

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
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WINTER

December 19, 2019

Cancellation No. 92070611

*The Weidt Group, Inc.*

*v.*

*Schneider Electric USA, Inc.*

Before Deputy Chief Administrative Trademark Judge Thurmon and  
Kuhlke and Goodman, Administrative Trademark Judges.

On February 17, 2019, The Weidt Group, Inc., (Petitioner) filed a petition to cancel  
U.S. Reg. No. 5638377<sup>1</sup> owned by Schneider Electric USA, Inc. (Respondent).

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<sup>1</sup> U.S. Reg. No. 5638377, issued December 25, 2018, for the mark NEO NETWORK in standard characters; alleging first use anywhere on December 31, 2015, and first use in commerce on July 26, 2016, in connection with the following goods and services: 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 (International 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 (International 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 (International Class 42); the

1 TTABVUE. An answer was due in this proceeding on March 31, 2019. 2 TTABVUE  
3. Because an answer or an extension of time to file an answer was not submitted to  
the Board, the Board issued a notice of default on April 10, 2019, allowing Respondent  
thirty days show cause why judgment should not be entered against Respondent.  
4 TTABVUE. Having received no response to the notice, the Board entered default  
judgment on May 30, 2019, and granted the cancellation, 5 TTABVUE, and on June  
15, 2019, Respondent's registration was cancelled. 6 TTABVUE.

This case now comes up for consideration of Respondent's fully briefed motion  
(filed June 27, 2019) for relief from default judgment. 8 TTABVUE. Specifically,  
Respondent requests that the Board vacate the orders granting default judgment and  
cancelling its registration, and reinstitute the cancellation proceeding.

The Board has considered the parties' briefs and materials or evidence submitted  
therewith, but addresses the record only to the extent necessary to set forth the  
Board's analysis and findings, and does not repeat or address all of the parties'  
arguments or materials. *Guess? IP Holder LP v. Knowlux LLC*, 116 USPQ2d 2018,  
2019 (TTAB 2015).

### **Legal Standard**

Fed. R. Civ. P. 60(b), made applicable to Board proceedings by Trademark Rule  
2.116(a), states, in part: "On motion and just terms, the court may relieve a party ...  
from a final judgment, order, or proceeding for the following reasons: (1) mistake,  
inadvertence, surprise, or excusable neglect; ... or (6) any other reason justifying relief

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term "network" is disclaimed; cancelled under Section 18 of the Trademark Act, on June 15,  
2019.

from the operation of the judgment.” Further, Fed. R. Civ. P. 60(b) requires that any motion for relief from judgment be made within a “reasonable time,” with a one year maximum limitation on motions made pursuant to the first three grounds for relief (mistake, inadvertence, surprise, excusable neglect; newly discovered evidence; or fraud). *Djeredjian v. Kashi Co.*, 21 USPQ2d 1613, 1615 (TTAB 1991). The determination of whether to grant a Fed. R. Civ. P. 60(b) motion is a matter largely within the discretion of the court, or in this instance, the Board. *See Case v. BASF Wyandotte*, 737 F.2d 1034, 222 USPQ 737 (Fed. Cir. 1984) (cited in *Djeredjian*, 21 USPQ2d at 1615). Among the factors to be considered in determining a Rule 60(b) motion to vacate a default judgment based on mistake are the following: (1) whether the non-defaulting party will be substantially prejudiced; (2) whether the default was willful; and (3) whether defendant has a meritorious defense. *See Djeredjian*, 21 USPQ2d at 1615 (internal citations omitted). Nevertheless, because default judgments for failure to timely answer the complaint are not favored by the law, a motion under Fed. R. Civ. P. 55(c) or 60(b) seeking relief from such a judgment is generally treated with more liberality by the Board than are other motions under Fed. R. Civ. P. 60(b) for relief from other types of judgments, such as default judgments entered against plaintiffs for failure to prosecute the case. *See Information Sys. and Networks Corp. v. U.S.*, 994 F.2d 792, 795 (Fed. Cir. 1993) (“a trial on the merits is favored over default judgment”); *see also* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 312.03 (2019); 11 Fed. Prac. & Proc. Civ. §§ 2857 and 2858 (3d ed. August 2019 update).

