

ESTTA Tracking number: **ESTTA644436**

Filing date: **12/15/2014**

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	Primepay, Inc.
Granted to Date of previous extension	12/14/2014
Address	1487 Dunwoody Drive West Chester, PA 19380 UNITED STATES
Attorney information	Mark Lebow Ladas & Parry 1727 King Street Suite 105 Alexandria, VA 22314 UNITED STATES mlebow@ladas.com, lebow@ttab.org Phone:703-837-9600

Applicant Information

Application No	86002242	Publication date	06/17/2014
Opposition Filing Date	12/15/2014	Opposition Period Ends	12/14/2014
Applicant	PrimeClerk, LLC 240 Riverside Blvd, PH2B New York, NY 10069 UNITED STATES		

Goods/Services Affected by Opposition

<p>Class 035. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: BUSINESS ASSISTANCE, ADVISORY AND CONSULTING SERVICES RELATED TO ORGANIZING, PREPARING, PROCESSING AND ANALYZING CLAIMS, PLEADINGS, AND OTHER PAPERWORK IN THE FIELDS OF BANKRUPTCY, FINANCIAL INSOLVENCY AND DEBT RESTRUCTURING, LAW, AND FIDUCIARY SERVICES; BUSINESS CONSULTING AND INFORMATION SERVICES; PROVIDING BUSINESSADMINISTRATION SUPPORT RELATED TO BANKRUPTCY, FINANCIAL INSOLVENCY AND DEBT RESTRUCTURING, LAW, AND FIDUCIARY SERVICES INDUSTRIES; PROVIDING AN ON-LINE SEARCHABLE DATABASE IN THE FIELD OF BUSINESS INFORMATION; COLLECTING, COMPILING AND SYSTEMATIZING INFORMATION INTO COMPUTER DATABASES AND DATABASE MANAGEMENT OF SAME; PREPARING FINANCIAL REPORTS FOR OTHERS, NAMELY, PREPARING SCHEDULES AND STATEMENTS FOR OTHERS IN THE FIELDS OF BANKRUPTCY, FINANCIAL INSOLVENCY AND DEBT RESTRUCTURING, LAW, AND FIDUCIARY SERVICES; LITIGATION SUPPORT SERVICES IN THE NATURE OF LEGAL DOCKET MANAGEMENT SERVICES FOR OTHERS IN THE BANKRUPTCY, INSOLVENCY AND RESTRUCTURING, LAW, AND FIDUCIARY SERVICES INDUSTRIES</p>
<p>Class 042. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: PROVIDING TEMPORARY USE OF ON-</p>

LINE, NON-DOWNLOADABLE SOFTWARE THAT ENABLES USERSTO SEARCH, ORGANIZE, SUBMIT AND PROCESSCLAIMS, PLEADINGS, AND DOCUMENTS IN CASES OF BANKRUPTCY, INSOLVENCY, FINANCIAL RESTRUCTURING AND FIDUCIARY SERVICES

Class 045. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: PROVIDING AN ON-LINE SEARCHABLE DATABASE IN THE FIELD OF BANKRUPTCY

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.	2056092	Application Date	06/01/1995
Registration Date	04/22/1997	Foreign Priority Date	NONE
Word Mark	PRIMEPAY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 1995/08/01 First Use In Commerce: 1995/08/01 providing business and financial management services		

U.S. Registration No.	2965713	Application Date	08/29/2003
Registration Date	07/12/2005	Foreign Priority Date	NONE
Word Mark	PRIMETAX		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 1995/07/31 First Use In Commerce: 1995/07/31 Tax payment processing services; payroll tax debiting services		

U.S. Registration No.	2941188	Application Date	08/29/2003
Registration Date	04/19/2005	Foreign Priority Date	NONE
Word Mark	PRIMEXPORTS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2001/12/21 First Use In Commerce: 2001/12/21		

	Software for creating custom tax reports for use in a spreadsheet
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U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	PRIMEPAY		
Goods/Services	PAYROLL TAX GOODS AND SERVICES		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	PRIMETAX		
Goods/Services	PAYROLL TAX GOODS AND SERVICES		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	PRIMEPEXPORTS		
Goods/Services	TAX SOFTWARE		

Attachments	76544205#TMSN.png(bytes) 76544207#TMSN.png(bytes) 2014-12-15 Notice of Opposition af.pdf(20442 bytes) 1997-04-22 Registration Certificate - Reg. No. 2056092.pdf(16685 bytes) 2014-12-15 TARR Status - Reg. No. 2056092.pdf(94873 bytes) 2005-07-12 Registration Certificate - Reg. No. 2965713.pdf(12782 bytes) 2014-12-15 TARR Status - Reg. No. 2965713.pdf(102798 bytes) 2005-04-19 Registration Certificate - Reg. No. 2941188.pdf(13097 bytes) 2014-12-15 TARR Status - Reg. No. 2941188.pdf(102972 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	/ml/
Name	Mark Lebow
Date	12/15/2014

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

PRIMEPAY, INC.,

Opposer,

v.

