

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Mailed: October 16, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*Lucasfilm Entertainment Company Ltd. LLC*

*v.*

*Ilan Moskowitz aka Captain Contingency*  
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Opposition No. 91244449  
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David M. Kelly, Linda K. McLeod, Jason M. Joyal, and Clint A. Taylor,  
of Kelly IP LLP, for Lucasfilm Entertainment Company Ltd. LLC.

Ilan Moskowitz aka Captain Contingency, pro se.  
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Before Kuczma, Heasley, and Lebow,  
Administrative Trademark Judges.

Opinion by Lebow, Administrative Trademark Judge:

Applicant, Ilan Moskowitz aka Captain Contingency, filed an application to register the mark MILLENNIAL FALCON, in standard characters, for “Entertainment services in the nature of live visual and audio performances by a live musical performance group; Entertainment services in the nature of live visual and audio performances, namely, musical band, rock group, gymnastic, dance, and ballet performances; Entertainment services in the nature of live vocal performances by a

live musical performance group; Entertainment, namely, live performances by musical bands; Entertainment, namely, live performances by a musical band; Multimedia entertainment services in the nature of recording, production and post-production services in the fields of music, video, and films; Production of musical sound recording; Production of sound and music video recordings,” in International Class 41.<sup>1</sup>

Opposer, Lucasfilm Entertainment Company Ltd. LLC, has opposed registration of Applicant’s mark MILLENNIAL FALCON, alleging prior use and registration of the mark MILLENNIUM FALCON for “toy vehicle[s],”<sup>2</sup> and prior use at common law for entertainment services; sound recordings; live musical concerts; films; television programs; computer and video games; comic books; books; amusement parks; toys; games; clothing. As grounds for opposition, Opposer alleges that registration of Applicant’s mark for the recited services (1) would be likely to cause confusion with Opposer’s mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), and (2) would be likely to cause dilution by blurring of Opposer’s famous mark under Trademark Act Section 43(c), 15 U.S.C. § 1125(c).<sup>3</sup>

Applicant denied the salient allegations in the notice of opposition.<sup>4</sup>

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<sup>1</sup> Application Serial No. 87066540 was filed on June 9, 2016 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging use in commerce since May 26, 2016. During prosecution, the application was amended to seek registration under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on Applicant’s alleged bona fide intention to use the mark in commerce. October 6, 2016 Response to Office Action, TSDR 2.

<sup>2</sup> Registration No. 2450785, registered May 15, 2001; renewed.

<sup>3</sup> 1 TTABVue (Notice of Opposition).

<sup>4</sup> 7 TTABVue (Amended Answer). Applicant also asserted a number of affirmative defenses—including failure to state a claim; laches, waiver, estoppel, and/or acquiescence; and

## I. ACR Procedure

The parties agreed to try this case via the Board's Accelerated Case Resolution ("ACR") procedure.<sup>5</sup> *See generally Kemi Organics, LLC v. Gupta*, 126 USPQ2d 1601, 1602 (TTAB 2018) (describing summary judgment ACR model); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 702.04(b) (June 2020) ("ACR summary judgment briefs may be presented either as cross motions for summary judgment or as a single motion for summary judgment."). The parties agreed, in relevant part, that:

1. The Board, in lieu of a full trial, may use the [ACR] procedure to resolve [this] proceeding based on the Parties' cross-motions for summary judgment, responses, and reply briefs filed in support thereof, and evidence and witness declaration testimony submitted therewith, the subject Application No. 87066540, and the pleaded registration attached to Opposer's Notice of Opposition ... under TBMP § 702.04(b).

5. The Parties agree that documents and things maintained in the ordinary course of business or obtained from verifiable, publicly-available sources (e.g., from an Internet website accompanied by valid URL and date downloaded) and produced in response to written discovery requests served in this proceeding are genuine and authentic for purposes of admission into evidence, but the Parties reserve their respective objections as allowed under the rules, including but not limited to hearsay, competency, accuracy, relevance, materiality, and/or weight to be afforded.

6. The Parties each reserve the right to submit materials admissible under Notice of Reliance, as set forth under TBMP § 704, and each Party reserves their respective right to object to such materials as permitted under the Federal Rules of Evidence and the Board's rules.

7. The Parties' ACR Briefs, witness declarations or affidavits, and accompanying exhibits shall be deemed the final record and briefs for

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abandonment—which were stricken by the Board following Opposer's motion to strike. 11 TTABVUE.

<sup>5</sup> 16 TTABVUE (Stipulation).

this case on which the Bard may decide any issue of material fact in dispute and make a final determination.<sup>6</sup>

As in a traditional Board proceeding, the burden of proof remains with Opposer, which must establish its case by a preponderance of the evidence. TBMP § 702.04(a).

The case is fully briefed. For the reasons set forth below, we sustain the opposition.

## II. The Record

The record consists of the pleadings, the file of the opposed application pursuant to Trademark Rule 2.122(b)(1), 37 C.F.R. § 2.122(b)(1), the parties' ACR stipulation;<sup>7</sup> and the following submissions by the parties:

### A. Opposer's Testimony and Evidence

- Testimony Declaration of Chris Gollaher ("Gollaher Decl."), Opposer's Director of Global Product Development, with 13 exhibits consisting of printouts of web pages from Opposer's websites and third-party websites; images of Opposer's publications; images of products sold under Opposer's MILLENNIUM FALCON mark and other marks, including those provided by Opposer's licensees;<sup>8</sup>
- Notices of Reliance ("NOR") on media attention in the nature of news, magazine, trade publication, and Internet articles and web pages of Opposer, Opposer's parent company - The Walt Disney Company ("Disney"), and third parties regarding Opposer and its use of MILLENNIUM FALCON as a mark or otherwise, as well as other marks owned by Opposer;<sup>9</sup> and
- NOR on Applicant's responses to certain requests for admission and

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<sup>6</sup> *Id.* at 2-5. In accordance with the stipulation, the Board may resolve any and all issues of material fact in the course of issuing a final ruling. *See TPI Holdings, Inc. v. TrailerTrader.com, LLC*, 126 USPQ2d 1409, 1411 (TTAB2018); *Bond v. Taylor*, 119 USPQ2d 1049, 1051 (TTAB 2016) ("In order to take advantage of any form of ACR, the parties must stipulate that the Board may resolve any genuine disputes of material fact in the context of something less than a full trial."). *See generally* TBMP §§ 528.05(a)(2), 702.04, and 705.

<sup>7</sup> 16 TTABVUE.

<sup>8</sup> 30-31 TTABVUE.

<sup>9</sup> 18-22, 25 TTABVUE (NOR 1-5, 8).

interrogatories;<sup>10</sup> UPSTO database printouts including trademark registration certificates and status printouts for 14 third-party registrations, and 14 registrations owned by Opposer for other marks;<sup>11</sup> and certain documents in the nature of Internet web page printouts produced by Applicant during discovery.<sup>12</sup>

#### B. Applicant's Testimony and Evidence

- Testimony declaration of Applicant, Ilan Moskowitz ("Applicant's Decl.") with exhibits, including Opposer's responses to Applicant's interrogatories; documents consisting of Internet web page printouts and articles, copies of digital or printed advertisements and promotional flyers, and a receipt, relating to Applicant's use of the mark MILLENNIAL FALCON.<sup>13</sup>

### III. Evidentiary Issues

Before turning to the merits, we discuss the parties' evidentiary objections

#### A. Opposer's Objections

Opposer objects to Applicant's reliance on two third-party registrations and two Wikipedia links that were identified for the first time and relied on by Applicant in his responsive brief.<sup>14</sup> Opposer correctly notes that merely listing third-party registration numbers in a brief does not make them of record, *see e.g., Edom Labs. Inc. v. Lichter*, 102 USPQ2d 1546, 1550 (TTAB 2012), TBMP § 704.03(b)(1), and that providing web addresses or hyperlinks without the material attached is insufficient to introduce them into the record.<sup>15</sup> *TV Azteca, S.A.B. de C.V. v. Martin*, 128 USPQ2d

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<sup>10</sup> 23-24 TTABVUE (NOR 6-7).

<sup>11</sup> 26-27 TTABVUE (NOR 9-10).

<sup>12</sup> 28 TTABVUE (NOR 11).

<sup>13</sup> 12 TTABVUE 12-34 (Applicant's Motion for Summary Judgment, Exhibits A-C).

<sup>14</sup> 40 TTABVUE 5 (Opposer's Reply Brief).

<sup>15</sup> *Id.*

1786, 1789 n.15 (TTAB 2018); TBMP § 704.08(b). Moreover, nothing in the parties' ACR stipulation purports to allow the parties to introduce evidence in this fashion. Accordingly, the Board sustains Opposer's objection to the third-party registrations and website links provided by Applicant and will not consider them or the arguments based thereon.

