

ESTTA Tracking number: **ESTTA357476**

Filing date: **07/12/2010**

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	Marshfield Utilities
Granted to Date of previous extension	07/11/2010
Address	2000 South Roddis Avenue Marshfield, WI 54449 UNITED STATES

Attorney information	Joseph W. Byrne Boardman, Suhr, Curry & Field LLP One South Pinckney Street, Fourth Floor Madison, WI 53703 UNITED STATES jbyrne@boardmanlawfirm.com Phone:(608) 257-9521
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Applicant Information

Application No	77546833	Publication date	01/12/2010
Opposition Filing Date	07/12/2010	Opposition Period Ends	07/11/2010
Applicant	Energy Curtailment Specialists, Inc. 4455 Genesee Street, Bldg. 6 Buffalo, NY 14225 UNITED STATES		

Goods/Services Affected by Opposition

Class 009. All goods and services in the class are opposed, namely: Electrical energy utilization metering devices complete with related software
Class 035. All goods and services in the class are opposed, namely: Consultation in the field of energy efficiency; Energy auditing; Energy management services, namely, providing a service that allows customers to purchase energy, namely, electricity, natural gas and renewable energy, at a fixed price; Energy price comparison services; Energy usage management; Energy usage management information services; Information in the field of energy efficiency; Promoting the benefits of energy efficient lighting technologies to professionals in the lighting field; Utility bill management services, namely, tracking, reporting, analyzing and delivering energy information in the form of utility bills and utility meter data rate schedules
Class 036. All goods and services in the class are opposed, namely: Brokerage of energy, namely, gas and electricity; Consultancy concerning financing of energy projects; Energy brokerage services

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	2463086	Application Date	10/20/1997
Registration Date	06/26/2001	Foreign Priority Date	NONE
Word Mark	POWERPAY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 1997/03/14 First Use In Commerce: 1997/03/14 AUTOMATIC UTILITY BILL PAYMENT SERVICES		

Attachments	Notice of Opposition w- Exhibit A - As Filed 7-12-2010 (A1034601).PDF (18 pages)(601102 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Joseph W. Byrne/
Name	Joseph W. Byrne
Date	07/12/2010

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

In the Matter of Application Serial No.: 77/546,833
Filed on: August 14, 2008
For the Mark: POWERPAY! NEW ENGLAND
Published in the Official Gazette on: January 12, 2010

MARSHFIELD UTILITIES)
)
)
 Opposer,)
)
 v.) **Opposition No. _____**
)
 ENERGY CURTAILMENT SPECIALISTS, INC.)
)
 Applicant.)

United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

NOTICE OF OPPOSITION

Marshfield Utilities, a Municipal Public Utility organized under the laws of the State of Wisconsin, with a place of business located at 2000 South Roddis Avenue, Marshfield, WI 54449 (hereinafter “Opposer”) believes that it will be damaged by registration of the designation POWERPAY! NEW ENGLAND for:

- (1) “electrical energy utilization metering devices complete with related software” in International Class 9;
- (2) “consultation in the field of energy efficiency; energy auditing; energy management services, namely, providing a service that allows customers to purchase energy, namely, electricity, natural gas and renewable energy, at a fixed price; energy price comparison services; energy usage management; energy usage management information services; information in the field of energy efficiency; promoting the benefits of energy efficient lighting technologies to professionals in the lighting field; utility bill management services, namely, tracking, reporting, analyzing and delivering energy information in the form of utility bills and utility meter data rate schedules” in International Class 35; and
- (3) “brokerage of energy, namely, gas and electricity; consultancy concerning financing of energy projects; energy brokerage services” in International Class 36

as shown in Application Serial No. 77/546,833 which was filed on August 14, 2008 by Energy Curtailment Specialists, Inc., a New York corporation with a place of business located at 4455 Genesee Street, Bldg. 6, Buffalo, NY 14225 (hereinafter “Applicant”) and hereby opposes same.

