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

Proceeding	91184197
Party	Defendant POWERTECH INDUSTRIAL CO., LTD.
Correspondence Address	Morton J. Rosenberg Rosenberg, Klein and Lee 3458 Ellicott Center Drive, Suite 101 Ellicott City, MD 21043-4178 UNITED STATES rkl@rkpatlaw.com
Submission	Brief on Merits for Defendant
Filer's Name	MORTON J. ROSENBERG
Filer's e-mail	rkl@rkpatlaw.com
Signature	/MORTON J. ROSENBERG/
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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.	:	Opposition No. 91184197
	:	Mark: HYBRID GREEN UPS
POWERTECH INDUSTRIAL	:	
CO., LTD.,	:	
	:	
Applicant.	:	

MAIN BRIEF OF APPLICANT POWERTECH INDUSTRIAL CO. LTD.

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I. INTRODUCTION AND STATEMENT OF ISSUES

Applicant, Powertech Industrial Co., Ltd., hereby submits its main Brief with respect to the Opposition Proceeding No. 91184197 pursuant to Trademark Rule 2.128.

There are two main issues before the Trademark Trial and Appeal Board in this Opposition Proceeding. The first issue is whether there would be a likelihood of confusion under the Lanham Act between Opposer's prior Registrations utilizing the mark "UPS" and Applicant's mark "HYBRID GREEN UPS". 15 U.S.C §1052(d). Opposer's Registrations Nos. 514,285; 966,774; 1,277,400; 1,375,109; 1,460,348; 1,874,248; 1,876,943; 1,878,016; 1,878,918; 2,098,168; 2,128,739; 2,278,090; 2,582,489; 2,830,249; 2,483,193; 3,160,062; 2,520,558 and 2,973,108, are generally directed to package delivery services and computer software as well as hardware associated with such package delivery services. Applicant's sought for mark is for power supplies, mobile phone battery chargers; mobile phone battery charger stations; battery chargers; universal power supplies; power saving adaptors; electric storage batteries; uninterruptible power supplies; AC/DC converters; and power source stable adapters, as provided in Serial No. 77/176,134.

The second issue before the Trademark Trial and Appeal Board is whether Applicant's mark "HYBRID GREEN UPS" is descriptive within the meaning of 15 U.S.C § 1052(e)(1).

It is respectfully submitted that the evidentiary record and the arguments presented herein demonstrate that there is no likelihood of confusion between Applicant's mark "HYBRID GREEN UPS" and Opposer's use of the mark "UPS" and further that Applicant's mark "HYBRID GREEN UPS" is not descriptive within the meaning of 15 U.S.C §1052(e)(1) and therefore a final judgment should be entered in favor of Applicant and Applicant's trademark application should be granted and issue as a U.S. Trademark Registration.

II. SUMMARY OF THE PROCEEDINGS AND EVIDENTIARY RECORD

II(a). Summary of the Proceedings

Applicant filed the subject trademark application, Serial No. 77/176,134, in the United States Patent and Trademark Office on 9 May 2007.

The Identification of the Goods as filed make clear that the letters “UPS” refer to “uninterruptible power supplies.”

In a telephone interview held with the Trademark Examining Attorney on 23 August 2007, the Trademark Examining Attorney indicated that Applicant would be required to disclaim the letters “UPS” apart from the mark as shown, which was agreed to by the Applicant.

In a Priority Official Action and Examiner’s Amendment dated 23 August 2007, the Trademark Examining Attorney at the U.S. Patent and Trademark Office suggested a minor change to the Identification of the Goods which was adopted and has resulted in the Identification of the Goods as they presently stand.

Applicant’s trademark application was published by the USPTO on 18 March 2008. Subsequent to publication, Opposer filed a Notice of Opposition on 19 May 2008 alleging priority and both a likelihood of confusion and dilution with its registered marks including the letters “UPS.”

On 24 June 2008 Applicant answered the Notice of Opposition denying the allegations relating to likelihood of confusion and dilution made in the Notice of Opposition. The claim of dilution has been withdrawn. Opp. Br., fn. 13.

On 23 June 2009, Opposer filed a Notice of Reliance; Opposer also filed a Motion to Amend the Notice of Opposition.

On 6 July 2009, Applicant filed an Opposition/Response to Opposer's Motion to Amend the Notice of Opposition.

On 27 July 2009, Opposer filed a Response in Support of Opposer's Motion to Amend the Notice of Opposition.

On 21 August 2009, the TTAB reset the Trial Dates; Applicant filed its Notice of Reliance.

On 4 September 2009, Applicant filed its Amended Answer to Opposer's Amended Notice of Opposition.

On 9 October 2009, Opposer filed a Supplemental Notice of Reliance.

On 4 December 2009, Applicant filed a Supplemental Notice of Reliance.

On 27 January 2010, Opposer filed a Rebuttal Notice of Reliance.

On 31 March 2010, Opposer filed its Main Brief on the Merits.

The Discovery and Trial Period having closed, Applicant now submits its Main Brief on the Merits.

II(b). Evidentiary Record

The record evidence in this Opposition Proceeding is as follows:

(1). Applicant's Evidentiary Record

Applicant's Notice of Reliance filed 21 August 2009

includes:

- (i) Applicant's Answer to the Notice of Opposition (as originally filed);
- (ii) Applicant's Answer to Opposer's First Set of Interrogatories to Applicant;
- (iii) Applicant's Answer to Opposer's First Set of Admissions;
- (iv) Applicant's Answer to Opposer's First Request for Production of Documents and Things including Exhibits Bates #000001-000144;
- (v) Copies of pages from Merriam-Webster's Collegiate Dictionary - 11th Edition (Bates #000145-000147);
- (vi) Copies of pages from the American National Standard IEEE Standard Dictionary of Electrical and Electronics Terms - 3rd Edition (Bates #000148-000152);
- (vii) Copies of pages from internet websites www.upsforless.com (Bates #000153-000154);
- (viii) Copies of pages from internet webiste www.falonups.com (Bates #000155-000156);
- (ix) Copies of pages from internet website www.direction.com (Bates #000157-000165);
- (x) Copies of pages from internet webiste www.apc.com (Bates #000166-000171)

(xi) Copies of pages from internet website

www.minutemanups.com (Bates #000172-000173);

(xii) Copies of pages from internet website www.jetcafe.org

(Bates #000174-000190);

(xiii) Applicant's Notice of Reliance filed on 4 December

2009 including Trademark Registration: 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;

3,017,698; and 3,359,502.

