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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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Submission	Answer
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Date	01/20/2015
Attachments	IBM's Answer to Third Amended NOP (F1613049x96B9E).pdf(286609 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.)	
)	Opposition No. 91/212472
INTERNATIONAL BUSINESS MACHINES)	
CORPORATION,)	
)	
Applicant.)	
)	

In the Matter of Application Serial No. 85/806,210
Mark: BIG INSIGHT and Design
Published in the Official Gazette on November 26, 2013

In the Matter of Registration No. 4,320,032
Mark: BIGINSIGHT
Registered: April 16, 2013

INTERNATIONAL BUSINESS MACHINES)	
CORPORATION,)	
)	
Opposer/Petitioner,)	
)	
v.)	Opposition No. 91/215572
)	
PROSPER BUSINESS DEVELOPMENT)	Cancellation No. 92/059154
CORPORATION,)	
)	
Applicant/Registrant.)	(As consolidated under 91/212,472)
)	

**APPLICANT INTERNATIONAL BUSINESS MACHINE CORPORATION'S ANSWER
AND AFFIRMATIVE DEFENSES TO OPPOSER'S THIRD AMENDED
NOTICE OF OPPOSITION**

Applicant International Business Machines Corporation (“Applicant” or “IBM”), by its undersigned counsel, pursuant to the order of the TTAB dated December 19, 2014 and amended by notice of correction dated December 29, 2014, for its answer and affirmative defenses to the Third Amended Notice of Opposition filed by Opposer Prosper Business Development Corporation hereby states as follows:

1. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 1 of the Third Amended Notice of Opposition and therefore denies the same.

2. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 2 of the Third Amended Notice of Opposition and therefore denies the same.

3. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 3 of the Third Amended Notice of Opposition and therefore denies the same, but states that in any event the date set forth is after Applicant first used the opposed mark.

4. Applicant admits that Opposer claims to own trademark registration no. 4,320,032 which is referenced in an Exhibit to the Third Amended Notice of Opposition and refers the Board to said exhibit for the details thereof, avers that said registration is based on use that occurred after Applicant first used the opposed mark, was filed after Applicant first used the opposed mark, was issued after Applicant first used the opposed mark, and that the registration is the subject of Cancellation Action 92/059154 consolidated with this opposition, and otherwise

lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 4 of the Third Amended Notice of Opposition and therefore denies the same.

5. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 5 of the Third Amended Notice of Opposition and therefore denies the same except avers that the date identified is after Applicant's first use of the mark herein opposed.

6. Applicant admits that Opposer purports to own trademark application S.N. 85/806,210 as alleged in Paragraph 6 of the Third Amended Notice of Opposition, states that contrary to Opposer's claim the application is for the mark BIGINSIGHT not BIGINSIGHTS, avers that said application does not provide Opposer with any further rights, states that said application is the subject of Opposition No. 91/212,472 consolidated herewith and that the filing date and purported first-use date are after Applicant's first use of the opposed mark, and otherwise lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 6 of the Third Amended Notice of Opposition and therefore denies the same.

7. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 7 of the Third Amended Notice of Opposition and therefore denies the same and expressly denies that Opposer has shown or can show that its mark is "a very strong mark."

8. Applicant admits the allegations in Paragraph 8 of the Third Amended Notice of Opposition, except avers that Application Serial No. 79/115,344 was filed pursuant to 15 U.S.C. § 1114f and not 35 U.S.C. § 1114f as alleged, avers that Applicant has used the mark

BIGINSIGHTS (“Applicant’s Mark”) in the United States since at least as early as May 2010, and states that the exhibit attached as Exhibit B to the Third Amended Notice of Opposition has no bearing on Applicant’s Mark.

9. Applicant admits the allegations in Paragraph 9 of the Third Amended Notice of Opposition.

10. Applicant admits the allegations in Paragraph 10 of the Third Amended Notice of Opposition.

11. Applicant denies the allegations contained in Paragraph 11 of the Third Amended Notice of Opposition.

12. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 12 of the Third Amended Notice of Opposition that refer or relate to Opposer’s services or consumers and therefore denies the same and otherwise denies any allegations express or implied contained in Paragraph 12 of any likelihood of confusion or confusion as to source.

13. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 13 of the Third Amended Notice of Opposition that refer or relate to Opposer’s trade channels or customers and therefore denies the same and otherwise denies any allegations express or implied contained in Paragraph 13 of any likelihood of confusion or any allegation that the opposed mark is identical or confusingly similar to Opposer’s mark.

14. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 14 of the Third Amended Notice of Opposition with respect to the claim that Opposer’s mark has been in continuous use and commerce since

any date and further states that based on the allegations of Paragraph 3 and 5 of the Third Amended Notice of Opposition, to the extent Opposer is relying on a first-use date of September 2010 denies that Opposer's mark has been in use prior to IBM's use of the applied-for mark, and further denies the claims set forth in Paragraph 14 of the Third Amended Notice of Opposition that Opposer's mark had "acquired significant distinctiveness and goodwill" prior to IBM's use of the applied-for mark which use dates back to May 2010.

15. Applicant denies the allegations contained in Paragraph 15 of the Third Amended Notice of Opposition.

16. Applicant denies the allegations contained in Paragraph 16 of the Third Amended Notice of Opposition.

17. Applicant denies the allegations contained in Paragraph 17 of the Third Amended Notice of Opposition.

18. Applicant denies knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 18 of the Third Amended Notice of Opposition as it relates to Opposer's claim that it is the "owner" of Opposer's mark, notes that there is a pending cancellation proceeding against said mark, denies any suggestion express or implied that any rights Opposer has in or to the use of the mark BIGINSIGHT are prior to Applicant's rights in the Opposed mark and otherwise denies all remaining allegations contained in Paragraph 18 of the Third Amended Notice of Opposition.

AS AND FOR A FIRST AFFIRMATIVE DEFENSE

19. Opposer has failed to state a claim on which relief can be granted because the date of Applicant's first use in commerce of Applicant's Mark precedes Opposer's stated first use

date and precedes any other date on which Opposer can rely. Absent priority, Opposer has no standing and no basis for its claims for relief.

AS AND FOR A SECOND AFFIRMATIVE DEFENSE

20. The registration on which Opposer relies in this proceeding is the subject of a preexisting cancellation action (thereby making a counterclaim duplicative in these proceedings). Because the registration which forms the basis for the Opposition is subject to cancellation, there is no basis for the claims set forth in the Third Amended Notice of Opposition.

AS AND FOR A THIRD AFFIRMATIVE DEFENSE

21. Various paragraphs of the Notice of Opposition do not comply with Fed. R. Civ. P. 8(a) and (e), which require a “short and plain statement” of the claims showing that Opposer is entitled to relief and 37 C.F.R. § 2.104(a) and T.B.M.P. § 312.03, which require “a short and plain statement” of the reasons why Opposer believes it would be damaged by the registration of the mark at issue. As such Applicant is not required to separately admit or deny each of the allegations contained therein.

WHEREFORE, Applicant International Business Machines Corporation respectfully requests that the Third Amended Notice of Opposition be dismissed with prejudice; that judgment be entered in favor of Applicant on the opposition; and that Application Serial No. 79/115,344 proceed to registration

Dated: New York, New York
January 20, 2015

Respectfully submitted,

FROSS ZELNICK LEHRMAN & ZISSU, P.C.

By:



Barbara A. Solomon
Emily Weiss

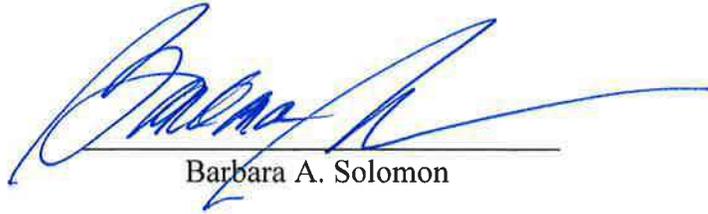
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Attorneys for Applicant

CERTIFICATE OF SERVICE

I hereby certify that on this 20th day of January, 2015, I caused a true and correct copy of the foregoing APPLICANT'S ANSWER AND AFFIRMATIVE DEFENSES TO OPPOSER'S THIRD AMENDED 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.
Isaac Wiles Burkholder & Teetor LLC
2 Miranova Place
Suite 700
Columbus, OH 43215



Barbara A. Solomon