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

Proceeding	92070611
Party	Defendant Schneider Electric USA, Inc.
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Signature	/kristine bergman/
Date	08/07/2020
Attachments	Schneider Electric Answer and Counterclaims - NEO NETWORK.pdf(37951 bytes)

Registration Subject to the filing

Registration No.	5964643	Registration date	01/21/2020
Registrant	WILLDAN ENERGY SOLUTIONS SUITE 300 2401 E. KATELLA AVENUE ANAHEIM, CA 92806 UNITED STATES		

Goods/Services Subject to the filing

Class 042. First Use: 2012/07/19 First Use In Commerce: 2012/07/19

All goods and services in the class are requested, namely: Providing on-line non-downloadable software for use in building and analyzing energy models, excluding software in the fields of medical or genetic testing and medical or genetic research

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

In the Matter of Registration No. 5,638,377
NEO NETWORK

THE WEIDT GROUP, INC.)	
WILLDAN ENERGY SOLUTIONS)	
Petitioners,)	
)	
v.)	Cancellation No. 92070611
)	
SCHNEIDER ELECTRIC USA, INC.)	
)	
Respondent.)	

**RESPONDENT'S ANSWER AND
COUNTERCLAIMS TO AMENDED PETITION FOR CANCELLATION**

ANSWER

In response to the Petition for Cancellation filed by The Weidt Group, Inc. and Willdan Energy Solutions ("Petitioners") regarding U.S. Reg. No. 5,638,377 for the NEO NETWORK trademark, registered and used by Schneider Electric USA, Inc. ("Respondent"), Respondent hereby answers as set forth below. Unless specifically admitted, Respondent denies each of the allegations in the Petition for Cancellation.

1. Respondent lacks the knowledge or information necessary to form a belief as to the truth of the allegations contained in Paragraph 1 and therefore denies them.
2. Respondent lacks the knowledge or information necessary to form a belief as to the truth of the allegations contained in Paragraph 2 and therefore denies them.
3. Respondent admits that Registration No. 4,429,793 identifies Petitioner as the owner of the mark shown therein for the goods shown therein and that Registration No. 4,429,793

claims a first-use date of July 19, 2012, on its face, but Respondent lacks the knowledge or information necessary to form a belief as to the truth of the claimed first-use date or any other information contained in Paragraph 3 and therefore denies the same.

4. Admitted.

5. Respondent admits that the application that matured into Registration No. 4,429,793 was filed on August 23, 2012. Respondent lacks the knowledge or information necessary to form a belief as to the truth of the remaining allegations contained in Paragraph 5 and therefore denies the same.

6. Admitted.

7. Respondent admits that Registration No. 5,964,643 identifies Petitioner as the owner of the mark shown therein for the goods shown therein and that Registration No. 5,964,643 claims a first-use date of July 19, 2012, on its face, but Respondent lacks the knowledge or information necessary to form a belief as to the truth of the claimed first-use date or any other information contained in Paragraph 7 and therefore denies the same.

8. Admitted.

9. Respondent admits that Application Serial No. 88/839,323 identifies Petitioner Willdan as the owner of the mark shown therein for the goods shown therein and that Application Serial No. 88/074,385 claims a first-use date of July 19, 2012, on its face, but Respondent lacks the knowledge or information necessary to form a belief as to the truth of the claimed first-use date or any other information contained in Paragraph 9 and therefore denies the same.

