

**THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB**

Mailed:  
January 31, 2011  
Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

United Parcel Service Of America, Inc.

v.

Powertech Industrial Co. Ltd.

Opposition No. 91184197  
against Serial No. 77176134

Stephen M. Schaetze of King & Spalding LLP for United Parcel  
Service Of America, Inc.

Morton J. Rosenberg of Rosenberg Klein and Lee for Powertech  
Industrial Co. Ltd.

Before Bucher, Kuhlke and Bergsman, Administrative Trademark  
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Powertech Industrial Co. Ltd. sought registration on  
the Principal Register of the mark **HYBRID GREEN UPS** (*in  
standard character format*) for goods identified in the  
application, as amended, as "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" in International Class 9.<sup>1</sup>

United Parcel Service Of America, Inc. has opposed this application on the ground that the applied-for term is a merely descriptive term under Section 2(e)(1) of the Act, 15 U.S.C. § 1052(e)(1), and alternatively, on the ground of priority of use and likelihood of confusion, alleging that applicant's mark, when used in connection with the identified goods, so resembles the following registered marks:



for "motor vehicle delivery service for retail stores" in International Class 39;<sup>2</sup>

<sup>1</sup> Application Serial No. 77176134 was filed on May 9, 2007 based upon applicant's allegation of a *bona fide* intention to use the mark in commerce. No claim is made to the exclusive right to use the term "UPS" apart from the mark as shown.

<sup>2</sup> Registration No. 0514285 issued on August 23, 1949; third renewal. No claim is made to the exclusive right to use the words "The Delivery System for Stores of Quality" and "Since 1907" apart from the mark as shown.

**UPS**

for "transportation of personal property for hire by diverse modes of transportation" in Int. Cl. 39;<sup>3</sup>



for "motor vehicle and air transportation of personal property" in International Class 39;<sup>4</sup>



for "motor vehicle and air transportation of personal property" in International Class 39;<sup>5</sup>

**UPS PREFERRED**

for "transportation by air, rail, boat, and motor vehicle of packages and freight" in Int. Cl. 39;<sup>6</sup>

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<sup>3</sup> Registration No. 0966774 issued on August 21, 1973; Second renewal.

<sup>4</sup> Registration No. 1277400 issued on May 8, 1984; renewed. No claim is made to the exclusive right to use the words "2nd Day Air," apart from the mark as shown.

<sup>5</sup> Registration No. 1375109 issued on December 10, 1985; renewed. No claim is made to the exclusive right to use the words "Next Day Air," apart from the mark as shown.

<sup>6</sup> Registration No. 1874248 issued on January 17, 1995; renewed.



for "transportation by air, rail, boat, and motor vehicle of packages and freight" in International Class 39;<sup>7</sup>



**UPS NEXT DAY AIR**

for "motor vehicle and air transportation of personal property" in International Class 39;<sup>8</sup>

**UPS 2ND DAY AIR**

for "motor vehicle and air transportation of personal property" in International Class 39;<sup>9</sup>

**UPS TRACKPAD**

for "computer programs and hand-held computers used for collection of package transit and delivery information" in Int. Cl. 9;<sup>10</sup>

**UPS ONLINE**

for "software for use in preparing and printing shipping documents and invoices and tracking the shipped packages" in International Class 9;<sup>11</sup>

**UPS.COM**

for "computer software for use in connection with worldwide pick up, tracing, and delivery of personal

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<sup>7</sup> Registration No. 1876943 issued on January 31, 1995; renewed.

<sup>8</sup> Registration No. 1878016 issued on February 7, 1995; renewed. No claim is made to the exclusive right to use the words "Next Day Air," apart from the mark as shown.

<sup>9</sup> Registration No. 1878918 issued on February 14, 1995; renewed. No claim is made to the exclusive right to use the words "2nd Day Air," apart from the mark as shown.

<sup>10</sup> Registration No. 2098168 issued on September 16, 1997; renewed.

<sup>11</sup> Registration No. 2128739 issued on January 13, 1998; renewed. No claim is made to the exclusive right to use the term "Online" apart from the mark as shown.

property by air, rail, boat, and motor vehicles" in Int. Cl. 9;<sup>12</sup>

## UPS INTERNET TOOLS

for "software for use in preparing and printing shipping forms, documents and invoices, and tracking of the shipped packages" in International Class 9;  
for "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" in Int. Cl. 39;<sup>13</sup>



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 information" in Int. Cl. 9;  
for "printed materials pertaining to information transportation and delivery, namely, press releases, pamphlets, brochures, newsletters, books, posters, periodicals, calendars, magazines, printed

<sup>12</sup> Registration No. 2483193 issued on August 28, 2001; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged.