## Parties' Arguments

Respondent requests that the Board vacate its order granting the cancellation on the grounds that it did not receive a copy of the Notice of Institution from the Board constituting service of the petition to cancel on Respondent, the notice of default, or the Commissioner's order cancelling its registration. 8 TTABVUE 2-4.<sup>2</sup> (Barengolts dec. ¶¶ 5-7, 8 TTABVUE 11; Linehan dec. ¶¶ 4-7, 8 TTABVUE 14). Noting that the Notice of Institution<sup>3</sup> was mailed to "800 Federal Street, Andover, MA 01810" (Respondent's "owner address" of record), Respondent explains that mail that is received at its "800 Federal Street, Andover, MA 01810" location is sorted by one individual among approximately 600 employees, and that if correspondence, as in this case, is not addressed to a particular individual, it is possible that it will not be delivered or its delivery will be delayed. Linehan dec. ¶¶ 8-9, 8 TTABVUE 14. In any event, Respondent states that it just recently discovered the May 30, 2019 order granting the default judgment when Ms. Linehan, Respondent's in-house counsel, received a copy of the order on June 17, 2019, from a colleague in Respondent's legal department. Linehan dec. ¶¶ 4 and 6, 8 TTABVUE 14. Respondent also informs the Board that Petitioner's counsel had sent to Ms. Linehan a letter objecting to Respondent's registration on December 5, 2018, about two months before the petition

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<sup>2</sup> Attached to Respondent's motion are the declarations of Respondent's outside counsel, Phillip Barengolts of Pattishall, McAuliffe, Newbury, Hilliard & Geraldson LLP, and of Respondent's in-house counsel, Nicole L. Linehan, Associate General Counsel, IP for Schneider Electric USA, Inc.

<sup>3</sup> Respondent notes that because no address is shown on the Notice of Default or the order cancelling its registration it is unclear as to whether those orders were mailed to Respondent. 8 TTABVUE 3.

was filed, but Petitioner's counsel did not send a courtesy copy of the petition or otherwise communicate with Ms. Linehan or Respondent's outside counsel regarding the cancellation, notwithstanding the fact that Petitioner had allowed Respondent until January 18, 2019, to respond to the Petitioner's letter. Linehan dec. ¶ 3, 8 TTABVUE 13; Barengolts dec. ¶¶ 3-4, 8 TTABVUE 10-11. Respondent also points out that it maintains current **correspondence** address information with the USPTO in regard to its registration, and both Ms. Linehan and Mr. Barengolts have authorized the USPTO to communicate with them via email. 8 TTABVUE 4.

In opposition, Petitioner argues that Respondent's motion should be denied in view of the circumstances related to its alleged non-receipt of Board orders and for failing to meet the requirements of Rule 60(b). Specifically, Petitioner contends that Respondent's address has been the same throughout the two and one-half year prosecution of the underlying application and later, during this proceeding; that USPTO records of this proceeding and of the underlying application do not show that Respondent failed to receive any documents from the USPTO during this proceeding or, earlier during the prosecution of the application;<sup>4</sup> and that Respondent has not explained why neither of its counsel received copies of the Board's orders by email. Further, Petitioner asserts that the Board should deny Respondent's motion in view of Respondent's assertedly negligent handling of its contact information and its issues

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<sup>4</sup> When mail sent by the U.S. Postal Service is returned to the Board, a copy of the returned envelope will be uploaded to the electronic record of the proceeding at issue and will become part of the file history.

with its internal mail system, its alleged pattern of missing deadlines,<sup>5</sup> Respondent's lack of meritorious defense, and prejudice to Petitioner in the nature of increased costs from having to litigate a claim insofar as Respondent has no chance of succeeding.

