

ESTTA Tracking number: **ESTTA530907**

Filing date: **04/07/2013**

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

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	Glass Box Research Company
Granted to Date of previous extension	04/07/2013
Address	1333 W Devon Avenue Suite 201 Chicago, IL 60660 UNITED STATES

Attorney information	Barbara Grahn Oppenheimer Wolff & Donnelly, LLP Suite 2000, 222 South Ninth Street Minneapolis, MN 55402 UNITED STATES bgrahn@oppenheimer.com, ipdocket@oppenheimer.com Phone: 612-607-7325
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### Applicant Information

Application No	85535723	Publication date	10/09/2012
Opposition Filing Date	04/07/2013	Opposition Period Ends	04/07/2013
Applicant	Glass Box Analytics LLC 6715 Backlick Road, Suite 205 Springfield, VA 22150 UNITED STATES		

### Goods/Services Affected by Opposition

Class 035. First Use: 2011/09/28 First Use In Commerce: 2011/11/04 All goods and services in the class are opposed, namely: Providing consulting services in the field of drug pricing standards; providing business analysis of pharmaceutical product prices to the pharmaceutical industry
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### Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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### Mark Cited by Opposer as Basis for Opposition

U.S. Application No.	85799238	Application Date	12/10/2012
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	GLASS BOX RESEARCH		

Design Mark	<b>GLASS BOX RESEARCH</b>
Description of Mark	NONE
Goods/Services	Class 035. First use: First Use: 2009/04/00 First Use In Commerce: 2009/10/00 Market research services; market research studies; market research and business analyses; development of marketing strategies, concepts and tactics, namely, audience identification and development, consumer and market segmentation, and brand awareness; brand concept and brand development services for corporate and individual clients; advertising and marketing consultancy; business consultation regarding marketing activities, product pricing and launching of new products; marketing analysis, marketing data analysis, and quantitative market research analysis and services; marketing consulting; marketing services, namely, conducting consumer tracking behavior research and consumer trend and consumer insight analysis

Attachments	85799238#TMSN.jpeg ( 1 page )( bytes ) GLASS BOX notice of opp.pdf ( 5 pages )(336604 bytes )
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### **Certificate of Service**

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Barbara Grahn/
Name	Barbara Grahn
Date	04/07/2013

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

Glass Box Research Company	)	Opposition No. _____
	)	
Opposer	)	Mark: GLASS BOX ANALYTICS
	)	
v.	)	Serial No. 85535723
	)	
Glass Box Analytics LLC	)	Filing Date: February 7, 2012
	)	
Applicant	)	Published: October 9, 2012
_____	)	

**NOTICE OF OPPOSITION**

Glass Box Research Company, an Illinois corporation with offices located at 1333 W Devon Avenue, Chicago, Illinois (“Opposer”) believes it will be damaged by registration of the mark GLASS BOX ANALYTICS shown in trademark application Serial No. 85535723, filed February 7, 2012, and published in the *Official Gazette* on October 9, 2012, and hereby opposes registration of the mark pursuant to the previously-filed extensions of time to oppose. The grounds for opposition are as follows:

1. By the application herein opposed, Applicant seeks to register on the Principal Register the designation GLASS BOX ANALYTICS as a trademark for “Providing consulting services in the field of drug pricing standards; providing business analysis of pharmaceutical product prices to the pharmaceutical industry” in International Class 35.

2. Opposer has filed U. S. application Serial No. 85799238 for the mark GLASS BOX RESEARCH, filed on December 10, 2012, for “Market research services; market research studies; market research and business analyses; development of marketing strategies, concepts and tactics, namely, audience identification and development, consumer and market segmentation, and brand awareness; brand concept and brand development services for corporate and individual clients; advertising and marketing consultancy; business consultation regarding marketing activities, product pricing and launching of new products; marketing analysis,

marketing data analysis, and quantitative market research analysis and services; marketing consulting; marketing services, namely, conducting consumer tracking behavior research and consumer trend and consumer insight analysis” in Class 35. Opposer commenced use of its GLASS BOX RESEARCH mark at least as early as April, 2009, and has used the mark continuously since that date in connection with its services. The Examining Attorney has cited the Applicant’s application Serial No. 85535723 as posing a possible likelihood of confusion and states that registration of Opposer’s mark may be refused if Applicant’s application registers. Opposer will be damaged if Applicant’s application registers in that Opposer’s application will be refused registration.

