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Subject: U.S. TRADEMARK APPLICATION NO. 77921988 - ECLIPSE - 11186-033 - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 77921988

MARK: ECLIPSE



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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

TTAB INFORMATION:

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

APPLICANT: Summit Entertainment, LLC

CORRESPONDENT'S REFERENCE/DOCKET NO:

11186-033

CORRESPONDENT E-MAIL ADDRESS:

EXAMINING ATTORNEY'S APPEAL BRIEF

Summit Entertainment, LLC, limited liability Company (hereinafter referred to as "applicant") has appealed the trademark examining attorney's final refusal to register the mark ECLIPSE based upon Section 2(d) of the Trademark Act.

FACTS

On 01/28/2010, applicant filed an application to register the mark, ECLIPSE, 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, keychains of imitation leather, luggage, luggage tags, makeup bags sold empty, messenger bags, pet clothing, pet leashes, purses, umbrellas, wallets, wrist bands of leather, and wrist bands of imitation leather.” Applicant alleged intent to use the mark for the identified goods in interstate commerce.

In the first Office action mailed 5/4/2010, the examining attorney accepted applicant’s preliminary amendment dated 2/6/2010, which included an optional declaration in support of the Trademark application; advised applicant of prior pending application Serial Nos. 76285006, 77115348, 77156768; 77204383, 78606551, 78070275 and 77914002, which might bar registration of applicant’s mark under Trademark Act section 2(d), if the marks were to register; refused registration pursuant to Section 2(d) of the Trademark Act on the basis that the applicant's mark when applied to the services, so resembles the registrants’ marks, U.S. Registration No. 2541709, ECLIPSE for “cleats for footwear,” U.S.

Registration No. 3018770 ECLIPZE for “Anti-uv umbrellas used for sun protection, namely, stick, 2-fold and 3-fold models,” and U.S. Registration No. 3510930, ECLIPSE for “general purpose carry bags for military and police applications;” required an amendment to the identification of goods, because of indefiniteness and because particular items had been misclassified; and advised of the multiple-class application requirements if applicant added classes.

On 1/8/2010, applicant responded to the first Office action. In response to the identification of goods requirements, applicant amended the identification of goods, and moved misclassified goods to a co-pending application. Applicant also submitted arguments and evidence in support of registration as to the refusal under Trademark Act Section 2(d) and the prior pending applications.

On 12/9/2010, the examining attorney continued and maintained the Section 2(d) refusal as to 2541709, 3018770 and 3510930, accepted the amendment to the identification of goods, withdrew the advisory as to prior pending Application Serial No. 78070275 because it abandoned and suspended the application pending the disposition of prior pending Application Serial Nos. 76285006, 77115348, 77156768, 77204383, 78606551 and 77914002.

On 1/21/2014, the examining attorney removed the application from suspension because all prior pending applications except Application Serial Nos. 77156768 and 77914002 had been abandoned. The examining attorney withdrew the potential refusal to register based on Application Serial No. 77156768, but cited U.S. Registration No. 4080586, ECLIPS and Design for "trunks and travelling bags, namely, tote bags," (issued from Application Serial No. 77914002) as the basis for refusal under Trademark Act Section 2(d) as likely to cause confusion, to cause mistake or to deceive with applicant's mark.

On 7/18/2014, applicant responded to the third Office action with arguments and evidence in support of registration as to the refusal under Trademark Act Section 2(d).

On 8/26/ 2014, the examining attorney made the Trademark Act Section 2(d) refusal FINAL as to a likelihood of confusion between applicant's mark ECLIPSE 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" and registrants' marks U.S. Registration No. 3018770 ECLIPZE for "anti-uv umbrellas used for sun protection, namely, stick, 2-fold and 3-fold models," U.S. Registration No. 3510930, ECLIPSE for "general purpose carry bags for military and police applications," and U.S. Registration No. 4080586, ECLIPS and Design for "trunks and travelling bags, namely, tote bags."

