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

|                        |  |
|------------------------|--|
| Proceeding no.         | 92070611   |
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Registration No.: 5,638,377  
For the mark: NEO NETWORK

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Willdan Energy Solutions and the Weidt Group, Inc.

Petitioners,  
v.  
Schneider Electric USA, Inc.  
Registrant.

Cancellation No. 92070611

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**PETITIONERS' NON-CONFIDENTIAL TRIAL BRIEF**

Respectfully submitted,

WINTHROP & WEINSTINE, P.A.

Dated: March 8, 2024

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## **DESCRIPTION OF THE RECORD**

### **Operative Pleadings**

1. The Amended Petition for Cancellation (“Amended Pet.”) [15 TTABVUE 6, Ex. A.]
2. Respondent’s Answer to the Amended Pet. [18 TTABVUE 1.]

### **Evidence Automatically of Record**

1. The file of the subject registration for the NEO NETWORK mark.

### **Petitioners’ Evidence**

1. Petitioners’ Notice of Reliance (“NOR”) consisting of:
  - a. Petitioners’ Registration Nos. 4,429,793, 5,964,643 and associated maintenance filings [51 TTABVUE 13–33, NOR Exs. 1-3.]
  - b. Petitioners’ pending application Serial No. 88/839,323 for the NEO mark [51 TTABVUE 34, NOR Ex. 4.]
  - c. Office Actions issued by the U.S. Patent and Trademark Office (“USPTO”) in connection with Petitioners’ pleaded NEO application and for the subject registration [51 TTABVUE 38-82, NOR Exs. 5-8.]
  - d. Respondent’s responses to Petitioners’ written discovery requests, and supplemental and revised responses provided by Respondent after the Trademark Trial and Appeal Board (the “Board”) granted Petitioners’ Motion to Compel; 51 TTABVUE 98-153, NOR Exs. 11-18.]
  - e. Printout from Wikipedia regarding definition of “Energy Modelling;” [51 TTABVUE 154, Ex. 19.]

- f. Printouts and excerpts from Petitioners' website and marketing materials [51 TTABVUE 160-212, NOR Exs. 20-28.]
  - g. Printouts and excerpts third-party publications and websites. 51 TTABVUE 213-247, NOR Exs. 29-35.]
  - h. Printouts and excerpts of third-party publications and websites concerning awards, certifications, and publicity for Petitioners' NEO Marks; [51 TTABVUE 248-305, Exs. 36-50.]
  - i. Printouts and excerpts from websites and publications regarding Respondent's NEO NETWORK goods and services; [51 TTABVUE 306-348, NOR Exs. 51-62.]
  - j. Excerpts from Respondent's websites and publications regarding Respondent's energy modelling software and services; [51 TTABVUE 349-392, NOR Exs. 63-73.]; and
  - k. Printouts and excerpts from third-party publications demonstrating Respondent's Goods and Services and Petitioners' Services emanating from a single source; [51 TTABVUE 393-474, NOR Exs. 74-90.]
2. Confidential testimonial declaration of Jason Steinbock, Vice President of the NEO<sup>®</sup> business unit for Willdan. [49 TTABVUE 1, Declaration of Jason Steinbock ("Steinbock"), including exhibits comprising:
- a. Petitioners' Registrations [49 TTABVUE 25, 29, Exs. A-B.]
  - b. Petitioners' NEO Application [49 TTABVUE 32, Ex. C.]
  - c. Marketing materials for Petitioners' NEO services, namely, a case study of one client's use of the NEO services [49 TTABVUE 35, Ex. D.]
  - d. Third-party publications regarding Petitioners' certifications and partnerships [49 TTABVUE 38, 41, 50, Exs. E, F, G.]

- e. Publications from Petitioners' utility company clients marketing the NEO services. [49 TTABVUE 53-78, Exs. H-M.]
  - f. Examples of Petitioners' marketing brochures, mailers, and similar materials. [49 TTABVUE 79-90, Exs. N-Q.]
  - g. Third-party publications constituting unsolicited publicity for Petitioners' NEO services. [49 TTABVUE 91, 93, Exs. R, S.]
  - h. Third-party publications regarding awards and recognitions for Petitioners' NEO services. [49 TTABVUE 95, 98, Exs. T, U.]
  - i. Respondent's NEO NETWORK Registration. [49 TTABVUE 102, Ex. V.]
  - j. Screenshots and printouts from Respondent's website discussing the NEO NETWORK goods and services. [49 TTABVUE 105, Ex. W.]
  - k. Screenshots and printouts from Respondent's website advertising energy modelling software solutions. [49 TTABVUE 108, 112, Exs. X, Y.]
  - l. Screenshots from Respondent's website discussing the NEO NETWORK goods and services. [49 TTABVUE 115, Ex. Z.]
3. Declaration of Petitioners' counsel Timothy Sitzmann [53 TTABVUE 1.] and accompanying exhibits consisting of:
- a. Stipulation between the parties regarding introduction of documents produced by the parties in response to written discovery requests; [53 TTABVUE 7, Sitzmann Ex. 1.]
  - b. Documents produced by Respondent in response to Petitioners' written discovery requests [53 TTABVUE 8-42, Sitzmann Exs. 2-10.]

**Respondent's Evidence**

Respondent has not submitted any evidence in connection with the proceeding.



## **STATEMENT OF THE ISSUES**

Whether Respondent's NEO NETWORK mark is likely to cause confusion with Petitioners' (i) registered rights for its NEO<sup>®</sup> mark, (ii) registered rights for its NEO NET ENERGY OPTIMIZER mark, and/or (iii) Petitioners' pending application and prior common law rights for its NEO mark, which was refused registration by the US Patent and Trademark Office ("USPTO") based on a likelihood of confusion with Respondent's NEO NETWORK registration.

## INTRODUCTION

In early 2012, The Weidt Group, Inc. (“TWG”) developed an innovative software solution that provides significant capabilities for energy design assistance utilizing energy modelling, including software as a service for use in building energy models as well as analyzing, predicting, and optimizing energy usage for existing buildings and new building construction (the “NEO Platform”). At that same time, TWG began to offer a variety of consulting and similar services in the fields of clean technology, energy efficiency, building design, and other services to help their customers reduce their carbon emissions. Petitioners obtained federal registration number 4,429,793 for its NEO NET ENERGY OPTIMIZER® mark (the “793 Registration”), which issued on Nov. 5, 2013. [51 TTABVUE 14, NOR Ex. 1.]

On May 18, 2016, nearly three years after Petitioners received their first registration for its NEO NET ENERGY OPTIMIZER® mark, Respondent filed an application for the NEO NETWORK mark. The USPTO refused registration in three different Office Actions before eventually relenting and issuing a registration as Reg. No. 5,638,377 (“Respondent’s Registration”). Respondent’s Registration covers the following goods and services.

*Class 9: 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* (“Respondent’s Class 9 Goods”)

Class 35: *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* (“Respondent’s Class 35 Services”)

Class 42: *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* (“Respondent’s Class 42 Services”)

Respondent’s Class 9 Goods, Class 35 Services, and Class 42 Services are collectively referred to as “Respondent’s Goods and Services.”

Subsequently Petitioners filed an application for the mark NEO, which issued as registration number 5,964,643 on Jan. 21, 2020 (the “‘643 Registration”). The ‘793 Registration and the ‘643 Registration both identify the services as “*Providing on-line non-downloadable software for use in building and analyzing energy models*” (“Petitioners’ Registered Services”).

[51 TTABVUE 14, 23, NOR Exs. 1, 2.]

Petitioners also filed a second application for its NEO mark, which was assigned Serial No. 88/839,323 (the “‘323 Application”). The ‘323 Application was refused registration based on

Respondent's NEO NETWORK registration and has remained suspended for the past three years awaiting the disposition of this cancellation proceeding.

