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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91184197
Party	Plaintiff UNITED PARCEL SERVICE OF AMERICA, INC.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

**UNITED PARCEL SERVICE
OF AMERICA, INC.,**

Opposer,

v.

**POWERTECH INDUSTRIAL
CO. LTD.,**

Applicant.

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Opposition No. 91184197

Serial No. 77/176,134

Mark: HYBRID GREEN UPS

MAIN BRIEF OF OPPOSER UNITED PARCEL SERVICE OF AMERICA, INC.

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DESCRIPTION OF THE RECORD

The record evidence in this proceeding is as follows:

Opposer's Notice of Reliance filed June 23, 2009, including:

- **Opposer's Exhibit 1** - Applicant's Answers to Opposer's First Set of Interrogatories to Applicant, dated April 13, 2009.¹
- **Opposer's Exhibit 2** - Applicant's Response to Opposer's First Request For Admissions, dated April 26, 2009.

Opposer's Supplemental Notice of Reliance filed October 9, 2009, including:

- **Opposer's Exhibit 3** - Status and title copies of the U.S. Trademark Registration Nos.: 514,285; 966,774; 1,277,400; 1,375,109; 1,874,248; 1,876,943; 1,878,016; 1,878,918; 2,098,168; 2,128,739; 2,278,090; 2,830,249; 2,483,193; 3,160,062; 2,973,108.
- **Opposer's Exhibit 4** - Certified copy of U.S. Patent Publication Number 2009/0238205.
- **Opposer's Exhibit 5** - A printed copy of Applicant's website.

Opposer's Rebuttal Notice of Reliance filed January 27, 2010, including:

- Copies of third party registrations featuring the term "green"

Testimonial Deposition of Christopher T. Schenken filed March 1, 2010, including both the oral testimony of Mr. Schenken and the following exhibits:²

- **Schenken T. Dep. Ex. 1** - Opposer's Notice of Testimony Deposition

¹ Reference to Opposer's Exhibits is made in the following manner: "Opp. Ex. ___."

² Reference to pages of the Schenken Testimonial Deposition are made in the following manner: "Schenken T. Dep., p. ___." Reference to exhibits introduced at the Schenken Testimonial Deposition are made in the following manner: "Schenken T. Dep., Ex. ___, p. ___."

- **Schenken T. Dep. Ex. 2** - U.S. Trademark Registration 2,483,193
- **Schenken T. Dep. Ex. 3** - U.S. Trademark Registration 3,160,062
- **Schenken T. Dep. Ex. 4** - U.S. Trademark Registration 2,973,108
- **Schenken T. Dep. Ex. 5** - U.S. Trademark Registration 2, 803,249
- **Schenken T. Dep. Ex. 6** - U.S. Trademark Registration 2,278,090
- **Schenken T. Dep. Ex. 7** - U.S. Trademark Registration 2,128,739
- **Schenken T. Dep. Ex. 8** - U.S. Trademark Registration 2,098,168
- **Schenken T. Dep. Ex. 9** - U.S. Trademark Registration 1,878,918
- **Schenken T. Dep. Ex. 10** - U.S. Trademark Registration 1,878,016
- **Schenken T. Dep. Ex. 11** - U.S. Trademark Registration 1,876,943
- **Schenken T. Dep. Ex. 12** - U.S. Trademark Registration 1,460,348
- **Schenken T. Dep. Ex. 13** - U.S. Trademark Registration 1,874,248
- **Schenken T. Dep. Ex. 14** - U.S. Trademark Registration 1,375,109
- **Schenken T. Dep. Ex. 15** - U.S. Trademark Registration 1,277,400
- **Schenken T. Dep. Ex. 16** - U.S. Trademark Registration 966,774
- **Schenken T. Dep. Ex. 17** - U.S. Trademark Registration 514,285
- **Schenken T. Dep. Ex. 18** - CD and Brochure - UPS Trackpad
- **Schenken T. Dep. Ex. 19** - UPS.COM Pressroom Publication - Air
- **Schenken T. Dep. Ex. 20** - UPS.COM Pressroom Publication - UPS Air Operations
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- **Schenken T. Dep. Ex. 21** - UPS.COM Pressroom Publication - UPS Freight Less-Than-
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- **Schenken T. Dep. Ex. 22** - UPS Professional Services Publication - UPS Trackpad

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- **Schenken T. Dep. Ex. 30** - Photograph of UPS tug
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- **Schenken T. Dep. Ex. 33** - Photographs of UPS TRACKPAD
- **Schenken T. Dep. Ex. 34** - Calendar - Decision Green
- **Schenken T. Dep. Ex. 35** - CD - “Green” TV Spots on Whiteboard site
- **Schenken T. Dep. Ex. 36** - Photograph of early UPS hybrid vehicle
- **Schenken T. Dep. Ex. 37** - Operating in Unison, UPS 2002 Corporate Sustainability Report
- **Schenken T. Dep. Ex. 38** - Operating in Unison, 2004 UPS Corporate Sustainability Report
- **Schenken T. Dep. Ex. 39** - Operating in Unison, 2007 UPS Corporate Sustainability Report

- **Schenken T. Dep. Ex. 40** - BrandFinance250, The Annual Report on the World's Most Valuable Brands, January 2007
- **Schenken T. Dep. Ex. 41** - BrandFinance Global 500, The Annual Report on the World's Most Valuable Brands, April 2009
- **Schenken T. Dep. Ex. 42** - 2.0 Letter from the Chairman
- **Schenken T. Dep. Ex. 43** - UPS Enterprise Portal - Bob Stoffel Emphasizes Going Green
- **Schenken T. Dep. Ex. 44** - UPS.COM Pressroom - Ten Things you May not Know About UPS's Environmental Initiatives
- **Schenken T. Dep. Ex. 45** - Composite Exhibit. UPS Enterprise Portal - The Many Ways that Brown is Green
- **Schenken T. Dep. Ex. 46** - Decision Green: Frequently Asked Questions
- **Schenken T. Dep. Ex. 47** - UPS Carbon Neutral Frequently Asked Questions
- **Schenken T. Dep. Ex. 48** - Alternate Fuel Vehicles, January 9, 2009
- **Schenken T. Dep. Ex. 49** - Alternative Fuels and Technology
- **Schenken T. Dep. Ex. 50** - UPS.COM Pressroom - Fuel Management and Conversation at the UPS Airlines
- **Schenken T. Dep. Ex. 51** - UPS.COM Pressroom - UPS Uses Telematics To Go - And Save - Green
- **Schenken T. Dep. Ex. 52** - "The Many Ways That Brown is Green"
- **Schenken T. Dep. Ex. 53** - Environmental Stewardship
- **Schenken T. Dep. Ex. 54** - UPS.COM Pressroom - UPS First in Industry to Purchase Hydraulic Hybrid Vehicles

