

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Mark: UPTEC  
Serial No.: 88/299,672  
Docket: TGMB 8876

**RESPONSE TO OFFICE ACTION DATED APRIL 1, 2019**

This is in response to the office action dated April 2, 2019, wherein the Examining Attorney requested that Applicant amend the Classification of the goods and submit an additional filing fee. The Examiner also indicated that Application No.: 88/299,672, for the mark UPTEC (the “Applicant’s Mark”) was refused due to a likelihood of confusion with Registration Nos.: 5,625,720 for the mark UPTECH, 5,419,105 for the mark UPINTEK, and 4,824,422 for the mark UPSAVER (the “’720 Registration,” the “’105 Registration” and the “’422 Registration” respectively), (collectively the “Identified Marks”).

**I. AMENDMENT TO THE CLASSIFICATION OF GOODS AND MULTI-CLASS APPLICATION**

In response to the Examiner’s request that Applicant amend its classification of goods, Applicant would like to delete “design and development of software and hardware for producing, recording and processing digital and analogue signals” from its application. This deletion should further avoid the ‘720 Registration and the ‘105 Registration.

**II. CONFUSION BETWEEN APPLICANT’S MARK AND THE IDENTIFIED MARKS IS HIGHLY UNLIKELY**

Applicant respectfully disagrees with the Office's assessment that there may be a likelihood of confusion between Applicant's Mark and the Identified Marks. The relevant factors in determining whether a likelihood of confusion exists were set forth in *In re Application of E.I. DuPont de Nemours & Co.*, 177 U.S.P.Q. 563 (C.C.P.A. 1973). Not all of the DuPont factors are, however, relevant to every case, and even one factor may be dispositive on the question of likelihood of confusion. See *Id.* at 567; see also *In re Coors Brewing Co.*, 68 U.S.P.Q. 2d 1059 (Fed. Cir. 2003). Here, the most relevant of the DuPont factors are:

1. The number and nature of similar marks already on the register; and
2. The dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression.

Both of these factors weigh overwhelmingly against a likelihood of confusion finding.

Marks that share words may coexist when they are not likely to confuse consumers. Even where marks might otherwise be considered similar based on a dominant shared common term, the marks are not likely to confuse consumers where “the marks in their entireties convey significantly different commercial impressions.” MPEP §1207.01(b)(iii) (citing *Citigroup Inc. v. Capital City Bank Group, Inc.*, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011) and *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 73 USPQ2d 1350 (Fed. Cir. 2004)). Further, evidence of third-party use bears on the strength or weakness of a mark, and the weaker an existing mark, the closer an applicant’s mark can come without causing a likelihood of confusion. See *Juice Generation Inc. v. GS Enters. LLC*, 794 F.3d 13334 (Fed. Cir. 2015). In such a case, “the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is . . . diluted.” MPEP §1207(b)(iii)(citing *Citigroup Inc.* and *Shen Mfg. Co.*).

Here, there is no dominant shared common term, and the marks are so dissimilar, in terms of both composition and commercial impression, that confusion between the parties' marks is highly unlikely. Further, several third-party marks use the terms TECH, TEK and UP for related goods, and therefore the terms are weak and diluted. Namely, each term is weak, and this particularly applies to the terms TECH and TEK in IC 009, whereas UP is simply inherently weak and as a term bears no relation to the goods/services at issue.

Further, it cannot be overlooked that the Office asserted registrations by three (3) different registration owners, all of which can presumably co-exist on the Register and at the same time are believed to be likely to be confused with an additional mark sharing similar mark terms and goods/services.

**A. The Number and Nature of Similar Marks Used on Similar Goods Demonstrates that Confusion is Unlikely Because the Terms UP, TECH and TEK are Weak Source Identifiers When Taken Alone**

Confusion is unlikely when the only common elements of two marks is weak due to common use by others. The strength or weakness of existing trademarks is “connected to ‘the number and nature of similar marks in use on similar goods,’” See *Juice Generation Inc.* There are numerous examples of this reasoning in which marks were considered registrable despite containing common terms. See, e.g., *Shen Mfg. Co.* (Finding that RITZ and THE RITZ KIDS create a different commercial impression); *Keebler Co. v. Murray Bakery Prods., Inc.*, USPQ2d 1736 (Fed. Cir. 1989) (PECAN SHORTEES vs. PECAN SANDIES); *Kellogg Co. v. Pack 'Em Enterprises, Inc.*, 21 USPQ2d 1142 (Fed. Cir. 1991) (FROOTEE ICE vs. FROOT LOOPS); *Nutri/Sys., Inc. v. Con-Stan Indus., Inc.*, 1 USPQ2d 1809 (9th Cir. 1987) (NUTRI/SYSTEM vs. NUTRI-TRIM); *Sears Mortgage Corp. v. Northeast Savings F.A.*, 24 USPQ2d 1227 (TTAB 1992) (APPROVAL PLUS vs. APPROVAL FIRST); *Burns Philp Food, Inc. v. Modern Prods., Inc.*, 24 USPQ2d 1157 (TTAB 1992) (SPICE ISLAND vs. SPICE GARDEN and design); *Stouffer Corp. v. Health Valley Natural Foods Inc.*, 1 USPQ2d 1900 (TTAB 1986) (LEAN CUISINE vs. LEAN LIVING).

