ESTTA Tracking number: **ESTTA598873**
Filing date: **04/16/2014**

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

Proceeding	91215251
Party	Defendant iPay International SA
Correspondence Address	BARBARA H. LOEWENTHAL GOTTLIEB RACKMAN & REISMAN 270 MADISON AVE FL 8 NEW YORK, NY 10016-0601 efiling@grr.com;bloewenthal@grr.com
Submission	Other Motions/Papers
Filer's Name	Barbara Lowenthal
Filer's e-mail	bloewenthal@grr.com,efiling@grr.com
Signature	/bloewenthal/
Date	04/16/2014
Attachments	IPAYTAG - Motion for Ext. of Time to File Answer - Opp. 91215251.pdf(122185 bytes) IPAYTAG - Answer - Opp. 91215251.pdf(87995 bytes)

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

In the matter of Application Serial No. 85/781,396
Published: November 5, 2013
Mark: IPAYTAG

Hi Media SA, Opposer, - v - iPay International SA Applicant.	Opposition No. 91/215,251 Serial No.: 85/781,396

MOTION FOR EXTENSION OF TIME TO FILE ANSWER

Applicant, through its undersigned counsel requests leave to file an Answer to the Notice of Opposition, attached herewith. The deadline for filing the Answer was April 14, 2014. Due to the holidays and because of Internet problems, as discussed further below, the undersigned counsel did not receive instructions from its client until April 15, 2014, one day after the deadline for filing the Answer. For these reasons, this request is being sought and the undersigned seeks the Board's approval of the same.

I. Background

The background for this request is as follows:

On November 16, 2012 Applicant filed an Application for iPayTag in Serial No. 85/781,396 in Classes 9, 35, 36, 38 and 42. Applicant timely responded to the outstanding Office Action that was issued by the United States Patent and Trademark Office (PTO) on March 13, 2013. The Application was published for Opposition on November 5, 2013.

On March 4, 2014 Opposer filed a Notice of Opposition. The deadline for filing an to the Notice of Opposition was April 14, 2014 (the deadline set by the Trademark Trial and Appeal Board (TTAB) was April 13, 2013, which was a Sunday, accordingly, the deadline to Answer was April 14, 2014). The undersigned counsel had sent various communications to its client, a foreign associate in France which represents the Applicant, advising same of the deadline for filing the Notice of Opposition and requesting its instructions.

On April 15, 2014, upon receipt of a further reminder and upon review of prior correspondence from the undersigned counsel, the associate communicated with the undersigned and advised that: (a) it has been and is still out of the office due to holidays; and (b) its firm has been encountering trouble with its e-mails and did not receive some of our correspondence to it regarding the Oppositions and the deadline; and (c) it has been difficult for it to receive instructions from the Applicant. All of the foregoing factors have resulted in the delay for Answering the Opposition.

Moreover, the evening of April 14, 2014 is the beginning of the Passover holiday. On April 15, 2014, the undersigned counsel for Applicant attempted to contact Opposer's counsel to ascertain whether it would consent to leave to file this motion and the Answer, but, counsel for Opposer is not in the office due to the holiday. In fact, numerous attorneys are out of the office because of the Jewish holidays.

Due to the above, it was not until April 15, 2015 that the undersigned received instructions from its client requesting that it file an Answer to the Notice of Opposition. For the reasons set for the below, it is requested that the Answer be accepted by the TTAB.

II. Legal Standard

In accordance with TBMP §312.01 if a defendant realizes that it has not timely filed an Answer to a Notice of Opposition, it may file a motion asking that its late filed Answer be

The standard for determining whether default judgment should be entered against the defendant for its failure to file a timely Answer to the complaint is Fed. R. Civ. P. 55(c), that is, whether the defendant has shown good cause why default judgment should not be entered against it. A showing of "good cause" is usually found to have been established if: (a) the delay in filing is not the result of willful conduct or gross negligence on the part of the defendant; (b) the delay will result in substantial prejudice to plaintiff; and (c) the defendant has meritorious defense.

In Fred Hayman Beverly Hills Inc. v. Jacques Bernier Inc., 21 U.S.P.Q.2d 1556 (TTAB 1991), applicant filed an Answer to a Notice of Opposition nine days after expiration of the deadline as set by the TTAB. Applicant indicated that although the answer was prepared prior to the deadline, applicant's counsel went on vacation and did not file the answer until he returned to the office, after expiration of the deadline. The Board granted applicant's motion stating:

> In the present case, the failure to timely file the answer was clearly due to an inadvertence on the part of applicant's counsel and not the result of any willful conduct or gross neglect. Moreover, the nine day delay in the filing of the answer will cause minimal prejudice to opposer. Finally, by submission of an answer which is not frivolous, applicant has adequately shown that it has a meritorious defense.

Id. at 1557.

The foregoing factors are applicable here. As to the first factor, there was no willful conduct or gross neglect on the part of Applicant. There was no intent on the part of Applicant to allow the Application to become abandoned and to not answer the Notice of Opposition. As stated above there was a delay in communication between the undersigned, its client and the Applicant. Moreover, there was no prejudice to Opposer since the delay in filing an Extension of Time is only two (2) days. Accordingly, there is no prejudice to Opposer.

Lastly, because of the overall differences in the respective marks of the parties, and the dilution of the prefix "PAY," Applicant believes it has a meritorious defense.

In view of the above, it is requested that this Motion for Extension of Time be granted and that the TTAB consider the Answer.

