commerce [and] [g]oods 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. ... 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.”

App. Br., 8 TTABVUE 28 (emphasis in original).

While this may serve to restrict Applicant to selling only products that relate to motion pictures and entertainment, the Registrants’ various identifications have no restrictions and we must consider all *ordinary* channels of trade for the respective goods, not the Registrants’ *actual* channels of trade. The question would be, do the ordinary channels of trade for the various cited goods include goods sold in relation to motion pictures and entertainment? If they do, then Applicant’s “restriction” does not obviate the refusal.

Applicant has stated that its channels of trade are “mass market retailers and other affordable channels of commerce.” *Id.* These channels are certainly included in the ordinary channels of trade for the various cited goods. Applicant licenses use of its mark ECLIPSE for use on various goods, which could include the cited goods. The Registrants are the types of companies that could license such use on the various goods. The “all relating to” language does not eliminate the Registrants’ goods which, without restrictions, would presumptively include marketing their goods relating to motion pictures and entertainment. Thus, “we do not see the language as imposing a

meaningful limitation on Applicant's goods in any fashion, most especially with respect to either trade channels or class of purchasers.” *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1410 (TTAB 2015).

Applicant argues this language limits the nature of the goods in the sense that consumers purchasing Applicant’s goods “do so because they relate to the Twilight Motion Pictures.” App. Br., 8 TTABVUE 35. However, if the marks are identical and the goods, as identified, are identical and are a type of good that could be sold in relation to a motion picture, we must consider the nature of the goods to be the same.

Moreover, the “relating to” language in Applicant’s identification of goods does not avoid reverse confusion where a Registrant’s identification is not limited by channels of trade or classes of purchasers. As just stated, if the marks are identical and the goods, as identified, are identical and are a type of good that could be sold in relation to a motion picture, we must consider the nature of the goods to be the same. Despite any motion picture connection that may be claimed by Applicant, the statute still “protects the registrant and senior user from adverse commercial impact due to use of a similar mark by a newcomer.” *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). As the Federal Circuit stated:

The term “reverse confusion” has been used to describe the situation where a significantly larger or prominent newcomer “saturates the market” with a trademark that is confusingly similar to that of a smaller, senior registrant for related goods or services. *Sands, Taylor & Wood Co. v. Quaker Oats Co.*, 978 F.2d 947, 957 & n.12, 24 USPQ2d 1001, 1010 & n.12 (7th Cir. 1992), cert. denied, 61 U.S.L.W. 3621 (U.S. Apr. 19, 1993) (No. 92-1400). The junior user does not seek to benefit from the goodwill of the senior user; however, the senior user may experience diminution or

even loss of its mark's identity and goodwill due to extensive use of a confusingly similar mark by the junior user. *Banff, Ltd. v. Federated Department Stores, Inc.*, 841 F.2d 486, 490, 6 USPQ2d 1187, 1191 (2d Cir. 1988); *Ameritech, Inc. v. American Information Technologies Corp.*, 811 F.2d 960, 966, 1 USPQ2d 1861, 1866 (6th Cir. 1987).

The avoidance of confusion between users of disparate size is not a new concept; however, the weighing of the relevant factors must take into account the confusion that may flow from extensive promotion of a similar or identical mark by a junior user. *See DeCosta v. Viacom International Inc.*, 981 F.2d 602, 607-10, 25 USPQ2d 1187, 1191-93 (1st Cir. 1992).

Thus, because of the presumptions we must accord the cited registrations, the unilateral restrictions “essentially [are] a distinction without a difference for purposes of our likelihood of confusion analysis.” *In re i.am.symbolic, llc*, 116 USPQ2d at 1410.

Applicant argues that the goods are “often sold using imagery from the Twilight Motion Pictures.” However, the phrase “all relating to motion pictures and entertainment” does not require such specific limitation and the argument recognizes the option of marketing without such imagery by using the word “often.”

Applicant argues that because its goods are used in connection with motion pictures and entertainment and the Applicant is the producer and distributor behind the Twilight saga motion pictures, this presents a different context and as such a different meaning and commercial impression of its mark in contrast to the cited marks. Similar to the trade channels issue, the Registrants' marks do not exclude use

in relation to a movie and, accordingly, the meaning and commercial impressions of the cited marks could include such context.²¹

Applicant also points to what it is (movie producer) and what the Registrants are (magnetics company, consumer electronics company, sunglass manufacturer, gaming and computer accessory electronics company, manufacturer of gambling devices, seller of slot machines to casinos) essentially arguing that who owns the respective marks should impact how we view the similarity or dissimilarity of the marks (and the goods) based on context derived from ownership of the respective registrations.