<sup>13</sup> Registration No. 2830249 issued on April 6, 2004. No claim is made to the exclusive right to use the words "Internet Tools" apart from the mark as shown.

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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" in International Class 16;  
for "clothing, namely, hats, shorts, sweaters, jackets, socks, coats, t-shirts, pants, shirts, vests, sweatshirts, rainwear, footwear and gloves" in International Class 25;  
for "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

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<sup>14</sup> Registration No. 2973108 issued on July 19, 2005.

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network; licensing of computer software; transportation network management solution services; arranging expedited pick-up, storage, transportation and delivery services; customs clearance services" in International Class 35;  
for "communications services and telecommunications services, namely, electronic transmission of messages, data and voice data; facsimile and electronic message services, message delivery and sending services, telephone services and wire services; services of transportation of letters, documents and other texts by telex, by telephone, by electronic means; online document delivery via a global computer network" in International Class 38;  
for "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" in International Class 42;<sup>14</sup>

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**UPS WORLDSHIP**

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" in Int. Cl. 9;  
for "computerized tracking and tracing of packages in transit, namely, providing computerized information on domestic and international transportation and delivery services" in International Class 35; and  
for "transportation and delivery of personal property by air, rail, boat and motor vehicle" in Int. Cl. 39;<sup>15</sup>

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<sup>15</sup> Registration No. 3160062 issued on October 17, 2006.

as to be likely to cause confusion, to cause mistake or to deceive, under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).<sup>16</sup>

Respondent, in its answer, denied all the salient allegations of the notice of opposition.

## ***I. THE RECORD***

In addition to the pleadings and the file of the involved application, the record also includes the testimony deposition of Christopher T. Schenken filed March 1, 2010, and accompanying exhibits 1 - 61 thereto; Opposer's Notice of Reliance filed June 23, 2009, and accompanying exhibits 1-2 thereto, containing (a) Applicant's Answers to Opposer's First Set of Interrogatories to Applicant, dated April 13, 2009, and (b) Applicant's Response to Opposer's First Request For Admissions, dated April 26, 2009; Opposer's Supplemental Notice of Reliance filed October 9, 2009, and accompanying exhibits 3-5 thereto, containing status and title copies of opposer's claimed trademark registrations, a patent

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<sup>16</sup> Opposer's original Notice of Opposition included allegations of a false suggestion of connection under Section 2(a) of the Lanham Act, and that applicant's mark will blur the distinctiveness of opposer's famous UPS marks under the dilution provisions of Section 43(c) of the Act. Inasmuch as these issues were not tried, nor were they included in opposer's final briefs, we will consider these grounds as having been withdrawn.

publication and a 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." Applicant's Notice of Reliance filed August 21, 2009 includes copies of dictionary entries and Internet websites; and applicant's Supplemental Notice of Reliance filed on December 4, 2009 includes copies of trademark registrations.

## **II. FACTUAL FINDINGS**

Applicant is a Taiwanese corporation that manufactures and sells power supplies and related devices such as surge protectors.<sup>17</sup> Opposer is a well-known package delivery company that owns all the U.S. trademark registrations listed above.

## **III. ANALYSIS**

### **A. Opposer's Standing**

Because opposer's registrations are of record, opposer has established its standing. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); and *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

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<sup>17</sup> Opp. Exhibit # 5; [www.power-tech.com.tw/about%20powertech-e1.html](http://www.power-tech.com.tw/about%20powertech-e1.html)

A party has standing to oppose the registration of a mark if it has a direct and personal stake in the outcome of the proceeding (*i.e.*, in this case, preventing the registration of applicant's mark). This prevents litigation where there is no real controversy between the parties.

*Id.*; see also *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999). "The requirement of standing 'focuses on the party seeking to get his complaint before a federal court and not in the issues he wishes to have adjudicated'." *Morrow v. Microsoft Corp.*, 499 F.3d 1332, 84 USPQ2d 1377, 1382 (Fed. Cir. 2007), quoting *Valley Forge Christian College v. Americans United for Separation of Church and State*, 454 U.S. 464, 484 (1982). Thus, "[o]nce standing is established, the opposer is entitled to rely on any of the grounds ... which negate applicant's right to its subject registration." *Jewelers Vigilance v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021, 2023 (Fed. Cir. 1987); see also *Young v. AGB Corp.*, 152 F.3d 1377, 47 USPQ2d 1752, 1755 (Fed. Cir. 1998); *Lipton Industries, Inc. v. Ralston Purina Co.*, 213 USPQ at 190.

