

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 REQUEST FOR
ORAL ARGUMENT**

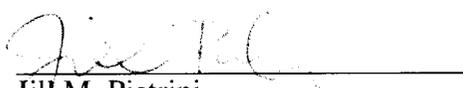
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Dear Commissioner:

Pursuant to 37 C.F.R. § 2.129(a) and TBMP § 802, Applicant Summit Entertainment, LLC hereby respectfully requests oral argument for this appeal.

Respectfully submitted,

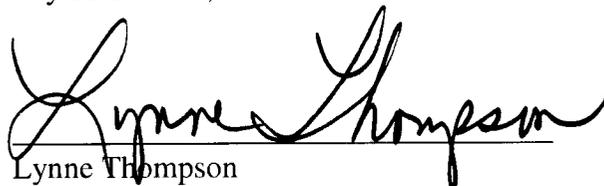
Dated: October 5, 2015



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CERTIFICATE OF MAILING

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 5th day of October, 2015.


Lynne Thompson

SMRH:473310614.1



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APPLICANT'S APPEAL BRIEF

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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) 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 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).

A. PRELIMINARY STATEMENT

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, 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, March 20, 2015, Ex. B.)

Registrant Neill Tools is a UK-based magnet manufacturer. (Office Action Response, 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 (Office Action Response, 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.)

Despite this background, the Examiner refused registration of Applicant’s ECLIPSE mark on the ground that it is likely to be confused with the Cited Marks. 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.

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. The Board should reverse the Examiner’s refusal to register Applicant’s ECLIPSE mark in Class 9 and allow the present application to proceed to publication.

B. STATEMENT OF FACTS

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

1. Information About The Parties

As explained above, Applicant is the well-known producer and distributor behind the enormously successful *Twilight* Motion Pictures. (Office Action Response, August 18, 2014 at 8.)

In contrast, Registrant Neill Tools is a UK-based magnet manufacturer. (Office Action Response, 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 (Office Action Response, 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 refusing registration of Applicant's ECLIPSE mark on the ground that it was likely to be confused with the following ten registrations:

- U.S. Registration No. 799,454 for ECLIPSE for “magnets” in Class 9 owned by Neill 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;
- 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. 1,827,339 for

eclips

for “clip-on sunglasses” in Class 9 owned by David E. Salk dba Focal Point Opticians (“Focal Point”);

- U.S. Registration No. 2,109,357 for SOLAR ECLIPSE for “sunglasses” in Class 9 owned by LEC;
- U.S. Registration No. 3,026,454 for

Eclipz

for “headphones” in Class 9 owned by Thomson;

- U.S. Registration No. 3,094,455 for ECLIPSE SHADES for “protective eyewear to view solar events” in Class 9 owned by Rainbow Symphony, Inc. (“Rainbow”);
- U.S. Registration No. 3,503,154 for



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. 3,515,398 for



for “Apparatus for converting electronic radiation to electrical energy, namely, photovoltaic solar modules; backpacks especially adapted for holding laptops; backpacks especially adapted for holding laptops and notebook computers; batteries and battery chargers; battery chargers; cell phone battery chargers; laptop carrying cases; messenger bags especially adapted for holding laptops; solar recharging battery pack for digital cameras; wheeled backpacks especially adapted for holding laptops; wheeled messenger bags especially adapted for holding laptops; solar batteries; solar cells” in Class 9 owned by Innovus Designs Inc. dba Eclipse Solar Gear (“Innovus”); and

- 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 Marderosian.

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 No. 77/708,443 for MIDNIGHT ECLIPSE for “gaming machines, namely, devices which accept a wager” in Class 9 owned by IGT;
- Application Serial No. 77/731,919 for CASH ECLIPSE for “gaming devices, namely, slot machines, with or without video output” in Class 9 owned by Bally.;
- Application Serial No. 77/763,490 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;
- Application Serial No. 77/763,499 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;

- Application Serial No. 77/882,752 for TOTAL ECLIPSE for “gaming machines, namely, electronic slot and bingo machines” in Class 9 owned by Eclipse Gaming Systems, LLC (“Eclipse Gaming”);
- Application Serial No. 77/913,990 for 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; computer software for use in authoring, downloading, transmitting, receiving, editing, extracting, encoding, decoding, playing, storing and organizing graphical data; measuring apparatus and instruments namely, graduated rulers; structural parts and structural fittings for all the aforesaid goods” in Class 9 owned by Ellison Educational Equipment, Inc. (“Ellison”); and
- Application Serial No. 77/914,002 for



for “apparatus for recording, transmission or reproduction of images, namely, machine readable media cartridges; data processing equipment; recorded media, namely, DVDs featuring graphical data; computer software for use in authoring, downloading, transmitting, receiving, editing, extracting, encoding, decoding, playing, storing and organizing graphical data; measuring apparatus and instruments namely, graduated rulers; structural parts and structural fittings for all the aforesaid goods” in Class 9 owned by Ellison.

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. (Office Action Response, 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 Registration No. 4,150,483.

Application Serial No. 77/731,919 for CASH ECLIPSE owned by Bally matured into Registration No. 4,202,676.

Application Serial No. 77/763,490 for ECLIPSE owned by Mad Catz matured into Registration No. 3,986,292.

Application Serial No. 77/763,499 for ECLIPSE & Design owned by Mad Catz matured into Registration No. 3,986,293.

Application Serial No. 77/913,990 for ECLIPS owned by Ellison matured into Registration No. 4,080,585.

