

ESTTA Tracking number: **ESTTA1090040**

Filing date: **10/20/2020**

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	Paylocity Corporation
Granted to Date of previous extension	10/21/2020
Address	1400 AMERICAN LANE SCHAUMBURG, IL 60007 UNITED STATES

Correspondence information	JAMES MICHAEL FAIER FAIER & FAIER PC 566 WEST ADAMS STREET SUITE 600 CHICAGO, IL 60661 UNITED STATES Primary Email: jmfaier@faier.com Secondary Email(s): ipdocket@faier.com 312-382-9400
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Applicant Information

Application No.	88700916	Publication date	06/23/2020
Opposition Filing Date	10/20/2020	Opposition Period Ends	10/21/2020
Applicant	Paylistic LLC 440 STEVENS AVENUE, SUITE 200 SOLANA BEACH, CA 92075 UNITED STATES		

Goods/Services Affected by Opposition

Class 035. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Accounts receivable billing services
Class 036. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Financial services, namely accounts receivables financing; factoring agency services

Applicant Information

Application No.	88700911	Publication date	06/23/2020
Opposition Filing Date	10/20/2020	Opposition Period Ends	
Applicant	Paylistic LLC		

	440 STEVENS AVENUE, SUITE 200 SOLANA BEACH, CA 92075 UNITED STATES
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Goods/Services Affected by Opposition

Class 035. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Accounts receivable billing services
Class 036. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Financial services, namely accounts receivables financing; factoring agency services

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
Disparaging	Trademark Act Section 2(a)
Other	Prior use of trade name; abandonment.

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3326870	Application Date	11/22/2005
Registration Date	10/30/2007	Foreign Priority Date	NONE
Word Mark	PAYLOCITY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 2006/01/01 First Use In Commerce: 2006/01/01 Administration of business payroll for others; payroll preparation for others; human resources consultation; human resources management; unemployment cost control management; and payroll tax filing		

U.S. Registration No.	4606104	Application Date	10/16/2012
Registration Date	09/16/2014	Foreign Priority Date	NONE
Word Mark	PAYLOCITY		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 035. First use: First Use: 2005/12/31 First Use In Commerce: 2005/12/31 Human resource services, namely, serving as a human resources department for others, human resources management, human resources consultation, personnel selection for others; payroll services for others, namely, administration of business payroll for others, payroll preparation, payroll processing service; re-selling services, namely, distributorship services in the field of computer software, namely, Benefit Administration Software and Applicant Tracking Software</p> <p>Class 036. First use: First Use: 2005/12/31 First Use In Commerce: 2005/12/31 Payroll services for others, namely, payroll tax debiting services</p> <p>Class 042. First use: First Use: 2005/12/31 First Use In Commerce: 2005/12/31 Computer services, namely, providing temporary use of online non-downloadable software for use in the fields of payroll and human resources,</p>		

	namely, for use in payroll preparation and human resources management; Application service provider (ASP) featuring software for use in the fields of payroll and human resources, namely, for use in payroll preparation and human resources management; Providing on-line, non-downloadable, Internet-based software application for Attendance Software which is also known as Time and Labor Management software for use in managing time and attendance for business and their employees
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U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	PAYLOCITY		
Goods/Services	Payroll and Human Resource Services and financial software		

Attachments	PAYLOCITY_CONSOLIDATED_OPPN_PAYLISTIC.pdf(842846 bytes)
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Signature	/jmfaier/
Name	JAMES MICHAEL FAIER
Date	10/20/2020

Electronic Submission

I certify that this correspondence (Notice of Opposition) is being uploaded in the TTAB Estta database, on 20 October 2020

/jamesmichaelfaier/
signature: _____

name of person signing certificate: James Michael Faier.
20 October 2020

**In the United States Patent and Trademark Office
Before the Trademark Trial and Appeal Board**

**Paylocity Corporation,
an Illinois corporation,**

Opposer,

vs.

**Paylistic LLC,
a Delaware Limited Liability Company,**

Applicant.

Consolidated Opposition

No. _____

SN 88700911 for PAYLISTIC (word)

Publication Date: 23 June 2020

Filed: 21 November 2019

SN 88700916 for PAYLISTIC (logo)

Publication Date: 23 June 2020

Filed: 21 November 2019

Notice of Opposition

[001] Opposer, Paylocity Corporation, an Illinois corporation, located and doing business as 1400 American Lane, Schaumburg, IL 60173, believes that it will be damaged by registration of the marks shown in Serial Number 88700911 and Serial Number 88700916 and hereby opposes same.

