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

Proceeding no.	92070611
Party	Plaintiff Willdan Energy Solutions and The Weidt Group, Inc.
Correspondence address	MICHAEL T OLSEN WINTHROP & WEINSTINE PA 225 SOUTH SIXTH STREET SUITE 3500 MINNEAPOLIS, MN 55402 UNITED STATES Primary email: trademark@winthrop.com Secondary email(s): molsen@winthrop.com, tsitzmann@winthrop.com 612-604-6400
Submission	Reply in Support of Motion
Filer's name	Timothy D. Sitzmann
Filer's email	trademark@winthrop.com, molsen@winthrop.com, tsitzmann@winthrop.com, mmiller@winthrop.com
Signature	/TDS/
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

The Weidt Group, Inc.
Willdan Energy Solutions,
Petitioners,
v.

Cancellation No. 92070611

Schneider Electric USA, Inc.,
Respondent.

TO: Respondent, through its attorney Phillip Barengolts, of Pattishall, McAuliffe, Newbury, Hilliard & Geraldson LLP, 200 South Wacker Drive, Ste. 2900, Chicago, IL 60606

**PETITIONERS' REPLY BRIEF IN SUPPORT OF ITS
MOTION TO COMPEL AND TEST SUFFICIENCY**

In response to Petitioners' Motion to Compel and Test Sufficiency (the "Motion"), Schneider Electric USA, Inc. ("Respondent" or "Schneider") discuss a number of requests from Petitioners' First Set of Written Interrogatories and Requests for Production of Documents ("RFPs") (the "First Set"). Although Petitioners agree that many of Respondent's responses to the First Set were deficient, the Motion did not seek to compel answers to requests from the First Set. The Motion only addresses requests from Petitioners' Second Set of Interrogatories, RFPs, and Requests for Admission ("RFAs") and Petitioners' Third Set of RFAs.

Petitioners provided information regarding the First Set to give context to the Trademark Trial and Appeal Board (the "Board"). However, the only relief Petitioners requested regarding the First Set is that, as required by TBMP 408.03, Respondent supplement its responses if further discovery reveals that the responses to the First Set are incomplete or no longer accurate.

A. Petitioners' Motion Is Timely

Respondent argues Petitioners waited until after the close of discovery to file the Motion, implying that the Motion is untimely. A motion to compel discovery does not need to be filed during the discovery period. TBMP 523.03. Moreover, Respondent did not provide its document

production until November 11, 2021. Petitioners' and Respondent's counsel spoke over the phone and via email throughout November, December and January to try to resolve the concerns. [Sitzmann ¶26.] On Dec. 22, Respondent's counsel stated it would supplement its production. [Id. ¶27.] Petitioners chose not to file a Motion to Compel at that time in part because it appeared there was an opportunity to resolve the concerns without resorting to motion practice.

On Dec. 29, 2022, Petitioners served their Third Set of RFAs on Respondent. [Id. ¶31.] Petitioners suspected Respondent would again provide deficient responses to these requests and did not wish to file multiple motions related to discovery deficiencies. Petitioners' suspicions were confirmed when it received Respondent's responses to the Third Set of RFAs on Jan. 28, 2022. [Id. ¶35.] Within mere hours of receiving the responses, Petitioners wrote to Respondent identifying the deficiencies in a good faith effort to resolve the concerns, as required by the Trademark Rules. [Id.] Respondent's counsel did not respond to Petitioners' Jan. 28, 2022 email, or Petitioners' follow-up email. [Id. ¶ 36.] After multiple follow-ups from Petitioners, Schneider finally confirmed on Feb. 28, 2022 that Schneider would not provide amended responses. [Id. ¶37.] Petitioners filed this Motion a mere five business days later. The Motion is timely under the rules and, in any event, would have been filed earlier had Respondent not ignored Petitioners' attempts to resolve the dispute. Respondent cannot now object to the timing of the Motion when Respondent contributed to the delay and was not prejudiced. [Id. ¶¶35-37.]

B. Respondent Fails to Justify its Refusal to Search its own Records.

Schneider's Response fails to justify its failure to search its records with respect to Petitioners' Second Set of RFPs. Respondent's production was originally due on Oct. 22, 2021, but Respondent requested and Petitioners granted an extension of time. [Sitzmann ¶¶ 13, 14.] Respondent served its written responses on Oct. 29, 2021, but did not produce any documents

because, apparently, Schneider had yet to search its records. [Id. ¶21.] Petitioners emailed Respondent on Nov. 1 and again on Nov. 10 asking when documents will be produced. Finally, on Nov. 11, Respondent’s counsel produced sixteen website printouts that were created on Nov. 11, apparently by Respondent’s counsel. [Id. ¶¶20-22.]

