

Mailed: August 29, 2002
Paper No. 19
PTH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Lucasfilm Ltd. and Lucas
Licensing, Inc.
v.
Mark Rose, dba Merope Games

Opposition No. 112,743
to application Serial No. 75/330,318
filed on June 26, 1997

Carole F. Barrett and Tuan T. Le of Coudert Brothers LLP for
Lucasfilm Ltd. and Lucas Licensing, Inc.

Mark Rose, pro se.

Before Simms, Hairston and Holtzman, Administrative
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

Mark Rose dba Merope Games has filed an application to
register THE FORCE as a trademark for "equipment used to
play a card game."¹

Registration has been opposed by Lucasfilm Ltd. and
Lucas Licensing, Inc. under Trademark Act Section 2(d).

¹ Serial No. 75/330,318 filed June 26, 1997 alleging first use on
May 23, 1997 and first use in commerce on June 4, 1997.

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Opposers allege that they are the creators and producers of the Star Wars motion pictures; that these motion pictures are familiar to hundreds of millions of people in the United States and throughout the world; that the first of the Star Wars motion pictures, namely, The Empire Strikes Back, was released for theatre viewing in May 1977; that a central theme in the Star Wars motion pictures is the manipulation of extrasensory powers, referred to as The Force, on the side of either good or evil; that the Star Wars mythology is premised on the power of the Force as "the generative or creative impulse, a spiritual energy that courses through the Star Wars universe and that promises victory in the struggle between the noble Rebel forces and the evil Empire to whomever most effectively marshals that power on its side"; that as a result, the public closely associates the well known slogans May The Force Be With You and The Force with opposers; that opposers continue to use May The Force Be With You and The Force as trademarks and service marks in connection with the Star Wars motion pictures; that opposers first used the mark MAY THE FORCE BE WITH YOU on posters at least as early as July 1, 1977 and the mark THE FORCE on toys at least as early as July 27, 1977; that opposers own several registrations for the mark STAR WARS, including registrations which cover equipment sold as a unit for playing a board game, puzzles, equipment sold as a unit for

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playing a video game, and videogame cartridges; that for many years opposers have operated a substantial marketing and licensing program to promote products based on the Star Wars motion pictures; that opposers have aggressively promoted the marks STAR WARS, THE FORCE and MAY THE FORCE BE WITH YOU; that the marks THE FORCE and MAY THE FORCE BE WITH YOU have been used at least as early as 1977 in association with the first Star Wars motion picture; that as a result of opposers' extensive advertising and use of these marks in connection with the Star Wars motion pictures, these marks are closely associated with opposers in the minds of the general public; and that applicant's use of the mark THE FORCE for equipment used to play a card game is likely to cause confusion as to the origin, source or sponsorship of applicant's goods.

Applicant, in his answer, admits that opposers are the creators and producers of the Star Wars motion pictures, and that these motion pictures are familiar to hundreds of millions of people in the United States and throughout the world. Applicant denies the remaining salient allegations of the likelihood of confusion claim and affirmatively alleges that "Opposer does not use THE FORCE as a trademark and service mark in connection with goods or services so as to cause a likelihood of confusion with the proposed mark of Applicant."

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The record consists of the pleadings; the file of the involved application; and opposers' notice of reliance on a photocopy of Registration No. 1,126,381 for the mark STAR WARS which covers, inter alia, "equipment sold as a unit for playing a board game;"² copies of office correspondence indicating that the registration has been renewed; printouts from the Office's TESS database of opposers' application Serial Nos. 75/495,647 and 75/496,228 for the mark THE FORCE for a variety of toys and games, including "card games"; excerpts from the book A Guide To The Star Wars Universe; and a printout of information downloaded on July 19, 2000 from the "Star Wars" web site. Accompanying the notice of reliance is the declaration of one of opposers' officers, Tonik Barber, who states that Registration No. 1,126,381 is owned by opposers and is valid and subsisting; and that opposers filed application Serial Nos. 75/495,647 and 75/496,228.³

² The photocopy does not show status and title.

