

ESTTA Tracking number: **ESTTA590565**

Filing date: **03/04/2014**

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	HI MEDIA SA
Granted to Date of previous extension	03/05/2014
Address	15-17 rue Vivienne Paris, F-75002 FRANCE

Attorney information	Jeffrey A. Lindenbaum Collen IP, Intellectual Property Law, P.C. The Holyoke-Manhattan Building, 80 South Highland Avenue Ossining, NY 10562 UNITED STATES jlindenbaum@collenip.com, docket@collenip.com Phone:914-941-5668
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### Applicant Information

Application No	85781396	Publication date	11/05/2013
Opposition Filing Date	03/04/2014	Opposition Period Ends	03/05/2014
Applicant	iPay International SA 37, rue d'Anvers Luxembourg, LUX 1130 LUX		

### Goods/Services Affected by Opposition

<p>Class 009. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Apparatus for recording, transmission or reproductions of sound or images; electronic database in the field of computers, database management, smart cards, computer games, advertising, business operations, financial transactions, real estate, telecommunications, and computer and website design/hosting recorded onto magnetic data carriers; mechanisms for coin-operated apparatus; blank smart cards, magnetic coded cards for payment of goods/services and unlocking doors, blank electronic chip cards, software for database management, electronic payment services and computer games, computer software applications for database management, electronic payment services and computer games, software applications for database management, electronic payment services and computer games, calculating machines, cash registers; computers, computer and Internet servers, software for conducting telecommunications, semi-conductors, microprocessors, integrated circuits, computers for micro-programming, computer memories, computer peripherals, computer programs for database management, electronic payment services and computer games, data processing units and their parts; electronic apparatus and equipment for remote connection to a computer and/or telecommunications network</p>
<p>Class 036. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Financial affairs, namely, financial</p>

management, and financial planning; Monetary affairs, namely, electronic payment processing services, and debit and creditcard services; Financial analysis, and monetary consultation; Real estate affairs, namely, agency and brokerage services

Class 038. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Telecommunications services, namely, transfer of data, access services, and providing access to computer and Internet networks; Communications by means of the Internet, namely, providing access to a database, voice communication services, and personal communication services; Providing access to data networks

## Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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## Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	3616157	Application Date	07/25/2007
Registration Date	05/05/2009	Foreign Priority Date	NONE
Word Mark	HIPAY		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 0 First Use In Commerce: 0 Magnetic cards; data processors and computers; computer software for processingonline payments and electronic transferof money; recorded computer operating system programs; multimedia software for processing online payments and electronic transfer of money; computer search engine software; computer search software for databases; storage and retrieval computer software for use with databases</p> <p>Class 036. First use: First Use: 0 First Use In Commerce: 0 Insurance services in the nature of issuing payment warranties on financial transfer warranties for online banking services, for security credit and debit cardtransactions; monetary affairs, namely,electronic money transfers; online payment processing services, namely, credit and debit card transaction processing services; banking services; credit bureaus; providing financial information; financial management; management of financialtransfers and assets via an electronic platform, namely, on-line banking services; financial transactions performed by electronic means, namely, electronic transfer of money; banking services, namely, management of bank accounts</p> <p>Class 038. First use: First Use: 0 First Use In Commerce: 0 Telecommunication access services; electronic transmission of messages and data; communication by electronic computer terminals; computer-assisted transmissionof messages and images; telephone or computer terminals communications; news agency services, namely, the transmission of news items to news reporting organizations; provision of access to a global computer network; connection by means of telecommunications to a global computer network</p>		

Related Proceedings	85781428, 85781458
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Attachments	79045117#TMSN.jpeg( bytes ) P1386_notice of opposition_140304 396 APP.pdf(23020 bytes ) Ex A HIPAY Reg 3-4-14.pdf(37496 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	/Jeffrey A. Lindenbaum/
Name	Jeffrey A. Lindenbaum
Date	03/04/2014

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

Applicant : iPay International SA  
Serial No. : 85/781,396  
Filed : November 16, 2012  
For : IPAYTAG  
Published : November 5, 2013

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, Virginia 22313

**NOTICE OF OPPOSITION**

The Opposer, Hi Media SA (“Hi Media” or “Opposer”) of 15-17 rue Vivienne F-75002 Paris France a corporation duly organized and existing under the laws of France, by its attorneys files this Notice of Opposition against iPay International SA (referred to as “Applicant”) because it believes it would be damaged by the registration of the mark described in the above-identified application in International Classes 009, 036 and 038, and hereby opposes the application in these Classes, pursuant to 15 USC § 1063 and 37 CFR § 2.104.

