

ESTTA Tracking number: **ESTTA428574**

Filing date: **09/02/2011**

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

Proceeding	92045849
Party	Plaintiff Primepay, Inc.
Correspondence Address	MARK LEBOW YOUNG & THOMPSON 209 MADISON STREET, SUITE 500 ALEXANDRIA, VA 22314 UNITED STATES mlebow@young-thompson.com
Submission	Motion to Amend Pleading/Amended Pleading
Filer's Name	Mark Lebow
Filer's e-mail	mlebow@young-thompson.com, jgoehring@young-thompson.com
Signature	/Mark Lebow/
Date	09/02/2011
Attachments	2011-09-02 M. Leave to Amend.pdf (3 pages)(11854 bytes) Ex. 1 .pdf (1 page)(5941 bytes) 2011-09-02 Second Amended Petition for Cancellation.pdf (4 pages)(13287 bytes)

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

PRIMEPAY, INC.,

PETITIONER,

v.

PRIMEPOINT, L.L.C.,

RESPONDENT.

Cancellation No. 92045849

**PETITIONER PRIMEPAY, INC.'S MOTION FOR LEAVE TO AMEND
PETITION FOR CANCELTION**

Petitioner PrimePay, Inc. hereby moves for leave to amend its petition for cancellation and attaches hereto as Exhibit 1 a proposed Second Amended Petition For Cancellation.

PrimePay previously amended its petition as a matter of right within 20 days of filing its initial petition. Accordingly, Petitioner's Amended Petition For Cancellation is presently the operative pleading in this matter. Respondent has not yet filed any response to this pleading. This proceeding was suspended before an Answer was required and has been suspended pending the outcome of a related federal court action. The federal court action substantially changed the issues available for litigation between the parties, necessitating the present motion for leave to amend.

As noted in detail in PrimePay's Opposition brief filed concurrently herewith, the proposed Second Amended Petition For Cancellation makes changes so that the grounds

for cancellation is PrimePay's registration to the PRIMEPAY mark, Reg. Nos. 2056092, rather than PrimePay's common law rights to the PRIMEPAY mark. With the proposed amended petition for cancellation, the similarity of the marks assessment – that most important confusion factor – changes significantly because the comparison will be between the marks as registered, not between the marks as used in commerce, which is how the District Court compared the marks for purposes of the infringement claim at issue in that proceeding. This overcomes Primepoint's motion asking the Board to adopt *en toto* the federal court's determinations because at least the issue of similarity of the marks is substantially different in this proceeding.

Leave to amend is freely given when justice so requires. Fed. R. Civ. P. 15(a). The TTAB follows Rule 15(a) and liberally grants leave to amend petitions and pleadings where the other party will not be prejudiced thereby. *See Miller Brewing Co. v. Anheuser-Busch Inc.*, 27 USPQ2d 1711 (TTAB 1993) (particularly where challenged pleading is the initial pleading); *Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428 (TTAB 1985); *Cool-Ray, Inc. v. Eye Care, Inc.*, 183 USPQ 618 (TTAB 1974). The TBMP notes, "plaintiffs to proceedings before the Board ordinarily can, and often do, respond to a motion to dismiss by filing, *inter alia*, an amended complaint. If the amended complaint corrects the defects noted by the defendant in its motion to dismiss, and states a claim upon which relief can be granted, the motion to dismiss normally will be moot." TBMP 503.03. The proposed amended pleading corrects the defects noted by Primepoint in its motion and states a claim upon which relief can be granted and which is likely to be granted.

This proceeding is still in its very earliest stages. Primepoint has not yet even filed an answer to PrimePay's petition for cancellation. Accordingly, there is no basis for Primepoint to assert prejudice or other equitable reasons why leave should be denied.

Dated: September 2, 2011

Respectfully submitted,

YOUNG & THOMPSON

/s/ Mark Lebow
Mark Lebow
209 Madison St., Suite 500
Alexandria, VA 22314

Attorneys for Petitioner

CERTIFICATE OF SERVICE

The undersigned certifies that the within MOTION FOR LEAVE TO AMEND was served on the below listed counsel of record for Respondent on this 2nd day of September, 2011 by placement with first class mail, postage prepaid.

