

ESTTA Tracking number: **ESTTA428832**

Filing date: **09/06/2011**

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	SunPower Corporation
Granted to Date of previous extension	09/07/2011
Address	77 Rio Robles San Jose, CA 95134 UNITED STATES

Attorney information	Patrick J. Gallagher Fulbright & Jaworski L.L.P. 98 San Jacinto Boulevard, Suite 1100 c/o Trademark Docketing Department Austin, TX 78701 UNITED STATES pgallagher@fulbright.com, ksolberg@fulbright.com, aotrademark@fulbright.com, trademark_docket@sunpowercorp.com Phone:612.321.2800
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**Applicant Information**

Application No	85084322	Publication date	05/10/2011
Opposition Filing Date	09/06/2011	Opposition Period Ends	09/07/2011
Applicant	SunPods, Inc. Suite 214 1922 The Alameda San Jose, CA 95126 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 009. First Use: 2008/12/08 First Use In Commerce: 2008/12/08 All goods and services in the class are opposed, namely: Photovoltaic solar modules for production of electricity; Solar panels for production of electricity
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**Grounds for Opposition**

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

U.S. Registration No.	2690090	Application Date	07/11/2001
Registration Date	02/25/2003	Foreign Priority Date	NONE
Word Mark	SUNPOWER		

Design Mark	<b>SUNPOWER</b>
Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 1989/00/00 First Use In Commerce: 1991/00/00 Photovoltaic cells; modules, namely, photovoltaic modules and solar cell modules; panels, namely, photovoltaic panels and solar cell panels

U.S. Registration No.	3582037	Application Date	03/31/2008
Registration Date	03/03/2009	Foreign Priority Date	NONE

Word Mark	SUNPOWER
Design Mark	<b>SUNPOWER</b>
Description of Mark	NONE
Goods/Services	<p>Class 006. First use: First Use: 2007/12/01 First Use In Commerce: 2007/12/01 Mounting systems for solar collectors comprised of structural supports, made of metal, for stabilization on the ground, solar collector supports made of metal, and clamps made of metal; solar panel mounts made of metal</p> <p>Class 011. First use: First Use: 2007/12/01 First Use In Commerce: 2007/12/01 Solar collectors, and mounting systems for solar collectors comprised of structural supports for stabilization on the ground, solar collector supports, and clamps, all sold as a unit with solar collectors</p> <p>Class 019. First use: First Use: 2008/02/01 First Use In Commerce: 2008/02/01 Roofing, not of metal, incorporating solar cells; mounting systems for solar collectors comprised of structural supports, not of metal, for stabilization on the ground, solar collector supports not of metal, and clamps, not of metal</p> <p>Class 037. First use: First Use: 2007/09/01 First Use In Commerce: 2007/09/01 Installation, repair, and maintenance of solar energy systems, solar collectors and solar heat collection panels; installation of facilities to produce solar energy; installation of ground-mounted and roof-mounted solar panel plants</p>

Attachments	<p>76283765#TMSN.gif ( 1 page )( bytes )  76688239#TMSN.gif ( 1 page )( bytes )  Notice of Opposition.pdf ( 8 pages )(510056 bytes )  Exhibit A.pdf ( 5 pages )(105355 bytes )</p>
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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	/patrick j. gallagher/
Name	Patrick J. Gallagher
Date	09/06/2011

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

In the matter of Application Serial No.: 85/084,322  
By SunPods, Inc. for the mark: SUN PODS SUN POWER ON DEMAND & Design  
Filed: July 14, 2010  
Published in the *Official Gazette* on: May 10, 2011

SunPower Corporation,	§	
	§	
Opposer,	§	
	§	
v.	§	Opposition No.: _____
	§	
SunPods, Inc.,	§	
	§	
Applicant.	§	
	§	