As grounds for the opposition, it is alleged that:

1. Opposer is the owner of the entire right, title, and interest in Federal trademark Registration Number 3,616,157 for the mark HIPAY. See Exhibit A.
2. Opposer has used the HIPAY mark in commerce in Classes 009, 036 and 038 and has acquired valuable goodwill and recognition for its mark. The public has come to associate the HIPAY mark with Opposer and Opposer’s goods and services.

3. The HIPAY mark is famous and has acquired distinctiveness.
4. Opposer is and has been engaged in the sale of goods and services in the United States under its HIPAY mark since a date prior to Applicant's use of Applicant's mark, and prior to the filing of Applicant's subject application.
5. Opposer has used its HIPAY mark in commerce and been actively expanding use of its HIPAY mark, including in connection with goods and services in International Classes 009, 036 and 038 since a time prior to the date of the Applicant's trademark application. As a result of its use, Opposer has acquired rights in its HIPAY mark.
6. Upon information and belief, Applicant has not commenced use of its mark in the United States.
7. Opposer's HIPAY mark is well recognized by consumers.
8. Consumers encountering Applicant's mark and goods and services are likely to believe that such goods and services originate from, or are authorized or sponsored by Opposer.
9. Applicant's mark is confusingly similar to Opposer's HIPAY mark.
10. Upon information and belief, Opposer's HIPAY mark and Applicant's mark are likely to be encountered through the same or similar channels of distribution.

11. Upon information and belief, Applicant has adopted its mark with full knowledge of Opposer's HIPAY mark.

12. If registered, Applicant's mark is likely to cause confusion, or to cause mistake or to deceive.

13. Use of Applicant's mark by Applicant will dilute Opposer's famous HIPAY Mark.

Opposer therefore prays that Applicant's application (Serial No. 85/781,396) be refused in Classes 009, 036 and 038, that no registration be issued thereon to Applicant in Classes 009, 036 and 038, and that this Opposition be sustained in favor of Opposer.

Respectfully submitted for  
HI MEDIA SA

By: /Jeffrey A. Lindenbaum/  
Jeffrey A. Lindenbaum  
Jess M. Collen  
COLLEN IP  
The Holyoke-Manhattan Building  
80 South Highland Ave.  
Ossining, New York 10562  
Tel: (914) 941-5668  
Fax: (914) 941-6091  
[jlindenbaum@collenip.com](mailto:jlindenbaum@collenip.com)

DATED: March 4, 2014

Filing Fee (3 Classes): \$900  
Encl. Exhibit A

SHOULD ANY OTHER FEE BE REQUIRED, THE PATENT AND TRADEMARK OFFICE IS HEREBY REQUESTED TO CHARGE SUCH FEE TO OUR DEPOSIT ACCOUNT 03-2465.

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING FILED THROUGH THE ELECTRONIC SYSTEM FOR TRADEMARK TRIAL AND APPEALS IN THE UNITED STATES PATENT AND TRADEMARK OFFICE.

COLLEN *IP*, THE HOLYOKE-MANHATTAN BUILDING, 80 SOUTH HIGHLAND AVENUE, OSSINING, NEW YORK 10562

By: /Jeffrey A. Lindenbaum/ Date: March 4, 2014

**CERTIFICATE OF SERVICE**

I, Jeffrey A. Lindenbaum, hereby certify that I caused a true and correct copy of the foregoing Notice of Opposition to be served upon:

BARBARA H. LOEWENTHAL  
GOTTLIEB RACKMAN & REISMAN  
270 MADISON AVE FL 8  
NEW YORK, NEW YORK 10016-0601  
[bloewenthal@grr.com](mailto:bloewenthal@grr.com)

via first-class mail and email, postage pre-paid on this 4<sup>th</sup> day of March, 2014.

\_\_\_\_\_/Jeffrey A. Lindenbaum/\_\_\_\_\_  
\_\_\_\_\_

EXHIBIT A

EXHIBIT A

Generated on: This page was generated by TSDR on 2014-03-04 14:46:56 EST

Mark: HIPAY

# HIPAY

US Serial Number: 79045117

Application Filing Date: Jul. 25, 2007

US Registration Number: 3616157

Registration Date: May 05, 2009

Register: Principal

Mark Type: Trademark, Service Mark

Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.