PRIMECLERK, LLC,

Applicant.

Opposition No.

Serial No. 86002242

NOTICE OF OPPOSITION

Opposer PRIMEPAY, INC., is a Virginia corporation with offices located at 1487 Dunwoody Drive, West Chester, PA 19380.

Applicant, PRIMECLERK, LLC, is a Delaware LLC with offices located at 240 Riverside Blvd., PH2B, New York, New York 10069.

Opposer believes that it will be damaged by registration of the mark “PRIME CLERK” as depicted in pending U.S. Application Serial No. 86002242 for services recited in International Classes 35, 42 and 45 and hereby opposes registration of the same.

The grounds for opposition are as follows:

1. Opposer is a full service employee management and solutions provider that renders a full range of integrated payroll and HR support goods and services, which include the provision of tax services in the nature of tax software

platforms and flexible benefit administration services with tax processing and payment services. Opposer has been in business for over 27 years, operates in all 50 states, and has more than 30 offices nationwide.

2. Since long prior to the filing date of the application herein opposed, Opposer adopted and commenced use of the term “PRIME” as the first word and syllable of a family of unitary, compound marks having the prefix “PRIME”. This family of marks includes but is not limited to the marks PRIMEPAY, PRIMEXCREEN, PRIMECLOCK, PRIMEUCC, PRIMECOMP, PREMEXPORTS, PRIMEFLEX, PRIMETAX, PRIMELINK, and PRIMEXPRESS for its various goods and services.
3. Opposer began to use the mark PRIMEPAY on or in connection with its goods and services including tax software and tax services, alone and/or with other elements, since at least as early as August 1995.
4. Opposer began to use the mark PRIMETAX on or in connection with its services including tax services, alone and/or with other elements, since at least as early as July 1995.
5. Opposer began to use the mark PRIMEEXPORTS on or in connection with tax software goods, alone and/or with other elements, since at least as early as July 1995.

6. Opposer has used its marks and family of PRIME-based marks, including the PRIMEPAY, PRIMETAX and PRIMEXPORT marks, continuously with the aforesaid goods or services since their respective dates of first use and since long before Applicant's filing date. The goods and services provided or rendered in connection with Opposer's Marks have been extensively advertised and promoted and are provided or rendered in commerce throughout the United States.

7. By virtue of the long, continued advertising, promotion, sale and/or rendering of its goods and services in connection with Opposer's Marks, as well as the high quality of those goods and services, Opposer's Marks are relied upon by the trade and public as specifically identifying Opposer's goods and services and distinguishing them from others. As a result, Opposer's Marks have developed valuable good will that belongs exclusively to Opposer.

8. In addition to its common law rights, Opposer is the owner of the following incontestable trademark registrations ("Opposer's Registrations") in the United States Patent and Trademark Office:

MARK	REG. NO.	REG. DATE	GOODS/SERVICES

PRIMEPAY	2056092	4/22/1997	Providing business and financial management services
PRIMETAX	2965713	7/12/2005	Tax payment processing services; payroll tax debiting services
PRIMEEXPORTS	2941188	4/19/2005	Software for creating custom tax reports for use in a spreadsheet

Copies of the registration certificates and electronic status records for these registrations, which are valid, subsisting, and in full force and effect, are attached hereto as Exhibit A.