In the Motion, Petitioners noted that “it does not appear that Schneider ever conducted a search of its records as part of its response to Petitioners’ second set of RFPs, in violation of TBMP 408.02.” [Motion at p. 9] Schneider’s silence with respect to this issue all but confirms this concern. Schneider’s failure to conduct a search justifies granting this Motion and ordering Schneider to comply with its discovery obligations by searching its records for documents responsive to the Second Set of RFPs and supplementing its responses as needed.

C. Schneider’s Allegation of Disproportionality Is Contrary to Black Letter Law

In its Response, Schneider argues that the issues before the Board are narrowly restricted because “Petitioners provide an online energy modeling tool for individual buildings” and “Schneider’s NEO NETWORK is a members-only renewable and clean energy marketplace.” [Response to Motion, p. 2.] Respondent argues that any discovery requests that are not restricted to Schneider’s narrow characterization of the parties’ services is disproportionate, irrelevant, and overly burdensome. However, Respondent ignores the fact that Petitioners’ pending application for the NEO mark has been refused registration based on a likelihood of confusion with Respondent’s NEO NETWORK registration. Respondent also ignores the broader scope of services identified in Petitioners’ pleaded common law rights and pending application, namely:

Software as a service (SAAS) services featuring software for use in analyzing, predicting, monitoring, managing, and optimizing energy usage for existing buildings and construction of new buildings, including mechanical systems, HVAC systems, power and electrical systems; Software as a service (SAAS) services featuring software for use in building and analyzing energy usage models in the field of energy and power efficiency and usage, including for use by utility

companies, engineers, architects, building owners, contractors, and equipment manufacturers; Consulting, engineering, technological planning, and research services in the field of energy efficiency, energy consumption, calculating energy costs, and energy design assistance

In Respondent's view, only Petitioners' registered services are relevant to the proceeding, and Petitioners' common law rights should be ignored. Yet simultaneously Respondent argues that Petitioners can only request discovery regarding Respondent's claim of what Respondent is actually offering, "a members-only renewable and clean energy marketplace," ignoring Respondent's own descriptions of its NEO NETWORK platform in press releases and in Respondent's NEO NETWORK trademark registration, which identifies a broader description.

All of Petitioners' discovery requests only seek information or documents concerning either (a) goods or services offered by Petitioners under its NEO mark; (b) goods or services provided by Respondent as part of the NEO NETWORK platform; or (c) goods or services that are contained with the description of goods and services for the NEO NETWORK registration. All of these categories of information are directly relevant to the proceeding under well-established law. *Johnston Pump/Gen. Valve Inc. v. Chromalloy Am. Corp.*, 10 USPQ2d 1671 (TTAB 1988) (services in a registration); TBMP 414 (11); *TBC Corp. v. Grand Prix Ltd.*, 16 USPQ2d 1399, 1400 (TTAB 1990) (whether one party provides the same or similar services as the other party, even under different marks, is relevant to establishing the relatedness).

D. Respondent Fails to Demonstrate the Requests are Overly Broad

For the first time, Respondent argues the phrase "energy efficiency solutions" in RFP No. 28 is "amorphous" and overly broad. In its original response, Respondent did not object that the phrase was vague, ambiguous, or otherwise objectionable. [Sitzmann Ex. 5.] In fact, Respondent agreed to produce responsive documents, waiving such an objection. [*Id.*] Moreover, during the parties' multiple discovery conferences and exchanges, Petitioners' counsel explained that the

phrase “energy efficiency” was a reference to efficient use of energy/electricity, as further demonstrated by Petitioners’ requests seeking information the extent to which Respondent provides goods and services through the NEO NETWORK platform to calculate current energy usage and analyze potential to reduce such usage; i.e., make it more efficient. [*See*, Sitzmann Ex. 5 (RFP Nos. 24, 28); Ex. 6 (RFA Nos. 33, 41, 45).]

With the foregoing “energy efficiency” exception aside, the Response to the Motion fails to provide the required specificity to support the objection that the Interrogatories and RFPs are overly broad and unduly burdensome. At best, Respondent argues that some of the requests are objectionable because (1) they include the word “all;” and (2) are irrelevant.

Although some of Petitioners’ requests contain the word “all,” each of these requests contains additional restrictive wording. For example, they limit the requests to cover information only within Respondent’s possession, and only in connection with services provided through the NEO NETWORK platform. The requests do not request information that is only in the possession of third parties. Specifically, each Interrogatory and RFP at issue falls within one of three categories, namely, information and documents within Schneider’s possession that:

- a) comprise the allegedly false statements and Petitioners’ alleged non-use of its NEO mark that form the basis of Schneider’s counterclaims for fraud and partial cancellation (Int. Nos. 19-26; RFP No. 27);
- b) demonstrates to what extent Schneider offers services through the NEO NETWORK platform that offer the same functionality as Petitioners’ services (Int. No. 30, 31, 32; RFP Nos. 22, 24, 28); or
- c) comprise services provided by Schneider on the NEO NETWORK platform that rely on the Station A technology (Int. 27, 30, 33, 34; RFP Nos. 23, 29).