Status Date: May 05, 2009

Publication Date: Feb. 17, 2009

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## Mark Information

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Mark Literal Elements: HIPAY

Standard Character Claim: No

Mark Drawing Type: 5 - AN ILLUSTRATION DRAWING WITH WORD(S) /LETTER(S)/ NUMBER(S) INSTYLIZED FORM

Color(s) Claimed: Color is not claimed as a feature of the mark.

Translation: "HIPAY" appearing in the mark has no meaning in a foreign language.

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## Related Properties Information

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International Registration Number: 0940668

International Registration Date: Jul. 25, 2007

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## Goods and Services

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Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of
- Asterisks \*..\* identify additional (new) wording in the goods/services.

**For:** Magnetic cards; data processors and computers; computer software for processing online payments and electronic transfer of money; recorded computer operating system programs; multimedia software for processing online payments and electronic transfer of money; computer search engine software; computer search software for databases; storage and retrieval computer software for use with databases

International Class(es): 009 - Primary Class

U.S Class(es): 021, 023, 026, 036, 038

Class Status: ACTIVE

Basis: 66(a)

**For:** Insurance services in the nature of issuing payment warranties on financial transfer warranties for online banking services, for security credit and debit card transactions; monetary affairs, namely, electronic money transfers; online payment processing services, namely, credit and debit card transaction processing services; banking services; credit bureaus; providing financial information; financial management; management of financial transfers and assets via an electronic platform, namely, on-line banking services; financial transactions performed by electronic means, namely, electronic transfer of money; banking services, namely, management of bank accounts

International Class(es): 036 - Primary Class

U.S Class(es): 100, 101, 102

Class Status: ACTIVE

Basis: 66(a)

**For:** Telecommunication access services; electronic transmission of messages and data; communication by electronic computer terminals; computer-assisted transmission of messages and images; telephone or computer terminals communications; news agency services, namely, the transmission of news items to news reporting organizations; provision of access to a global computer network; connection by means of telecommunications to a global computer network

International Class(es): 038 - Primary Class

U.S Class(es): 100, 101, 104

Class Status: ACTIVE

Basis: 66(a)

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## Basis Information (Case Level)

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Filed Use: No

Currently Use: No

Amended Use: No

Filed ITU: No	Currently ITU: No	Amended ITU: No
Filed 44D: No	Currently 44D: No	Amended 44D: No
Filed 44E: No	Currently 44E: No	Amended 44E: No
Filed 66A: Yes	Currently 66A: Yes	
Filed No Basis: No	Currently No Basis: No	

## Current Owner(s) Information

**Owner Name:** HI MEDIA  
**Owner Address:** 15-17 rue Vivienne  
F-75002 PARIS  
FRANCE  
**Legal Entity Type:** Société anonyme à conseil d'Administration  
**State or Country Where Organized:** FRANCE

## Attorney/Correspondence Information

### Attorney of Record

**Attorney Name:** Jess M. Collen  
**Docket Number:** H408

### Correspondent

**Correspondent Name/Address:** Jess M. Collen  
COLLEN IP, Intellectual Property Law, PC  
80 South Highland Avenue  
The Holyoke-Manhattan Building  
Ossining, NEW YORK 10562  
UNITED STATES