Description of Applicant's Application

[002] Applicant: Paylistic LLC, a Delaware limited liability company

Applicant's Address: 440 Stevens Ave., Suite 200, Solana Beach, CA 92075 USA

Application filing date: 21 November 2019.

Published for Opposition in the Official Gazette of 23 June 2020.

SN 88700911 for PAYLISTIC (WORDMARK)

In International Class 35 for “Accounts receivable billing services.”

Filing Basis: 1(b)

In International Class 36 for “Financial Services, namely accounts receivables financing; factoring agency services.”

Filing Basis: 1(b)

SN 88700916 for PAYLISTIC (LOGO)

In International Class 35 for “Accounts receivable billing services.”

Filing Basis: 1(b)

In International Class 36 for “Financial Services, namely accounts receivables financing; factoring agency services.”

Filing Basis: 1(b)

Standing for Petition to Cancel

[003] Opposer believes it is damaged by registration of the service mark PAYLISTIC (wordmark) as identified in USPTO SN 88700911 and service mark PAYLISTIC (logo) identified in USPTO SN 88700916 and therefore has standing to file this Petition to Cancel. Since as early as 2006, Opposer has used in U.S. commerce the mark PAYLOCITY for finance, namely, payroll, and human resource services. In 2007, Opposer registered the mark PAYLOCITY in the USPTO as RN 3326870 for “Administration of business payroll for others; payroll preparation for others; human resources consultation; human resources management; unemployment cost control management; and payroll tax filing” in International Classes 035 as well as other registered rights.

Opposer has a direct and personal stake in the outcome of this proceeding since Applicant's mark is confusingly similar to Opposer's mark with Applicant's mark making use of the identical prefix "PAY" formative and an identical middle "L" formative and an identical final "Y" formative as in Opposer's mark particularly as used for finance services.

Grounds for Opposition

As grounds for this opposition, Opposer alleges the following:

1. Ownership of U.S. Trademark Registration No. 3326870

[004] Opposer is the owner of U.S. Trademark Registration No. 3326870 for the mark "PAYLOCITY" for "Administration of business payroll for others; payroll preparation for others; human resources consultation; human resources management; unemployment cost control management; and payroll tax filing" which was registered on the Principal Register on 30 October 2007. Said registration was based on an application filed in the U.S. Patent and Trademark Office on 22 November 2005, which is a date prior to the date of filing of Applicant's application. Said registered mark of Opposer is valid and subsisting and is prima facie evidence of Opposer's exclusive right to use said mark in commerce for the services specified in said registration. In view of the similarity of the respective marks and the related nature of the services of the respective parties, it is alleged that Applicant's mark so resembles Opposer's registered mark, as to be likely to cause confusion, or to cause mistake or to deceive. Pursuant to 37 CFR 2.122(d), T.M.R.P. 2.122(d) one copy of the registration certificate along with a copy the USPTO status sheet are attached to be received into evidence by the Board.

2. Ownership of U.S. Trademark Registration No. 4606104

[005] Opposer is the owner of U.S. Trademark Registration No. 4606104 for the mark

"PAYLOCITY" in International Class 035 for "Human resource services, namely, serving as a human resources department for others, human resources management, human resources consultation, personnel selection for others; payroll services for others, namely, administration of business payroll for others, payroll preparation, payroll processing service; reselling services, namely, distributorship services in the field of computer software, namely, Benefit Administration Software and Applicant Tracking Software" and International Class 036 for "Payroll services for others, namely, payroll tax debiting services"; and International Class 042 for "Computer services, namely, providing temporary use of online non-downloadable software for use in the fields of payroll and human resources, namely, for use in payroll preparation and human resources management; Application service provider (ASP) featuring software for use in the fields of payroll and human resources, namely, for use in payroll preparation and human resources management; Providing on-line, non-downloadable, Internet-based software application for Attendance Software which is also known as Time and Labor Management software for use in managing time and attendance for business and their employees." The mark was registered on the Principal Register on 16 September 2014. Said registration was based on an application filed in the U.S. Patent and Trademark Office on 16 October 2012, which is a date prior to the date of filing of Applicant's application and prior to the date of Applicant's claimed date of first use. Said registered mark of Opposer is valid and subsisting and is prima facie evidence of Opposer's exclusive right to use said mark in commerce for the services specified in said registration. In view of the similarity of the respective marks and the related nature of the services of the respective parties, it is alleged that Applicant's mark so resembles Opposer's registered mark, as to be likely to cause confusion, or to cause mistake or to deceive. Pursuant to 37 CFR 2.122(d),

T.M.R.P. 2.122(d) one copy of the registration certificate along with a copy the USPTO status sheet are attached to be received into evidence by the Board.