- **Schenken T. Dep. Ex. 55** - BusinessWeek - UPS Takes the Lead on Hydraulic Hybrids
- **Schenken T. Dep. Ex. 56** - Advertisement Measurement Study
- **Schenken T. Dep. Ex. 57** - Page from Powertech Industrial Co., Ltd. website
- **Schenken T. Dep. Ex. 58** - Patent Application Publication Number: US 2008/0238205
- **Schenken T. Dep. Ex. 59** - The UPS Collection, Fall/Winter 2009 catalog
- **Schenken T. Dep. Ex. 60** - The UPS Collection, Capture the UPS Spirit catalog
- **Schenken T. Dep. Ex. 61** - 2009 Daron Worldwide Trading Inc. catalog

Applicant's Notice of Reliance filed August 21, 2009, including:

- Applicant's Answer to the Notice of Opposition
- Applicant's Answers to Opposer's First Set of Interrogatories to Applicant
- Applicant's Response to Opposer's First Set of Requests for Admission
- Applicant's Answer to Opposer's First Request to Applicant for Production of Documents and Things, including Bates Nos. 1-144
- Pages from Merriam-Webster's Collegiate Dictionary - 11th Edition, Bates Nos. 145-147
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- Pages from the website www.apc.com, Bates Nos. 166-171
- Pages from the website www.minutemanups.com, Bates Nos. 172-173
- Pages from the website www.jetcafe.org, Bates Nos. 174-190.

Applicant's Supplemental Notice of Reliance filed December 4, 2009, including:

- Copies of Certificates of U.S. Trademark Registrations Nos.: 3,150,532; 3,688,778;
3,083,913; 2,888,591; 3,347,176; 3,489,672; 3,686,916; 3,538,919; 3,401,906; 3,017,697;
3,359,502.

STATEMENT OF THE ISSUES

1) Whether the designation “HYBRID GREEN UPS,” when used on or in connection with power supplies; mobile phone battery chargers; mobile phone battery charger stations; battery chargers; universal power supplies; power saving adapters; electric storage batteries; uninterruptible power supplies; AC/DC converters; and power source stable adapters (“Applicant’s Goods”), is merely descriptive within the meaning of Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1).

2) Whether the designation “HYBRID GREEN UPS” so resembles the mark “UPS” as shown in U.S. Registrations 514,285; 966,774; 1,277,400; 1,375,109; 1,874,248; 1,876,943; 1,878,016; 1,878,918; 2,098,168; 2,128,739; 2,278,090; 2,830,249; 2,483,193; 3,160,062; 2,973,108 as to be likely, when used in connection with Applicant’s Goods, to cause confusion, or to cause mistake or to deceive within the meaning of Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

I. INTRODUCTION

Applicant Powertech Industrial Co., Ltd. (“Powertech”) seeks to register the designation “HYBRID GREEN UPS” for interruptible power supplies and related goods. Powertech has disclaimed the term UPS as descriptive of an uninterruptible power supply. Powertech intends to use the designation “HYBRID GREEN UPS” for an, inter alia, uninterruptible power supply that conserves energy (e.g., is “green”) and provides a simultaneous diversified AC and DC output (e.g., a “hybrid”). Accordingly, the designation “HYBRID GREEN UPS” conveys an immediate idea of a quality, characteristic, feature, function, purpose or use of the goods and is, therefore, merely descriptive within the meaning of Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1).

Alternatively, Opposer United Parcel Service of America, Inc. (“UPS”) owns the famous trademark “UPS,” which is entitled to the broadest scope of protection. The designation “HYBRID GREEN UPS” wholly incorporates and therefore so closely resembles the famous mark “UPS” that, when the designation is used by Powertech, it is likely to cause confusion, mistake or deception as to the source or origin of Powertech’s goods and the public is likely to assume erroneously that such goods are in some way connected with or sponsored by UPS. Accordingly, the designation “HYBRID GREEN UPS” is likely to cause confusion or to cause mistake or to deceive in violation of Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).³

³ UPS originally brought a claim for dilution under Section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c). That claim is hereby withdrawn.

II. BACKGROUND

A. Parties

Applicant Powertech is a Taiwanese corporation that manufactures and sells power supplies and related devices such as surge protectors. Opp. Ex. 5; see also, www.power-tech.com.tw/about%20powertech-e1.html. Opposer UPS is an affiliate of UPS, Inc., the well-known package delivery company, and owns all rights, title and interest to various UPS marks.

B. UPS and The Famous Mark “UPS”

UPS was founded in 1907 and has grown to be the world’s largest package delivery company. The mark “UPS” (including its variant formations) is a leading symbol of the company’s goodwill. “UPS” is one of the strongest trademarks in the world. The development of the company and the mark are directly relevant to this proceeding.

1. The Company—Remarkable Growth

UPS was started by James Casey in 1907 as a private messenger and delivery service in Seattle, Washington. Schenken T. Dep., Ex. 24; see also, www.ups.com/content/us/en/about/history/1929.html. The company originally operated under the name American Messenger Company. In response to telephone calls received at a basement office, messengers ran errands, delivered store packages, and carried notes, baggage, and trays of food from restaurants. In 1919, the business first expanded to Oakland, California, and with the advent of the automobile, the company continued to focus on local delivery such as delivering retail store packages. Several years later, the company acquired a “common carrier” service in Los Angeles, and the business of

delivering packages began to grow in earnest. By the early 1930's, the business had expanded to the east coast. With such dramatic growth, a new name was adopted - United Parcel Service. Id. The mark "UPS" has been in use since at least as early as 1933. Schenken T. Dep., pp. 37-38.

