

ESTTA Tracking number: **ESTTA954736**

Filing date: **02/17/2019**

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 has filed a petition to cancel the registration indicated below.

Petitioner Information

Name	The Weidt Group, Inc.		
Entity	Corporation	Citizenship	Delaware
Address	5800 Baker Road Minnetonka, MN 55345 UNITED STATES		

Attorney information	Michael T. Olsen / Tucker A. Chambers Winthrop & Weinstine, P.A. 225 South Sixth Street, Suite 3500 Minneapolis, MN 55402 UNITED STATES trademark@winthrop.com, molsen@winthrop.com, tchambers@winthrop.com 6126046586
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Registration Subject to Cancellation

Registration No.	5638377	Registration date	12/25/2018
Registrant	Schneider Electric USA, Inc. 800 Federal Street Andover, MA 01810 UNITED STATES		

Goods/Services Subject to Cancellation


<p>Class 009. First Use: 2015/12/31 First Use In Commerce: 2016/07/26 All goods and services in the class are subject to cancellation, namely: Mobile application software used to provide information regarding green energy and clean energy technology, namely, providing business information and referrals in the fields of clean energy projects, agreements, deals, events, conventions, advice, and best practices for companies, clean energy developers, building owners, utilities, and government entities; software platform for use in asset optimization, industrial automation, machine diagnostics, and optimization of industrial, manufacturing and infrastructure management processes; software applied to the protection, control, management, surveillance and supervision of electric installations and networks and communication networks</p>
<p>Class 035. First Use: 2015/12/31 First Use In Commerce: 2016/07/26 All goods and services in the class are subject to cancellation, namely: Providing an interactive website featuring business information and referrals in the fields of clean energy projects, agreements, deals, events, conventions, advice, and best practices for companies, clean energy developers, building owners, utilities, and government entities</p>
<p>Class 042. First Use: 2015/12/31 First Use In Commerce: 2016/07/26 All goods and services in the class are subject to cancellation, namely: Providing an interactive website featuring technology that allows companies, clean energy developers, building owners, utilities, and government entities to facilitate business transactions by sharing and obtaining information, intro-</p>


ductions and referrals in the fields of clean energy technology, projects, agreements, deals, events, conventions, advice, best practices, regulations, and laws, said interactive website not for use in building and analyzing energy models

Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act Sections 14(1) and 2(d)
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Marks Cited by Petitioner as Basis for Cancellation

U.S. Application No.	88074385	Application Date	08/10/2018
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	NEO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 2012/07/19 First Use In Commerce: 2012/07/19 Providing on-line non-downloadable software for use in building and analyzing energy models		

U.S. Registration No.	4429793	Application Date	08/23/2012
Registration Date	11/05/2013	Foreign Priority Date	NONE
Word Mark	NEO NET ENERGY OPTIMIZER		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 2012/07/19 First Use In Commerce: 2012/07/19 Providing on-line non-downloadable software for use in building and analyzing		

	energy models
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Attachments	88074385#TMSN.png(bytes) 85711188#TMSN.png(bytes) 20190217 Petition for Cancellation - NEO NETWORK - Schneider - SN 87040952.pdf(438370 bytes)
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Signature	/Tucker A. Chambers/
Name	Tucker A. Chambers
Date	02/17/2019

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

The Weidt Group, Inc.,
Petitioner,

v.

Cancellation No. _____

Schneider Electric USA, Inc.,
Respondent.

PETITION FOR CANCELLATION

The Weidt Group, Inc. (“Petitioner”) believes that it is and will continue to be damaged by the registration of the claimed NEO NETWORK mark shown in Registration No. 5,638,377, and hereby petitions to cancel the same. The grounds for cancellation are as follows:

Petitioner’s NEO Marks

1. Petitioner is the owner of prior common law rights to the word marks NEO and NEO NET ENERGY OPTIMIZER (collectively “Petitioner’s NEO Marks”) for a variety of software goods and services in the field of energy efficiency, including but not limited to, software for building and analyzing energy models, providing real-time building energy information and analytics, analyzing energy efficiency of building designs, performing full life-cycle energy cost analysis, comparing designs to energy costs and sustainability programs and standards, applying results to utility market transformation incentive programs, and modeling energy efficient building plans, to obtain electrical power savings, reduce energy costs, optimize building performance, and reduce environmental impacts (“Petitioner’s Goods & Services”).

2. Petitioner has continuously used Petitioner’s NEO Marks in commerce for Petitioner’s Goods & Services since at least as early as July 19, 2012.

3. Petitioner is the record owner of U.S. Trademark Registration No. 4,429,793 for the mark NEO NET ENERGY OPTIMIZER® (“Petitioner’s Registration”) for “providing on-line non-downloadable software for use in building and analyzing energy models” in International Class 42, with a first-use-in-commerce date at least as early as July 19, 2012.