Opposer also objects to certain statements by Applicant in paragraphs 6-7, 9, and 11, of his declaration for lack of personal knowledge, lack of foundation, and speculation, and to all of the printed matter attached to Exhibit B of Applicant's declaration on the basis that the statements and materials are hearsay but offered for the truth of the matter asserted.<sup>16</sup> We decline to exclude this evidence, which is not outcome determinative, and will consider it for what it is worth. *See Grote Indus., Inc. v. Truck-Lite Co., LLC*, 126 USPQ2d 1197, 1200 (TTAB 2018); *U.S. Playing Card Co. v. Harbro LLC*, 81 USPQ2d 1537, 1540 (TTAB 2006) (“[B]ecause an opposition is akin to a bench trial, the Board is capable of assessing the proper evidentiary weight to be accorded the testimony and evidence, taking into account the imperfections surrounding the admissibility of such testimony and evidence.”).

### **B. Applicant's Objections**

Applicant objects to and moves to strike from the record what he characterizes as “Opposer's secret, undisclosed evidence” relied on by Opposer but redacted from the public version of its main brief:<sup>17</sup>

Opposer's brief hides what appears to be its most important evidence

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<sup>16</sup> 29 TTABVUE (Opposer's Statement of Objections).

<sup>17</sup> 35 TTABVUE 6.

and argument regarding the MILLENNIAL FALCON mark and whether it has acquired distinctiveness or fame. ... Opposer has not, to [Applicant's] knowledge, presented any argument to the Board as to why its secret evidence and secret argument should be allowed. If it has presented such argument, then this is just another layer of unfairness visited on [Applicant] by one of the biggest corporations in the world. The Board should not countenance such secret evidence and secret argument, whether or not that might appear to be allowed by the Board's rules, because this conduct violates fundamental principles of due process.

Opposer could have offered a confidentiality agreement to [Applicant] but never did. Instead it took advantage of rules that, as applied in this proceeding, are deeply unfair and un-American.

In response, Opposer explains that its April 2019 responses to Applicant's discovery requests included general and specific objections to requests seeking information or evidence designated by Opposer as being "Confidential – For Attorneys' Eyes Only (trade secret/commercially sensitive)" ("AEO"), and informed Applicant that Opposer "intended to rely on those materials at trial but would not produce them to pro se Applicant pursuant to TBMP § 412.02(b)."<sup>18</sup> Correspondence between the parties then followed, wherein Applicant alleged various purported deficiencies, while Opposer maintained that its objections and responses were proper.<sup>19</sup> Opposer argues that Applicant, as a party, and as an individual appearing pro se, is not entitled to view materials designated as AEO material as set forth in the Board's Standard Protective Order, and that Applicant waived its objections by not challenging the sufficiency of Opposer's responses through a motion to compel.<sup>20</sup>

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<sup>18</sup> 40 TTABVUE 16 (Opposer's Reply Brief); 38 TTABVUE 2-51 (Taylor Decl., Exhibit 1).

<sup>19</sup> *Id.* at 52-62 (Exhibits 2-3).

<sup>20</sup> 40 TTABVUE 15-16 (Opposer's Reply Brief).

We agree.

Applicant was notified at the start of this proceeding that the Board's Standard Protective Order is automatically imposed in all inter partes proceedings and was provided a link to that order.<sup>21</sup> The Standard Protective Order governs the exchange of information unless the Board approves a modified agreement, either by stipulation or upon motion. 37 C.F.R. § 2.116(g); *Kairos Inst. of Sound Healing LLC v. Doolittle Gardens LLC*, 88 USPQ2d 1541, 1544 (TTAB 2009); TBMP § 412.01. It provides for two tiers of protected information: (1) Confidential and (2) Confidential – For Attorneys' Eyes Only (trade secret/ commercially sensitive).<sup>22</sup> "Parties and those parties or individuals appearing pro se will not have access to information designated as [AEO]." *Id.*; see also *U.S. Polo Ass'n v. David McLane Enters., Inc.*, 2019 USPQ2d 108442, at \*2 (TTAB 2019) ("Parties, including in-house counsel, do **not** have access to information designated 'AEO'"). Accordingly, under the terms of the Standard Protective Order, Applicant, as a party and individual appearing in this matter pro se, is not entitled to gain access to AEO materials.

Paragraph 14 of the Standard Protective Order provides a remedy to a party who believes that materials have been improperly designated as confidential: "the party challenging the designation may make a motion before the Board seeking a determination of the status of the information. A challenge to the designation of information as protected must be made substantially contemporaneous with the

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<sup>21</sup> 2 TTABVUE 4. (Link: <https://www.uspto.gov/trademarks-application-process/appealing-trademark-decisions/standard-documents-and-guidelines-0>).

<sup>22</sup> 38 TTABVUE 68 (Taylor Decl., Exhibit A – Board's Standard Protective Order, ¶ 14).



designation, or as soon as practicable after the basis for challenge is known.”<sup>23</sup> *See also* TBMP § 412.01(b). Thus, Applicant could have challenged Opposer’s designation of AEO materials at the time of designation if he believed the designation was improper, but he did not do so. He therefore waived his right to object to Opposer’s AEO designations.

Applicant represents himself in this proceeding, which the applicable rules permit him to do, notwithstanding the Board’s recommendations against it. However, Board proceedings often involve complicated issues of substantive law and procedure, which can prove difficult for a layperson. While we have kept in mind that Applicant is representing himself, we are limited in our ability to excuse the consequences of his unfamiliarity with the law. Strict compliance with the Trademark Rules of Practice is expected of all parties before the Board. *See McDermott v. San Francisco Women’s Motorcycle Contingent*, 81 USPQ2d 1212 n.2 (TTAB 2006), *aff’d*, 240 Fed. App’x 865 (Fed. Cir. 2007).<sup>24</sup>

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<sup>23</sup> *Id.*

<sup>24</sup> Applicant’s suggestion that Opposer was required to first present argument to the Board before designating evidence as AEO material reflects a misunderstanding of the applicable trademark rules and procedures. 11 TTABVUE 10-11. The Board’s Institution Order warned Applicant that this proceeding “is similar to a civil action in a federal district court and can be complex. The Board strongly advises all parties to secure the services of an attorney who is familiar with trademark law and Board procedure.” 2 TTABVUE 6. The Board cautioned Applicant again when it granted Opposer’s motion to strike Applicant’s insufficiently pled affirmative defenses earlier in this proceeding that “while Patent and Trademark Rule 10.14 permits any person to represent him or herself, it is generally advisable for a person who is not acquainted with the technicalities of the procedural and substantive law involved in an opposition or cancellation proceeding to secure the services of an attorney who is familiar with such matters.”

#### IV. Entitlement to a Statutory Cause of Action

Entitlement to a statutory cause of action is a threshold issue in every inter partes case. *See Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *John W. Carson Found. v. Toilets.com, Inc.*, 94 USPQ2d 1942, 1945. A party in the position of plaintiff may oppose a mark “where it has “both a ‘real interest’ in the proceedings as well as a ‘reasonable’ basis for its belief of damage.” *Empresa Cubana*, 111 USPQ2d at 1062 (citing *ShutEmDown Sports, Inc. v. Lacy*, 102 USPQ2d 1036, 1041 (TTAB 2012) (quoting *Ritchie v. Simpson*, 170 F.3d 1092 (Fed. Cir. 1999)).

Opposer, with its notice of opposition, provided a current copy of information from the USPTO’s Trademark Status & Document Retrieval (TSDR) system database showing the current status and title of its pleaded Registration No. 2450785 for the mark MILLENNIUM FALCON, which is valid and subsisting.<sup>25</sup> Opposer’s entitlement to a cause of action in this proceeding is therefore established. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Primrose Ret. Communities, LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030, 1032 (TTAB 2016) (entitlement to a statutory cause of action established based on pleaded registration made of record).

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<sup>25</sup> 1 TTABVUE 17 (Notice of Opposition).

## **V. The Parties and Their Marks**

### **A. Applicant**

Applicant “is a performer” who “decided to use the Millennial Falcon trademark for his musical performances in May 2016 as a parody of, and satirical comment on, corporate culture, and in particular the culture of the entertainment behemoth, Disney,” which he claims “swallowed the entire Star Wars franchise in the preceding years.”<sup>26</sup> He “envisioned his band as a kind of privateering ship, where he played the role of captain (Captain Contingency) with a crew of like-minded musicians, all of whom identified as members of the Millennial generation”<sup>27</sup> and “wanted his band name to make a statement about millennial-age attitudes toward Disney and Star Wars corporate culture.”<sup>28</sup> Applicant began using the mark MILLENNIAL FALCON in connection with his musical performances “as early as August 5, 2016,” after he filed his application.<sup>29</sup>

### **B. Opposer**

Opposer was founded in 1971 and is the owner of the highly successful Star Wars film franchise, which started with the original 1977 film STAR WARS, and continued over the next four decades with ten subsequent Star Wars films, including<sup>30</sup>

STAR WARS: Episode V - The Empire Strikes Back (1980)
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STAR WARS: Episode - VI Return of the Jedi (1983)
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<sup>26</sup> 12 TTABVUE 2 (Applicant’s Main Brief).

