

**TTAB**

Docket No. 22HF-165423-300

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Summit Entertainment, LLC

Serial No: 77/921,988

Filed: January 28, 2010

Class: 18

Mark: ECLIPSE

Examiner:

Priscilla Milton

Law Office: 110

**APPLICANT'S APPEAL BRIEF**



**07-27-2015**

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Applicant Summit Entertainment, LLC (“Applicant”) hereby submits this brief in support of its appeal of the Examiner’s partial 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 two marks (“Cited Marks”):

- U.S. Registration No. 3,018,770 for ECLIPZE for “anti-uv umbrellas used for sun protection, namely, stick, 2-fold and 3 fold models” in Class 18 owned by Solar Solutions LLC (“Solar Solutions”);



- U.S. Registration No. 4,080,586 for  for “trunks and travelling bags, namely, tote bags,” in Class 18 owned by Ellison Educational Equipment, Inc. dba Sizzix (“Sizzix”).

The goods at issue are “All-purpose carrying bags, all-purpose carrying cases, back packs, beach bags, business card cases, collars for pets, cosmetic carrying cases sold empty, key cases, key chains of leather, key chains of imitation leather, luggage, luggage tags, makeup bags sold empty, messenger bags, pet clothing, pet leashes, namely, animal leashes, purses, umbrellas, wallets, **all relating to motion pictures and entertainment**” in Class 18 (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, July 16, 2014 at 6.) In connection with its successful franchise, Applicant seeks registration of the mark ECLIPSE for

various goods in Class 18. Indeed, Applicant's use of its ECLIPSE mark refers to the third of these films and is often used with imagery from that film. (*Id.*)

Registrant Solar Solutions is a manufacturer of specialty products, namely, anti-uv umbrellas for sun protection. (Office Action Response, January 5, 2010 at 11.)

Registrant Sizzix is a manufacturer of tote bags, which are advertised to stationery and scrapbooking enthusiasts. (Office Action Response, July 16, 2014 at 11.)

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 July 16, 2014, and its Request for Reconsideration dated February 27, 2015, the Request for, 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 18 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, July 16, 2014 at 6.) In contrast, Registrant Solar Solutions is a manufacturer of anti-uv umbrellas for sun protection

(Office Action Response, January 5, 2010 at 11) and Registrant Sizzix is a manufacturer of tote bags. (Office Action Response, July 16, 2014 at 11.)

## **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 “all-purpose carrying bags, all-purpose carrying cases, back packs, beach bags, business card cases, collars for pets, cosmetic carrying cases sold empty, key cases, key chains of leather, key chains of imitation leather, luggage, luggage tags, makeup bags sold empty, messenger bags, pet clothing, pet leashes, namely, animal leashes, purses, umbrellas, wallets” in Class 18.

On May 5, 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 three marks. The Examiner cited the Cited Mark U.S. Registration No. 3,018,770 for ECLIPZE for “anti-uv umbrellas used for sun protection, namely, stick, 2-fold and 3 fold models” in Class 18 owned by Registrant Solar Solutions as well as U.S. Registration No. 2,541,709 for ECLIPSE for “cleats for footwear for sports” in Class 25 owned by Softspikes, Inc. (“Softspikes”) and U.S. Registration No. 3,510,930 for ECLIPSE for “general purpose carry bags for military and police applications” in Class 18 owned by Simula, Inc. (“Simula”) (Office Action, May 5, 2010 at 2.) The Examiner also provided information about six prior pending applications, including Application Serial No. 77/914,002 for ECLIPS & Design for trunks and travelling bags, namely, tote bags, filed by Registrant Sizzix. (Office Action, May 5, 2010 at 1.) The Examiner noted that the prior pending applications, including, Application Serial No. 77/914,002, could be cited as a bar to registration should those applications eventually mature to registration.

Applicant filed its response to the Office Action on November 5, 2010 arguing that Applicant's mark was distinguishable from U.S. Registration Nos. 3,018,770, 2,541,709 and 3,510,930 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 10, 2010, the Examiner suspended the application pending the disposition of the prior pending applications and continued and maintained the refusal to register based on Reg. Nos. 2,541,709, 3,018,770 and 3,510,930. (Notice of Suspension, December 10, 2010, at 1.)

U.S. Application Serial No. 77/914,002 matured into U.S. Registration No. 4,080,586, namely the Cited Mark ECLIPS & Design owned by Registrant Sizzix.