On 3/3/15, in response to the final office action, applicant filed a Notice of Appeal, submitted a request for reconsideration with evidence and arguments in support of registration, and proposed an amendment to the identification of goods, that reads as follows: "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."

On 5/7/15 the examining attorney advised applicant that the Office reassigned this application to the undersigned trademark examining attorney; accepted the amendment to the identification of goods, withdrew the refusal under Trademark Act section 2(d) as it relates to U.S. Registration No. 3510930 for

the mark ECLIPSE for “general purpose carry bags for military and police applications, denied the request for reconsideration and made additional evidence of record to support the refusal under Trademark Act Section 2(d). On 7/27/2015, applicant filed its appeal brief.

The sole issue on appeal is whether the applicant's mark ECLIPSE 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, all relating to motion pictures and entertainment," is confusingly similar to the registered marks are ECLIPZE for “anti-us umbrellas used for sun-protection, namely, stick, 2-fold and 3-fold models,” and ECLIPS and design for “trunks and travelling bags, namely, tote bags.”

ARGUMENTS

APPLICANT’S MARK IS CONFUSINGLY SIMILAR TO REGISTRANTS MARKS AND THE RESPECTIVE GOODS ARE RELATED

In any likelihood of confusion determination, two key considerations are similarity of the marks and similarity or relatedness of the goods and/or services. *Syndicat Des Proprietaires Viticulteurs De Chateauneuf-Du-Pape v. Pasquier DesVignes*, 107 USPQ2d 1930, 1938 (TTAB 2013) (citing *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29 (C.C.P.A. 1976)); That is, the

marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973)); TMEP §1207.01(b)-(b)(v). Additionally, the goods and/or services are compared to determine whether they are similar or commercially related or travel in the same trade channels. See *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369-71, 101 USPQ2d 1713, 1722-23 (Fed. Cir. 2012).

A. THE MARKS ARE CONFUSINGLY SIMILAR

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F. 3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014) (citing *In re 1st USA Realty Prof’ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007)).

Applicant argues that the marks are distinguishable in appearance, sound, connotation and commercial impression. Applicant points to the difference in appearance of the respective marks. As to the cited mark ECLIPZE applicant states that the marks are visually different because of the “unique spelling of the word ‘eclipse’ as ECLIPZE.” Applicant contends that because of the hundreds of registrations on the federal register for the mark ECLIPSE, the difference in the spelling; even by one letter is sufficient to avoid confusion. As to the mark ECLIPS and Design, applicant argues that the cited mark has so many

visual differences that it looks nothing like applicant's mark. However, when comparing marks, the test is not whether the marks can be distinguished in a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods and/or services offered under the respective marks is likely to result. *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 1053, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012). The proper focus is on the recollection of the average purchaser, who retains a general rather than specific impression of trademarks. *United Global Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1049, (TTAB 2014).

In the present case, the marks in question are essentially phonetic equivalents and thus sound similar. Similarity in sound alone may be sufficient to support a finding that the marks are confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); see *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b)(iv).

While applicant agrees that the mark ECLIPZE is a novel spelling of ECLIPSE, applicant's argument that the marks sound different is unpersuasive. There is no correct pronunciation of a mark because it is impossible to predict how the public will pronounce a particular mark. See *Embarcadero Techs., Inc. v. RStudio, Inc.*, 105 USPQ2d 1825, 1835 (TTAB 2013) (quoting *In re Viterra Inc.*, 671 F.3d 1358, 1367, 101 USPQ2d 1905, 1912 (Fed. Cir. 2012)). The marks in question could clearly be pronounced the same; such similarity in sound alone may be sufficient to support a finding that the marks are confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988).