The company continued to acquire common carrier licenses throughout the country, and expanded its business accordingly. For example, from those few people who started the company in 1907, UPS today employs in excess of 400,000 people. Schenken T. Dep., Ex. 24, p. 1. UPS acquired its first package delivery car, a Model T Ford, in 1913. www.ups.com/content/us/en/about/history/1929.html. In 2008, the company operated a fleet of vehicles that included more than 99,000 package cars, trucks, vans, tractors, and motorcycles. Schenken T. Dep., Ex. 24, p. 1. This fleet included more than 1,700 "hybrid" vehicles, all of which prominently display the mark "UPS." Schenken T. Dep., p. 63, Ex. 32, p. 2. In 1929 UPS became the first package delivery company to provide air service via privately operated airlines. www.ups.com/content/us/en/about/history/1929.html. The UPS air delivery service has grown dramatically. In 2008, UPS operated a fleet of approximately 260 company-owned jets and another approximately 301 chartered jets, each of which bears the famous mark "UPS" and displays a tail section painted in the well-known UPS brown color. Schenken T. Dep., p. 44, Ex. 19, Ex. 20, p. 1, Ex. 24, p. 2. UPS presently operates air hubs in Louisville, Kentucky; Philadelphia, Pennsylvania; Dallas, Texas; Ontario, California; Rockford, Illinois; and Columbia, South Carolina. Schenken T. Dep., Ex. 20, p. 2. Package operations at those facilities are conducted using "tugs" and other vehicles that bear the mark "UPS." Schenken T. Dep., Ex. 30. The UPS browntails fly almost one

thousand flight segments per day to various airports throughout the United States. Schenken T. Dep., Ex. 20, p. 2.

Of course, the package operations business has grown as well. In 2008, UPS delivered approximately 3.9 billion packages and documents. Schenken T. Dep., p. 61, Ex. 24. Of that daily volume, some 2.1 million packages were delivered by air. Id. Many “UPS” marks, each of which relies on “UPS” as a root, are used in these operations, including: UPS NEXT DAY AIR, UPS NEXT DAY AIR & Design, UPS 2ND DAY AIR, UPS 2ND DAY AIR & Design, UPS PREFERRED, and UPS PREFERRED & Design. Schenken T. Dep., p. 31-36. Many, if not all of those 3.9 billion packages displayed the mark “UPS.” In 2008, the provision of services under the UPS family of “UPS” Marks resulted in revenues of approximately \$42.6 Billion. Schenken T. Dep., p. 61, Ex. 24. In 2008, UPS served an average of 7.9 million customers per day. Id. Those customers have access to UPS in several ways, including by the more than 4500 “The UPS Store” retail outlets, the 1000 UPS Customer Centers, the more than 15,000 authorized UPS outlets, and the 40,000 UPS drop boxes. Id.

Moreover, deliveries are made to customers by the more than 60,000 UPS drivers, each of which wears the famous brown UPS uniform and drive the immediately recognizable UPS package car, both of which display the “UPS” mark. Schenken T. Dep., p. 16, 39-40, Ex. 32, p. 1. In making those deliveries, UPS drivers use a hand-held electronic device known as the “Delivery Information Acquisition Device” or “DIAD,” of which there are more than 100,000 in daily use. Schenken T. Dep., p. 16, Ex. 23, p. 1. The DIAD displays the famous “UPS” mark and allows the driver to electronically capture various delivery information, including customer signatures. Schenken T. Dep.,

p. 17, Ex. 29. Thus, customers routinely see the mark “UPS” not only on envelopes and packages, but on the trucks, the driver uniforms and the DIAD that is used to track delivery of the packages. Schenken T. Dep., Ex. 32, p. 3. Importantly, the DIAD is an electronic device that is powered by the very devices at issue in this proceeding - a power supply for a hand held computing device that is capable of RF transmission, GPS positioning, data capture and processing, and a host of other capabilities. Schenken T. Dep., p. 57.

As shown by the innovative DIAD, UPS has embraced the digital age. To that end, UPS maintains a robust Internet presence at www.ups.com. Users of this website can perform a wide range of tasks, including arranging for package delivery, tracking delivery status, ordering various UPS goods and services, downloading software, and learning more about the company. Id. The website prominently displays the mark “UPS.” The website uses and promotes a wide range of goods and services under “UPS” formative trademarks, including: UPS TRACKPAD, UPS ONLINE, UPS INTERNET TOOLS, UPS.COM, and UPS WORLDSHIP. Schenken T. Dep., pp. 31-36. In 2008, UPS received an average of 18.5 million page views at www.ups.com, with a peak daily volume of 26.2 million page views. Schenken T. Dep., pp. 58-59. In that same year, UPS processed a business day average of 22.7 million tracking requests, with a peak day volume of 35.6 million tracking requests. Schenken T. Dep., p. 59. Thus, in addition to seeing the mark on packages and delivery items, tens of millions of people see the mark “UPS” by visiting the UPS website.

The business has grown into other areas. Under the umbrella organization “UPS Supply Chain Solutions”, UPS offers logistics and distribution services, transportation

and freight (air, sea, ground, rail) services, freight forwarding services, international trade management services, customs brokerage services. Schenken T. Dep., Ex. 24, p. 2. UPS also offers specialty services such as service parts logistics technical repair and configuration services, supply chain design and planning services, and returns management services. UPS also offers and provides a wide range of software and related goods and services that are used by UPS customers and agents to facilitate the many different services offered and provided by UPS. Id. These businesses are supported by yet additional UPS facilities, including more than 6,500 tractors and 22,000 trailers. Id. In 2008, UPS Supply Chain Services enjoyed revenues of approximately \$7.4 Billion.

2. Other Uses of the Famous Mark “UPS” and Its Various Formatives

Use of the mark UPS is ubiquitous. In addition to the many uses mentioned above, UPS advertises in every conceivable media. UPS’ goods and services are advertised on television, radio and the Internet. Schenken T. Dep., p. 83, Ex. 35. UPS’ goods and services are advertised in print and in outdoor media. See generally, Schenken T. Dep., Exs. 43, 52. All such advertising prominently uses and promotes the mark “UPS.” The mark “UPS” is used in connection with various sponsorships, including the sponsorship of major sporting events, such NASCAR and the 2008 Olympic Games in Beijing, China. Schenken T. Dep., p. 72-74, Ex. 27. [REDACTED]

[REDACTED] Schenken T. Dep., p. 78. Over the last 75 years, UPS has spent substantial sums advertising and promoting its goods and services under the mark “UPS.”

UPS has conducted marketing studies to measure the impact of its advertising and promotional efforts. Those studies demonstrate that the mark is, in fact, well recognized

by the public. For example, UPS tests brand awareness, using both aided and unaided questions. In a recent 2008 brand awareness study regarding companies that ship via ground, awareness of UPS was extremely high, with 94% of respondents mentioning “UPS.” Schenken T. Dep., Ex 56, p. 7. With reference to overnight shipping, awareness of the “UPS” brand was again extremely high, with 88% of respondents mentioning “UPS.” Id.