<sup>27</sup> *Id.*

<sup>28</sup> *Id.*

<sup>29</sup> 12 TTABVUE 13 (Applicant Decl. ¶ 7). Applicant does not claim use of the mark in connection with the other services identified in the application.

<sup>30</sup> 31 TTABVUE 3-4 (Gollaher Decl. ¶¶ 6, 8, and 10).

STAR WARS: Episode I - The Phantom Menace (1999)
STAR WARS: Episode II - Attack of the Clones (2002)
STAR WARS: Episode III - Revenge of the Sith (2005)
STAR WARS: The Force Awakens (2015)
Rogue One: A STAR WARS Story (2016)
STAR WARS: The Last Jedi (2017)
Solo: A STAR WARS Story (2018)
STAR WARS: The Rise of Skywalker (2019)

Opposer’s Star Wars films have a variety of characters and canon elements that are part and parcel of Opposer’s Star Wars “fictional universe,” and which are featured throughout the film series, including characters such as Luke Skywalker, Darth Vader, Yoda, Obi-Wan Kenobi, Princess Leia, Han Solo, Chewbacca, R2-D2, Rey, Lando Calrissian, and elements such as the Millennium Falcon, Death Star, Lightsaber, The Force, Jedi, and Sith.<sup>31</sup>

The original Star Wars movie generated hundreds of millions of dollars in domestic box office revenues and earned six Academy Awards; the others have either received an Academy Award or have been nominated for one.<sup>32</sup> Collectively, the films include “6 of the top 20 all-time grossing movies by domestic box office,” generating more than \$3.5 billion in earnings.<sup>33</sup> A number of them have been re-released over the years, some with special editions, and they continue to be available through a wide range of media, including on DVD and Blu Ray, through streaming services, and cable TV providers.<sup>34</sup>

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<sup>31</sup> *Id.* at 6, 12 (¶¶ 15, 35).

<sup>32</sup> *Id.* at 4 (¶ 9 and 11).

<sup>33</sup> *Id.* at 5. (¶ 12).

<sup>34</sup> *Id.* (¶ 14).

The Star Wars films are also well-known for their musical scores. The original Star Wars film was selected by the American Film Institute as the greatest American film of all time, and in 2005 the Library of Congress entered its soundtrack into the National Recording Registry for being “culturally, historically, or aesthetically significant,” the first entry of its kind.<sup>35</sup> Two of the soundtrack albums for the Star Wars films have been certified Platinum, two were certified Gold, and more than 1.5 million units have sold collectively.<sup>36</sup>

Since 2009, Opposer, itself or through its licensees, has offered a STAR WARS concert tour around the United States that features a band playing live music from the STAR WARS Films while the films are displayed.”<sup>37</sup> Opposer’s advertisements and promotions for these concerts display various Star Wars characters and canon elements, including the Millennium Falcon spaceship.<sup>38</sup>

Since 1977, Opposer has, itself or through licensees, produced, marketed, distributed, and sold a wide range of consumer products and merchandise tied to Opposer’s STAR WARS films, its characters and elements, including the Millennium Falcon spaceship element that comprises Opposer’s MILLENNIUM FALCON mark in this proceeding.<sup>39</sup> Opposer’s parent company, The Walt Disney Company (“Disney”), took over Opposer’s production, marketing, distribution and sales when it

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<sup>35</sup> *Id.* at 6 (¶ 18).

<sup>36</sup> *Id.* at 7 (¶ 19).

<sup>37</sup> *Id.* (¶ 20).

<sup>38</sup> *Id.* at 26-28 (¶ 52).

<sup>39</sup> *Id.* at 7-8 (¶ 22).

acquired Opposer in 2012.<sup>40</sup> Recognized as one of the top licensors in the United States, Disney “engages in a vast licensing program under which it licenses the use of [Opposer’s] brands, characters, and elements in connection with a wide variety of products and services, including ...but not limited to, entertainment services, theater productions, television programs, motion picture films, comic books, books, toys, dolls, sporting goods, bags, personal-care products, linens, towels, apparel, food, online games, computer games, video games, music, and mobile applications, among other things.”<sup>41</sup>

Millennium Falcon is the name of the fictional spaceship piloted by Han Solo (played by actor Harrison Ford), a smuggler, and his co-pilot, Chewbacca.<sup>42</sup> In the 1977 STAR WARS film, Hans Solo’s spaceship is chartered by Luke Skywalker, Obi-Wan Kenobi, and droids R2-D2 and C-3PO, “to safely transport stolen plans of the Death Star space station and superweapon operated by the Galactic Empire and its leader the evil Darth Vader.”<sup>43</sup> The ship and its passengers are captured, but after saving the Princess Leia, they escape on the Millennium Falcon and in the final battle, the Death Star is destroyed.<sup>44</sup> An image of the Millennium Falcon from the film is shown below:<sup>45</sup>

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<sup>40</sup> *Id.* at 8 (¶ 23).

<sup>41</sup> *Id.* at 9 (¶ 24).

<sup>42</sup> *Id.* at 4, 9 (¶¶ 8, 28).

<sup>43</sup> *Id.* at 9-10 (¶ 28).

<sup>44</sup> *Id.* at 10 (¶¶ 28-29).

<sup>45</sup> *Id.* at 11 (¶ 30))



Opposer's Millennium Falcon spaceship has been featured in a number of television series and documentaries since 1997, including<sup>46</sup>

The Making of STAR WARS (ABC, 1977)
SPFX: The Making of THE EMPIRE STRIKES BACK (CBS, 1980)
Classic Creatures: RETURN OF THE JEDI (CBS, 1983)
From STAR WARS to JEDI: The Making of a Saga (PBS, 1983)
LEGO STAR WARS: The Empire Strikes Out (Cartoon Network, 2012)
LEGO STAR WARS: The Hunt for Luke Skywalker (YouTube, 2014),
LEGO STAR WARS Microfighters (Lego.com and YouTube, 2014, 2016)
LEGO STAR WARS: Droid Tales (Disney XD, 2015, available on Disney+)
LEGO STAR WARS: The Resistance Rises (Disney XD, 2016)
STAR WARS Blips (YouTube, 2017)
LEGO STAR WARS: All-Stars (Disney XD, 2018, now DISNEY+)
LEGO STAR WARS: The Freemaker Adventures (Disney XD, 2016-2017, now DISNEY+ streaming service)
STAR WARS: Forces of Destiny (YouTube, 2017-2018, now on The Disney Channel)
STAR WARS Galaxy of Adventures (2018-present, starwarskids.com, YouTube)

<sup>46</sup> *Id.* at 12-14 (¶¶ 36-38).

The consuming public has had continued access to the Star Wars film franchise up to the present time: The Disney Channel had 86 million subscribers, and Disney XD channel had 68 million subscribers, as of September 2019; the Disney+ subscription services had 50+ million subscribers as of April 8, 2020.<sup>47</sup> Sales and revenues from DVDs, Blue Rays, and digital versions of Opposer's STAR WARS films, which feature the Millennium Falcon spaceship, have been substantial.<sup>48</sup>

MILLENNIUM FALCON-branded toy vehicles is an early example of Opposer's merchandising of consumer products, which was first offered in 1977 and continued to be offered to the present time.<sup>49</sup> These goods, covered by Opposer's Registration No. 2450785, include various toy vehicles in the nature of MILLENNIUM FALCON-branded LEGO toy construction (which have had substantial commercial success as determined by unit sales revenues), toy vehicle models and kits, toy vehicle dolls and plush toys, toy vehicle pool floatation devices, and other toys, some examples of which are shown below:<sup>50</sup>

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<sup>47</sup> *Id.* at 14 (¶ 39).

<sup>48</sup> Opposer has designated its sales units and revenues for these goods as confidential so we only refer to them in general terms.

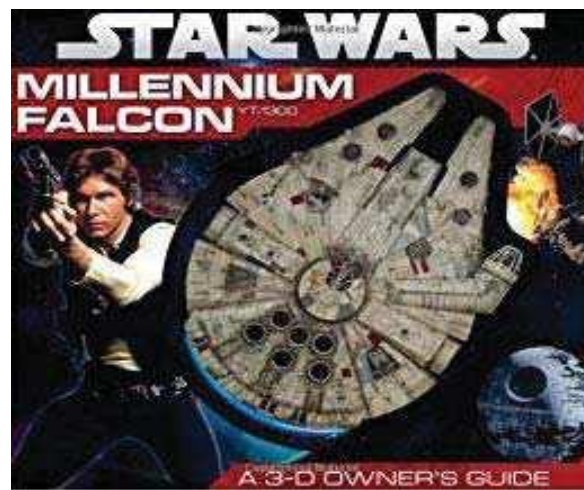
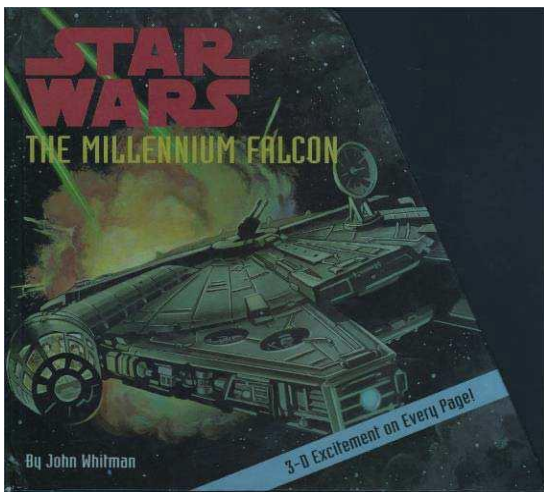
<sup>49</sup> *Id.* at 39 (¶ 68).