Additionally, applicant's contention that the marks have a different connotation is not supported by any evidence of record. There is no evidence of record that demonstrates that the wording "ECLIPSE," "ECLIPZE" and/or "ECLIPS" have a different meaning. The marks are phonetically identical and share the meaning "eclipse." See *In re Viterra Inc.*, 101 USPQ2d 1905 (Fed. Cir. 2012) (holding XCEED for agricultural seed, likely to cause confusion with the registered mark X-SEED & Design [SEED disclaimed] for agricultural seeds).

Applicant's argument that the different stylized font in the letter "E" and "CLIPS" in the mark ECLIPS with the background design behind the letter E does not suggest "eclipse," (e.g., for a lunar solar event) nor does it connote applicant's motion picture "Eclipse," but connotes a type of hair clip, paper clip and so on, is not supported by any evidence of record. The literal element of ECLIPS and design is ECLIPS, the phonetic equivalence of "eclipse," is the most prominent element in this cited mark.

Although marks must be compared in their entireties, the word portion generally may be the dominant and most significant feature of a mark because consumers will request the goods and/or services using the wording. See *In re Viterra Inc.*, 671 F.3d 1358, 1362, 1366, 101 USPQ2d 1905, 1908, 1911 (Fed. Cir. 2012); *In re Davia*, 110 USPQ2d 1810, 1813 (TTAB 2014). For this reason, greater weight is often given to the word portion of marks when determining whether marks are confusingly similar. *Joel Gott Wines, LLC v. Rehoboth Von Gott, Inc.*, 107 USPQ2d 1424, 1431 (TTAB 2013) (citing *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999)); TMEP §1207.01(c)(ii).

Applicant's argument that confusion is unlikely because its mark is closely associated with the Twilight series of motion pictures is unpersuasive. An association with the Twilight series of motion pictures is not reflected in the mark itself. There is no imagery from the films or words associated with the films in the mark itself.

Further, applicant contends that the examining attorney did not give due consideration to the evidence submitted support the conclusion that the cited marks are weak. The examining attorney respectfully disagrees. Applicant has submitted numerous printouts of third-party registrations for marks containing the wording ECLIPSE, as well as applicant's prior U.S. Registrations for the marks ECLIPSE, to support the argument that this wording is weak, diluted, or so widely used that it should not be afforded a broad scope of protection. It was previously noted that the goods/services listed in the prior registrations submitted by applicant are different and unrelated to the goods in the application and the cited registration. 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 and/or services*. See *Nat'l Cable Television Ass'n, Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 1579-80, 19 USPQ2d 1424, 1430 (Fed. Cir. 1991).

Evidence of weakness or dilution consisting solely of third-party registrations, such as those submitted by applicant in this case, is generally entitled to little weight in determining the strength of a mark, because such registrations do not establish that the registered marks identified therein are in *actual use* in the marketplace or that consumers are accustomed to seeing them. See *AMF Inc. v. Am. Leisure*

Prods., Inc., 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1204 (TTAB 2009); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1639 (TTAB 2009); *Richardson-Vicks Inc. v. Franklin Mint Corp.*, 216 USPQ 989, 992 (TTAB 1982). Furthermore, as mentioned above, the goods and/or services listed in the third-party registrations submitted by applicant are different from those at issue and thus do not show that the relevant wording is commonly used in connection with the goods and/or services at issue.

Additionally, applicant's referenced the evidence of previously cited cancelled third-party U.S. Registration No. 3510930 for ECLIPSE also supported the conclusion that the cited marks are weak. However, a cancelled or expired registration is "only evidence that the registration issued and does not afford an applicant any legal presumptions under [Section] 7(b)," including the presumption that the registration is valid, owned by the registrant, and the registrant has the exclusive right to use the mark in commerce in connection with the goods and/or services specified in the certificate. *In re Pedersen*, 109 USPQ2d 1185, 1197 (TTAB 2013) (citing *Anderson, Clayton & Co. v. Krier*, 478 F.2d 1246, 1248, 178 USPQ 46, 47 (C.C.P.A. 1973) (statutory benefits of registration disappear when the registration is cancelled); *In re Brown-Forman Corp.*, 81 USPQ2d 1284, 1286 n.3 (TTAB 2006); *In re Phillips-Van Heusen Corp.*, 63 USPQ2d 1047, 1047 n.2 (TTAB 2002)); see TBMP §704.03(b)(1)(A); TMEP §1207.01(d)(iv). Nor does a cancelled or expired registration provide constructive notice under Section 22, in which registration serves as constructive notice to the public of a registrant's ownership of a mark. See *Action Temp. Servs. Inc. v. Labor Force Inc.*, 870 F.2d 1563, 1566, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989) ("[A] canceled registration does not provide constructive notice of anything.").