Yet further, independent third parties have acknowledged that the mark UPS has achieved the highest level of recognition and fame. In January of 2007, BrandFinance250 ranked “UPS” the 42nd most valuable trademark in the world, with a 2006 brand value of \$14,168 million. Schenken T. Dep., Ex. 40, p. 27. In 2008, BrandFinance Global 500 ranked “UPS” the 38th most valuable trademark in the world. Schenken T. Dep., Ex. 41, p. 8. And most recently, in 2009, BrandFinance Global 500 ranked “UPS” the 32nd most valuable trademark in the world, with a brand value of \$11,873 million. Schenken T. Dep., pp. 96-98; Schenken T. Dep., Ex. 41, p. 8.

In addition, UPS has protected its mark to ensure that the mark remains strong and readily recognized by the public as indicating only UPS as the source of goods and services under that trademark. For example, UPS has filed lawsuits, initiated opposition and cancellation proceedings, sent cease and desist letters and monitored third parties to ensure that the mark has not been misused. To that end, UPS has repeatedly licensed its mark to third parties so that it could ensure that the quality of the goods and services met its standards. Schenken T. Dep., p. 135.

UPS has acted to protect its exclusive rights in the mark by obtaining registrations for its many uses, including:

1. **UPS THE DELIVERY SYSTEM FOR STORES OF QUALITY SINCE 1907 & Design**, Reg. No. 514,285, for motor vehicle delivery service for retail stores.
2. **UPS**, Reg. No. 966,774, for transportation of personal property for hire by diverse modes of transportation.
3. **UPS 2ND DAY AIR & Design**, Reg. No. 1,277,400, for motor vehicle and air transportation of personal property.
4. **UPS NEXT DAY AIR & Design**, Reg. No. 1,375,109, for motor vehicle and air transportation of personal property.
5. **UPS PREFERRED**, Reg. No. 1,874,248, for transportation by air, rail, boat, and motor vehicle of packages and freight.
6. **UPS PREFERRED & Design**, Reg. No. 1,876,943, for transportation by air, rail, boat, and motor vehicle of packages and freight.
7. **UPS NEXT DAY AIR**, Reg. No. 1,878,016, for motor vehicle and air transportation of personal property.
8. **UPS 2ND DAY AIR**, Reg. No. 1,878,918, for motor vehicle and air transportation of personal property.
9. **UPS TRACKPAD**, Reg. No. 2,098,168, for computer programs and hand-held computers used for collection of package transit and delivery information.
10. **UPS ONLINE**, Reg. No. 2,128,739, for software for use in preparing and printing shipping documents and invoices and tracking the shipped packages.
11. **UPS & Design**, Reg. No. 2,278,090, for software for use in preparing and printing shipping documents and invoices and tracking the shipped packages.
12. **UPS INTERNET TOOLS**, Reg. No. 2,830,249, for software for use in preparing and printing shipping forms, documents and invoices, and tracking of the shipped packages and delivery of personal property by air, rail, boat, and motor vehicle; providing computerized information on domestic and international transportation and delivery services and package tracking.
13. **UPS.COM**, Reg. No. 2,483,193, for computer software for use in connection with worldwide pick up, tracing, and delivery of personal property by air, rail, boat and motor vehicle.

14. UPS WORLDSHIP, Reg. No. 3,160,062, for computer hardware, operating software and peripherals, modems, laser and thermal printers, scanners, network interface cards, electrical and fiber optic cables, scales and display screens, for package shipping rate calculators, shipping record keeping and software for use in preparing and printing shipping documents and invoices, and tracking of shipped packages, and computerized tracking and tracing of packages in transit, namely, providing computerized information on domestic and international transportation and delivery services, and transportation and delivery of personal property by air, rail, boat and motor vehicle.

15. UPS & Design, Reg. No. 2,973,108, for computer hardware and computer software in the field of transportation and delivery and in connection with worldwide pick-up, tracing and delivery; batteries; alternative power supply appliances, namely, voltage surge protectors; magnetic discs and tapes; computer printers, scales and scanners; computer software for providing automated download of files, for preparing and printing of shipping labels, documents and invoices, for providing electronic shipping labels, shipping documents and invoices, for providing information on available transportation and delivery services, and for providing proof of delivery documentation, including digitized signature of the recipient of the package and the receipt, transmission and processing of customer identifying shipping account, and printed materials pertaining to information transportation and delivery, namely, press releases, pamphlets, brochures, newsletters, books, posters, periodicals, calendars, magazines, printed instructional, educational and teaching material, paper banners, envelopes, cardboard boxes and packages, shipping and address labels, stationery, desk sets, pen and pencil sets, pen, paper clip dispensers, pen and holder desk sets, note holders, fountain pens, desk folders, stationery-type portfolios, business card files, ring binders, letter openers, desk caddies, packing paper, paper bags, cardboard, cardboard envelopes and cartons; plastic bags and envelopes and pouches for packaging, plastic bubble packs for wrapping or packaging, and clothing, namely, hats, shorts, sweaters, jackets, socks, coats, t-shirts, pants, shirts, vests, sweatshirts, rainwear, footwear and gloves, and advertising services; logistics management in the field of transportation and delivery; business management services; business consulting services; business administration services; Providing facilities for the use of office equipment and machinery; management assistance services in the field of transportation and delivery; management consulting services; providing computerized tracking and tracing of packages in transit; distribution of advertising samples for others; mail sorting handling and receiving services; retail store services featuring stamps and office supplies; data processing services; photocopying services; document reproduction services; Franchising, namely, offering technical assistance in the establishment and/or operation of retail mailing, shipping, packaging, faxing and electronic communication outlets; providing automated registration for customer identifying shipping account information over the global computer network; licensing of computer software; transportation network management solution services; arranging expedited pick-up, storage, transportation and delivery services; customs clearance services, and legal services, scientific research services, design and development of computer hardware and software,

consulting services in the field of design, selection, implementation and use of computer hardware and software systems for others.

Each of these marks is in use by UPS. Schenken T. Dep., pp. 31-36.

Thus, the mark “UPS” has become famous. The public recognizes and relies on the mark “UPS” to identify and distinguish UPS’ goods and services from those of others.

