

ESTTA Tracking number: **ESTTA89181**

Filing date: **07/11/2006**

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

**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

**Opposer Information**

Name	United Parcel Service of America, Inc.
Granted to Date of previous extension	07/12/2006
Address	55 Glenlake Parkway, NE Atlanta, GA 30328 UNITED STATES
Attorney information	Keith E. Sharkin King & Spalding LLP 1185 Avenue of the Americas New York, NY 10036 UNITED STATES nytrademarks@kslaw.com, ksharkin@kslaw.com, dgross@kslaw.com Phone:212-556-2369

**Applicant Information**

Application No	78579398	Publication date	03/14/2006
Opposition Filing Date	07/11/2006	Opposition Period Ends	07/12/2006
Applicant	Cleo Communications, Inc. 4203 Galleria Drive Loves Park, IL 61111 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 035. First Use: 2004/05/04 First Use In Commerce: 2004/05/04 All goods and services in the class are opposed, namely: Providing information and data management in the field of electronic commerce to connect the user to the supply chain of goods and services for customers by means of a global computer network
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Attachments	PDF_Scan.pdf ( 7 pages )(205007 bytes )
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Signature	/Keith E. Sharkin/
Name	Keith E. Sharkin
Date	07/11/2006

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

In the Matter of Application  
Serial No. 78/579,398 Published  
in the Official Gazette of  
March 14, 2006 at Page TM 724

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UNITED PARCEL SERVICE OF AMERICA, INC., :

Opposer, : Opposition No.

v. :

CLEO COMMUNICATIONS, INC., :

Applicant. :

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NOTICE OF OPPOSITION

TO THE COMMISSIONER OF TRADEMARKS:

UNITED PARCEL SERVICE OF AMERICA, INC., a Delaware corporation located and doing business at 55 Glenlake Parkway, N.E., Atlanta, Georgia 30328, believes that it will be damaged by the registration of application Serial No. 78/579,398 for the designation SYNCHRONIZED COMMERCE SERVICE as a service mark for "providing information and data management in the field of electronic commerce to connect the user to the supply chain of goods and services for customers by means of a global computer

network" filed on March 3, 2005 by Cleo Communications, Inc. and having previously been granted an extension of time to oppose, hereby opposes the same.

The grounds for opposition are as follows:

1. Opposer has been, and is now engaged in the business of providing air, sea and ground transportation and delivery services for packages, documents, freight and other personal property throughout the United States and the world. Opposer, in connection with its transportation and delivery services, provides supply chain solutions and logistical services via the Internet.

2. Since at least as early as April 2003, and prior to May 4, 2004, the date of first use claimed by applicant, opposer adopted and used and has continued to use the mark SYNCHRONIZING THE WORLD OF COMMERCE in interstate commerce in connection with its transportation and delivery and supply chain and logistical services. Since that date, opposer has continuously used said mark to identify and distinguish opposer's services from those of others.

3. Opposer is the owner of a federal registration on the Principal Register in the United States Patent and Trademark Office for the service mark SYNCHRONIZING THE WORLD OF COMMERCE, Registration No. 2,957,551, dated May 31, 2005, for "freight

forwarding; packaging articles for transportation; transportation of letters, documents, communications, printed matter, and other goods and property by air, boat, rail, and motor vehicle; warehousing, storage, packing for shipment, delivery by air, boat, rail, and motor vehicle, and pick-up for returns with respect to the foregoing". Said registration is valid and subsisting, unrevoked and uncanceled, and in full force and effect.

4. Opposer uses the mark SYNCHRONIZING THE WORLD OF COMMERCE in connection with its transportation and delivery and supply chain and logistical services. The mark is applied to the opposer's aircrafts, vehicles, signage, facilities, and drop-off and retail access points. Opposer also displays the mark prominently on all of its envelopes and packaging. Last year alone, approximately 3.75 billion packages were delivered to customers in more than 200 countries in envelopes or boxes that displayed opposer's SYNCHRONIZING THE WORLD OF COMMERCE mark. Opposer also uses the mark "Synchronized Commerce" in connection with its transportation and delivery services.