In reply, Respondent points out, *inter alia*, that Petitioner has not demonstrated any recognizable prejudice and reiterates that it has maintained accurate and up-to-date contact information.

### **Analysis and Order**

Trademark Rule 2.113(c)(1), 37 C.F.R. § 2.113(c)(1), provides that the Board shall forward a copy of the notice of institution to the party shown by the records of the Office to be the current **owner** of the registration(s) sought to be cancelled at the email or address of record for the current owner. To effectuate Rule 2.113(c)(1), the Board retrieves **the current address of the registration owner** from the USPTO's internal electronic file database, and uses that address to serve the registrant in the Board proceeding. Any representation and correspondence address of the registrant that may be of record in the registration file at the time of the commencement of the Board proceeding is **not** considered to be effective for purposes of the Board proceeding, be it in-house counsel with a different address than the registration owner, as in this case, or registrant's outside counsel.<sup>6</sup> Rather, under Rule 2.113(c),

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<sup>5</sup> Petitioner alleges that Respondent missed several deadlines during the prosecution of the underlying application. 10 TTABVUE 9.

<sup>6</sup> The USPTO considers a power of attorney filed while an application is pending to end with registration. *See* Trademark Rule 2.17(g)(1), 37 C.F.R. § 2.17(g)(1); Trademark Manual of Examining Procedure (TMEP) § 605.04 (October 2018). In view thereof, the Office encourages

the Board sends correspondence to the owner of the registration itself or, if registrant is an entity domiciled in a foreign country, its domestic representative, *see* Trademark Rule 2.24, 37 C.F.R. § 2.24, unless and until an attorney makes an appearance in the Board proceeding on the registrant's behalf, or a written power of attorney is filed in the proceeding by the registrant, or written authorization of some other person entitled to be recognized is filed in the proceeding by the registrant, or the registrant designates in writing another address to which correspondence is to be sent. TBMP § 117.03.

Petitioner essentially argues that, but for Respondent's purported negligence, Respondent should have received (and perhaps did receive) the mailed notice of institution and subsequent Board orders. However, some of Petitioner's factual assertions on which its argument is based do not take into consideration certain aspects of the procedures followed by the Trademark Examining Operation (TMEO), or the Board's rules and procedures. In particular, the contention that "Respondent's address" has been the same throughout the prosecution of the underlying application of the involved registration and through the Board's institution of this proceeding ignores the potential if not frequent differences between the correspondence address of the applicant during prosecution and the address of record of the owner of a registration used at the commencement of a Board cancellation proceeding. Further,

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applicants and registrants to do the following: "To ensure that email is authorized and your email address is current, please use the Trademark Electronic Application System (TEAS) Change of Correspondence Address **and** Change of Owner's Address forms (emphasis added). See <https://www.uspto.gov/trademarks-getting-started/trademark-basics/checking-status-application-or-registration>. This recommendation is also included in a notice that accompanies an issued registration.

Petitioner's arguments do not appreciate the process used by the Board to obtain the current address of the registration owner of record, discussed above.

Here, the original correspondent for Respondent, as applicant during the *ex parte* review of the underlying application of the involved registration, was Ms. Linehan, whose office (along with the Schneider Electric Intellectual Property Department) is located at a different address than Respondent. Later in the *ex parte* prosecution, Respondent submitted a revocation of the power of attorney of record and appointed Mr. Barengolts as its attorney of record;<sup>7</sup> and when Respondent filed its statement of use, it updated its correspondence address a third time by filing another revocation of power of attorney and re-appointing Ms. Linehan as its correspondent. Although Respondent sought to comply with Trademark Rule 2.18(b)(1), 37 C.F.R. § 2.18(b)(1),<sup>8</sup> that is, by maintaining a current **correspondence address**, which clearly it did, neither Ms. Linehan, nor Mr. Barengolts received correspondence from the Board because registrant's **correspondence address prior to registration is not**