10. Admitted.

11. Admitted, but Respondent notes that the U.S. Patent and Trademark Office only issued an office action after being prompted to do so by Petitioner Willdan's Petition to Make Special.
12. Admitted.
13. Admitted.
14. Admitted.
15. Admitted.
16. Admitted.
17. Respondent lacks the knowledge or information necessary to form a belief as to the truth of the allegations contained in Paragraph 17 and therefore denies them.
18. Respondent lacks the knowledge or information necessary to form a belief as to the truth of the allegations contained in Paragraph 18 and therefore denies them.
19. Respondent lacks the knowledge or information necessary to form a belief as to the truth of the allegations contained in Paragraph 19 and therefore denies them.
20. Respondent lacks the knowledge or information necessary to form a belief as to the truth of the allegations contained in Paragraph 20 and therefore denies them.
21. Respondent lacks the knowledge or information necessary to form a belief as to the truth of the allegations contained in Paragraph 21 and therefore denies them.
22. Respondent lacks the knowledge or information necessary to form a belief as to the truth of the allegations contained in Paragraph 22 and therefore denies them.
23. Respondent lacks the knowledge or information necessary to form a belief as to the truth of the allegations contained in Paragraph 23 and therefore denies them.

24. Respondent lacks the knowledge or information necessary to form a belief as to the truth of the allegations contained in Paragraph 24 and therefore denies them.

25. Respondent lacks the knowledge or information necessary to form a belief as to the truth of the allegations contained in Paragraph 25 and therefore denies them.

26. Denied.

27. Admitted.

28. Denied.

29. Denied.

30. Denied.

31. Denied.

32. Denied.

33. Admitted.

34. Denied.

35. Respondent admits that the "NEO" element of NEO NETWORK is identical to the word NEO but denies that "NEO" is the dominant portion of Respondent's NEO NETWORK mark and denies the remaining allegations contained in Paragraph 35.

36. Denied.

37. Respondent admits that in the Office Action issued for Willdan's Application and prompted by Willdan's Petition to Make Special initially refused registration of Ser. No. 88/839,323 based on a likelihood of confusion with Respondent's NEO NETWORK mark, but denies that such an office action constitutes a conclusion by the U.S. Patent and Trademark Office and that the initial refusal applied to all of Petitioners' NEO Marks, and so denies the remaining allegations contained in Paragraph 37.

38. Denied.

39. Denied.

40. Denied.

41. Denied on the basis that Petitioner's definition of "Respondent's Claimed Goods & Services" does not include "services that provide information regarding efficient use of energy."

42. Respondent admits that in the Office Action issued for Willdan's Application and prompted by Willdan's Petition to Make Special initially refused registration of Ser. No. 88/839,323 based on a likelihood of confusion with Respondent's NEO NETWORK mark, but denies that such an office action constitutes a conclusion by the U.S. Patent and Trademark Office and so denies the remaining allegations contained in Paragraph 42.

43. Denied.

44. Denied.

45. Denied.

46. Denied.

47. Denied.

48. Denied.

49. Denied.

50. Denied.

51. Respondent lacks the knowledge or information necessary to form a belief as to the truth of the allegations contained in Paragraph 51 and therefore denies them.

52. Denied.

53. Denied.

54. Denied.

55. Denied.

56. Denied on the basis that Petitioner's definition of "Respondent's Claimed Goods & Services" does not include goods and services that "are intended to be utilized by building owners and utilities."

57. Denied on the basis that Petitioner's definition of "Respondent's Claimed Goods & Services" does not include "goods or services that allows users to predict energy usage."

58. Denied.

59. Denied.

60. Denied.

61. Denied.

62. Denied.

COUNTERCLAIMS

Schneider Electric, USA, Inc. ("Cross-Petitioner"), believes it is and will continue to be damaged by United States Trademark Registration No. 5,964,643, owned currently and previously by The Weidt Group, Inc. ("Weidt") and Willdan Energy Group ("Willdan") (collectively, "Cross-Respondents"), and hereby petitions for partial cancellation or restriction of this registration and cancellation on the basis of fraud. In support thereof, Cross-Petitioner states as follows:

1. Cross-Petitioner Schneider Electric is a global specialist in energy management and automation. It offers energy and automation digital solutions for efficiency and sustainability in homes, buildings, data centers, infrastructure and industries by combining energy technologies, real-time automation, software, and other services.