(2). Opposer's Evidentiary Record

(i) Opposer's Notice of Reliance filed 23 June 2009

includes:

Opposer's Exhibit 1 - Applicant's Answers to Opposer's First Set of Interrogatories to Applicant, dated 13 April 2009;

Opposer's Exhibit 2 - Applicant's Response to Opposer's First Request for Admissions, dated 26 April 2009.

(ii) Opposer's Supplemental Notice of Reliance filed 9

October 2009 includes:

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 and 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.

(iii) Opposer's Rebuttal Notice of Reliance filed 27

January 2010 includes:

Copies of third party registrations which include the term

“green.”

(iv) Testimonial Deposition of Christopher T. Schenken

filed 1 March 2010 including Schenken Testimonial Deposition, Exhibits 1-

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III. STATEMENT OF FACTS

Applicant, Powertech Industrial Co., Ltd., is a corporation of Taiwan.

Applicant filed an intent-to-use trademark application at the USPTO on 9 May 2007 and after a determination by the USPTO that the mark, after having been searched, was not barred by a similar registered or pending mark. The Trademark Examining Attorney did not find that the words “HYBRID GREEN” were descriptive of Applicant’s goods.

Applicant’s mark passed to publication on 18 March 2008.

Applicant’s Identification of Goods as published: 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 in International Class 9.

Opposer has made a world wide claim of ownership directed to the “UPS” mark and has previously brought and aggressively pursued a similar Opposition proceeding against Applicant in Taiwan. The Taiwan Intellectual Property Office (TIPO) has rendered a decision rejecting such Opposition; a copy of the TIPO decision and summary of portions of which are attached as an Appendix to this Brief for completeness sake.

**IV. DISSIMILARITY OF THE MARKS “HYBRID GREEN UPS” AND
OPPOSER’S USE OF THE LETTERS “UPS” DICTATE AGAINST THE
LIKELIHOOD OF CONFUSION WHEN THE DECISIONAL FACTORS
OF E.I. DUPONT NEMOURS & CO. ARE TAKEN INTO ACCOUNT**

The decisional process relating to similarity of marks was enunciated in In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973) and consists of a number of factors to be taken into account with respect to a determination of a likelihood of confusion:

IV(a). The dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression dictates against any likelihood of confusion between the marks at issue.

Applicant’s mark is directed to “HYBRID GREEN UPS”, which has no meaning except as in a trademark sense. The letters “UPS” have been disclaimed apart from Applicant’s mark since the letters “UPS” have entered the English language lexicon (the letters “UPS” are a common acronym for “uninterruptible power supply” or “universal power supply”). The term “HYBRID GREEN” has no meaning except in a trademark sense when Applicant’s goods are taken into account.

Opposer has objected to the use of Applicant’s “UPS” in Applicant’s mark claiming there would be a likelihood of confusion. Additionally, to Applicant’s

knowledge, Opposer has not used the combined words “HYBRID GREEN” in any trademark sense.

Applicant’s mark and Opposer’s marks both include the letters “UPS” and Applicant submits that the common portion of the marks at issue, namely, “UPS” is a commonly used acronym standing for “uninterruptible power supply” and/or “universal power supply.” This commonly used acronym is used by many third party registrants and by numerous third parties in the field of electronic components and power supplies. App. Not. Rel., Bates #000126-000139 attached to App. Ans. to Opp. First Req. to App. for Prod. of Doc. and Things. Each of the exhibits is directed to a third party registrant who uses the letters “UPS” for goods similar to Applicant’s goods. All of the aforementioned registrations are classified in International Class 9. Additionally, such registrations use the letters “UPS” either as a suffix or a prefix much in the manner of Applicant’s use of the letters “UPS” in Applicant’s mark.

The terminology and use of the letters “UPS” have clearly become a well known acronym in the electronic and power supply channels of trade. This well known acronym can be found in numerous sources including the internet web page www.acronymfinder.com. App. Not. Rel., Bates #000110 attached to App. Ans. to Opp. First Req. to App. for Prod. of Doc. and Things.

Numerous articles relating to power supply systems commonly use the letters “UPS” as an abbreviation for “uninterruptible power supplies.” App. Not.

Rel., Bates #000111-000125 attached to App. Ans. to Opp. First Req. to App. for Prod. of Doc. and Things.

Articles and other publications using the letters “UPS” relating to UPS technologies literally are seen in commerce by the thousands and are commonly understood by those in the power supply channels of trade to represent “universal power supply” or “uninterruptible power supply.”

As noted before, the letters “UPS” have entered the lexicon and are understood to mean “uninterruptible power supplies” and “universal power supplies” as is provided in Merriam-Webster’s Collegiate Dictionary and the IEEE Standard Dictionary of Electrical and Electronic Terms. App. Not. Rel., Bates #000145-000152 attached to App. Ans. to Opp. First Req. to App. for Prod. of Doc. and Things. In fact, the USPTO recognizing that the letters “UPS” stands for “uninterruptible power supply” or “universal power supply”, required Applicant to disclaim the letters “UPS” apart from its mark.

Numerous websites use “UPS” as an acronym for “uninterruptible power supplies” and “universal power supplies” and such is used in advertisements in all types of media. App. Not. Rel., Bates #000153-000171 attached to App. Ans. to Opp. First Req. to App. for Prod. of Doc. and Things.

