

ESTTA Tracking number: **ESTTA251617**

Filing date: **11/26/2008**

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	Nielsen Business Media, Inc.
Granted to Date of previous extension	12/03/2008
Address	770 Broadway New York, NY 10003-9595 UNITED STATES

Attorney information	Gene S. Winter, Esq. St. Onge Steward Johnston & Reens LLC 986 Bedford Street Stamford, CT 06905 UNITED STATES litigation@ssjr.com Phone:203-324-6155
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**Applicant Information**

Application No	77215449	Publication date	08/05/2008
Opposition Filing Date	11/26/2008	Opposition Period Ends	12/03/2008
Applicant	Edgewood Consulting Group, Inc. Suite 226 1719 Route 10 Parsippany, NJ 07054 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 035. First Use: 1999/04/01 First Use In Commerce: 1999/04/01 All goods and services in the class are opposed, namely: Market research consultation; Market research services; Market research studies
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**Grounds for Opposition**

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
The mark is merely descriptive	Trademark Act section 2(e)(1)
Dilution	Trademark Act section 43(c)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)

**Mark Cited by Opposer as Basis for Opposition**

U.S. Registration No.	1576716	Application Date	06/13/1988
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Registration Date	01/09/1990	Foreign Priority Date	NONE
Word Mark	BUYING POWER INDEX		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 1954/05/00 First Use In Commerce: 1954/05/00 PROVIDING INFORMATION IN THE FORM OF AN INDEX RELATING TO DEMOGRAPHICS AND PURCHASING ABILITY		

Attachments	App No 77215449 Not of Opposition.pdf ( 9 pages )(645844 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	/Andy I. Corea/
Name	Andy I. Corea
Date	11/26/2008

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

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<b>NIELSEN BUSINESS MEDIA, Inc.</b>	:	
	:	
<b>Opposer,</b>	:	
	:	
<b>v.</b>	:	<b>Opposition No.</b>
	:	<b>[not yet assigned]</b>
<b>Edgewood Consulting Group, Inc.</b>	:	<b>Application No. 77/215,449</b>
	:	
<b>Applicant.</b>	:	

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Re U.S. Trademark Application Serial No. 77/215,449  
For: BRAND POWER INDEX  
By: Edgewood Consulting Group, Inc.  
Filed on: 06/26/2007  
Published: 08/05/2008  
Extension of time granted to December 3, 2008

**Notice of Opposition**

Opposer Nielsen Business Media, Inc. opposes registration of the mark BRAND POWER INDEX, in U.S. Trademark Application Serial No. 77/215,449. Opposer states the following grounds for opposition.

1. Opposer, Nielsen Business Media (“Opposer”) is a Delaware corporation with an address at 770 Broadway, 8<sup>th</sup> Floor, New York, NY 10003-9595.

2. Opposer is the owner of the U.S. Trademark Registration No. 1,576,716 (“Opposer’s Mark”) for use in connection with “providing information in the form of an index relating to demographics and purchasing ability.” A copy of the registration record from the USPTO online TARR database is attached as Exhibit A to this Notice of Opposition and made of record in this proceeding.

3. Opposer has used the trademark BUYING POWER INDEX since at least as early as 1954.

4. Opposer has used the trademark BUYING POWER INDEX in connection with publishing information in the form of an index relating to demographics and purchasing ability, long prior to Applicant's adoption of the trademark BRAND POWER INDEX.

5. Opposer has been using the BUYING POWER INDEX mark in connection with its goods and services since long prior to any date on which Applicant may rely in this proceeding.

6. Opposer's use of the BUYING POWER INDEX mark for a sustained period of time has made it a strong indicia of the source of Opposer's goods and services has made the mark famous within the meaning of 15 U.S.C. §1125(c).

7. Applicant is a California corporation and lists an address of Suite 226, 1719 Route 10, Parsippany, NJ 07054 in the opposed trademark application.

8. On June 26, 2007, Applicant filed an application to register the trademark BRAND POWER INDEX ("Applicant's Mark"). The application was assigned Application Serial No. 77/215,449 and recites the following services: "Market research consultation; Market research services; Market research studies."

9. Applicant asserts a date of first use of April 1, 1999 in the opposed application.

10. Opposer's first alleged use and registration of the BUYING POWER INDEX Mark is long prior to Applicant's adoption of the mark BRAND POWER INDEX.

11. Opposer's Mark was registered and has become famous within the meaning of 15 U.S.C. § 1125 long prior to the date of alleged first use by Applicant for Applicant's Mark.

12. Applicant's Mark BRAND POWER INDEX is similar in sound, appearance, and meaning to Opposer's BUYING POWER INDEX Mark.

13. The services recited in U.S. Trademark Application Serial No. 77/215,449 are related to Opposer's goods and services sold or promoted under the BUYING POWER INDEX Mark.

14. Applicant's Mark so resembles Opposer's Mark, as to be likely to cause confusion, mistake or deception as to the source of the goods and services offered, within the meaning of 15 U.S.C. § 1052(d).

15. The use and registration of Applicant's Mark will damage Opposer in the selling of its goods and services by causing a likelihood of confusion.