3. Prior Adoption and Use of Similar Mark or Trade Name

[006] Opposer, since at least as early as 01 January 2006, has been, and is now using the mark PAYLOCITY in connection with the sale of payroll services for others, human resource services for others, and human resource consultation for others. Said use has been valid and continuous since said date of first use and has not been abandoned. Said mark of Opposer is symbolic of extensive good will and consumer recognition built up by Opposer through substantial amounts of time and effort in advertising and promotion. In view of the similarity of the respective marks and the related nature of the services of the respective parties, it is alleged that Applicant's mark so resembles Opposer's mark previously used in the United States, and not abandoned, as to be likely to cause confusion, or to cause mistake, or to deceive.

4. Opposition Based on Lanham Act §2(a)

[007] Opposer, since at least as early as 01 January 2006, has been, and is now operating under the designation PAYLOCITY in the area of payroll services for others, human resource services for others, and human resource consultation for others. Said use has been valid and continuous since said date of first use and the relevant class of the public has come to associate Opposer with said designation. In view of the similarity of Applicant's mark with Opposer's designation, and in view of the related nature of the uses thereof, it is alleged that Applicant's mark consists of and comprises matter that may disparage and falsely suggest a connection with Opposer.

5. Opposition based on Abandonment

[008] Applicant, on information and belief, abandoned its mark without intent to use. Opposer

contacted Applicant's representative, Mr. Rich Ramirez, after receiving the Notice of Withdrawal from Applicant's counsel to ask about who would receive correspondence about the application. Mr. Ramirez responded, "We have dissolved the LLC and I was one of the managing partners." Opposer believes that Applicant abandoned the mark and the application but having asked Mr. Ramirez to withdraw the applications, Mr. Ramirez neither responded nor withdrew the applications.

Prayer for Relief

[009] WHEREFORE, Opposer prays that Trademark Trial and Appeal Board sustain the Opposition with regard to SN 88700911 for the PAYLISTIC (wordmark) and SN 88700916 for PAYLISTIC (logo).

Fees


[010] Opposer submits a fee of \$800 for this opposition. If the fees at any time tendered in this proceeding are deemed insufficient, then please take those fees from Faier & Faier P.C. deposit account 06-0040.

**Paylocity Corporation
an Illinois corporation**

by:

print name:

title:

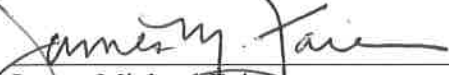


James Michael Faier
Attorney for Opposer

CERTIFICATE OF SERVICE

I, James Michael Faier, an attorney, certify that I served on this date a copy of the foregoing NOTICE OF OPPOSITION upon applicant via email to rich@jmjcapitalgroup.com.

Dated this 20 day of October 2020.


James Michael Raier

Signed: 20 October 2020.

Generated on: This page was generated by TSDR on 2020-10-20 19:30:11 EDT

Mark: PAYLOCITY

PAYLOCITY

US Serial Number: 78759629

Application Filing Date: Nov. 22, 2005

US Registration Number: 3326870

Registration Date: Oct. 30, 2007

Register: Principal

Mark Type: Service Mark

TMS Common Status Descriptor:



LIVE/REGISTRATION/Issued and Active

The trademark application has been registered with the Office.

Status: The registration has been renewed.

