

ESTTA Tracking number: **ESTTA897327**

Filing date: **05/17/2018**

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	Xcel Energy Inc.
Granted to Date of previous extension	06/06/2018
Address	414 Nicollet Mall Minneapolis, MN 55401 UNITED STATES

Attorney information	Kristine M. Boylan Briggs and Morgan, P.A. 80 South 8th Street 2200 IDS Center Minneapolis, MN 55402 UNITED STATES Email: kboylan@briggs.com, ljoyce@briggs.com, ip@briggs.com Phone: 612-977-8878
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Applicant Information

Application No	87586485	Publication date	02/06/2018
Opposition Filing Date	05/17/2018	Opposition Period Ends	06/06/2018
Applicant	Eaton Corporation 1000 Eaton Boulevard Cleveland, OH 44122 UNITED STATES		

Goods/Services Affected by Opposition

Class 007. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Hydraulic motors and structural and replacement parts therefor

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.	2869976	Application Date	03/08/2001
Registration Date	08/03/2004	Foreign Priority Date	NONE
Word Mark	HOMESMART FROM XCEL ENERGY		

Design Mark	
Description of Mark	NONE
Goods/Services	<p>Class 035. First use: First Use: 2001/03/01 First Use In Commerce: 2001/03/01 RETAIL STORE SERVICES FEATURING LARGE APPLIANCES, HEATING AND COOLING SYSTEMS AND ELECTRICAL FIXTURES</p> <p>Class 036. First use: First Use: 2001/03/01 First Use In Commerce: 2001/03/01 PROVIDING EXTENDED WARRANTY SERVICE CONTRACTS FOR MAINTENANCE AND REPAIR OF LARGER APPLIANCES, HEATING AND COOLING SYSTEMS AND ELECTRICAL FIXTURES</p>

U.S. Registration No.	2970929	Application Date	05/28/1999
Registration Date	07/19/2005	Foreign Priority Date	NONE
Word Mark	XCEL ENERGY		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 036. First use: First Use: 2000/09/00 First Use In Commerce: 2000/09/00 financing services and financial consultation programs provided to utilities, energy marketers and equipment vendors, to help them identify equipment for industrial, institutional and commercial customers and obtain financing for them to acquire that equipment; brokerage of electrical energy, natural gas and other forms of power and energy between utilities and municipalities, cooperatives and government agencies</p> <p>Class 037. First use: First Use: 2000/09/00 First Use In Commerce: 2000/09/00 Transformer maintenance and repair services; furnace, central air conditioning and large appliance repair services; polychlorinated biphenyl disposal services for others; power maintenance services, namely, maintenance of lighting transformers and other electrical equipment; construction, maintenance and repair of natural gas and electric power generation plants, systems and equipment; energy efficient home and building construction</p> <p>Class 039. First use: First Use: 2000/09/00 First Use In Commerce: 2000/09/00 Public utility services in the nature of electricity and natural gas transmission; transmission of natural gas and liquefied natural gas through pipelines; storage of natural gas and liquefied natural gas; public electric utility services, namely, assessing power supply requirements and problems for sensitive electronic equipment</p> <p>Class 040. First use: First Use: 2000/09/00 First Use In Commerce: 2000/09/00 recycling services</p> <p>Class 042. First use: First Use: 2000/09/00 First Use In Commerce: 2000/09/00 Automated energy services, namely remote monitoring and thermostatic control of energy utilization; reviewing standards and practices to ensure compliance with environmental regulations and laws concerning polychlorinated biphenyl</p>		