Accordingly, there is no question but that opposer has established a real interest in preventing the registration of applicant's mark and, therefore, pursuant to the controlling case law, opposer may object to the registration

of applicant's mark as being merely descriptive. See *Coach Services, Inc. v. Triumph Learning LLC*, \_\_\_ USPQ2d \_\_\_ (TTAB Opposition No. 91170112, September 17, 2010).

**B. Is Applicant's mark merely descriptive?**

A mark is merely descriptive, and therefore unregistrable pursuant to the provisions of Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), if it immediately conveys "knowledge of a quality, feature, function, or characteristic of the goods or services." *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007) [ASPIRINA is merely descriptive of analgesic product]. See also *In re MBNA America Bank N.A.*, 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003) [MONTANA SERIES and PHILADELPHIA CARD are merely descriptive of applicant's "affinity" credit card services; a "mark is merely descriptive if the ultimate consumers immediately associate it with a quality or characteristic of the product or service"]; *In re Nett Designs, Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) [THE ULTIMATE BIKE RACK is merely descriptive of bicycle racks]; *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987) [APPLE PIE is merely descriptive of a potpourri mixture]; and *In re Quik-Print Copy Shops, Inc.*, 616 F.2d 523, 205 USPQ 505, 507

(CCPA 1980). To be "merely descriptive," a term need only describe a single significant quality or property of the goods [or services]. *Gyulay*, 3 USPQ2d at 1009. Descriptiveness of a mark is not considered in the abstract, but in relation to the particular goods or services for which registration is sought. That is, when we analyze the evidence of record, we must keep in mind that the test is not whether prospective purchasers can guess what applicant's goods [or services] are after seeing only applicant's mark. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978) [GASBADGE merely descriptive of a "gas monitoring badge"; "Appellant's abstract test is deficient - not only in denying consideration of evidence of the advertising materials directed to its goods, but in failing to require consideration of its mark 'when applied to the goods' as required by statute."]. Rather, 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 1314, 1316-1317 (TTAB 2002); and *In re Patent & Trademark Services Inc.*, 49 USPQ2d 1537, 1539 (TTAB 1998).

In addition to considering the applied-for mark in relation to the goods or services for which registration is

sought, the proper test for descriptiveness also considers the context in which the mark is used and the significance that the mark is likely to have on the average purchaser encountering the goods or services in the marketplace. *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Pennzoil Products Co.*, 20 USPQ2d 1753 (TTAB 1991); and *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986).

A mark is suggestive, and therefore registrable on the Principal Register without a showing of acquired distinctiveness, if imagination, thought or perception is required to reach a conclusion on the nature of the goods or services. "Whether a given mark is suggestive or merely descriptive depends on whether the mark 'immediately conveys ... knowledge of the ingredients, qualities, or characteristics of the goods ... with which it is used,' or whether 'imagination, thought, or perception is required to reach a conclusion on the nature of the goods.'" (citation omitted) *In re Gyulay*, 3 USPQ2d at 1009; *In re Home Builders Association of Greenville*, 18 USPQ2d 1313 (TTAB 1990); and *In re American Greetings Corp.*, 226 USPQ 365 (TTAB 1985).

Hence, the first question before us is whether the term **HYBRID GREEN UPS** conveys information about a significant characteristic, purpose, function or use of applicant's

goods with the immediacy and particularity required by the Trademark Act.

Applicant has disclaimed the letters "UPS" inasmuch as this is a well known abbreviation for "uninterruptible power supply" [or "system"] and hence would be a generic designation for the identified goods. In fact, the parties agree that the term "UPS" cannot provide any source identifying function for applicant's involved goods. However, the parties do disagree over whether the applied-for term as a whole, **HYBRID GREEN UPS**, is merely descriptive of applicant's intended products.

Opposer begins by pointing out that a composite term consisting of nothing more than a combination of descriptive terms is itself merely descriptive if it fails to evoke any new or unique commercial impression.

