

ESTTA Tracking number: **ESTTA404010**

Filing date: **04/15/2011**

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

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	U.S. Gas & Electric, Inc.		
Entity	Corporation	Citizenship	Delaware
Address	290 N.W. 165th Street, PH5 North Miami Beach, FL 33169 UNITED STATES		

Attorney information	Jami A. Gekas Wildman, Harrold, Allen & Dixon LLP 225 W, Wacker Drive Suite 2800 Chicago, IL 60606 UNITED STATES gekas@wildman.com Phone:3122012000
----------------------	--

Registrations Subject to Cancellation

Registration No	2238079	Registration date	04/13/1999
Registrant	NEW YORK STATE ELECTRIC & GAS CORPORATION 4500 Vestal Parkway East P. O. Box 3607 Binghamton, NY 139023607 UNITED STATES		

Goods/Services Subject to Cancellation

Class 035. First Use: 1980/05/01 First Use In Commerce: 1980/05/01 All goods and services in the class are cancelled, namely: [distributorships featuring energy efficient household appliances]
Class 039. First Use: 1980/05/01 First Use In Commerce: 1980/05/01 All goods and services in the class are cancelled, namely: utility services, namely, distribution and [transmission] * transmission * of electricity, distribution, transportation and storage of natural gas, assisting businesses and consumers in efficient energy use, and energy brokerage services
Class 040. First Use: 1980/05/01 First Use In Commerce: 1980/05/01 All goods and services in the class are cancelled, namely: generation of electricity
Class 041. First Use: 1980/05/01 First Use In Commerce: 1980/05/01 All goods and services in the class are cancelled, namely: educational services, namely, conducting classes, seminars and distributing materials on the subject of efficient energy use
Class 042. First Use: 1980/05/01 First Use In Commerce: 1980/05/01 All goods and services in the class are cancelled, namely: energy auditing and energy management for others; research and development services for others; and providing consultation and advice relating to compliance of environmental regulations and energy use

Grounds for Cancellation

Abandonment	Trademark Act section 14
The registration is being used by, or with the	Trademark Act section 14

permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used.			
Registration No	3656846	Registration date	07/21/2009
Registrant	New York State Electric & Gas Corporation P.O. Box 3607 4500 Vestal Parkway East Binghamton, NY 13902 UNITED STATES		

Goods/Services Subject to Cancellation

Class 035. First Use: 1997/06/01 First Use In Commerce: 1997/06/01 All goods and services in the class are cancelled, namely: Energy related services, namely, performing energy audits for others, and energy utilization consultation; providing consumer product information in the field of energy efficient equipment and products
Class 039. First Use: 1997/06/01 First Use In Commerce: 1997/06/01 All goods and services in the class are cancelled, namely: Utility services, namely, distribution and transmission of electricity, distribution, transportation and storage of natural gas, and transportation and storage services in the energy industry

Grounds for Cancellation

Abandonment	Trademark Act section 14
The registration is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used.	Trademark Act section 14

Related Proceedings	New York State Electric & Gas Corp. v. U.S. Gas & Electric, Inc., Case No. 09 CV 6618 (W.D.N.Y.)
---------------------	--

Attachments	TTAB Notice of Cancellation_2238079 (name).pdf (5 pages)(76265 bytes) TTAB Notice of Cancellation_3656846 (logo).pdf (6 pages)(115743 bytes)
-------------	---

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	/Helen I. Odom/
Name	Helen I. Odom
Date	04/15/2011

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

In the Matter of Registration No. 2,238,079
Mark: NYSEG
Registration Date: April 13, 1999

U.S. GAS & ELECTRIC, INC.	:	
	:	Cancellation No. _____
Petitioner,	:	
	:	
v.	:	
	:	
NEW YORK STATE ELECTRIC & GAS CORPORATION,	:	
	:	
Registrant.	:	

PETITION FOR CANCELLATION

Petitioner, U.S. GAS & ELECTRIC, INC., a Delaware corporation, with its principal place of business at 290 N.W. 165th Street, PH5, North Miami Beach, Florida 33169 (“Petitioner”), believes that it is, and will continue to be, damaged by Registration No. 2,238,079, for the mark NYSEG (“Registration”) and petitions to cancel said Registration.