Application Serial No. 77/914,002 for ECLIPS & Design owned by Ellison matured into Registration 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 Registration 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. Registration 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 (Office Action, February 27, 2014 at 1.)

Applicant filed its response to the second Office Action on August 18, 2014 arguing that Applicant's mark was distinguishable from the Cited Marks. (Office Action Response, August 14, 2014.) Applicant pointed out the weakness of the Cited Marks, the significant dissimilarities in the connotation and commercial impressions between Applicant's mark and the Cited Marks

¹ The Examiner withdrew the refusal to register based on Registration 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.

as well as the different contexts in which the marks are encountered, the differences between the goods offered under the respective marks, the differences in the purchasing conditions, the sophistication of Registrants' consumers, and the lack of fame of the Cited Marks.

On September 22, 2014, the Examiner issued a final Office Action withdrawing the refusal to register based on Registration Nos. 4,080,585 and 4,080,586, but refusing registration of Applicant's mark on likelihood of confusion grounds based on Registration 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. (Office Action, 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 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. (Office Action, September 14, 2014 at 5.) The Examiner maintained her position that Applicant's mark and the Cited Marks were highly similar and that Applicant's goods and Registrants' goods were related. (*Id.* at 2-4.) The Examiner also disregarded Applicant's allegations concerning the weakness of the Cited Marks and the sophistication of the relevant consumers. (*Id.* at 3.) The Examiner stated that Applicant must respond to the final Office Action or the Refused Goods would be deleted from the application and the application would proceed for the remaining goods. (*Id.* at 5.)

Applicant responded to the Examiner's September 22, 2014 final refusal by filing a Request for Reconsideration on March 20, 2015. (Request for Reconsideration, March 20, 2015.) In the Request for Reconsideration, Applicant requested amendment of the identification of goods to:

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.

Applicant pointed out the Examiner's disregard for the weakness of the Cited Marks, which Applicant noted as a very important element in determining likelihood of confusion. (*Id.* at 6-7.) Applicant also explained again why the connotations and commercial impressions of Applicant's mark and the Cited Marks are dissimilar. (*Id.* at 8-12.)

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, namely, 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; digital media, namely, downloadable multimedia files containing images relating to motion pictures, television programs, music and documentaries. (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 Registration 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 Registration 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.

C. **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. As explained below, 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 nine 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

Reg. No.	Mark	Class and Goods/Services
		decorations, pencil cases, pencils, pens, postcards, posters, sheet music, songbooks, stationery, stickers, and trading cards; kits containing party supplies, namely, paper napkins, plastic 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

(Office Action Response, 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. (Request for 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. (Office Action Response, 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. *Keebler Co. v. Associated Biscuits, Ltd.*, 207 USPQ 1034, 1038 (TTAB 1980) (citing the plethora of marks registered by the PTO 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.’”); *see also First Sav. Bank, F.S.B. v. First Bank Sys.*, 101 F.3d 645, 653-54 (10th Cir. 1996) (“The 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.”); *King Candy Co. v. Eunice King’s Kitchen, Inc.*, 182 USPQ 108, 109-10 (CCPA 1974); *General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 626 (8th Cir. 1987).

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 titled 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. (Office Action, September 22, 2014 at 3, original emphasis.) First, the Examiner’s attempt to characterize Applicant’s goods as different from Registrants’ goods are without merit. The fact remains that 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). In *Top Tobacco*, the applicant submitted several third-party registrations for marks incorporating the term "Classic" in connection with tobacco products to show weakness of the opposer's asserted mark CLASSIC CANADIAN for tobacco. The Board found that opposer's mark was entitled to only a narrow scope of protection, and that use of the term "Classic" in competing marks would be a weak basis for asserting likelihood of confusion:

The fact that the USPTO has allowed so many registrations for the tobacco-related goods containing a shared term to co-exist on the Principal register may be used "to establish that [the] portion common to the marks involved in a proceeding has a normally understood and well-known meaning [and] that this

has been recognized by the [USPTO]...; and that therefore the inclusion of [the shared term] in each mark may be an insufficient basis on which to predicate a holding of confusing similarity.”

Top Tobacco, 101 USPQ.2d at 1173 (quoting *Red Carpet Corp. v. Johnstown American Enterprises Inc.*, 7 USPQ.2d 1404, 1406 (TTAB 1988)).

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.” The same result should be reached here.

3. The Marks are Distinguishable in Appearance, Sound, Connotation and Commercial Impression and the Different Contexts in Which the Marks are Encountered

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 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. (Office Action Response, 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. (Request for 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.

This is yet one more factor that weighs against any likelihood of confusion.

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 ECLIPSE is dissimilar from the Cited Marks in all respects.

(1) Applicant's Mark is Distinguishable From Neill Tools' ECLIPSE mark in U.S. Registration No. 799,454 in Light of the Different Contexts in Which Both Marks Are Encountered

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. Further supporting this result is the fact that Neill Tools' mark is extremely weak as explained above, and that both marks are encountered in entirely different contexts.

Applicant's mark and Neill Tools' mark are distinguishable in light of the different contexts in which they are encountered. *See 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) (discussing identical BOTTOMS UP marks, "[b]ut more important, and especially in this case is the nature of the marks and the commercial impression that they project in connection with the respective goods").

As previously stated, Applicant is the producer and distributor behind the enormously successful *Twilight* Motion Pictures and its use of its ECLIPSE mark therefore refers to the third of these films. In contrast, Neill Tools, doing business as Eclipse Magnetics, is a UK-based company that purports to manufacture over 20,000 different products related to magnetics. (Office Action Response, August 18, 2014, Ex. H.)