We note from a copy of applicant's relevant patent, made part of the record by opposer, that applicant uses the entire terminology "hybrid green uninterruptible power system" about a hundred times within the patent document. The following from the excerpts of two paragraphs from applicant's lengthy patent document is representative of such uses:

[¶0024] Moreover, the **hybrid green uninterruptible power system**<sup>20</sup> has a secondary battery mounted inside and charged by DC power converted from AC utility power. Simultaneously, a plurality of additional DC power are [sic] provided to the DC power output ports<sup>208</sup> 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**<sup>20</sup> inverts power from the secondary battery into AC power so that the **hybrid green uninterruptible power system**<sup>20</sup> can provide the AC power to the external load via the AC power output ports<sup>204</sup> and simultaneously provide one or more sets of additional DC power and the DC power output ports<sup>208</sup> ...

[¶0046] 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 ... [emphasis supplied]

Furthermore, while we cannot be sure of the quality of the translation to the English language from the original Chinese language of the Taiwanese applicant, the following screenprint from applicant's website was placed into the record by opposer:


PowerTech Industrial Co., Ltd.
Awards
Home
Site Map
中文

About Powertech
Events
Products & Services
Human Resources

- Surge Protector for IT Products
- Surge Protector for AV Products
- Green Power & Energy Saving Surge
  - Hybrid Green Power
  - Green Power
  - Master / Slave
- Smart Home Wireless Solutions
- Other Surge Protector Products
- DAB Modules

## Hybrid Green Power





**Hybrid**  
Coolest Power System Provide AC & Multi-Range DC Output simultaneously

**Green**  
Energy Saving & Material Resources Economically

**Power**  
Ensure Optimal Customization to Various Power Applications and Battery Back Up Protect.

		Conventional UPS			Hybrid Green Power		
		UPS	Notebook Adaptor	USB Charger	UPS	Notebook Adaptor	USB Charger
<b>Power Efficiency</b>	AC Mode Stand-by Mode	>95%	88%	<b>75%</b>	>95%	88%	<b>85%</b>
	Back Up Mode	70%	<b>62%</b> ★	<b>52%</b> ★	70%	<b>85%</b> ★	<b>85%</b> ★

★ Power efficiency of DC output for battery-powered

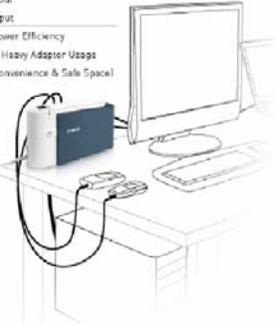
**Conventional UPS**

- ✔ Battery Backup
- ✔ Surge Protection
- ✔ AC Output
- ✘ Low Power Efficiency
- ✘ Heavy Adaptor Inconvenience



**Hybrid Green Power**

- ✔ Battery Backup
- ✔ Surge Protection
- ✔ AC Output
- ✔ DC Output
- ✔ High Power Efficiency
- ✔ Free of Heavy Adaptor Usage (Very Convenience & Safe Space)



18

18

<http://www.power-tech.com.tw/product-e2-11.html>

- 16 -

The callout boxes at the top of this web page read as follows:

**“Hybrid:** Coexist Power System Provide AC & Multi-Range DC Output simultaneously [Diversified AC & DC output]” and

**“Green:** Energy Saving & Material Resources Economically”

Furthermore, the chart in the mid-section of this page shows precise percentages of the added energy efficiencies of applicant’s product over the conventional power supplies (or systems) in both the AC and back-up DC modes.

Finally, opposer argues that during the discovery phase of this trial, applicant admitted that its goods are intended to be energy efficient, that the goods are intended to use less energy than other comparable goods, and that the goods at issue are beneficial (and are intended to appear to be beneficial) to the environment.

In response, applicant’s arguments are summarized below:

- Applicant’s goods are uninterruptible power supplies, battery chargers and other electronic components, which type of products are not generally/immediately associated with having inherent ecological characteristics.
- When applied to applicant’s goods, the word “Hybrid” would require imagination, thought and perception for a purchaser to reach a conclusion as to the nature of the goods.
- Third-party marks contain both words individually, and sometimes without disclaimer(s).
- Applicant already owns Registration No. 3550928 for **HYBRID GREEN SYSTEM** and Registration No. 3550927 for the mark **HYBRID GREEN POWER** (for substantially the same goods as the subject trademark application), and that

both registrations issued by the U.S. Patent and Trademark Office without any disclaimer(s).