These requests are narrowly tailored, and are directly relevant to the claims at issue in the proceeding. Indeed, it is difficult to understand how requests regarding the facts that comprise the elements of proof for Schneider’s counterclaims for fraud and partial cancellation could be

considered irrelevant. Likewise, requests inquiring whether one party offers services that have overlapping functionality are also relevant.

With respect to Station A, Schneider’s argument is an exercise in sleight of hand. A request concerning Schneider’s NEO NETWORK services do not become irrelevant merely because the services use technology developed by a third party. Schneider does not dispute that the services are provided through Schneider’s platform. [Sitzmann ¶34, Ex. 9 (RFA Nos. 46–52, 55).] Schneider does not dispute that the services are prominently branded and marketed to consumers under the NEO NETWORK mark. [Id., Ex. 9, RFA Nos. 51, 55).] Below is an excerpt from one of the few publicly available marketing materials that depicts how consumers interact with Schneider’s services behind the login screen. Respondent has admitted the accuracy of the screenshot as being part of Schneider’s YouTube account. [Id., Ex. 9, RFA No. 52]



NEO Network uses proprietary Station A technology to identify potential cost, energy, and carbon reduction measures at your sites. Opportunities are created using intelligently estimated cost, usage, and site information. These estimates can be improved with actual site data. Savings estimates presented are indicative and require additional validation. Recommended technologies currently include onsite solar and battery storage. Additional technologies will be added over time.

Additional examples of marketing statements and screenshots are shown in additional RFAs. [Id. RFA Nos. 46, 47, 48, 51, 52, 55.] The website makes clear that “**NEO Network** uses proprietary Station A technology to **identify potential cost, energy, and carbon reduction measures at your sites.**” [Id. Ex. 9, RFA No. 52.]

As these examples demonstrate, Schneider has integrated Station A technology into the services it provides under the NEO NETWORK mark, services which include “potential cost,

energy, and carbon reduction measures” as well as “saving estimates.” [Id. RFA No. 52.] Moreover, as identified in a release authenticated by Schneider, the Station A technology will be integrated into the NEO NETWORK platform such that “NEO Network members will seamlessly gain an independent view of onsite clean energy opportunities—without upfront data—for their buildings to accelerate their energy goals, estimate savings potential, and increase resilience on the journey to net zero.” [Id. RFA No. 48.] Even in its response to the Motion, Schneider admits that Petitioners’ goods and services, at a minimum, include “an online energy modeling tool for individual buildings.” [Response to Motion, p. 2.] Accordingly, Petitioners’ requests are relevant to whether Schneider’s goods and services are related to Petitioners’ services. Furthermore, Schneider’s website indicates that “[a]dditional technologies will be added over time” to these savings and energy usage calculators available. [Sitzmann Ex. 9, RFA No. 52.] Such expanded technologies are covered by the broad description in Respondent’s NEO NETWORK registration. Accordingly, the requests are also relevant to the extent they provide information regarding Schneider’s plans of expansion of functionality for its NEO NETWORK DER calculator and NEO NETWORK platform. TBMP § 414(8) (plans for expansion are discoverable).

Finally, Respondent did not produce a single document from Respondent’s possession in response to the Second Set of RFPs. [Sitzmann ¶¶ 20, 21.] Instead, Respondent produced a mere sixteen documents, all of which appeared to have been printed by Respondent’s counsel the day they were produced (three weeks after the original due date for the responses). [Id.] Respondent’s claim that throughout the proceeding it has produced “over 600 pages of documents,” is misleading because 373 pages are merely printouts from the USPTO application files for Petitioners’ and Respondent’s respective trademark applications, and the pleadings from

this proceeding. [*Id.* ¶¶ 8, 9.] The vast majority of the remaining documents are duplicative public website printouts and press releases. [*Id.* ¶¶ 8, 9, 12, 20, 21, 28, 42, 43]. In sum, Schneider has produced a mere 55 documents, only 20 of which are documents provided from Respondent's own records (as opposed to the USPTO database or public website printouts), including just one single email. [*Id.* ¶¶ 42, 43.] It is simply not credible that Respondent has just one responsive email in its possession. There may be times where it is difficult to determine when a request is overly burdensome, but this is not one of them. It is not burdensome or disproportional to expect a party to produce more than sixteen documents outside of USPTO records or third-party website printouts, even for a cancellation proceeding.