First, several of these types of companies could be potential licensees of a company like Applicant. Second, these arguments are more directed to an infringement claim drawing upon real world use of the marks, but our inquiry is confined to the register. It is possible to have the register reflect more accurately the real world facts on the

²¹ We note that Applicant stresses the renown of its mark in connection with a movie. To the extent this has an impact in the determination, it would serve to increase likelihood of confusion by making it more likely that purchasers will remember the famous mark and think of it when encountering similar goods sold under a similar mark. Such likelihood of confusion is only a reason to refuse a new registration, not grant one. To the extent that the mark is well known, such fact supports refusal of Applicant's application, "because when confusion is likely, it is the prior Registrant that must prevail. Even if it eclipses the renown of the prior Registrant, Applicant's fame does not entitle it to usurp the cited Registrant's rights in the mark." *In re i.am.symbolic*, 116 USPQ2d at 1413 n.7.

Further as explained in *In re i.am.symbolic*, "[t]he purported lack of fame of Registrant's mark, as argued by Applicant, is of little consequence. See TMEP § 1207.01(d)(ix). Because of the nature of the evidence required to establish the fame of a registered mark, the Board normally does not expect the Examining Attorney to submit evidence as to the fame of the cited mark in an *ex parte* proceeding. See *In re Thomas*, 79 USPQ2d 1021, 1027 n.11 (TTAB 2006). And, in an *ex parte* analysis of the du Pont factors for determining likelihood of confusion, the "fame of the mark" factor is normally treated as neutral when no evidence as to fame has been provided. See *id.*; see also *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1204 (TTAB 2009) (noting that the absence of evidence as to the fame of the registered mark "is not particularly significant in the context of an *ex parte* proceeding")." *Id.* at 1413.

ground as Applicant seeks to do with its addition of the wording “all related to motion pictures and entertainment”; however to achieve the full picture, in particular where there are no differences in the marks, Applicant would have to seek to restrict the cited registrations to their respective trade channels through a petition for partial cancellation.²²

Sophistication of Purchasers

Applicant argues that the potential purchasers of the Registrants’ goods would exercise a high degree of care. Again, Applicant’s arguments impermissibly narrow the unrestricted identifications in the cited registrations which are not limited by, for example, price point, and there is nothing inherent in the identification of, e.g., “magnets” which would limit the price point of all of the goods sold in the ordinary channels of trade for magnets which would include mass retailers. In our analysis, we must consider all potential customers, including the less sophisticated. *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 765 (TTAB 1986) (average ordinary wine consumer must be looked at in considering source confusion). There is nothing in the record that purchasers of the applied-for goods, including mouse pads and magnets, in retail stores exercise more than the usual care taken in purchasing such items, and such items can be subject to impulse purchasing. However, even if we were to assume that purchasers of Registrants’ various goods are discriminating, it is settled that even sophisticated purchasers are not immune from source confusion, especially

²² See Section 18 of the Trademark Act, 15 U.S.C. § 1068. See also TBMP § 309.03(d) (2015) and cases cited therein.

where the marks and goods are identical. *See In re Research Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986) (citing *Carlisle Chemical Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970) (“Human memories even of discriminating purchasers ... are not infallible.”)). *See also In re Shell Oil Co.*, 26 USPQ2d at 1690; *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988). The identity of the marks and the relatedness of the goods sold thereunder outweigh any presumed sophisticated purchasing decision. *See HRL Associates, Inc. v. Weiss Associates, Inc.*, 12 USPQ2d 1819 (TTAB 1989), *aff'd*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990) (similarities of goods and marks outweigh sophisticated purchasers, careful purchasing decision, and expensive goods). *See also Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162-63 (Fed. Cir. 2014).