Consistent with this distinction, consumers are likely to encounter Neill Tools' mark at different locations than they would encounter Applicant's ECLIPSE mark. According to Neill Tools' website, its products are only available at one place in the United States -- Magnetic Products, Inc. in Highland, Michigan. (*Id.*) In contrast, Applicant's merchandise is available at mass market retailers and other general channels of commerce. (*Id.* at 10.) This means that Applicant's mark and Neill Tools' mark do not appear side-by-side in the marketplace or in any similar channels of trade.

Consumers who purchase Neill Tools' products and Applicant's goods also do so for entirely different reasons. 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.) Indeed, in order to assist consumers in this regard, Neill Tools describes the various characteristics of its magnets to consumers on its website, including their maximum temperatures, their varying levels of coercivity and their ability to resist corrosion. *Id.* Conversely, consumers who purchase Applicant's motion picture-related magnets do so because they are fans of the *Twilight* Motion Pictures. Further supporting this distinction is the fact that Applicant's goods sometimes include imagery from the *Twilight* Motion Pictures.

These differences indicate that Applicant's mark and Neill Tools' mark are unlikely to be confused.

(2) Applicant's Mark is Distinguishable From Fujitsu's Marks ECLIPSE and ECLIPSE (Stylized) in Registration No. 1,526,584 and U.S. Registration No. 1,581,195 Because of the Stylized Font in U.S. Registration No. 1,526,585 and the Different Contexts in Which The Marks Are Encountered

Applicant's mark is distinguishable from Fujitsu's mark ECLIPSE and ECLIPSE (Stylized). In support of her claim that Applicant's mark and the marks in U.S. Registration No.

1,526,584 and U.S. Registration No. 1,581,195 are likely to be confused, the Examiner states that the marks “share the same dominant feature, namely, ‘ECLIPSE’.” (Office Action at 3.) This is an incomplete analysis.

First, in evaluating the similarity of Applicant’s mark and U.S. Registration No. 1,581,195 for 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 others in the marketplace, including Applicant’s ECLIPSE mark.

ECLIPSE

Second, even in cases where an applicant’s and registrant’s marks 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. Further supporting this result is the fact that Fujitsu’s ECLIPSE marks are extremely weak as explained above, and that Applicant’s mark and Fujitsu’s marks are encountered in entirely different contexts. *See In re Sears, Roebuck & Co.*, 2 USPQ.2d at 1314; *In re Sydel Lingerie Co., Inc.*, 197 USPQ at 630.

As explained above, Applicant is the producer and distributor behind the enormously successful *Twilight* Motion Pictures. Applicant’s use of the ECLIPSE mark, therefore, refers to the third of these films. In contrast, Fujitsu is a Japanese-based consumer electronics company. (Office Action Response, 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.*)

Consistent with this distinction, consumers are likely to encounter Fujitsu's mark at different locations than they would encounter Applicant's ECLIPSE mark. 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.)

Consumers who purchase Fujitsu's "mobile sound equipment" and Applicant's goods also do so for entirely different reasons. Consumers who purchase Fujitsu's equipment do so because they want to listen to music in their cars, or because they want navigational assistance. (*Id.* at Ex. I.) In contrast, those consumers who purchase Applicant's portable music players do so often because they are fans of the *Twilight* Motion Pictures. These items are different from and compatible with the "mobile sound equipment" that Fujitsu provides under its ECLIPSE mark in the same way that an iPod music player is different from and compatible with the "mobile sound equipment" Fujitsu provides. (*Id.*) Indeed, just as consumers would not confuse Fujitsu's "mobile sound equipment" with other portable music players – like an iPod music player – so too would consumers not confuse Fujitsu's "mobile sound equipment" with Applicant's portable music players. This is especially the case considering that Applicant's portable music players sometimes include imagery from the *Twilight* Motion Pictures.

(3) Applicant's Mark is Distinguishable From LEC's SOLAR ECLIPSE mark in U.S. Registration No. 2,109,357 Because of the Additional SOLAR Element and the Different Contexts in Which Both Marks are Encountered

Applicant's mark is distinguishable from LEC's mark SOLAR ECLIPSE. In evaluating the similarity of Applicant's mark and U.S. Registration No. 2,109,357 for SOLAR ECLIPSE, the Examiner argues that the marks "share the same dominant feature, namely, 'ECLIPSE'." (*See, e.g.,* Office Action, February 27, 2014 at 3.) It is insufficient, however, 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 (C.C.P.A. 1960) (“[A]lthough appellee’s mark embodies appellant’s entire mark, when considering those marks in their entireties, 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 SOLAR ECLIPSE 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) (“A particular feature of a mark may be more obvious or dominant, and therefore, when determining likelihood of confusion, greater weight ought to be given to the

force and effect of such a feature.”). 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.”); *In re Cynosure Inc.*, 90 USPQ.2d 1644, 1646 (TTAB 2009); *Eveready Battery Co. v. Green Planet Inc.*, 91 USPQ.2d 1511, 1518 (TTAB 2009); *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). In the present case, consumers will focus on the SOLAR portion of LEC’s mark because it is the first part of the SOLAR ECLIPSE mark.

In addition, Applicant’s mark and LEC’s SOLAR ECLIPSE mark create distinct commercial impressions. Because of the well-known werewolf characters in the *Twilight* Motion Pictures, Applicant’s ECLIPSE mark brings to mind a lunar eclipse, which is when the moon moves into the shadow of the earth. (Office Action Response, August 18, 2014, Ex. D.) Conversely, LEC’s mark refers to a solar eclipse, which is when the moon passes between the sun and the earth. Just as these two terms have distinct meanings so too do they create distinct commercial impressions.

