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

Proceeding	91212472
Party	Plaintiff Prosper Business Development Corporation
Correspondence Address	MARIBETH DEEVERS ISAAC WILES BURKHOLDER & TEETOR LLC 2 MIRANOVA PLACE, SUITE 700 COLUMBUS, OH 43215 UNITED STATES mdeavers@isaacwiles.com, rperryman@isaacwiles.com
Submission	Motion to Amend Pleading/Amended Pleading
Filer's Name	Maribeth Deavers
Filer's e-mail	mdeavers@isaacwiles.com
Signature	/Maribeth Deavers/
Date	01/17/2014
Attachments	Amended Notice of Opposition.pdf(48451 bytes) Prosper Exhibit A.pdf(100052 bytes) Prosper Exhibit B.pdf(13102 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**

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

AMENDED NOTICE OF OPPOSITION

PROSPER BUSINESS DEVELOPMENT CORPORATION, a corporation organized under the laws of the State of Ohio, believes that it will be damaged by the registration of the mark BIGINSIGHTS (U.S. Ser. No. 79115344) (the “Application”) to International Business Machines Corporation (“IBM”, also referred to as the “Applicant”) and hereby opposes the same.

As grounds for opposition, it is alleged that:

1. Opposer is an international business acceleration company providing consulting services to businesses, namely advising on marketing strategies, developing innovations to increase market leadership, providing consumer insights and analysis and publishing real time consumer behavior studies.

2. Opposer has been providing these various consulting and marketing services for over 20 years and Opposer and its services are recognized worldwide. Opposer provides information about its marketing and consulting services on its websites www.goproper.com,

www.bigresearch.com, and www.biginsight.com among others. Websites of third parties also include information about the Opposer's goods and services.

3. Opposer began providing certain consulting services in commerce to the general public under the trademark "BIGINSIGHT" on April 5, 2011.

4. Opposer owns the trademark registration for BIGINSIGHT which registered on April 16, 2013, U.S. Reg. No. 4320032 ("Opposer's Mark") (See Exhibit A attached).

5. Opposer's Mark has been used in connection with "providing news, information and analysis compiled from multiple global sources in the field of current events related to marketing strategies and consumer behavior for businesses" as early as April 5, 2011 (See Exhibit A). Such mark is currently in use with respect to such services.

6. Opposer also owns the trademark application for the design mark BIGinsights, Application Serial No. 85/806210, filed December 19, 2012.

7. Opposer has invested significant sums of money marketing and promoting its services under the BIGINSIGHT mark. As a result of these investments and its worldwide use, Opposer's Mark has acquired valuable goodwill and distinction and is a very strong mark in the field of marketing and business consulting services.

8. Applicant filed a section 66(a) trademark application pursuant to 35 U.S.C. § 1141f which was assigned Application Serial No. 79/115344 with an International Registration Date of May 21, 2012, for the purpose of extending protection of an international trademark registration to the United States and with an intent to use the mark BIGINSIGHTS in commerce. Applicants claimed Paris Priority date is January 11, 2012. (See Exhibit B attached).

9. IBM's Application was published for opposition in the *Official Gazette* on August 27, 2013.

10. Applicant's mark is used in connection with "advice on company management and business advice; business development services; conducting marketing studies; implementing and conduction commercial exhibitions in the field of computers, computing services, information technology and electronic business transactions via global computer networks". (See Exhibit B).

11. Applicant's mark is identical to Opposer's Mark in appearance, sound, connotation and commercial impression.

12. Applicant's proposed services are overlapping and/or legally identical to services provided by Opposer under Opposer's Mark, particularly business development services, conducting marketing services, and implementing and conducting commercial exhibitions in the field of computers in International Class 035. (See Exhibit B).

13. Applicant and Opposer operate in substantially similar trade channels and their goods and services are viewed by the same customers. Purchasers familiar with Opposer's services are likely to mistakenly believe that Applicant's services are sponsored, authorized, endorsed, affiliated with or otherwise approved by the Opposer because the IBM mark sought to be registered and used by Applicant is identical to or confusingly similar to the Opposer's Mark.

14. Opposer's Mark has been in continuous use in commerce in the United States prior to IBM's use of the applied for mark and has already acquired significant distinctiveness and good will.

15. Because of the substantial similarities of Applicant's mark to Opposer's Mark there is a substantial likelihood of confusion to the public.

16. For the aforementioned reasons, the registration sought by Applicant is contrary to the provisions of Section 2 of the Lanham Act and Opposer believes it would be damaged thereby.

17. Applicant's mark should be refused from registration under the Lanham Act for all International Classes set forth in its Application.

18. As the owner of Opposer's Mark, Opposer has a present and prospective right to use the mark BIGINSIGHT. This right would be impaired by registration of Applicant's mark.

WHEREFORE, Opposer believes that it has a real interest in this proceeding and will be irreparably damaged by the registration of Applicant's mark, and respectfully requests that the Board sustain this Opposition and refuse the registration of the Applicant's mark.

