

ESTTA Tracking number: **ESTTA962613**

Filing date: **03/26/2019**

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	Bain & Company Inc.
Granted to Date of previous extension	03/27/2019
Address	131 Dartmouth Street Boston, MA 02116 UNITED STATES

Attorney information	Kimberly B. Herman Sullivan & Worcester LLP One Post Office Square Boston, MA 02109 UNITED STATES kherman@sandw.com, mpalmisciano@sandw.com, trademark@sandw.com 617-338-2943
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Applicant Information

Application No	87222304	Publication date	11/27/2018
Opposition Filing Date	03/26/2019	Opposition Period Ends	03/27/2019
Applicant	ICF CONSULTING GROUP, INC. 9300 LEE HIGHWAY FAIRFAX, VA 22031 UNITED STATES		

Goods/Services Affected by Opposition

Class 035. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Advertising and marketing services

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
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Marks Cited by Opposer as Basis for Opposition


U.S. Registration No.	2953691	Application Date	11/11/2003
Registration Date	05/17/2005	Foreign Priority Date	NONE
Word Mark	NET PROMOTER		

Design Mark	NET PROMOTER
Description of Mark	NONE
Goods/Services	Class 035. First use: First Use: 2004/01/01 First Use In Commerce: 2004/01/01 Business marketing consulting services;market research services; conducting business, customer satisfaction, customer loyalty and market research surveys

U.S. Registration No.	4766998	Application Date	03/31/2014
Registration Date	07/07/2015	Foreign Priority Date	NONE

Word Mark	NPS
Design Mark	NPS
Description of Mark	NONE
Goods/Services	Class 035. First use: First Use: 2003/03/00 First Use In Commerce: 2003/03/00 Business consulting and information services; business consulting services, namely, customer and employee surveys, metrics and feedback processes for comparing, rating the quality of and improving performance, products, services, pricing, sales and marketing, customer experienceand customer service; business consulting services, namely, customer and employee satisfaction and loyalty services Class 041. First use: First Use: 2003/03/00 First Use In Commerce: 2003/03/00 Business training consulting services and employee training services; providing online publications in the nature of reports, articles, and newsletters and publication of printed matter in the field of business training consulting servicesand employee training services; providing online publications in the nature of reports, articles, and newsletters and publication of printed matter in the field of business consulting and informationservices; providing online publicationsin the nature of

	reports, articles, and newsletters and publication of printed matter in the field of business consulting services, namely, customer and employee surveys, metrics and feedback processes for comparing, rating the quality of and improving performance, products, services, pricing, sales and marketing, customer experience and customer service; providing online publications in the nature of reports, articles, and newsletters and publication of printed matter in the field of business consulting services, namely, customer and employee satisfaction and loyalty services; educational services, namely, providing web-based and classroom training of business leaders and employees for certification in the fields of profitable growth, improving performance, products, services, pricing, sales and marketing, customer experience and customer service, and customer and employee satisfaction and loyalty; providing online publications and publication of printed matters for the aforementioned educational services
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U.S. Registration No.	3455429	Application Date	01/11/2006
Registration Date	06/24/2008	Foreign Priority Date	NONE
Word Mark	NPS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 2005/11/00 First Use In Commerce: 2005/11/00 Business consulting services, namely, a customer metrics and feedback process for performance improvement and business consulting services in the nature of customer satisfaction and customer loyalty services to the financial services, information technology, automotive, aerospace and defense, chemicals, construction and building, mining, real estate and consumer products fields		

Attachments	78326460#TMSN.png(bytes) 86237989#TMSN.png(bytes) 78789466#TMSN.png(bytes) Notice of Opposition - Bain Company v. ICF Consulting Group.pdf(1075578 bytes)
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Signature	/Kimberly B. Herman/
Name	Kimberly B. Herman
Date	03/26/2019

4. Opposer owns U.S. Trademark Registration No. 2,953,691, registered on May 17, 2005, for the word mark NET PROMOTER in connection with “Business marketing consulting services; market research services; conducting business, customer satisfaction, customer loyalty and market research surveys” in Class 35 (copy of USPTO TESS record is attached hereto as Exhibit A).

5. Opposer owns U.S. Trademark Registration No. 4,766,998, registered on July 7, 2015, for the word mark NPS in connection with, *inter alia*, business consulting and information services in Class 35 and business training consulting services and employee training services in Class 41 (copy of USPTO TESS record is attached hereto as Exhibit B).