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<sup>7</sup> To the extent Respondent and its outside counsel believed that Mr. Barengolts was identified as registrant's "domestic representative," such an assumption is incorrect, notwithstanding the indication of the TEAS form filed that he is registrant's domestic representative. Only entities with foreign domiciles may designate a domestic representative for receiving service of documents. *See* Trademark Rules 2.119(d) and 2.24, 37 C.F.R. §§ 2.119(d) and 2.24; TBMP § 114.07.

<sup>8</sup> Trademark Rule 2.18(b)(1), applicable to this proceeding when the subject motion was filed, states, "[i]f a physical or e-mail correspondence address changes, the applicant, registrant, or party to a proceeding must file a written request to change the correspondence address. The request should be promptly filed." Trademark Rule 2.18 is amended effective December 21, 2019, and no longer includes Rule 2.18(b)(1). However, new Trademark Rule 2.18(c), 37 C.F.R. § 2.18(c), states, that [t]he applicant, registrant, or party to a proceeding must maintain current and accurate correspondence addresses, as required by § 2.23, for itself and its attorney, if one is designated. If any of these addresses change, a request to change the address, signed in accordance with § 2.193(e)(9), must be promptly filed."



**incorporated into the Board’s records, nor is it used for serving the petition to cancel at the point of institution.**<sup>9</sup> *Cf. 3PMC, LLC v. Huggins*, 115 USPQ2d 1488, 1490 (TTAB 2015) (with multiple electronic filing systems that operate and update differently, ... it [is not] always true that electronic systems are immediately cognizant of all the data or documents that ultimately bear on a procedural determination of respective rights.”).

Respondent could have included Ms. Linehan’s email address in the “owner address” field of its application when the application was filed (or later, by amendment through TEAS), along with its authorization to serve registrant by email, in which case Ms. Linehan would have received a copy of the Board’s institution order, as well as subsequent orders, until Respondent appointed its outside counsel to represent it before the Board.<sup>10</sup> However, given that Ms. Linehan’s email or some other internal email address of registrant was not included in the Respondent’s (as owner) address of record, the Board’s several orders were not emailed to Respondent’s in-house counsel, as suggested by Petitioner. Accordingly, although Respondent admits that its internal physical mail delivery system needs improvement, we find

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<sup>9</sup> Thus, although Respondent’s outside counsel is currently shown in the Board’s records as the correspondent for Respondent, before it submitted the instant motion, only the name of the owner of the registration and its physical address of record would have been identified in the Board’s Trademark Trial and Appeal Board Inquiry System (TTABVUE).

<sup>10</sup> Since the 2017 amendments to the Trademark Rules became effective, in cancellation proceedings, the Board would serve defendants in cancellation proceedings by U.S. mail, pending system enhancements to facilitate email service at a later date. *See* TBMP § 309.02(c)(2). Currently, the Board is able to serve the institution order by email, as long as an email address is included with the **owner** information **and** email service is authorized.

that Respondent's default was not willful inasmuch as the record clearly shows that it sought to maintain a current correspondence address with the Office. *See* TMEP § 609.03 ("The owner of an application or registration has a duty to maintain a current and accurate **correspondence address.**") (emphasis added).<sup>11</sup>

Turning next to whether Petitioner will be prejudiced, Petitioner has not argued that it will have lost witnesses or evidence should relief be granted. Mere delay or loss of tactical advantage, without more, has not been found to constitute prejudice. *See, e.g., Pratt v. Philbrook*, 109 F.3d 18 (1st Cir. 1997) (cited in *Pumpkin Ltd. v. Seed Corps*, 43 USPQ2d 1582, 1587 (TTAB 1997) (prejudice typically results if witnesses or evidence become unavailable as a result of the delay)). Under these circumstances, we find no basis on which Petitioner could be substantially prejudiced should Respondent's motion be granted. *See Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154, 1156 (TTAB 1991). Similarly, notwithstanding Petitioner's arguments to the contrary, Respondent's answer that was submitted with its motion, 8 TTABVUE 17-20, is not frivolous and thus sets forth a meritorious defense. *See DeLorme Publ'g Co v. Eartha's Inc.*, 60 USPQ2d 1222, 1224 (TTAB 2000) (all that is necessary to establish a meritorious defense are plausible responses to the allegations in the petition).