9. By the application herein opposed, Serial No. 86002242, Applicant seeks to register the designation “PRIME CLERK” as a trademark for the following services:

Class 35: Business assistance, advisory and consulting services related to organizing, preparing, processing and analyzing claims, pleadings, and other paperwork in the fields of bankruptcy, financial insolvency and debt restructuring, law, and fiduciary services; business consulting and information services; providing business administration support related to bankruptcy,

financial insolvency and debt restructuring, law and fiduciary services industries; providing an on-line searchable database in the field of business information; collecting, compiling and systematizing information into computer databases and database management of same; preparing financial reports for others, namely, preparing schedules and statements for others in the fields of bankruptcy, financial insolvency and debt restructuring, law, and fiduciary services; litigation support services in the nature of legal docket management services for others in the bankruptcy, insolvency and restructuring law, and fiduciary services industries;

Class 42: Providing temporary use of online, non-downloadable software that enables users to search, organize, submit and process claims, pleadings, and documents in cases of bankruptcy, insolvency, financial restructuring and fiduciary services” and

Class 45: Providing an on-line searchable database in the field of bankruptcy.

10. Upon information and belief, Applicant did not use the mark “PRIME CLERK” in commerce on or in connection with the applied for services before the dates of use referenced for Opposer’s marks in paragraphs 3, 4 and 5 above, or before the priority dates, filing dates, or registration date accorded to Opposer’s registrations referenced in paragraph 8 above. Priority is not an issue.
11. Applicant’s Mark “PRIME CLERK” is confusingly similar in appearance, sound, connotation and commercial impression to Opposer’s Marks.
12. The services for which Applicant seeks registration are closely similar to, overlapping with, identical to, or otherwise related to the goods and services provided and rendered by Opposer through Opposer’s Marks.
13. Upon information and belief, the goods and services provided on or in connection with Opposer’s Marks and the services covered by Application Serial

- No. 86002242 are intended to be directed to similar or identical classes of purchasers and/or to be distributed through overlapping or identical channels of trade in the United States.
14. Applicant's use of the mark depicted in Application Serial No. 86002242 interferes with Opposer's use of Opposer's Marks and is likely to cause the public to believe that the goods and services of Applicant originate with Opposer, or vice versa, or that Applicant is owned or controlled by or in some manner affiliated or associated with Opposer, or vice versa, and is otherwise likely to cause confusion, cause mistake or deceive.
 15. Any defect, inadequacy or deficiency found in Applicant's goods marketed, sold or otherwise provided under the mark depicted in Application Serial No. 86002242 would reflect negatively upon and seriously injure the reputation and goodwill associated with the goods provided by Opposer and provided in connection Opposer's Marks and family of marks.
 16. If Applicant were granted a registration based on Application Serial No. 86002242, Applicant would thereby obtain at least a *prima facie* exclusive right to use the mark PRIME CLERK mark depicted in Application Serial No. 86002242. Any such registration would be a source of damage and injury to Opposer and its customers.

WHEREFORE, Opposer prays that Application Serial No. 86002242 be rejected, that no registration be issued thereon to Applicant, and that this opposition be sustained in favor of Opposer.

December 15, 2014

Respectfully submitted,

/Mark Lebow/
Mark Lebow
Attorney for Opposer
Ladas & Parry
1727 King Street, Suite 105
Alexandria, VA 22314
Tel: (703) 837-9600

CERTIFICATE OF SERVICE

I hereby certify the foregoing Notice of Opposition was served by U.S. mail, postage prepaid, to Applicant's counsel of record, Joel Karni Schmidt, Esq., Cowan, Liebowitz & Latman, P.C., 1133 Avenue of the Americas, New York, NY 10036-6710 this 15th day of December 2014.

/Joy Climo/
Joy Climo

EXHIBIT A

Int. Cl.: 35

Prior U.S. Cls.: 100, 101, and 102

Reg. No. 2,056,092

United States Patent and Trademark Office

Registered Apr. 22, 1997

**SERVICE MARK
PRINCIPAL REGISTER**

PRIMEPAY

PRIMEPAY, INC. (VIRGINIA CORPORATION)
301 LINDENWOOD DRIVE
SUITE 100
MALVERN, PA 19355 ASSIGNEE OF AUTO-
TAX, INC. (VIRGINIA CORPORATION)
MCLEAN, VA 22102

FOR: PROVIDING BUSINESS AND FINAN-
CIAL MANAGEMENT SERVICES, IN CLASS 35
(U.S. CLS. 100, 101 AND 102).
FIRST USE 8-1-1995; IN COMMERCE
8-1-1995.

SN 74-682,810, FILED 6-1-1995.

MARY CRAWFORD, EXAMINING ATTORNEY

STATUS **DOCUMENTS**[Back to Search](#)[Print](#)**Generated on:** This page was generated by TSDR on 2014-12-15 13:38:35 EST**Mark:** PRIMEPAY

No Image exists for this case.