16. Applicant's use and registration of BRAND POWER INDEX mark falsely suggests a connection with Opposer within the meaning of 15 U.S.C. §1052(a).

17. The use and registration of Applicant's Mark will dilute the distinctive quality of Opposer's Marks within the meaning of Section 43(c) of the Lanham Act.

18. Applicant's Mark BRAND POWER INDEX is descriptive of the services recited in the application, and Applicant has not demonstrated sufficient evidence

of acquired distinctiveness to support registration under Section 2(f), 15 U.S.C. § 1052(f) of the Lanham Act.


19. Applicant committed fraud in the prosecution of its trademark registration when it claimed that its use of the mark BRAND POWER INDEX had been substantially exclusive in light of Opposer's prior use and registration of the confusingly similar mark BUYING POWER INDEX.

WHEREFORE, Opposer requests that the Trademark Trial and Appeal Board sustain this Opposition and refuse registration of the mark BILLBOARD BANDS, U.S. Trademark Application Serial No. 77/215,449.

Payment in the amount of \$300 is submitted herewith.

Respectfully submitted

November 26, 2008

  
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Gene S. Winter  
Andy I. Corea  
ST.ONGE STEWARD JOHNSTON & REENS LLC  
986 Bedford Street  
Stamford, CT 06905  
Telephone: (203) 324-6155  
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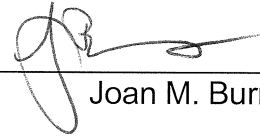
**CERTIFICATE OF SERVICE**

This is to certify that a true copy of the foregoing **NOTICE OF OPPOSITION** was served by first class mail, postage prepaid on the Correspondent for the Applicant as follows:

Niky Economy Syrengelas  
CROCKETT & CROCKETT  
24012 Calle De La Plata  
Suite 400  
Laguna Hills, CA 92653-7623

Nov. 26, 2008

\_\_\_\_\_  
Date



\_\_\_\_\_  
Joan M. Burnett

# **EXHIBIT A**



**Thank you for your request. Here are the latest results from the TARR web server.**

\*This page was generated by the TARR system on 2008-09-11 15:15:57 ET

**Serial Number:** 73733834 [Assignment Information](#) [Trademark Document Retrieval](#)

**Registration Number:** 1576716

**Mark (words only):** BUYING POWER INDEX

**Standard Character claim:** No

**Current Status:** This registration has been renewed.

**Date of Status:** 2002-07-01

**Filing Date:** 1988-06-13

**Transformed into a National Application:** No

**Registration Date:** 1990-01-09

**Register:** Principal

**Law Office Assigned:** (NOT AVAILABLE)

**If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov)**

**Current Location:** 900 -File Repository (Franconia)

**Date In Location:** 2002-07-02

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#### LAST APPLICANT(S)/OWNER(S) OF RECORD

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1. NIELSEN BUSINESS MEDIA, INC.

**Address:**

NIELSEN BUSINESS MEDIA, INC.

770 BROADWAY

NEW YORK, NY 10003

United States

**Legal Entity Type:** Corporation

**State or Country of Incorporation:** Delaware

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#### GOODS AND/OR SERVICES

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**International Class:** 035

**Class Status:** Active

PROVIDING INFORMATION IN THE FORM OF AN INDEX RELATING TO DEMOGRAPHICS  
AND PURCHASING ABILITY

**Basis:** 1(a)

**First Use Date:** 1954-05-00

**First Use in Commerce Date:** 1954-05-00

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**ADDITIONAL INFORMATION**

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**Disclaimer:** "INDEX"

**Section 2(f)**

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**MADRID PROTOCOL INFORMATION**

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(NOT AVAILABLE)

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**PROSECUTION HISTORY**

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**NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.**

2008-09-10 - Automatic Update Of Assignment Of Ownership

2006-09-13 - Assignment Of Ownership Not Updated Automatically

2002-07-01 - First renewal 10 year

2002-07-01 - Section 8 (10-year) accepted/ Section 9 granted

2002-03-27 - Response received to Post Registration action - Sections 8 & 9

2002-03-27 - PAPER RECEIVED

2001-10-26 - Post Registration action mailed Sections 8 & 9

2001-03-02 - Response received to Post Registration action - Sections 9

2000-08-28 - Post Registration action mailed - Section 9

2000-01-03 - Combined Section 8 (10-year)/Section 9 filed

1996-06-21 - Section 8 (6-year) accepted & Section 15 acknowledged

1995-12-26 - Section 8 (6-year) and Section 15 Filed

1990-01-09 - Registered - Principal Register

1989-10-17 - Published for opposition

1989-09-16 - Notice of publication

1989-07-17 - Approved for Pub - Principal Register (Initial exam)

1989-07-03 - Communication received from applicant

1989-03-13 - Non-final action mailed

1989-02-16 - Communication received from applicant

1988-08-11 - Non-final action mailed

1988-08-08 - Assigned To Examiner

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**ATTORNEY/CORRESPONDENT INFORMATION**

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**Attorney of Record**

GENE S. WINTER

**Correspondent**

GENE S. WINTER

ST.ONGE STEWARD JOHNSTON AND REENS

986 BEDFORD STREET

STAMFORD, CT 06905-5619

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