As grounds of opposition, it is alleged that:

1. Opposer is now and for many years past has been engaged in providing electric and water utility services to, *inter alia*, individuals and residential customers, schools, governmental agencies and entities, businesses, and commercial and industrial customers.

2. Opposer is now and for many years past has also been providing a bill payment service to its customers by which said customers can manage, track and pay their utility bills.

3. Since long prior to August 14, 2008, the filing date of the application herein opposed, Opposer adopted and used, and is using, the mark POWERPAY in commerce in connection with the foregoing utility and bill payment services.

4. Opposer has prior use in interstate commerce of the POWERPAY mark for the foregoing services and since the adoption and first use of the POWERPAY mark as aforesaid, Opposer has continuously used the POWERPAY mark in connection with advertising, promoting and providing its services in commerce in the United States.

5. Opposer's POWERPAY mark is now and ever since its first use as aforesaid has been applied to brochures, advertisements and promotional literature for the aforesaid services and has appeared on Opposer's website.

6. Opposer's services are now and for many years past have been widely promoted and provided under the POWERPAY mark in commerce in the United States.

7. The POWERPAY mark has come to be favorably known, and of great value to Opposer, and in the mind of the trade and public, identifies Opposer's services and distinguishes Opposer's services from the goods and services of others.

8. Opposer is the owner, in the United States Patent and Trademark Office, of U.S. Registration No. 2,463,086 for the mark POWERPAY for "automatic utility bill payment

services” in International Class 36 which issued on June 26, 2001 based on U.S. Application Serial No. 75/375,989 which was filed on October 20, 1997.

9. Said registration is valid and subsisting, unrevoked and uncanceled, and in full force and effect.

10. Opposer owns said registration and the service mark shown thereby and all the business and goodwill symbolized thereby and associated therewith in the United States.

11. Pursuant to Trademark Rule 2.122(d), current printouts from the electronic database records (e.g., TARR, TESS, and Assignment databases) of the United States Patent and Trademark Office for U.S. Registration No. 2,463,086 are attached hereto as Exhibit A and show the current status and title of the aforesaid registration.

12. By the application herein opposed, Applicant seeks to register the designation POWERPAY! NEW ENGLAND for

- (a) “electrical energy utilization metering devices complete with related software” in International Class 9;
- (b) “consultation in the field of energy efficiency; energy auditing; energy management services, namely, providing a service that allows customers to purchase energy, namely, electricity, natural gas and renewable energy, at a fixed price; energy price comparison services; energy usage management; energy usage management information services; information in the field of energy efficiency; promoting the benefits of energy efficient lighting technologies to professionals in the lighting field; utility bill

management services, namely, tracking, reporting, analyzing and delivering energy information in the form of utility bills and utility meter data rate schedules” in International Class 35; and

- (c) “brokerage of energy, namely, gas and electricity; consultancy concerning financing of energy projects; energy brokerage services” in International Class 36.

13. The opposed application is currently an intent-to-use based application filed on August 14, 2008 which date occurred well after Opposer first commenced use of its POWERPAY mark.

14. The August 14, 2008 filing date of the opposed application also occurred well after the June 26, 2001 issue date of U.S. Registration No. 2,463,086.

15. The August 14, 2008 filing date of the opposed application also occurred well after the October 20, 1997 filing date of U.S. Application Serial No. 75/375,989.

16. On information and belief, Applicant has made no actual use of the designation POWERPAY! NEW ENGLAND in interstate commerce or otherwise prior to August 14, 2008 in connection with any of the International Class 9 goods recited in the application herein opposed.

17. On information and belief, Applicant has made no actual use of the designation POWERPAY! NEW ENGLAND in interstate commerce or otherwise prior to August 14, 2008 in connection with any of the International Class 35 services recited in the application herein opposed.

18. On information and belief, Applicant has made no actual use of the designation POWERPAY! NEW ENGLAND in interstate commerce or otherwise prior to August 14, 2008 in connection with any of the International Class 36 services recited in the application herein opposed.