Strength/Weakness of the ECLIPSE Marks

Applicant argues that the term ECLIPSE is widely used as a mark for various goods in relevant industries encompassing Applicant’s various goods in Class 9. The record establishes the weakness of this mark for all of Applicant’s identified goods and we apply a very narrow scope of protection in our determination. Because there are so many ECLIPSE marks in Class 9 and several in the relevant fields (*e.g.*, computer accessories, glasses), any addition to the marks, including differences in meaning and commercial impression based on the context of Applicant’s goods, is

sufficient to obviate likely confusion. We particularly note that the record includes over 70 third-party registrations in the electronics industry including:²³

ECLIPSE for microfilm and microfiche, scanners (Reg. No. 2800500);²⁴

ECLIPSEX for computer software programs for operating informational displays (Reg. No. 2957083);²⁵

ECLIPSEPLUS for computer software for managing, tracking, scheduling and deploying advertising and commercials; computer software for billing advertisers and for planning advertising sales (Reg. No. 3767129);²⁶

ECLIPSE for building access control system for personnel comprised of personnel identification cards and recognition devices, data entry pads and biometric recognition devices,

²³ In *Juice Generation, Inc. v. GS Enterprises LLC*, 794 F.3d 1334, 115 USPQ2d 1671 (Fed. Cir. 2015) the Court found third-party registrations “in the food service industry” which included goods (various food items) and services (restaurants, cafes, bars) to be relevant to the question of weakness of a mark for restaurant services. In this case, where there are over 100 live registrations in Class 9 for marks with the word ECLIPSE along with the third-party registrations referenced by the Examining Attorney to show the relatedness of goods, it is clear goods in this Class can inhabit a broad category. *See, e.g.*, Reg. No. 4640039 for audio recorders, cases for mobile phones, computer hardware and computer peripherals, computer keyboards, laptop carrying cases, MP3 players; Reg. No. 4621038 for cell phone cases, cell phone covers, computer keyboards, computer mouse, mouse pads; and Reg. No. 4032679 for sunglasses, carrying case for cell phones, headphones, etc. June 15, 2015 Denial Req. for Recon., pp. 120, 179, 132. In view thereof, we find it appropriate to define the relevant industries broadly for the respective goods.

We further note, that despite these third-party registrations seemingly pointing to a relationship between, for example, sunglasses and cell phone covers, and the existence of third-party registrations for a variety of cameras, Applicant’s ECLIPSE mark was approved for “cases for mobile phones” and “disposable cameras” in the child application over the ECLIPSE registrations for various electronic items, sunglasses and cameras, which indicates the Office recognizes the narrow scope of protection to be accorded the ECLIPSE marks in these goods categories.

²⁴ August 21, 2014 Response, p. 72.

²⁵ *Id.* at 73.

²⁶ *Id.* at 77.

electronic data processors, alarm devices and door locks (Reg. No. 3808558);²⁷

ECLIPSE for infrared and thermal imaging cameras and accessories therefor, namely, video transmitting devices, digital cameras, digital video recorders, glare reduction shields, retractable attachment straps, shoulder straps, monocular eyepieces, extendable camera booms, camera tripods, and receiving and transmitting antennae; all for use in the field of firefighting operations (Reg. No. 3854539);²⁸

DRI ECLIPSE for bed-wetting treatment alarm (Reg. No. 3887344)²⁹

ECLIPSE for computer software for improving performance of micro-lithographic processes (Reg. No. 3922222);³⁰

ECLIPSE for jeweler's magnifying glasses with lights for examining diamonds and other precious gemstones (Reg. No. 4007223);³¹

ECLIPSE for cytometers (Reg. No. 4013645);³²

SOLAR ECLIPSE for remote video monitoring system consisting primarily of a camera and video monitor for recording and transmitting images to a remote location (Reg. No. 4357374);³³

ECLIPSAIR for apparatus, namely, electronic instruments for the operation of audio-visual WLAN infotainment systems in aircrafts; apparatus, namely, electronic

²⁷ *Id.* at 79.

²⁸ *Id.* at 80.

²⁹ *Id.* at 82.

³⁰ *Id.* at 83.

³¹ *Id.* at 86.

³² *Id.* at 87.