6. Opposer owns U.S. Trademark Registration No. 3,455,429, registered on June 24, 2008, for the word mark NPS in connection with, *inter alia*, business consulting services in Class 35 (copy of USPTO TESS record is attached hereto as Exhibit C).

7. The foregoing registrations are valid and subsisting, constituting prima facie evidence of Opposer’s ownership of, and exclusive rights to use, its NPS Marks in commerce in connection with the services recited in the registrations.

8. Through use of the NPS Marks in the United States in connection with services highly related to those of Applicant, Opposer has established extremely valuable goodwill and recognition in the NPS Marks by virtue of the quality of services offered thereunder.

Applicant and Its NET EMPATHY SCORE Mark

9. ICF Consulting Group, Inc. (“Applicant”) is identified as a Delaware corporation with an address at 9300 Lee Highway, Fairfax, Virginia 22031.

10. On November 4, 2016, Applicant filed a trademark application for the mark NET EMPATHY SCORE for “Advertising and marketing services” in Class 35 on an intent-to-use basis. The application was assigned Serial No. 87/222,304 (copy of USPTO TESS record is

attached hereto as Exhibit D). The services listed in the application are identical, substantially similar and/or closely related to the services Opposer offers under its NPS marks.

11. Upon information and belief, Applicant has not used the NET EMPATHY SCORE mark in commerce for the services identified in Application Serial No. 87/222,304.

Likelihood of Confusion, 15 U.S.C. § 1052(d)

12. Opposer repeats and alleges each and every allegation set forth in Paragraphs 1 through 11 above.

13. Opposer's use in commerce of its NPS Marks commenced, and Opposer's pleaded registrations issued, long prior to the November 1, 2016 filing date of Applicant's Application Serial No. 87/222,304 for the mark NET EMPATHY SCORE.

14. Applicant's NET EMPATHY SCORE so resembles in sight, sound, connotation and overall commercial impression Opposer's previously used NPS Marks as to be likely, when used in connection with Applicant's services covered by Application Serial No. 87/222,304, to cause confusion, or to cause mistake, or to deceive as to the source of the parties' respective goods and services under Section 2(d) of the Lanham Act, as amended, 15 U.S.C. § 1052(d).

WHEREFORE, Opposer believes that it will be damaged by the registration of the mark shown in Application Serial No. 87/222,304 and respectfully requests that this opposition be sustained and that registration to Applicant be refused.

A filing has been submitted electronically. If the filing fee is found to be insufficient for any reason, please charge such deficiency to our Deposit Account No. 500751.

Respectfully submitted,

BAIN & COMPANY, INC.

By its attorneys,

Dated: March 26, 2019

/Kimberly B. Herman/

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EXHIBIT A



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NET PROMOTER

Word Mark NET PROMOTER

Goods and Services IC 035. US 100 101 102. G & S: Business marketing consulting services; market research services; conducting business, customer satisfaction, customer loyalty and market research surveys. FIRST USE: 20040101. FIRST USE IN COMMERCE: 20040101

Standard Characters Claimed

Mark Drawing Code (4) STANDARD CHARACTER MARK

Serial Number 78326460

Filing Date November 11, 2003

Current Basis 1A

Original Filing Basis 1B

Published for Opposition August 3, 2004

Registration Number 2953691

Registration Date May 17, 2005

Owner (REGISTRANT) Satmetrix Systems, Inc. CORPORATION CALIFORNIA 3 Twin Dolphin Drive, Suite 225 Redwood City CALIFORNIA 94065

Assignment Recorded ASSIGNMENT RECORDED

Attorney of Record Todd S. Bontemps, Esq.

Type of Mark SERVICE MARK

3/24/2019

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Register PRINCIPAL
Affidavit Text SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20150513.
Renewal 1ST RENEWAL 20150513
Live/Dead Indicator LIVE

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NPS

Word Mark NPS

Goods and Services IC 035. US 100 101 102. G & S: Business consulting and information services; business consulting services, namely, customer and employee surveys, metrics and feedback processes for comparing, rating the quality of and improving performance, products, services, pricing, sales and marketing, customer experience and customer service; business consulting services, namely, customer and employee satisfaction and loyalty services. FIRST USE: 20030300. FIRST USE IN COMMERCE: 20030300