Applicant's mark and LEC's mark also are distinguishable in light of the different contexts in which they are encountered. See *In re Sears, Roebuck & Co.*, 2 USPQ.2d at 1314; *In re Sydel Lingerie Co., Inc.*, 197 USPQ at 630.

As explained above, Applicant is the producer and distributor behind the enormously successful *Twilight* Motion Pictures. Applicant's use of the ECLIPSE mark, therefore, refers to the third of these films: *The Twilight Saga: Eclipse*. In contrast, LEC apparently "engages in the design, marketing, and distribution of sunglasses and optical frames to retail channels of distribution." (Office Action Response, August 18, 2014, Ex. K.)

Consistent with this distinction, consumers will likely encounter goods bearing Applicant's and LEC's SOLAR ECLIPSE mark at different locations. Specifically, whereas retail outlets would experience LEC's mark directly from LEC, individual consumers encounter goods bearing Applicant's ECLIPSE mark at mass market retailers and other affordable channels of commerce. Similarly, consumers would purchase Applicant's goods and LEC's goods for entirely different reasons. Consumers who purchase LEC's products do so because they are presumably looking for high quality, stylish sunglasses. Conversely, consumers who are interested in purchasing Applicant's sunglasses do so because they relate to the *Twilight* Motion Pictures. Further supporting this distinction is the fact that Applicant's goods sometimes include imagery from the *Twilight* Motion Pictures, and LEC's products do not and cannot do so without infringing Applicant's rights associated with the *Twilight* Motion Pictures. These differences indicate that confusion is unlikely.

(4) Applicant's Mark is Distinguishable From Fujitsu's Mark ECLIPSE & Design in U.S. Registration No. 3,503,154 Because of the Additional Design Elements in the Cited Registration and the Different Contexts in Which Both Marks Are Encountered

In evaluating the similarity of Applicant's mark and U.S. Registration No. 3,503,154 is for ECLIPSE & Design, the Examiner argues that the marks "share the same dominant feature, namely, 'ECLIPSE'." (*See, e.g.,* Office Action, February 27, 2014 at 3.) Contrary to the Examiner's statement, however, Applicant's mark and Fujitsu's ECLIPSE & Design mark are distinctly dissimilar in appearance 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 and Fujitsu's mark also are distinguishable in light of the different contexts in which they are encountered. *See In re Sears, Roebuck & Co.*, 2 USPQ.2d at 1314; *In re Sydel Lingerie Co., Inc.*, 197 USPQ at 630. The reasons for this are given in Section C.3.b.(2) above.

(5) Applicant's Mark is Distinguishable Mr. Marderosian's ECLIPSE DOGGY mark in U.S. Registration No. 3,544,541 Because of the Additional DOGGY Element in the Cited Registration and the Different Contexts in Which Both Marks Are Encountered

Applicant's mark is distinguishable from Mr. Marderosian's mark ECLIPSE DOGGY. In support of her argument that Applicant's mark and the mark in U.S. Registration No.

3,544,541 are likely to be confused, the Examiner states that the marks “share the same dominant feature, namely, ‘ECLIPSE.’” (*See, e.g.*, Office Action, February 27, 2014 at 3.) It is not enough to simply note that Applicant’s mark shares components with the ECLIPSE DOGGY mark. *See Murray Corp. of America*, 280 F.2d at 161; *see also General Mills, Inc.*, 824 F.2d at 627. Indeed, such a rule would violate the anti-dissection rule. *See Estate of P.D. Beckwith, Inc.*, 252 U.S. at 545-46.

Contrary to the Examiner’s position, Applicant’s mark and the ECLIPSE DOGGY mark are distinct in appearance, sound and commercial impression. Applicant’s mark and the ECLIPSE DOGGY mark appear differently 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. Indeed, this impression is confirmed by the way Mr. Marderosian uses his ECLIPSE DOGGY mark in the marketplace. (Office Action Response, August 18, 2014, Ex. N.)

In addition, Applicant’s mark and the ECLIPSE DOGGY mark sound completely different because of the addition of the second, two-syllable word DOGGY to the ECLIPSE DOGGY mark. In fact, 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. *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).

Applicant's mark and Mr. Marderosian's ECLIPSE DOGGY mark also are distinguishable in light of the different contexts in which they are encountered. See *In re Sears, Roebuck & Co.*, 2 USPQ.2d at 1314; *In re Sydel Lingerie Co., Inc.*, 197 USPQ at 630.

As explained above, Applicant is the producer and distributor behind the enormously successful *Twilight* Motion Pictures. Applicant's use of the ECLIPSE mark, therefore, refers to the third of these films. In stark contrast, Mr. Marderosian appears to be an illustrator who created a canine character for kids called "Eclipse Doggy." (Office Action Response, August 18, 2014, Ex. N.) Mr. Marderosian's "Eclipse Doggy" character is one a "group of six special friends" whom Mr. Marderosian calls the "Angels from the Attic." (*Id.*) Despite the extremely broad description of goods found in Mr. Marderosian's registration for ECLIPSE DOGGY, it appears that he is only using this character in books, flash cards, and as a plush toy doll. (*Id.*) Such products also appear to be available solely from Mr. Marderosian's website at <www.angelsfromtheattic.com>. (*Id.*)

Consistent with this distinction, consumers are likely to encounter Mr. Marderosian's mark at different locations than they would encounter Applicant's ECLIPSE mark. As explained above, it appears that consumers must purchase Mr. Marderosian's goods directly from Mr. Marderosian's website. This means that such goods will not appear alongside Applicant's goods in mass market retailers and other general channels of commerce. Similarly, Applicant's and Mr. Marderosian's customers also are likely to purchase each party's respective goods for entirely different reasons. For example, whereas those customers of Mr. Marderosian may purchase his goods because they are looking for a plush toy doll for their small, very young

children, 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.