Status Date: Jan. 11, 2017

Publication Date: Sep. 12, 2006

Notice of Allowance Date: Dec. 05, 2006

Mark Information

Mark Literal Elements: PAYLOCITY

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

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: Administration of business payroll for others; payroll preparation for others; human resources consultation; human resources management; unemployment cost control management; and payroll tax filing

International Class(es): 035 - Primary Class

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

Class Status: ACTIVE

Basis: 1(a)

First Use: Jan. 01, 2006

Use in Commerce: Jan. 01, 2006

Basis Information (Case Level)

Filed Use: No

Currently Use: Yes

Filed ITU: Yes

Currently ITU: No

Filed 44D: No

Currently 44E: No

Filed 44E: No

Currently 66A: No

Filed 66A: No

Currently No Basis: No

Filed No Basis: No

Current Owner(s) Information

Owner Name: PAYLOCITY CORPORATION

Owner Address: 3850 N. WILKE ROAD
ARLINGTON HEIGHTS, ILLINOIS UNITED STATES 60060

Legal Entity Type: CORPORATION

State or Country ILLINOIS
Where Organized:

Attorney/Correspondence Information

Attorney of Record

Attorney Name: James Michael Faier

Docket Number: 8512

Attorney Primary jmfaier@faier.com
Email Address:

Attorney Email Yes
Authorized:

Correspondent

Correspondent James Michael Faier
Name/Address: Faier & Faier P.C.
566 W. Adams St.
Suite 600
Chicago, ILLINOIS UNITED STATES 60661

Phone: 312-382-9400

Fax: 312-382-9200

Correspondent e- jmfaier@faier.com skim@faier.com
mail:

Correspondent e- Yes
mail Authorized:

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Jan. 11, 2017	NOTICE OF ACCEPTANCE OF SEC. 8 & 9 - E-MAILED	
Jan. 11, 2017	REGISTERED AND RENEWED (FIRST RENEWAL - 10 YRS)	74704
Jan. 11, 2017	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	74704
Jan. 11, 2017	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	74704
Nov. 01, 2016	TEAS SECTION 8 & 9 RECEIVED	
Nov. 01, 2016	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Oct. 30, 2016	COURTESY REMINDER - SEC. 8 (10-YR)/SEC. 9 E-MAILED	
Nov. 26, 2012	NOTICE OF ACCEPTANCE OF SEC. 8 & 15 - E-MAILED	
Nov. 26, 2012	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	76533
Nov. 26, 2012	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	76533
Oct. 31, 2012	TEAS SECTION 8 & 15 RECEIVED	
May 21, 2008	AUTOMATIC UPDATE OF ASSIGNMENT OF OWNERSHIP	
Oct. 30, 2007	REGISTERED-PRINCIPAL REGISTER	
Sep. 22, 2007	LAW OFFICE REGISTRATION REVIEW COMPLETED	77976
Sep. 22, 2007	ASSIGNED TO LIE	77976
Aug. 17, 2007	ALLOWED PRINCIPAL REGISTER - SOU ACCEPTED	
Aug. 03, 2007	STATEMENT OF USE PROCESSING COMPLETE	75606
Jun. 02, 2007	USE AMENDMENT FILED	75606
Jun. 02, 2007	TEAS STATEMENT OF USE RECEIVED	
Dec. 05, 2006	NOA MAILED - SOU REQUIRED FROM APPLICANT	
Sep. 12, 2006	PUBLISHED FOR OPPOSITION	
Aug. 23, 2006	NOTICE OF PUBLICATION	
Jul. 19, 2006	LAW OFFICE PUBLICATION REVIEW COMPLETED	76539
Jul. 18, 2006	ASSIGNED TO LIE	76539
Jul. 13, 2006	APPROVED FOR PUB - PRINCIPAL REGISTER	
Jul. 13, 2006	EXAMINER'S AMENDMENT ENTERED	88888
Jul. 13, 2006	EXAMINERS AMENDMENT E-MAILED	6328
Jul. 13, 2006	EXAMINERS AMENDMENT -WRITTEN	78303
Jun. 04, 2006	NON-FINAL ACTION E-MAILED	6325
Jun. 04, 2006	NON-FINAL ACTION WRITTEN	78303
May 26, 2006	ASSIGNED TO EXAMINER	78303
Nov. 29, 2005	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: GENERIC WEB UPDATE

Date in Location: Jan. 11, 2017

Assignment Abstract Of Title Information

Summary

Total Assignments: 2

Registrant: Sarowitz, Steve

Assignment 1 of 2

Conveyance: ASSIGNS THE ENTIRE INTEREST

Reel/Frame: [3776/0882](#)

Pages: 5

Date Recorded: May 13, 2008

Supporting Documents: [assignment-tm-3776-0882.pdf](#)

Assignor

Name: [SAROWITZ, STEVEN](#)

Execution Date: May 13, 2008

Legal Entity Type: INDIVIDUAL

Citizenship: UNITED STATES

Assignee

Name: [PAYLOCITY CORPORATION](#)

Legal Entity Type: CORPORATION

State or Country Where Organized: ILLINOIS

Address: 3850 N. WILKE ROAD
ARLINGTON HEIGHTS, ILLINOIS 60060

Correspondent

Correspondent Name: DUSAN CLARK, ESQ.