US Serial Number: 74682810**Application Filing Date:** Jun. 01, 1996**US Registration Number:** 2056092**Registration Date:** Apr. 22, 1997**Register:** Principal**Mark Type:** Service Mark**Status:** The registration has been renewed.**Status Date:** May 18, 2007**Publication Date:** Mar. 05, 1996**Notice of Allowance Date:** May 28, 1996

Mark Information

Mark Literal Elements: PRIMEPAY**Standard Character Claim:** No**Mark Drawing Type:** 1 - TYPESET WORD(S) /LETTER(S) /NUMBER(S)

Goods and Services

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 incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: providing business and financial management services**International Class(es):** 035 - Primary Class**U.S Class(es):** 100, 101, 102**Class Status:** ACTIVE**Basis:** 1(a)**First Use:** Aug. 01, 1995**Use in Commerce:** Aug. 01, 1995

Basis Information (Case Level)

Filed Use: No**Currently Use:** Yes**Filed ITU:** Yes**Currently ITU:** No

Filed 44D: No

Currently 44D: No

Filed 44E: No

Currently 44E: No

Filed 66A: No

Currently 66A: No

Filed No Basis: No

Currently No Basis: No

Current Owner(s) Information

Owner Name: PRIMEPAY, INC.

Owner Address: 596 LANCASTER AVENUE
MALVERN, PENNSYLVANIA 19355
UNITED STATES

Legal Entity Type: CORPORATION

State or Country Where Organized: VIRGINIA

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Mark Lebow

Docket Number: 5541-1001

Correspondent

Correspondent Name/Address: Mark Lebow
Ladas & Parry LLP
Suite 105
1727 King Street
Alexandria, VIRGINIA 22314
UNITED STATES

Phone: 703-837-9600

Fax: 703-837-098

Correspondent e-mail: mlebow@ladas.com avmail@ladas.com

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Aug. 13, 2013	NOTICE OF SUIT	
Dec. 31, 2012	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Sep. 27, 2012	NOTICE OF SUIT	
Jun. 25, 2012	NOTICE OF SUIT	
Jun. 07, 2012	NOTICE OF SUIT	
Mar. 15, 2008	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
May 18, 2007	REGISTERED AND RENEWED (FIRST RENEWAL - 10 YRS)	70132
May 18, 2007	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	

May 17, 2007	ASSIGNED TO PARALEGAL	70132
Apr. 17, 2007	REGISTERED - COMBINED SECTION 8 (10-YR) & SEC. 9 FILED	
Apr. 17, 2007	TEAS SECTION 8 & 9 RECEIVED	
Dec. 14, 2006	CASE FILE IN TICRS	
Jul. 09, 2003	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	
Apr. 11, 2003	REGISTERED - SEC. 8 (6-YR) & SEC. 15 FILED	
Apr. 11, 2003	PAPER RECEIVED	
Apr. 22, 1997	REGISTERED-PRINCIPAL REGISTER	
Feb. 18, 1997	ALLOWED PRINCIPAL REGISTER - SOU ACCEPTED	
Feb. 10, 1997	STATEMENT OF USE PROCESSING COMPLETE	
Nov. 27, 1996	USE AMENDMENT FILED	
May 28, 1996	NOA MAILED - SOU REQUIRED FROM APPLICANT	
Mar. 05, 1996	PUBLISHED FOR OPPOSITION	
Feb. 02, 1996	NOTICE OF PUBLICATION	
Nov. 30, 1995	APPROVED FOR PUB - PRINCIPAL REGISTER	
Nov. 29, 1995	ASSIGNED TO EXAMINER	72004

Maintenance Filings or Post Registration Information

Affidavit of Continued Use: Section 8 - Accepted

Affidavit of Incontestability: Section 15 - Accepted

Renewal Date: Apr. 22, 2007

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: POST REGISTRATION

Date in Location: May 18, 2007

Assignment Abstract Of Title Information

Summary

Total Assignments: 1

Registrant: PRIMEPAY, II

Assignment 1 of 1

Proceedings

Int. Cl.: 36

Prior U.S. Cls.: 100, 101 and 102

United States Patent and Trademark Office

Reg. No. 2,965,713

Registered July 12, 2005

**SERVICE MARK
PRINCIPAL REGISTER**

PRIMETAX

PRIMEPAY, INC. (VIRGINIA CORPORATION)
596 LANCASTER AVENUE
MALVERN, PA 19355

FIRST USE 7-31-1995; IN COMMERCE 7-31-1995.