**Phone:** (914) 941-5668

**Fax:** (914) 941-6091

### Domestic Representative

**Domestic Representative Name:** Jess M. Collen

**Phone:** (914) 941-5668

**Fax:** (914) 941-6091

## Prosecution History

Date	Description	Proceeding Number
Apr. 21, 2013	FINAL DECISION TRANSACTION PROCESSED BY IB	
Mar. 13, 2012	LIMITATION FROM THE IB EXAMINED, NO ACTION IS NEEDED	72589
Dec. 23, 2011	RESTRICTION OF HOLDER'S RIGHT OF DISPOSAL RECEIVED	
Apr. 16, 2011	CHANGE OF NAME/ADDRESS REC'D FROM IB	
Aug. 13, 2009	FINAL DISPOSITION NOTICE SENT TO IB	
Aug. 13, 2009	FINAL DISPOSITION PROCESSED	67445
Aug. 05, 2009	FINAL DISPOSITION NOTICE CREATED, TO BE SENT TO IB	
May 05, 2009	REGISTERED-PRINCIPAL REGISTER	
Apr. 30, 2009	NOTIFICATION OF POSSIBLE OPPOSITION - PROCESSED BY IB	
Apr. 16, 2009	NOTIFICATION OF POSSIBLE OPPOSITION SENT TO IB	
Apr. 16, 2009	NOTIFICATION OF POSSIBLE OPPOSITION CREATED, TO BE SENT TO IB	
Feb. 17, 2009	PUBLISHED FOR OPPOSITION	
Jan. 28, 2009	NOTICE OF PUBLICATION	
Jan. 12, 2009	LAW OFFICE PUBLICATION REVIEW COMPLETED	70468
Jan. 08, 2009	EXAMINERS AMENDMENT MAILED	
Jan. 07, 2009	APPROVED FOR PUB - PRINCIPAL REGISTER	
Jan. 07, 2009	EXAMINER'S AMENDMENT ENTERED	88888
Jan. 07, 2009	EXAMINERS AMENDMENT -WRITTEN	81094
Dec. 03, 2008	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
Dec. 03, 2008	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
Dec. 03, 2008	TEAS REQUEST FOR RECONSIDERATION RECEIVED	
Oct. 10, 2008	UNDELIVERABLE MAIL - NO ACTION TAKEN	99888

Jun. 03, 2008	FINAL REFUSAL MAILED	
Jun. 03, 2008	FINAL REFUSAL WRITTEN	81094
May 20, 2008	ASSIGNED TO LIE	70468
May 19, 2008	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
May 19, 2008	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
May 19, 2008	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
May 15, 2008	ATTORNEY REVOKED AND/OR APPOINTED	
May 15, 2008	TEAS REVOKE/APPOINT ATTORNEY RECEIVED	
Dec. 14, 2007	REFUSAL PROCESSED BY IB	
Nov. 27, 2007	NON-FINAL ACTION MAILED - REFUSAL SENT TO IB	
Nov. 27, 2007	REFUSAL PROCESSED BY MPU	72589
Nov. 27, 2007	NON-FINAL ACTION (IB REFUSAL) PREPARED FOR REVIEW	
Nov. 26, 2007	NON-FINAL ACTION WRITTEN	81094
Nov. 16, 2007	ASSIGNED TO EXAMINER	81094
Nov. 16, 2007	NEW APPLICATION ENTERED IN TRAM	
Nov. 15, 2007	SN ASSIGNED FOR SECT 66A APPL FROM IB	

### International Registration Information (Section 66a)

<b>International Registration Number:</b> 0940668	<b>International Registration Date:</b> Jul. 25, 2007
<b>Priority Claimed Flag:</b> Yes	<b>Date of Section 67 Priority Claim:</b> Jan. 29, 2007
<b>Intl. Registration Status:</b> REQUEST FOR EXTENSION OF PROTECTION PROCESSED	<b>Date of International Registration Status:</b> Nov. 15, 2007
<b>Notification of Designation Date:</b> Nov. 15, 2007	<b>Date of Automatic Protection:</b> May 15, 2009
<b>International Registration Renewal Date:</b> Jul. 25, 2017	
<b>First Refusal Flag:</b> Yes	

### TM Staff and Location Information

#### TM Staff Information - None

#### File Location

**Current Location:** PUBLICATION AND ISSUE SECTION      **Date in Location:** May 05, 2009

### Assignment Abstract Of Title Information

#### Summary

**Total Assignments:** 1

**Registrant:** HI MEDIA

#### Assignment 1 of 1

**Conveyance:** CHANGE OF ADDRESS

**Reel/Frame:** [4523/0437](#)

**Pages:** 2

**Date Recorded:** Apr. 16, 2011

**Supporting Documents:** [assignment-tm-4523-0437.pdf](#)

#### Assignor

**Name:** [HI MEDIA](#)

**Execution Date:** Mar. 02, 2011

**Legal Entity Type:** UNKNOWN

**State or Country Where Organized:** FRANCE

#### Assignee

**Name:** [HI MEDIA](#)

**Legal Entity Type:** UNKNOWN

**State or Country Where Organized:** No Place Where Organized Found

**Address:** 15-17 RUE VIVIENNE  
F-75002 PARIS, FRANCE

#### Correspondent

**Correspondent Name:** HI MEDIA

**Correspondent Address:** 15-17 RUE VIVIENNE  
F-75002 PARIS  
FRANCE

**Domestic Representative - Not Found**