19. On information and belief, Applicant has made no actual use of the designation POWERPAY! NEW ENGLAND in interstate commerce or otherwise prior to August 14, 2008 in connection with any goods or services.

20. On information and belief, Applicant has made no actual use of the designation POWERPAY! NEW ENGLAND in interstate commerce or otherwise prior to March 1, 2008 in connection with any of the International Class 9 goods recited in the application herein opposed.

21. On information and belief, Applicant has made no actual use of the designation POWERPAY! NEW ENGLAND in interstate commerce or otherwise prior to March 1, 2008 in connection with any of the International Class 35 services recited in the application herein opposed.

22. On information and belief, Applicant has made no actual use of the designation POWERPAY! NEW ENGLAND in interstate commerce or otherwise prior to March 1, 2008 in connection with any of the International Class 36 services recited in the application herein opposed.

23. On information and belief, Applicant has made no actual use of the designation POWERPAY! NEW ENGLAND in interstate commerce or otherwise prior to March 1, 2008 in connection with any goods or services.

24. On information and belief, Applicant has made no actual use of the designation POWERPAY! NEW ENGLAND in interstate commerce or otherwise prior to June 26, 2001 in connection with any of the International Class 9 goods recited in the application herein opposed.

25. On information and belief, Applicant has made no actual use of the designation POWERPAY! NEW ENGLAND in interstate commerce or otherwise prior to June 26, 2001 in connection with any of the International Class 35 services recited in the application herein opposed.

26. On information and belief, Applicant has made no actual use of the designation POWERPAY! NEW ENGLAND in interstate commerce or otherwise prior to June 26, 2001 in connection with any of the International Class 36 services recited in the application herein opposed.

27. On information and belief, Applicant has made no actual use of the designation POWERPAY! NEW ENGLAND in interstate commerce or otherwise prior to June 26, 2001 in connection with any goods or services.

28. On information and belief, Applicant has made no actual use of the designation POWERPAY! NEW ENGLAND in interstate commerce or otherwise prior to

October 20, 1997 in connection with any of the International Class 9 goods recited in the application herein opposed.

29. On information and belief, Applicant has made no actual use of the designation POWERPAY! NEW ENGLAND in interstate commerce or otherwise prior to October 20, 1997 in connection with any of the International Class 35 services recited in the application herein opposed.

30. On information and belief, Applicant has made no actual use of the designation POWERPAY! NEW ENGLAND in interstate commerce or otherwise prior to October 20, 1997 in connection with any of the International Class 36 services recited in the application herein opposed.

31. On information and belief, Applicant has made no actual use of the designation POWERPAY! NEW ENGLAND in interstate commerce or otherwise prior to October 20, 1997 in connection with any goods or services.

32. Applicant's designation POWERPAY! NEW ENGLAND in Application Serial No. 77/546,833 is identical or substantially similar in sight, sound, connotation and commercial impression to Opposer's POWERPAY mark.

33. The International Class 9, 35 and 36 goods and services for which Applicant seeks registration in Application Serial No. 77/546,833 are identical to, or similar and closely related to, the services in connection with which Opposer uses and has registered its POWERPAY mark.

34. On information and belief, the channels of trade for the International Class 9, 35 and 36 goods and services for which Applicant seeks registration in Application Serial No. 77/546,833 are identical or similar to the channels of trade for the services in connection with which Opposer uses and has registered its POWERPAY mark.

35. On information and belief, the conditions under which, and buyers to whom sales are made of, the International Class 9, 35 and 36 goods and services for which Applicant seeks registration in Application Serial No. 77/546,833 are identical or similar to the conditions under which, and buyers to whom sales are made of, the services in connection with which Opposer uses and has registered its POWERPAY mark.