SER. NO. 76-544,205, FILED 8-29-2003.

FOR: TAX PAYMENT PROCESSING SERVICES;
PAYROLL TAX DEBITING SERVICES, IN CLASS 36
(U.S. CLS. 100, 101 AND 102).

MARC LEIPZIG, EXAMINING ATTORNEY

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Mark: PRIMETAX

PRIMETAX

US Serial Number: 76544205

Application Filing Date: Aug. 29, 2005

US Registration Number: 2965713

Registration Date: Jul. 12, 2005

Register: Principal

Mark Type: Service Mark

Status: A Sections 8 and 15 combined declaration has been accepted and acknowledged.

Status Date: Feb. 01, 2012

Publication Date: Apr. 19, 2005

Mark Information

Mark Literal Elements: PRIMETAX

Standard Character Claim: No

Mark Drawing Type: 1 - TYPESET WORD(S) /LETTER(S) /NUMBER(S)

Goods and Services

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 incontestability; and
- Asterisks *.* identify additional (new) wording in the goods/services.

For: Tax payment processing services; payroll tax debiting services

International Class(es): 036 - Primary Class

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

Class Status: ACTIVE

Basis: 1(a)

First Use: Jul. 31, 1995

Use in Commerce: Jul. 31, 1995

Basis Information (Case Level)

Filed Use: Yes

Currently Use: Yes

Filed ITU: No

Currently ITU: No

Filed 44D: No

Currently 44D: No

Filed 44E: No

Currently 44E: No

Filed 66A: No

Currently 66A: No

Filed No Basis: No

Currently No Basis: No

Current Owner(s) Information

Owner Name: PRIMEPAY, INC.

Owner Address: 1487 Dunwoody Drive
West Chester, PENNSYLVANIA 19380
UNITED STATES

Legal Entity Type: CORPORATION

State or Country Where Organized: VIRGINIA

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Mark Lebow

Docket Number: 5541-1002

Attorney Primary Email trademarks@young-thompson.com
Address:

Attorney Email Authorized: No

Correspondent

Correspondent Name/Address: Mark Lebow
Ladas & Parry LLP
Suite 105
1727 King Street
Alexandria, VIRGINIA 22314
UNITED STATES

Phone: 703-837-9600

Fax: 703-837-098

Correspondent e-mail: mlebow@ladas.com avmail@ladas.com

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Dec. 31, 2012	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Jun. 07, 2012	NOTICE OF SUIT	
Feb. 01, 2012	NOTICE OF ACCEPTANCE OF SEC. 8 & 15 - MAILED	
Feb. 01, 2012	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	73376
Feb. 01, 2012	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	73376
Dec. 12, 2011	TEAS SECTION 8 & 15 RECEIVED	
Mar. 16, 2008	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Jul. 12, 2005	REGISTERED-PRINCIPAL REGISTER	
Apr. 19, 2005	PUBLISHED FOR OPPOSITION	

Mar. 30, 2005	NOTICE OF PUBLICATION	
Jan. 14, 2005	LAW OFFICE PUBLICATION REVIEW COMPLETED	65287
Sep. 24, 2004	ASSIGNED TO LIE	65287
Sep. 22, 2004	APPROVED FOR PUB - PRINCIPAL REGISTER	
Sep. 22, 2004	TEAS/EMAIL CORRESPONDENCE ENTERED	88888
Sep. 20, 2004	CORRESPONDENCE RECEIVED IN LAW OFFICE	88888
Sep. 20, 2004	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Mar. 19, 2004	NON-FINAL ACTION MAILED	
Mar. 17, 2004	ASSIGNED TO EXAMINER	74816

Maintenance Filings or Post Registration Information

Affidavit of Continued Use: Section 8 - Accepted

Affidavit of Incontestability: Section 15 - Accepted

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: TMO LAW OFFICE 115

Date in Location: Feb. 01, 2011

Assignment Abstract Of Title Information - None recorded

Proceedings

Summary

Party type

Number of Proceedings: 1

Type of Proceeding: Opposition

Int. Cl.: 9

Prior U.S. Cls.: 21, 23, 26, 36 and 38

Reg. No. 2,941,188

United States Patent and Trademark Office

Registered Apr. 19, 2005

**TRADEMARK
PRINCIPAL REGISTER**

PRIMEXPORTS

PRIMEPAY, INC. (VIRGINIA CORPORATION)
596 LANCASTER AVENUE
MALVERN, PA 19355

FIRST USE 12-21-2001; IN COMMERCE 12-21-2001.