<sup>50</sup> *Id.* at 41 (¶ 59).





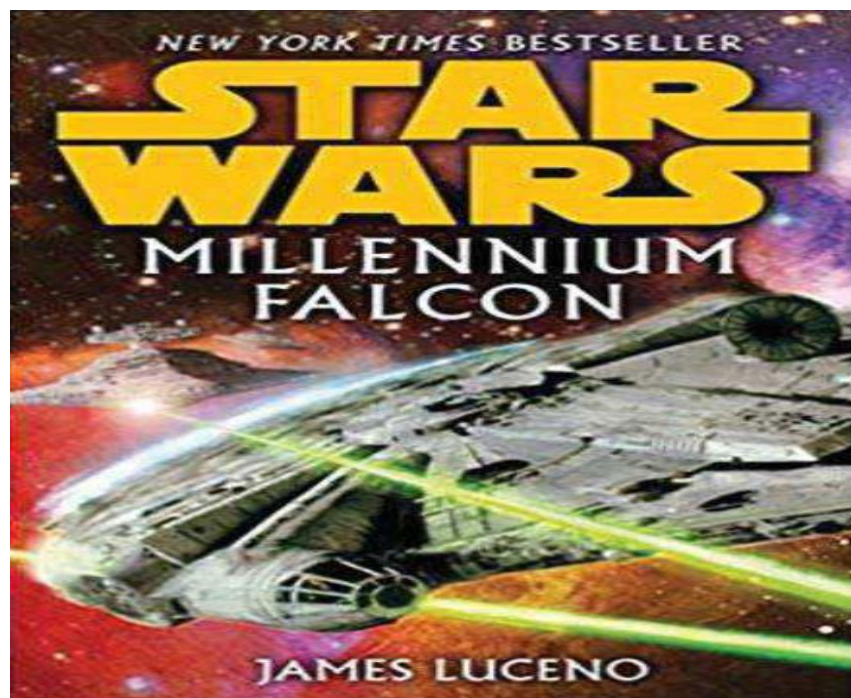
Opposer has used MILLENNIUM FALCON on or in connection with a series of printed publications over the years, including with 2008 New York Times bestseller book titled STAR WARS – MILLENNIUM FALCON, and has been “featured in the title and on the cover of at least 10 other books” including: STAR WARS THE MILLENNIUM FALCON pop-up book, (1977); STAR WARS MILLENNIUM FALCON – A 3-D Owner’s Guide (2010, revised 2018); STAR WARS MILLENNIUM FALCON – Owner’s Workshop Manual (2011); STAR WARS MILLENNIUM FALCON deluxe model and book Set (2016); STAR WARS - BUILDERS – MILLENNIUM FALCON (2016) book and model; and IncrediBuilds STAR WARS – MILLENNIUM FALCON book and model, which continue to be available from nationwide retailers. The mentioned publications are shown below:<sup>51</sup>



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<sup>51</sup> *Id.* at 15-18 (¶¶ 41-43).





These publications generated substantial revenues for Opposer during 2015-2018.<sup>52</sup>

Opposer has also used the mark MILLENNIUM FALCON and MILLENNIUM FALCON CHALLENGE on or in connection with games, including computer and video games over the years, including “the 1994 computer game STAR WARS MILLENNIUM FALCON, the 1997 handheld video game STAR WARS MILLENNIUM FALCON CHALLENGE, and the 1997 video game STAR WARS MILLENNIUM FALCON CHALLENGE for the “R-Zone” gaming platform, several of which are shown below:<sup>53</sup>

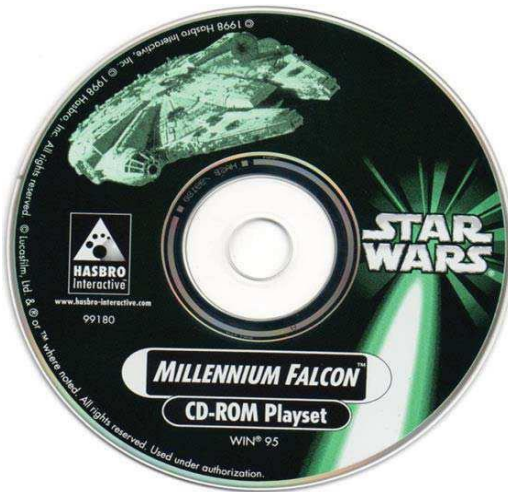


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<sup>52</sup> *Id.* at 20 (¶ 46).

<sup>53</sup> *Id.* at 20-23 (¶ 47).



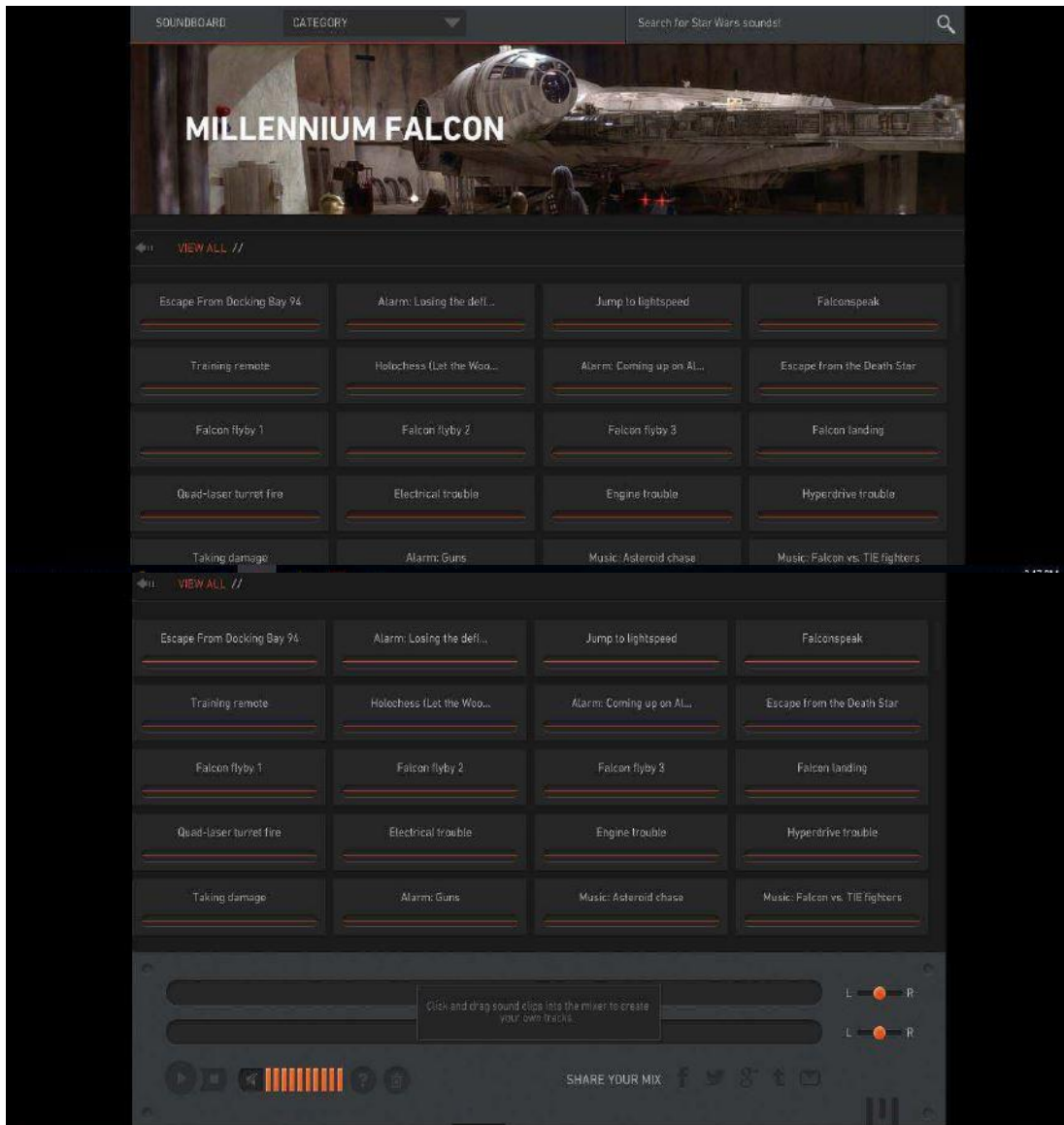


The Millennium Falcon spaceship has also “been featured in numerous computer and video games. In some of these other computer and video games, players could virtually fly the MILLENNIUM FALCON spaceship,” such as with the 2015 game, Star Wars Battlefront, which “was the biggest video game release in Star Wars history, with more than 13 million units sold as of February 2016.”<sup>54</sup>

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<sup>54</sup> *Id.*

Since 2010, Opposer has used the mark MILLENNIUM FALCON for providing an online soundboard. The soundboard, “prominently displays the MILLENNIUM FALCON Mark and spaceship and allows consumers to create musical tracks with sound effects from the MILLENNIUM FALCON spaceship.”<sup>55</sup> Screen shots of the soundboard are shown below:<sup>56</sup>



<sup>55</sup> *Id.* at 29-30. (¶ 55).