As grounds for cancellation, Petitioner alleges the following:

1. On information and belief, Registrant New York State Electric & Gas Corporation (“Registrant”) is a New York corporation with its principal place of business at 89 East Avenue, Rochester, New York 14649 (“Registrant”). Registrant is a regulated energy services utility.
2. On information and belief, Registrant owns the Registration, which covers the word mark “NYSEG” (the “NYSEG Word Mark”).
3. On information and belief, the Registration issued on the Principal Register on April 13, 1999, for use in connection with the following International Classes of Goods and Services:

- Class 39: “utility services, namely, distribution and transmission of electricity, distribution, transportation and storage of natural gas, assisting businesses and consumers in efficient energy use, and energy brokerage services”;
- Class 40: “generation of electricity”;
- Class 41: “educational services, namely, conducting classes, seminars and distributing materials on the subject of efficient energy use”; and
- Class 42: “energy auditing and energy management for others; research and development services for others; and providing consultation and advice relating to compliance of environmental regulations and energy use”.

4. On information and belief, the NYSEG Word Mark was previously registered in International Class 35 for “distributorships featuring energy efficient household appliances,” which Class 35 is currently cancelled.

5. On information and belief, Registrant claims a date of first use in each class of May 1, 1980.

6. Registrant has legally abandoned the NYSEG Word Mark by engaging in naked licensing without sufficient quality control. In particular, Registrant has allowed an affiliated, unregulated energy services company known as NYSEG Solutions, Inc. (“NYSEG Solutions”) to make use of the NYSEG Logo Mark for over a decade.

7. On information and belief, Registrant does not exercise any authority or control over NYSEG Solutions and its use of the NYSEG Word Mark, and does not exercise any control over NYSEG Solutions with respect to the nature and quality of products or services on or in connection with which the mark is used. As such, NYSEG Solutions is not a “related company” within the meaning of

Section 45 of the Lanham Act (15 U.S.C. § 1127), and its use of the NYSEG Word Mark does not inure to the benefit of Registrant pursuant to Section 5 (15 U.S.C. § 1055).

8. Moreover, even if NYSEG Solutions could be considered a “related company” to Registrant within the meaning of Section 45 of the Lanham Act, the use by NYSEG Solutions of the NYSEG Word Mark does not inure to the benefit of Registrant, because NYSEG Solutions has used the mark in a manner likely to deceive the public. In particular, Registrant has allowed NYSEG Solutions to use the NYSEG Word Mark in order to deceive consumers into believing that NYSEG Solutions’ services emanate from Registrant itself, and/or that elements of Registrant’s reputation are applicable to NYSEG Solutions, when in fact they are not. Such use is in violation of Section 5 of the Lanham Act, and thereby affects the validity of the NYSEG Word Mark and the Registration.

9. The foregoing acts, including legal abandonment through naked licensing, use of the NYSEG Word Mark by NYSEG Solutions with the permission of Registrant so as to misrepresent the source of services on or in connection with which the mark is used, and use of the NYSEG Word Mark in such manner as to deceive the public, have rendered the mark subject to cancellation, pursuant to 15 U.S.C. § 1064(3).

10. In or around December 2009, Petitioner began doing business as “New York Gas & Electric” or “NYG&E” within New York State, although not within the geographic area in which Registrant operates as a regulated utility. On December 4, 2009, Registrant initiated legal action against Petitioner in the U.S. District Court for the Western District of New York (Case No. 09-cv-6618) alleging trademark infringement and unfair competition under the Lanham Act and New York State Law (the “District Court Action”), and asserting that Petitioner had engaged in willful acts of infringement of the NYSEG Logo Mark as depicted in the Registration. The District Court Action is ongoing.

11. Registrant has relied on its ownership of Registration No. 2,238,079 in the District Court Action, and unless Registration No. 2,238,079 is canceled, Petitioner will continue to be damaged thereby. Furthermore, the Registration is injurious to Petitioner because it casts a cloud on Petitioner's right to use the trade name "NYG&E."

WHEREFORE, for all of the foregoing reasons, Petitioner respectfully requests cancellation of Registration Number 2,238,079 for the mark NYSEG.

Respectfully submitted this 15th day of April, 2011,

/Jami A. Gekas/
Jami A. Gekas
Helen I. Odom
WILDMAN, HARROLD, ALLEN
& DIXON LLP
225 West Wacker Drive
Chicago, Illinois 60606-1229
Telephone: (312) 201-2000
Facsimile: (312) 201-2555

ATTORNEYS FOR PETITIONER
U.S. GAS & ELECTRIC, INC.