Petitioner TWG filed this Petition for Cancellation on Feb. 17, 2019. [1 TTABVUE 1.] A Notice of Default issued on May 30, 2019. [4 TTABVUE 1.] Respondent filed a Motion to Set Aside Default Judgment claiming Respondent had received the Notice of Default, but did not receive the Petition for Cancellation, even though the service copies of the Petition for Cancellation and the Notice of Default were sent to the same mailing address. [8 TTABVUE.] The Board granted Respondent's motion.

Willdan Energy Solutions ("Willdan") acquired TWG's ownership interest in the NEO mark and associated registrations and applications on March 8, 2019. [49 TTABVUE 4, Steinbock ¶ 4.] The Board granted a Motion to Join Willdan and accept an Amended Petition for Cancellation on July 8, 2020 (TWG and Willdan are collectively referred to herein as "Petitioners"). [17 TTABVUE, Board Order.]

The evidence shows the dominant portion of Respondent's mark is the NEO term, which is identical to Petitioners' NEO mark and identical to the dominant portion of Petitioners' NEO NET ENERGY OPTIMIZER mark (collectively, "Petitioners' NEO Marks"). The word NETWORK and the words NET ENERGY OPTIMIZER were all disclaimed by Respondent and Petitioners due to their descriptive meaning. Accordingly, the identical term NEO is the dominant and only distinctive element in Respondent's Mark and Petitioners' Marks. Indeed, Respondent even admits that customers often shorten its NEO NETWORK mark simply to "NEO." [51 TTABVUE 120, NOR, Ex. 13, RFA 29.] Accordingly, there is no legitimate dispute that Respondent's Mark and Petitioners' Marks create overall commercial impressions that are highly similar, if not identical.

Moreover, a simple review of the identification of goods and services descriptions confirms that the goods and services identified in Respondent's Registration overlap with the services identified in Petitioners' Registrations, Petitioners' Application, and Petitioners' common law rights. The record demonstrates that the actual use of the parties' respective marks confirms that this overlap exists in the real world. The record further demonstrates that any other goods and services identified in Respondent's Registration that do not overlap with Petitioners' services are closely related to Petitioners' services.

The evidence demonstrates that there is a likelihood of confusion based solely on the *du Pont* factors regarding the similarity of the marks and the relatedness of the goods and services. The likelihood of confusion is further exacerbated by the overlapping nature of the channels of trade and classes of consumers. Moreover, the likelihood of confusion is even greater in light of the strength of Petitioners' NEO Marks, which have significant conceptual strength and marketplace strength.

## **STATEMENT OF FACTS**

In early 2012, TWG developed a software program and web-based software service that provided significant capabilities for purposes of energy design assistance using energy modelling, including software as service for use in building and analyzing energy models, 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 (collectively, the “NEO Platform”). [49 TTABVUE 3-4, Steinbock ¶ 8.]

The NEO Platform is a powerful, easy-to-use energy modelling platform that enables building owners, architects, government entities, utility companies, and other users to optimize energy usage, save money, and meet decarbonization goals. [49 TTABVUE 6, Steinbock ¶ 17, 49.] Energy optimization often includes the use of energy modelling tools to review, aggregate, and analyze building energy and financial data. [49 TTABVUE 6, Steinbock ¶ 17.] These energy models help determine life-cycle costs, comparative performance, and efficiency design and construction decisions. [49 TTABVUE 6, Steinbock ¶ 17.] Any attempts to change a building’s energy usage must comply with federal, state, and local regulations and energy mandates. [49 TTABVUE 6, Steinbock ¶ 18.] Energy optimization software such as the NEO Platform enables users to maximize their resources through energy modelling to create a roadmap by identifying problem areas, generating recommendations for improvements, and maximizing productivity and return on investment. [49 TTABVUE 6, Steinbock ¶ 19.]

The NEO Platform has extensive data libraries and functionality. [49 TTABVUE 6-7, Steinbock ¶ 20-21.] The NEO Platform permits users to provide information regarding geographic locations, building types, room size, geographic location, and mechanical systems, such as heating, ventilation, and air conditioning (HVAC) systems. [49 TTABVUE 7, Steinbock ¶ 22.] The user can provide extensive customization, all the way down to details such as the hours the building is

open, the size of the space asset area, the height of the third floor, thermostat setpoints, the type of fryers, refrigerated areas, computer systems, and other equipment installed in the building, and more. [49 TTABVUE 7, Steinbock ¶ 22.] The NEO Platform takes this information and models a variety of potential energy-saving measures, covering architectural, mechanical and electrical concepts, as well as calculating net effect on energy use, energy costs, and potential program incentives, providing an optimal path to energy goals via usage, cost savings, and/or life-cycle cost analysis. [49 TTABVUE 8, Steinbock ¶ 23.]

In addition to providing software as a service comprising the NEO Platform, Petitioners also provide a variety of consulting, engineering, technological planning, and research services in the fields of energy efficiency, energy consumption, calculating energy costs, and energy design assistance. [49 TTABVUE 4, Steinbock ¶ 9.]

Petitioners' Registered Services are utilized for a variety of applications including energy efficiency, green energy ratings and audits, regulatory compliance, building design and construction, decarbonization efforts, environmental certifications, and other applications. [49 TTABVUE 9, Steinbock ¶ 27.] Petitioners' Registered Services also permit energy modelling for on-site solar photovoltaic ("PV") systems to predict energy production, cost, and environmental impact for PV solar systems. [49 TTABVUE 10, Steinbock ¶ 32.] Petitioners' Registered Services can predict energy usage and production to enable the user to plan for and achieve decarbonization, cost reduction, and energy efficiency goals. [49 TTABVUE 10, Steinbock ¶ 32.] Petitioners' Registered Services also contain functionality to review compliance with federal, state, and local regulations, as well as reporting requirements for green energy standards and credits. [49 TTABVUE 10-11, Steinbock ¶¶ 33-35.]

Petitioners filed an application to register the NEO NET ENERGY OPTIMIZER® mark on Aug. 23, 2012, that matured into the '793 Registration. [49 TTABVUE 4, Steinbock ¶ 10,

Ex. A.] On Aug. 10, 2018, Petitioners filed an application for the standalone NEO<sup>®</sup> mark, which matured into the ‘643 Registration. [49 TTABVUE 4, Steinbock ¶ 11, Ex. B.]

The ‘643 Registration for the NEO mark and the ‘793 Registration for the NEO NET ENERGY OPTIMIZER mark cover Petitioners’ Registered Services, namely, “*Providing on-line non-downloadable software for use in building and analyzing energy models.*” [51 TTABVUE 14, 23, NOR Exs. 1, 2.][49 TTABVUE 4, Steinbock ¶ 10-11, Ex. A, B.] The phrase “energy models” is an industry term that generally describes the process of creating computer models to model energy usage for purposes of analysis, testing, simulation, and predictions of a wide variety of data sets related to energy, including energy usage, energy efficiency, decarbonization, regulatory compliance, and other data inputs. [49 TTABVUE 5, Steinbock ¶ 15.]

In addition to the ‘793 Registration and the ‘643 Registration (collectively, “Petitioners’ Registrations”), Willdan filed an application for the NEO mark on March 18, 2020 that was assigned Serial No. 88/839,323 (“Petitioners’ Application”). [49 TTABVUE 4-5, Steinbock ¶ 12, Ex. C.] Petitioners’ Application identifies the following services in Class 42 “*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*” (the “‘323 Services”). [49 TTABVUE 4, Steinbock ¶ 12, Ex. C.]