3. Opposer’s date of first use of its mark is prior to the filing date of Applicant’s application.

4. On information and belief, Applicant did not commence use of the mark GLASS BOX ANALYTICS prior to Opposer’s first use of its GLASS BOX RESEARCH mark.

5. Applicant’s GLASS BOX ANALYTICS mark is confusingly and deceptively similar to Opposer’s GLASS BOX RESEARCH mark.

6. Opposer has advertised and promoted its GLASS BOX RESEARCH mark in connection with the sale and promotion of its services. As a result of such use and promotion, Opposer’s mark has developed and represents valuable goodwill inuring to the benefit of Opposer.

7. Applicant’s services are the same as or closely related to Opposer’s services offered under its GLASS BOX RESEARCH mark.

8. Applicant’s and Opposer’s services are likely to be offered through the same channels of trade.

9. Consumers and potential consumers of Applicant’s services are likely to be consumers and potential consumers of Opposer’s services and Opposer is likely to market its services to consumers and potential consumers of Applicant’s services.

10. Due to the similarity between Applicant's and Opposer's marks, the identical or related nature of the services identified in Applicant's application and the services offered by Opposer under its GLASS BOX RESEARCH mark, the overlap of consumers, and the similarity of trade channels for Applicant's and Opposer's services, customers and potential customers are likely to believe that Applicant's services originate with Opposer, resulting in a likelihood of confusion in the marketplace, and damage to Opposer.

11. Registration by Applicant of the mark GLASS BOX ANALYTICS for Applicant's services is likely to cause confusion or to cause mistake and deception among purchasers and potential purchasers with Opposer's previously used mark, resulting in damage to Opposer.

12. Because of the similarity of the marks and the related nature of the services, registration of the GLASS BOX ANALYTICS mark by Applicant is likely to cause confusion, mistake or deception that Applicant's services are those of Opposer, or are otherwise endorsed, sponsored or approved by Opposer.

13. Registration of the mark shown in application Serial No. 85535723 will result in damage to Opposer under the provisions of Section 2 of the U. S. Trademark Act, 15 U.S.C. § 1052, pursuant to the allegations stated above.

WHEREFORE, Opposer asks that its opposition to this application be sustained and that registration of GLASS BOX ANALYTICS be refused as to all services in the application.

Please direct all correspondence to:

Barbara J. Grahn  
OPPENHEIMER WOLFF & DONNELLY, LLP  
222 South Ninth Street, Suite 2000  
Minneapolis, MN 55402

Opposer appoints Barbara Grahn, Erika Koster, Barbara Wrigley, Ed Laine, Andrew Hansen, Dennis Hansen, and Aaron Scott of the firm of Oppenheimer Wolff & Donnelly, LLP,

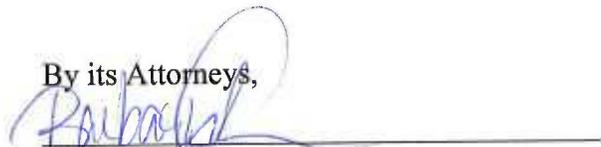
its attorneys to transact all business in the U. S. Patent and Trademark Office relating to this matter with full power of substitution.

Respectfully submitted,

GLASS BOX RESEARCH COMPANY

Date: April 7, 2012

By its Attorneys,



Barbara J. Grahn

OPPENHEIMER WOLFF & DONNELLY, LLP

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Minneapolis, MN 55402

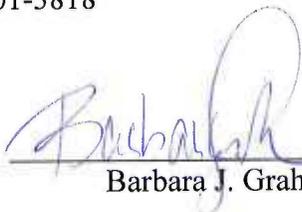
612-607-7325

[bgrahn@Oppenheimer.com](mailto:bgrahn@Oppenheimer.com)

**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the foregoing Notice of Opposition was served upon Applicant by First Class Mail, postage prepaid, at the following address on the 7<sup>th</sup> day of April, 2013:

Christine S. Beaman  
Womble Carlyle Sandridge & Rice, LLP  
1 W 4<sup>th</sup> St  
Winston Salem, North Carolina 27101-3818



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Barbara J. Grahn