2. During discovery in this proceeding whereby Cross-Respondents seek to cancel Cross-Petitioner's registration of NEO NETWORK (Reg. No. 5,638,377) based in part on their prior registration of NEO, Cross-Petitioner learned that Cross-Respondents use the NEO mark only for a web-based software program that calculates the cost-effectiveness of HVAC systems for a particular building project. See <https://netenergyoptimizer.com/how-it-works>.

3. Despite the limited nature of Cross-Respondents' software, Cross-Respondents applied for and obtained registrations for marks for a much broader range of services.

4. On August 2, 2018, Cross-Respondent Weidt learned of Cross-Petitioner's NEO NETWORK mark.

5. A week later, on August 8, 2018, Cross-Respondent Weidt filed application Serial No. 88/074,385 for NEO for "providing on-line non-downloadable software for use in building and analyzing energy models" in Class 42.

6. Cross-Respondents' application for NEO (Ser. No. 88/074,385) matured into Reg. No. 5,964,643 on January 21, 2020, for "providing on-line non-downloadable software for use in building and analyzing energy models, excluding software in the fields of medical or genetic testing and medical or genetic research" in Class 42.

7. Cross-Respondents' broad description of services in Class 42 does not accurately describe the actual scope of Cross-Respondents' software under its NEO mark.

8. Cross-Respondents have used this inaccurately-broad description of services as a basis for their petition to cancel Cross-Petitioner's registration of NEO NETWORK. Although this inaccurately-broad description does not cause a likelihood of confusion with Cross-Petitioner's NEO NETWORK mark, if Cross-Respondents' registration was appropriately

narrowed, it would eliminate even the *possibility* of confusion between Cross-Respondents' NEO mark and Cross-Petitioner's NEO NETWORK mark.

**COUNT I – RESTRICTION UNDER SECTION 18 OF
THE TRADEMARK ACT, 15 U.S.C. § 1068**

9. Cross-Petitioner repeats and re-alleges Paragraphs 1-8 as though fully set forth herein.

10. On January 21, 2020, Cross-Respondent Willdan obtained a registration of NEO (Reg. No. 5964643) for "providing on-line non-downloadable software for use in building and analyzing energy models, excluding software in the fields of medical or genetic testing and medical or genetic research" in Class 42.

11. Cross-Respondents, however, are not using NEO for any services besides a web-based software program that calculates the cost-effectiveness of HVAC systems for a particular building project.

12. Accordingly, pursuant to Section 18 of the Trademark Act, 15 U.S.C. § 1068, Cross-Petitioner requests that Cross-Respondents' registration of NEO (Reg. No. 5,964,643) be amended to read "providing on-line non-downloadable software **only** for use in analyzing the cost-effectiveness of **HVAC systems in buildings**, excluding software in the fields of medical or genetic testing and medical or genetic research" in Class 42.

13. Cross-Petitioner submits that the foregoing restriction will eliminate even the possibility of confusion with Cross-Petitioner's NEO NETWORK registration as alleged by Cross-Respondents because Cross-Respondents are not using their mark on the goods and services, or related goods or services, that will be excluded from Cross-Respondents' registration if the proposed restriction is entered.

COUNT II – FRAUD ON THE PTO
ON THE BASIS OF KNOWN PRIOR REGISTRATION

14. Cross-Petitioner repeats and re-alleges Paragraphs 1-13 as though fully set forth herein.

15. On August 10, 2018, in Application No. 88/074,385, which matured into Registration No. 5,964,643, Cross-Respondent Weidt declared, through its representative James Douglas and under oath, that "[t]he mark is in use in commerce on or in connection with the goods/services in the application" and "[t]he signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements **and the like may jeopardize the validity of the application** or submission or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true."

16. This declaration was knowingly false because at the time Cross-Respondent Willdan filed Application Ser. No. 88/074,385, it was aware of Cross-Petitioner's application for and use of NEO NETWORK (Ser. No. 87/040,952).