As used within the applied-for mark, the words "hybrid" and "green" would both be viewed as adjectives, modifying the designation "UPS" (functioning as a noun). Applicant's adoption and usage of the words "hybrid" and "green" within "Hybrid Green UPS" is totally consistent with the commonly understood meanings of these respective words. The word "hybrid" is often used to describe a system consisting of two components performing similar functions.<sup>19</sup> The word "green" is often used to describe something that is environmentally-friendly.<sup>20</sup> Contrary to applicant's arguments, we find there is no new or incongruous meaning that grows out of its combining the words "hybrid" and "green" with the designation "UPS." Rather, within the composite term, we find that the combined meaning flows logically from the individual meanings, and that meaning is merely descriptive of applicant's electrical components. In

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<sup>19</sup> **hy·brid** 3 b : something (as a power plant, vehicle, or electronic circuit) that has two different types of components performing essentially the same function  
– hybrid adjective . <http://www.merriam-webster.com/dictionary/hybrid>  
The Board may take judicial notice of dictionary definitions. *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

<sup>20</sup> **Green** 10 b : concerned with or supporting environmentalism; 10 c : tending to preserve environmental quality (as by being recyclable, biodegradable, or nonpolluting).  
<http://www.merriam-webster.com/dictionary/green>

short, it appears from applicant's own literature that its involved devices function in both the AC and back-up DC modes - the "hybrid" characteristic - and that the energy efficiencies of these products will tend to preserve environmental quality - or be "green."

As noted above, the test is not whether prospective purchasers can guess what applicant's goods are after seeing only applicant's mark. Such an abstract test has repeatedly been found to be deficient. We must presume that prospective customers will know of the power system's ability to provide both AC and DC outputs, and that this family of products is touted for its energy savings.

The fact that applicant may be the first and possibly the only user of a descriptive designation cannot alone alter the basic descriptive significance of the term and bestow trademark rights therein, and clearly does not justify registration if the only significance conveyed by the term is merely descriptive. See *In re National Shooting Sports Foundation, Inc.*, 219 USPQ 1018 (TTAB 1983) [SHOOTING, HUNTING, OUTDOOR TRADE SHOW AND CONFERENCE is descriptive of conducting and arranging trade shows in hunting, shooting, and outdoor sports products field]; *In re Gould*, 173 USPQ 243, 245 (TTAB 1972). See also *Styleclick.com*, 57 USPQ2d 1445, 1448 (TTAB 2000) ["That applicant may be the first or

only entity using E FASHION is not dispositive"]. Thus, opposer's failure to uncover examples of that specific term being used by applicant's competitors does not detract from the fact that these three words, when combined, would be perceived as merely descriptive when used in connection with applicant's electric power devices in International Class 9.

Applicant also argues that third-party registrations of other marks containing the words "hybrid" or "green" support the proposition that the mark in its application is not merely descriptive of the named goods. However, it is well settled that each case must be decided on its own merits, based upon the record in each particular application. A mark that is merely descriptive is not somehow registrable simply because other allegedly similar marks are registered. *In re Scholastic Testing Services, Inc.*, 196 USPQ 517, 519 (TTAB 1977).

Certainly, none of these third-party marks involved applicant's particular combination of terms as applied to these named goods, and thus the facts in those records (to which we are not privy) would obviously be different. Moreover, even if the situations of these third-party registrations appeared to be close to the facts of the current case, the Board is not bound by actions taken in the past by Trademark

Examining Attorneys. *In re National Novice Hockey League, Inc.* 222 USPQ 638, 641 (TTAB 1984). Whether one focuses on third-party registrations or on applicant's two earlier-issued registrations, while uniform treatment under the Trademark Act is highly desirable, our task here is to determine, based upon the record before us, whether applicant's asserted mark is registrable.

Accordingly, we find this application is barred by the provisions of Section 2(e)(1) of the Lanham Act.

**C. Alternatively, has opposer proven a likelihood of confusion?**

With our decision herein finding that applicant's proposed mark is merely descriptive, the opposition is sustained, and registration to applicant is refused. However, in the interest of completeness, we will also pursue, in the alternative - should applicant's mark be determined to be distinctive - whether opposer has demonstrated a likelihood of confusion herein.