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing PETITION FOR CANCELLATION has been served on Registrant New York State Electric & Gas Corporation by mailing said copy on April 15th, 2011, via First Class Mail, postage prepaid to:

Michael T. Murphy
K&L Gates LLP
1601 K Street, NW
Washington DC 20006-1600
ATTORNEY OF RECORD FOR REGISTRANT
NEW YORK STATE ELECTRIC & GAS CORPORATION

With a courtesy copy via email to:

Michael F. Orman, Esq. (morman@nixonpeabody.com)
Daniel F. Dovi, Esq. (ddovi@nixonpeabody.com)
Nixon Peabody LLP
1300 Clinton Square
Rochester, New York 14604-1792

/Helen I. Odom/

Helen I. Odom
ATTORNEY FOR PETITIONER

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

In the Matter of Registration No. 3,656,846
Mark: NYSEG (Stylized)
Registration Date: July 21, 2009

U.S. GAS & ELECTRIC, INC. :
 :
 : Cancellation No. _____
 :
 Petitioner, :
 :
 :
 v. :
 :
 :
 NEW YORK STATE ELECTRIC & GAS :
 CORPORATION, :
 :
 :
 Registrant. :

PETITION FOR CANCELLATION

Petitioner, U.S. GAS & ELECTRIC, INC., a Delaware corporation, with its principal place of business at 290 N.W. 165th Street, PH5, North Miami Beach, Florida 33169 (“Petitioner”), believes that it is, and will continue to be, damaged by Registration No. 3,656,846, for the mark NYSEG (Stylized) (“Registration”) and petitions to cancel said Registration.

As grounds for cancellation, Petitioner alleges the following:

1. On information and belief, Registrant New York State Electric & Gas Corporation (“Registrant”) is a New York corporation with its principal place of business at 89 East Avenue, Rochester, New York 14649. Registrant is a regulated energy services utility.
2. On information and belief, Registrant owns the Registration, which covers the stylized mark “NYSEG” (the “NYSEG Logo Mark”), as follows:



3. On information and belief, the Registration issued on the Principal Register on July 21, 2009, for use in connection with the following International Classes of Goods and Services:

- Class 35: “energy related services, namely, performing energy audits for others, and energy utilization consultation; providing consumer product information in the field of energy efficient equipment and products”; and
- Class 39: “utility services, namely, distribution and transmission of electricity, distribution, transportation and storage of natural gas, and transportation and storage services in the energy industry”.

4. On information and belief, Registrant claims a date of first use in both classes of June 1, 1997.

5. On information and belief, neither Registrant, nor any licensee thereof, is making use of the NYSEG Logo Mark in connection with the services specified in the Registration or in connection with any other goods or services.

6. On information and belief, in or about December, 2010, Registrant adopted a new logo mark (“New Logo”), which it is currently using, as shown below:



7. Registrant has a pending application for this New Logo (Application Serial Number 85/220,802) for use in connection with a variety of goods and services in International Classes 4, 37, 39, 40, and 42 (the “Application”).

8. On information and belief, Registrant is now using the same mark reflected in the Application, or a similar leaf design mark on its website (located at www.nyseg.com), marketing materials and all other materials intended to convey its mark to consumers.

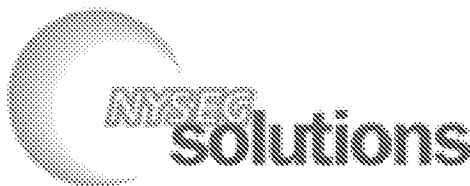
9. The design mark in the Application is materially different in appearance from the mark reflected in the Registration and conveys a different commercial impression from the mark in the Registration.

10. Registrant's material change to the mark in its Registration constitutes abandonment of the mark under Section 45 of the Lanham Act.

11. The differences between the mark depicted in the Registration and the mark currently being used by Registrant result in a different commercial impression created by the respective marks, and evidence Registrant's intent to abandon the mark shown in its Registration. Thus, Registrant cannot tack the use of the mark in the Registration to the mark currently being used.

12. Registrant has abandoned its use of the NYSEG Logo Mark without any intent to resume use, and accordingly has abandoned the mark within the meaning of Sections 14 and 45 of the Lanham Act (15 U.S.C. § 1064 and § 1127).