<sup>56</sup> *Id.* at 232 (Exhibit 6).

In addition, Opposer has licensed use of the name MILLENNIUM FALCON for various consumer products over the years, since 1977, including for the following goods: “clothing, sleepwear, underwear, bags, backpacks, wallets, luggage, headwear, gloves, accessories, jewelry, footwear, clocks, watches, drinkware, lunch boxes, drink accessories, room décor, bedding, kitchenware, Christmas ornaments, speakers, consumer electronics, costumes, games, model kits, toys, toy vehicles, plush toys, outdoor play toys, prop replicas, stationery, trading cards, and wall décor,” some examples of which are shown below:<sup>57</sup>



<sup>57</sup> *Id.* at 36-37 (¶ 64).





Since 2016, Opposer has, itself or through licensees, provided a MILLENNIUM FALCON loudspeaker through nationwide retailers such as Amazon.com, Walmart, and Kohl's.<sup>58</sup>



Opposer uses the Millennium Falcon spaceship element in various other ways over the years. For example, two songs have used Millennium Falcon in their name: “The Millennium Falcon / Imperial Cruiser Pursuit” from the 1997 soundtrack of the film STAR WARS: A New Hope, and “L3 & Millennium Falcon” from the 2018 soundtrack of the film Solo: A STAR WARS Story.<sup>59</sup> Opposer’s Millennium Falcon spaceship has

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<sup>58</sup> *Id.* at 38-39 (¶ 67).

<sup>59</sup> *Id.* at 29 (¶ 54).



also been used since 2011 at Disneyland in California, and at Disney World in Florida, in connection with motion simulator rides that display the spaceship “so that consumers feel like they are ‘following’ the MILLENNIUM FALCON spaceship into space.”<sup>60</sup> Since 2015, Disney has provided entertainment services related to the Millennium Falcon spaceship aboard its cruise ships, such as an interactive replica of the interior of the spaceship with interactive panels in the “Star Wars Millennium Falcon” game room on its ship, the Disney Dream, an excerpt of which is shown below:<sup>61</sup>



## VI. Likelihood of Confusion

Section 2(d) of the Trademark Act prohibits the registration of a mark that “[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.” 15

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<sup>60</sup> *Id.* at 30 (¶ 56).

<sup>61</sup> *Id.* at 32, 239 (¶ 60 and Exhibit 8).

U.S.C. § 1052(d). To prevail on its § 2(d) claim, Opposer must prove, by a preponderance of the evidence, that it has priority in the use of its mark and that registration of Applicant's mark is likely to cause confusion, mistake, or deception as to the source or sponsorship of the services identified in his application. *Cunningham v. Laser Golf Corp.*, 55 USPQ2d at 1848.

Our analysis is based on all of the probative evidence of record. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”). In making our determination, we consider each *DuPont* factor for which there is evidence and argument. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. *See Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) (“[T]he various evidentiary factors may play more or less weighty roles in any particular determination”).

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and services. *See In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”).

### **A. Priority**

Because Opposer's pleaded registration is of record, priority in the opposition proceeding is not at issue with respect to the mark and "toy vehicle" goods identified therein. *Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1469 (TTAB 2016) (citing *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974)).

Moreover, as discussed above, the evidence shows that Opposer used MILLENNIUM FALCON as a mark in connection with books, computer and video games, online soundboards, and a variety of consumer products (i.e., clothing, footwear, bags, watches, drinkware, room décor, bedding, kitchenware, speakers, games, model kits, toys, toy vehicles, plush toys, prop replicas, stationery, trading cards), all prior to June 9, 2016, the constructive use date of Applicant's intent-to-use application, and the earliest date on which Applicant is entitled to rely. Section 7(c) of the Trademark Act, 15 U.S.C. § 1057(c) (In the absence of evidence establishing earlier use of its mark, a party may rely for priority purposes on the filing date of its application); *Cent. Garden & Pet Co. v. Doskocil Mfg. Co.*, 108 USPQ2d 1134, 1140 (TTAB 2013); *Syngenta Crop Prot., Inc. v. Bio-Chek, LLC*, 90 USPQ2d 1112, 1119 (TTAB 2009).

### **B. Similarity of the Marks**

The first *DuPont* factor considers the "similarities or dissimilarities of the marks in their entireties as to appearance, sound, connotation and commercial impression." *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1049 (Fed. Cir. 2018)

(quoting *DuPont*, 177 USPQ at 177). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s*, 126 USPQ2d 1742, 1746 (TTAB 2018) (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff’d mem.*, 777 Fed. Appx. 516 (Fed. Cir. 2019).

The test is not whether the marks can be distinguished in a side-by-side comparison, but rather whether their overall commercial impressions are so similar that confusion as to the source of the goods and services offered under the respective marks is likely to result. *See Zheng Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (citing *Coach Servs. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012)). Our focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of marks. *Spoons Rests., Inc. v. Morrison, Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff’d mem.*, 972 F.2d 1353 (Fed. Cir. 1992); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1740 (TTAB 2014); *Neutrogena Corp. v. Bristol-Myers Co.*, 410 F.2d 1391, 161 USPQ 687, 688 (CCPA 1969) (many consumers “may have but dim recollections from having previously seen or heard one or the other of the involved marks.”).

Opposer’s mark is MILLENNIUM FALCON and Applicant’s mark is MILLENNIAL FALCON. Both marks are arbitrary with respect to the parties’ goods and services, and they are almost identical in appearance, sound, connotation, and commercial impression (differing only in the last two letters of their respective first

9-letter words). A “millennium” is “a period of 1000 years.”<sup>62</sup> “Millennial,” an adjective of the noun millennium, means “of or relating to a millennium.”<sup>63</sup> The terms thus convey the same connotation and commercial impression.

“Millennial” is also defined as “a person born in the 1980s or 1990s – usually plural” (noun), and “of or relating to millennials” (in adjective form).<sup>64</sup> Based on this alternate definition, Applicant disputes that the marks are similar, particularly as to meaning:<sup>65</sup>

Millennial, in the context in which [Applicant] uses it is not a period of time at all but rather is an adjective used in reference to a stereotypical view of a presumed set of attitudes and behaviors exhibited by a particular set of American’s, i.e., the Millennial generation. [Applicant] chose to parody the corporate culture represented by Millennium Falcon to lampoon the glut of marketing and production of elements of the franchise aimed at the Millennial generation by Disney/[Opposer] in their attempt to control the market for entertainment on all levels. In doing so, [Applicant] created a trademark with a meaning that is in critical and obvious opposition to Opposer’s asserted trademark....

One aspect of this different meaning and the parody it expresses is that, just as the Millennium Falcon is used by rebel forces to fight a totalitarian empire, the Millennial Falcon is the vehicle for [Applicant] to rebel against the overreaching corporate empire. The name “Millennial Falcon,” also evokes and pokes fun at a certain pop culture nostalgia experienced by the Millennial generation in consuming Opposer’s products and services. The parody is a joke aimed at Disney/[Opposer’s] use of this generational nostalgia to sell products to Millennials and their families. Members of the Millennial generation understand this parody and appreciate it.

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<sup>62</sup> 22 TTABVUE 141-148 (Opposer’s NOR 5, Exhibit 7).

<sup>63</sup> *Id.*

<sup>64</sup> *Id.*

<sup>65</sup> 12 TTABVUE 6-7 (Applicant’s Main Brief) (emphasis added, citations omitted).

“However, we must look to the likely consumer perception of the mark in connection with the identified goods [and services], rather than applicant’s intended connotation.” *UMG Recordings, Inc. v. Mattel, Inc.*, 100 USPQ2d 1868, 1886 (TTAB 2011). Notwithstanding Applicant’s intention to impart the above-described connotation for his mark, the record is devoid of evidence showing that the relevant public perceives the mark in that way.