With the letters “UPS” entering the English lexicon, being used by many third party registrants, and further being used in literally thousands of advertisements by third parties associating the letters “UPS” with “uninterruptible power supply” and “universal power supply”, Applicant submits that the common

portion of the marks at issue, namely, “UPS” is inherently weak and that Applicant’s use would not give rise to any likelihood of confusion (especially when the diverse channels of trade of Applicant and Opposer are taken into account). Where the common elements of conflicting marks may be words or letters that are weak, this fact reduces the likelihood of confusion. Smith v. Tobacco Byproducts & Chemical Corp., 243 F.2d 188, 113 U.S.P.Q. 339 (C.C.P.A 1957). The remaining portion of Applicant’s mark “HYBRID GREEN” has no relation or similarity to any of the marks alleged by the Opposer in the Notice of Opposition and the Amended Notice of Opposition.

The basic rule of trademark analysis is that marks must be compared in their entireties and not dissected. When articulating reasons for reaching a conclusion on the issue of confusion, there may be nothing improper in stating that more or less weight has been given to a particular feature of the mark, however, the ultimate conclusion must rest on the consideration of the marks in their entireties. In re National Data Corp., 753 F.2d 1056, 224 U.S.P.Q. 749 (Fed. Cir. 1985). It is believed that it is improper to simply dissect Applicant’s mark and then draw a correspondence between a portion of Applicant’s mark and Opposer’s marks.

In making a comparison of the degrees of identity between the marks at issue, the marks are to be compared with respect to similarity of pronunciation, appearance and verbal translation, such as i.e., the “sight, sound and meaning

trilogy.” J. T. McCarthy, McCarthy on Trademarks and Unfair Competitions, § 23:21 (4th Ed. 2009).

Additionally, as decided in Carefirst of Maryland, Inc. v. First Care, P.C., 434 F.3d 263, 271, 77 U.S.P.Q.2d 1577 (4th Cir. 2006), “If one of two similar marks is commonly paired with other material, that pairing will serve to lessen any confusion that might otherwise be caused by the textual similarity between the two marks.” (emphasis added). This is most significant in the instant Opposition since the letters “UPS” have little independent strength. Since Opposer’s registered marks containing “UPS” are weak (in the power supply channels of trade), consumers when encountering Applicant’s mark “HYBRID GREEN UPS” on the one hand and Opposer’s “UPS” on the other hand, are more likely to focus on the differences between the two marks.

Turning to the comparison of degrees of identity between the marks, when the marks are taken in their entirety, Applicant’s mark “HYBRID GREEN UPS” and the complained of marks containing “UPS” provide for a different overall commercial impression to the potential purchaser.

When the “sound” meaning of the mark is taken into account, Applicant’s mark in its entirety is directed to “HYBRID GREEN UPS” as opposed to the Opposer’s marks “UPS” and provides for an entirely different sound to the potential purchaser.

Finally, with regard to the “meaning” portion of the trilogy, Applicant’s use of the letters “UPS” is clearly understood by potential purchasers to mean

“uninterruptible power supplies” or “universal power supplies” (since this is what Applicant is selling) as opposed to the packaging and delivery services related to Opposer’s use of the letters “UPS” which means United Parcel Service.

IV(b). When the nature of Applicant’s goods and Opposer’s services and goods is taken into account, such dictates against any likelihood of confusion.

Applicant’s application is directed to various electronic components in International Class 9, namely, 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.

Opposingly, Opposer has cited many Registrations associated with services relating to transportation and delivery of packages. In some of the registrations cited by the Opposer, computer programs, software, and computer hardware are listed as goods in International Class 9, however, all of the goods cited by the Opposer are specifically claimed as being directed to the delivery, tracking, transportation and invoicing of packages. All of these marks use the letters “UPS” which stands for “United Parcel Service.”

Applicant’s goods are directed to electronic components and not to computer software having any relation to the delivery and transportation services provided by Opposer. Additionally, Applicant’s goods cannot be classified as

“computer hardware,” although such components may exist in a computer in some fashion. None of the goods of Applicant are directed in any manner, shape or form to electronic components with relation to tracking, shipping, transportation or invoicing of packages.

The only common feature associated with the channels of trade of Applicant’s goods and Opposer’s services is that both Applicant’s goods and Opposer’s services serve people or customers, which would apply to almost any product or service being registered.

Applicant neither desires nor claims to have any interest in the services provided by the Opposer and simply uses the letters “UPS” to be an acronym for “universal power supplies” or “uninterruptible power supplies” as is commonly used by thousands, if not millions, of other parties associated with electronic components.

IV(c). When the conditions under which and buyers to whom sales are made are considered, such dictate against any likelihood of confusion.

With respect to the types of purchasers of Applicant’s goods, such are clearly those who have some type of electronic system in their home, office, or laboratory that utilizes power supplies and needs battery chargers, etc.. The purchasers of Applicant’s goods are not “off the shelf” buyers, but are purchasing their goods for a specific purpose.

Opposingly, the Opposer's services and goods are directed to persons who are transporting various packages and it is extremely difficult to believe that a purchaser of a power supply for an electronic component would possibly confuse this with the services provided by the Opposer in transporting packages.

IV(d). When the number and nature of similar marks in use on similar goods are considered, such dictate against any likelihood of confusion.

Opposer's basis for likelihood of confusion is directed to the letters "UPS." The letters "UPS" have been used by many registrants for trademarks on the Principal Register using "UPS" as a prefix or suffix in International Class 9. App. Not. Rel., Bates #000126-000139 attached to App. Ans. to Opp. First Req. to App. for Prod. of Doc. and Things.

Still further, countless third parties use the letters "UPS" in advertising worldwide as letters pertaining to uninterruptible or universal power supplies. App. Not. Rel., Bates #000153-000171 attached to App. Ans. to Opp. First Req. to App. for Prod. of Doc. and Things.

Many articles have been published on the internet relating to "UPS" as "uninterruptible power supplies" and in these articles the "uninterruptible" or "universal power supplies" are abbreviated as "UPS". App. Not. Rel., Bates #000172-000190 attached to App. Ans. to Opp. First Req. to App. for Prod. of Doc. and Things.

