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

Proceeding	91243210
Party	Defendant AtSite, Inc.
Correspondence Address	MICHAEL C. PETOCK PETOCK & PETOCK, LLC P.O. BOX 856 VALLEY FORGE, PA 19482 mp@petocklaw.com no phone number provided
Submission	Answer
Filer's Name	Michael C. Petock
Filer's email	mp@petocklaw.com
Signature	/Michael C. Petock/
Date	09/11/2018
Attachments	Answer09.118.pdf(83773 bytes)

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

ENGIE INSIGHT SERVICES INC.	]	
	]	
	]	
Opposer	]	
	]	
vs.	]	Opposition No.: 91243210
	]	Application No.: 87/532,516
ATSITE, INC.	]	Mark: INSITE
	]	Filed: July 18, 2017
Applicant.	]	Published for Opposition: June 26, 2018
	]	

ANSWER TO NOTICE OF OPPOSITION AND AFFIRMATIVE DEFENSES

AtSite, Inc., a Delaware corporation with a principal place of business at 2021 L St., NW, Second Floor Washington, DC 20036 (hereinafter "AtSite" or "Applicant"), by its undersigned attorneys, as and for its Answer to the Notice of Opposition against Application Serial No. 87/532,516 for registration of INSITE, states as follows:

1. Admitted. By way further answer, Opposer only very recently adopted its "ENGIE INSIGHT" mark with full knowledge of Applicant's preexisting use and rights in its INSITE mark.

2. Admitted only that Opposer provides an energy and sustainability software platform utilizing its ENGIE INSITE mark. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the remaining allegations vaguely characterizing the purpose and nature of Opposer's software platform and therefore denies the same. By way of further answer, after entering into a contractual business relationship involving Applicant's INSITE branded services, Opposer commenced offering competitive services under a confusingly similar mark.

3. Denied. By way of further answer, the purpose and nature of Applicant's software is set forth in detail in its Application and Opposer's synoptic characterization and interpretation of the same is denied. The reference to http://www.atsitesolutions.com/news/insite3-intelligence-platform-released contains no averment of fact and the document speaks for itself requiring no response. To the extent that a response is required, the allegations are denied.

4. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 4 of the Notice of Opposition, and the same are therefore denied. By way of further answer, Opposer admits in Paragraph 1 of its Notice of Opposition that Opposer uses the term "INSIGHT" as a mark and not in a descriptive sense.[1] The reference to Marco Vriens & Roger Verhulst, Marketing Research Magazine, Unleashing Hidden Insights 13, 13 (Winter 2008) contains no averment of fact and the document speaks for itself requiring no response. To the extent that a response is required, the allegations are denied.

5. Denied. By way of further answer it is admitted only that Applicant sent Opposer a cease and desist letter on or about March 5, 2018 demanding that Opposer (not Applicant) cease and desist from use of INSIGHT as a mark. Otherwise, the cease and desist letter is a document that speaks for itself and the allegations as to its contents require no response. To the extent that a response is required, Applicant denies the remaining allegations characterizing the contents of the cease and desist letter.

6. Admitted that Applicant sent Opposer a cease and desist letter on or about March 5, 2018 referencing its U.S. Reg. Nos. 4,659,661 and 4,493,976. Otherwise, the cease and desist letter is a document that speaks for itself and the allegations as to its contents require no response. To

[1] See also https://www.engieinsight.com/solution/energy-sustainability-management-platform/ (*Discover why thousands of leading companies have gained a competitive advantage by utilizing the ENGIE Insight Platform. Sign up to start your free, no-obligation trial today!*)

the extent that a response is required, Applicant denies the remaining allegations characterizing the contents of the cease and desist letter.

7. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 7 of the Notice of Opposition regarding what Opposer believes, and the same are therefore denied. By way of further answer, Applicant seeks only to prevent Opposer from using a confusingly similar mark.

8. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 8 of the Notice of Opposition, and the same are therefore denied.

COUNT I
[ALLEGED] MERE DESCRIPTIVENESS

9. Paragraph 9 is an incorporation paragraph to which no response is required.

10. Admitted.

11. Denied.

12. Denied.

13. Denied.

14. Denied.

15. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 15 of the Notice of Opposition, and the same are therefore denied. By way of further answer, Applicant's mark "InSite" aligns with its business name AtSite which has been used for over 15 years and is protected by Registration Nos. 3,467,702 and 4,655,601. Further, Applicant's mark could also be perceived as a play on the idiom "in sight."