Petitioners began offering Petitioners’ Registered Services and the ‘323 Services (collectively, “Petitioners’ Services”), including access to the NEO Platform, under the NEO® and NEO NET ENERGY OPTIMIZER® marks at least as early as July 19, 2012. [49 TTABVUE 8, Steinbock ¶¶ 24.] Petitioners have provided all of Petitioners’ Services under the NEO® and NEO NET ENERGY OPTIMIZER® marks continuously since 2012 through the present day. [49 TTABVUE 8, Steinbock ¶¶ 24.] Petitioners have provided all of Petitioners’ Services to a variety of customers including, without limitation, building and property owners, architects, engineers, utility companies, contractors, design professionals and consultants, manufacturers, governmental entities, and educational organizations. [49 TTABVUE 8-10, Steinbock ¶¶ 25, 36, 38.]

Petitioners’ Services provided under the NEO and NEO NET ENERGY OPTIMIZER marks have generated significant commercial success, increasing nearly ten-fold over the last decade from approximately [\$ ██████████] in 2013 to [\$ ██████████] in 2023. [49 TTABVUE 13, Steinbock ¶¶ 43.] The annual revenue for these years are set out in the table below:

| <b>Year</b> | <b>Revenue</b> |
|-------------|----------------|
| 2022        |                |
| 2021        |                |
| 2020        |                |
| 2019        |                |
| 2018        |                |
| 2017        |                |
| 2016        |                |
| 2015        |                |
| 2014        |                |
| 2013        |                |

[49 TTABVUE 13, Steinbock ¶¶ 43.]

Petitioners have also received a number of awards and recognitions, including receiving the 2021 Air Conditioning, Heating and Refrigeration (“AHR”) Expo Innovation Award for the software category, being endorsed by Green Business Certification Inc. (“GBCI”) as a Leadership in Energy and Environmental Design (“LEED”) Partnership program, and being identified in

Architect Magazine as the number one architecture firm for sustainability in 2014 and 2015 due to the use of the NEO Platform.<sup>1</sup> [49 TTABVUE 11, Steinbock ¶ 42.]

Petitioners have also invested significant amounts in marketing and advertising, with the annual marketing expenses attributable to the NEO Platform set out in the table below.

| <b>Year</b> | <b>Amount</b> |
|-------------|---------------|
| 2022        |               |
| 2021        |               |
| 2020        |               |
| 2019        |               |
| 2018        |               |
| 2017        |               |
| 2016        |               |
| 2015        |               |
| 2014        |               |
| 2013        |               |

[49 TTABVUE 13, Steinbock ¶ 44.]

Respondent filed application Serial No. 87/040,952 for the NEO NETWORK mark (“Respondent’s Application”) that matured into the subject registration of this cancellation proceeding on May 18, 2016 (“Respondent’s Registration”). This date is nearly four years after the Aug. 23, 2012 filing date for Petitioners’ ‘793 Registration. [49 TTABVUE 4, Steinbock ¶ 10, Ex. A.] It is also nearly four years after Petitioners’ first use in commerce of both the NEO and NEO NET ENERGY OPTIMIZER marks, which was at least as early as July 19, 2012. [49 TTABVUE 8, Steinbock ¶ 24.] Respondent’s Registration disclaims the term NETWORK.

Respondent’s Application was initially refused registration by the USPTO in a first Office Action on the basis that Respondent’s NEO NETWORK mark would create a likelihood of confusion with Petitioners’ ‘793 Registration for the NEO NET ENERGY OPTIMIZER mark. [51 TTABVUE 65-70, NOR Ex. 6.] The refusal was maintained in a Final Office Action, and a Denial

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<sup>1</sup> At the time, TWG was owned by architecture firm EYP. [49 TTABVUE 3, Steinbock ¶ 4.]

of Request for Reconsideration. [51 TTABVUE 71-82, NOR Exs. 7, 8.] In a Second Request for Reconsideration, Respondent deleted many of the goods and services from its application and submitted extrinsic evidence regarding the parties' respective goods and services that did not reflect the parties' actual goods and services. [Registration File.] In consideration of these amendments and arguments based on extrinsic evidence, the USPTO withdrew the refusal.

The services identified in Respondent's Registration directly overlap with Petitioners' Registered Services and the '323 Services. [49 TTABVUE 15, Steinbock ¶¶ 48, 49, 50.] Many of the consumers identified in Respondent's Registration are the same consumers that purchase Petitioners' Registered Services and the '323 Services, namely, companies, clean energy developers, building owners, utility companies, and government entities. [Registration File; 49 TTABVUE, Steinbock ¶¶ 17, 25, 36, 38, 49, 51.] Respondent has used its NEO NETWORK mark to advertise energy modelling solutions, for example as shown in the screenshot below.

Explore the NEO Network DER Calculator | Schneider Electric

[49 TTABVUE, Steinbock ¶¶ 55.] On another website, Respondent advertises a “NEO Network Strategy Calculator” that permits users to enter information regarding their energy consumption to analyze and predict energy usage, costs, and savings. [49 TTABVUE 21, Steinbock ¶¶ 57, Ex. Z.]

Respondent also provides a number of goods and services that also directly compete with Petitioners’ Services, including Petitioners’ Registered Services. [49 TTABVUE, Steinbock ¶¶ 52-57, Exs. W-Z; 51 TTABVUE 349-392, NOR Exs. 63-73.] These goods and services include products specifically marketed as “Building Energy Modelling” solutions, software “designed for building owners, operations, and maintenance . . . to comply with the emerging building energy codes and standards, achieve sustainability results and manage their increasingly essential energy

systems,” and software solutions to obtain “[m]ore accurate forecasts of building energy consumption.” [49 TTABVUE 14, Steinbock ¶¶ 52, 53, 54, Exs. W, X, Y.] There are also numerous third parties that provide both building energy modelling software or services on the one hand, and information on green/clean energy technology on the other hand. [51 TTABVUE 393-474, NOR Exs. 74-90.]

Petitioners’ Registrations, Petitioners’ Application, and Respondent’s Registration do not contain any express restrictions to the channels of trade. [49 TTABVUE 4, Steinbock ¶¶ 10-12, Exs. A, B, C.] Petitioners’ Services are marketed through similar channels of trade as the goods and services identified in Respondent’s Registration. [49 TTABVUE 22, Steinbock ¶ 60.] Respondent and Petitioners regularly attend many of the same trade shows and conferences. [49 TTABVUE 22, Steinbock ¶ 61, 62.]

Respondent’s marketing efforts frequently highlight the term NEO apart from the term NETWORK. In fact, Respondent’s own website and Respondent’s director responsible for the NEO NETWORK services often refer to NEO NETWORK simply as “NEO.” [51 TTABVUE 307, 321, 344, NOR Exs. 51<sup>2</sup>, 55<sup>3</sup>, 61<sup>4</sup>.] Third-party publications regularly shorten NEO NETWORK to “NEO.” [51 TTABVUE 307-08, 313-14, 326, 344-45, 347-48, NOR Exs. 51<sup>5</sup>, 53<sup>6</sup>, 56<sup>7</sup>, 61<sup>8</sup>, 62<sup>9</sup>.] Respondent even admitted that its own customers sometimes “shorten the mark to ‘NEO’.” [51 TTABVUE 120, NOR Ex. 13, RFA 29.] Respondent’s logo that is used consistently

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<sup>2</sup> “What we’ve done through NEO is ....”

<sup>3</sup> “NEO has become an incubator...”

<sup>4</sup> “What NEO deals with...”

<sup>5</sup> “NEO includes data...” and “Hoekstra says NEO is building on...”

<sup>6</sup> “NEO brings together;” “NEO is a virtual community;” and “NEO members can.”

<sup>7</sup> “NEO provides corporate buyers...” and “NEO aims to accelerate the transition.”

<sup>8</sup> “NEO has three elements;” “NEO is not the only organization;” and “NEO’s public launch.”