	compounds, power systems maintenance, and protective equipment testing and replacement; promoting public awareness of energy conservation and efficient electricity utilization by businesses through energy audits and consultation in the effects of energy efficient lighting, energy efficient air conditioning, energy efficient refrigeration, energy efficient motors and controls, window glazing, and energy conservation and home energy audits; promoting public awareness of the need for appliance rebates, energy efficient lighting for homes, air conditioning load control, appliance recycling, and special time-of-day rates; in-person troubleshooting special power supply requirements for customers having sensitive electronic equipment
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U.S. Registration No.	3011277	Application Date	09/07/2004
Registration Date	11/01/2005	Foreign Priority Date	NONE
Word Mark	XCEL ENERGY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 039. First use: First Use: 2000/09/00 First Use In Commerce: 2000/09/00 PUBLIC UTILITY SERVICES IN THE NATURE OF ELECTRICITY AND NATURAL GAS TRANSMISSION; TRANSMISSION OF NATURAL GAS AND LIQUEFIED NATURAL GAS THROUGH PIPELINES; STORAGE OF NATURAL GAS AND LIQUEFIED NATURAL GAS		

U.S. Registration No.	2733811	Application Date	11/30/2000
Registration Date	07/08/2003	Foreign Priority Date	NONE
Word Mark	XCEL ENERGY CENTER		
Design Mark			

Description of Mark	NONE
Goods/Services	Class 041. First use: First Use: 2000/09/24 First Use In Commerce: 2000/09/24 PROVIDING STADIUM FACILITIES FOR SPORTSAND RECREATIONAL ACTIVITIES

Attachments	76221465#TMSN.png(bytes) 78479283#TMSN.png(bytes) 76173585#TMSN.png(bytes) XCEL Opposition Doc.pdf(110168 bytes)
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Signature	/Kristine M. Boylan/
Name	Kristine M. Boylan
Date	05/17/2018

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

Xcel Energy Inc.,)	
)	
)	Opposition No. _____
Opposer,)	
)	Serial No. 87/586,485
v.)	
)	Mark: XCEL
Eaton Corporation,)	
)	
)	
Applicant.)	

NOTICE OF OPPOSITION

Xcel Energy Inc. (“Opposer”), a corporation duly organized and existing under the laws of Minnesota, with a mailing address of 414 Nicollet Mall, Minneapolis, Minnesota 55041, believes in good faith that it will be damaged by registration of the XCEL mark shown in United States Trademark Serial No. 87/586,485, filed on August 28, 2017 by Eaton Corporation (“Applicant”) with a mailing address of 1000 Eaton Boulevard, Cleveland, Ohio 44122, and hereby opposes the same.

The grounds for opposition are as follows:

1. Opposer is a power and energy provider, a utility holding company serving millions of residential and industrial customers in eight Western and Midwestern states.
2. Opposer adopted the XCEL ENERGY Mark at least as early as 2000 and has used it extensively and continuously since then in interstate commerce.
3. Opposer’s brand is well-known as a power and energy provider and covers public utility services in the nature of electricity and natural gas transmission, recycling services,

automated energy services, maintenance and repair services, and financing services. Opposer owns the following U.S. federal registrations incorporating, in whole or in part, “XCEL”:

Class	Description of Services	Mark	U.S. Reg. No(s).
35	Retail store services featuring large appliances, heating and cooling systems and electrical fixtures	HOMESMART FROM XCEL ENERGY	2869976
36	Providing extended warranty service contracts for maintenance and repair of larger appliances, heating and cooling systems and electrical fixtures; Financing services and financial consultation programs provided to utilities, energy marketers and equipment vendors, to help them identify equipment for industrial, institutional and commercial customers and obtain financing for them to acquire that equipment; brokerage of electrical energy, natural gas and other forms of power and energy between utilities and municipalities, cooperatives and government agencies	HOMESMART FROM XCEL ENERGY; XCEL ENERGY	2869976; 2970929
37	Transformer maintenance and repair services; furnace, central air conditioning and large appliance repair services; polychlorinated biphenyl disposal services for others; power maintenance services, namely, maintenance of lighting transformers and other electrical equipment; construction, maintenance and repair of natural gas and electric power generation plants, systems and equipment; energy efficient home and building construction	XCEL ENERGY	2970929
39	Public utility services in the nature of electricity and natural gas transmission; transmission of natural gas and liquefied natural gas through pipelines; storage of natural gas and liquefied natural gas; public electric utility services, namely, assessing power supply requirements and problems for sensitive electronic equipment	XCEL ENERGY	3011277
40	Recycling services	XCEL ENERGY	2970929
41	Providing stadium facilities for sports and recreational activities	XCEL ENERGY CENTER	2733811
42	Automated energy services, namely remote monitoring and thermostatic control of energy utilization; reviewing standards and practices to ensure compliance with environmental regulations and laws concerning polychlorinated biphenyl compounds, power systems maintenance, and protective equipment testing and replacement; promoting public awareness of energy conservation and efficient electricity utilization by businesses through energy audits and consultation in the effects of energy efficient lighting, energy efficient air conditioning, energy efficient refrigeration, energy efficient motors and controls, window glazing, and energy conservation and home energy audits; promoting public awareness of the need for appliance rebates, energy efficient lighting for homes, air conditioning load control, appliance recycling, and special time-of-day rates; in-person troubleshooting special power supply requirements for customers having sensitive electronic equipment	XCEL ENERGY	2970929