16. Admitted. By way of further Answer, Applicant's services in class 35 and class 42 are more fully set forth in its Application.

17. The purpose and nature of Applicant's services and software is set forth in detail in its Application and Opposer's synoptic characterization and interpretation of the same is denied.

18. Denied.

19. Denied.

20. Denied.

21. Denied.

22. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 22 of the Notice of Opposition, and the same are therefore denied. By way of further answer, INSIGHT and INSITE have historically been considered inherently distinctive marks by the United States Patent and Trademark Office and registerable without proof of secondary meaning in connection with a wide array of goods and services.

23. Denied.

24. Admitted only that a federal registration would provide to Applicant the legal benefits afforded by a federal trademark registration. Otherwise, Applicant lacks knowledge or information sufficient to form a belief as to the truth of the remaining allegations set forth in Paragraph 24 of the Notice of Opposition, and the same are therefore denied.

25. Denied.

AFFIRMATIVE DEFENSES

In further answer to the Notice of Opposition, Applicant states that:

FIRST AFFIRMATIVE DEFENSE

Opposer's Notice of Opposition fails to state a claim upon which relief can be granted, and in particular fails to state legally sufficient grounds for sustaining the opposition.

SECOND AFFIRMATIVE DEFENSE

Opposer lacks standing.

THIRD AFFIRMATIVE DEFENSE

Applicant's mark is not merely descriptive for services set forth in Applicant's Application. In fact, Applicant owns Registration No. 4,659,661 for the mark INSITE which was determined by the USPTO to be inherently distinctive and not merely descriptive.

FOURTH AFFIRMATIVE DEFENSE

To the extent that the mark is determined to be merely descriptive, Applicant's mark has acquired distinctiveness/ secondary meaning as a source indicator for its services.

FIFTH AFFIRMATIVE DEFENSE

Opposer's claims are barred by virtue of the existence of Applicant's Registration Nos. 4,659,661 and 4,493,976 (Morehouse Defense).

SIXTH AFFIRMATIVE DEFENSE

Opposer's claims are barred by the doctrine of laches based on its delay in asserting its claims including based on the existence of Applicant's Registration Nos. 4,659,661 and 4,493,976.

SEVENTH AFFIRMATIVE DEFENSE

Opposer's claims are barred by the doctrine of waiver and acquiescence including based on its business and contractual relationship with Applicant and agreement that it would not use any proprietary aspect of AtSite's services.

EIGHTH AFFIRMATIVE DEFENSE

Opposer's claims are barred by the doctrine of estoppel including based on its business and contractual relationship with Applicant and agreement that it would not use any proprietary aspect of AtSite's services.

NINTH AFFIRMATIVE DEFENSE

Opposer's claims are barred by the doctrine of unclean hands.

TENTH AFFIRMATIVE DEFENSE

Opposer uses the term INSIGHT not in a descriptive sense but as a mark and its brand in numerous public forms, including Opposer's website.

WHEREFORE, Applicant respectfully requests that the Notice of Opposition be dismissed with prejudice and that Applicant's application serial number 87/532,516 for INSITE proceed to registration.

Respectfully submitted,

ATSITE, INC.

Dated: 9/11/18 By: /Michael C. Petock/

Michael C. Petock, Esq.
PETOCK & PETOCK, LLC
1220 Valley Forge Road
P.O. Box 856
Valley Forge, PA 19482-0856
Tel: (610) 935-8600
Fax: (610) 933-9300
mp@petocklaw.com
PA Attorney ID No. 93,692
Attorney for Applicant

CERTIFICATE OF SERVICE

I hereby certify that on September 11, 2018 a true and complete copy of the foregoing Answer to Notice of Opposition and Affirmative Defenses has been served on the following counsel for ENGIE INSIGHT SERVICES INC. by electronic mail to:

J. Christopher Lynch
Lee & Hayes, PLLC
601 W Riverside Ave Ste. 1400
Spokane, WA 99201
UNITED STATES
chris@leehayes.com

/Michael C. Petock/

Michael C. Petock, Esq.
PETOCK & PETOCK, LLC
1220 Valley Forge Road
P.O. Box 856
Valley Forge, PA 19482-0856
Tel: (610) 935-8600
Fax: (610) 933-9300
mp@petocklaw.com
PA Attorney ID No. 93,692
Attorney for Applicant