(6) Applicant's Mark is Different From Mad Catz's ECLIPSE and ECLIPSE & Design Marks in U.S. Registration No. 3,986,292 and U.S. Registration No. 3,986,293 Because of the Additional Design Element in U.S. Registration No. 3,986,293 and the Different Contexts in Which the Marks Are Encountered

In evaluating the similarity of Applicant's mark and U.S. Registration No. 3,986,292 for ECLIPSE and U.S. Registration No. 3,986,293 for ECLIPSE & Design, the Examiner states that the marks "share the same dominant feature, namely, 'ECLIPSE'." (*See, e.g.*, Office Action, February 27, 2014 at 3.) The Examiner also argues that the word portion of ECLIPSE & Design mark is the dominant element and thus should be accorded greater weight. (*Id.*) Contrary to the Examiner's statement, Applicant's mark and the Cited Marks are actually dissimilar in appearance and commercial impression.

As an initial matter, it is insufficient to suggest that Applicant's ECLIPSE mark and the ECLIPSE & Design mark are likely to be confused simply because they both share the ECLIPSE element. *See Murray Corp. of America*, 280 F.2d at 161; *see also General Mills, Inc.*, 824 F.2d at 627. Indeed, such a result would violate the anti-dissection rule. *See Estate of P.D. Beckwith, Inc.*, 252 U.S. at 545-46. It also ignores the weakness of the ECLIPSE element in general, as discussed above.

With respect to U.S. Registration No. 3,986,293 for ECLIPSE & Design, the Examiner virtually ignores the impact that Mad Catz's stylization and the design element 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 Mad

Catz's ECLIPSE (Stylized) mark from others in the marketplace, including Applicant's ECLIPSE mark.



Furthermore, even in cases where an applicant's and registrant's marks 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. Mad Catz's ECLIPSE marks are extremely weak as explained above, and Applicant's mark and Mad Catz's marks are encountered in entirely different contexts. *See In re Sears, Roebuck & Co.*, 2 USPQ.2d at 1314; *In re Sydel Lingerie Co., Inc.*, 197 USPQ at 630.

As explained above, Applicant is the producer and distributor behind the enormously successful *Twilight* Motion Pictures. Applicant's use of the ECLIPSE mark, therefore, refers to the third of these films. In contrast, Mad Catz is a gaming and computer accessory electronics company. (Office Action Response, August 18, 2014, Ex. O.) Mad Catz has registered its ECLIPSE marks for computer peripherals and accessories, including keyboards, mice, mousepads and wireless remote pointers. (*Id.*) However, Applicant conducted a search on Mad Catz's online store website for "ECLIPSE" products which only revealed a refurbished USB external VGA video card. (*Id.*)

Consistent with this distinction, consumers are 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 in the U.S. 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 entirely 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.

These differences indicate that Applicant's mark and Mad Catz's marks are unlikely to be confused.

(7) Applicant's Mark is Distinguishable From IGT's Mark MIDNIGHT ECLIPSE in U.S. Registration No. 4,150,483 Because of the Additional MIDNIGHT Element in the Cited Registration and the Different Contexts in Which Both Marks Are Encountered

In evaluating the similarity of Applicant's mark and U.S. Registration No. 4,150,483 for MIDNIGHT ECLIPSE, the Examiner argues that the marks "share the same dominant feature, namely, 'ECLIPSE'." (*See, e.g.*, Office Action, February 27, 2014 at 3.) It is not enough to simply note that Applicant's mark shares components with the MIDNIGHT ECLIPSE mark. *See Murray Corp. of America*, 280 F.2d at 161; *see also General Mills, Inc.*, 824 F.2d at 627. Again, such a rule would violate the anti-dissection rule. *See Estate of P.D. Beckwith, Inc.*, 252 U.S. at 545-46.

Contrary to the Examiner's position, Applicant's mark and the MIDNIGHT ECLIPSE mark are dissimilar in appearance and sound. Applicant's mark and IGT's MIDNIGHT

ECLIPSE mark appear and sound differently because of the addition of the word MIDNIGHT to IGT's mark.

As previously explained, 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 at 163. 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*, 396 F.3d at 1372–73, 73 USPQ.2d at 1692. In the present case, consumers will focus on the MIDNIGHT portion of IGT's mark because it is the first part of the MIDNIGHT ECLIPSE mark and because it is a distinctive and fanciful word in connection with “gaming machines, namely devices which accept a wager.”

Applicant's mark and IGT's mark also are distinguishable in light of the different contexts in which they are encountered. *See In re Sears, Roebuck & Co.*, 2 USPQ.2d at 1314; *In re Sydel Lingerie Co., Inc.*, 197 USPQ at 630.

As explained above, Applicant is the producer and distributor behind the enormously successful *Twilight* Motion Pictures. Applicant's use of the ECLIPSE mark, therefore, refers to the third of these films. In stark contrast, IGT sells slot machines to casinos and other gambling institutions. (Office Action Response, August 18, 2014, Ex. Q.)

