

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

JMW/MCF

Mailed: May 4, 2015

Opposition No. 91219765

Primepay, Inc.

v.

Prime Clerk, LLC

By the Trademark Trial and Appeal Board:

On March 30, 2015, Applicant filed proposed amendments to application Serial No. 86002242, with Opposer's consent, and Opposer's withdrawal without prejudice of the opposition, contingent upon entry of the amendment.

By the proposed amendments Applicant seeks to amend its name by placing a space between the words "Prime" and "Clerk" and to amend the recitation of services as follows:

International Class 35

From: "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."

To: "BUSINESS ASSISTANCE, ADVISORY AND CONSULTING SERVICES, ALL OF THE FOREGOING 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 IN THE FIELDS OF BANKRUPTCY, FINANCIAL INSOLVENCY AND DEBT RESTRUCTURING, LAW, AND FIDUCIARY 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 FIELDS OF BANKRUPTCY, FINANCIAL INSOLVENCY AND DEBT RESTRUCTURING, LAW, AND FIDUCIARY SERVICES; COLLECTING, COMPILING AND SYSTEMATIZING INFORMATION IN THE FIELDS OF BANKRUPTCY, FINANCIAL INSOLVENCY AND DEBT RESTRUCTURING, LAW AND FIDUCIARY SERVICES 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."

International Class 42

From: "PROVIDING TEMPORARY USE OF ON-LINE, 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."

To: "PROVIDING TEMPORARY USE OF ON-LINE, 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; NONE OF THE FOREGOING SERVICES RELATING TO THE DIRECT PROVISION OF TAX PAYROLL ADMINISTRATION AND TAX PREPARATION SERVICES.

International Class 45

From: “PROVIDING AN ON-LINE SEARCHABLE DATABASE IN THE FIELD OF BANKRUPTCY.”

To: PROVIDING AN ON-LINE SEARCHABLE DATABASE IN THE FIELD OF BANKRUPTCY; **NONE OF THE FOREGOING SERVICES RELATING TO THE DIRECT PROVISION OF TAX PAYROLL ADMINISTRATION AND TAX PREPARATION SERVICES.**

Inasmuch as the amendments to the recitations of services are clearly limiting in nature as required by Trademark Rule 2.71(a), and because Opposer consents thereto, the amendments are approved and entered. *See* Trademark Rule 2.133(a).

Section 1201.02(c) of the TMEP allows correction of an entity’s name where:

the applicant identifies itself by a name under which it does business, which is not a legal entity, then amendment to state the applicant’s correct legal name is permitted. *Cf. In re Atlanta Blue Print Co.*, 19 USPQ2d 1078 (Comm'r Pats. 1990) (finding that Post Registration staff erred in refusing to allow amendment of affidavit under 15 U.S.C. § 1058 to show registrant’s corporate name rather than registrant’s trade name).

Where there has been only a single, continuing commercial enterprise that was the owner of the mark as of the filing date of the application, an applicant may correct a defect in identifying itself by name or legal entity in the application. *See Accu Personnel Inc. v. Accustaff Inc.*, 38 USPQ2d 1443, 1444-45 (TTAB 1996) (corporation formed by merger of four separate companies which did not survive the merger, was proper person to file even if corporation did not exist at time of filing). *Cf. Great Seats Ltd. v. Great Seats Inc.*, 84 USPQ2d 1235, 1240 (TTAB 2007) (application void ab initio

where two separate commercial entities were in existence on application filing date and application was filed in name of wrong entity).

Applicant states its correct legal name is Prime Clerk, LLC, and opposer consents to the requested amendment.

In view thereof, applicant's motion to amend the application is granted, the amendment is entered, and applicant's correct name is entered in the caption of this case.

The contingency in opposer's withdrawal having now been met, the opposition is dismissed without prejudice.