Correspondent Address: SIDLEY AUSTIN LLP
717 N. HARWOOD ST., SUITE 3400
DALLAS, TX 75201

Domestic Representative - Not Found

Assignment 2 of 2

Conveyance: SECURITY INTEREST

Reel/Frame: [6696/0153](#)

Pages: 15

Date Recorded: Jul. 17, 2019

Supporting Documents: [assignment-tm-6696-0153.pdf](#)

Assignor

Name: [PAYLOCITY CORPORATION](#)

Execution Date: Jul. 17, 2019

Legal Entity Type: CORPORATION

State or Country Where Organized: ILLINOIS

Assignee

Name: [PNC BANK, NATIONAL ASSOCIATION \(AS ADMINISTRATIVE AGENT\)](#)

Legal Entity Type: NATIONAL BANKING ASSOCIATION

State or Country Where Organized: UNITED STATES

Address: 500 FIRST AVE., 4TH FLOOR
PITTSBURGH, PENNSYLVANIA 15219

Correspondent

Correspondent Name: STEPHANIE A. MARTINEZ, MCGUIREWOODS LLP

Correspondent Address: GATEWAY PLAZA, 800 EAST CANAL STREET
RICHMOND, VA 23219

Domestic Representative - Not Found

Proceedings

Summary

Number of Proceedings: 3

Type of Proceeding: Opposition

Proceeding Number: 91225615

Filing Date: Dec 29, 2015

Status: Terminated

Status Date: Mar 24, 2017

Interlocutory Attorney: ELIZABETH A DUNN

Defendant

Name: Velocity Global, LLC

Correspondent Address: DARIN L BROWN
HOLLAND & HART LLP
PO BOX 8749
DENVER CO UNITED STATES , 80201-8749

Correspondent e-mail: docket@hollandhart.com , ejcooper@hollandhart.com , dlbrown@hollandhart.com , mamoore@hollandhart.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
VELOCITY GLOBAL	Registered	<u>86594253</u>	<u>5193730</u>

Plaintiff(s)

Name: Paylocity Corporation

Correspondent Address: JAMES MICHAEL FAIER
FAIER & FAIER PC
566 W ADAMS ST, SUITE 600
CHICAGO IL UNITED STATES , 60661

Correspondent e-mail: jmfaier@faier.com , DLBrown@hollandhart.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
PAYLOCITY	REGISTERED AND RENEWED	<u>78759629</u>	<u>3326870</u>
PAYLOCITY	Section 8 and 15 - Accepted and Acknowledged	<u>77406931</u>	<u>3867921</u>
PAYLOCITY REDEFINING THE WORLD OF PAYROLL + HR	Cancelled - Section 8	<u>77406953</u>	<u>3867922</u>

Prosecution History

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Dec 29, 2015	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Jan 04, 2016	Feb 13, 2016
3	PENDING, INSTITUTED	Jan 04, 2016	
4	STIP FOR EXT	Jan 15, 2016	
5	EXTENSION OF TIME GRANTED	Jan 15, 2016	
6	ANSWER	Mar 14, 2016	
7	STIP TO SUSP PEND SETTL NEGOTIATIONS	Aug 10, 2016	
8	SUSPENDED	Aug 10, 2016	
9	STIP TO SUSP PEND SETTL NEGOTIATIONS	Nov 08, 2016	
10	SUSPENDED	Nov 08, 2016	
11	STIP TO SUSP PEND SETTL NEGOTIATIONS	Jan 11, 2017	
12	SUSPENDED	Jan 11, 2017	
13	W/DRAW OF OPPOSITION	Mar 21, 2017	
14	BD DECISION: DISMISSED W/ PREJ	Mar 24, 2017	
15	TERMINATED	Mar 24, 2017	
16	BD DECISION: DISMISSED	Mar 28, 2017	

Type of Proceeding: Opposition

Proceeding Number: 91213907

Filing Date: Dec 10, 2013

Status: Terminated

Status Date: Jan 14, 2015

Interlocutory Attorney: CHERYL S GOODMAN

Defendant

Name: Klein, George M.