**1. Priority**

Because opposer's pleaded registrations are of record, Section 2(d) priority is not an issue in this case as to the mark and the services and products covered by the

registrations. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

## **2. Likelihood of Confusion**

We turn, then, to the issue of likelihood of confusion under Section 2(d) of the Trademark Act. Our determination must be based upon our analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *See In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003).

### **a. The fame of opposer's marks**

This *du Pont* factor requires us to consider the fame of opposer's mark. Fame, if it exists, plays a dominant role in the likelihood of confusion analysis because famous marks enjoy a broad scope of protection. A famous mark has extensive public recognition and renown. *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000); and *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

Fame may be measured indirectly by the volume of sales and advertising expenditures of the goods and services identified by the marks at issue, "by the length of time those indicia of commercial awareness have been evident," widespread critical assessments and through notice by independent sources of the products identified by the marks, as well as the general reputation of the products and services. *Bose Corp. v. QSC Audio Products Inc.*, 63 USPQ2d at 1305-1306, 1309. Although raw numbers of product sales and advertising expenses may suffice in some cases, more compelling is the trademark owner's sales and/or advertising figures as compared to those of its competitors.

Moreover, because of the extreme deference that we accord a famous mark in terms of the wide latitude of legal protection it receives, it is the duty of the party asserting that its mark is famous to clearly prove it. *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007). Opposer introduced evidence of the following in order to establish the fame of its mark:

1. Opposer began using the UPS mark at least as early as 1933;<sup>21</sup>
2. Opposer employs more than 400,000 persons;<sup>22</sup>

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<sup>21</sup> Christopher T. Schenken testimony deposition at 37-38.

<sup>22</sup> *Id.*, Exhibit # 24 at 1.

3. Opposer's current fleet has a hundred thousand ground vehicles and 550 brown tail jets, the latter of which fly a thousand flight segments each day in the U.S.;<sup>23</sup>
4. In 2008, UPS delivered almost four billion packages and documents - most displaying the UPS mark;<sup>24</sup>
5. Almost eight million customers per day, having access to 4500 UPS retail outlets, 1000 UPS Customer Centers, more than 15,000 other smaller authorized UPS outlets and 40,000 UPS drop boxes, provided for opposer more than forty billion dollars of revenue in 2008 alone.<sup>25</sup>
6. Deliveries are made to customers by the more than 60,000 UPS drivers, each of whom wears a brown UPS uniform and drives a brown UPS package car, both of which display the UPS mark;<sup>26</sup>
7. On an average day, opposer receives more than twenty million tracking requests;<sup>27</sup>
8. Opposer's goods and services are advertised on television, radio and the Internet, in print and in outdoor media, all of which prominently promotes the UPS mark. Its sponsorships including NASCAR racing events, the 2008 Olympic Games in Beijing, China. Consistent with the substantial sums opposer has spent promoting the UPS mark over the past seventy-five years, over the past five years opposer has committed more than \$350 million to its marketing expenditures.<sup>28</sup>
9. As a measurement of brand awareness among members of the general public, recent studies show 94% awareness

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

<sup>24</sup> *Id.* at 61, Exhibit # 24.

<sup>25</sup> *Id.*

<sup>26</sup> *Id.* at 16, 39-40, Exhibit # 32 at 1.

<sup>27</sup> *Id.* at 58-59.

<sup>28</sup> *Id.* at 72-74, 78, Exhibit # 27.

of UPS as to ground transportation and 88% awareness of UPS as to overnight shipping;<sup>29</sup>

10. BrandFinance Global 500 recently ranked UPS as the 32<sup>nd</sup> most valuable trademark in the world, having a brand value of twelve to fourteen billion dollars.

Based upon the entire record, we find that opposer's UPS marks are famous for purposes of likelihood of confusion.

However, this factor alone is not sufficient to establish likelihood of confusion. If that were the case, having a famous mark would entitle the owner to a right *in gross*, and that is against the principles of trademark law. See *University of Notre Dame du Lac v. J. C. Gourmet Imports Co., Inc.*, 703 F.2d 1372, 217 USPQ 505, 507 (Fed. Cir. 1983). See also *Recot Inc. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) ("... fame alone cannot overwhelm the other *du Pont* factors as a matter of law."). In this case, we find that the differences in the goods and services, as well as the different commercial impressions engendered by the marks, are significant countervailing factors dispelling any likelihood of confusion. See *Blue Man Productions Inc. v. Tarmann*, 75 USPQ2d 1811, 1819-1820 (TTAB 2005), *rev'd on other grounds*, Civil Action No. 05-2037 (D.D.C. April 3, 2008).