3. Extensive Use of “UPS” in Hybrid and Green Activities

UPS has led the drive to sustainable processes. UPS has developed and employed thousands of hybrid vehicles in the delivery process. These vehicles are identified by both the mark “UPS” and the term “hybrid.” Schenken T. Dep., p. 92-93. UPS has also led the effort to reduce carbon emissions. These efforts are being made by UPS in all aspects of the business. For example, UPS has recently announced that a plan to cut the carbon emissions of its airline by an additional 20 percent by 2020, for a cumulative reduction of 42 percent since 1990. Schenken T. Dep., Ex. 42, p. 2. UPS has also led the effort to “green” the business in a variety of ways. For example, UPS has issued Sustainability Reports since 2003 that document the many steps being taken to implement “green” procedures. Schenken T. Dep., Exs. 37-39 (Annual Sustainability Reports).

UPS has heavily promoted its “green” efforts. It has created television commercials promoting its efforts, such as the reusable envelope and UPS’s use of right turns to save fuel and thus reduce emissions. Schenken T. Dep., Ex. 35. UPS created a 2009 calendar to promote its DECISION GREEN program, entitled “brown thinks green,” and filled with facts about UPS’s green initiatives. Schenken T. Dep., Ex. 34. As a part of its DECISION GREEN program, UPS often features an image of a UPS package car marked as “hybrid electric vehicle” with a tree growing from the top. Id. at p. 8,

Schenken T. Dep., Ex. 52. UPS issues press releases touting its hybrid vehicles, recycling efforts, paper-saving efforts, and power-saving efforts, to name a few. Schenken T. Dep., Ex. 44. In addition to enumerating the steps it has taken to be “green” in these press releases, UPS often uses the word “green” to describe these steps, such as “UPS Uses Telematics To Go - And Save - Green.” Schenken T. Dep., Ex. 51. UPS heavily promotes its “green fleet” as well. Schenken T. Dep., Exs. 54, 55.

UPS uses “green” in its advertising. For example, on UPS.com in the Business Solutions section, UPS promotes its services under the heading “Go Green. Ship Green. Smart Solutions to Help Green Your Business.” Schenken T. Dep., Ex. 45, p.45. Next to this heading is a photo of a UPS package car featuring the UPS shield above the words “Hybrid Electric Vehicle.” Id.

As a result of these and many other similar efforts, the relevant public has come to see the terms “hybrid” and “green” in tandem with the famous mark “UPS” such that consumers can be expected to think of UPS when they see those terms in use. Third parties have begun to use “green” in connection with UPS. For example, Marc Gunther, a contributing editor at Fortune magazine, featured an article on his blog titled, “UPS to FedEx: We’re Greener Than You.” Schenken T. Dep., Ex. 45, p. 6. Thus, UPS has made extensive use of the mark “UPS” with the terms “hybrid” and “green.”

C. Applicant’s Designation “HYBRID GREEN UPS”

On May 9, 2007, Applicant Powertech filed U.S. trademark application serial number 77/176,134 (“the Application”) to register the designation “HYBRID GREEN UPS” in Class 9 for power supplies; mobile phone battery chargers; mobile phone battery charger stations; battery chargers; universal power supplies; power saving adapters;

electric storage batteries; uninterruptible power supplies; AC/DC converters; power source stable adapters (“Applicant’s Goods”). Applicant disclaimed the “UPS” portion of its designation as being merely descriptive of such goods.

The application was based on an intent-to-use, and Powertech confirms that it has not yet used the designation in commerce. Opp. Ex. 2, Response to Request For Adm., No. 39. Of course, by virtue of its disclaimer, Powertech takes the position that “UPS” is descriptive of an uninterruptible power supply. See Opp. Ex. 2, Response to Request For Admission Nos. 60-62. Further, based on a review of certain promotional material on the Powertech website, it is evident that the term “HYBRID” describes a feature of the goods -- namely, that the uninterruptible power supply simultaneously provides “AC” (alternating current) output and multi-range DC (direct current) output. Opp. Ex. 5; Schenken T. Dep. Ex. 57. Similarly, it is evident that the term GREEN also describes a feature of the goods -- that they are energy saving. Id. Not surprisingly, the Powertech website therefore features definitions of both “HYBRID” and “GREEN” in relation to its products. In view thereof, Powertech further admits the descriptive nature of its mark in its responses to Opposer’s First Set of Interrogatories and First Requests for Admissions. Opp. Exs. 1 and 2, Response to Interrogatory No. 3 and Request Nos. 52-56. Specifically, when asked about the decision to select the mark, Powertech responded that “the term ‘HYBRID’ was simply chose for use as a convenient word which could apply to various goods as listed in the allowed application” and “the word ‘GREEN’ was believed to be a word which shows some type of environmental friendliness.” Opp. Ex. 1, Response to Interrogatory No. 3. Further, Powertech admits that goods to be offered under the designation HYBRID GREEN UPS are intended:

1. to be energy efficient;
2. to use less energy than comparable goods;
3. to be beneficial to the environment; and
4. to appear to be beneficial to the environment.

Opp. Ex. 2, Response to Request Nos. 52-56.

Yet further, Applicant actually uses the designation in a descriptive manner in its patent application. More specifically, on June 12, 2007, Powertech filed Patent Application Serial No. 11/808,594 with the United States Patent and Trademark Office. Opp. Ex. 4. The application is entitled “Hybrid Green Uninterruptible Power System and Bi-Directional Converter Module and Power Conversion Method Thereof” (emphasis added). *Id.* The Abstract identifies the application as allegedly disclosing “a hybrid green uninterruptible power system, including” *Id.* at p. 1, Col. 2, Abstract. The “Field of the Invention” and the “Summary of the Invention” go to great lengths to explain that the alleged invention is a hybrid green uninterruptible power system or “hybrid green UPS.” *Id.* at p. 1, Cols. 1 and 2. Importantly, the preamble of each of the claims the alleged invention in terms of: “a hybrid green uninterruptible power system” or “a method for controlling a hybrid green uninterruptible power system.” *Id.* at p. 5, Cols. 1 and 2.

D. Procedural Status

The Application was published for opposition on March 18, 2008. UPS filed a timely Notice of Opposition on May 19, 2008 alleging likelihood of confusion under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d). Applicant filed its Answer on June 24, 2008. On June 23, 2009, UPS moved to amend the Notice of Opposition to include a

cause for descriptiveness under Section 2(e)(1), which the Board granted on August 21, 2009. Applicant filed an Amended Answer on September 4, 2009.

UPS's rebuttal testimony period closed on January 27, 2010, such that the deadline for Opposer's Trial Brief is March 29, 2010. Trademark Rule 2.128(a) and (b).