<sup>9</sup> “The NEO platform gives renewable energy stakeholders access...;” “What sets NEO apart is...;” “NEO is offered through Schneider Electric’s...;” NEO has been in development...;” and “NEO is available for an annual subscription fee...”

throughout its website and most marketing materials likewise emphasizes the term NEO apart from the term “Network,” utilizing much larger font and more noticeable dark blue color, as shown in the excerpt below.



[51 TTABVUE 316-17, 325, NOR Exs. 54, 56.]

## ARGUMENT

### **I. PETITIONERS HAVE ESTABLISHED STANDING AND PRIORITY.**

Petitioners have made their pleaded registration numbers Reg. No. 4,429,793 for the NEO NET ENERGY OPTIMIZER mark and Reg. No. 5,964,643 for the NEO mark of record. [See 15 TTABVUE, Amended Pet., Exs. A-C; 51 TTABVUE 14-31, NOR, Exs. 1-2.] Petitioners have also established prior common law rights in its NEO mark in connection with a variety of software services, consulting services, information services, and similar services in the fields of energy efficiency, cost reduction, green and clean energy, decarbonization efforts, regulatory compliance, and similar fields, as further embodied by Petitioners' pleaded application Serial No. 88/839,323 for the NEO mark. [49 TTABVUE 6, Steinbock ¶¶ 24, 25.] Therefore, Petitioners have established standing to petition to cancel Respondent's Registration. *Cunningham v. Laser Golf Corp.*, 55 U.S.P.Q.2d 1842, 1844 (Fed. Cir. 2000).

Respondent's Application for the NEO NETWORK mark was filed on an intent-to-use basis on May 18, 2016. Respondent has stated in response to Petitioners' Int. No. 1 that Respondent's date of first use in commerce was July 26, 2016. [51 TTABVUE 97, NOR Exs. 11.] Petitioners' '793 Registration issued before Respondent's filing date and Respondent's earliest date of first use. [See 15 TTABVUE, Amended Pet., Exs. A-C; 51 TTABVUE 13, NOR, Exs. 1-2.] Accordingly, Petitioners have established priority based on their prior registration for the NEO NET ENERGY OPTIMIZER mark.

Petitioners have also demonstrated through testimony and supporting documentation that Petitioners have continuously used the NEO mark in connection with Petitioners' Services since at least as early as 2012. [49 TTABVUE 3, Steinbock ¶¶ 8, 22, 24, 42<sup>10</sup>, 58; Ex. U.] Petitioners'

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<sup>10</sup> The award was received in 2015 and the associated article published on September 15, 2015, before Respondent's filing date and earliest first use date.

significant revenue and marketing spend further demonstrate widespread use of Petitioners' marks from 2013 through the present day. [49 TTABVUE 13, Steinbock ¶¶ 43, 44.]

Accordingly, Petitioners have established priority over Respondent based on Petitioners' prior use and registration of Petitioners' NEO Marks in connection Petitioners' Registered Services and the '323 Services. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 182 U.S.P.Q. 108, 110 (C.C.P.A. 1974).

## **II. RESPONDENT'S NEO NETWORK MARK IS LIKELY TO CAUSE CONFUSION WITH PETITIONERS' NEO<sup>®</sup> AND NEO NET ENERGY OPTIMIZER<sup>®</sup> MARKS.**

Section 2(d) of the Lanham Act prohibits registration of a mark on the Principal Register that would create a likelihood of confusion with a prior registered mark, or with a party's prior common law rights. 15 U.S.C. § 1052(d). The factors the Board considers in determining a likelihood of confusion are set out in *In re E.I. du Pont de Nemours & Co.*, 177 U.S.P.Q. 563 (C.C.P.A. 1973). The relevance and weight to be given the various factors may differ from case to case, and the Board is not required to consider every *du Pont* factor. *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 73 U.S.P.Q.2d 1350, 1353 (Fed. Cir. 2004). Nevertheless, key considerations are the similarities between the marks and the relatedness of the goods and services recited in the parties' registrations and application. *Mattel Inc. v. Funline Merch. Co.*, 81 U.S.P.Q.2d 1372, 1374 (T.T.A.B. 2006).

Here, the record contains evidentiary support for the *du Pont* factors regarding (A) similarity of the marks; (B) the overall strength of Petitioners' NEO<sup>®</sup> and NEO NET ENERGY OPTIMIZER<sup>®</sup> marks; (C) overlapping channels of trade and overlapping class of consumers; and (D) relatedness of the parties' respective goods and services.

In determining whether likelihood of confusion exists, all doubts must be resolved in favor of the senior user. *Nina Ricci S.A.R.L. v. E.T.F. Enter., Inc.*, 12 U.S.P.Q.2d 1901, 1904 (Fed. Cir.



1989). This is because the newcomer has the opportunity of avoiding confusion and is charged with the obligation to do so. *See In re Shell Oil Co.*, 26 U.S.P.Q.2d 1687, 1691 (Fed. Cir. 1993); *In re G.B.I. Tile & Stone, Inc.*, 92 U.S.P.Q.2d 1366, 1372 (T.T.A.B. 2009).

In the present case, the relevant *du Pont* factors readily establish that Respondent's NEO NETWORK mark is likely to cause confusion with Petitioners' NEO and NEO NET ENERGY OPTIMIZER marks.

**A. Petitioners' NEO Marks Create the Same Commercial Impression as Respondent's NEO NETWORK Mark.**

To determine whether two marks are similar for purposes of assessing a likelihood of confusion, the Board will consider the appearance, sound, connotation, and overall commercial impression of each mark. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 73 U.S.P.Q.2d 1689, 1692 (Fed. Cir. 2005). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *In re Binion*, 93 U.S.P.Q.2d 1531, 1534 (T.T.A.B. 2009). When comparing marks, "[t]he proper test is not a side-by-side comparison of the marks, but instead 'whether the marks are sufficiently similar in terms of their commercial impression' such that [consumers] who encounter the marks would be likely to assume a connection between the parties." *Coach Servs., Inc. v. Triumph Learning LLC*, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012); TMEP 1207.01(b). When the goods or services at issue are closely related, as is the case here, less similarity between the marks is necessary to support a finding of likelihood of confusion. *In re Mighty Leaf Tea*, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010).

1. NEO Compared to NEO NETWORK.

Petitioners' NEO<sup>®</sup> mark creates the same commercial impression as Respondent's NEO NETWORK mark. The term NEO in both marks is identical in sight. [18 TTABVUE 5, Amended

Answer ¶ 35.] The term NEO in both marks is identical in sound. [Id.] The term NEO in both marks is identical in meaning, because no evidence in the record suggests that the term NEO is defined to have multiple different meanings that change depending on the context in which the term appears. Respondent has admitted that the only difference between Petitioners' NEO mark and Respondent's NEO NETWORK mark is the addition of the term NETWORK. [51 TTABVUE 120, NOR Ex. 13, RFA 28.] These factors all demonstrate that the overall commercial impression created by both marks is identical.