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<sup>29</sup> Id., Exhibit # 56 at 7.

b. The relationship of the goods and services, the channels of trade and classes of consumers.

There are clear and significant differences between applicant's electric power devices in International Class 9, and the various services and collateral goods identified in opposer's registrations including, *inter alia*, transportation and delivery services and related software. While opposer uses its mark on software related to its delivery services, the record does not support the conclusion that opposer uses its UPS designation to identify goods in trade in International Class 9, and notwithstanding an acknowledgment that each day opposer's drivers use more than a hundred thousand hand-held electronic devices known as the "Delivery Information Acquisition Device" [DIAD].<sup>30</sup> Similarly, extensive usage of the Internet, its UPS Supply Chain Services, that its packages include goods of the type to be marketed by applicant, and the fact that opposer's fleet of ground vehicles includes more than 1,700 "hybrid" engine vehicles do not somehow extend opposer's proprietary interest in its UPS mark any closer to applicant's use of its mark with electric power devices. On the other hand, if applicant were marketing, for example, software capable of coordinating the transportation and delivery of packages and

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<sup>30</sup> *Id.* at 16, Exhibit # 23 at 1.

documents, the situation would be different. However, we are constrained to determine the issue of likelihood of confusion based upon the goods identified in the description of goods. *Cunningham v. Laser Golf Corp.*, 55 USPQ2d at 1846; *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987); and *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983).

Even though we must presume that applicant's electric power devices will be sold to members of the general public, who also utilize opposer's transportation and delivery services, we find that applicant's products would not be sold under circumstances likely to give rise to the mistaken belief that electric power devices and transportation and delivery services and related hardware/software tools will emanate from the same source.

In view of the foregoing, in spite of the fact that the class of consumers most certainly overlaps, we find that the goods and services are not related, and that the channels of trade are quite distinct.

c. The similarity / dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.

We now turn to the *du Pont* factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial

impression. *In re E.I. du Pont de Nemours & Co.*, 177 USPQ at 567. Each of these characteristics of a mark (appearance, sound, meaning and commercial impression) must be considered in determining confusing similarity. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

As to appearance and sound, neither the word "Hybrid" nor the word "Green" appear anywhere in any of opposer's registered marks. While opposer's ground fleet includes "hybrid" vehicles, nowhere does opposer claim common law usage of a composite of "Hybrid UPS" or "Green UPS" for any goods or services. The only similarity in sound and appearance between the parties' respective marks involves the identical usage of three letters, U•P•S.

However, even this common component creates entirely different connotations and commercial impressions when considered in light of the nature of the respective goods and services. *Viacom International Inc. v. Komm*, 46 USPQ2d 1233, 1238 (TTAB 1998) (the word "Mouse" has different meanings when applied to a computer peripheral as opposed to a cartoon superhero); and *Bost Bakery, Inc. v. Roland Industries, Inc.*, 216 USPQ 799, 801-802 (TTAB 1991) [HERITAGE HEARTH is not confusingly similar to OLD HEARTH inasmuch as the common word "Hearth" is highly suggestive as applied to

bread, but the word "Heritage" is largely arbitrary as applied to such goods].

Opposer's UPS marks, when applied to transportation and delivery services and related hardware/software tools, consist of an arbitrary initialism (albeit drawn from opposer's corporate name). On the other hand, applicant's UPS initialism, when applied to its uninterruptible power supplies, is an abbreviated term accepted in the field as a generic, shorthanded reference to applicant's electric power devices. In view of the completely different meanings and commercial impressions engendered by the marks, we find that applicant's UPS mark is not confusingly similar to opposer's UPS marks.

d. Balancing the factors.

Notwithstanding the facts that opposer's mark is famous and that the classes of consumers overlap, because the goods and services of the parties are not similar or related in any way, because the goods move in different channels of trade, and because the marks, as used by the parties, have different meanings and engender different commercial impressions, we find that applicant's use of its **HYBRID GREEN UPS** mark for electric power devices is not likely to cause confusion with opposer's various **UPS** marks for

transportation and delivery services and related hardware/software tools.

Accordingly, opposer has failed to demonstrate that there would be a likelihood of confusion herein.

*Decision:* In light of our finding that applicant's mark is merely descriptive under Section 2(e)(1) of the Lanham Act, the opposition is sustained and registration to applicant is hereby denied.