Dated: April 16, 2014

Respectfully submitted,

GOTTLIEB, RACKMAN & REISMAN, P.C.

Barbara H. Loewenthal
Jonathan Purow
Attorney for Applicant
270 Madison Avenue
New York, NY 10016
(212) 684-3900

CERTIFICATE OF FILING/MAILING

I hereby certify that this MOTION FOR EXTENSION OF TIME TO FILE ANSWER is being electronically transmitted to the Trademark Trial and Appeal Board through the Electronic System for Trademark Trials and Appeals (ESTTA) this 16th day of April, 2014.

Dated: April 16, 2014

Madelin Rowland

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing MOTION FOR EXTENSION OF TIME TO FILE ANSWER was served on Jeffrey A. Lindenbaum, counsel of record for Opposer on April 16, 2014, via first class mail, postage prepaid, addressed as follows:

Jeffrey A. Lindenbaum
Jess M. Collen
COLLEN IP
The Holyoke-Manhattan Building
80 South Highland Ave.
Ossining, New York 10562

Dated: April 16, 2014

Madelin Rowland

S:\MADELIN\DIANA MULLER\LDBM SOCIETE AVOCATS\OPP. 91215251 AGAINST IPAYTAG - SN 85781396\IPAYTAG MOTION 4-15-14.DOCX

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

In the matter of Application Serial No. 85/781,396
Published: November 5, 2013
Mark: IPAYTAG

Hi Media SA, Opposer, - v - iPay International SA Applicant.	Opposition No. 91/215,251 Serial No.: 85/781,396

ANSWER TO NOTICE OF OPPOSITION

iPay International SA, ("Applicant") a corporation of Luxembourg, located at 37, rue D'Anvers, Luxembourg, Luxembourg 1130, by its Attorneys Gottlieb, Rackman & Reisman, P.C., Answers the Notice of Opposition as follows:

1. Applicant admits that the Opposer, Hi Media S.A. ("Hi Media or Opposer) filed a Notice of Opposition and without knowledge or information sufficient to form a belief as to the truth of the remaining allegations in the first unnumbered paragraph of the Notice of Opposition and therefore denies the same.

2. Applicant is without knowledge or information sufficient to form a belief as the truth of the allegations in paragraph 1 of the Notice of Opposition and therefore denies the same.

3. Applicant is without knowledge or information sufficient to form a belief as the truth of the allegations in paragraph 2 of the Notice of Opposition and therefore denies the same.

4. Applicant is without knowledge or information sufficient to form a belief as the truth of the allegations in paragraph 3 of the Notice of Opposition and therefore denies the same.

5. Applicant is without knowledge or information sufficient to form a belief as the truth of the allegations in paragraph 4 of the Notice of Opposition and therefore denies the same.

6. Applicant is without knowledge or information sufficient to form a belief as the truth of the allegations in paragraph 5 of the Notice of Opposition and therefore denies the same.

7. Applicant is without knowledge or information sufficient to form a belief as the truth of the allegations in paragraph 6 of the Notice of Opposition and therefore denies the same.

8. Applicant is without knowledge or information sufficient to form a belief as the truth of the allegations in paragraph 7 of the Notice of Opposition and therefore denies the same.

9. Applicant denies the allegations in paragraph 9 of the Notice of Opposition.

10. Applicant denies the allegations in paragraph 10 of the Notice of Opposition.

11. Applicant denies the allegations in paragraph 11 of the Notice of Opposition.

12. Applicant denies the allegations in paragraph 12 of the Notice of Opposition.

13. Applicant denies the allegations in paragraph 13 of the Notice of Opposition.

AFFIRMATIVE DEFENSES

14. Opposer fails to state a claim upon which any relief can be granted. Rule 12(b) of the Federal Rules of Civil Procedure.

15. In addition to Opposer's marks, there are numerous other companies that have used and are using and/or have registered marks incorporating the suffix "PAY" for goods or services that may be considered related to the services identified in Opposer's marks.

16. Opposer has permitted, either actually or constructively, the use by others of marks bearing the term "PAY," and variations thereof, in whole or in part, for products identical or similar to those used by Opposer, such that Opposer is estopped from complaining about Applicant.

17. There are sufficient differences between the marks of the parties here such that there is no likelihood of confusion arising from the parties' use of their respective marks.

WHEREFORE, Applicant respectfully requests that the Board dismiss the Notice of Opposition with prejudice.

Dated: April 16, 2014

Respectfully submitted,

GOTTLIEB, RACKMAN & REISMAN, P.C.

Barbara Loewenthal
Jonathan Purow
Attorney for Applicant
270 Madison Avenue
New York, NY 10016
(212) 684-3900

CERTIFICATE OF FILING/MAILING

I hereby certify that this ANSWER is being electronically transmitted to the Trademark Trial and Appeal Board through the Electronic System for Trademark Trials and Appeals (ESTTA) this 16th day of April, 2014.

Dated: April 16, 2014

Madelin Rowland

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing ANSWER was served on Jeffrey A. Lindenbaum, counsel of record for Opposer on April 16, 2014, via first class mail, postage prepaid, addressed as follows:

Jeffrey A. Lindenbaum
Jess M. Collen
COLLEN IP
The Holyoke-Manhattan Building
80 South Highland Ave.
Ossining, New York 10562

Dated: April 16, 2014

Madelin Rowland

S:\MADELIN\DIANA MULLER\LDBM SOCIETE AVOCATS\OPP. 91215251 AGAINST IPAYTAG - SN 85781396\ANSWER HIPAY4-15-14.DOCX