Correspondent Address: LOUIS T PERRY
FAEGRE BAKER DANIELS
300 NORTH MERIDIAN STREET, SUITE 2700
INDIANAPOLIS IN UNITED STATES , 46204

Correspondent e-mail: louis.perry@faegrebd.com , tmindy@faegrebd.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
PEOPLOCITY	Registered	85644807	4867350

Plaintiff(s)

Name: Paylocity Corporation

Correspondent Address: JAMES MICHAEL FAIER
FAIER & FAIER PC
566 W ADAMS ST SUITE 600
CHICAGO IL UNITED STATES , 60661

Correspondent e-mail: jmfaier@faier.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
PAYLOCITY	Section 8 and 15 - Accepted and Acknowledged	77406931	3867921
PAYLOCITY REDEFINING THE WORLD OF PAYROLL + HR	Cancelled - Section 8	77406953	3867922
PAYLOCITY	REGISTERED AND RENEWED	78759629	3326870

Prosecution History

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Dec 10, 2013	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Dec 10, 2013	Jan 19, 2014
3	PENDING, INSTITUTED	Dec 10, 2013	
4	STIP FOR EXT	Jan 17, 2014	
5	EXTENSION OF TIME GRANTED	Jan 17, 2014	
6	CHANGE OF CORRESP ADDRESS	Jan 17, 2014	
7	STIP FOR EXT	Feb 18, 2014	
8	EXTENSION OF TIME GRANTED	Feb 18, 2014	
9	STIP FOR EXT	Feb 18, 2014	
10	EXTENSION OF TIME GRANTED	Feb 18, 2014	
11	ANSWER	Mar 19, 2014	
12	STIP TO SUSP PEND SETTL NEGOTIATIONS	May 20, 2014	
13	SUSPENDED	May 20, 2014	
14	STIP TO SUSP PEND SETTL NEGOTIATIONS	Jun 19, 2014	
15	SUSPENDED	Jun 19, 2014	
16	STIP TO SUSP PEND SETTL NEGOTIATIONS	Jul 17, 2014	
17	SUSPENDED	Jul 17, 2014	
18	STIP TO SUSP PEND SETTL NEGOTIATIONS	Aug 08, 2014	
19	SUSPENDED	Aug 08, 2014	
20	STIP TO SUSP PEND SETTL NEGOTIATIONS	Sep 17, 2014	
21	SUSPENDED	Sep 18, 2014	
22	MOT TO AMEND APPLICATION	Nov 12, 2014	
23	BD DECISION: DISMISSED W/ PREJ	Jan 14, 2015	

Type of Proceeding: Opposition

Proceeding Number: 91199044

Filing Date: Mar 11, 2011

Status: Terminated

Status Date: Feb 03, 2012

Interlocutory Attorney: ANDREW P BAXLEY

Defendant

Name: Payality, Inc.

Correspondent Address: D GREG DURBIN
MCCORMICK BARSTOW SHEPPARD
WAYTE CARRUTH LLP, 5 RIVER PARK PLACE EAST
FRESNO CA UNITED STATES , 93720 1501

Correspondent e-mail: daniel.cho@mccormickbarstow.com, melany.hertel@mccormickbarstow.com, greg.durbin@mccormickbarstow.com, rebecca.brown@mccormickbarstow.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
PAYALITY	Abandoned - After Inter-Partes Decision	<u>85101480</u>	

Plaintiff(s)

Name: Paylocity Corporation

Correspondent Address: JAMES MICHAEL FAIER
FAIER AND FAIER PC
566 WEST ADAMS STREET, SUITE 600
CHICAGO IL UNITED STATES , 60661

Correspondent e-mail: jmfaier@FAIER.COM

Associated marks

Mark	Application Status	Serial Number	Registration Number
PAYLOCITY	REGISTERED AND RENEWED	<u>78759629</u>	<u>3326870</u>
PAYLOCITY	Section 8 and 15 - Accepted and Acknowledged	<u>77406931</u>	<u>3867921</u>
PAYLOCITY REDEFINING THE WORLD OF PAYROLL + HR	Cancelled - Section 8	<u>77406953</u>	<u>3867922</u>