On January 22, 2014, the Examiner issued a second Office Action refusing registration of Applicant's mark based on a likelihood of confusion with Registration No. 4,080,586 for ELCIPS & Design owned by Registrant Sizzix and continuing the refusal to register Applicant's mark based on a likelihood of confusion with U.S. Registration No. 3,018,770 for ECLIPZE owned by Registrant Solar Solutions and U.S. Registration No. 3,510,930 for ECLIPSE owned by Registrant Simula. (Office Action, January 22, 2014 at 1.)<sup>1</sup>

Applicant filed its response to the second Office Action on July 16, 2014 arguing that Applicant's mark was distinguishable from the Cited Marks. (Office Action Response, July 16, 2014.) Applicant pointed out the weakness of the Cited Marks, the significant dissimilarities in

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<sup>1</sup> In the January 22, 2014 Office Action, the Examiner noted that U.S. Registration No. 2,541,709 had since been canceled and all the prior pending applications, except Serial Nos. 77/156,768 and 77/914,002, had since been abandoned, so that these marks were no longer a bar to registration of Applicant's mark. The Examiner withdrew the potential refusal to register based on Serial No. 77/156,768, but cited U.S. Registration No. 4,080,586 (issued from Serial No. 77/914,002) as a bar to registration based on likelihood of confusion.

the connotation and commercial impressions between Applicant's mark and the Cited Marks 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 Registrant's consumers, and the lack of fame of the Cited Marks.

On August 27, 2014, the Examiner issued a final Office Action refusing registration of Applicant's mark on likelihood of confusion grounds. (Office Action, August 27, 2014.) 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 1-3.) The Examiner also disregarded Applicant's allegations concerning the weakness of the Cited Marks and the sophistication of the relevant consumers. (*Id.* at 3.)

Applicant responded to the Examiner's August 26, 2014 final refusal by filing a Request for Reconsideration on February 27, 2015. (Request for Reconsideration, February 27, 2015.) In the Request for Reconsideration, Applicant requested amendment of the identification of goods to:

All-purpose carrying bags, all-purpose carrying cases, back packs, beach bags, business card cases, collars for pets, cosmetic carrying cases sold empty, key cases, key chains of leather, key chains of imitation leather, luggage, luggage tags, makeup bags sold empty, messenger bags, pet clothing, pet leashes, namely, animal leashes, purses, umbrellas, wallets, 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 3-4.) Applicant also explained again why the connotations and commercial impressions of Applicant's mark and the Cited Marks are dissimilar. (*Id.* at 5.)

To preserve its rights, Applicant also filed a Notice of Appeal concurrently with its Request for Reconsideration

On May 7, 2015, the Examiner accepted the amendment to Applicant's identification of goods and withdrew the refusal to register based on U.S. Registration No. 3,510,930 for ECLIPSE owned by Registrant Simula. 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 U.S. Registration No. 4,080,586 for ELCIPS & Design owned by Registrant Sizzix and U.S. Registration No. 3,018,770 for ECLIPZE owned by Registrant Solar Solutions. (Denial of Request for Reconsideration, May 7, 2015.) As a result on May 23, 2015, the Board ordered that the proceedings before the Board resume, allowing Applicant sixty days to file its appeal brief. (TTAB Docket No. 11.) 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 Registrants’ ECLIPZE and ECLIPS & Design marks are weak and thus that consumer confusion 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 the Cited marks in Class 18.

As of February 27, 2015, there were currently 340 “live” registered marks containing words identical or virtually identical to ECLIPSE. (Request for Reconsideration, February 27, 2015, Ex. A.) These ECLIPSE marks are registered for a wide variety of goods and services, which are probative to show that the Office considers ECLIPSE to be a weak mark.

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

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

Reg. No.	Mark	Class and Goods/Services
		other solid surfaces
4,198,901	ECLIPSE	5: Bandages for skin wounds

(Office Action Response, July 16, 2014, Ex. I.)

In Class 18 alone, the Cited Marks co-exist with each other and also co-exist with previously cited U.S. Registration No. 3,510,930 for ECLIPSE. The fact that the Office has already registered hundreds of marks consisting of or incorporating ECLIPSE, including in Class 18, is a strong indication that Applicant's application for ECLIPSE in Class 18 can and should be allowed to co-exist with those hundreds of marks as well, particularly since Applicant's ECLIPSE mark is associated with the third motion picture in Applicant's *Twilight* Motion Pictures and because Applicant's mark is spelled different from either of the Cited Marks.