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<sup>11</sup> We note also that Petitioner had communicated with Respondent's in-house counsel prior to the filing of the petition to cancel. Although a petitioner is not required to serve the petition to cancel, a petitioner **may** forward a courtesy copy to an attorney who it believes is representing respondent. *Jacques Moret, Inc. v. Speedo Holdings B.V.*, 102 USPQ2d 1212, 1216 (TTAB 2012) (emphasis original).

Respondent's failure to respond to the petition to cancel may be due in part to an irregularity in its in-house mail delivery system; however, said default is not due to want of effort by Respondent's counsel to maintain a current correspondence address. Additionally, there is no prejudice to Petitioner and Respondent has a meritorious defense. Accordingly, the motion for relief from default judgment entered on May 30, 2019, is **GRANTED**, the default judgment is set aside, and Respondent's registration will be reinstated in due course. Further, Respondent's answer submitted on June 27, 2019, 8 TTABVUE 17, is accepted as Respondent's pleading of record.

**PROCEEDING RESUMED; TRIAL DATES RESET**

This proceeding is resumed. Trial dates, including the mandatory discovery conference, disclosure due dates, and the discovery period, are reset as shown in the following schedule:

<b>Deadline for Discovery Conference</b>	<b>1/20/2020</b>
<b>Discovery Opens</b>	<b>1/20/2020</b>
<b>Initial Disclosures Due</b>	<b>2/19/2020</b>
<b>Expert Disclosures Due</b>	<b>6/18/2020</b>
<b>Discovery Closes</b>	<b>7/18/2020</b>
<b>Plaintiff's Pretrial Disclosures Due</b>	<b>9/1/2020</b>
<b>Plaintiff's 30-day Trial Period Ends</b>	<b>10/16/2020</b>
<b>Defendant's Pretrial Disclosures Due</b>	<b>10/31/2020</b>
<b>Defendant's 30-day Trial Period Ends</b>	<b>12/15/2020</b>
<b>Plaintiff's Rebuttal Disclosures Due</b>	<b>12/30/2020</b>
<b>Plaintiff's 15-day Rebuttal Period Ends</b>	<b>1/29/2021</b>

<b>Plaintiff's Opening Brief Due</b>	<b>3/30/2021</b>
<b>Defendant's Brief Due</b>	<b>4/29/2021</b>
<b>Plaintiff's Reply Brief Due</b>	<b>5/14/2021</b>
<b>Request for Oral Hearing (optional) Due</b>	<b>5/24/2021</b>

Generally, the Federal Rules of Evidence apply to Board trials. Trial testimony is taken and introduced out of the presence of the Board during the assigned testimony periods. The parties may stipulate to a wide variety of matters, and many requirements relevant to the trial phase of Board proceedings are set forth in Trademark Rules 2.121 through 2.125, 37 C.F.R. §§ 2.121-2.125. These include pretrial disclosures, the manner and timing of taking testimony, matters in evidence, and the procedures for submitting and serving testimony and other evidence, including affidavits, declarations, deposition transcripts and stipulated evidence. Trial briefs shall be submitted in accordance with Trademark Rules 2.128(a) and (b), 37 C.F.R. §§ 2.128(a) and (b). Oral argument at final hearing will be scheduled only upon the timely submission of a separate notice as allowed by Trademark Rule 2.129(a), 37 C.F.R. § 2.129(a).