17. The false declaration is material because without it Application Serial No. 88/074,385 would not have been allowed to register.

18. On information and belief, and (among other facts) in light of the fact that Cross-Petitioner Weidt filed its application for NEO (Ser. No. 88/074,385) when it was aware of Cross-Petitioner's claimed rights in NEO NETWORK and, indeed, had just learned of Cross-Petitioner's use of NEO NETWORK just 8 days prior to filing Ser. No. 88/074,385, Cross-Respondent Weidt knew that the declaration was false at the time it was made and Cross-Respondent Weidt made the false declaration with the intent to deceive the USPTO.

19. By such actions, Cross-Respondents defrauded the USPTO.

20. Cross-Petitioner would be damaged by Cross-Respondent Willdan's continued registration and claim of ownership of NEO (Reg. No. 5,964,643), as Cross-Respondents rely on the fraudulently-obtained registration of NEO as a basis to cancel Cross-Petitioners' NEO NETWORK registration.

**COUNT III – FRAUD ON THE PTO ON THE BASIS OF KNOWINGLY
FALSE CLAIMS OF USE FOR APPLIED-FOR SERVICES (Reg. No. 5,964,643)**

21. Cross-Petitioner repeats and re-alleges Paragraphs 1-19 as though fully set forth herein.

22. On August 10, 2018, in Application No. 88/074,385, which matured into Registration No. 5,964,643, Cross-Respondent Weidt declared, through its representative James Douglas and under oath, that "[t]o the best of the signatory's knowledge and belief, no other persons, except, if applicable, concurrent users, have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services of such other persons, to cause confusion or mistake, or to deceive" and "[t]he signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements **and the like may jeopardize the validity of the application** or submission or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true."

23. This declaration was false because at the time Cross-Respondent Willdan filed Application Ser. No. 88/074,385, it was aware that it did not use NEO for any services besides a web-based software program that calculates the cost-effectiveness of HVAC systems for a particular building project.

24. The false declaration is material because without it Application Serial No. 88/074,385 would not have been allowed to register and could not provide Cross-Respondent with the false appearance of prior rights in its NEO mark.

25. On information and belief, and (among other facts) in light of the fact that Cross-Petitioner Weidt filed its application for NEO (Ser. No. 88/074,385) when it was aware that it did not use NEO for any services besides a web-based software program that calculates the cost-effectiveness of HVAC systems for a particular building project and it was aware Cross-Petitioner's claimed rights in NEO NETWORK and, indeed, had just learned of Cross-Petitioner's use of NEO NETWORK just 8 days prior to filing (Ser. No. 88/074,385), Cross-Respondent Weidt knew that the declaration was false at the time it was made and Cross-Respondent Weidt made the false declaration with the intent to deceive the USPTO.

26. By such actions, Cross-Respondents defrauded the USPTO.

27. Cross-Petitioner would be damaged by Cross-Respondent Willdan's continued registration and claim of ownership of NEO (Reg. No. 5,964,643), as Cross-Respondents rely on the fraudulently-obtained registration of NEO as a basis to cancel Cross-Petitioners' NEO NETWORK registration.

Respectfully submitted,

PATTISHALL, McAULIFFE, NEWBURY,
HILLIARD & GERALDSON LLP

Dated: August 7, 2020

By: /Kristine Bergman/

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CERTIFICATE OF SERVICE

I, Kristine A. Bergman, hereby certify that a copy of the foregoing **ANSWER AND COUNTERCLAIMS TO AMENDED PETITION FOR CANCELLATION**, was electronically served to Timothy Sitzmann at TSitzmann@winthrop.com and Michael Olsen MOlsen@winthrop.com, Attorneys for Petitioners, The Weidt Group and Willdan Energy Solutions, on this 7th day of August, 2020.

/Kristine A. Bergman/