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. (Denial of Request for Reconsideration, May 7, 2015 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 in Class 18. This indicates that confusion is unlikely.

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 ... .”)

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 TTAB 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, July 16, 2014, Exhs. 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.*, Exh. 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.*, Exh. 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, February 27, 2015, Exh. 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 Examiner did not address Applicant's express limitation to the identification of goods anywhere in the Denial of the Request for Reconsideration. 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 on 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) Reg. No. 3,018,770**

Applicant's ECLIPSE Mark and the Cited Mark ECLIPZE are visually different because of Solar Solutions' unique spelling of the word "eclipse" as ECLIPZE. Considering the hundreds of ECLIPSE marks already on the federal register, this difference in spelling, even by one letter, is significant enough to distinguish Solar Solutions' ECLIPZE mark from Applicant's mark. *See, e.g., Echo Drain v. Newsted*, 307 F. Supp.2d 1116, 1126 (C.D. Cal. 2003) (no likelihood of confusion between ECHO DRAIN and ECHOBRAIN); *Colgate-Palmolive v. J.M.D. All-Star Import*, 486 F. Supp.2d 286, 290-91 (S.D.N.Y. 2007) (no likelihood of confusion between COLGATE and COLDDATE).

Applicant's mark and Solar Solutions' mark also sound different. By choosing to replace the "s" in "eclipse" with a "z", Solar Solutions' ECLIPZE mark creates a buzzing sound at the end. This makes Solar Solutions' ECLIPZE mark sound differently than Applicant's ECLIPSE mark when spoken aloud. 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) ("PEAK" and "PEAK PERIOD" both for toilet preparations, not likely to be confused); *Kayser-Roth Corp. v. Morris, Co., Inc.*, 164 USPQ 153, 153-54 (TTAB 1969) ("PAUL JONES ESQUIRE" and "ESQUIRE" not likely to be confused for apparel items).

Finally, the term ECLIPZE is a more playful spelling of the word ECLIPSE and also refers to blocking out the harmful rays of the sun, which is not a connotation that Applicant's mark conveys. Applicant's ECLIPSE mark connotes Applicant's motion picture *Eclipse*, which is associated with vampires and werewolves.

(2) **Reg. No. 4,080,586**

Applicant's ECLIPSE mark and the Cited Mark ECLIPS & Design mark are visually different based on a number of factors. First, the Cited Mark is spelled ECLIPS, not ECLIPSE. The Cited Mark displays the letter "E" in a left-italicized lower case font and the word "CLIPS" in block stylized lower case font. The letter "E" is shown in light font because it is surrounded by a dark colored heart design that displays a pair of wings sprouting from the heart and two fanciful curlicues extending on one ridge of the heart. The word "CLIP" is shown in dark font:



The Examiner failed to give sufficient weight to any of these differences. Marks should not be dissected, and no feature of a mark should be ignored. *In re Hearst Corp.*, 982 F.2d 493, 494 (Fed. Cir. 1992), *reh'g, en banc, denied*, 1993 U.S. App. LEXIS 7705 (Fed. Cir. Apr. 7, 1993) ("Marks tend to be perceived in their entirety, and all components thereof must be given appropriate weight."); *Opryland USA Inc. v. Great Am. Music Show, Inc.*, 970 F.2d 847, 851 (Fed. Cir. 1992) ("When it is the entirety of the marks that is perceived by the public, it is the entirety of the marks that must be compared."); *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 1007 (CCPA 1981) (noting that a mark should not be dissected and considered

piecemeal but instead must be considered as a whole in determining likelihood of confusion). When viewed in their entirety, it is patently obvious that Applicant's ECLIPSE mark visually looks nothing like the Cited Mark which is spelled ECLIPS. Registrant Sizzix's use of two types of fonts for the letter E and the word CLIPS suggests that the definition of ECLIPS is not "Eclipse" (i.e., a lunar/solar event), but a type of "clip" (e.g., hair clip, paper clip, etc.). Applicant's mark lacks the cheerful distinctive heart & wings design that Registrant Sizzix's mark incorporates. Finally, Applicant's ECLIPSE mark connotes Applicant's motion picture *Eclipse*, which features vampires and werewolves, not the childlike and playful impression conjured by the Cited Mark.