4. True and correct copies of Petitioner’s Registration and a current printout of information from the electronic database records of the USPTO, showing the current status and title of Petitioner’s Registration, are attached as Exhibit A.

5. The application filing date and nationwide constructive use date for the NEO NET ENERGY OPTIMIZER® mark covered by Petitioner’s Registration is August 23, 2012.

6. Petitioner’s Registration issued on the Principal Register of the USPTO on November 5, 2013.

7. Petitioner is also the record owner of Application Serial No. 88/074,385 for the standard-character NEO mark for “providing on-line non-downloadable software for use in building and analyzing energy models,” claiming a first-use-in-commerce date at least as early as July 19, 2012.

Respondent’s NEO NETWORK Mark

8. Schneider Electric USA, Inc. (“Respondent”) is the record owner of Registration No. 5,638,377 (“Respondent’s Registration”) for the standard-character mark NEO NETWORK (the “Claimed NEO NETWORK Mark”).

9. Respondent filed the application that matured into Respondent’s Registration on May 18, 2016.

10. Respondent’s Registration claims first use of the Claimed NEO NETWORK Mark as of December 31, 2015, and first use in commerce as of July 26, 2016 (“Respondent’s Claimed First Use Dates”).

11. The goods and services identified in Respondent's Registration in Classes 9, 35, and 42 are the following:

- "Mobile application software used to provide information regarding green energy and clean energy technology, namely, providing business information and referrals in the fields of clean energy projects, agreements, deals, events, conventions, advice, and best practices for companies, clean energy developers, building owners, utilities, and government entities; software platform for use in asset optimization, industrial automation, machine diagnostics, and optimization of industrial, manufacturing and infrastructure management processes; software applied to the protection, control, management, surveillance and supervision of electric installations and networks and communication networks" in Int'l Class 9;
- "Providing an interactive website featuring business information and referrals in the fields of clean energy projects, agreements, deals, events, conventions, advice, and best practices for companies, clean energy developers, building owners, utilities, and government entities" in Int'l Class 35; and
- "Providing an interactive website featuring technology that allows companies, clean energy developers, building owners, utilities, and government entities to facilitate business transactions by sharing and obtaining information, introductions and referrals in the fields of clean energy technology, projects, agreements, deals, events, conventions, advice, best practices, regulations, and laws, said interactive website not for use in building and analyzing energy models" in Int'l Class 42 (collectively, "Respondent's Claimed Goods & Services").

12. Respondent's Registration issued on December 25, 2018, which is within five years of the filing date of this Petition for Cancellation.

13. This Petition for Cancellation is timely filed.

Count I: Priority and Likelihood of Confusion (Lanham Act § 2(d))

14. Petitioner restates and incorporates by reference the preceding paragraphs.

15. Petitioner has used Petitioner's NEO Marks in commerce for Petitioner's Goods & Services prior to the filing date of the application that matured into Respondent's Registration.

16. Petitioner's nationwide constructive use date of August 23, 2012 for the NEO NET ENERGY OPTIMIZER® mark covered by Petitioner's Registration, and the registration date of November 5, 2013 for Petitioner's Registration, predate Respondent's Claimed First Use Dates by over two years.

17. Petitioner's first use in commerce of Petitioner's NEO Marks, since at least as early as July 19, 2012, predates Respondent's Claimed First Use Dates by over three years.

18. On information and belief, Petitioner has used Petitioner's NEO Marks in commerce for Petitioner's Goods & Services prior to any use by Respondent of the Claimed NEO NETWORK Mark in commerce for Respondent's Claimed Goods & Services.

19. Petitioner has priority over Respondent to use Petitioner's NEO Marks for Petitioner's Goods & Services, as a result of the prior nationwide constructive use date alleged above, and as a result of Petitioner's prior common law trademark rights and continuous use in commerce of Petitioner's NEO Marks for Petitioner's Goods & Services.

20. Petitioner has expended considerable time, effort, and money developing, promoting, advertising, and popularizing Petitioner's NEO Marks in connection with Petitioner's Goods & Services.

21. The purchasing public has come to know, rely upon, and recognize Petitioner's NEO Marks as a strong indicator of the source of Petitioner's Goods & Services.

22. Petitioner's NEO Marks are inherently distinctive.

23. Respondent's Registration claims a standard-character mark, without claim to any particular font style, size, or color of the mark.

24. Petitioner's NEO Marks are visually similar to the Claimed NEO NETWORK Mark.

25. Petitioner's NEO Marks are similar in sound to the Claimed NEO NETWORK Mark.

26. Petitioner's NEO Marks are similar in meaning to the Claimed NEO NETWORK Mark.

27. Petitioner's NEO Marks have similar overall commercial impressions as the Claimed NEO NETWORK Mark.

28. The dominant element of the Claimed NEO NETWORK Mark is the term "NEO" because that term appears first and the term "NETWORK" is disclaimed and non-distinctive.