Use of a common term by multiple third parties can signify the reduced distinctiveness of similar marks and make confusion unlikely. Consumers recognize this, and distinguish between weak marks on similar goods “on the basis of minute distinctions.” *Standard Brands, Inc. v. RJR Foods, Inc.*, 192 USPQ 383, 385-386 (TTAB 1976). Accordingly, “evidence of third-party use of similar marks on similar goods is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.” *Palm Bay Imports v. Veuve Clicquot Ponsardin*, 396 F. 3d 1369 (Fed. Cir. 2005).

A review of the Trademark Register indicates that the terms UP, TECH and TEK occur in a multitude of third-party registrations and applications that have proceeded past examination, which are discussed in more detail below. These third-party registrations relate to IC 009 and 042 in which Applicant’s goods reside.

A search of the register identified other live marks that include the terms TECH and TEK. See the chart below. Most of the marks show below use standard character claims and comprise the terms, combined with one or more secondary terms. Indeed, in those cases, the mark, when taken as a whole, were still considered distinguishable from other marks on the register. Some examples of these marks are as follows:

<b>Seral No.</b>	<b>Reg. No.</b>	<b>MARK</b>
<b>88036220</b>	<b>5869530</b>	<b>DR TECH</b>
<b>88229821</b>	<b>5849313</b>	<b>IVO TECH</b>
<b>88059789</b>	<b>5846838</b>	<b>BAY TEK ENTERTAINMENT</b>
<b>88210126</b>	<b>5838249</b>	<b>VITALTECH</b>
<b>88185617</b>	<b>5775269</b>	<b>TOUGHTTECH</b>
<b>88098766</b>	<b>5773526</b>	<b>TEKREPLAY</b>
<b>88009374</b>	<b>5765479</b>	<b>INNOTECH</b>
<b>88073769</b>	<b>5749253</b>	<b>TECHSMITH MOTION</b>
<b>88040186</b>	<b>5738240</b>	<b>IAVATECH</b>
<b>88157849</b>	<b>5703420</b>	<b>TECHAMOR</b>
<b>88036207</b>	<b>5701862</b>	<b>OHTECH</b>
<b>88047618</b>	<b>5691078</b>	<b>MOBESTECH</b>
<b>88020657</b>	<b>5679969</b>	<b>TECHNOPROPS</b>
<b>88017431</b>	<b>5679750</b>	<b>ALTECH</b>
<b>88975383</b>	<b>5874492</b>	<b>TECHREV</b>
<b>87698852</b>	<b>5508057</b>	<b>DEPSTECH</b>
<b>87695740</b>	<b>5859782</b>	<b>WINGTECH</b>
<b>88060093</b>	<b>5871185</b>	<b>TECHLINK SOLUTIONS</b>
<b>88314520</b>	<b>5861482</b>	<b>TEKMONSTER</b>
<b>88262429</b>	<b>5855756</b>	<b>:ITECHART</b>
<b>88315973</b>	<b>5845290</b>	<b>ZAYTECH</b>
<b>88315944</b>	<b>5802777</b>	<b>EDTECH</b>
<b>88189931</b>	<b>5798609</b>	<b>TOURTECH</b>
<b>88009426</b>	<b>5755077</b>	<b>ANTECH SYSTEMS</b>
<b>87311070</b>	<b>5845936</b>	<b>EDUTECH LAB</b>
<b>87675394</b>	<b>5835423</b>	<b>PERATECH</b>

<b>87765206</b>	<b>5816705</b>	<b>TECH KINGDOM</b>
<b>87816173</b>	<b>5694895</b>	<b>SBTECH</b>

In addition, a search of the register identified other live marks that include the term UP. See the chart below. Most of the marks show below use standard character claims and comprise the term UP combined with one or more secondary terms. Indeed, in those cases, the mark, when taken as a whole, were still considered distinguishable from other marks on the register. Some examples of these marks are as follows:

<b>Serial No.</b>	<b>Reg No.</b>	<b>MARK</b>
<b>88317960</b>	<b>5856814</b>	<b>UP GLIDE</b>
<b>88033129</b>	<b>5708541</b>	<b>UPSIGN</b>
<b>87884589</b>	<b>5803218</b>	<b>ZUP</b>
<b>87586254</b>	<b>5754312</b>	<b>AG UP</b>
<b>87829375</b>	<b>5742795</b>	<b>UP &amp; COMING</b>
<b>87007197</b>	<b>5189344</b>	<b>TEXTUP</b>
<b>88283827</b>	<b>5834144</b>	<b>UPZ</b>
<b>88274980</b>	<b>5827492</b>	<b>LEVEL UP</b>
<b>88241132</b>	<b>5806016</b>	<b>UPMELY</b>
<b>88104641</b>	<b>5749708</b>	<b>UP FITNESS</b>
<b>88036238</b>	<b>5690171</b>	<b>UPLEYING</b>
<b>87815526</b>	<b>5865246</b>	<b>UPTAB</b>
<b>87815526</b>	<b>5865246</b>	<b>UPTAB</b>
<b>87786125</b>	<b>5776656</b>	<b>UPTYMA</b>
<b>87655177</b>	<b>5770535</b>	<b>UPUN</b>
<b>87429772</b>	<b>5760227</b>	<b>GO-UP</b>
<b>87729237</b>	<b>5710952</b>	<b>SUP</b>
<b>87193275</b>	<b>5514449</b>	<b>UPTAKE</b>
<b>87488097</b>	<b>5379031</b>	<b>UPEOR</b>
<b>87478884</b>	<b>5390251</b>	<b>UPREV</b>

Accordingly, based on the number of existing registrations formed from the terms TECH, TEK and UP, it is clear that the terms are relatively weak and diluted source identifiers, and are entitled to only a narrow scope of protection.

**B. The Differences in the Commercial Impressions of the Marks Make Confusion Highly Unlikely**

Among the DuPont factors referenced by the Office are the similarity of the marks. This factor should be evaluated with respect to the “similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.” *Dupont*, 177 U.S.P.Q. 563 (C.C.P.A. 1973). Further, an evaluation with respect to likelihood of confusion “cannot be predicated on dissection of a mark.” *In re National Data Corp.*, 224 U.S.P.Q. 749, 751 (Fed. Cir. 1985); TMEP §1207.01(b). Although one feature of a mark may be more significant in creating a commercial impression, “the ultimate conclusion rests on consideration of the marks in their entireties.” *Id.*

In this case, the commercial impression of Applicant’s Mark is predicated on evaluation of the mark as a whole, while the commercial impression of each earlier mark in the Identified Registrations is similarly predicated on each respective mark as a whole.

The Applicant’s Mark UPTEC is significantly different from the term marks cited by the Office. Indeed, the Applicant’s mark has a unique commercial impression. This is particularly relevant with respect to the ‘422 Registration that only includes the term UP. Moreover, none of the marks identified by the Office include the suffix TEC.

As shown in the above table, when taken as a whole, each mark is clearly distinguishable on its face. Further, none of these marks were rejected because of the close relationship of the goods. Indeed, each mark listed above was reviewed concurrently with the others and none of the marks listed above were rejected on the basis of similarity with earlier registered TECH, TEK or UP formatives. As discussed above, the extensive variety of existing registrations for TECH, TEK, and UP formatives indicates the weakness of the terms TECH, TEK, and UP, taken alone, and allows the marks to be distinguishable when taken as a whole.

In the current case, rather than comparing the marks as a whole, the Office merely compares matter arguably shared by some of the marks i.e. the terms TECH, TEK, and UP individually. In doing so, the Office notes that “the Applicant’s mark and Registrants’ marks are identical in part and create the same overall commercial impression.” The Examiner solely relied on the fact that the terms TECH, TEK, and UP were identical. The Examiner’s approach strips away the commercial impression of the mark – under the standard applied by the Office, any pair of marks sharing a single word could be considered confusingly similar, and any of marks identified in the previous section of this response would be considered confusingly similar to each and every one of the Identified Registrations. The Office never demonstrates that the mere existence of overlapping words in both marks *create[s] a similar overall commercial impression* as required, nor does the Office even attempt to compare the “marks in their entireties.” See TMEP §1207.01(b).

It is for this very reason – the potential to strip away the commercial impression of the mark, that the marks UPTECH, UPINTEK and UPSAVER, and Applicant’s mark UPTEC are inherently different. Visually UPTEC is distinguishable from the Identified marks. Applicant’s Mark uses the TEC suffix which is not used in any of the Identified Marks. Applicant’s Mark, UPINTEK and UPSAVER are phonetically distinct. The consumer, who is used to reviewing many TECH, TEC, TEK and UP marks in commerce, would recognize these distinctions.

Further, that the terms TECH, TEK, and UP are inherently weak as is demonstrated by the mere fact that there exists a multitude of marks, held by different owners, that would be identical if not for the “something more” provided by the visual and phonetic differences. Accordingly, just as a wide variety of compound marks incorporating the terms were previously considered registrable, Applicant’s unique mark, UPTEC, should be similarly registrable when taken as a whole.

### **CONCLUSION**

A substantial likelihood that the public will be confused must be shown in order for an application to be rejected on the grounds of likelihood of confusion. In view of the significant differences between the parties' marks, when viewed in light of the inherent weakness of the

terms TECH, TEK, and UP, confusion is not likely. Accordingly, Applicant requests that the rejection based on likelihood of confusion be withdrawn.