13. In addition to its express abandonment of the NYSEG Logo Mark, Registrant has also legally abandoned the NYSEG Logo Mark by engaging in naked licensing without sufficient quality control. In particular, Registrant has allowed an affiliated, unregulated energy services company known as NYSEG Solutions, Inc. ("NYSEG Solutions") to make use of the NYSEG Logo Mark for over a decade, as shown below:



14. On information and belief, Registrant does not exercise any authority or control over NYSEG Solutions and its use of the NYSEG Logo Mark, and does not exercise any control over NYSEG Solutions with respect to the nature and quality of products or services on or in connection with which the mark is used. As such, NYSEG Solutions is not a “related company” within the meaning of Section 45 of the Lanham Act (15 U.S.C. § 1127), and its use of the NYSEG Logo Mark does not inure to the benefit of Registrant pursuant to Section 5 (15 U.S.C. § 1055).

15. Moreover, even if NYSEG Solutions could be considered a “related company” to Registrant within the meaning of Section 45 of the Lanham Act, the use by NYSEG Solutions of the NYSEG Logo Mark does not inure to the benefit of Registrant, because NYSEG Solutions has used the mark in a manner likely to deceive the public. In particular, Registrant has allowed NYSEG Solutions to use the NYSEG Logo Mark in order to deceive consumers into believing that NYSEG Solutions’ services emanate from Registrant itself, and/or that elements of Registrant’s reputation are applicable to NYSEG Solutions, when in fact they are not. Such use is in violation of Section 5 of the Lanham Act, and thereby affects the validity of the NYSEG Logo Mark and the Registration.

16. The foregoing acts, including express abandonment, legal abandonment through naked licensing, use of the NYSEG Logo Mark by NYSEG Solutions with the permission of Registrant so as to misrepresent the source of services on or in connection with which the mark is used, and use of the NYSEG Logo Mark in such manner as to deceive the public, have rendered the mark subject to cancellation, pursuant to 15 U.S.C. § 1064(3).

17. In or around December 2009, Petitioner began doing business as “New York Gas & Electric” or “NYG&E” within New York State, although not within the geographic area in which Registrant operates as a regulated utility. On December 4, 2009, Registrant initiated legal action against Petitioner in the U.S. District Court for the Western District of New York (Case No. 09-cv-6618)

alleging trademark infringement and unfair competition under the Lanham Act and New York State Law (the “District Court Action”), and asserting that Petitioner had engaged in willful acts of infringement of the NYSEG Logo Mark as depicted in the Registration. The District Court Action is ongoing.

18. Registrant has relied on its ownership of Registration No. 3,656,846 in the District Court Action, and unless Registration No. 3,656,846 is canceled, Petitioner will continue to be damaged thereby. Furthermore, the Registration is injurious to Petitioner because it casts a cloud on Petitioner’s right to use the trade name “NYG&E.”

WHEREFORE, for all of the foregoing reasons, Petitioner respectfully requests cancellation of Registration Number 3,656,846 for the mark NYSEG (Stylized).

Respectfully submitted this 15th day of April, 2011,

/Jami A. Gekas/
Jami A. Gekas
Helen I. Odom
WILDMAN, HARROLD, ALLEN
& DIXON LLP
225 West Wacker Drive
Chicago, Illinois 60606-1229
Telephone: (312) 201-2000
Facsimile: (312) 201-2555

ATTORNEYS FOR PETITIONER
U.S. GAS & ELECTRIC, INC.

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing PETITION FOR CANCELLATION has been served on Registrant New York State Electric & Gas Corporation by mailing said copy on April 15, 2011, via First Class Mail, postage prepaid to:

Michael T. Murphy
K&L Gates LLP
1601 K Street, NW
Washington DC 20006-1600
ATTORNEY OF RECORD FOR REGISTRANT
NEW YORK STATE ELECTRIC & GAS CORPORATION

With a courtesy copy via email to:

Michael F. Orman, Esq. (morman@nixonpeabody.com)
Daniel F. Dovi, Esq. (ddovi@nixonpeabody.com)
Nixon Peabody LLP
1300 Clinton Square
Rochester, New York 14604-1792

/Helen I. Odom/

Helen I. Odom
ATTORNEY FOR PETITIONER