Consistent with this distinction, consumers are likely to encounter IGT's mark at different locations than they would encounter Applicant's ECLIPSE mark, namely, casinos and other gambling locations. Indeed, the gambling industry is regulated such that gaming can only take place in certain states and locations. This means that such goods will not appear alongside

Applicant's goods in mass market retailers and other affordable channels of commerce. Similarly, Applicant's and IGT's customers also are likely to purchase each party's respective goods for entirely different reasons. IGT's customers are casinos and gambling institutions that are purchasing IGT's slot machines so that people will play those games and produce revenue for the casinos. 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 IGT's mark are unlikely to be confused.

(8) Applicant's Mark is Different From Bally's Mark CASH ECLIPSE in U.S. Registration No. 4,202,676 in Light of the Additional CASH Element in the Cited Registration and the Different Contexts in Which Both Marks Are Encountered

In evaluating the similarity of Applicant's mark and U.S. Registration No. 4,202,676 for CASH ECLIPSE, the Examiner argues that the marks "share the same dominant feature, namely, 'ECLIPSE'." (*See, e.g.*, Office Action, February 27, 2014 at 3.) It is not enough to simply note that Applicant's mark shares components with the CASH ECLIPSE mark. *See Murray Corp. of America*, 280 F.2d at 161; *see also General Mills, Inc.*, 824 F.2d at 627. Indeed, such a rule would violate the anti-dissection rule. *See Estate of P.D. Beckwith, Inc.*, 252 U.S. at 545-46.

Contrary to the Examiner's position, Applicant's mark and the CASH ECLIPSE mark are dissimilar in appearance and sound. Applicant's mark and Bally's CASH ECLIPSE mark appear and sound differently because of the addition of the word CASH to Bally's mark.

As previously explained, 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 at 163. 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*, 396 F.3d at 1372–73, 73 USPQ.2d at 1692. In the present case, consumers will focus on the CASH portion of Bally’s mark because it is the first part of the CASH ECLIPSE mark.

Notably, 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 not the word ECLIPSE, and that ECLIPSE is a very diluted and therefore weak mark.

Applicant’s mark and Bally’s mark also are distinguishable in light of the different contexts in which they are encountered. *See In re Sears, Roebuck & Co.*, 2 USPQ.2d at 1314.

As explained above, Applicant is the producer and distributor behind the enormously successful *Twilight* Motion Pictures. Applicant’s use of the ECLIPSE mark, therefore, refers to the third of these films. In stark contrast, Bally sells slot machines to casinos and other gambling institutions. (Office Action Response, August 18, 2014, Ex. R.) In fact, 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.

Consistent with this distinction, consumers are likely to encounter Bally’s mark at different locations than they would encounter Applicant’s ECLIPSE mark, namely, casinos and other gambling locations. Indeed, the gambling industry is regulated such that gaming can only take place in certain states and locations. This means that such goods will not appear alongside Applicant’s goods in mass market retailers and other general channels of commerce. Similarly, Applicant’s and Bally’s customers also are likely to purchase each party’s respective goods for

entirely different reasons. Bally's customers are casinos and gambling institutions that are purchasing Bally's slot machines so that people will play those games and produce revenue for the casinos. 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 Bally's mark are unlikely to be confused.

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.*, Office Action, February 27, 2014 at 4-5.) However, as previously explained by Applicant, the Board has made clear that this is insufficient to find likelihood of confusion.

The courts and the Board routinely hold that, even in a situation where two marks are identical, 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) (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.")). Here, consumers are unlikely to confuse Applicant's mark

with the Cited Marks because of the lack of similarity between the parties' commercial activities, as well as the absence of common ground between their channels of trade.

In this case, 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.*, Office Action Response, March 20, 2015, Ex. B.) As explained above, 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, if not impossible, 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.

Applicant discusses each of the Registrant's goods in turn.

(1) Applicant's Goods are Not Related to the Goods in U.S. Registration No. 799,454

U.S. Registration No. 799,454 is ECLIPSE for "magnets" in Class 9 owned by Neill Tools. The Examiner claims that Applicant's and Neill Tools' marks are likely to be confused because both parties offer magnets. (Office Action, February 27, 2014 at 4.)

Unlike Applicant's magnets, which are often marketed to the predominantly female fans of the *Twilight* Motion Pictures, Neill Tools' products are likely marketed to companies and other industry participants. (Office Action Response, August 18, 2014, Ex. H.) It is highly unlikely, if not impossible, that these companies and other industry participants would confuse Neill Tools' magnets for commercial and industrial purposes with Applicant's motion picture-related goods, especially when the former are not marketed with and are otherwise devoid of any imagery from the *Twilight* Motion Pictures. This is yet one more factor that weighs against any likelihood of confusion.

(2) Applicant's Goods are Not Related to the Goods in U.S. Registration No. 1,526,584 and U.S. Registration No. 1,581,195

U.S. Registration No. 1,526,584 is for ECLIPSE and U.S. Registration No. 1,581,195 is for ECLIPSE (Stylized) for "mobile sound equipment and accessories, namely, am-fm tuners, cassette, CD and speakers, amplifiers and equalizers" in Class 9, both owned by Fujitsu. The Examiner claims that Applicant's and Fujitsu's marks are likely to be confused because Applicant's "portable and handheld electronic digital devices for playing music" are highly related to Fujitsu's goods. (Office Action, February 27, 2014 at 4.)