The addition of the descriptive and disclaimed term NETWORK does not change the fact that the NEO and NEO NETWORK marks create the same or at least highly similar overall commercial impression. Likelihood of confusion cannot be avoided between otherwise confusingly similar marks merely by adding a term. *E.g., In re Mighty Leaf Tea*, 94 U.S.P.Q.2d at 1260-61. If the dominant portion of both marks is the same, then the marks are confusingly similar notwithstanding the peripheral differences. *Id.*

Consumers' natural impulse is to focus on the first word in a trademark. *See, e.g., Palm Bay Imps., Inc.*, 73 U.S.P.Q.2d at 1692 (VEUVE ROYALE and two VEUVE CLICQUOT confusingly similar because "VEUVE . . . remains a 'prominent feature' as the first word in the mark and the first word to appear on the label"); *Century 21 Real Estate Corp. v. Century Life of Am.*, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (CENTURY 21 and CENTURY LIFE OF AMERICA confusingly similar because "consumers must first notice [the] identical lead word"). The word NETWORK in Respondent's mark is merely descriptive of Respondent's goods and services and was disclaimed by Respondent. [49 TTABVUE 14 Steinbock ¶ 46, Ex. V.] Therefore, the term NETWORK does not change the overall impression as compared to Petitioners' NEO mark. *See, e.g., In re Dixie Rests., Inc.*, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997) (affirming the Board's finding that "DELTA," not the disclaimed term "CAFE," is the dominant portion of the

mark THE DELTA CAFE). Thus, the marks are confusingly similar because consumers are likely to perceive both marks as NEO.

Moreover, the incorporation of an entire mark further increases the similarity of the two marks at issue. *See, e.g., Glamorene Prods. Corp. v. The Procter & Gamble Co.*, 190 U.S.P.Q. 543 (C.C.P.A. 1976) (BOUNCE and BOUNCE BACK confusingly similar); *Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc.*, 188 USPQ 105, 106 (C.C.P.A. 1975) (BENGAL LANCER and design and BENGAL confusingly similar); *In re Integrated Embedded*, 120 USPQ2d 1504, 1513 (T.T.A.B. 2016) (finding BARR GROUP and BARR confusingly similar); *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1090 (T.T.A.B. 2016) (finding JAWS DEVOUR YOUR HUNGER and JAWS confusingly similar). In the present case, the entirety of Petitioners' NEO mark is incorporated into Respondent's NEO NETWORK mark. This further establishes that the NEO and NEO NETWORK marks create highly similar overall commercial impressions.

Additionally, it is widely recognized that consumers frequently shorten marks to the initial term. *See In re Abcor Dev. Corp.*, 200 U.S.P.Q. 215, 219 (C.C.P.A. 1978) (Rich, J., concurring: "the users of language have a universal habit of shortening full names -- from haste or laziness or just economy of words"); *In re SL&E Training Stable Inc.*, 88 U.S.P.Q.2d 1216, 1219 (T.T.A.B. 2008). Respondent's own use of the NEO NETWORK mark demonstrates that it is not merely possible that consumers will shorten "Neo Network" to "Neo," but that this shortening is already happening. Respondent itself shortens its NEO NETWORK mark to NEO in its marketing materials. [51 TTABVUE 321, NOR Ex. 55.] Respondent's website refers to Neo Network as "NEO." [51 TTABVUE 321, NOR Ex. 55.] Third-party publications refer to the "Neo Network" as "NEO." [51 TTABVUE 307-08, 313-14, 326, 344-45, 347-48, NOR Exs. 53, 56, 61, 62.] Even Respondent's director in charge of the Neo Network business repeatedly and frequently refers to "Neo Network" as "NEO." [51 TTABVUE 308, 342, 344, 347, NOR Exs. 51, 60, 61, 62.] In light

of the foregoing, it is no surprise that Respondent's customers also refer to "Neo Network" as "NEO." [51 TTABVUE 120, NOR Ex. 13, RFA 29.] This evidence confirms that when a prospective customer encounters the "Neo Network" mark, they will remember, refer to, and understand the mark simply as "Neo." Accordingly, the two marks create the same commercial impression, all to the detriment and damage of Petitioners.

Furthermore, the USPTO reached this same conclusion. Petitioners' Application for the NEO mark in Class 42 was refused registration based on a likelihood of confusion with Respondent's Registration for the NEO NETWORK mark. [51 TTABVUE 39-64, NOR Ex. 5.] Respondent's Registration will continue to prevent Petitioners from registering their NEO mark in connection with the '623 Services unless and until Respondent's Registration is cancelled.

Accordingly, Respondent's NEO NETWORK marks creates an overall very similar, if not identical, commercial impression as Petitioners' NEO mark set forth in its '643 Registration and common law rights in the NEO mark dating back to 2012, as embodied in Petitioners' Application.

## 2. NEO NET ENERGY OPTIMIZER Compared to NEO NETWORK.

As established above, the term NEO is the dominant element of Respondent's NEO NETWORK mark. Likewise, the term NEO is the dominant element of Petitioners' NEO NET ENERGY OPTIMIZER mark. Like the term "network," the additional wording NET ENERGY OPTIMIZER is descriptive and has been disclaimed by Petitioners. [51 TTABVUE 14, NOR Ex. 1.] Therefore, these descriptive, disclaimed terms do not affect the commercial impression of the marks created by the shared, identical, dominant term NEO. *In re Dixie Rests., Inc.*, 41 USPQ2d at 1533-34 (concluding DELTA is the dominant element of THE DELTA CAFÉ mark).

Furthermore, the USPTO agrees that these marks are confusingly similar. Respondent's NEO NETWORK mark initially received a Section 2(d) likelihood of confusion refusal on the

basis of Petitioners' NEO NET ENERGY OPTIMIZER mark in an Initial Office Action. [51 TTABVUE 66-70, NOR Ex. 6.] The USPTO maintained the 2(d) refusal in a Final Office Action. [51 TTABVUE 72-77, NOR Ex. 7.] The USPTO again maintained the 2(d) refusal in a denial of a Request for Reconsideration. [51 TTABVUE 79-82, NOR Ex. 8.]. The Examiner only approved Respondent's NEO NETWORK mark for registration after having two phone calls with Respondent on December 8, 2017, and January 5, 2018, and only after reviewing the extrinsic and misleading evidence submitted by Respondent regarding the scope of Respondent's and Petitioners' respective goods and services. [Registration File, Dec. 8, 2017 and Jan. 5, 2018 Notations to File.]

The Examiner's decision to withdraw the refusal was a mistake. The addition of descriptive terms does not change the fact that the marks share the identical, dominant term NEO. Indeed, as established above, consumers frequently shorten marks to the initial dominant term, and the evidence of record demonstrates that this has already occurred with the parties' respective marks. [E.g., 51 TTABVUE 120, NOR Ex. 13, RFA 29.] *See, e.g., In re Abcor Dev. Corp.*, 200 U.S.P.Q. at 219.

Accordingly, the NEO NETWORK mark creates a highly similar, if not identical, commercial impression as Petitioners' NEO NET ENERGY OPTIMIZER mark. Therefore, the similarity of the marks factor heavily favors a finding of a likelihood of confusion.

**B. Strength of Petitioners' NEO<sup>®</sup> and NEO NET ENERGY OPTIMIZER<sup>®</sup> Marks.**

In determining the strength of a mark, consideration is given to a mark's inherent strength based on the nature of the mark itself and its commercial strength based on the marketplace recognition of the mark. *See In re Chippendales USA, Inc.*, 96 U.S.P.Q.2d 1681, 1686 (Fed. Cir. 2010) ("A mark's strength is measured both by its conceptual strength (distinctiveness) and its

marketplace strength (secondary meaning).”); *Top Tobacco, L.P. v. North Atlantic Operating Co., Inc.*, 101 U.S.P.Q.2d 1163, 1171-72 (T.T.A.B. 2011) (same).

NEO<sup>®</sup> and the NEO portion of the NEO NET ENERGY OPTIMIZER mark for Petitioners’ Services is an arbitrary term. An arbitrary term is strong and entitled to a “broad scope of protection.” *In re Opus One Inc.*, 60 U.S.P.Q.2d 1812, 1813 (T.T.A.B. 2001). Although Petitioners derived NEO from the phrase “net energy optimizer,” acronyms are never descriptive unless the acronym is substantially synonymous with the underlying wording. TMEP 1209.03(h); *Modern Optics Inc. v. The Univis Lens Co.*, 110 USPQ 293, 295 (C.C.P.A. 1956). The record contains no evidence that the term NEO is descriptive, or that the acronym is substantially synonymous with the phrase “net energy optimizer.” Therefore, NEO<sup>®</sup> falls in the arbitrary marks category, which receives the second broadest scope of protection on the spectrum of distinctiveness. *Opus One Inc.*, 60 U.S.P.Q.2d at 1813.