IC 041. US 100 101 107. G & S: Business training consulting services and employee training services; providing online publications in the nature of reports, articles, and newsletters and publication of printed matter in the field of business training consulting services and employee training services; providing online publications in the nature of reports, articles, and newsletters and publication of printed matter in the field of business consulting and information services; providing online publications in the nature of reports, articles, and newsletters and publication of printed matter in the field of business consulting services, namely, customer and employee surveys, metrics and feedback processes for comparing, rating the quality of and improving performance, products, services, pricing, sales and marketing, customer experience and customer service; providing online publications in the nature of reports, articles, and newsletters and publication of printed matter in the field of business consulting services, namely, customer and employee satisfaction and loyalty services; educational services, namely, providing web-based and classroom training of business leaders and employees for certification in the fields of profitable growth, improving performance, products, services, pricing, sales and marketing, customer experience and customer service, and customer and employee satisfaction and loyalty; providing online publications and publication of printed matters for the aforementioned educational services. FIRST USE: 20030300. FIRST USE IN COMMERCE: 20030300

Standard Characters Claimed

Mark Drawing Code (4) STANDARD CHARACTER MARK

Serial Number 86237989

Filing Date March 31, 2014

Current Basis 1A

3/24/2019

Trademark Electronic Search System (TESS)

Original Filing Basis 1A
Published for Opposition April 21, 2015
Registration Number 4766998
International Registration Number 1242315
Registration Date July 7, 2015
Owner (REGISTRANT) Bain & Company Inc. CORPORATION MASSACHUSETTS 131 Dartmouth Street Boston MASSACHUSETTS 02116
Assignment Recorded ASSIGNMENT RECORDED
Attorney of Record Kimberly B. Herman
Prior Registrations 3455429
Type of Mark SERVICE MARK
Register PRINCIPAL
Live/Dead Indicator LIVE

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NPS

Word Mark	NPS
Goods and Services	IC 035. US 100 101 102. G & S: Business consulting services, namely, a customer metrics and feedback process for performance improvement and business consulting services in the nature of customer satisfaction and customer loyalty services to the financial services, information technology, automotive, aerospace and defense, chemicals, construction and building, mining, real estate and consumer products fields. FIRST USE: 20051100. FIRST USE IN COMMERCE: 20051100
Standard Characters Claimed	
Mark Drawing Code	(4) STANDARD CHARACTER MARK
Trademark Search Facility Classification Code	LETTER-3-OR-MORE NPS Combination of three or more letters as part of the mark
Serial Number	78789466
Filing Date	January 11, 2006
Current Basis	1A
Original Filing Basis	1B
Published for Opposition	December 12, 2006
Registration Number	3455429
Registration Date	June 24, 2008
Owner	(REGISTRANT) BAIN & COMPANY, INC. CORPORATION MASSACHUSETTS 131 DARTMOUTH STREET BOSTON MASSACHUSETTS 02116 (REGISTRANT) REICHHELD, FRED INDIVIDUAL UNITED STATES 40 HAMPSHIRE ROAD WELLESLEY MASSACHUSETTS 02481

3/24/2019

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(REGISTRANT) SATMETRIX SYSTEMS, INC. CORPORATION CALIFORNIA 950 TOWER LANE, SUITE
500 FOSTER CITY CALIFORNIA 94404

Assignment Recorded	ASSIGNMENT RECORDED
Attorney of Record	Kimberly B. Herman
Type of Mark	SERVICE MARK
Register	PRINCIPAL
Affidavit Text	SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20171228.
Renewal	1ST RENEWAL 20171228
Live/Dead Indicator	LIVE

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NET EMPATHY SCORE

Word Mark	NET EMPATHY SCORE
Goods and Services	IC 035. US 100 101 102. G & S: Advertising and marketing services
Standard Characters Claimed	
Mark Drawing Code	(4) STANDARD CHARACTER MARK
Serial Number	87222304
Filing Date	November 1, 2016
Current Basis	1B
Original Filing Basis	1B
Published for Opposition	November 27, 2018
Owner	(APPLICANT) ICF CONSULTING GROUP, INC. CORPORATION DELAWARE 9300 LEE HIGHWAY FAIRFAX VIRGINIA 22031
Assignment Recorded	ASSIGNMENT RECORDED
Attorney of Record	John Pickerill
Disclaimer	NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "EMPATHY" APART FROM THE MARK AS SHOWN
Type of Mark	SERVICE MARK
Register	PRINCIPAL
Live/Dead Indicator	LIVE

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