As with the preceding mark, Fujitsu's marks do not create any likelihood of confusion with Applicant's mark because Fujitsu's goods are not the same as Applicant's often music players. Furthermore, Applicant's goods are marketed as general consumer products often to the

female fans of the PG 13-rated *Twilight* Motion Pictures, whereas Fujitsu's products are marketed primarily to automobile owners for use in their vehicles. (Office Action Response, August 18, 2014, Ex. I.) Moreover, Fujitsu's registrations for ECLIPSE and ECLIPSE (Stylized) are extremely weak and thus limited solely to the goods in its registrations. *Keebler Co.*, 207 USPQ at 1038 (crowded marks are "entitled to only a very circumscribed scope of protection limited to essentially the same mark for essentially the same goods"). As a result, there is no principled reason why Applicant's ECLIPSE mark cannot co-exist with Fujitsu's registrations.

Further supporting the result that confusion is unlikely is the lack of similarity between the parties' commercial activities, as well as the absence of common ground between their channels of trade.

(3) Applicant's Goods are Not Related to the Goods in U.S. Registration No. 2,109,357

U.S. Registration No. 2,109,357 is for SOLAR ECLIPSE for "sunglasses" in Class 9 owned by LEC. The Examiner claims that Applicant's and LEC's marks are likely to be confused because both parties offer sunglasses. (Office Action, February 27, 2014 at 4.)

LEC appears to design, market and distribute sunglasses to retail channels. (Office Action Response, August 18, 2014, Ex. K.) Unlike Applicant's goods, which are marketed primarily to the often female fans of the *Twilight* Motion Pictures, LEC's products are likely marketed to adults. These differences further indicate that confusion is unlikely.

(4) Applicant's Goods are Not Related to the Goods in U.S. Registration No. 3,503,154

U.S. Registration No. 3,503,154 is for ECLIPSE & Design 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.

The Examiner argues that Applicant’s and Fujitsu’s marks are likely to be confused because Applicant offers portable music players and Fujitsu offers “mobile sound equipment.” (Office Action, February 27, 2014 at 4.) Applicant respectfully disagrees with the Examiner for the reasons given in Section C.4.(2) above.

(5) Applicant’s Goods are Not Related to the Goods in U.S. Registration No. 3,544,541

U.S. Registration No. 3,544,541 is for ECLIPSE DOGGY for a number of goods in Class 28 owned by Mr. Marderosian. The Examiner claims that Applicant’s and Mr. Marderosian’s marks are likely to be confused because both parties offer decorative windsocks. (Office Action, February 27, 2014 at 4.) Putting aside the issue of whether Mr. Marderosian is using or has ever used his ECLIPSE DOGGY mark in connection with decorative windsocks (Applicant could not find any evidence of this) any decorative windsock offered by Mr. Marderosian would be different from the decorative windsock offered by Applicant. (Office Action Response, August 18, 2014, Ex. N.) This is so because of the lack of similarity between the parties’ commercial activities, as well as the absence of common ground between their channels of trade.

Mr. Marderosian is an illustrator who has created a canine character for kids called “Eclipse Doggy.” (*Id.*) This character is very cuddly and innocent-looking, and the words that accompany the character on Mr. Marderosian’s website are very simple. Therefore, unlike Applicant’s goods, which are marketed often to the female fans of the *Twilight* Motion Pictures, Mr. Marderosian likely markets his character to the parents of very young children. Given these facts, it is virtually impossible for consumers to confuse Mr. Marderosian’s cuddly “angels from the attic” with Applicant’s products related to the *Twilight* Motion Pictures.

(6) Applicant's Goods are Not Related to the Goods in U.S. Registration No. 3,986,292 and U.S. Registration No. 3,986,293

U.S. Registration No. 3,986,292 is for ECLIPSE and U.S. Registration No. 3,986,293 is for ECLIPSE & Design for “computer keyboards, computer mice; mouse pads; wireless presenter in the nature of a wireless remote pointer,” in Class 9, both owned by Mad Catz. The Examiner argues that Applicant’s and Mad Catz’s marks are likely to be confused because Mad Catz has registered its mark for computer keyboards, mice, mousepads and wireless remote pointers while Applicant has applied to register its ECLIPSE mark for laptop computers, computer storage devices and mouse pads. (Office Action, February 27, 2014 at 4-5.) Putting aside the issue of whether Mad Catz is using or has ever used the ECLIPSE marks in connection with the registered goods (Applicant could not find any evidence of this), the computer accessory goods offered by Mad Catz are different from the computer products offered by Applicant. (Office Action Response, August 18, 2014, Ex. O.) This is so because of the lack of similarity between the parties’ commercial activities, as well as the absence of common ground between their channels of trade.

Mad Catz is offering more specialized computer accessories. For example, Mad Catz’s “wireless remote pointers” are specialized products that only professionals or other business people are likely to use. (*Id.*) These products are directed to a distinct class of customers than the often female fans of the *Twilight* Motion Pictures who buy Applicant’s products. This is one more reason why confusion is highly unlikely.

(7) Applicant's Goods are Not Related to the Goods in U.S. Registration No. 4,150,483

U.S. Registration No. 4,150,483 is for MIDNIGHT ECLIPSE for “gaming machines, namely devices which accept a wager,” in Class 9 owned by IGT. The Examiner argues that

Applicant's and IGT's marks are likely to be confused because both parties offer "gaming machines". (Office Action, February 27, 2014 at 5.) However, the Examiner appears to have mistaken Applicant's electronic gaming devices, namely gaming machines, as the same type of machines offered by IGT, which are gaming devices which accept a wager. This is a critical distinction between the respective goods. Also, there is a distinct lack of similarity between the parties' commercial activities, as well as the absence of common ground between their channels of trade.