**NOTICE OF OPPOSITION**

Opposer, SunPower Corporation (hereinafter “SunPower”), a Delaware corporation with a principal place of business at 77 Rio Robles, San Jose, California 95134, believes that it will be damaged by registration of the above-identified alleged mark, SUN PODS SUN POWER ON DEMAND & Design as shown in U.S. Trademark Application Serial No. 85/084,322 (the “Application”) and hereby opposes the same under the provisions of 15 U.S.C. § 1063. As grounds for opposition, SunPower asserts the following:

1. SunPower designs, manufactures and delivers high-performance solar electric systems for residential, commercial and utility-scale power plant customers.
2. Founded in 1985, SunPower has been an innovative leader in the solar industry for 25 years. In 2009, SunPower’s revenues exceeded \$1.5 billion, and SunPower’s revenues exceeded \$2 billion in 2010. SunPower projects its revenues to be close to \$3 billion in 2011.

3. Since at least as early as 1989, SunPower has continuously used the name and mark SUNPOWER in connection with the sale and distribution of solar-related goods. Since that time, SunPower has continuously used the SUNPOWER mark on and in connection with a variety of solar-related goods, including: photovoltaic cells, photovoltaic panels, photovoltaic modules, inverters and converters for solar energy, measuring and control devices for converting electrical energy from solar, and photovoltaic power plant systems.

4. SunPower owns U.S. Trademark Registration No. 2,690,090 for the mark SUNPOWER registered in connection with “photovoltaic cells; modules, namely, photovoltaic modules and solar cell modules; panels, namely, photovoltaic panels and solar cell panels” in Class 9 (hereinafter the “SUNPOWER Mark”). The underlying application for this registration was filed on July 11, 2001. U.S. Registration No. 2,690,090 issued on February 25, 2003, and the registration is incontestable pursuant to Section 15 of the Trademark Act, 15 U.S.C. § 1065.

5. SunPower also owns U.S. Trademark Registration No. 3,582,037 for the SUNPOWER Mark registered in connection with “Mounting systems for solar collectors comprised of structural supports, made of metal, for stabilization on the ground, solar collector supports made of metal, and clamps made of metal; solar panel mounts made of metal,” in Class 6; “Solar collectors, and mounting systems for solar collectors comprised of structural supports for stabilization on the ground, solar collector supports, and clamps, all sold as a unit with solar collectors,” in Class 11; “Roofing, not of metal, incorporating solar cells; mounting systems for solar collectors comprised of structural supports, not of metal, for stabilization on the ground, solar collector supports not of metal, and clamps, not of metal,” in Class 19; and “Installation, repair, and maintenance of solar energy systems, solar collectors and solar heat collection panels; installation of facilities to produce solar energy; installation of ground-mounted and roof-

mounted solar panel plants,” in Class 37. The underlying application for this registration was filed on March 31, 2008. U.S. Registration No. 3,582,037 issued on March 3, 2009. This registration is valid, subsisting and in full force and effect.

6. SunPower also uses the SUNPOWER Mark in its domain name <sunpowercorp.com> to identify itself on the Internet, having done so since at least 1999.

7. As a result of SunPower’s extensive and continuous use of the SUNPOWER Mark, the SUNPOWER Mark has come to represent a considerable amount of goodwill amongst the consuming public and is of great value to SunPower.

8. The SUNPOWER Mark is valid and subsisting and has been used continuously by SunPower since the date of first use set forth in U.S. Registration No. 2,690,090.

9. The SUNPOWER Mark is inherently distinctive and serves to identify and indicate the source of SunPower’s goods and services to the consuming public.

10. As a result of the long use and promotion of the SUNPOWER Mark by SunPower, the SUNPOWER Mark has become distinctive to designate SunPower, to distinguish SunPower and its products and services from those of other businesses, and to distinguish the source or origin of SunPower’s products and services. As a result of those efforts by SunPower, the relevant customers and consumers throughout the United States widely recognize and associate the SUNPOWER Mark with SunPower and its products and services.

11. As a result of SunPower’s long use and promotion of the SUNPOWER Mark, SunPower has acquired valuable common law rights in the SUNPOWER Mark throughout the United States.