III. ARGUMENT

A. Opposer Has Standing to Bring This Opposition

Opposer UPS owns the right, title, and interest to the famous mark "UPS" (including its various formatives) that has been in use since at least 1933. Opposer UPS is the owner of numerous registrations for the mark "UPS" and various "UPS" formative marks. These rights establish UPS' standing to oppose the junior mark U.S. Serial No. 77/176,134, filed May 19, 2007. See King Candy Co., Inc. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).⁴

B. The Designation "HYBRID GREEN UPS" Is Merely Descriptive

1. The Applicable Law

A term is merely descriptive of goods or services, within the meaning of Section 2(e)(i), if it "forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services." In re Gyulaz, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987), In re MetPath, 223 USPQ 88 (TTAB 1984). A term need not immediately convey an idea of each and every specific feature of an applicant's good or services in order to be "merely descriptive;" it is enough that the subject term describes one significant attribute, function or property of the goods or services. In re

⁴ Powertech has not challenged UPS's standing or priority.

Dial-a-Mattress Operating Corp., 240 F. 3rd 1341, 1346, 57 USPQ2d 1807 (Fed. Cir. 2001); In re H.U.D.D.L.E., 216 USPQ 358 (TTAB 1982).

Whether a term is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought. The fact that a term may have other meanings in different contexts is not controlling. In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979). The question is “whether someone who knows what the goods or services are will understand the mark to convey information about them.” In re Tower Tech Inc., 64 USPQ2d 1134, 1317 (TTAB 2002).

Composite marks are considered in their entirety. The composite mark is registrable only if as a unitary mark it provides a separate, non-descriptive meaning. For example, when descriptive terms are combined, the determination of whether the composite has a descriptive significance turns on whether the combination evokes a new and unique commercial impression. If each component term retains its descriptive significance in relation to the goods or services, the combination results in a composite that is itself descriptive. In re Oppedahl & Larson LLP, 373 F. 3rd 1171, 71 USPQ2d 1370 (Fed. Cir. 2004). Of course, disclaimed terms do not indicate source and, therefore, any disclaimed component term would be considered descriptive for purposes of the subject application. Safer, Inc. v. OMS Invs., Inc., 2010 TTAB LEXIS 51, *44 (T.T.A.B. Feb. 23, 2010).

Therefore, this Board has repeatedly held that composite designations that comprise nothing more than a combination of descriptive terms are themselves descriptive. See In re Putman Publishing Co., 39 USPQ2d 2021 (TTAB 1996) (FOOD & BEVERAGE ONLINE held to be merely descriptive of news and information service for

the food processing industry); In re Copytele Inc., 31 USPQ2d 1540 (TTAB 1994) (SCREEN FAX PHONE merely descriptive of “facsimile terminals employing electrophoretic displays”); In re Serv-A-Portion Inc., 1 USPQ2d 1915 (TTAB 1986) (SQUEEZE N SERV held to be merely descriptive of ketchup); In re Uniroyal, Inc., 215 USPQ 716 (TTAB 1982) (STEELGLAS BELTED RADIAL held merely descriptive of vehicle tires containing steel and glass belts).

2. The Designation Is Merely Descriptive

The subject designation, HYBRID GREEN UPS, is nothing more than a combination of descriptive terms that results in a descriptive composite; the designation fails to evoke any new or unique commercial impression. First, with reference to the “UPS” component, Powertech has taken the position by disclaimer that “UPS” is descriptive of an “uninterruptible power supply.”⁵ This is consistent with Powertech’s U.S. Patent Application Serial No. US 2008/0238205 A1, in which Powertech repeatedly equates “UPS” and “uninterruptible power system.” Powertech cannot assert that the term “UPS” provides any source identifying function.

Next, Powertech’s patent application teaches that the “hybrid” component is descriptive in that it describes the ability to simultaneously provide both AC and DC power. More specifically, the application describes the “hybrid” component as follows:

Moreover, the hybrid green uninterruptible power system 20 has a secondary battery mounted inside and charged by DC power converted from AC utility power. Simultaneously, a plurality of additional DC power are provided to the DC power output ports 208 individually. Therefore, when AC utility power is interrupted or an irregular voltage occurs, the secondary battery releases power, and the inverter inside the hybrid green uninterruptible power system 20 inverts power from the secondary battery into AC power so that the hybrid green uninterruptible

⁵ For purposes of the instant analysis, the difference between an uninterruptible power supply and an uninterruptible power system is of no consequence.

power system 20 can provide the AC power to the external load via the AC power output ports 204 and simultaneously provide one or more sets of additional DC power and the DC power output ports 208.

Opp. Ex. 4, p. 2, Col. 2, ¶ 0024. Powertech’s promotional material at its Internet website similarly describes the “hybrid” component as a “co-exist power system [that] provide[s] AC & Multi-Range DC Output simultaneously.” Opp. Ex. 5. Thus, the term “hybrid” is descriptive of a system that provides AC and DC output simultaneously.

Next, the Powertech patent application further teaches that the “green” component refers to the devices ability to conserve energy. More particularly, the Powertech patent application states:

Therefore, regardless of whether the AC utility power is normally inputted or invalid, an additional DC power can be induced for provision to the external device. Consequently, the hybrid green uninterruptible power system concurrently having an AC power output port and a DC power output port according to the present invention can meet different demands and significantly improve the efficiency of energy conversion between the UPS battery and the external device, thereby less energy is wasted during converting power.

Opp. Ex. 4, p. 4, Col. 2, ¶ 0046. Again, Powertech’s promotional material confirms that the “green” component is the energy sourcing feature. Opp. Ex. 5. For example, Powertech asserts that for a conventional “Notebook Adaptor” use, the power efficiency of a “Conventional UPS” is 628, whereas for a “Hybrid Green Power” system, the power efficiency is 85%. Id.; Schenken T. Dep., Ex. 57.

Additionally, Powertech has admitted that Applicant’s Goods to be offered under the Proposed Mark are intended to be energy efficient (Opp. Ex. 2, Response to Request for Admissions, No. 52) that the goods at issue intended to use less energy than otherwise comparable goods (Id., Request for Admissions, No. 53), that the goods at issue are beneficial to the environment (Id., Request for Admission, No. 54), and that the goods at

issue are intended to appear to be beneficial to the environment (Id., Request for Admission, No. 55). These responses, taken alone and together, show that the cited goods are and are intended to be “green.” Applicant further admitted Opposer’s Request for Admission No. 56 that Applicant’s Goods to be offered under the Proposed Mark are for use with more than one type of power output, which indicates that Applicants goods are “hybrid” in the commonly-understood sense of the word. Id.