In 2013, Petitioners’ gross revenue for Petitioners’ Services was [\$██████████]. 49 TTABVUE, Steinbock ¶ 43.] Petitioners’ revenue approximately doubled year-over-year for the next four years, reaching [\$██████████] in 2016. [Id.] This repeated, significant growth demonstrates significant commercial success. Petitioners’ revenue has remained significant, averaging approximately [\$██████████] over each of the last five years. [Id.] Additionally, over the last five years, Petitioners have spent [\$██████████] on advertising and marketing Petitioners’ Services under the NEO Marks. [Id. ¶ 20.] Petitioners’ commercial success is also reflected in the numerous awards, partnerships and certifications received, and the unsolicited publicity it has received. [49 TTABVUE, Steinbock ¶¶ 34, 35, 36, 42, Exs. F, G, R, S, T, U; 51 TTABVUE NOR, Exs. 35-50.]

The conceptual strength of Petitioners’ NEO<sup>®</sup> Marks coupled with the commercial success generated over the last 10 years results in a conceptually and commercially strong mark that is

entitled to a broad scope of rights. Accordingly, this factor favors a finding that a likelihood of confusion exists.

**C. Overlap of Channels of Trade and Class of Consumers.**

“If [a] registration or [an application] describes goods or services broadly, and there is no limitation as to their . . . channels of trade or class of purchasers, it is presumed that the registration [or application] encompasses all goods or services of the type described, that they move in all normal channels of trade, and that they are available to all classes of purchasers.” TMEP 1207.01(a)(iii). The Board will not read into a registration or application a restriction that does not appear on the face of the registrations. *See In re Thor Tech, Inc.*, 90 U.S.P.Q.2d 1634, 1638 (T.T.A.B. 2009).

The identification of goods and services descriptions in Respondent’s Registration include broadly worded language without any express limitation as to channels of trade or classes of consumers. Likewise, Petitioners’ identification of services descriptions for Petitioners’ Registrations and Petitioners’ Application are broadly worded without any limitation as to channels of trade or classes of consumer. [15 TTABVUE, Amended Pet., Exs. A-C; 51 TTABVUE, Petitioners’ NOR, Exs. 1-2.] A portion of Respondent’s services description refers to some potential customers, namely, “companies, clean energy developers, building owners, utilities, and government entities.” However, these same potential customers are expressly identified in Petitioners’ Application, and the record establishes that these are also the normal and actual customers for Petitioners’ Registered Services. [*Id.*; 49 TTABVUE, Steinbock ¶¶ 49, 51, 59.] The record also establishes that the normal channels of trade for Respondent’s Goods and Services and Petitioners’ Services overlap. [49 TTABVUE, Steinbock ¶¶ 60-62.] Accordingly, Petitioners and Respondent have overlapping channels of trade and overlapping classes of consumers.

**D. Relatedness of the Goods and Services.**

The nature, scope, and similarity of the goods and services must be determined based on the identification of goods and services listed in the relevant registrations. *Coach Servs.*, 101 USPQ2d at 1722. The goods or services at issue need not be identical or directly competitive but instead merely “related in some manner and/or if the circumstances surrounding their marketing [be] such that they could give rise to the mistaken belief that [the goods or services] emanate from the same source.” *Id.*, at 1722.

Here, the *du Pont* factor regarding relatedness of the goods and services weighs heavily in favor of a likelihood of confusion because (1) Respondent’s Goods and Services comprise energy modelling services that are competitive with Petitioners’ Registered Services; (2) Petitioners’ Services overlap with Respondent’s Goods and Services; and (3) it is common for a single source to provide both parties’ respective goods and/or services.

1. Respondent’s Goods and Services directly compete with Petitioners’ Services.

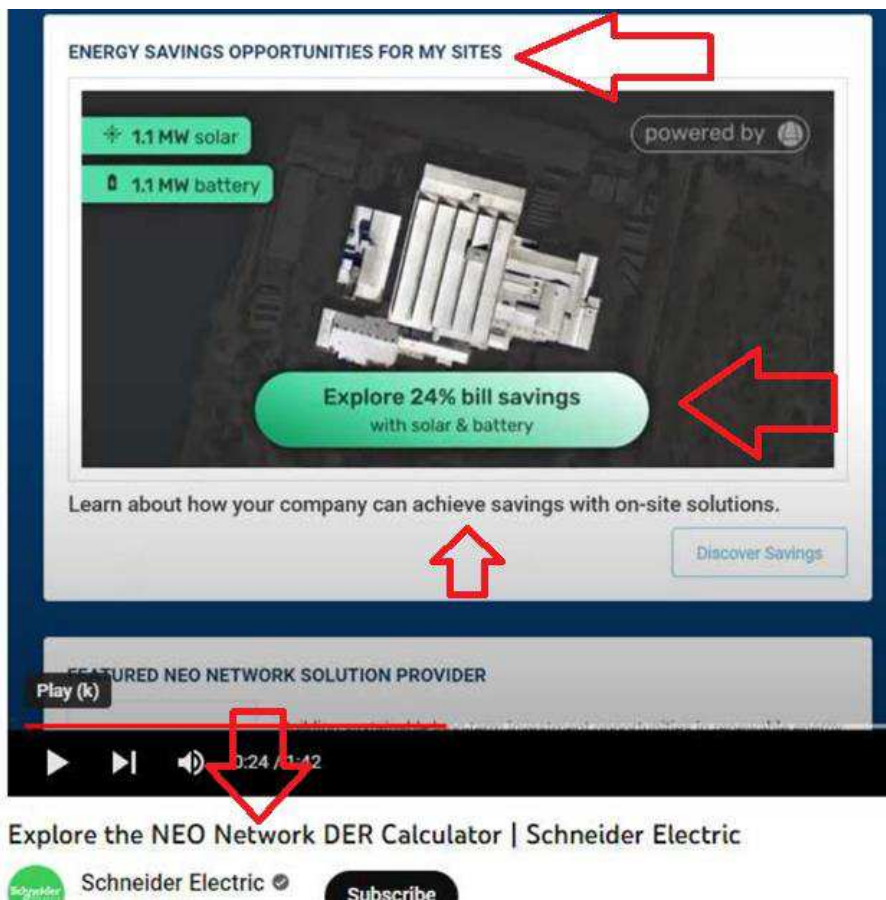
Respondent added the exclusionary phrase “not for use in building and analyzing energy models” to its Class 42 Services to finally convince the USPTO to withdraw the refusal based on Petitioners’ NEO NET ENERGY OPTIMIZER mark. Notwithstanding this, Respondent’s Class 9 Goods and Class 35 Services do not include exclusionary language. More importantly, Respondent’s exclusion in Class 42 is not accurate. All of Respondent’s Goods and Services utilize software and platforms that build and analyze energy models in order to provide the information services identified in Respondent’s Class 42 Services. [49 TTABVUE 16-21, Steinbock ¶¶ 55-57]

Numerous documents and screenshots demonstrate that Respondent’s Goods and Services include use of energy modelling tools to analyze, calculate, and generate strategies to reduce energy use and energy costs. One particular press release described Respondent’s Goods and Services with the following statement:



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.

[51 TTABVUE, NOR Ex. 15, RFA 45.] Screenshots of the foregoing statement and other screenshots of Respondent’s provision and advertising of Respondent’s Goods and Services under Respondent’s Mark are reproduced below. [52 TTABVUE, Steinbock ¶ 55.]