Applicant admits that MILLENNIAL FALCON “conjures up the phrase “Millennium Falcon,”<sup>66</sup> which he argues is necessary in order for there to be a parody at all, and that “[a]ny perceived similarities between [the marks] are solely for illustrating the obvious parody.”<sup>67</sup> We agree with Applicant that MILLENNIAL FALCON conjures up Opposer’s mark, but find no parody in the wording, much less one that is obvious. Moreover, we have long held that parody is a viable defense in a likelihood of confusion analysis only if the involved marks are otherwise not found confusingly similar. Here, the marks are virtually identical. *See Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1592 (TTAB 2008) (“Parody is not a defense if the marks would otherwise be considered confusingly similar.”).

We therefore reject Applicant’s argument that there is any significant difference between the marks. To suggest otherwise is to inflate the importance of the subtle differences beyond reason. Simply put, the two marks are not only highly similar in appearance and sound, but the differences are nearly imperceptible apart from a side -

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<sup>66</sup> 7 TTABVUE 8-9 (Applicant’s Answer).

<sup>67</sup> 12 TTABVUE 9 (Applicant’s Main Brief).

by-side comparison. The first *DuPont* factor weighs heavily in favor of finding a likelihood of confusion.

### **C. Similarity of the Goods and Services**

The second *DuPont* factor considers the “similarity or dissimilarity and nature of the goods or services as described in an application or registration,” *Detroit Athletic*, 128 USPQ2d at 1047 (quoting *DuPont*, 177 USPQ at 567).

It is “not necessary that the goods [and services] be identical or even competitive to support a finding of a likelihood of confusion.” *Coach Servs.*, 101 USPQ2d at 1722 (quoting *7-Eleven, Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)). “[L]ikelihood of confusion can be found ‘if the respective goods [and services] are related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the same source.’” *Id.* It is “well established that ‘confusion may be likely to occur from the use of the same or similar marks for goods, on the one hand, and for services involving those goods, on the other.’” *Detroit Athletic*, 128 USPQ2d at 1051 (quoting TMEP § 1207.01(a)(ii)).

Applicant’s identification of services includes live visual and audio performances by a live musical performance group, a musical band, and a rock group; gymnastic, dance, and ballet performances; multimedia entertainment services in the nature of recording, production and post-production services in the fields of music, video, and films; production of musical sound and video recordings.

Opposer’s registration for the mark MILLENNIUM FALCON covers toy vehicles.

However, it is clear from the record that Opposer uses its mark in commerce for many other goods and services. Indeed, MILLENNIUM FALCON is a merchandising mark, part and parcel of the STAR WARS mythos in promoting Opposer's films and music, and has been the subject of licenses for numerous collateral products.

"It is common knowledge, and a fact of which we can take judicial notice, that the licensing of commercial trademarks on 'collateral' products [and services] has become a part of everyday life." *DC Comics v. Pan Am. Grain Mfg. Co. Inc.*, 77 USPQ2d 1220, 1225 (quoting *Turner Entertainment Co. v. Nelson*, 38 USPQ2d 1942, 1945-1946 (TTAB 1996)). The record shows that Opposer has since 1977, and more aggressively since Disney took over its producing, marketing, distribution, and sales in 2012, used its STAR WARS trademarks, characters, elements, and brands, including the fictional MILLENNIUM FALCON spaceship, with a wide variety of products and services including entertainment services, theater productions, television programs, motion picture films, comic books, books, toys, dolls, sporting goods, bags, personal-care products, linens, towels, apparel, food, online games, computer games, video games, music, and mobile applications.<sup>68</sup>

Opposer's "[l]icensees over the years include numerous well-known companies such as Disney, Marvel, Hasbro, Hallmark, Mattel, LEGO, Revell, Kenner, Bandai, Tiger Electronics, Topps, Crayola, and NASCAR, just to name a few."<sup>69</sup> "Sales of STAR WARS merchandise has been tremendous. For example, global retail sales for

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<sup>68</sup> 30-31 TTABVUE 7-8 (Gollaher Decl., ¶ 22-23).

<sup>69</sup> *Id.* at 65 (¶ 65).



STAR WARS merchandise in the first quarter of 2016, which included various items of MILLENNIUM FALCON merchandise, exceeded \$3 billion, a significant portion of which took place in the United States.”<sup>70</sup>

Mr. Gollaher testified that that “[s]ales of MILLENNIUM FALCON branded merchandise have likewise been enormous,” and that it has earned substantial revenues “for other merchandise sold by licensees bearing the MILLENNIUM FALCON Mark.”<sup>71</sup> Opposer has designated its revenues as confidential, so we only refer to them in general terms, but we agree that they are substantial.

Although MILLENNIUM FALCON has not been used on as wide a variety of goods as the STAR WARS mark, it has been used as a mark on or in connection with many goods, by Opposer or by licensees, with printed publications, games, computer and video games, loudspeakers, “clothing, sleepwear, underwear, bags, backpacks, wallets, luggage, headwear, gloves, accessories, jewelry, footwear, clocks, watches, drinkware, lunch boxes, drink accessories, room décor, bedding, kitchenware, Christmas ornaments, speakers, consumer electronics, books, games, computer games and videos, toys, model kits, loudspeakers, online soundboards, clothing, footwear, bags, wallets, luggage, jewelry, watches, drinkware, lunch boxes, room décor, bedding, kitchenware, Christmas ornaments, costumes, stationery, trading cards, and other goods.”<sup>72</sup> Further, Opposer has used MILLENNIUM FALCON as the

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<sup>70</sup> *Id.* at 63 (¶ 84).

<sup>71</sup> *Id.* at 63-64 (¶ 86).

<sup>72</sup> *Id.* at 15-18, 20-23, 29-30, 36-38 (¶¶ 41-43, 47, 55, 64, 67).

name of its spaceship in conjunction with its STAR WARS films, television series, musical recordings, and live concerts.

Consumers are therefore likely to view MILLENNIUM FALCON as a merchandising mark. The “element” to which Opposer gave the name MILLENNIUM FALCON has been used in the various STAR WARS stories for so many decades, and is an integral part of the stories, to the point that it is akin to a character in the stories. In addition, because Opposer coined the word term “MILLENNIUM FALCON” for the fictional spaceship portrayed in the films (and therefore it has no other meaning), when consumers see the term they will view it as an indicator of the STAR WARS mythos.

Although Opposer does not specifically provide its musical recordings and concerts under the MILLENNIUM FALCON mark, it is clear from the evidence that Opposer associates its well-known Star Wars element, the MILLENNIUM FALCON spaceship, with its STAR WARS films, television series, musical recordings and concerts. Applicant, in addition to identifying musical performances in the opposed application, identifies entertainment multimedia entertainment services of musical and sound recording, production and post-production services in the fields of music, video, and films.

Thus, the question is whether the parties’ respective goods/services are related in some manner or that the conditions surrounding their marketing are such that they would be encountered by the same persons under circumstances that could, in light of the close similarity of the marks, give rise to the mistaken belief that the goods

come from or are associated with the same source. *Coach Servs.*, 101 USPQ2d at 1722; *Anheuser-Busch, LLC v. Innvopak Sys. Pty Ltd.*, 115 USPQ2d 1816, 1826 (TTAB 2015). That is, in this marketing environment, including the licensing of commercial marks, will the purchasing public believe that Applicant's musical performances, and/or its musical and sound recording, production and post-production services in the fields of music, video, and films come from or are sponsored by or associated with Opposer? On this record, we find that the answer is in the affirmative. *Hewlett-Packard v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) ("Even if the goods and services in question are not identical, the consuming public may perceive them as related enough to cause confusion as to source or origin of the goods and services."); *see also L.C. Licensing, Inc. v. Berman*, 86 USPQ2d 1883, 1890 (TTAB 2018) (quoting *Recot Inc. v. M.C. Becton*, 214 F.3d 1332, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) ("Even if the goods [or services] in question are different from, and thus not related to, one another in kind, the same [goods or services] can be related in the mind of the consuming public as to the origin of the goods. It is this sense of relatedness that matters in the likelihood of confusion analysis.")).

In many ways, Opposer's use of MILLENNIAL FALCON as a merchandising mark is similar to the way DC Comics used its KRYPTONITE mark. In *DC Comics*, the opposer was primarily a publisher of print media containing stories about various superhero characters, including Superman, its first superhero character from 1938. *DC Comics*, 77 USPQ2d at 1223. "Kryptonite," composed of mineral fragments from the doomed planet Krypton, appeared in the story beginning in 1949, and is a key

element in the story “as it is the only thing that can bring Superman down.” *Id.*

The opposer in DC Comics only owned registrations for t-shirts, toys, games, action figures and accessories therefor, but it also licensed the use of its KRYPTONITE mark for goods such as jewelry, gum, and crystals. *Id.* at 1225. When opposer licensed its “Superman property,” it permitted the licensee to use any of the elements of the Superman mythos or universe including the Kryptonite element. *Id.* at 1223. In addition, the opposer had used its mark in promotions and tie-ins with Kraft macaroni and cheese (“It Sure Beats A Bowl of Kryptonite”) and Diet Coke (“Caffeine Free. Kryptonite Free.”) *Id.* The Board found opposer’s goods “obviously different” from the applicant’s identification of goods for prepared alcoholic fruit cocktails.