Finally, the Powertech patent application demonstrates that the composite is descriptive. For example, the patent application states that its fundamental object is to provide a “hybrid green uninterruptible power system.” Opp. Ex. 4, p. 1, Col. 2, ¶ 0010. The application, which equates the component “UPS” to “uninterruptible power system,” even claims the alleged invention as a “hybrid green uninterruptible power system.” Id. at p. 5, Col. 1, Claim 1. The composite is nothing more than the sum of descriptive components.

Based on Powertech’s disclaimer, its admissions regarding the qualities and characteristics of the goods and its use of the terms “hybrid” and “green” to describe those goods (both on its website and in its patent application) UPS respectfully submits that the designation “HYBRID GREEN UPS” should be found merely descriptive under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1).

C. A Likelihood of Confusion Exists in Violation of Section 2(d)

Assuming Powertech can establish trademark rights in subject designation, the record demonstrates a likelihood of confusion between “HYBRID GREEN UPS” and the famous mark “UPS” under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on the factors set forth in In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177

USPQ 563, 567 (CCPA 1973). These factors are well known to the Board and need not be recited in detail here. An opposer does not need to show that every DuPont factor weighs in its favor. Cunningham v. Laser Golf Corp., 222 F.3d 943, 947; 55 USPQ2d 1842, 1845 (Fed. Cir. 2000). While the likelihood of confusion analysis considers all of the DuPont factors, it may focus on dominant or key factors such as the fame of a mark, similarity of the marks and relatedness of the goods and services. Kenner Parker Toys Inc. v. Rose Art Industries, Inc., 963 F.2d 350, 352, 22 USPQ2d 1453 (Fed. Cir. 1992); Hewlett-Packard Co. v. Packard Press, Inc., 281 F.3d 1261, 1265; 62 USPQ2d 1001, 1003 (Fed. Cir. 2002). If there is no evidence of record as to a particular factor, the Board does not consider that factor. Cunningham, 222 F.3d at 947. Any doubt as to which way a factor points is to be resolved in favor of the opposer as the senior user. See Hewlett-Packard Co., 281 F.3d at 1265.

1. The UPS Mark is famous and entitled to the broadest scope of protection

Fame plays a dominant role in cases featuring a famous or strong mark. Kenner Parker Toys Inc., 963 F.2d 350. Famous marks are given more protection because they are more likely to be remembered and associated in the public mind than a weaker mark. Id. A famous mark is one “with extensive public recognition and renown.” Id.

The mark “UPS” is famous. UPS has been using the mark “UPS” continuously since 1933. Schenken T. Dep., pgs. 37-38. UPS’s use of UPS is ubiquitous. The UPS Mark is displayed on thousands of vehicles and hundreds of planes flying to hundreds of airports daily. Id. at 44. The UPS Mark is displayed on 6,700 tractors and 22,100 trailers traveling all around the country. Id. at 51. UPS.COM received 26.2 million unique views on a peak day of 2008. Id. at 58. UPS delivers 15.5 million packages on a daily basis by

60,000 drivers all wearing the UPS Mark on their clothing, vehicles and equipment. Id. at 61. UPS vehicles bearing the UPS Mark travel over a billion miles a year. Id. at 69, Ex. 26.

UPS sponsors major sporting events and activities such as NASCAR, golf tournaments, the National Hot Rod Association, the racehorse Big Brown, and the Olympics, to name a few. Schenken T. Dep., pgs. 72-74. [REDACTED]

[REDACTED] Id. at 77. [REDACTED]

[REDACTED] Id. at 78.

UPS has been ranked one of the top brands in the world. For example, BrandFinance250 ranked UPS the 42nd most valuable trademark in January 2007. Id. at 95, Ex. 40, p. 27. BrandFinance Global 500 ranked UPS the 38th most valuable trademark in 2008 and the 32nd most valuable trademark in 2009. Schenken T. Dep., pgs. 96-96, Ex. 41, p. 8. UPS tests brand awareness, and with reference to ground delivery, as high as 94 percent of respondents mentioned UPS. Schenken T. Dep., p. 120, Ex. 56, p. 7. With reference to air delivery, as high as 88 percent of respondents mentioned UPS.

These factors demonstrate the strength and fame of the mark “UPS.” As such, the mark “UPS” is entitled to the broadest scope of protection.

2. Powertech’s Designation and the Mark “UPS” are similar in sight and sound

A disclaimer does not remove disclaimed elements from the mark. Trademark Manual of Examining Procedure (“TMEP”) § 1213.10. A composite mark must be regarded as a whole, including any disclaimed component, in evaluating similarity to

other marks for purposes of likelihood of confusion. Id.; See In re National Data Corp., 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); Specialty Brands, Inc. v. Coffee Bean Distributors, Inc., 748 F.2d 669, 672, 223 USPQ 1281, 1282 (Fed. Cir. 1984); Giant Food, Inc. v. Nation's Foodservice, Inc., 710 F.2d 1565, 1570, 218 USPQ 390, 395 (Fed. Cir. 1983); Schwarzkopf v. John H. Breck, Inc., 340 F.2d 978, 144 USPQ 433 (C.C.P.A. 1965); In re MCI Communications Corp., 21 USPQ2d 1534, 1538-39 (Comm'r Pats. 1991). Thus, the disclaimer of "UPS" from Applicant's Mark does not remove the "UPS" portion from the likelihood of confusion analysis.

The various "UPS" marks, including the formative "UPS" marks, are either comprised of "UPS" or feature "UPS" as the dominant portion of the mark. The same is true for Powertech's designation "HYBRID GREEN UPS." The "UPS" component will dominate because the terms "hybrid" and "green" are descriptive. Although marks are to be compared in their entireties, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark." In re National Data Corp., 732 F.2d at 1058. One element of the mark may be more significant in creating a commercial impression. See In re Dixie Restaurants, Inc., 105 F.3d 1405, 1407; 41 USPQ 1531, 1534 (Fed. Cir. 1997). The test for similarity of marks is not whether the marks can be distinguished when placed side by side – rather, the focus is on the recollection of the average purchaser, who normally retains a general rather than specific impression of the marks. See Sealed Air Corp. v. Scott Paper Co., 190 USPQ 106 108 (TTAB 1975). Additionally, when an opposer's mark is famous, the degree of similarity between the marks need not be as great as when the opposer's mark is obscure

or weak. Kenner Parker Toys, 22 USPQ2d at 1456. See also Specialty Brands, Inc., 748 F.2d 669 (“less care may be taken in purchasing a product under a famous name”).