29. The dominant "NEO" element of the Claimed NEO NETWORK Mark is identical to Petitioner's NEO mark.

30. Petitioner's Goods & Services are related and overlapping with Respondent's Claimed Goods & Services.

31. Petitioner's Goods & Services and Respondent's Claimed Goods & Services both encompass software in the field of energy, including for example, software that provides building owners with information regarding the use of energy.

32. The identification of Respondent's Claimed Goods & Services set forth in Respondent's Registration is unrestricted as to channels of trade.

33. Respondent's Claimed Goods & Services are presumed to travel in all channels of trade.

34. The identification of services in Petitioner's Registration is unrestricted as to channels of trade and classes of consumers.

35. The services identified in Petitioner's Registration are presumed to be available and directed to all classes of consumers and travel in all channels of trade.

36. Based on the similarity of Petitioner's NEO Marks and the Claimed NEO NETWORK Mark, and the relatedness of Petitioner's Goods & Services and Respondent's Claimed Goods & Services, the continued registration of the Claimed NEO NETWORK Mark causes a likelihood of confusion.

37. Respondent's Claimed NEO NETWORK Mark so closely resembles Petitioner's NEO Marks as to be likely, when used in connection with Respondent's Claimed Goods & Services, to cause confusion, to cause mistake, or to deceive as to affiliation, source, or sponsorship, to the detriment of Petitioner.

38. For the foregoing reasons, Respondent's Registration should be cancelled pursuant to Sections 2 and 14 of the Lanham Act, 15 U.S.C. §§ 1052(d), 1064.

WHEREFORE, Petitioner requests that the Trademark Trial and Appeal Board:

1. Sustain this Petition for Cancellation;
2. Cancel U.S. Reg. No. 5,638,377; and
3. Grant Petitioner any further relief the Board deems equitable.

Dated: February 17, 2019

WINTHROP & WEINSTINE, P.A.

/Tucker A. Chambers/

Michael T. Olsen

Tucker A. Chambers

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Minneapolis, Minnesota 55402

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(612) 604-6800 (Facsimile)

Attorneys for Petitioner

EXHIBIT A

United States of America

United States Patent and Trademark Office

NEO NET ENERGY OPTIMIZER

Reg. No. 4,429,793

THE WEIDT GROUP, INC. (DELAWARE CORPORATION)
5800 BAKER ROAD
MINNETONKA, MN 55345

Registered Nov. 5, 2013

Int. Cl.: 42

FOR: PROVIDING ON-LINE NON-DOWNLOADABLE SOFTWARE FOR USE IN BUILDING AND ANALYZING ENERGY MODELS, IN CLASS 42 (U.S. CLS. 100 AND 101).

SERVICE MARK

FIRST USE 7-19-2012; IN COMMERCE 7-19-2012.

PRINCIPAL REGISTER

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "NET ENERGY OPTIMIZER", APART FROM THE MARK AS SHOWN.

SN 85-711,188, FILED 8-23-2012.

CARYN GLASSER, EXAMINING ATTORNEY




Lisa Street Lee

Deputy Director of the United States Patent and Trademark Office

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Starting Oct. 4, 2018, bulk data customers should no longer obtain direct access to TSDR data through tsdrsec.uspto.gov. [There are two alternative ways to receive bulk data from TSDR.](#)