The Board found in *DC Comics* that “[a]lthough KRYPTONITE has not been used on the wide variety of goods that the Superman mark itself has been used, it has been used on various items,” and that

[c]onsumers would be “likely to view KRYPTONITE as a merchandising mark in the same manner that Superman is a merchandising mark”: the “element” to which opposer gave the name “kryptonite” has been used in the various Superman stories for so many decades, and is an integral part of the stories, to the point that it is akin to a character in the stories. In addition, because opposer coined the word “KRYPTONITE” for the fictional substance (and therefore it has no other meaning), when consumers see the term they will view it as an indicia of the Superman mythos.

Accordingly, the Board found that the parties’ goods were sufficiently related such that consumers would believe that they come from or are associated with the same source. *Id.* at 1226-1227.

We find, similarly, that because Opposer has used MILLENNIUM FALCON as a merchandising mark with respect to a variety of goods; because consumers recognize that, in the general marketing environment, merchandising marks are used to identify a variety of goods and services; and because Opposer has used the term MILLENNIUM FALCON in connection with the promotion of its STAR WARS films, television series, musical recordings, and live concerts, we find that, in the sense discussed in the *Recot* and *Hewlett Packard* cases, Applicant's services and Opposer's goods and services are related. Based on the foregoing, and taking into account that the more similar the marks at issue, the less similar the goods or services need to be to support a finding of likelihood of confusion, *see General Mills, Inc. v. Fage Dairy Processing Indus. S.A.*, 100 USPQ2d 1584, 1597 (TTAB 2011), *judgment set aside on other grounds*, and *General Mills, Inc. v. Fage Luxembourg S.A.R.L.*, 110 USPQ2d 1679 (TTAB 2014), we find that consumers, encountering MILLENNIAL FALCON in connection with Applicant's musical performance and his multimedia musical and sound recording, production and post-production services in the fields of music, video, and films, are likely to believe that the mark has been licensed by Opposer for such services, and that the services are therefore sponsored by Opposer. *See In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *Time Warner Entm't. Co. v. Jones*, 65 USPQ2d 1650, 1661-62 (TTAB 2002); *Harley-Davidson Motor Co., Inc. v. Pierce Foods Corp.*, 231 USPQ 857 (TTAB 1986).

The second *DuPont* factor favors a finding of likelihood of confusion.

#### **D. Similarity of Trade Channels and Classes of Purchasers**

The third *DuPont* factor considers the “similarity or dissimilarity of established, likely-to-continue trade channels.” *DuPont*, 177 USPQ at 567.

Opposer argues that “the evidence shows that both Applicant’s and [Opposer’s] entertainment services in fact travel through the same channels of trade to the same consumers. For example, both market and offer their respective services online, on social media, and at live music venues. Applicant even promotes his services in comic books he offers as part of his record albums.”<sup>73</sup>

Applicant argues that his trade channels are widely separated from Opposer’s marketing and sales practices because “[Applicant] provides the Millennial Falcon services in bars, nightclubs, and the like, and advertises in channels likely to reach the mostly adult clientele for such venues. ... [Applicant’s] services are not provided or advertised in toy stores or in any venue where consumers are looking for any goods or services produced by Disney/[Opposer].”<sup>74</sup>

As discussed, Opposer’s MILLENNIUM FALCON is a merchandising mark, and it has been used as an indicator of the STAR WARS mythos in promoting Opposer’s films and music, and has been the subject of licenses for certain collateral products, so its purview is not limited to the toy vehicles covered by its registration. Additionally, as Opposer has noted, Applicant’s recitation of services contains no

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<sup>73</sup> 32 TTABVUE 37-38 (Opposer’s Main Brief).

<sup>74</sup> 12 TTABVUE 7-8 (Applicant’s Main Brief).

restrictions on channels of trade or customer type.<sup>75</sup> Therefore, we must deem his services to travel in all appropriate trade channels to all potential purchasers of such services. *See Royal Appliance Mfg. Co. v. Minuteman Int'l, Inc.*, 30 Fed. App'x 964, 969 n.1 (Fed. Cir. 2002) (“absent restrictions in the [opposed] application and [asserted] registration, goods and services are presumed to travel in all appropriate trade channels to all potential purchasers of such goods [and services]”); *Cunningham v. Laser Golf Corp.*, 55 USPQ2d at 1846 (affirming Board finding that where the identification is unrestricted, “we must deem the goods to travel in all appropriate trade channels to all potential purchasers of such goods [and services]”).

Based on the foregoing, Applicant’s musical performance services necessarily include the same venues in which Opposer provides its STAR WARS concerts. However, there is insufficient evidence of record that Applicant’s other services are provided in the same channels as Opposer’s other goods and services.

This third *DuPont* factor slightly favors a finding of likelihood of confusion.

#### **E. Purchasing Conditions and Sophistication of Customers**

The fourth *DuPont* factor considers “[t]he conditions under which and buyers to whom sales are made, i.e. ‘impulse’ vs. careful, sophisticated purchasing.” *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (quoting *DuPont*, 177 USPQ at 567).

Applicant argues that “[t]he Millennial Falcon band has a sophisticated audience that will not mistake the two names, but rather is able to recognize both the

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<sup>75</sup> 32 TTABVue 38 (Opposer’s Main Brief).

distinction and the parody being employed.”<sup>76</sup> However, Applicant has not provided any evidence to show that consumers of visual and audio musical performance or its other services are sophisticated. Even if he had, consumers may not be sophisticated or knowledgeable in the field of trademarks or immune from source confusion. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993) (indicating that “even sophisticated purchasers can be confused by very similar marks”); *Top Tobacco, LP v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1170 (TTAB 2011). Moreover, our decision must be based on the “least sophisticated purchasers,” *Stone Lion*, 110 USPQ2d at 1163.

Applicant argues that his services are directed to a “predominantly adult clientele,” unlike those who may purchase Opposer’s toy vehicles.<sup>77</sup> As discussed, Opposer’s goods and services are not limited to toy vehicles. Moreover, adult purchasers are aware of the prevalence and importance of merchandising marks. Because the Millennium Falcon spaceship is such a well-known part of the Star Wars story, adult purchasers of Applicant’s goods would likely be aware of the term Millennium Falcon as part of the Star Wars mythos from their childhoods, as well as from their exposure to the word as adults through general entertainment movies and television programs.

The fourth *DuPont* factor is neutral in our analysis.

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<sup>76</sup> 12 TTABVUE 7 (Applicant’s Main Brief).

<sup>77</sup> 12 TTABVUE 4 (Applicant’s Main Brief).



## **F. Strength of Opposer's Mark**

The fifth *DuPont* factor considers the “fame” or strength of the prior mark, and enables an opposer to expand the scope of protection afforded its pleaded mark by adducing evidence of “[t]he fame of the prior mark (sales, advertising, length of use).” *DuPont*, 177 USPQ at 567. Fame, if it exists, plays a dominant role in the likelihood of confusion analysis because famous marks enjoy a broad scope of protection. A famous mark has extensive public recognition and renown. *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 54 USPQ2d at 1897; *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). Because of the extreme deference that we accord a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting that its mark is famous to clearly prove it. *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007).

The strength of a mark “varies along a spectrum from very strong to very weak.” *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005) (quoting *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1063 (Fed. Cir. 2003)). To determine a mark’s place on that spectrum, we consider its inherent strength, based on the nature of the mark itself, and its commercial strength, based on its marketplace recognition. *See In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A

mark's strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength."); *Bell's Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1345 (TTAB 2017); *Top Tobacco, L.P. v. North Atlantic Operating Co., Inc.*, 101 USPQ2d at 1171-72 (the strength of a mark is determined by assessing its inherent strength and its commercial strength).

Turning first to inherent strength, MILLENNIUM FALCON is fanciful term coined by Opposer and, therefore, it is an inherently strong mark when used in connection with Opposer's goods and services. *See Palm Bay Imps.*, 73 USPQ2d at 1692 (arbitrary terms are conceptually strong trademarks); *Alberto-Culver Co. v. Helene Curtis Indus., Inc.*, 167 USPQ 365, 370 (TTAB 1970) (CANAL HOLDINGS used in connection with investment, management and consultation services is an arbitrary term because it does not describe, or suggest, any quality or characteristic of those services); *see also Nautilus Grp., Inc. v. Icon Health & Fitness, Inc.*, 372 F.3d 1330, 71 USPQ2d 1173, 1180 (Fed. Cir. 2004) (defining an arbitrary mark as a "known word [or term] used in an unexpected or uncommon way" and observing that such marks are typically strong).