Thus, these third-party registrations have little, if any, probative value with respect to the registrability of applicant's mark.

Applicant's argues that the consumers' of the owners of the sited registrations (Solar Solutions and Sizzix) exercise a high degree of care. As to ECLIPZE for "anti-uv umbrellas used for sun protection, namely, stick, 2-fold and 3-fold models," applicant contends that consumers interested in their health and safety would do their research before purchasing the registrant's products. Applicant states as follows: "Solar Solutions' products are also relatively expensive, costing \$50 on one retailers site... These are expensive items and Registrant Solar Solutions consumer is likely to 'do their homework' or at least pause and exercise thought and consideration before making such a purchase." While this may be true in some cases, applicant has not made any evidence of record to support this conclusion. Moreover, UV umbrellas can be purchased as low as \$11.95 and \$14.95.¹ Such umbrellas are sold online side by side with regular umbrellas, golf umbrellas and the like.² Thus the question arises as to whether these goods are every-day consumer items similar to sunglasses used to protect ones' eyes from the sun whereas the UV umbrellas are used to protect the ones' skin. "Generally, casual purchasers of low-cost, every-day consumer items exercise less care in their purchasing decisions and are more likely to be confused as to the source of the goods." *In re Davia*, 110 USPQ2d 1810, 1818 (TTAB 2014) (citing *Specialty Brands, Inc. v. Coffee Bean Distribs., Inc.*, 748 F.2d 669, 672, 223 USPQ 1281, 1282 (Fed. Cir. 1984)).

¹ See Office electronic Outgoing mail dated 5/7/2015, pages 11 and 12.

² See Office electronic Outgoing mail dated 5/7/2015, pages 2 – 36.

Applicant further argues that the tote bags, provided under the cited mark ECLIPS and Design, are for use to carry expensive equipment and that consumers of this product would likely be careful to choose the right bag for task. Once again, applicant has not made any evidence of record to support this conclusion. Moreover, the fact that purchasers are careful, sophisticated or knowledgeable in a particular field does not necessarily mean that they are careful, sophisticated or knowledgeable in the field of trademarks or immune from source confusion. TMEP §1207.01(d)(vii); *see, e.g., Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d. 1317, 1325, 110 USPQ2d 1157, 1163-64 (Fed. Cir. 2014); *Top Tobacco LP v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1170 (TTAB 2011).

Finally, as it relates to the cited marks, applicant contends that the examining attorney must consider the fame of the cited marks. However, because of the nature of the evidence required to establish the fame of a registered mark, the Board normally does not expect the examining attorney to submit evidence as to the fame of the cited mark in an ex parte proceeding. *See In re Thomas*, 79 USPQ2d 1021, 1027 n.11 (TTAB 2006). Since the examining attorney is not expected to submit evidence regarding the fame of the cited mark, this factor is treated neutral in such proceedings. *See* TMEP §1207.01(d)(ix).

The examining attorney maintains that the marks create a substantially similar overall commercial impression. The marks are similar in sound, appearance and connotation in that they are phonetically identical. Moreover, the applicant evidence of dilution of the cited marks is insufficient and there is no evidence to support applicant's claim that consumers of the owners of the cited registrations are careful purchasers. Thus, in the case at hand, viewing the marks in their entireties, the similarities in appearance sound, connotation and overall commercial impression outweighs the dissimilarities. There is no evidence of record that would support a different conclusion.