4. Opposer's registered marks are valid and subsisting, and are symbolic of the extensive goodwill and consumer recognition built up by Opposer through years of use and development in advertising and sales.

5. Notwithstanding Opposer's long-standing rights in and to its XCEL ENERGY trademark, Applicant filed an application to register the trademark XCEL on August 28, 2017 for use in connection with a product that is in direct competitive proximity with Opposer's XCEL ENERGY services.

6. The XCEL application was assigned Serial No. 87/586,485 and was published for opposition in the Official Gazette on February 6, 2018 in association with "hydraulic motors and structural and replacement parts therefor" in International Class 7.

7. Applicant's mark XCEL is confusingly similar to Opposer's XCEL ENERGY mark, as set forth and protected by Opposer's above-identified registrations. The marks have the same sound, appearance, meaning, connotation and commercial impression, and the goods and services are the same or highly similar so that there would be a likelihood of confusion, mistake and deception if Applicant's mark were to register.

8. Applicant is a power management company offering energy-efficient products and services to help customers effectively manage electrical, hydraulic and mechanical power more reliably, efficiently, safely and sustainably. Applicant adopted the XCEL designation to refer to hydraulic motors offered in connection with its hydraulic power units and systems. According to its website, "Eaton's hydraulics business manufactures hydraulic power and motion control, fluid conveyance, and filtration products for a variety of mobile and industrial applications."

9. Applicant's energy-efficient products and services are in direct competitive proximity with Opposer's energy services and offerings, including Applicant's efforts to deliver efficient, renewable energy and sustainable energy alternatives. The related nature of the goods and services accentuates the similarity between the marks and exacerbates the likelihood of confusion regarding the marks and the likelihood of confusion as to source, sponsorship or affiliation.

10. Applicant's goods and Opposer's services are likely to be encountered and/or purchased by the same or similar consumers.

11. Applicant's goods and Opposer's services sold under the mark(s) are sold in the same or similar commercial channels.

12. The conditions surrounding the marketing of Applicant's and Opposer's goods and services are such that they are likely to be encountered by the same purchasers under the same or similar circumstances that could give rise to the mistaken belief that the goods originate from a common source, resulting in a likelihood of confusion in the marketplace, and damage to Opposer.

13. Opposer has prior and senior rights in its XCEL ENERGY Mark pursuant to, without limitation, its use in commerce, and United States Trademark Registrations.

14. Opposer will be damaged by any registration of Applicant's asserted XCEL Mark because it so resembles Opposer's XCEL ENERGY Mark as to be likely to cause confusion, mistake and to deceive under Lanham Act § 2(d), 15 U.S.C. § 1052(d).

WHEREFORE, Opposer believes that it will be damaged by registration of Applicant's mark and requests that registration of the proposed mark XCEL be denied.

Dated: May 17, 2018

BRIGGS AND MORGAN, P.A.

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