Commercial strength may be measured indirectly by the volume of sales and advertising expenditures in connection with the goods or services sold under the mark, and supported by other indicia such as length of time of use of the mark; widespread critical assessments; notice by independent sources of the goods or services identified by the marks; and the general reputation of the goods or services. *Weider Publ'ns, LLC v. D & D Beauty Care Co.*, 109 USPQ2d 1347, 1354 (TTAB 2014);

*Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1308 (Fed. Cir. 2002) (recognizing indirect evidence as appropriate proof of strength). The proper legal standard for evaluating the commercial strength of a mark under the fifth *DuPont* factor is the class of customers and potential customers of a product or service, and not the general public. *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017).

Opposer's demonstration of commercial strength rests primarily on evidence of the success of its Star Wars films, discussed at length above. Recapitulating, the evidence shows that Opposer has used MILLENNIUM FALCON as a mark, and in many other ways, since 1977 in association with its Star Wars franchise. Opposer's witness, Mr. Gollaher, testified that "the films in which [Opposer's] MILLENNIUM FALCON Mark and spaceship have appeared have collectively generated billions of dollars in domestic box office revenues" and that the films "include six of the top twenty all-time grossing movies by domestic box office."<sup>78</sup> "Collective box office revenues from films in which the MILLENNIUM FALCON mark and spaceship have appeared exceeded \$4 billion, with more than \$2 billion from films in the past five years."

As to Opposer's use of MILLENNIUM FALCON as a mark. Mr. Gollaher testified that "global retail sales for STAR WARS merchandise in just the first quarter of 2016, which included various items of MILLENNIUM FALCON-branded merchandise, exceeded \$3 billion, a significant portion of which took place in the United States."

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<sup>78</sup> 30-31 TTABVue 4-5, 12 (Gollaher Delc., ¶ 12, 34).

He further testified regarding revenues generated specifically relating to Opposer's use of the MILLENNIUM FALCON mark in connection with the sale of its books, as well as its toy construction sets sold through its licensee, Lego, made of record confidentially, which are impressive.<sup>79</sup>

Separately, Mr. Gollaher testified that for decades, Opposer's MILLENNIUM FALCON mark "has received extensive media attention from a variety of nationwide publications" over the years, listing various newspapers such as The Washington Post, The Los Angeles Times, The Chicago Tribune, and others.<sup>80</sup> Such media attention to MILLENNIUM FALCON as the famed fictional spaceship from Opposer's Star Wars films further supports the public association of MILLENNIUM FALCON with Opposer.

Overall, the evidence is insufficient to persuade us that the MILLENNIUM FALCON mark enjoys the highest level of renown as a trademark. However, it is indeed commercially very strong. Accordingly, we find that the mark enjoys a high level of public recognition, such that the *DuPont* factor of fame weighs in favor of a finding of likelihood of confusion.

### **G. Actual Confusion**

The seventh *DuPont* factor considers the "nature and extent of any actual confusion" between the marks. *DuPont*, 177 USPQ at 567.

Applicant argues that there has been no actual confusion. Evidence of actual

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<sup>79</sup> *Id.* at 18, 41 (¶¶ 44, 69).

<sup>80</sup> *Id.* at 60-52 (¶ 81).

confusion, where it exists, would of course be highly probative of a likelihood of confusion. *See Edom Labs, Inc. v. Lichter*, 102 USPQ2d 1546, 1553 (TTAB 2012) (“The existence of actual confusion is normally very persuasive evidence of likelihood of confusion and undercuts any possible claim that the marks are so dissimilar that there can be no likelihood of confusion.”).

The opposite, however, is not true; an absence of evidence of actual confusion carries little weight. *See In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003); *Gillette Can. Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992); *J.C. Hall Co. v. Hallmark Cards, Inc.*, 340 F.2d 960, 52 C.C.P.A. 981, 144 USPQ 435, 438 (CCPA 1965). It is “meaningful only if the record indicates appreciable and continuous use by applicant of its mark for a significant period of time in the same markets as those served by opposer under its marks.” *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 94 USPQ2d 1645, 1660 (TTAB 2010), *aff’d*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011).

As Opposer points out, “[n]ot only is the Application based on intent-to-use, but Applicant at most has shown only a handful of performances under the MILLENNIAL FALCON Mark since 2016, most of which were rendered in one city, and Applicant produced no evidence of attendance figures, box office receipts, or other sales information.” *See Regents v. Miners*, 110 USPQ2d 1182, 1196 (TTAB 2014) (applicant had only begun to offer services two years before discovery closed, so little opportunity for confusion). There is nothing in the record regarding the extent of use of Applicant’s mark, so we are unable to gauge whether there has been

any meaningful opportunity for confusion to occur in the marketplace. *See Bond v. Taylor*, 119 USPQ2d 1049, 1056 (TTAB 2016).

The seventh *DuPont* factor is neutral in our analysis.

#### **H. Bad Faith**

Under the thirteenth *DuPont* factor, evidence of an applicant's bad faith adoption of its mark is relevant to our likelihood of confusion analysis. *L.C. Licensing Inc. v. Berman*, 86 USPQ2d at 1891 (bad faith is strong evidence that confusion is likely, as such an inference is drawn from the imitator's expectation of confusion). *See also, J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889, 1891 (Fed. Cir. 1991); *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434 (TTAB 2012).

Opposer argues that Applicant adopted the MILLENNIAL FALCON mark in bad faith.<sup>81</sup> Specifically, Opposer points to the timing of Applicant's adoption of MILLENNIAL FALCON as a mark "just a *few months* after release of the blockbuster film *STAR WARS: The Force Awakens*, which predominantly features the MILLENNIUM FALCON spaceship and was accompanied by MILLENNIUM FALCON-branded products" as "telling"; his various admissions that he selected the mark because of its association to the Millennium Falcon element in Opposer's Star Wars films; and his use of the use mark since its adoption to continue that association:<sup>82</sup>

Applicant also uses STAR WARS indicia in rendering musical

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<sup>81</sup> 32-33 TTABVUE 37-38 (Opposer' Main Brief), referencing Applicant's responses to Opposer's Requests for Admissions Nos. 2-6 and 30, 23 TTABVUE 19-22, and his Answer, 7 TTABVUE 8-9).

<sup>82</sup> *Id.*

performances under the MILLENNIAL FALCON mark by performing with X-WING spaceship props from the STAR WARS Films, and by making references to spaceships in connection with his services, including referring to his band as “spaceship, not bad” and offering comic books featuring a “Millennial Falcon” spaceship as both free downloads and with the purchase of his music records.

The photo shown below is an excerpt from Applicant’s Facebook page, which shows the use of Opposer’s Star Wars X-WING spaceship props as part of the staging of his performance:<sup>83</sup>



Applicant asserts the props were owned and positioned by the venue several weeks before his performance, but in any event, they “do not in any way even suggest [Applicant’s] bad faith, but instead are further evidence that the relevant consumers’ [sic] have a familiarity with the STAR WARS movies such that they will instantly recognize the parody inherent in the MILLENNIAL FALCON mark and not be confused.”<sup>84</sup> As another example, Applicant used the following advertisement on his

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<sup>83</sup> 28 TTABVUE 13 (Opposer’s NOR 11) (red outlining added by Opposer).

<sup>84</sup> 35 TTABVUE 4 (Opposer’s Reply Brief).

Facebook page to promote one of his performances:



Applicant believes that his mark “appropriately conjures up the phrase “Millennium Falcon” in order to “carry out” his parody.<sup>85</sup> However, we find no parody in the mark itself. From this cumulative evidence, particularly, Applicant’s acknowledgement that he applied for the mark MILLENNIAL FALCON knowing it would call to mind Opposer’s MILLENNIUM FALCON, the popular and well-known element of the first STAR WARS film and franchise; and that Applicant’s use since adoption of the mark continues to make reference to Opposer’s STAR WARS universe, we find that Applicant’s adopted the mark MILLENNIAL FALCON with the intention to trade off of Opposer’s MILLENNIUM FALCON mark. Such intent is strong evidence that confusion is likely as such an inference is drawn from the imitator’s own expectation that consumers will associate his mark with Opposer’s.

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<sup>85</sup> 7 TTABVUE 9 (Applicant’s Answer).



*See DC Comics*, 77 USPQ2d at 1229; *Broadway Catering Corp. v. Carla Inc.*, 215 USPQ 462 (TTAB 1982).

The evidence also shows that Applicant intended to parody Opposer's mark with his mark, even though he failed in the attempt. We therefore consider the thirteenth *DuPont* factor neutral in our analysis.

#### **I. Conclusion as to Likelihood of Confusion**

On the basis of the preceding factors favoring Opposer, we find that Opposer has established its claim of likelihood of confusion. Applicant, as the newcomer, had the obligation to select a mark that would avoid confusion, but it did not do so. Because we find that Opposer has established its likelihood of confusion claim, we do not reach its claim of dilution under Section 43(c) of the Trademark Act.

**Decision:** The opposition is sustained and registration to Applicant is refused.