Further, the letters “UPS” have entered the lexicon of the English language and the Merriam-Webster’s Collegiate Dictionary lists the letters “UPS” as an abbreviation for “uninterruptible power supply.” The IEEE Standard Dictionary of Electronics and Electronic Terms also indicates that the letters “UPS” stand for “uninterruptible power supply.” App. Not. Rel., Bates #000145-000152 attached to App. Ans. to Opp. First Req. to App. for Prod. of Doc. and Things.

Thus, there is an overwhelming number of users using the letters “UPS” for electronic components in the nature of uninterruptible and/or universal power supplies. The use of “UPS” is commonplace in the electronics field and is used as a common abbreviation by millions of people all over the world.

The Trademark Examining Attorney at the U.S. Patent and Trademark Office recognized that the letters “UPS” when taken in relation to Applicant’s goods stand precisely for “uninterruptible” and/or “universal power supply” and required a disclaimer of the letters “UPS” apart from Applicant’s mark.

IV(e). The fame of the Opposer’s mark “UPS” applies to transportation, packaging and delivery of packages, but does not extend to electronic components which are in a completely different field and operate in a completely different channel of trade.

Applicant admits that the mark “UPS” is directed to a well known mark and is used in the transportation, packaging and delivery of packages. The mark “UPS” used by the Opposer however, is in a completely different field and

channel of trade than Applicant's mark and is an acronym for "United Parcel Service." The letters "UPS" have entered the English language lexicon and stand for "uninterruptible power supply" or "universal power supply" for goods which are totally unrelated to the services and the goods complained of by the Opposer.

All of the goods listed by the Opposer, such as computer software, are directed to the broader field of transportation, packaging and delivery of packages. Applicant's goods are simply directed to electronic components which are used in conjunction with other electronic devices for applications having absolutely nothing to do with the shipping or transportation of packages.

Opposer has indicated that Opposer uses the letters "UPS" as a trademark on electronic goods such as DIADs, the internet, and a wide range of computer software. Opp. Br. p. 35-37. Opposer however, does not deny that the letters "UPS" used by itself in any manner stands for United Parcel Service. Further, what is not stated by Opposer is that Opposer, although using the letters "UPS", such use is directed to packaging, transportation, and delivery services associated with packages, but not power supplies. As to the fact that the mark "UPS" is visible to what the Opposer claims are "millions of individuals" in the United States, this may be true through its advertising, however, the mark "UPS" is associated with "United Parcel Service" and the services of transportation, delivery and packaging.

Although the letters "UPS" may be used on battery operated handheld electronic clipboards known as DIAD, this does not imply that such is directed in

any manner, shape or form to power supplies or battery chargers as is the case for Applicant's goods. The Opposer has stated that Applicant's website describes devices which may recharge a portable computer. Opposer then makes the disingenuous relation that all such devices are used by UPS in its business. It is not understood by Applicant why the mere fact that Opposer may be using Applicant's goods in its business would in some way negate Applicant's registration of its mark especially in this case where the letters "UPS" have been disclaimed apart from the mark as standing for "uninterruptible power supply." It is not believed that Opposer has made any connection between Applicant's goods and Opposer's goods with respect to the diverse channels of trade of Opposer and Applicant as well as the actual goods themselves.

The Opposer alleges that: "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." Opp. Br. p. 36. Once again, Applicant believes that the mere fact that Applicant's goods using the mark "HYBRID GREEN UPS" are being shipped through some UPS vehicle is no reason for preventing Applicant from obtaining its registration directed to the compound mark "HYBRID GREEN UPS" for its specific goods. The fact that Applicant's goods may possibly be shipped through United Parcel Service does not give the right to United Parcel Service to form a legal basis to successfully oppose Applicant's mark.

Since the Opposer is creating a hypothetical “scenario”, Applicant then assumes Opposer takes the position that any uninterruptible power supply goods which simply use the letters “UPS” would be an infringement of their trademark registrations. Since it has clearly been shown that the letters “UPS” are descriptive and have entered the English lexicon, then it is Opposer’s position that no party may use the letters “UPS” for uninterruptible power supplies whether they place it in combination with a prefix or suffix which distinguishes that mark from Opposer’s marks.

IV(f). The common term “UPS” used by Applicant and Opposer in their respective marks creates dissimilar commercial impressions.

Opposer indicates that its mark “UPS” is used in connection with the term “HYBRID”. Opp. Br. p. 34-35. To this end, the Opposer has indicated that Opposer uses alternative fuel vehicles used in its transportation services and such vehicles bear the “UPS” mark. The Opposer also stated that “the mark UPS is also extensively used in connection with the term “hybrid”. To this end, the Opposer has indicated it uses alternative fuel vehicles which bear the “UPS” mark and that somewhere on the vehicles, there is language such as “hydraulic hybrid” or “hybrid electric vehicle”. The combination of “UPS” and “HYBRID” does not appear to be directed to a trademark and the language “hydraulic hybrid” or “hybrid electric vehicle” may at best be a mark for vehicles. To Applicant’s knowledge however, such is not claimed the Opposer. Additionally, Applicant

notes that the Opposer uses the term “close proximity” when the letters “UPS” are used with the words “hydraulic hybrid” or “hybrid electric vehicle”. If in fact the Opposer is using the letters “UPS” and claiming some connection to the word “HYBRID” such would be directed to a “vehicle” and certainly not to the goods claimed by Applicant in International Class 9. None of the marks pleaded by Opposer is directed to vehicles and therefore, any claim of confusion related to such vehicles is meaningless.

The Opposer then has stated that some type of “sustainability reports” discuss UPS’s “green” initiatives in detail, such as “UPS’s Decision Green Program.” Opp. Br. p. 35. Such use of the word “GREEN” may in fact appear in some reports, however, there is neither indication nor evidence that Opposer is using the word “GREEN” in the trademark sense and further has not applied it to any of its goods or services.

