

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

Oral Hearing: February 10, 2016

Mailed: June 29, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Summit Entertainment, LLC
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Serial No. 77921988
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Jill M. Pietrini of Sheppard Mullin Richter & Hampton LLP,
for Summit Entertainment, LLC.

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

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Before Kuhlke, Taylor and Goodman,
Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

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

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

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

clothing, pet leashes, namely, animal leashes, purses, umbrellas, wallets, all relating to motion pictures and entertainment, in International Class 18.²

The Trademark Examining Attorney refused registration of Applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark, when used in connection with the identified goods, namely, "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" so resembles the registered mark ECLIPZE (in standard characters) for "Anti-uv umbrellas used for sun protection, namely, stick, 2-fold and 3-fold models," in International Class 18,³

and the registered mark  for "trunks and travelling bags, namely, tote bags," in International Class 18,⁴ as to be likely to cause confusion, mistake or deception.

² Application Serial No. 77921988 was filed on January 28, 2010, under Section 1(b) of the Trademark Act, based upon Applicant's allegation of a *bona fide* intention to use the mark in commerce.

³ Registration No. 3018770, issued on November 22, 2005.

⁴ Registration No. 4080586, issued on January 3, 2012. The mark is also registered for various other goods including craft knives and machine readable media cartridges not relied on or relevant to the refusal.

When the refusal was made final, Applicant appealed and requested reconsideration, including for consideration of an amendment to the identification of goods. The Board granted the request and the Examining Attorney accepted the amendment to the identification of goods but maintained the refusal under Section 2(d).

After briefing and oral argument the Board suspended further proceedings on the appeal pending cancellation of one of the cited registrations, Reg. No. 3018770. On June 24, 2016, Reg. No. 3018770 was cancelled for failure to file a Section 9 renewal. In view thereof, the refusal based on Reg. No. 3018770 is moot. The only remaining issue for appeal is the refusal under Section 2(d) based on Reg. No. 4080586.

Likelihood of Confusion

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

While Applicant and the Examining Attorney addressed the *du Pont* factors of the similarity of the goods and channels of trade, strength of the mark, and sophistication of the purchaser, we find that the *du Pont* factor of the similarity of the marks is dispositive.

We consider the marks ECLIPSE and  and compare them “in their entirety as to appearance, sound, connotation and commercial impression.” *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). The marks “must be considered ... in light of the fallibility of memory” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (quoting *San Fernando Elec. Mfg. Co. v. JFD Elecs. Components Corp.*, 565 F.2d 683, 196 USPQ 1 (CCPA 1977)). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Winnebago Indus., Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). “[S]imilarity is not a binary factor but is a matter of degree.” *In re St. Helena Hosp.*, 113 USPQ2d at 1085 (quoting *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059 (Fed. Cir. 2003)).

Applicant argues that the marks are visually different, stressing that “the letter ‘E’ [is] in a left-italicized lower case font and the word ‘CLIPS’ in block stylized lower case font ... [and the letter ‘E’ is] shown in a 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 ... [and] [t]he word ‘CLIP’

is shown in dark font.” App. Br. 12 TTABVUE 17. Applicant further argues that this separation results in a different connotation from Applicant’s mark which is the word ECLIPSE, *i.e.*, a lunar or solar event; “[i]nstead consumers are likely to view the mark as ‘e-clips.’” App. Reply Br. 15 TTABVUE 3. Moreover, the heart design with wings further separates  from the meaning lunar or solar event.

The Examining Attorney argues that the marks are phonetically identical and that there is no evidence of record to support Applicant’s argument that  does not connote eclipse, *i.e.*, a lunar or solar event. Ex. Att. Br. 14 TTABVUE 8-9.

As noted by Applicant “[s]imilarity of the marks in one respect – sight, sound, or meaning – will not automatically result in a determination that confusion is likely even if the goods are identical or closely related; rather, taking into account all of the relevant facts of a particular case, similarity as to one factor alone *may* be sufficient to support a holding that the marks are confusingly similar.” App. Reply Br. 15 TTABVUE 2 (citing TMEP §1207.01(b)(i)) (emphasis added).

We find that the differences in Registrant’s mark sufficiently distinguish it from Applicant’s mark. We agree that the separation of the “e” from the word “clips” evokes a very different connotation and combined with the heart wing design a very different commercial impression. To the extent  may evoke as a secondary meaning a lunar or solar event based on only the sound for some potential consumers, it is outweighed by the differences in appearance, the e clips connotation and commercial impression.

In view thereof, this *du Pont* factor weighs against likelihood of confusion. Moreover, we find this factor to be pivotal in that even assuming the other relevant *du Pont* factors weigh in favor of finding likelihood of confusion, this factor of the dissimilarities of the marks outweighs the other factors. *See Kellogg Co. v. Pack'em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) (“We know of no reason why, in a particular case, a single *du Pont* factor may not be dispositive”).

As has often been said, each case must be determined on the particular facts. Under the facts of this case, because of the very different connotations and commercial impressions of the marks, we find that confusion is not likely between Applicant’s mark ECLIPSE and the mark  in the cited registration.

Decision: The refusal to register Applicant’s mark is reversed.