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.[1]

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],"[2] 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).[3]

Applicant denied the salient allegations in the notice of opposition.[4]

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[1] 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.

[2] Registration No. 2450785, registered May 15, 2001; renewed.

[3] 1 TTABVUE (Notice of Opposition).

[4] 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.[5] *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.
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> 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

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

[5] 16 TTABVUE (Stipulation).

this case on which the Bard may decide any issue of material fact in dispute and make a final determination.[6]

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;[7] 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;[8]

- 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;[9] and

- NOR on Applicant's responses to certain requests for admission and

[6] *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 (TTAB 2018); *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.

[7] 16 TTABVUE.

[8] 30-31 TTABVUE.

[9] 18-22, 25 TTABVUE (NOR 1-5, 8).

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

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.[13]

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.[14] 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.[15] *TV Azteca, S.A.B. de C.V. v. Martin*, 128 USPQ2d

[10] 23-24 TTABVUE (NOR 6-7).

[11] 26-27 TTABVUE (NOR 9-10).

[12] 28 TTABVUE (NOR 11).

[13] 12 TTABVUE 12-34 (Applicant's Motion for Summary Judgment, Exhibits A-C).

[14] 40 TTABVUE 5 (Opposer's Reply Brief).

[15] *Id*.

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