³³ *Id.* at 93.

instruments for in-flight communication in aircrafts (Reg. No. 4438238);³⁴



for computer software for use by physicians and other healthcare practitioners and healthcare providers for office management (Reg. No. 3134758);³⁵

ECLIPSE for electrical voice intracomunications systems for use in the production of live musical performances, theatre, and other live events, namely, electrical voice intracomunications systems comprising control station, interface modules, frames, controller cards, connectors, power supplies, panels and mountings, software for operation of the foregoing, and user manuals sold as a package therewith (Reg. No. 3315056);³⁶



for security products, namely surveillance cameras, camera mounting brackets, camera housing, quads, switchers, multiplexors, monitors, and digital video recorders (Reg. No. 3316904);³⁷

ECLIPSE iLM for software for managing databases (Reg. No. 3478560);³⁸

ECLIPSE for wireless communications systems, namely, digital modems, multiplexers, microwave radio transmitters and receivers, antennas, and related operating firmware, all sold separately, or as a unit used together to interconnect stations in mobile networks or provide local access to telecommunications systems for

³⁴ *Id.* at 94.

³⁵ *Id.* at 101.

³⁶ *Id.* at 102.

³⁷ *Id.* at 103.

³⁸ *Id.* at 106.

voice and/or data services, and manuals sold as a unit (Reg. No. 3737252);³⁹

ECLIPSE for microscopes and parts therefor (Reg. No. 2092155);⁴⁰



for apparatus for recording, transmission or reproduction of images, namely, machine readable media cartridges; data processing equipment; recorded media, namely, DVDs featuring graphical data in the field of personal crafting and child education; computer software for use in authoring, downloading, transmitting, receiving, editing, extracting, encoding, decoding, playing, storing and organizing graphical data in the field of personal crafting and child education; structural parts and structural fittings for all the aforesaid goods (Reg. No. 4080586);⁴¹ and

ECLIPS for apparatus for recording, transmission or reproduction of images, namely, machine readable media cartridges; data processing equipment; recorded media, namely, DVDs featuring graphical data in the field of personal crafting and child education; computer software for use in authoring, downloading, transmitting, receiving, editing, extracting, encoding, decoding, playing, storing and organizing graphical data in the field of personal crafting and child education; structural parts and structural fittings for all the aforesaid goods (Reg. No. 4080585).⁴²

Other third-party registrations in the different fields covered by Class 9 relevant to Applicant's identified goods include:

³⁹ *Id.* at 119.

⁴⁰ *Id.* at 133.

⁴¹ This registration was initially cited against this application but was withdrawn during prosecution.

⁴² This registration was initially cited against this application but was withdrawn during prosecution.

ECLIPSE SHADES for protective eyewear to view solar events (Reg. No. 3094455);⁴³

ECLIPSE for contact lens (Reg. No. 1670064);⁴⁴

ECLIPSE for safety spectacles (Reg. No. 1808360);⁴⁵ and

SOLAR ECLIPSE for sunglasses (Reg. No. 2109357).⁴⁶

The Examining Attorney argues that third-party registrations support that several of these goods are related. *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993). While that may be so, given the weakness of ECLIPSE in the relevant fields, we only hold on the refusals where the marks are identical without any other matter to serve to distinguish them and the goods are identical. We address the refusals based on the groupings made by the Examining Attorney.

1. Decorative magnets sold in sheets ... Magnets

The registration cited against Applicant's decorative magnets sold in sheets and magnets is:

Reg. No. 799454 ECLIPSE (in typed form) for "magnets."

Applicant's mark ECLIPSE (in standard characters) is identical to Registrant's mark ECLIPSE (in typed form). Applicant's "magnets" are identical to Registrant's "magnets" and its "decorative magnets sold in sheets" are legally identical as they are

⁴³ *Id.* at 100. This registration was initially cited against this application but was withdrawn during prosecution.

⁴⁴ *Id.* at 122.

⁴⁵ *Id.* at 125.

⁴⁶ *Id.* at 135. This registration is cited against the sunglasses, eyeglasses and cases therefor.

encompassed by Registrant's broad and unlimited identification "magnets." Even assuming the wording "all relating to motion pictures and entertainment" in Applicant's mark serves to limit Applicant's goods, there are no such limitations in Registrant's identification and it encompasses magnets sold "relating to motion pictures and entertainment." Under such circumstances, we must presume the goods travel in the same channels of trade and are offered to the same classes of consumers. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012).