B. THE GOODS ARE RELATED AND IN THE SAME CHANNELS OF TRADE

The respective goods are related. The goods and/or services of the parties need not be identical or even competitive to find a likelihood of confusion. See *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) (“[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods.”).

The respective goods and/or services need only be “related in some manner and/or if the circumstances surrounding their marketing [be] such that they could give rise to the mistaken belief that [the goods and/or services] emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)).

Applicant argues that the involved goods are unrelated in that applicant’s goods are all relating to motion pictures and entertainment. Applicant contends that confusion is unlikely because the respective goods are sold through different channels of trade to different classes of consumers.

Applicant has provided evidence which purportedly demonstrates that applicant’s mark always refers to the Eclipse films and feature imagery from the films. Applicant claims that the owner of ECLIPZE is a

manufacturer of specialty products, namely anti-uv umbrellas for sun protection and the owner of ECLIPS and Design is a manufacturer of tote bags, which are marketed to stationery and scrapbooking enthusiasts. However, applicant's arguments regarding the difference in the actual goods and channels of trade are not persuasive, inasmuch as the determination of the question of likelihood of confusion is determined based on the description of the goods and/or services stated in the application and registration at issue, not on extrinsic evidence of actual use. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1323, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (quoting *Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)).

In this case, the identification set forth in the registrations has no restrictions as to nature, type, channels of trade, or classes of purchasers. Therefore, it is presumed that these goods and/or services "travel in the same channels of trade to the same class of purchasers." *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)).

As to U.S. Registration No. 3018770 for trunks and travelling bags, namely, tote bags

In the present case, the respective goods are related in that they are items necessary for travel, including those items that are essential when travelling with pets. The trademark examining attorney has attached evidence from the USPTO's X-Search database consisting of a number of third-party marks registered for use in connection with the same or similar goods and/or services as those of both applicant and registrant in this case as well. This evidence shows that the goods and/or services listed

therein, namely carrying bags, 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, trunks and tote bags,, are of a kind that may emanate from a single source under a single mark. See *In re Anderson*, 101 USPQ2d 1912, 1919 (TTAB 2012); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988); TMEP §1207.01(d)(iii).³ See excerpts below.

U.S. Registration No. 3685789, **CARL EDWARDS** for "credit card cases; **backpacks; tote bags; pet leashes; collars for pets.**"

U.S. Registration No. 4086302 **LIVE LIFE WITH A WAG** for "**tote bags, all-purpose carry-on bags, duffle bags, back-packs; umbrellas; pet equipment, namely, pet coats, pet leashes and pet collars.**"

U.S. Registration No. 4008954 for **THE BUZINESS DIAMOND MAJESTÉ and Design** for "chain mesh purses; key cases of leather or imitation leather; key wallets; **key cases**; leather key cases; **leather key chains; all-purpose carrying bags; animal leashes**; baby carrying bags; **backpacks**; book bags, sports bags, bum bags, wallets and handbags; bags for carrying babies' accessories; belt bags; briefcases and attaché cases; business cases; canvas shopping bags; carry-all bags; carry-on bags; carrying cases; carrying cases for documents; cosmetic bags sold empty; **cosmetic carrying cases sold empty**; credit card cases and holders; diaper bags; document cases; dog leashes; drawstring bags; duffel bags for travel; duffle bags; evening handbags; fashion handbags; garment bags for travel; garment bags for travel made of leather; **garments for pets**; handbags, **purses** and wallets; *leashes for animals*; leather and imitation leather bags; leather bags and wallets; suitcases and wallets; leather cases; leather credit card cases; leather handbags; make-up bags sold empty; overnight bags; pet accessories, namely, specially designed canvas, vinyl or leather bags attached to animal leashes for holding small items such as keys, credit cards, money or disposable bags for disposing of pet waste; pet collar accessories,

³ See Office electronic Outgoing mail dated 5/7/2015, pages 37 – 83.

namely, charms; pet tags specially adapted for attaching to pet leashes or collars; pommel bags; toiletry bags sold empty; toiletry cases sold empty; **tote bags**; travel bags; travel cases; traveling bags; traveling cases of leather; **traveling trunks**; **umbrellas**; vanity cases sold empty; wheeled duffel bags.”