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

**4. Applicant's Goods and the Goods in U.S. Registration No. 3,018,770 and Registration No. 4,080,586 Are Not Related**

The Examiner has consistently suggested that Applicant's and Registrants' goods are "highly related." (*See, e.g.*, Office Action, January 22, 2014 at 2.) However, as previously explained by Applicant, the TTAB has made clear that this is insufficient to find likelihood of confusion.

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, February 26, 2015, Ex. H.) Simply put, Registrants' products have no affiliation with the *Twilight* Motion Pictures or Applicant's *Eclipse* film. Applicant's ECLIPSE products in Class 18 are often associated with imagery from Applicant's *Eclipse* film. (Request for Reconsideration, February 27, 2015, Exh. B.) 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 Registrant's goods. TMEP § 1207.01(a)(i) (citations omitted).

Solar Solutions' "anti-uv umbrellas used for sun protection, namely, stick, 2-fold and 3 fold models" are for the specific purpose of sun protection. Consumers who are interested in purchasing Applicant's novelty-related umbrellas do so primarily because they are fans of the *Twilight* Motion Pictures and secondarily because they are looking for an umbrella to keep them dry in the rain.

Sizzix's "tote bags" are likely intended to hold scrapbooking and other stationery products. (Office Action Response, July 16, 2014 at 11, Exh. H.) Sizzix's website appear to be primarily older/middle-aged women, and homemakers or teachers. (*Id.*) The ECLIPS products on Sizzix's website appear to be paper die cutting machines for paper crafts. (*Id.*) They also prominently feature Sizzix's house brand SIZZIX on the paper die cutting machines. Registrant's tote bags are not sold on Registrant's website, but are presumably intended to hold Registrant's machinery or other stationery accessories. (*Id.*)

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

##### **5. Registrants' Consumers 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. The threshold for confusion is much higher for careful, sophisticated, discriminating

purchasers than for impulse purchasers, and there is always less likelihood of confusion if the purchase concerns an expensive product or is made after careful examination of the product. *See In re Digirad Corp.*, 45 USPQ.2d 1841, 1843 (TTAB 1998).

Consumers of Solar Solutions' goods would exercise a high degree of care. Solar Solutions purports to offer "anti-uv umbrellas used for sun protection, namely, stick, 2-fold and 3-fold models." (Office Action Response, July 16, 2014, at 15.) Consumers interested in their health and safety (i.e, sunburn, melanoma, cancer, etc.) would presumably "do their research" before purchasing Solar Solutions' products. Solar Solutions' products are also relatively expensive, costing almost \$50 on one retailer site. (*Id.*, Exh. J.) These are expensive items, and Registrant Solar Solutions' consumers are likely to "do their homework" or at least, pause and exercise thought and consideration before making such a purchase.

Consumers of Sizzix's goods would exercise a high degree of care. Sizzix's goods are targeted toward a specific audience, namely, crafters or scrapbookers interested in paper arts. (Office Action Response, July 16, 2014, Exh. H.) Sizzix's ECLIPS paper cutters are priced between \$399 and \$499. (*Id.*) Sizzix's tote bags are presumably intended to carry this expensive machinery equipment and Sizzix's consumers would likely be careful to choose the right bag for this task. Again, Registrant Sizzix's consumers are likely to "do their homework" or at least, pause and exercise thought and consideration before making such a purchase.

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

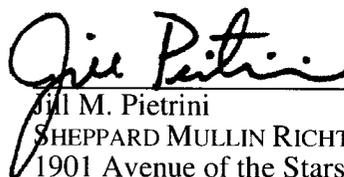
Examiner has offered no evidence that Registrants' ECLIPSE marks are famous or are likely to be remembered in the public mind, despite repeated opportunities to do so. This is unsurprising considering the weakness of Registrants' ECLIPSE marks in general and the very fact that the Cited Marks are co-existing with each other. 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,

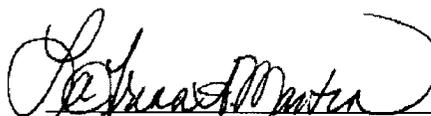
Dated: July 21, 2015



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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 21st day of July, 2015.



LaTrina A. Martin

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	
Summit Entertainment, LLC	
Serial No.:	77/921,988
Filed:	January 28, 2010
Class:	18
Mark:	ECLIPSE

Examining Attorney

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: July 21, 2015



Jill M. Pietrini  
SHEPPARD MULLIN RICHTER & HAMPTON LLP  
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Los Angeles, California 90067-6017  
(310) 228-3700

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 21st day of July, 2015.



LaTrina A. Martin