SER. NO. 76-544,207, FILED 8-29-2003.

FOR: SOFTWARE FOR CREATING CUSTOM
TAX REPORTS FOR USE IN A SPREADSHEET, IN
CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

MARC LEIPZIG, EXAMINING ATTORNEY

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Mark: PRIMEXPORTS

PRIMEXPORTS

US Serial Number: 76544207

Application Filing Date: Aug. 29, 2005

US Registration Number: 2941188

Registration Date: Apr. 19, 2005

Register: Principal

Mark Type: Trademark

Status: A Sections 8 and 15 combined declaration has been accepted and acknowledged.

Status Date: Nov. 29, 2011

Publication Date: Jan. 25, 2005

Mark Information

Mark Literal Elements: PRIMEXPORTS

Standard Character Claim: No

Mark Drawing Type: 1 - TYPESET WORD(S) /LETTER(S) /NUMBER(S)

Goods and Services

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 incontestability; and
- Asterisks *.* identify additional (new) wording in the goods/services.

For: Software for creating custom tax reports for use in a spreadsheet

International Class(es): 009 - Primary Class

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

Class Status: ACTIVE

Basis: 1(a)

First Use: Dec. 21, 2001

Use in Commerce: Dec. 21, 2001

Basis Information (Case Level)

Filed Use: Yes

Currently Use: Yes

Filed ITU: No

Currently ITU: No

Filed 44D: No

Currently 44D: No

Filed 44E: No

Currently 44E: No

Filed 66A: No

Currently 66A: No

Filed No Basis: No

Currently No Basis: No

Current Owner(s) Information

Owner Name: PRIMEPAY, INC.

Owner Address: 596 Lancaster Avenue
Malvern, PENNSYLVANIA 19355
UNITED STATES

Legal Entity Type: CORPORATION

State or Country Where Organized: VIRGINIA

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Mark Lebow

Docket Number: 5541-1005

Attorney Primary Email: trademarks@young-thompson.com

Attorney Email Authorized: Yes

Address:

Correspondent

Correspondent Name: Mark Lebow

Name/Address: Ladas & Parry LLP
Suite 105
1727 King Street
Alexandria, VIRGINIA 22314
UNITED STATES

Phone: 703-837-9600

Fax: 703-837-098

Correspondent e-mail: mlebow@ladas.com avmail@ladas.com

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Dec. 31, 2012	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Nov. 29, 2011	NOTICE OF ACCEPTANCE OF SEC. 8 & 15 - E-MAILED	
Nov. 29, 2011	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	64591
Nov. 28, 2011	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	64591
Oct. 19, 2011	TEAS SECTION 8 & 15 RECEIVED	
Mar. 16, 2008	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Apr. 19, 2005	REGISTERED-PRINCIPAL REGISTER	
Jan. 25, 2005	PUBLISHED FOR OPPOSITION	
Jan. 05, 2005	NOTICE OF PUBLICATION	
Nov. 29, 2004	LAW OFFICE PUBLICATION REVIEW COMPLETED	77075

Nov. 22, 2004	ASSIGNED TO LIE	77075
Nov. 18, 2004	APPROVED FOR PUB - PRINCIPAL REGISTER	
Nov. 18, 2004	AMENDMENT FROM APPLICANT ENTERED	76532
Oct. 12, 2004	CORRESPONDENCE RECEIVED IN LAW OFFICE	76532
Oct. 12, 2004	PAPER RECEIVED	
Sep. 23, 2004	FINAL REFUSAL MAILED	
Sep. 22, 2004	FINAL REFUSAL WRITTEN	74816
Sep. 22, 2004	TEAS/EMAIL CORRESPONDENCE ENTERED	88888
Sep. 20, 2004	CORRESPONDENCE RECEIVED IN LAW OFFICE	88888
Sep. 20, 2004	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Mar. 19, 2004	NON-FINAL ACTION MAILED	
Mar. 17, 2004	ASSIGNED TO EXAMINER	74816

Maintenance Filings or Post Registration Information

Affidavit of Continued Use: Section 8 - Accepted

Affidavit of Incontestability: Section 15 - Accepted

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: TMO LAW OFFICE 115

Date in Location: Nov. 29, 201

Assignment Abstract Of Title Information - None recorded

Proceedings

Summary

Party type

Number of Proceedings: 1

Type of Proceeding: Opposition