U.S. Registration No. 4059737, **THE QUIET LIFE** for “Wallets, billfolds, **leather key chains**, bags and leather goods, namely, purses, clutches, handbags, fashion handbags, cosmetic cases sold empty, athletic bags, gym bags, duffel bags, **tote bags**, **beach bags**, shoulder bags, **messenger bags**, travel bags, hobo bags, wheeled bags, **backpacks**, knapsacks, daypacks, fanny packs, briefcases, suitcases, **luggage**, **trunks**, diaper bags, baby carriers worn on the body, straps for luggage, shoulder straps, bag straps, leather straps, leather thongs, pocket books, coin purses, key cases, **collars for pets**, **leashes for animals**, **clothing for animals**, whips, canes, **umbrellas**, and parasols.”

U.S. Registration No. 4527195, a Design mark for “all-purpose sport bags; all-purpose athletic bags; **all-purpose carrying bags**; all-purpose reusable carrying bags; athletic bags; **backpacks** for pets; Canvas shopping bags; Carry-all bags; **collars for pets**; duffel bags; garments for pets; gym bags; pet collar accessories, namely, bells, silencers, safety lights and blinkers, pendants and charms; Pet collar accessories, namely, bows and charms; **pet tags** specially adapted for attaching to **pet leashes or collars**; **tote bags**.”

U.S. Registration No. 4720634, **NEW ORLEANS PELICANS and Design** for “athletic bags, shoe bags for travel, overnight bags, **umbrellas**, **backpacks**, baby backpacks, knapsacks, duffel bags, **tote bags**, **beach bags**, **beach tote bags**, drawstring pouches, luggage, **luggage tags**, patio umbrellas, beach umbrellas, valises, attaché cases, billfolds, wallets, briefcases, canes, business card cases, book bags, all purpose sports bags, golf umbrellas, gym bags, purses, coin purses, fanny packs, waist packs, **cosmetic cases sold empty**, garment bags for travel, handbags, key cases, **leather key chains**, **suitcases**, toiletry cases sold empty, trunks for traveling and rucksacks, **pet clothing**, **pet leashes**, and **pet collars**.”

U.S. Registration No. 4538375, **SIGNARE** for “ (Based on Use in Commerce) (Based on 44(e))Bags, namely, all purpose sport bags, canvas shopping bags, leather shopping bags, mesh shopping bags, wheeled shopping bags, across body bags in the nature of **messenger bags**, shoulder bags, hobo bags, travel bags, **tote bags**, beach bags, school bags, all purpose **carrying bags**; tapestry bags, namely, all purpose **carrying bags**; handbags; **trunks** and travelling bags;

luggage; rucksacks; buckled bags, namely, attaché cases and briefcases; cosmetic bags sold empty; make-up bags sold empty; wallets and purses; **umbrellas**.”

U.S. Registration No. 4388446, **SANTIAGO GONZALEZ** for “leather and imitation leather goods, namely, handbags, wallets, cosmetic cases sold empty, key cases, **coin purses**, brief cases, document cases, attaché cases, **luggage** and **trunks**, animal **leashes**, duffel bags, business card cases, credit card cases and holders, all purpose **carrying bags**, **backpacks**, **beach bags**, gentlemen's handbags, gym bags, **leather key chains**, **messenger bags**, overnight bags, travel bags, **umbrellas**.”