Applicant's arguments and evidence regarding Registrant's actual use are unavailing because they impermissibly narrow the scope of the registration by extrinsic evidence. It is well-established that the question of likelihood of confusion must be determined on the basis of an analysis of the mark as applied to the goods and/or services recited in an applicant's application vis-à-vis the goods and/or services recited in the cited registration, rather than what the evidence shows the goods and/or services to be. *In re Total Quality Group Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999). *Accord*, *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). In view thereof, the refusal is affirmed as to "decorative magnets sold in sheets" and "magnets."

2. Backpacks adapted for holding computers, laptop carrying cases, mousepads, computer storage devices, namely, flash drives; covers for ... laptop computers⁴⁷

⁴⁷ The Examining Attorney included "laptop computers" in this grouping but as explained *supra* "laptop computers" are not part of the identification only "covers for ... laptop computers" are part of the identification.

The registrations owned by the same registrant cited against Applicant's backpacks adapted for holding computers, laptop carrying cases, mousepads, computer storage devices, namely, flash drives, and covers for laptop computers, are:

Reg. No. 3986292 for the mark ECLIPSE (in standard characters) for "computer keyboards; computer game joysticks; computer mice; mouse pads; wireless presenter in the nature of a wireless remote pointer"; and

Reg. No. 3986293 for the mark  for "computer keyboards; computer game joysticks; computer mice; mouse pads; wireless presenter in the nature of a wireless remote pointer."

Registrant's mark ECLIPSE (in standard characters)⁴⁸ is identical to Applicant's mark ECLIPSE (in standard characters). Applicant's "mousepads" (or "mousepads ... relating to motion pictures and entertainment") are identical to or encompassed by Registrant's unlimited identification "Mouse pads" and are presumed to travel in the same channels of trade and be offered to the same classes of consumers. *Viterra*, 101 USPQ2d at 1908. In view thereof, the refusal is affirmed as to "mousepads."

However, given the narrow scope of protection to be accorded ECLIPSE marks in the electronic field, we find Applicant's "backpacks adapted for holding computers, laptop carrying cases, computer storage devices, namely, flash drives; covers for ... laptop computers" sufficiently different from Registrant's "computer keyboards; computer mice; mouse pads; wireless presenter in the nature of a wireless remote pointer" to avoid likelihood of confusion.

⁴⁸ We only consider the registration for the standard character mark as it is closer than Registrant's design mark .

In this regard, we observe that the Examining Attorney originally cited Registration No. 3515398 for “backpacks especially adapted for holding laptops; backpacks especially adapted for holding laptops and notebook computers; laptop carrying cases; messenger bags especially adapted for holding laptops” against Applicant’s “backpacks adapted for holding computers, laptop carrying cases”; however, after that registration cancelled,⁴⁹ the Examining Attorney lumped these goods in with the goods barred by the “mouse pads” registrations.

The refusal is reversed as to “backpacks adapted for holding computers, laptop carrying cases, computer storage devices, namely, flash drives, and covers for laptops.”

3. Covers for ... portable and handheld electronic digital devices for playing music, namely, MP3 and MP4 players

The registrations, owned by the same entity, cited against Applicant’s covers for the MP3 and MP4 players are:

Reg. No. 1526584 ECLIPSE (in typed form) for “mobile sound equipment and accessories, namely, am-fm tuners, cassette, cd and speakers, amplifiers and equalizers”;

Reg. No. 1581185 **ECLIPSE** for “mobile sound equipment and accessories, namely, am-fm tuners, cassette, cd and dat players, speakers, amplifiers and equalizers”; and

Reg. No. 3503154  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

⁴⁹ This registration co-existed under different ownership with the two cited registrations.

players; navigation apparatus for automobiles in the nature of on-board computers.”

As noted above, Applicant’s goods are *covers* for MP3 and MP4 players. The record does not support a finding that such covers are sufficiently related to Registrant’s goods in this case and the USPTO has already approved Applicant’s mark for mobile phone covers. In view thereof, the refusal is reversed as to “covers for portable and handheld electronic digital devices for playing music, namely, MP3 and MP4 players.”

4. Eyeglasses and eyeglass cases, sunglasses and sunglass cases

The registration cited against Applicant’s eyeglasses and eyeglass cases, sunglasses and sunglass cases is:

Reg. No. 2109357 SOLAR ECLIPSE (in typed form) for “sunglasses.”