In effect, Opposer is taking the letters “UPS” and stating that because it uses the word “HYBRID” on some vehicles, and then further using the word “GREEN” in some type of report, that Applicant’s compound mark “HYBRID GREEN UPS” can be thought of as a mark which is confusingly similar when the Opposer uses individual words in three separate areas of reports, vehicles and advertisement. But a registered mark must relate to specific goods or services—mere suggestion of or proximity to an actual mark, absent any actual association to those goods (as indicated in a valid registration), is meaningless. Opposer in

essence seeks to extend Federal trademark protection to goods/services it has not Federally registered or uses in the trademark sense.

V. APPLICANT’S “HYBRID GREEN UPS” IS NOT DESCRIPTIVE OF APPLICANT’S GOODS

V(a). Applicable Law

Applicant’s mark is directed to “HYBRID GREEN UPS”, which may at best be considered suggestive but not descriptive. The distinction lies in the fact that suggestive terms are those requiring the buyer to use thought, imagination, or perception to connect the mark with the goods. Descriptive terms are those which **directly** convey to the buyer the ingredients, qualities, or characteristics of the product. Educ. Dev. Corp. v. Econ. Co., 562 F.2d 26, 29, 195 U.S.P.Q. 482 (10th Cir. 1977) (emphasis added). These concepts were originally used in General Shoe Corp. v. Rosen, 111 F.2d 95, 98, 45 U.S.P.Q. 196 (4th Cir. 1940). Further, the determination of whether a mark is descriptive requires consideration of the meaning of the term or mark to the perspective purchasers and not to the public in general. Educ. Dev. Corp. (citing Blisscraft of Hollywood v. United Plastics Co., 294 F.2d 694, 699, 131 U.S.P.Q. 55 (2nd Cir. 1961)).

One of the barometers used by the courts to qualify the distinction is the so-called “imagination test.” Zatarains, Inc. v. Oak Grove Smokehouse, Inc., 698 F.2d 786, 792, 217 U.S.P.Q. 988 (5th Cir. 1983). This test seeks to measure the relationship between the actual words of the mark and the products to which they

are applied and echoes the analysis found in Educ. Dev. Corp. If a term “requires imagination, thought and perception to reach a conclusion as to the nature of the goods, it is considered a suggestive term.” Zatarains citing Stix Prod., Inc. v. United Merchants & Mfr., Inc., 295 F.Supp. 479, 488, 160 U.S.P.Q. 777 (S.D.N.Y. 1968). What is more, the TTAB has stated in In re Tennis In The Round, Inc., 199 U.S.P.Q 496 (T.T.AB. 1978) “if one must exercise mature thought or follow a multi-stage reasoning process in order to determine what product or service characteristics the term indicates, the term is suggestive rather than merely descriptive.” (citing In re C.J. Webb, Inc., 182 USPQ 63 (T.T.A.B. 1974)).

If the mark does not clearly indicate only what the goods are, their function, characteristics or use, then it cannot be “merely descriptive.” J. T. McCarthy, McCarthy on Trademarks and Unfair Competitions, §11:51 (4th Ed. 2009). The word “merely” should be equated with “only”. In re Quik Print Copy Shops, Inc., 616 F.2d 523, 205 U.S.P.Q 505 (C.C.P.A. 1980).

V(b). Applicant’s use of “HYBRID GREEN UPS” is not descriptive of Applicant’s goods since such would require imagination, thought and perception to reach a conclusion as to the nature of the goods.

Applicant’s mark is directed to “HYBRID GREEN UPS” and includes the words “HYBRID GREEN” in combination with the well known abbreviation for uninterruptible power supplies (UPS). The term “HYBRID GREEN UPS” is a compound mark and whether taken alone or in combination, the words

“HYBRID” and “GREEN” do not provide to a purchaser of Applicant’s goods any possible feature or characteristic of the goods without extensive imagination, thought and perception to be used by purchaser.

The term “GREEN” has in some instances been considered to be a term which relates to conservation, however, such word must be taken in context with Applicant’s goods. Applicant’s goods are directed to uninterruptible power supplies, battery chargers and other electronic components which are not generally associated with having inherent ecological characteristics. It is true that each reputable company selling goods generally would want the goods to be ecologically friendly, however, it is not necessarily a conscious consideration when a user is purchasing such electronic components.

The purchaser of Applicant’s goods including the word “GREEN” would generally be a purchaser of electronic equipment which is used with other electronic components for a variety of applications. The term “GREEN” would not readily come to the mind of the user as being a product which is ecologically friendly since this is not a term which is immediately or inherently associated with electronic components. The term “GREEN” may be used in the lexicon as associated with services or products which would have an ecological impact. When a purchaser is purchasing electronic components, the term “GREEN” is not generally seen to be in the lexicon of electrical supplies.

The remaining term in Applicant’s mark is directed to the word “HYBRID” and when applied to Applicant’s goods, namely, electronic components, would at

best require imagination, thought and perception for a purchaser to reach a conclusion as to the nature of the goods. The term “HYBRID” standing by itself, is defined as something of a mixed origin, or unlike parts as provided in Webster’s New World Dictionary, 2nd College Ed. Potential purchasers seeking to purchase Applicant’s goods and seeing the term “HYBRID” would not immediately understand that the goods were directed to any particular type of electronic component or to any feature of the component itself.

Thus, a purchaser of Applicant’s goods when seeing the word “HYBRID” may take this word as meaning a component having many disparate parts, may infer that the component is formed of differing or disparate components, may take the meaning that the electronic component is multi-functional, may understand that the word is directed to an electronic component which itself may be used with many other electronic components, as well as a host of other interpretations. Since there are many interpretations of the word “HYBRID”, the potential purchaser must be able to give a great amount of thought and perception in order to come to a conclusion as to the nature of the goods.

Thus, at the very worst, the word “HYBRID” used in connection with Applicant’s goods can only be termed in the abstract to be suggestive and not descriptive when Applicant’s goods are taken into account.

V(c). Numerous marks issued on the Principal Register use the words “GREEN” and/or “HYBRID” without requiring a disclaimer of either “HYBRID” or “GREEN.”