5. The mark SYNCHRONIZING THE WORLD OF COMMERCE is prominently displayed on opposer's website located at WWW.UPS.COM. This website is one of the most visited websites in the world, with approximately 145 million hits per business-day and over 10 million daily on-line tracking requests.

6. The mark SYNCHRONIZING THE WORLD OF COMMERCE is now, and ever since its date of first use in April 2003 has been, applied to product literature for opposer's transportation and delivery and supply chain and logistical services. Opposer has also used the mark in connection with package tracking, international trade management, customs brokerage, supply chain consulting, logistics, and other services that it offers via the Internet.

7. The services offered for sale and sold under the mark SYNCHRONIZING THE WORLD OF COMMERCE have been extensively advertised and promoted. As a result of the quality of opposer's services, the advertising for these services and opposer's reputation for fair dealing with the trade and the public, the mark SYNCHRONIZING THE WORLD OF COMMERCE has become famous with goodwill of inestimable value to opposer; and the famous mark SYNCHRONIZING THE WORLD OF COMMERCE identifies and distinguishes opposer's services from those of others to the trade and to the public.

8. By the application herein opposed, applicant seeks to register the designation SYNCHRONIZED COMMERCE SERVICE as a service mark for "providing information and data management in the field of electronic commerce to connect the user to the supply chain of goods and services for customers by means of a global

computer network".

9. Applicant's information data management services to connect the user to the supply chain of goods and services for customers which are to be offered under its alleged mark SYNCHRONIZED COMMERCE SERVICE are closely related to the services in connection with which opposer has used and continues to use the mark SYNCHRONIZING THE WORLD OF COMMERCE.

10. The services set forth in the application to be offered for sale under the alleged mark SYNCHRONIZED COMMERCE SERVICE which applicant seeks to register will be encountered by the same or similar class of purchasers as those who are interested in or familiar with the services offered by opposer under the mark SYNCHRONIZING THE WORLD OF COMMERCE.

11. Applicant's designation SYNCHRONIZED COMMERCE SERVICE is so similar to opposer's previously used and registered mark SYNCHRONIZING THE WORLD OF COMMERCE as to be likely, when applied to applicant's services, to cause confusion, to cause mistake and to deceive with consequent injury to opposer and the public.

12. Opposer will be damaged by the registration sought by applicant because such registration would support and assist applicant in the confusing and misleading use of applicant's mark and would give color of exclusive statutory rights to applicant in

violation and derogation of the prior and superior rights of opposer to the mark SYNCHRONIZING THE WORLD OF COMMERCE.

13. As alleged above, opposer has used the mark SYNCHRONIZING THE WORLD OF COMMERCE in commerce since at least as early as April 2003 in connection with a wide variety of services. The mark SYNCHRONIZING THE WORLD OF COMMERCE has since acquired, through opposer's extensive use and advertising, goodwill of inestimable value and identifies and distinguishes opposer's services from those of others. As such, the mark SYNCHRONIZING THE WORLD OF COMMERCE is a famous trademark with strong and distinctive character and qualifies for protection under Section 13 (15 U.S.C. §1063 as amended) and Section 43(c) (15 U.S.C. §1125(c)) of the Lanham Act.

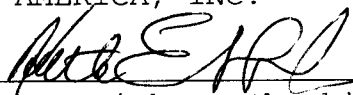
14. Applicant's application Serial No. 78/579,398 was filed on March 3, 2005, and therefore, is subject to the provisions of Section 13 as amended and Section 43(c) of the Lanham Act.

15. Applicant's use and registration of the mark SYNCHRONIZED COMMERCE SERVICE as shown in Application Serial No. 78/579,398 will lessen the capacity of opposer's extensively used and advertised SYNCHRONIZING THE WORLD OF COMMERCE mark to distinguish the opposer's services from those of others all to the damage of opposer.

WHEREFORE, opposer requests that the opposition to the application for registration of SYNCHRONIZED COMMERCE SERVICE be sustained and that the registration sought by applicant be refused.

Dated: July 11, 2006

KING & SPALDING LLP  
Attorneys for Opposer  
UNITED PARCEL SERVICE OF  
AMERICA, INC.

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