IGT is a manufacturer of gambling devices which accept a wager. IGT's customers are casinos and other gambling businesses who require slot machines for their business. (Office Action Response, August 18, 2014, Ex. Q.) The potential for confusion in this context is minimal if it even exists at all. This is another reason why confusion is highly unlikely.

(8) Applicant's Goods are Not Related to the Goods in U.S. Registration No.

U.S. Registration No. 4,202,676 is for CASH ECLIPSE for "gaming devices, namely, slot machines, with or without video output" in Class 9 owned by Bally. The Examiner argues that Applicant's and Bally's mark are likely to be confused because both parties offer "gaming machines". (Office Action, February 27, 2014 at 5.) However, the Examiner again appears to have mistaken Applicant's electronic gaming devices, namely gaming machines, as the same type of machines offered by Bally, which are slot machines. This is a critical distinction between the respective goods. Also, there is a distinct lack of similarity between the parties' commercial activities, as well as the absence of common ground between their channels of trade.

Bally is a manufacturer of slot machines. Bally's customers are casinos and other gambling businesses who require slot machines for their business. (Office Action Response, August 18, 2014, Ex. R.) As with IGT's MIDNIGHT ECLIPSE, the potential for confusion in

this context is minimal. Further, the coexistence of IGT's MIDNIGHT ECLIPSE and Bally's CASH ECLIPSE – both are for gaming devices that accept a wager – significantly undercuts the Examiner's position on a likelihood of confusion.

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) (wholesale buyers of one gallon jugs of juice are sophisticated and not likely to be confused); *Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 718 (Fed. Cir. 1992) "(Where the purchasers are the same, their sophistication is important and often dispositive because '[s]ophisticated consumers may be expected to exercise greater care.');" *In re Digirad Corp.*, 45 USPQ.2d 1841, 1843 (TTAB 1998).

(1) Neill Tools' Customers Exercise Care

Customers of Neill Tools' products would exercise a high degree of care. As explained above, those customers of Neill Tools' goods 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. (Office Action Response, August 18, 2014, Ex. H.) Often times the type of magnet one purchases is dictated by its anticipated use. Neill Tools' consumers would exercise care in choosing the type of magnet needed, and would thus be unlikely to confuse these goods with Applicant's consumer-related and decorative magnets.

(2) Fujitsu's Customers Exercise Care

Customers of Fujitsu's goods would exercise a high degree of care. As explained above, customers who are interested in Fujitsu's "mobile sound equipment" are looking for in-dash and in-seat DVD players, radios, and navigational units. (Office Action Response, 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. Conversely, those consumers of Applicant's goods are looking for merchandise related to the popular *Twilight* Motion Pictures. Fujitsu's customers would exercise care in distinguishing between such goods and Fujitsu's goods.

(3) LEC's Customers Exercise Care

Customers of LEC's eyewear would exercise a high degree of care. As explained above, consumers who are interested in LEC's products are presumably looking for a high quality, stylish product. (Office Action Response, August 18, 2014, Ex. K.) The decision to purchase such a product is not based on impulse, but instead after careful consideration of a number of factors, including color, size, style, lens quality, and price. Conversely, those consumers of Applicant's goods are looking for merchandise specifically related to the popular *Twilight* Motion Pictures. LEC's customers would exercise care in distinguishing between such goods and LEC's sunglasses.

(4) Mr. Marderosian's Customers Exercise Care

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. Therefore, 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. (Office Action Response, August 18, 2014, Ex. N.) Conversely, those consumers of Applicant's goods are looking for merchandise related to the popular *Twilight* Motion Pictures. Mr. Marderosian's consumers are very unlikely to confuse Applicant's merchandise with Mr. Marderosian's goods for very small children.

(5) Mad Catz's Customers Exercise Care

Customers of Mad Catz's goods would also exercise a high degree of care. Computer peripherals can be expensive products and typically used for a long time. Consumers who wish to invest in these products for their computers are likely to "do their homework" before making a purchase. Conversely, consumers of Applicant's goods are looking for merchandise related to the popular *Twilight* Motion Pictures. Mad Catz's consumers are very unlikely to confuse Applicant's motion picture-centric goods with Mad Catz's computer accessories for adults and business professionals.

(6) IGT's Customers Exercise Care

Customers of IGT'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 will likely study the machines carefully before installing them in their casinos. Conversely, those consumers of Applicant's goods are looking for merchandise related to the popular *Twilight* Motion Pictures. IGT's consumers are very unlikely to confuse Applicant's merchandise with IGT's goods, which can only be purchased by gambling institutions.

(7) Bally's Customers Exercise Care

Customers of 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 Bally's gaming machines who encounter Bally's CASH ECLIPSE mark will likely study the machines carefully before installing them in their casinos. Conversely, those consumers of Applicant's goods are looking for merchandise related to the popular *Twilight* Motion Pictures. Bally's customers are very unlikely to confuse Applicant's goods with Bally's goods, which can only be purchased by gambling institutions.

These purchasing conditions weigh in favor of a finding that there is no likelihood of confusion between Applicant's mark and the Cited Marks.

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.

D. 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. Applicant requests oral argument and has separately filed a Request for Oral Argument.

Respectfully submitted,

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CERTIFICATE OF MAILING

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 5th day of October, 2015.



Lynne Thompson

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