36. In view of, *inter alia*, the similarity in sight, sound, connotation and commercial impression between Applicant's proposed designation and Opposer's POWERPAY mark, the similarity and relatedness between the respective goods and services of Applicant and Opposer, the similarity of the channels of trade for the respective goods and services of Applicant and Opposer, and the similarity in the conditions under which, and buyers to whom sales are made, for the respective goods and services of Applicant and Opposer, Applicant's proposed POWERPAY! NEW ENGLAND designation in Application Serial No. 77/546,833 so resembles Opposer's previously used and registered POWERPAY mark as to be likely, when used in connection with Applicant's proposed International Class 9, 35 and 36 goods and services, to cause confusion, to cause mistake and to deceive with consequent injury to Opposer and the public.

37. In addition, Applicant's designation POWERPAY! NEW ENGLAND in Application Serial No. 77/546,833 so resembles Opposer's previously used and registered POWERPAY mark as to be likely, when used in connection with the International Class 9, 35 and 36 goods and services recited in Application Serial No. 77/546,833, to lead to the belief that Applicant's goods and services are sponsored by, affiliated with, approved by, or otherwise emanate from Opposer, with consequent injury to Opposer and the public. Any faults or defects which might be found with Applicant's goods and services would reflect adversely upon and seriously injure the valuable reputation and goodwill of Opposer.

38. Additionally, Applicant's POWERPAY! NEW ENGLAND designation as depicted in Application Serial No. 77/546,833 so resembles Opposer's previously used and registered POWERPAY mark so as to falsely suggest a connection between Applicant and Opposer.

39. Opposer will also 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 designation and would give to Applicant color of exclusive statutory rights to such designation in violation and derogation of the prior and superior rights of Opposer.

WHEREFORE, Opposer believes that it would be damaged by registration of Applicant's designation, and therefore requests that registration of Applicant's designation be denied in its entirety and that this opposition be sustained with respect to the International Class 9, 35 and 36 goods and services recited in the application herein opposed.

Authorization to charge the filing fee for this Notice as required by 37 C.F.R. § 2.6(a)(17) to a credit card is being provided simultaneously with the filing of this Notice of Opposition. In the event that such authorization is defective or deficient in any manner, the Commissioner is hereby authorized to charge any required fees, or any deficiency in any required fees, to deposit account no. 02-2850.

Please recognize as attorneys for Opposer, Joseph W. Byrne, Esq., a member in good standing of the Bar of the State of Wisconsin, and the firm of Boardman, Suhr, Curry & Field LLP, One South Pinckney Street, Fourth Floor, P.O. Box 927, Madison, WI 53701-0927. Please address all communications to Joseph W. Byrne, Esq. of said firm at said address.

Dated this 12th day of July, 2010.

Respectfully submitted,
MARSHFIELD UTILITIES

/Joseph W. Byrne/

Joseph W. Byrne
Attorney for Marshfield Utilities

Boardman, Suhr, Curry & Field LLP
One South Pinckney Street, Fourth Floor
P.O. Box 927
Madison, WI 53701-0927
Telephone: (608) 257-9521
Facsimile: (608) 283-1709

CERTIFICATE OF SERVICE

I hereby certify and declare under penalty of perjury that I served a true and correct copy of this document upon Attorney Darren Rimer, attorney for Energy Curtailment Specialists, Inc., by depositing such copy with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to Attorney Darren Rimer, Rimer & Mathewson LLP, 27281 Las Ramblas, Suite 200, Mission Viejo, CA 92691 on the 12th day of July, 2010.

Executed on July 12, 2010

/Joseph W. Byrne/
Joseph W. Byrne
Attorney for Marshfield Utilities

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EXHIBIT A

to

Notice of Opposition

Involving

Application Serial No. 77/546,833

Opposition No. _____

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This page was generated by the TARR system on 2010-07-12 12:14:05 ET

Serial Number: 75375989 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: 2463086

Mark (words only): POWERPAY

Standard Character claim: No

Current Status: Section 8 and 15 affidavits have been accepted and acknowledged.

