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Filing date: **04/07/2014**

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

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|------------------------|--|
| Proceeding | 91212472 |
| Party | Plaintiff Prosper Business Development Corporation |
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| Submission | Other Motions/Papers |
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| Date | 04/07/2014 |
| Attachments | Reply to Opposition to Motion for Leave.pdf(40950 bytes) |

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

**IN THE MATTER OF Trademark Application Serial No. 79115344
for the mark BIGINSIGHTS;
Published in the Official Gazette on August 27, 2013**

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|---|---|--------------------------------|
| PROSPER BUSINESS DEVELOPMENT CORPORATION | : | |
| | : | |
| | : | |
| Opposer, | : | |
| v. | : | |
| | : | Opposition No. 91212472 |
| INTERNATIONAL BUSINESS MACHINES, CORPORATION | : | |
| | : | |
| | : | |
| Applicant. | : | |

**OPPOSER’S REPLY TO APPLICANT’S OPPOSITION TO MOTION FOR LEAVE TO
FILE SECOND AMENDED NOTICE OF OPPOSITION**

Applicant asserts that Opposer’s Motion for Leave to file a second amended Complaint was outside the procedural rules provided by Civ. R. 15 and TBMP Section 507.01 in that Opposer seeks to impermissibly add causes of action. However, TBMP Section 507.01 note 3, referring to TBMP Section 314, states that the Board “will not entertain claims or defenses that are not asserted in the pleadings *as originally filed or as amended or deemed amended.*” The use of the word “or” indicates that claims asserted in the pleadings as originally filed may be considered by the Board. As previously stated, in the initial Notice of Opposition, Opposer made reference to both Classes 9 and 42 in addition to Class 35. Thus, a second amended notice of opposition would not be presenting any claims not previously contemplated by the Opposer and on which Applicant was put on notice. Additionally, TBMP Section 507.01 n. 5 states that “[a]mendments that would amplify or clarify the grounds for opposition are not prohibited by the rule against adding claims.” As established in Opposer’s Motion for Leave, Applicant requested

clarification that Opposer intended to oppose registration of Applicant's mark in Classes 9, 35 and 42, after which Opposer attempted to submit its Second Amended Notice of Opposition. This amendment would "amplify or clarify" the grounds for opposition in accordance with TMBP 507.01. Therefore, it is within the Board's discretion to grant Opposer leave to submit its Second Amended Notice of Opposition.

Applicant asserts that Opposer's Motion for Leave was procedurally deficient in that Opposer failed to attach a copy of the proposed amended pleading. This is not true, as the proposed Amended Notice was attached as the only exhibit to the Motion. Applicant then changes its tune and argues that the attached copy, which it initially asserts was not attached at all, was not properly redlined in accordance with TBMP 507.01. However, the TBMP makes no mention of any requirement that a proposed Amended Notice must be redlined to highlight the differences between the Notice of Opposition as accepted by the Board, and the proposed Amended Notice.

Applicant's last argument is that Opposer has no factual basis for contesting mark registration for classes 9 and 42. However, the opposition of registration of Applicant's mark for classes 9 and 42 would have the same operative facts of the opposition of registration of Applicant's mark for class 35.

Finally, notions of judicial economy are in favor of allowing Opposer to amend its Notice of Opposition. If the Board were to reject Opposer's Motion, Opposer will move to cancel Applicant's registration of "BIGINSIGHTS" under classes 9 and 42 under 15 USC Section 1064. Rather than the parties and the Board going through the time, effort and costs associated with two separate proceedings based on the same operative facts, the Board should grant Opposer leave to amend its Notice of Opposition and decide on all 3 classes at once.

Based upon the foregoing, Opposer respectfully requests that the Board grant it leave to file a Second Amended Notice of Opposition.

/s/ Maribeth Deavers
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CERTIFICATE OF SERVICE

A copy of the foregoing Notice of Opposition has been filed electronically through the ESTTA and served via First Class mail, postage prepaid, on April 7, 2014, to the following counsel of record:

Barbara Solomon
Fross, Zelnick, Lehrman & Zissu, P.C.
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/s/ Maribeth Deavers
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