# Discover Savings Opportunities for My Sites

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.

## Select Sites to Review (step 1 of 3)

Click on one of your locations below to see additional details about the opportunity.

### SITES YOU ARE REQUESTING:

No sites selected yet.

Waiting for cache

0:31 / 1:42

### Explore the NEO Network DER Calculator | Schneider Electric

Schneider Electric 176K subscribers [Subscribe](#)

Go Back

YOUR RECOMMENDATION FOR  
**6255 Halle Drive**  
Valley View, OH 44125-4615

+ 380 kW



Explore 13% bill savings  
with solar.

Play (k)

0:39 / 1:42

### SITES YOU ARE REQUESTING:

No sites selected yet.

### Explore the NEO Network DER Calculator | Schneider Electric

Click on one of your locations below to see additional details about the opportunity.

| Location  | Bill Savings | Energy Savings |
|---|--------------|----------------|
| 1660 Scenic Avenue<br>Costa Mesa, CA 92626-1410       | -24%         | -57%           |
| 152 Fairgrounds Road<br>South Knaptown, RI 02892-1511 | -25%         | -64%           |
| 7801 Northern Pass Drive<br>El Paso, TX 79911         | -17%         | -100%          |
| 70 Mechanic Street<br>Foxborough, MA 02035            | -14%         | -49%           |
| 6255 Halle Drive<br>Valley View, OH 44125-4435        | -13%         | -44%           |
| 38 Neponset Avenue<br>Foxborough, MA 02035            | -12%         | -39%           |
| 235 Burgess Road<br>Greensboro, NC 27409-9778         | -10%         | -100%          |
| 1601 Northwestern Drive<br>El Paso, TX 79912-8024     | -9%          | -100%          |
| 600 Federal Street<br>Andover, MA 01810-1044          | -            | -              |
| 6755 College Corner Pike<br>Gainesville, TX 78705     | -            | -              |

**YOUR LIST OF SITES FOR THIS INQUIRY:**

- 6255 Halle Dr, Valley View, OH 44125, USA
- 38 Neponset Ave, Foxborough, MA 02035, USA

Select the addresses above for which you'd like to receive more information about the opportunity. Add more addresses by selecting the locations from the list at left.

[52 TTABVUE Steinbock ¶ 55.] These screenshots confirm that the information provided through Respondent's Goods and Services utilize energy modelling and analyses to calculate energy costs, energy savings, and predictions for decarbonization efforts using solar power installations. These capabilities are precisely the same functionality as Petitioners' Registered Services, as well as Petitioners' Services that have been provided under Petitioners' NEO Marks since at least as early as 2012, and identified in Petitioners' Application. [52 TTABVUE 10, 21, Steinbock ¶¶ 32, 56.]

Respondent has also advertised the "NEO Network Strategy Calculator" portion of Respondent's Goods and Services at a now-removed website with the URL <https://www.myrenewablestrategy.com/>. [52 TTABVUE Steinbock ¶ 57.] The website advertised a service whereby users can input their electricity consumption information to generate predicted costs and potential savings with respect to energy usage and costs. [52 TTABVUE Steinbock ¶ 57.] Respondent's statements on this website further establish that Respondent's Goods and

Services specifically rely on energy modelling software, just like the NEO Platform. [52 TTABVUE Steinbock ¶ 57.] Therefore, Respondent’s Goods and Services overlap in function and purpose with Petitioners’ Services, including Petitioners’ Registered Services.

In fact, documents describing the NEO Network calculator that were produced as “attorney’s eyes only” describe in more detail this software and the business and technology information generated by such software. [52 TTABVUE 15, Sitzmann Ex. 2.] Specifically, [REDACTED]

[REDACTED] [52 TTABVUE 15, Sitzmann Ex. 2.] [REDACTED]

[REDACTED]. [49 TTABVUE 10, Steinbock ¶ 32.] [REDACTED]

[REDACTED]. [52 TTABVUE 15, Sitzmann Ex 2.] [REDACTED]

[REDACTED] [49 TTABVUE 7, Steinbock ¶ 22.] [REDACTED]

[REDACTED] [52 TTABVUE 15, Sitzmann Ex 2.] [REDACTED]

[REDACTED] [49 TTABVUE 7, Steinbock ¶ 22.]

Furthermore, Respondent admitted Respondent’s Goods and Services provide the same information and functionality as Petitioners’ Services. Specifically, Respondent admitted that Respondent’s Goods and Services (i) can be used to “to make some decisions about energy usage” [51 TTABVUE, NOR Ex. 13, RFA 3.]; (ii) include information and software about “energy savings,” “energy efficiency,” “energy use,” “reduction of energy use,” and “energy sustainability.” [51 TTABVUE, NOR Ex. 13, RFAs 4, 5, 6, 10.] Respondent further admitted that

Respondent's Goods and Services provide information to assist users "to improve their decarbonization measures for buildings," to obtain information "on the geospatial characteristics of buildings," "to estimate energy savings potential for buildings," and "to analyze potential energy savings through onsite clean energy solutions." [51 TTABVUE 132-134, NOR Ex. 15, RFAs 37, 40, 41, 43.] All of these admissions conclusively demonstrate that Respondent's Goods and Services directly compete with Petitioners' Services including specifically Petitioners' Registered Services.

Moreover, evidence that the goods and services identified in both parties' respective registrations emanate from a single source demonstrates that such goods and services are closely related. *In re Davia*, 110 USPQ2d 1810, 1817 (TTAB 2014); TMEP 1207.01(a)(vi). In addition to the NEO NETWORK services, Respondent provides numerous other energy modelling software solutions, such as Respondent's "Building Energy Modelling" solution. [49 TTABVUE 15-16, ¶ 52, Ex. W.] Respondent provides another software platform described as being "for building owners ... to comply with the emerging building energy codes and standards, achieve sustainability results and manage their increasingly essential energy systems." [49 TTABVUE 16, ¶ 53, Ex. X.] Respondent provides yet another software solution that offers "more accurate forecasts of building energy consumption." [49 TTABVUE 16, ¶ 54, Ex. Y.] These various software solutions are directly competitive to Petitioners' Registered Services. [49 TTABVUE 15-16, ¶¶ 52-54, Exs. W-Y.] Even if Respondent's NEO NETWORK goods and services were not competitive, which they are, Respondent's numerous other competitive software solutions demonstrate that it is common for Respondent's Goods and Services and Petitioners' Registered Services to emanate from the same source, including from Respondent. *In re Davia*, 110 USPQ2d at 1817. Accordingly, such evidence establishes that Respondent's Goods and Services directly compete with Petitioners' Registered Services and the '323 Services.

2. Respondent's Goods and Services descriptions overlap with and are closely related to Petitioners' Registered Services.

The descriptions of goods and services set forth in Respondent's Registration for the NEO NETWORK Mark directly overlap with Petitioners' Registered Services. For example, in Class 9, Respondent's description of goods includes 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; and
- Software applied to the protection, control, management, surveillance and supervision of electric installations and networks and communication networks

Respondent's Class 9 Goods necessarily overlap with Petitioners' Registered Services, namely, "*software for use in building and analyzing energy models.*" It cannot be emphasized enough that Respondent's Class 9 Goods **do not exclude** software for "building and analyzing energy models." As a result, Respondent's Class 9 Goods are broad enough to include Petitioners' Registered Services.