Date of Status: 2006-10-14

Filing Date: 1997-10-20

Transformed into a National Application: No

Registration Date: 2001-06-26

Register: Principal

Law Office Assigned: LAW OFFICE 109

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 830 -Post Registration

Date In Location: 2006-10-14

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. [MARSHFIELD UTILITIES](#)

Address:

[MARSHFIELD UTILITIES](#)
[2000 SOUTH RODDIS AVENUE](#)
[MARSHFIELD, WI 54449](#)
[United States](#)

Legal Entity Type: [MUNICIPAL PUBLIC UTILITY](#)

State or Country Where Organized: [Wisconsin](#)

GOODS AND/OR SERVICES

International Class: 036
Class Status: Active
AUTOMATIC UTILITY BILL PAYMENT SERVICES
Basis: 1(a)
First Use Date: 1997-03-14
First Use in Commerce Date: 1997-03-14

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2006-10-14 - Section 8 (6-year) accepted & Section 15 acknowledged

2006-10-12 - Case File In TICRS

2006-09-27 - Assigned To Paralegal

2006-08-01 - Section 8 (6-year) and Section 15 Filed

2006-08-01 - PAPER RECEIVED

2001-06-26 - Registered - Principal Register

2001-01-05 - Extension Of Time To Oppose Received

2000-12-26 - Published for opposition

2000-11-24 - Notice of publication

2000-10-23 - Approved for Pub - Principal Register (Initial exam)

1998-07-06 - Letter of suspension mailed

1998-06-25 - Assigned To Examiner

1998-06-16 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record
JOSEPH W BYRNE

Correspondent
BOARDMAN, SUHR, CURRY & FIELD LLP
ATTN: IP DEPARTMENT, JOSEPH W. BYRNE
1 SOUTH PINCKNEY STREET, FOURTH FLOOR
P.O. BOX 927
MADISON, WI 53701-0927

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Typed Drawing

Word Mark	POWERPAY
Goods and Services	IC 036. US 100 101 102. G & S: AUTOMATIC UTILITY BILL PAYMENT SERVICES. FIRST USE: 19970314. FIRST USE IN COMMERCE: 19970314
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	75375989
Filing Date	October 20, 1997
Current Filing Basis	1A
Original Filing Basis	1A
Published for Opposition	December 26, 2000
Registration Number	2463086
Registration Date	June 26, 2001
Owner	(REGISTRANT) Marshfield Electric and Water Department MUNICIPAL PUBLIC UTILITY WISCONSIN 2000 South Roddis Ave. Marshfield WISCONSIN 54449 (LAST LISTED OWNER) MARSHFIELD UTILITIES MUNICIPAL PUBLIC UTILITY WISCONSIN 2000 SOUTH RODDIS AVENUE MARSHFIELD WISCONSIN 54449
Assignment Recorded	ASSIGNMENT RECORDED
Attorney of Record	JOSEPH W BYRNE
Type of Mark	SERVICE MARK
Register	PRINCIPAL
Affidavit Text	SECT 15. SECT 8 (6-YR).
Live/Dead Indicator	LIVE

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Trademark Assignment Abstract of Title

Total Assignments: 1

Serial #: [75375989](#)

Filing Dt: 10/20/1997

Reg #: [2463086](#)

Reg. Dt: 06/26/2001

Registrant: Marshfield Electric and Water Department

Mark: POWERPAY

Assignment: 1

Reel/Frame: [3126/0298](#)

Received: 07/22/2005

Recorded: 07/22/2005

Pages: 4

Conveyance: CHANGE OF NAME

Assignor: [MARSHFIELD ELECTRIC AND WATER DEPARTMENT](#)

Exec Dt: 02/14/2005

Entity Type: MUNICIPAL PUBLIC UTILITY

Citizenship: WISCONSIN

Assignee: [MARSHFIELD UTILITIES](#)

2000 SOUTH RODDIS AVENUE
MARSHFIELD, WISCONSIN 54449

Entity Type: MUNICIPAL PUBLIC UTILITY

Citizenship: WISCONSIN

Correspondent: JOSEPH W. BYRNE

1 SOUTH PINCKNEY STREET,
FOURTH FLOOR
MADISON, WI 53703

Search Results as of: 07/12/2010 12:14 PM

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Web interface last modified: October 18, 2008 v.2.0.2

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