E. The Business Records and Representative Sample Exceptions Are Unavailable

With respect to Respondent's reliance on the business records exception under Section 33(d), Respondent continues to ignore that the exception is only available in limited circumstances. *Hewlett Packard Enter. Dev. LP v. Arroware Inds., Inc.*, 2019 WL 1970877 (TTAB 2019) [precedential] (citations omitted). Respondent does not even feign an attempt to meet the required elements regarding the burdens imposed by the request. *Id.* Respondent therefore cannot rely on the business record exception and must serve amended answers.

Respondent attempts to circumvent this by stating that some of its answers reference a document or two, or provides some limited information. However, this does not cure the deficiency of such open-ended answers because Petitioners have no way of knowing what Respondent's intended answer is, and whether there are additional relevant documents or information beyond what is listed.

Likewise, Respondent argues that Respondent only required to provide a representative sample of documents. However, reliance on a representative sample requires that "an explanation

must be made describing why the request is unduly burdensome. (For example, the responding party has tens of thousands of documents spanning decades.)” *E.g., Grupo Marti, S.A. Grupo Marti, S.A. v. Martis S.A.*, 2008 WL 9718104 (TTAB January 31, 2008). Respondent failed to do so here. Moreover, a total of 16 website printouts (with no internal documents) cannot be considered a truly representative sample in response to Petitioners Second Set of RFPs comprising nine requests that cover a fraud counterclaim, a partial cancellation counterclaim, and the likelihood of confusion claim. For example, RFP No. 25 requests screenshots to show Respondent’s use of the NEO NETWORK mark for the various functionalities of the mobile application and computer software listed in the Class 9 goods description for the NEO NETWORK registration; in response Respondent provided two screenshots of its website. [Sitzmann Ex. 5.] A website is not a mobile application nor computer software, making it difficult to understand how the documents are responsive, let alone a representative sample of all types of response screenshots.

F. Respondent’s Answers to the RFAs Remain Deficient

Respondent claims that it had to qualify its answers RFA Nos. 47 and 48 in order to specify upon which website the statement appears. Petitioners’ concerns with these answers is not that a URL was included, but that Respondent refuses to acknowledge that these are the Respondent’s own statements. The requests direct Respondent to “Admit that Respondent made the following statement on its website . . .” However, Respondent instead admitted only that “the statement is reflected on [the website].” This is significant because it may enable Respondent to argue the statement was not made by Respondent or was otherwise unauthorized.

With respect to RFA Nos. 49, 57, and 58, Respondent argues that “Petitioners include quoted language, but without identifying from where Petitioners copied the language.”

[Response to Motion, p. 15.] However, Petitioners specifically identified each URL from which the quoted language was found in the email serving Respondent with the Third Set of RFAs. A copy of this email is included as part of the Motion. [Sitzmann, Ex. 7.] The rules require Respondent to make a reasonable inquiry before it denies or qualifies an answer. TBMP 407.03(b). At a minimum, this obligation does not permit Respondent to ignore the information that was included in the email serving the RFAs on the Respondent. The RFAs requested whether these statements existed and Respondent cannot in good faith deny that such statements were made when Respondent was directly presented with evidence of such statements on Respondent's own websites. [Id.]

CONCLUSION

Petitioners have sought only to identify the facts and documents that support Respondent's allegations for fraud, partial cancellation, and that the parties' goods and services are unrelated. Yet Respondent has refused to search its own records, failed to provide direct answers to Interrogatories, and relied on boilerplate objections to RFPs to justify its hand-picked selection of a representative sample of documents. Such responses and objections fail to meet Respondent's discovery obligations. Accordingly, Petitioners respectfully request that the Board grant the relief requested in the Motion.

Respectfully submitted,

WINTHROP & WEINSTINE, P.A.

Dated: May 1, 2022

/Timothy D. Sitzmann/
Michael T. Olsen
Timothy D. Sitzmann
Megan M. Miller

ATTORNEYS FOR PETITIONERS
THE WEIDT GROUP, INC. and
WILLDAN ENERGY SOLUTIONS

CERTIFICATE OF SERVICE BY E-MAIL

Timothy Sitzmann, of the City of Minneapolis, County of Hennepin, in the State of Minnesota, says that on the 1st day of May, 2022, he served by e-mail, a true and correct copy of Petitioners' Reply in Support of the Combined Motion to Compel and Test Sufficiency, in the above-captioned matter to the following last known e-mail addresses of record for counsel for Schneider Electric USA, Inc., namely, pb@pattishall.com, JARA@pattishall.com, JGV@pattishall.com and docket@pattishall.com.

/s Timothy D. Sitzmann
Timothy D. Sitzmann

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