Moreover, the evidence of record establishes that Petitioners' Registered Services comprise models used specifically for the information identified in Respondent's Class 9 Goods description including, without limitation "clean energy" such as onsite PV solar production, "best practices," "asset optimization" such as calculating the most efficient use of energy resources,

“optimization of industrial, manufacturing, and infrastructure management processes,” and managing electric installations. [49 TTABVUE Steinbock ¶¶ 17, 18, 48.] Indeed, energy optimization often includes the use of energy modelling tools to review, aggregate, and analyze building energy and financial data. [49 TTABVUE, Steinbock ¶ 17.] The most effective energy optimization initiatives involve using automated modelling software rather than manual calculations. [49 TTABVUE, Steinbock ¶ 18.] Additionally, Respondent’s description of goods in Class 9 specifically identifies “building owners,” “utilities,” and “government entities” as intended customers for Respondent’s Goods and Services, and these entities are and have always been customers for Petitioners’ Registered Services, too. [49 TTABVUE, Steinbock ¶ 25.]

Additionally, the evidence of record establishes that Petitioners’ Services provide the same information identified in Respondent’s Goods and Services. The NEO Platform can be used for asset optimization and infrastructure management processes, such as modifying use of current building and equipment assets for improved performance. [52 TTABVUE Steinbock ¶ 48.] Also, Petitioners’ NEO Services and the NEO Platform can be used to manage and improve electric installations in buildings. [52 TTABVUE Steinbock ¶ 48.] The NEO Platform also provides information about “green energy and clean energy technology” such as PV solar panels. [52 TTABVUE Steinbock ¶ 48.] Accordingly, Petitioners’ NEO Platform and associated services perform the same functionality in the same fields as those identified in Class 9 of Respondent’s Registration. Accordingly, Petitioners’ Services overlap with, and are closely related to, Respondent’s Class 9 Goods.

Furthermore, Respondent’s Class 35 Services and Class 42 Services also overlap with, and are closely related to, Petitioners’ Registered Services. The identification of services descriptions for Respondent’s Registration in Class 35 and Class 42 comprise the following:

- Class 35: 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.
- Class 42: 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.

Petitioners' Registered Services contain no limitations as to the type of data and information generated as part of the services. [51 TTABVUE 14-31, NOR Exs. 1-2.] Accordingly, Petitioners' Registration must logically include Respondent's "business information . . . in the fields of clean energy projects . . . advice, and best practices for companies, clean energy developers, building owners, utilities, and government entities." *See, e.g., Coach Servs., Inc.*, 101 USPQ2d at 1722. An "interactive website" is broad enough to include a web-based software platform. In fact, the record demonstrates that "[b]ecause the NEO Platform is provided over the web, the NEO Platform also constitutes an interactive website," just like Respondent's Class 42 Services. [49 TTABVUE Steinbock ¶ 49.]

In fact, Petitioners' Registered Services directly overlap with Respondent's Class 35 Services and Class 42 Services because the "website which delivers access to the NEO Platform likewise features business information in the fields of clean energy projects, advice, best practices, regulations, and laws, including specifically for building owners, utilities, and government entities." [49 TTABVUE Steinbock ¶ 49.] "[B]uilding owners, utilities, and government entities



(such as school districts and others) regularly use the NEO Platform to obtain information about how to improve their buildings to improve their energy efficiency.” [49 TTABVUE Steinbock ¶ 49.]

Although Respondent’s Registration includes the exclusionary phrase “not for use in building and analyzing energy models,” this exclusionary phrase only affects the means of generating the information being provided to the consumers. Respondent’s Class 42 Services and Petitioners’ Registered Services provide the same type of information, for the same purposes, to the same customers. [49 TTABVUE 15, Steinbock ¶ 49.] In any event, Respondent’s exclusionary language is false and misleading because Respondent’s Services actually utilize energy analysis tools, as noted in the preceding section. [49 TTABVUE 16-21, Steinbock ¶¶ 55-57.]

Notwithstanding the foregoing, Petitioners’ Services as set forth in ‘236 Application and Petitioners’ Registered Services directly overlap with Respondent’s Class 42 services, as well as Respondent’s goods and services in Classes 9 and 35. [49 TTABVUE 15, Steinbock ¶ 50.]

Accordingly, Petitioners’ Services, including Petitioners’ Registered Services, directly overlap with Respondent’s goods and services in classes 9, 35, and 42.

3. Numerous third parties provide both Respondent’s Goods and Services and Petitioners’ Services under the same mark.

The evidence of record demonstrates that the same entity offers both products or services at issue establishes that the goods or services are closely related because it establishes that consumers are accustomed to seeing the goods and services emanating from the same source. *In re G.B.I. Tile & Stone, Inc.*, 92 U.S.P.Q.2d at 1371; *In re Paper Doll Promotions, Inc.*, 84 U.S.P.Q.2d 1660, 1668 (T.T.A.B. 2007). Numerous third parties offer both building energy modelling software and services on the one hand, and Respondent’s Goods and Services on the other hand. [51 TTABVUE 393-474, NOR, Exs. 74-90.] Also, the fact that Respondent provides

both energy modelling software for buildings as well as Respondent's Goods and Services is another example of the parties' respective goods and services emanating from a single source.

In fact, the USPTO reached this same conclusion on multiple occasions. Petitioners' Reg. No. 4,429,793 for the NEO NET ENERGY OPTIMIZER mark was cited to refuse registration of Respondent's NEO NETWORK mark in three different office actions. [51 TTABVUE 65-82, NOR, Exhibits 6-8]. The Examiner stated that Petitioners' and Respondent's Goods and Services are "intended for the same purposes, namely, to provide information on energy and energy consumption." [51 TTABVUE 68, NOR, Exhibit 6]. Likewise, Petitioners' pending application Ser. No. 88/839,323 for NEO has been refused based on Respondent's Registration. [51 TTABVUE p 38-64, NOR, Exhibit 5]. This Office Action concluded that third parties "provide interactive websites with technology for energy information or downloadable software for the same as well as consulting, engineering, and/or research services (provided real time or via software or a website) regarding energy in applicant and registrant's field." [51 TTABVUE 43, NOR, Exhibit 5].

Accordingly, this evidence further establishes that Petitioners' Services, including Petitioners' Registered Services, and Respondent's Goods and Services frequently emanate from the same source and are therefore closely related.

In light of the significant evidence of record, the relatedness of the goods and services factor strongly favors Petitioners.

### **CONCLUSION**

Respondent's NEO NETWORK mark is confusingly similar to Petitioners' NEO<sup>®</sup> and NEO NET ENERGY OPTIMIZER<sup>®</sup> marks. In fact, Respondent and Respondent's customers all view, interpret, and remember the NEO NETWORK mark simply as "NEO." Respondent's Goods and Services overlap with and are directly competitive with Petitioners' Registered Services and

the '323 Services. The confidential and non-confidential evidence all demonstrate that Respondent provides competitive energy modelling software, energy sustainability software, and similar information services under the NEO NETWORK mark. The evidence demonstrates that the parties' respective goods and services travel in overlapping channels of trade and appeal to the same classes of consumers, often attending the same trade shows. The evidence further establishes that Petitioners' NEO Marks are conceptually and commercially strong, and therefore entitled to a broad scope of protection.

Accordingly, the relevant likelihood of confusion factors establish that Respondent's NEO NETWORK mark is likely to cause confusion with Petitioners' NEO Marks, and the continued registration of the NEO NETWORK mark will continue to damage Petitioners. Indeed, such damage is evident in the fact that Petitioners' Application has been refused based on Respondent's Registration.

Therefore, Petitioners respectfully requests that the Board sustain this petition and cancel registration of Respondent's NEO NETWORK mark.

**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 8th day of March 2024, he served by e-mail, a true and correct copy of Petitioners' Confidential Trial Brief and Non-Confidential Trial Brief in the above-captioned matter to the following last known e-mail addresses of record for Schneider Electric USA, Inc., namely, pb@pattishall.com, jara@pattishall.com, pam@pattishall.com, and docket@pattishall.com.

/s Timothy D. Sitzmann

Timothy D. Sitzmann

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