JORDAN A LAVINE
FLASTER GREENBERG PC
1628 JFK BLVD, SUITE 1500
PHILADELPHIA, PA 19103

/s/ Jeffrey M. Goehring

EXHIBIT 1

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

PRIMEPAY, INC.,

Petitioner,

v.

PRIMEPOINT, L.L.C.,

Respondent.

Cancellation No. 92045849

SECOND AMENDED PETITION FOR CANCELLATION

Petitioner PRIMEPAY, INC. is a Virginia corporation with offices located at 596 Lancaster Avenue, Malvern, Pennsylvania 19355.

Respondent PRIMEPOINT, L.L.C. is a New Jersey limited liability company with offices located at 163 Route 130, Building IC, Bordentown, New Jersey 08504.

Petitioner believes that it will be damaged by registration of the mark PRIMPOINT and Design as shown in Registration No. 2715127 for services in International Class 35 and hereby petitions to cancel the same.

The grounds for cancellation are as follows:

1. Petitioner has used its mark PRIMEPAY in connection with business and financial management services, including payroll services, in commerce since at least as early as August 1995 and, in any event, prior to any use of the mark PRIMPOINT by Respondent.

2. Petitioner intends to continue use of the mark PRIMEPAY in connection with the services recited in paragraph 1.
3. As a result of its continuous and exclusive use of its PRIMEPAY mark in commerce on or in connection with the services recited in paragraph 1, Petitioner has developed substantial good will.
4. As a result of the high quality of the services it provides under its PRIMEPAY mark, Petitioner has garnered a valuable reputation.
5. Furthermore, Petitioner has developed substantial common law rights in its PRIMEPAY mark.
6. Petitioner owns incontestable Registration No. 2056092 for the mark PRIMEPAY for use in connection with “providing business and financial management services” in International Class 35 (hereafter, the “PRIMEPAY Registration”).
7. On May 13, 2003, Respondent obtained U.S. Registration No. 2715127 for the mark PRIMEPOINT and Design for “financial services, namely, banking and payroll services” in International Class 36, on the basis of use in commerce, alleging a date of first use of its mark in commerce on or in connection with the recited services since as early as December 2000.
8. Priority is not an issue. Petitioner’s use of its PRIMEPAY mark precedes Respondent’s claimed date of first use of its mark PRIMEPOINT and Design as alleged in Registration No. 2715127.

9. Registration No. 2715127 for the mark PRIMEPOINT is closely similar in appearance, connotation, sound and/or commercial impression to Petitioner's mark as depicted in the PRIMEPAY Registration.
10. The services recited in Registration Serial No. 2715127 are closely related to and/or are overlapping with Petitioner's services recited in the PRIMEPAY Registration.
11. Upon information and belief, Petitioner avers that the services described in Registration Serial No. 2715127 are advertised and provided in similar channels of trade and to similar customers as Petitioner's services depicted in the PRIMEPAY Registration.
12. Respondent's use of the mark PRIMPOINT and Design in connection with the services described in Registration No. 2715127 interferes with Petitioner's use of its PRIMEPAY Mark as depicted in the PRIMEPAY Registration and is likely to cause the public to believe that the services of Respondent originate with Petitioner, or vice versa, or that Respondent is owned or controlled by or in some manner affiliated or associated with Petitioner, or vice versa, and is otherwise likely to cause confusion, cause mistake or deceive.
13. Any defect, inadequacy or deficiency found in Respondent's services marketed, sold or otherwise provided under the PRIMPOINT and Design mark would reflect negatively upon and seriously injure the reputation and goodwill associated with the services rendered by Petitioner in connection with its PRIMEPAY Mark as depicted in the PRIMEPAY Registration.

14. If Respondent were permitted to maintain its registration, it would continue to have at least a *prima facie* exclusive right to use the mark PRIMPOINT and Design mark. Such continued registration would be a source of damage and injury to Petitioner and its customers.

WHEREFORE, Petitioner prays that Registration No. 2715127 will be cancelled and that this cancellation be sustained in favor of Petitioner.

September 2, 2011

Respectfully submitted,

/Mark Lebow/

Mark Lebow

Attorney for Petitioner

Young & Thompson

209 Madison St., Suite 500

Alexandria, VA 22314

Tel: (703) 521-2297