Many marks have been issued by the U.S. Patent and Trademark Office on the word “GREEN” for goods in International Class 9 including “VILLAGE GREEN SYSTEMS,” Registration No. 3,150,532; “HOP TO GREEN,” Registration No. 3,688,778; “CLEAN GREEN POWER MACHINE,” Registration No. 3,083,913 for solar energy systems; “ECO-GREEN,” Registration No. 2,888,591 for environmentally friendly electrical cables; “GREEN,” Registration No. 3,347,176 for video tapes and DVDs; “PROGRAMMABLE POWER FOR A GREEN PLANT,” Registration No. 3,489,672 for semiconductor integrated circuits; “ORANGE FOR SAFETY GREEN FOR THE ENVIRONMENT,” Registration No. 3,686,916 for environmentally friendly highway traffic safety equipment, “GREEN CELL,” Registration No. 3,538,919 for batteries; “CODE GREEN NETWORKS,” Registration No. 3,401,906 for computer hardware and software; “ALL SYSTEMS GREEN,” Registration No. 3,017,697 for computer software, “GREEN PLUMBERS,” Registration No. 3,359,502 for air conditioning units, etc. App. Supp. Not. Rel., Exhibit 1.

Based upon the fact that there are many registrants which use the term “GREEN” in a mark, much like Applicant, the U.S. Patent and Trademark Office has not considered the word “GREEN” to be a descriptive term for all goods. It is

true that the word “GREEN” may be required to be disclaimed from certain goods, however, those are generally associated with ecological characteristics.

Further, Applicant has been issued Registration No. 3,550,927 for the mark “HYBRID GREEN POWER” for essentially the same goods as provided in the subject trademark application. This Registration is in effect at the present time and only the word “POWER” was required to be disclaimed apart from the mark as shown. Thus, Applicant’s use of the words “HYBRID GREEN” was not considered by the U.S. Patent and Trademark Office to be descriptive of Applicant’s goods. Further, Applicant is the owner of Registration No. 3,550,928 directed to the mark “HYBRID GREEN SYSTEM” for essentially the same goods as is provided in the subject trademark application. The word “SYSTEM” was disclaimed apart from the mark as shown, yet the words “HYBRID GREEN” were not considered by the U.S. Patent and Trademark Office to be descriptive of Applicant’s goods.

With respect to the word “HYBRID”, Applicant once again takes note that Applicant owns Registrations No. 3,550,928 for the mark “HYBRID GREEN SYSTEM” and Registration No. 3,550,927 for the mark “HYBRID GREEN POWER” (for substantially the same goods as the subject trademark application) which have been issued by the USPTO without any disclaimer necessary.

Additionally, the USPTO has issued in International Class 9 Registration No. 3,571,724 for the mark “DIGITAL HYBRID WIRELESS” for wireless microphone transmitters; “HYBRIDPACK,” Registration No. 3,606,753 for

integrated circuit chips, and “HYBRID,” Registration No. 3,349,399 for computer graphic cards, etc. All marks issued without the requirement of a disclaimer of the word “HYBRID”.

V(d). Applicant’s use of “HYBRID GREEN UPS” in a patent application does not imply that the mark is “merely descriptive.”

Opposer has alleged that the use of the words “HYBRID GREEN” in a patent application filed by Applicant necessarily forms a basis for concluding that the mark is “merely descriptive.”

Applicant has used the words “HYBRID GREEN” in its processing of its own patent application before the U.S. Patent and Trademark Office. The use of the words “HYBRID GREEN” and terminology associated therewith are taken with respect to the invention detailed in the patent application. Applicant is his own lexicographer and in context with the provisions of 35 USC 112, first paragraph, the Applicant must describe the invention in concise and full form. Applicant filed its trademark application directed to “HYBRID GREEN UPS” prior to filing its patent application and has the right to use its mark or portions thereof in its own application when detailing the invention. The mere fact that Applicant uses the term “HYBRID GREEN” is simply a wording of Applicant’s mark in connection with its own goods, but does not “merely describe” the invention as provided in the patent application.

Applicant has the right to use its own trademark in any context it desires and in this case, Applicant has used the words “HYBRID GREEN” (which is a portion of the subject mark) in a patent application which cannot imply that a purchaser of the goods would consider “HYBRID GREEN UPS” to be descriptive of the goods.

VI. CONCLUSION

The designation “HYBRID GREEN UPS” when used on or in connection with Applicant’s goods is not merely descriptive within the meaning of Trademark Act 15 U.S.C §1052(e)(1). Further, Applicant’s mark “HYBRID GREEN UPS” when Applicant’s goods and Opposer’s goods and services are taken into account, is totally dissimilar and cannot lead to any confusion, mistake or deception within the meaning of Trademark Act 15 USC §1052(d).

Based upon the foregoing arguments, it is respectfully requested that Applicant’s mark be passed to Registration.

VII. APPENDIX

Applicant, Powertech Industrial Co., Ltd. has provided to the undersigned Attorneys a decision rendered by the Taiwan Intellectual Property Office (TIPO) which Applicant believes has bearing on the subject Opposition. The opposing party, United Parcel Service of America, Inc. brought an Opposition in Taiwan against Applicant's Taiwan Trademark Registration 1,302,608, relating to the mark "HYBRID GREEN UPS."

Attached is a copy of the decision sent by the Applicant to the undersigned Attorneys.