³ While a party may not generally establish ownership of a registration or application by way of notice of reliance and a declaration, in this case, applicant has not objected to the materials. Thus, we consider applicant to have stipulated to the entry of these materials for purposes of establishing opposers' ownership of the registration and applications. Similarly, while a printout retrieved from the Internet does not qualify as a printed publication under Trademark Rule 2.122(e) and generally may not be introduced in an opposition by means of a notice of reliance, in this case, applicant has not objected to the printout. Thus, we consider applicant to have stipulated to the entry of the printout into the record.

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Applicant took no testimony and offered no other evidence. Both parties filed briefs on the case.

It is essentially opposers' position that they have rights in the slogans THE FORCE and MAY THE FORCE BE WITH YOU "that are superior to the alleged rights applicant has in THE FORCE." (Brief, p. 4). Opposers contend that the slogans THE FORCE and MAY THE FORCE BE WITH YOU have been associated with opposers and the Star Wars motion pictures since the first film was released in 1977, and that because of the fame of the motion pictures, the public associates these slogans with opposers. Further, opposers argue that these slogans are identical/similar to applicant's applied-for mark THE FORCE; and that opposers' Star Wars motion pictures and applicant's card game are sufficiently related that confusion is likely to result from contemporaneous use of the phrases and applicant's mark.

Applicant, on the other hand, argues that opposers have "failed to produce evidence where THE FORCE mark was used on goods in class 28 prior to applicant's approval"; that opposers continually refer to their use of Star Wars, but that "Star Wars or anything similar appears nowhere on applicant's mark;" and that opposers have submitted no proof of damage or actual confusion. (Brief, pages 1-2).

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Considering first the issue of priority, our primary reviewing court in T.A.B. Systems v. PacTel Teletrac, 77 F3d. 1372, 37 USPQ2d 1879, 1881 (Fed. Cir. 1996), noted:

In an opposition founded on section 2(d), the opposer must establish its own proprietary rights in the same or a confusingly similar designation in order to defeat the application. It is well settled that one may ground one's opposition to an application on the prior use of a term in a manner analogous to service mark or trademark use. Such an "analogous use" opposition can succeed, however, only where the analogous use is of such a nature and extent as to create public identification of the target term with the opposer's product or service. (citations omitted).

At the outset, we wish to make clear that opposers have failed, on this record, to establish technical trademark or service mark use of THE FORCE or MAY THE FORCE BE WITH YOU in connection with any goods or services prior to applicant's alleged date of first use. Opposers submitted no testimony and/or documentary evidence during their testimony period that would establish such prior technical trademark or service mark use. Although opposers pleaded prior use of THE FORCE and MAY THE FORCE BE WITH YOU as "marks", mere allegations in a notice of opposition (unless admitted) are not proof of the matter pleaded. In this case, applicant did not admit these allegations. Thus, we turn to the question of whether opposers have used THE FORCE and MAY THE FORCE BE WITH YOU in a manner analogous to trademark or service mark use prior to applicant's alleged

date of first use. In this regard, we note that A Guide to the Star Wars Universe (1994) contains the following entry:

Force, the

The force is an energy field generated by all living things. It surrounds and penetrates everything, binding the galaxy together. Like any energy field, the Force can be manipulated. Knowledge of these manipulation techniques gives the Jedi Knights their powers. There are two sides to the Force: the peace, knowledge, and serenity of the light side, and the anger, fear, and aggression of the dark side. Both sides of the Force are a part of the natural order, life-affirming and destructive. Through the Force, a Jedi Knight can see far-off places, perform amazing feats, and accomplish what would otherwise be impossible.

There are three known Force skills: control, sense, and alter. Only Force-sensitive beings can master Jedi skills and the techniques they control. The control skill is the ability of the Jedi to control his or her own inner Force. With this skill the Jedi learns to master the functions of his or her own body. The sense skill helps a Jedi sense the Force in things beyond and outside themselves. A Jedi learns to feel the bonds that connect all things. The alter skill allows a Jedi to change the distribution and nature of the Force to create illusions, move objects, and change the perceptions of others.

In addition, we judicially notice the following two entries from A Dictionary of Catch Phrases (American and British, from the Sixteenth Century to the Present Day) (1992)⁴:

force: See: brute force; don't force; may the Force.