When Powertech’s designation is compared to the various “UPS” marks, it is important to note that Powertech’s designation incorporates the entirety of the famous mark “UPS.” Likelihood of confusion is often found where the entirety of one mark is incorporated within another. Coca-Cola Bottling Co. v. Seagram & Songs, Inc., 526 F.2d 556, 188 USPQ 105 (CCPA 1975) (likelihood of confusion between BENGAL LANCER & Design for club soda, quinine, water and ginger ale and BENGAL for gin); Lilly Pulitzer, Inc. v. Lilli Ann Corp., 376 F.2d 324, 153 USPQ 406 (CCPA 1967) (likelihood of confusion between THE LILLY for dresses and LILLI ANN for dresses); Johnson Publishing Co. v. International Development Ltd., 221 USPQ 155, 156 (TTAB 1982) (likelihood of confusion between EBONY for cosmetics and EBONY DRUM for hairdressing and conditioner); and In re Cosvetic, 202 USPQ 842 (TTAB 1979) (likelihood of confusion between HEAD START COSVETIC & Design for hair conditioning, shampoo and condition and HEADSTART for after-shave).

The additional terms “HYBRID” and “GREEN” in Powertech’s designation do not distinguish it from the mark “UPS” and the many “UPS” formatives because of the highly descriptive nature of those terms. Thus, based on the similarity in sight and sound, there is a likelihood of confusion between Applicant’s Mark and the famous UPS Marks.

3. In Use, Powertech’s Designation and the “UPS” Mark create similar commercial impressions

UPS has demonstrated substantial use of the famous mark “UPS” in relation to environmentally-friendly programs and initiatives. Such programs and initiatives are often referred to by UPS as “green” and the mark “UPS” is used extensively in

connection with the term “green.” UPS’s annual sustainability reports, beginning in 2003, discuss UPS’s “green” initiatives in detail, as does UPS’s DECISION GREEN program. Schenken T. Dep., p. 89, Ex. 37. The mark “UPS” is also extensively used in connection with the term “hybrid.” UPS uses 1,783 alternative fuel vehicles, all bearing the UPS Mark. Schenken T. Dep., p. 63. This fleet of hybrid vehicles bears the language “HYDRAULIC HYBRID” or “HYBRID ELECTRIC VEHICLE” in close proximity to the UPS mark. *Id.* at 92.

Through UPS’s use of the mark “UPS” and the various formative marks in connection with green initiatives, including these hybrid vehicle technologies, UPS has created the commercial impression that it is a green company that promotes hybrid technology. Thus, when consumers hear HYBRID GREEN UPS, they are likely to think of UPS and believe that the UPS is the source of the goods. Schenken T. Dep., p. 129-130. See *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1003-04 (Fed. Cir. 2002) (holding that even though PACKARD TECHNOLOGIES and HEWLETT PACKARD differ somewhat in appearance and sound, the marks convey a similar commercial impression because consumers would be aware of Hewlett-Packard’s heavy involvement in technology-based goods and therefore the marks are similar in their entirety).

4. The goods offered under Powertech’s Designation are similar to the goods and services offered under the famous “UPS” Mark

The issue is not whether consumers will confuse the goods and/or services, but rather, whether there is a likelihood of confusion as to the source of the goods and/or service. *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984) [emphasis added]. Additionally,

“special care is necessary to appreciate that products not closely related may nonetheless be confused as to source by the consumer because of the fame of the mark.” Bose Corp. v. QSC Audio Products, Inc. 293 F.3d 1367, 63 USPQ2d 1303, 1310 (Fed. Circ. 2002).

UPS uses the “UPS” marks on electronic goods such as DIADS, the Internet, and a wide range of computer software. As a result, the mark “UPS” is visible to millions of individuals in the United States. The “UPS” mark is used on the battery-operated, handheld electronic clipboard known as the DIAD. Schenken T. Dep., p. 16. Such electronic devices are routinely “recharged” by means of a power supply, such as the hybrid device intended to be offered by Powertech. Moreover, sixty thousand UPS drivers, clad in uniforms bearing the “UPS” mark carry the DIAD and show it to literally millions of customers for signature. Id. The mark “UPS” is in use on printers and computers for customers who use UPS WORLDSHIP. Id. at 17-18. UPS licenses the mark UPS for use in connection with electronic and battery powered items such as high-quality model planes, remote controlled planes, children’s toys which light up and make sound, key chains, watches, flashlights, to name a few. Id. at 134 and 146, Schenken T. Dep., Ex. 60. Rechargeable electronic devices permeate the business world. For example, the intended “hybrid green uninterruptible power supply” shown at the Powertech website demonstrates the devices as recharging a portable computer, a telephone, a personal digital assistant (“PDA”) and a desktop computer. Opp. Ex. 5. All such devices are used by UPS in its business. Moreover, one could readily envision a scenario where a HYBRID GREEN UPS product would be shipped via UPS in a hybrid vehicle under the UPS Decision Green program. The goods and services here are interrelated.

The fame of the mark “UPS” in connection with the wide variety of items with which UPS uses the famous mark “UPS,” including electronics, makes it likely that a consumer encountering the designation “HYBRID GREEN UPS” is likely to mistakenly believe that UPS is the source of the goods offered in connection with that mark.

IV. CONCLUSION

The designation “HYBRID GREEN UPS,” in view of Powertech’s disclaimer and admissions and the evidence of record, when used on or in connection with the subject goods, is merely descriptive within the meaning of Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1). Assuming that Powertech could establish any trademark right in the designation “HYBRID GREEN UPS,” said designation so resembles the mark “UPS” as used and registered by UPS as to be likely, when used in connection with the subject goods, to cause confusion, or to cause mistake or to deceive within the meaning of Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). Accordingly, UPS respectfully submits that this opposition should be sustained and the requested registration should be refused.

Date: March 31, 2010

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that the foregoing was served upon Applicant's attorneys this day by depositing a true and correct copy of Opposer's Opposition Brief and Exhibits thereto with the United States Postal Service as first-class mail, postage prepaid, addressed to:

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Dated: March 31, 2010

/Elizabeth M. Fox/

Elizabeth M. Fox
An Attorney for Opposer

CERTIFICATE OF TRANSMISSION

I hereby certify that the foregoing Opposer's Opposition Brief is being transmitted to the United States Patent and Trademark Office through the Electronic System for Trademark Trials and Appeals ("ESTTA") on the date indicated below:

Dated: March 31, 2010

/Elizabeth M. Fox/

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