DATED: January 17, 2014

Respectfully submitted,

/s/ Maribeth Deavers

Maribeth Deavers (0055903)

mdeavers@isaacwiles.com

Robert C. Perryman (0088797)

rperryman@isaacwiles.com

ISAAC, WILES, BURKHOLDER & TEETOR LLC

Two Miranova Place, Suite 700

Columbus, Ohio 43215

(614) 221-2121 Phone

(859) 365-9516 Fax

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 January 14, 2014, to the following counsel of record:

Barbara Solomon
Fross, Zelnick, Lehrman & Zissu, P.C.
866 United Nations Plaza at First Avenue & 48th Street
New York, N.Y. 10017

/s/ Maribeth Deavers
Maribeth Deavers (0055903)

United States of America
United States Patent and Trademark Office

BIGINSIGHT

Reg. No. 4,320,032

Registered Apr. 16, 2013

Int. Cl.: 35

SERVICE MARK

PRINCIPAL REGISTER

PROSPER BUSINESS DEVELOPMENT CORPORATION (OHIO CORPORATION)
400 WEST WILSON BRIDGE ROAD
STE 200
WORTHINGTON, OH 43085

FOR: PROVIDING NEWS, INFORMATION AND ANALYSIS COMPILED FROM MULTIPLE GLOBAL SOURCES IN THE FIELD OF CURRENT EVENTS RELATED TO MARKETING STRATEGIES AND CONSUMER BEHAVIOR FOR BUSINESSES, IN CLASS 35 (U.S. CLS. 100, 101 AND 102).

FIRST USE 4-5-2011; IN COMMERCE 4-5-2011.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

SER. NO. 85-620,362, FILED 5-9-2012.

MATTHEW GALAN, EXAMINING ATTORNEY



Sean Street Lee

Acting Director of the United States Patent and Trademark Office

**REQUIREMENTS TO MAINTAIN YOUR FEDERAL
TRADEMARK REGISTRATION**

**WARNING: YOUR REGISTRATION WILL BE CANCELLED IF YOU DO NOT FILE THE
DOCUMENTS BELOW DURING THE SPECIFIED TIME PERIODS.**

Requirements in the First Ten Years*

What and When to File:

First Filing Deadline: You must file a Declaration of Use (or Excusable Nonuse) between the 5th and 6th years after the registration date. *See* 15 U.S.C. §§1058, 1141k. If the declaration is accepted, the registration will continue in force for the remainder of the ten-year period, calculated from the registration date, unless cancelled by an order of the Commissioner for Trademarks or a federal court.

Second Filing Deadline: You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between the 9th and 10th years after the registration date.*
See 15 U.S.C. §1059.

Requirements in Successive Ten-Year Periods*

What and When to File:

You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between every 9th and 10th-year period, calculated from the registration date.*

Grace Period Filings*

The above documents will be accepted as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

**The United States Patent and Trademark Office (USPTO) will NOT send you any future notice or
reminder of these filing requirements.**

***ATTENTION MADRID PROTOCOL REGISTRANTS:** The holder of an international registration with an extension of protection to the United States under the Madrid Protocol must timely file the Declarations of Use (or Excusable Nonuse) referenced above directly with the USPTO. The time periods for filing are based on the U.S. registration date (not the international registration date). The deadlines and grace periods for the Declarations of Use (or Excusable Nonuse) are identical to those for nationally issued registrations. *See* 15 U.S.C. §§1058, 1141k. However, owners of international registrations do not file renewal applications at the USPTO. Instead, the holder must file a renewal of the underlying international registration at the International Bureau of the World Intellectual Property Organization, under Article 7 of the Madrid Protocol, before the expiration of each ten-year term of protection, calculated from the date of the international registration. *See* 15 U.S.C. §1141j. For more information and renewal forms for the international registration, see <http://www.wipo.int/madrid/en/>.

NOTE: Fees and requirements for maintaining registrations are subject to change. Please check the USPTO website for further information. With the exception of renewal applications for registered extensions of protection, you can file the registration maintenance documents referenced above online at <http://www.uspto.gov>.



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451
www.uspto.gov

Nov 6, 2013

NOTICE OF PUBLICATION

1. Serial No.:
85-806,210
2. Mark:
BIG INSIGHT
(STYLIZED/DESIGN)
3. International Class(es):
35, 41
4. Publication Date:
Nov 26, 2013
5. Applicant:
Prosper Business Development Corporation

The mark of the application identified appears to be entitled to registration. The mark will, in accordance with Section 12(a) of the Trademark Act of 1946, as amended, be published in the *Official Gazette* on the date indicated above for the purpose of opposition by any person who believes he will be damaged by the registration of the mark. If no opposition is filed within the time specified by Section 13(a) of the Statute or by rules 2.101 or 2.102 of the Trademark Rules, the Commissioner of Patents and Trademarks may issue a certificate of registration.

Copies of the trademark portion of the *Official Gazette* containing the publication of the mark may be obtained from:

The Superintendent of Documents
U.S. Government Printing Office
PO Box 371954
Pittsburgh, PA 15250-7954
Phone: 202-512-1800

By direction of the Commissioner.

Email Address(es):

mdeavers@isaacwiles.com