⁴ The Board may take judicial notice of dictionary definitions. *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

may the Force be (or go) with you!: Picked up from Star Wars - now jocular for "God bless you" (Ashley, 1983, from US). The *Star Wars* series of films burst upon the world from Hollywood in the late 1970's; in UK the phrase may have enjoyed much quot'n, but never really became a c.p., except perhaps as a punning ref. to the Police Force.

Also, applicant has admitted in his answer that opposers are the creators and producers of the Star Wars motion pictures; that the first Star Wars motion picture was released for theatrical exhibition in May 1977, followed by *The Empire Strikes Back* in 1980 and *The Return of the Jedi* in 1983; and that the Star Wars motion pictures are familiar to hundreds of millions of people in the United States and throughout the world.

Because the Star Wars motion pictures are familiar to millions of people in the United States, there is simply no question that THE FORCE and MAY THE FORCE BE WITH YOU are well known slogans that the public associates with these motion pictures and opposers. The fame of the slogans THE FORCE and MAY THE FORCE BE WITH YOU is evidenced by their inclusion in a dictionary. See e.g., *The B.V.D. Licensing Corp. v. Body Action Design Inc.*, 846 F2d. 727, 6 USPQ2d 1719, 1720 (Fed. Cir. 1988) [In finding that "B.V.D." is a famous trademark for underwear, the court noted "[w]hen a trademark attains dictionary recognition as a part of the language, we take it to be reasonably famous."]. Thus, we find that opposers have proprietary rights in THE FORCE and

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MAY THE FORCE BE WITH YOU dating from the release of the first Star Wars motion picture in May 1977, which is prior to applicant's alleged date of first use.

We turn then to the issue of likelihood of confusion. Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the likelihood of confusion factors set forth in *In re E.I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

Considering first opposers' slogans THE FORCE and MAY THE FORCE BE WITH YOU and applicant's applied-for mark THE FORCE, it is obvious that opposer's THE FORCE and applicant's mark THE FORCE are identical. Moreover, we find that opposers' MAY THE FORCE BE WITH YOU, the dominant portion of which is THE FORCE, and applicant's mark THE FORCE are substantially similar. The parties' slogans/marks, in short, are so similar/identical that, if used in connection with the same or closely related products, confusion as to the origin or affiliation of such products would be likely.

Turning, therefore, to consideration of the respective goods, it is well settled that goods need not be identical or even competitive in nature in order to support a finding of likelihood of confusion. Instead, it is sufficient that the goods are related in some manner and/or that the

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circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under situations that would give rise, because of the marks employed in connection therewith, to the mistaken belief that they originate from or are in some way associated with the same producer or provider. See e.g., *Monsanto Co. v. Enviro-Chem Corp.*, 199 USPQ 590, 595-96 (TTAB 1978) and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

In the circumstances of this case, we concur with opposers that its Star Wars motion pictures, on the one hand, and applicant's card game, on the other hand, are related products. It is common knowledge that motion picture companies license their marks for use on a variety of products. Indeed, opposers are the owners of a registration for the mark STAR WARS for a board game and an application for the mark THE FORCE for a card game. Moreover, the potential for confusion as to the origin or sponsorship of applicant's card game is heightened by the fact that card games are relatively inexpensive items and are sold to ordinary consumers. Thus, a great deal of care would not be exercised in their purchase.

Further, a review of the specimens (shown below) submitted with applicant's application reveals that the card game is identified as "A Space Age Card Game" and THE FORCE

mark (in increasing size) is displayed on a background depicting a galaxy along with laser lights.



This certainly evokes the theme and imagery of opposers' Star Wars motion pictures.

Finally, with respect to applicant's argument that there is no proof of actual confusion or damage to opposers,

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in the absence of any evidence concerning the extent of applicant's sales of his card game, we are unable to determine whether there has been an opportunity for confusion to occur. In any event, the test is not actual confusion, but likelihood of confusion.

In sum, based on the identity/substantial similarity in the slogans/marks, and the relatedness of the goods, we find that there is a likelihood that the purchasing public would be confused as a result of applicant's use of the mark THE FORCE for equipment for playing a card game in view of opposers' prior use of the slogans THE FORCE and MAY THE FORCE BE WITH YOU in their Star Wars motion pictures. In particular, purchasers are likely to believe that applicant's equipment for playing a card game originates with or is sponsored by or licensed by opposers.

Decision: The opposition is sustained.