STATUS	DOCUMENTS	MAINTENANCE	Back to Search	Print
Generated on: This page was generated by TSDR on 2019-02-14 23:20:54 EST				
Mark: NEO NET ENERGY OPTIMIZER				
NEO NET ENERGY OPTIMIZER				
US Serial Number:	85711188	Application Filing Date:	Aug. 23, 2012	
US Registration Number:	4429793	Registration Date:	Nov. 05, 2013	
Register:	Principal			
Mark Type:	Service Mark			
TM5 Common Status Descriptor:	LIVE/REGISTRATION/Issued and Active			
	The trademark application has been registered with the Office.			
Status:	A Sections 8 and 15 combined declaration has been accepted and acknowledged.			
Status Date:	Dec. 06, 2018			
Publication Date:	Apr. 30, 2013	Notice of Allowance Date:	Jun. 25, 2013	
▼ Mark Information ▲ Collapse All				
Mark Literal Elements:	NEO NET ENERGY OPTIMIZER			
Standard Character Claim:	Yes. The mark consists of standard characters without claim to any particular font style, size, or color.			
Mark Drawing Type:	4 - STANDARD CHARACTER MARK			
Disclaimer:	"NET ENERGY OPTIMIZER"			
▼ Goods and Services				
Note:				
The following symbols indicate that the registrant/owner has amended the goods/services:				
<ul style="list-style-type: none"> • Brackets [.] indicate deleted goods/services; • Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and • Asterisks *.* identify additional (new) wording in the goods/services. 				
For:	Providing on-line non-downloadable software for use in building and analyzing energy models			
International Class(es):	042 - Primary Class	U.S Class(es):	100, 101	
Class Status:	ACTIVE			
Basis:	1(a)			
First Use:	Jul. 19, 2012	Use in Commerce:	Jul. 19, 2012	
▼ Basis Information (Case Level)				
Filed Use:	No	Currently Use:	Yes	
Filed ITU:	Yes	Currently ITU:	No	
Filed 44D:	No	Currently 44E:	No	
Filed 44E:	No	Currently 66A:	No	
Filed 66A:	No	Currently No Basis:	No	
Filed No Basis:	No			
▼ Current Owner(s) Information				
Owner Name:	THE WEIDT GROUP, INC.			
Owner Address:	5800 BAKER ROAD MINNETONKA, MINNESOTA UNITED STATES 55345			
Legal Entity Type:	CORPORATION	State or Country Where Organized:	DELAWARE	
▼ Attorney/Correspondence Information				
Attorney of Record				
Attorney Name:	Michael T. Olsen	Docket Number:	12316.1	
Attorney Primary Email Address:	trademark@winthrop.com	Attorney Email Authorized:	Yes	

Correspondent		
Correspondent Name/Address:	MICHAEL T. OLSEN WINTHROP & WEINSTINE, P.A. 225 South Sixth Street Capella Tower, Suite 3500 MINNEAPOLIS, MINNESOTA UNITED STATES 55402-4629	
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Correspondent e-mail:	trademark@winthrop.com molsen@winthrop.com tchambers@winthrop.com cclassen@winthrop.com	Correspondent e-mail Authorized: Yes
Domestic Representative - Not Found		
▼ Prosecution History		
Date	Description	Proceeding Number
Dec. 06, 2018	NOTICE OF ACCEPTANCE OF SEC. 8 & 15 - E-MAILED	
Dec. 06, 2018	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	76874
Dec. 06, 2018	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	76874
Nov. 12, 2018	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Nov. 12, 2018	TEAS SECTION 8 & 15 RECEIVED	
Nov. 05, 2018	COURTESY REMINDER - SEC. 8 (6-YR) E-MAILED	
Nov. 05, 2013	REGISTERED-PRINCIPAL REGISTER	
Oct. 04, 2013	NOTICE OF ACCEPTANCE OF STATEMENT OF USE E-MAILED	
Oct. 03, 2013	LAW OFFICE REGISTRATION REVIEW COMPLETED	68171
Sep. 30, 2013	ALLOWED PRINCIPAL REGISTER - SOU ACCEPTED	
Sep. 09, 2013	STATEMENT OF USE PROCESSING COMPLETE	65362
Aug. 12, 2013	USE AMENDMENT FILED	65362
Sep. 06, 2013	CASE ASSIGNED TO INTENT TO USE PARALEGAL	65362
Aug. 12, 2013	TEAS STATEMENT OF USE RECEIVED	
Aug. 06, 2013	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Jun. 25, 2013	NOA E-MAILED - SOU REQUIRED FROM APPLICANT	
Apr. 30, 2013	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Apr. 30, 2013	PUBLISHED FOR OPPOSITION	
Apr. 10, 2013	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
Mar. 26, 2013	LAW OFFICE PUBLICATION REVIEW COMPLETED	68171
Mar. 26, 2013	ASSIGNED TO LIE	68171
Mar. 12, 2013	APPROVED FOR PUB - PRINCIPAL REGISTER	
Mar. 08, 2013	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
Mar. 07, 2013	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
Mar. 07, 2013	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Jan. 30, 2013	AUTOMATIC UPDATE OF ASSIGNMENT OF OWNERSHIP	
Nov. 27, 2012	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Nov. 27, 2012	NON-FINAL ACTION E-MAILED	6325
Nov. 27, 2012	NON-FINAL ACTION WRITTEN	82426
Nov. 27, 2012	ASSIGNED TO EXAMINER	82426
Sep. 06, 2012	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Aug. 27, 2012	NEW APPLICATION ENTERED IN TRAM	
▼ Maintenance Filings or Post Registration Information		
Affidavit of Continued Use:	Section 8 - Accepted	
Affidavit of Incontestability:	Section 15 - Accepted	
▼ TM Staff and Location Information		
TM Staff Information - None		
File Location		
Current Location:	TMEG LAW OFFICE 108	Date in Location: Dec. 06, 2018
▼ Assignment Abstract Of Title Information - Click to Load		
▼ Proceedings - Click to Load		