12. SunPower's use of the SUNPOWER Mark is long prior to the filing date of this Application, the alleged date of first use of the alleged mark that is the subject of this Application, or any date upon which Applicant SunPods, Inc. can claim priority.

13. Applicant, SunPods, Inc. (hereinafter "Applicant"), filed U.S. Application Serial No. 85/084,322 for SUN PODS SUN POWER ON DEMAND & Design under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), in connection with "Photovoltaic solar modules for production of electricity; Solar panels for production of electricity" in Class 9.

14. Applicant's alleged mark "SUN PODS SUN POWER ON DEMAND & Design" was published for opposition in the *Official Gazette* on May 10, 2011.

15. SunPower timely filed for a 30-day Extension of Time to Oppose the Application on June 8, 2011, which was granted until July 9, 2011. Additionally, SunPower timely filed for a 60-day Extension of Time to Oppose the Application on July 8, 2011, which was granted until September 7, 2011.

16. According to Applicant's current website (at <http://www.sunpods.com/>) Applicant's current logo consists of the element "SUNPODS" to the right of an image of a solar module containing nine solar panels. Additionally, the phrase "SUN POWER ON DEMAND" does not appear under the element "SUN PODS," as presented in the alleged mark that is the subject of this Application. (Attached as Exhibit A is a true and correct printout from Applicant's current website showing its use of Applicant's logo.)

17. The phrase "SUN POWER ON DEMAND" appears in white font against a gray background on the right side of the header of Applicant's website.

18. Applicant is using the phrase “SUN POWER ON DEMAND” independent of the “SUN PODS” design element that appears in the designation that is the subject of this Application.

19. The use of the phrase “SUN POWER ON DEMAND” includes the “TM” designation, indicating that Applicant is claiming ownership of trademark rights in that phrase.

20. Applicant disclaimed the phrase “SUN POWER ON DEMAND” in this Application and therefore acknowledged that it does not have an exclusive right to use “SUN POWER ON DEMAND.”

21. Both Applicant’s use of the “TM” designation in connection with the phrase “SUN POWER ON DEMAND” on Applicant’s website and Applicant’s claim of ownership of the phrase “SUN POWER ON DEMAND” are inconsistent with Applicant’s acknowledgement that it does not have an exclusive right to use “SUN POWER ON DEMAND.”

22. Applicant did not use the alleged mark that is the subject of U.S. Application Serial No. 85/084,322 in commerce in connection with any goods or services in the United States prior to December 8, 2008.

23. Applicant did not use the alleged mark that is the subject of U.S. Application Serial No. 85/084,322 in commerce in connection with the goods set forth in U.S. Application Serial No. 85/084,322 in the United States prior to December 8, 2008.

24. The alleged mark, “SUNPODS SUN POWER ON DEMAND & Design,” which Applicant seeks to register, so resembles the SUNPOWER Mark as to be likely, when used on or in connection with Applicant’s goods, to cause confusion, or to cause mistake, or to deceive. Purchasers and prospective purchases are likely to falsely believe that the goods of Applicant sold under the alleged mark “SUN PODS SUN POWER ON DEMAND & Design” are



sponsored, endorsed or approved by SunPower, or are in some way affiliated, connected or associated with SunPower. Registration should therefore be refused under 15 U.S.C. § 1052(d).

25. Registration of Applicant's alleged mark would be a source of damage to SunPower because consumers are likely to attribute the source or sponsorship of Applicant's goods and services to SunPower.

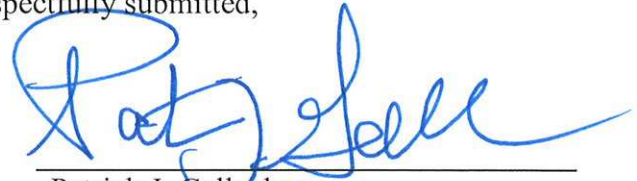
26. Registration of Applicant's alleged mark would be a source of damage to SunPower because it would enable Applicant to trade on and receive the benefit of the goodwill in the SUNPOWER Mark, which SunPower has built up at great labor and expense over more than 20 years.