The record includes the following third-party registrations for eyewear:

ECLIPSE SHADES for protective eyewear to view solar events (Reg. No. 3094455);⁵⁰

ECLIPSE for contact lens (Reg. No. 1670064);⁵¹ and

ECLIPSE for safety spectacles (Reg. No. 1808360).⁵²

In addition, we take judicial notice of the definition for the word ECLIPSE as “any obscuration of light.”⁵³ The definition of ECLIPSE further supported by the third-

⁵⁰ August 21, 2014 Response p. 100. This registration was originally cited but withdrawn during prosecution.

⁵¹ *Id.* at 122.

⁵² *Id.* at 125.

⁵³ Dictionary.com based on the RANDOM HOUSE DICTIONARY (2016) (www.dictionary.com). *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff’d*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983) (the Board may take judicial notice of dictionary definitions). *See also In re Driven Innovations, Inc.*, 115 USPQ2d 1261, 1266 n.18

party registrations indicate this term has a suggestive connotation used in connection with eyewear, in particular sunglasses, namely, that light is obscured. We further note the record suggests some of the ECLIPSE registrations for electronic accessories have some relevance to the weakness of this term. *See* Reg. No. 4032670, for the mark EXPERIMENT WITH NATURE for, *inter alia*, cases for spectacles and sunglasses; eyeglasses; sunglasses; audio headphones; carrying cases for cell phones; cases for mobile phones; and earphones and headphones.⁵⁴ Although the marks may share the same suggestive connotation of obscuring light, in view of the weakness of the term ECLIPSE in this field, the addition of SOLAR to Registrant's mark is sufficient to distinguish these marks. The refusal as to eyeglasses and eyeglass cases, sunglasses and sunglass cases is reversed.

5. Slot machines and covers for ... gaming devices, namely, gaming machines

The registrations, owned by different entities, cited against Applicant's slot machines and covers for gaming devices, namely, gaming machines are:

Reg. No. 4150483 MIDNIGHT ECLIPSE (in standard characters) for "gaming machines, namely, devices which accept a wager"; and

Reg. No. 4202676 CASH ECLIPSE (in standard characters) for "gaming devices, namely slot machines, with or without video output."

As noted above Applicant's goods are "covers for ... gaming devices, namely, gaming machines." The record does not support a finding that such covers are related

(TTAB 2015); *In re Petroglyph Games Inc.*, 91 USPQ2d 1332, 1334 n.1 (TTAB 2009); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006).

⁵⁴ June 15, 2015 Denial Req. for Recon., pp. 120-122.

to Registrants' goods, and the refusal is reversed as to covers for gaming devices, namely, gaming machines.

Further, we find the additional wording in the Registrants' marks, co-existing with different owners, to be sufficient to distinguish them from Applicant's mark, in particular, CASH ECLIPSE which clearly would not share the movie connotation with Applicant's mark.

The refusal is reversed as to "slot machines" and "covers for gaming devices, namely, gaming machines."

6. Decorative wind socks for indicating wind direction and intensity

The registration cited against these goods has been cancelled and is no longer a bar to the registration. No other cited registration has similar or related goods on their face and there is no evidence to support a finding that these goods are related to any of the goods in the remaining cited registrations. The refusal is reversed as to "decorative wind socks for indicating wind direction and intensity."

7. Camera cases, covers for cell phones and personal digital assistants, namely PDAs

The Examining Attorney did not specifically address these goods. None of the cited registrations contain these goods or serve as a bar to these goods.⁵⁵ The refusal is reversed as to "camera cases," and "covers for cell phones and personal digital assistants, namely PDAs."

⁵⁵ As previously noted the USPTO allowed Applicant's child application for cases for mobile phones, protective carrying cases for PDAs, cell phones, computer games, headphones and earphones.

Decision: The refusal to register Applicant's mark is **affirmed** as to **decorative magnets sold in sheets, magnets, mousepads,** and **reversed** as to **backpacks adapted for holding computers, camera cases, decorative wind socks for indicating wind direction and intensity, eyeglasses and eyeglass cases, laptop carrying cases, slot machines, sunglasses and sunglass cases, computer storage devices, namely, flash drives; covers for 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.** The decorative magnets sold in sheets, magnets, and mousepads will be deleted from the application and it will proceed to publication.