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

Proceeding	91185164
Party	Defendant Repsol-Gas Natural LNG, S.L.
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Date	02/14/2011
Attachments	REPSOL Answer.pdf (5 pages)(14901 bytes)

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

STREAM GAS AND ELECTRIC, LTD.)	
)	
)	
Opposer,)	Opposition No. 91185164
)	
v.)	Mark: STREAM REPSOL GAS NATURAL LNG
)	and Design
REPSOL-GAS NATURAL LNG, S.L.)	
)	Application Serial No.: 79/036,767
Applicant.)	
)	
)	

ANSWER TO NOTICE OF OPPOSITION

Repsol-Gas Natural LNG, S.L. (hereinafter, “Repsol Gas” or “Applicant”), by its undersigned attorneys, Cozen O’Connor, hereby responds to the Notice of Opposition (hereinafter, the “Notice”) filed by Stream Gas and Electric, Ltd. (hereinafter, “Stream Gas” or “Opposer”) against Repsol Gas’ U.S. Application Serial No. 79/036,767 for the mark STREAM REPSOL GAS NATURAL LNG and Design as follows:

In response to the first unnumbered paragraph of the Notice, Repsol Gas denies that Opposer is or will be damaged by the registration of U.S. Application Serial No. 79/036,767. Repsol Gas admits that U.S. Application Serial No. 79/036,767 identifies “Fuels, namely, natural gas and liquefied gas” in International Class 4 and “Distribution, transport and storage of energy, fuel compounds, gas and liquefied gas” in International Class 39. Repsol Gas is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations contained in the first unnumbered paragraph of the Notice and therefore denies the same.

1. Upon information and belief, Repsol Gas denies that Stream Gas owns the mark STREAM ENERGY and U.S. Registration No. 3,442,457 for the mark STREAM ENERGY.

Repsol Gas is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations contained in Paragraph 1 of the Notice and therefore denies the same.

2. Repsol Gas denies that Stream Gas has built invaluable goodwill in connection with its services offered under the STREAM ENERGY mark. Repsol Gas is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations contained in Paragraph 2 of the Notice and therefore denies the same.

3. Repsol Gas admits that it filed an application for registration of U.S. Application Serial No. 79/036,767 for the goods and services listed above on February 16, 2007, with a priority date of October 25, 2006. Repsol Gas denies the remaining allegations contained in Paragraph 3 of the Notice.

4. Repsol Gas denies the allegations contained in Paragraph 4 of the Notice.

5. Repsol Gas denies the allegations contained in Paragraph 5 of the Notice.

6. Repsol Gas denies the allegations contained in Paragraph 6 of the Notice.

7. Repsol Gas denies the allegations contained in Paragraph 7 of the Notice.

AFFIRMATIVE DEFENSES

First Affirmative Defense (Unclean Hands)

In the application which matured into U.S. Registration No. 3,442,457, Stream Gas claimed January 1, 2005 as the date of first use in general and of first use in commerce. The application also identified “Electricity and natural gas services, namely, the transmission and distribution of electricity and gas” in International Class 39. On July 9, 2008 (the same day on which the instant Notice was filed), Stream Gas filed with the Post Registration Unit of the U.S. Patent and Trademark Office a Request for Rule 7(h) Correction of Registration (hereinafter, the “Request”). In its Request, Stream Gas stated that the dates of first use and use in commerce

should be changed to “at least as early as March 2005,” and that the identification of services should be corrected to read: “Electricity services, namely, the transmission and distribution of electricity.” The Declaration of Pierre Koshakji accompanying the Request stated that the corrections were sought as a result of Mr. Koshakji’s “errors made in good faith when the Statement of Use was submitted.”

In a Post Registration Office Action dated August 8, 2008, the U.S. Patent and Trademark Office denied Stream Gas’ Request, stating that because U.S. Registration No. 3,442,457 is the subject of an inter partes proceeding before this Board, it can only be amended with Repsol Gas’ consent, or upon motion granted by the Board. To date, Stream Gas has neither sought nor obtained Repsol Gas’ consent to amend U.S. Registration No. 3,442,457, nor has it moved the Board for an order granting such an amendment. As a result, U.S. Registration No. 3,442,457 continues to reflect incorrect dates of first use and use in commerce, and an identification of services which does not accurately reflect the services with which Opposer was using the STREAM ENERGY mark at the time it filed the Statement of Use.

Given that Stream Gas has failed to correct material, false statements made to the U.S. Patent and Trademark Office, Stream Gas has come to this Board with unclean hands, and its Notice of Opposition should be dismissed with prejudice.

**Second Affirmative Defense
(Lack of Standing)**

Upon information and belief, on December 31, 2009, Opposer assigned U.S. Registration No. 3,442,457 to SGE IP Holdco, LLC. On January 7, 2010, Opposer recorded the assignment of U.S. Registration No. 3,442,457 with the U.S. Patent and Trademark Office, identifying Opposer as the Assignor and SGE IP Holdco, LLC as the Assignee. As Opposer is no longer the

owner of U.S. Registration No. 3,442,457, Opposer has no standing to pursue the claims asserted in the instant Notice. The Notice of Opposition should therefore be dismissed with prejudice.

WHEREFORE, Applicant Repsol-Gas Natural LNG, S.L. hereby respectfully requests that the Notice of Opposition be dismissed with prejudice.

Respectfully submitted,

COZEN O'CONNOR

Dated: February 14, 2011

By:

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing ANSWER TO NOTICE OF OPPOSITION was served upon counsel for Opposer by First Class Mail, postage prepaid, on this 14th day of February 2011 as follows:

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/David B. Sunshine/