27. Registration of Applicant's alleged mark would be a source of damage to SunPower, as it would confer upon Applicant various statutory presumptions to which it is not entitled in view of SunPower's long prior use of the SUNPOWER Mark.

WHEREFORE, SunPower requests that registration of Application Serial No. 85/084,322 for SUN PODS SUN POWER ON DEMAND & Design be denied in its entirety and this opposition be sustained.

The filing fee in the amount of \$300 as required by 37 C.F.R. § 2.6(a)(17) is submitted herewith. The Commissioner of Trademarks is authorized to draw on the deposit account of Fulbright & Jaworski, L.L.P., Account No. 50-1212/SUNP.T5240US.OP/PJG, in the event that anything prevents the successful completion of electronic payment of the filing fee.

Respectfully submitted,



By:

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Patrick J. Gallagher  
Laura J. Borst  
Renee S. Kraft  
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ATTORNEYS FOR OPPOSER  
SUNPOWER CORPORATION

Dated: September 6, 2011

**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the Notice of Opposition has been served via First Class Mail to Applicant's attorney of record at the address below on this the 6<sup>th</sup> day of September, 2011:

MARK DAVID TORCHE  
PATWRITE LLC  
408 W MAIN ST  
MARSHALLTOWN, IA 50158-5759

  
Katie T. Solberg

# **Exhibit A**



SUN POWER ON DEMAND™

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### SunPods Makes Installation Easy

### Recent News

#### SunPods Creates Solar Arrays with Autodesk Software

August 31, 2011 - Clean technology company SunPods Inc. is using software from Autodesk, Inc. (NASDAQ: ADSK) to design and manufacture modular solar array units that

### What are SunPods?

SunPods designs and manufactures factory-built solar arrays ready to power-up on delivery. SunPods units come complete with all of the components required for many different solar applications including electric vehicle charging and UPS back-up power.

Power small projects with one unit or interconnect



help make solar power more accessible and affordable. Unlike conventional customized ground-mounted solar arrays that require extensive onsite assembly and construction, SunPods are configured and built in a factory...

them up to utility-scale solar farms. SunPods vision is to make solar cost-effective and easy to install virtually anywhere.

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**About Us: The SunPods Story**

One thing was very obvious to SunPods founders, Dan Jaeger and Michael Gumm: The innovations in solar technologies were making solar energy more affordable; however, solar installation methods remained inefficient, resulting in high installation costs.

Combining their knowledge and experience gained from years in the solar, building and roofing industries, Dan and Michael developed the vision to speed up the solar PV installation process while reducing installation costs over a wide variety of solar applications. Thus, the latest in solar innovations was created, which we call SunPods™, Sun Power on Demand.

The SunPods photovoltaic systems address the importance of meeting construction budgets, installation schedules, array commissioning deadlines and reaching

specific power output goals – all critical in the installation process. Often, the failure to meet these specific project goals and deadlines results in substantial financial losses and penalties.

### **So, what are SunPods?**

SunPods are factory-built solar photovoltaic (PV) arrays – complete with PV modules, wiring, inverter, and other components specific to the solar application. A “SunPods unit” refers to the individual, solar power unit that is pre-manufactured and delivered to the project site ready to power-up with minimal site preparation or construction. The SunPods are pre-assembled into modular units so that no assembly is required on the project site. The SunPods product line was developed using our “SunPods Solar Smart Technology™” design concept. This streamlined process is applied to improve existing products and all new product development.

### **Solar energy scalable to utility-size solar farms**

Using SunPods flexible modular design allows designers and engineers to design and build solar PV arrays from a simple single unit to full-scale utility sized power farms.

We’re excited about SunPods and seeing the vision come to form a solar business that is gaining widespread attention from the government, commercial and residential customers as well as the solar industry.

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