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

Proceeding	91212472
Party	Defendant International Business Machines, Corporation
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Date	08/14/2014
Attachments	Opposition to Motion to Amend (Suspended Opposition Proceeding).pdf(162571 bytes)

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

In the Matter of Application Serial No. 79/115,344
Mark: BIGINSIGHTS
Published in the Official Gazette on August 27, 2013

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

APPLICANT'S OPPOSITION TO OPPOSER'S SECOND MOTION TO AMEND NOTICE OF OPPOSITION

Applicant International Business Machines Corporation ("Applicant") submits this memorandum in opposition to Opposer Prosper Business Development Corporation's ("Opposer") Second Motion to Amend its Notice of Opposition.[1]

Opposer's motion should be denied for the simple reason that it is prohibited by the Board's suspension order dated March 24, 2014. (Dkt. No. 15 (the "Order").)

In the Order, the Board suspended this proceeding pending decision on Opposer's March 4 motion for leave to file a Second Amended Notice of Opposition, a motion which Applicant has opposed and which is fully briefed before the Board. In the Order, the Board

[1] Prosper mislabels its motion as a "Second" Motion to amend. But in fact this is now Prosper's third attempt to amend its notice of opposition. Prosper filed an amended opposition on January 17, 2014, prior to Applicant's answer, which amendment was accepted on February 20, 2014. (Dkt. Nos. 11 & 12). On March 4, 2014, Prosper filed a motion for leave to file a second amended opposition, (Dkt. No. 13), which is pending.

expressly instructed the parties that "[a]ny submission filed during the pendency of this motion which is not germane thereto will receive no consideration." (*Id.*)

Opposer's filing of yet another motion to amend directly contravenes the Board's Order. The instant motion is not germane to Opposer's prior contested motion, which sought leave to add a new claim for likelihood of confusion as to two classes of goods and services in Applicant's Application that were not included either in Opposer's original or its First Amended Notice of Opposition. (Dkt. No. 13.) Applicant opposed Opposer's prior motion on the ground that its attempt to add the new claim and new goods and services is barred by the limitations placed on amendments to oppositions against an application filed under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks. *See* 37 C.F.R. § 2.107(b) and TBMP §§ 315 and 507.01. (Dkt. No. 14.) Opposer's new motion to amend bears no relation to the subject of its prior motion or to Applicant's opposition thereto. Rather, Opposer's new motion seeks leave to change the date of first use of its cited mark to a date that is seven months earlier than the first use date claimed in its application and alleged in its original Notice of Opposition, First Amended Notice of Opposition and proposed Second Amended Notice of Opposition. (Dkt. No. 17.) Because Opposer's motion is not germane to the motion currently before the Board, the motion must be denied as prohibited by the Board's Order suspending this proceeding. (Dkt. No. 15.)

Further, the proposed Third Amended Notice of Opposition filed by Opposer contains two technical deficiencies each of which provides separate grounds to deny Opposer's motion. First, the proposed Third Amended Notice of Opposition is not based on the first amended opposition, which the Board previously noted is the operative pleading. (Dkt. Nos. 11 & 12.) Rather, it is based on Opposer's proposed Second Amended Notice of Opposition, which has not

been accepted by the Board but is merely under consideration by the Board. Prosper's motion appears to be an attempt to do an end-run around the Board and to force it into accepting the earlier-filed and contested Second Amended Notice of Opposition. If the Board were to accept the proposed *Third* Amended Notice of Opposition as written, it effectively would also accept Opposer's *Second* Amended Notice of Opposition, to Applicant's detriment.

Second, the proposed Third Amended Notice of Opposition is internally inconsistent because it alleges two different amended first use dates for Opposer's cited mark: September 10, 2010 (proposed 3d Am. Not. of Opp., Dkt. No. 17, ¶ 5) and September 16, 2010 (*id.* ¶ 3). Such inconsistency fails to give Applicant clear notice of Opposer's actual claim and is prejudicial to Applicant. Therefore, Opposer's motion to amend should be denied on these bases, as well.

For the reasons stated above, Applicant respectfully requests that the Board deny Opposer's motion and, as requested in Applicant's opposition to Opposer's first motion to amend, confirm that Opposer's First Amended Notice of Opposition is the operative pleading in this proceeding. Should the Board decide to consider Opposer's instant motion despite the Board's Order instructing that it would not consider a new motion, Applicant respectfully requests leave to oppose the motion substantively on its merits at that time.

Dated: New York, New York
August 14, 2014

FROSS ZELNICK LEHRMAN & ZISSU, P.C.

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CERTIFICATE OF SERVICE

I hereby certify that on this 14th day of August, 2014, I caused a true and correct copy of the foregoing APPLICANT'S OPPOSITION TO OPPOSER'S SECOND MOTION TO AMEND NOTICE OF OPPOSITION to be served by First Class Mail, postage prepaid, on Opposer by serving a copy of the same on Opposer's counsel:

Maribeth Deavers Meluch, Esq.
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