Applicant has provided the undersigned Attorneys with a summary of portions of the TIPO Opposition decision as follows:

1. The main body of the Opposition decision: That the Opposition shall be rejected.

2. Apparently on pages 3-4 of the Opposition decision the TIPO has stated that with respect to Trademark Act Article 23(1) 12 and 23(1) 13 that a Trademark Application shall be rejected if the proposed mark satisfies any of the following: "one that is identical or similar to another person's well-known Trademark or mark and hence is likely to confuse the relevant public or likely to dilute the distinctiveness or reputation of said well-known Trademark or mark" and "one that is identical or similar to a Registered Trademark or a proposed Trademark of a preceding Application that is designated for use on identical or

similar goods or services thereof and hence likely to cause confusion to relevant consumers”. However,

(1) The opposed Trademark “HYBRID GREEN UPS” (Reg. No. 01302608) is composed of “HYBRID”, “GREEN”, and “UPS.” The meaning of the “UPS” is “uninterruptible power supply”, which is disclaimed by the Trademark Right Holder. The Opposer’s Trademarks “UPS” (Reg. No. 20326, 805884) and “UPS Online Envoy” (Reg. No. 101607), “UPS Express Saver” (Reg. No. 1251709) and “UPS Proactive Response” (Reg. No. 1275975), consist of the letters “UPS” or in which the first word “UPS” is combined with other words. The “UPS” is the abbreviation of the Opposer’s name “United Parcel Service”, which is a corporation name. The latter Trademark (“HYBRID GREEN UPS”), where the “UPS” is placed at the end of the Trademark and its exclusive right for use is disclaimed, is quite different from the former, where there is only one “UPS” or the “UPS” is provided as a prefix. Judged by the length, combination and the positions of the words, the opposed Trademark is different than Opposer’s said Trademarks.

(2). Additionally, many other marks in which the “UPS” is combined with other words or figures, have been approved to be Registered in Class 9 (in Taiwan), with such a sampling of Registrations being No. 742805, 742911, 750865, 809003, 963087, 1040392, 1353685. Further, it is evident by accessing Google and Yahoo that there are many “UPS” uses found on the internet.

(3). With regard to differing commercial impression, all in all, the opposed Trademark is composed of “HYBRID”, “GREEN” indicating compound energy, green power or environmental protection. No matter what the appearance, concept or pronunciation, they are giving the consumers quite different impressions, and therefore, they are not likely to confuse the relevant public or not likely to dilute the distinctiveness or reputation of the said well-known Trademarks or marks.

The above has been sent to the undersigned Attorneys as the “gist” of the TIPO decision and has been requested by the Applicant to be provided as an Appendix to Applicant’s Main Brief before the TTAB.

Applicant respectfully submits that this Opposition be denied and that the requested application pass to issuance.

Respectfully submitted,

10 May 2010

/Morton J. Rosenberg/

Morton J. Rosenberg
Samuel L. Gompers
Attorneys for Applicant
POWERTECH INDUSTRIAL CO.
LTD.

ROSENBERG, KLEIN & LEE
3458 Ellicott Center Drive, Suite 101
Ellicott City, Md. 21043
Telephone: 410-465-6678
Email: rkl@rkpatlaw.com

CERTIFICATE OF ELECTRONIC TRANSMISSION

I hereby certify that this Applicant's Brief is being transmitted electronically to the U.S. Patent and Trademark office on the date shown below.

For: ROSENBERG, KLEIN & LEE

10 May 2010

/Morton J. Rosenberg/
Morton J. Rosenberg
Attorney for Applicant

CERTIFICATE OF SERVICE

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

Stephen M. Schaetzel
King & Spalding LLP
1180 Peachtree Street
Atlanta, Georgia 30309

10 May 2010

/Morton J. Rosenberg/
Morton J. Rosenberg
Attorney for Applicant

正本

檔 號
保存年限

經濟部智慧財產局商標異議審定書

106 雙掛號
臺北市大安區敦化南路2段71號18樓

受文者：勝德國際研發股份有限公司（代理人：李玉金 君）

發文日期：中華民國98年10月6日
發文文號：(98) 智商0860字第09880492640號



速 別：
密等及解密條件或保密期限：

附 件：

機關地址：106臺北市大安區辛亥路2段185號3樓

聯絡人：陳美穗
聯絡電話：02-23767606
傳 真：02-27359095
中台異字第G00970586號



裝

被 異 議 商 標：註冊第01302608號「HYBRID GREEN UPS」
商 標

異 議 人：美商·美國聯合包裹服務公司

地 址：美國

代 表 人：傑弗瑞 弗艾史東 君

商 標 代 理 人：林秋琴 何愛文 君

地 址：臺北市大安區敦化南路1段245號8樓

商 標 權 人：勝德國際研發股份有限公司

地 址：臺北縣中和市中山路2段407號10樓

代 表 人：周義雄 君

商 標 代 理 人：李玉金 君

地 址：臺北市大安區敦化南路2段71號18樓

審 查 人 員：謝文明

訂

線



主文：異議不成立。

事實：商標權人以「HYBRID GREEN UPS」指定使用於修正前商標法施行細則第13條第009類之「延長線、電源線、電線收線器、附有插頭電線、電線、變壓器、穩壓器、電源供應器、行動電話用充電器、行動電話充電站、變電器、電池充電器、不斷電電源供應器、省電器、節省能源器、不斷電供電器、電源保護器、電壓調整器、交直流電壓轉換器、電源穩定器」商品申請註冊，經本局核准列為註冊第1302608號商標。異議人於97年5月29日以本件商標之註冊有違商標法第23條第1項第12、13款規定提出異議，經本局依法通知商標權人答辯到局。

理由：

一、本案兩造當事人主張：

(一) 異議人主張略以，系爭「HYBRID GREEN UPS」商標係由意為混合物之「HYBRID」、常見單字「GREEN」及與據爭商標相同之「UPS」所組成，其中無字義之字母組合「UPS」構成系爭商標最惹人注意之主要部分，雖已聲明不專用，然仍應整體觀察，而與據爭「UPS」商標於外觀上予人印象極其相近，應屬構成近似，又據爭「UPS」商標為異議人公司名稱「United Parcel Service」之簡稱，異議人係創設於西元1907年，為現今世界數一數二之著名郵件包裹快遞公司，運輸遞送網路遍及全球五大洲200個以上之國家及地區，2007年總遞送文件及包裹件數逾40億件，營收高達497億美元，此外，自1988年設立台灣分公司迄今，全台各地廣設服務據點，該據爭「UPS」等系列商標在全球及台灣廣泛註冊與積極使用而成為家喻戶曉之著名商標，其著名性並經本局中台異字第G00860837、G00860838、G00861320、G00870086及G00950189號等商標異議審定書肯認在案。且系爭商標指定使用之變壓器、電池充電器、電壓調整器等商品，復與據爭註冊第805884號「UPS」商標指定使用於過電壓保護器、電池、蓄電器等商品之性質、功能、銷售對象與通路皆雷同，當然屬類似商品，是系爭商標之註冊，應有商標法第23條第1項第12、13款規定之適用，依法應撤銷其註冊等語。