U.S. Registration No. 4724636, **NEVER WALK ALONE** for “**pet collars**; pet collar accessories, namely, bows, charms, beads, bells, safety lights and pendants with information; pet products, namely, pet restraining devices consisting of leashes, harnesses, collars and restraining straps; pet tags specially adapted for attaching to pet leashes or collars; Backpacks, knapsacks, **tote bags**, handbags, **luggage**, luggage tags, **umbrellas**; **Pet clothing**; pet accessories, namely, specially designed canvas, vinyl or leather bags attached to animal leashes for holding small items such as keys, credit cards, money or disposable bags for disposing of pet waste.”

U.S. Registration No. 4584200, **IMELT** for “baby carrying bags; backpacks; bags and holdalls for sports clothing; bags for carrying babies' accessories; bags for climbers in the nature of **all-purpose carrying bags**; bags for sports; belt bags; billfolds; briefcases; Canvas shopping bags; Credit card cases; Handbags; Imitation leather; leather; leather and imitation leather; leather straps; **luggage**; Polyurethane leather; **purses**; rawhides; rucksacks; shopping bags made of skin; shopping bags with wheels attached; suitcases; travel bags; travel cases; travelling **trunks**; valises; wallets.”

The trademark examining attorney refers to the excerpted materials from the Google search engine in which references to tote bags and/or trunks being sold in the same online stores as those goods offered by applicant appear in several stories.⁴

⁴ See Office electronic Outgoing mail dated 5/7/2015, pages 84 - 171.

U.S. Registration No. 4080586 for the goods anti-uv umbrellas used for sun protection, namely, stick, 2-fold and 3-fold models.

Applicant's argument that the goods are distinguishable is unpersuasive. Applicant points to the fact that the registrant's goods are "anti-uv umbrellas would be bought by consumers for a specific purpose, to protect from the sun rays are different from applicant's general merchandise of goods. However, applicant's umbrellas are described broadly and could include UV umbrellas used for sun protection from sun rays. The trademark examining attorney refers to the excerpted materials from the Google search engine in which references to umbrellas and UV umbrellas appeared in the same stories. This evidence demonstrates that those providing umbrellas may also provide UV umbrellas.⁵

Material obtained from the Internet is generally accepted as competent evidence. *See In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-03 (TTAB 2009) (accepting Internet evidence to show relatedness of goods in a likelihood of confusion determination).

The Internet has become integral to daily life in the United States, with Census Bureau data showing approximately three-quarters of American households used the Internet in 2013 to engage in personal communications, to obtain news, information, and entertainment, and to do banking and shopping. *See In re Nieves & Nieves LLC*, 113 USPQ2d at 1642 (taking judicial notice of the following two official government publications: (1) Thom File & Camille Ryan, U.S. Census Bureau, Am. Cmty. Survey Reports ACS-28, *Computer & Internet Use in the United States: 2013* (2014), available at <http://www.census.gov/content/dam/Census/library/publications/2014/acs/acs-28.pdf>, and (2) The

⁵ See Office electronic Outgoing mail dated 5/7/2015, pages 11 and 12

Nat'l Telecomms. & Info. Admin. & Econ. & Statistics Admin., *Exploring the Digital Nation: America's Emerging Online Experience* (2013), available at

[http://www.ntia.doc.gov/files/ntia/publications/exploring_the_digital_nation -
_americas_emerging_online_experience.pdf](http://www.ntia.doc.gov/files/ntia/publications/exploring_the_digital_nation_-_americas_emerging_online_experience.pdf)). Thus, the widespread use of the Internet in the United

States suggests that Internet evidence may be probative of public perception in trademark examination.

CONCLUSION

Applicant's mark ECLIPSE is confusingly similar to the registrants' marks ECLIPZE and ECLIPS and Design. The marks are substantially similar in sound, appearance, connotation and overall commercial impression. Further, the respective services are closely related and in the same channels of trade. Any doubt that could possibly exists in determining the likelihood of confusion must be resolved in the favor of the registrant. TMEP §1207.01(d)(i); see *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002).

Respectfully submitted,

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