(二) 商標權人答辯略以，系爭「HYBRID GREEN UPS」

商標中之「GREEN」英文字所要傳達之意涵為節能、省能進而達到環保之意涵，非單純指綠色而言，另「HYBRID」也是目前節能減碳議題中之重要能源使用之參考方向，今系爭商標所欲使用之商品，即為節能減碳、省能環保方式之混合兩種電源供應之不同來源之電源供應裝置，而「UPS」一字則為「Uninterruptible Power Supply」之意涵，其中文意義即為「不斷電電源供應系統」或稱「不斷電系統」，復於Google之網站查詢，檢索UPS相關於不斷電系統之辭彙，而單單僅選擇台灣地區的網頁，則出現之資料筆數繁多，並不會造成一般消費者將之與運輸業之美商UPS「United Parcel Service」有所混淆，故整體而言，系爭商標與僅單純由三個英文字母所組成之據爭「UPS」商標並無構成近似或混淆之虞，又系爭商標指定使用之商品與據爭註冊第805884號「UPS」商標指定使用之商品亦不相同，況以「UPS」作為商標圖樣之一部分，結合其他外文字及其他圖樣申准註冊在第9類商品者，包括註冊第796125、119549、859088、1189123、534039、1353685、1040392、963087、809003、750865、742805、742911號等商標，是系爭商標之註冊，並無違商標法第23條第1項第12、13款之規定等語。

二、按商標法第23條第1項第12、13款本文規定：商標「相同或近似於他人著名商標或標章，有致相關公眾混淆誤認之虞，或有減損著名商標或標章之識別性或信譽之虞者」及「相同或近似於他人同一或類似商品或服務之註冊商標或申請在先之商標，有致相關消費者混淆誤認之虞者」，不得註冊。前揭條款之適用應以兩造商標構成相同或近似為必須具備要件。經查：

(一) 本件系爭註冊第1302608號「HYBRID GREEN UPS」商標圖樣，係由外文「HYBRID」、「GREEN」及「UPS」分置左右排列順序所組成，其中「UPS」為「Uninterruptible Power Supply」之意涵，其中文意義即為「不斷電電源供應系統」或稱「不斷電系統」，其係為商標權人指定使用於不斷電電源供應器、不斷電供電器等商品之說明文字，已為商標權人聲明不在專用之列，而異議人據爭註冊第20326、805884號「UPS」、第101607號「

UPS ONLINE ENVOY」、第1251709號「UPS EXPRESS SAVER」及第1275975號「UPS PROACTIVE RESPONSE」等商標圖樣（詳如異議理由書所載、註冊資料及使用資料），則或為單純之外文「UPS」所構成，或由置於字首之外文「UPS」結合其他外文字所組成，且其外文「UPS」係為異議人公司名稱「United Parcel Service」之簡稱，二者相較，兩造商標圖樣上雖均有相同之外文「UPS」一字，然前者係置於一長串外文之字尾處，並為商標權人聲明不在專用之列，而後者則或為單純之「UPS」一字，或置於較為引人注意之字首位置，整體觀之，兩造商標圖樣或構成之字母字數長短不一、繁簡有別，或排列位置不同，且各結合其他足資區辨之不同外文「HYBRID GREEN」與「ONLINE ENVOY」、「EXPRESS SAVER」、「PROACTIVE RESPONSE」等。

- (二) 況以「UPS」結合其他外文字或圖形作為商標圖樣之一部分，在本局申准註冊於第9類相關商品，並將「UPS」聲明不在專用之列者，即有多件，如：註冊第742805、742911、750865、809003、963087、1040392、1353685號等商標，此有本局商標註冊簿及商標權人檢送之商標註冊資料影本附卷可稽；復於Google及YAHOO!奇摩之網站查詢，以「UPS」檢索結果出現有關「UPS快遞、國際快遞」及「UPS不斷電系統」等相關資料之筆數繁多。
- (三) 綜上，系爭商標雖係由含有複合能源、綠色環保概念之外文「HYBRID」、「GREEN」結合具有商品說明文字之「UPS」所組成，然其所組成之「HYBRID GREEN UPS」商標態樣，與據爭「UPS」等系列商標，二者無論於外觀、觀念或讀音上均予消費者寓目印象截然不同，以具有普通知識經驗之消費者，於購買時施以普通之注意，當可辨識而不會誤認二者來自同一來源或雖不相同但有關聯之來源，應非屬構成近似之商標，自無致相關公眾或相關消費者混淆誤認之虞，亦無減損著名商標或標章之識別性或信譽之虞。從而本件系爭商標之註冊，揆諸上開說明，自無前揭商標法第23條第1項第12、13款規定之適用。

三、至異議人所舉本局中台異字第G00860837、G00860838、G00861320、G00870086、G00950189

號等商標異議審定書一節，核其商標圖樣及商品/服務與本案不同，案情有別；另所舉之註冊第1359399號「DECISION GREEN」商標及已廣泛採用複合能源 (Hybrid) 之運輸車輛等節，亦與本案無關，尚不足以執為本案有利之論據，併予敘明。

四、綜上論述，異議人之主張洵無理由，爰依商標法第16條規定處分如主文。

正本：美商·美國聯合包裹服務公司（代理人：林秋琴 何愛文 君）【收文者地址：臺北市大安區敦化南路1段245號8樓】、勝德國際研發股份有限公司（代理人：李玉金 君）【收文者地址：臺北市大安區敦化南路2段71號18樓】

副本：



局長 王 美 花

依照分層負責規定
授權單位主管決行

如有不服，得於收受本件商標異議審定書之次日起30日內備具訴願書正、副本（均含附件），並檢附原商標異議審定書影本1份經由本局向經濟部提起訴願。