Prosecution History

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Mar 11, 2011	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Mar 17, 2011	Apr 26, 2011
3	PENDING, INSTITUTED	Mar 17, 2011	
4	D'S APPEARANCE OF COUNSEL/POWER OF ATTORNEY	Apr 20, 2011	
5	D'S MOT FOR EXTEN. OF TIME W/ CONSENT	Apr 21, 2011	
6	P'S REQUEST TO CORRECT ITS EMAIL ADDRESS	Apr 21, 2011	
7	EXTENSION OF TIME GRANTED	May 11, 2011	
8	ANSWER	Jun 10, 2011	
9	BOARD'S ORDER TRIAL DATES REMAIN AS PREVIOUSLY SET	Jun 15, 2011	
10	P'S MOT FOR EXTEN. OF TIME W/ CONSENT	Aug 19, 2011	
11	EXTENSION OF TIME GRANTED	Aug 23, 2011	
12	STIP TO SUSPEND PEND SETTLEMENT NEGOTNS	Dec 28, 2011	
13	SUSPENDED	Dec 28, 2011	
14	WITHDRAWAL OF APPLICATION	Jan 30, 2012	
15	BD'S DECISION: DISMISSED W/O PREJUDICE	Feb 03, 2012	
16	TERMINATED	Feb 03, 2012	

Int. Cl.: 35

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

United States Patent and Trademark Office

Reg. No. 3,326,870

Registered Oct. 30, 2007

**SERVICE MARK
PRINCIPAL REGISTER**

PAYLOCITY

SAROWITZ, STEVE (UNITED STATES INDIVIDUAL)
3850 N. WILKE ROAD
ARLINGTON HEIGHTS, IL 60004

FOR: ADMINISTRATION OF BUSINESS PAYROLL FOR OTHERS; PAYROLL PREPARATION FOR OTHERS; HUMAN RESOURCES CONSULTATION; HUMAN RESOURCES MANAGEMENT; UNEMPLOYMENT COST CONTROL MANAGEMENT; AND PAYROLL TAX FILING, IN CLASS 35 (U.S. CLS. 100, 101 AND 102).

FIRST USE 1-1-2006; IN COMMERCE 1-1-2006.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

SN 78-759,629, FILED 11-22-2005.

DAYNA BROWNE, EXAMINING ATTORNEY

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Mark: PAYLOCITY

PAYLOCITY

US Serial Number: 85755905

Application Filing Date: Oct. 16, 2012

US Registration Number: 4606104

Registration Date: Sep. 16, 2014

Register: Principal

Mark Type: Service Mark

TM5 Common Status Descriptor:



LIVE/REGISTRATION/Issued and Active

The trademark application has been registered with the Office.

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

Status Date: Sep. 16, 2014

Publication Date: Oct. 15, 2013

Notice of Allowance Date: Dec. 10, 2013

Mark Information

Mark Literal Elements: PAYLOCITY

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Related Properties Information

Claimed Ownership of US Registrations: 3326870, 3867921, 3867922

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: Human resource services, namely, serving as a human resources department for others, human resources management, human resources consultation, personnel selection for others; payroll services for others, namely, administration of business payroll for others, payroll preparation, payroll processing service; reselling services, namely, distributorship services in the field of computer software, namely, Benefit Administration Software and Applicant Tracking Software

International Class(es): 035 - Primary Class

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

Class Status: ACTIVE

Basis: 1(a)

First Use: Dec. 31, 2005

Use in Commerce: Dec. 31, 2005

For: Payroll services for others, namely, 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: Dec. 31, 2005

Use in Commerce: Dec. 31, 2005

For: Computer services, namely, providing temporary use of online non-downloadable software for use in the fields of payroll and human resources, namely, for use in payroll preparation and human resources management; Application service provider (ASP) featuring software for use in the fields of payroll and human resources, namely, for use in payroll preparation and human resources management; Providing on-line, non-downloadable, Internet-based software application for Attendance Software which is also known as Time and Labor Management software for use in managing time and attendance for business and their employees

International Class(es): 042 - Primary Class

U.S Class(es): 100, 101

Class Status: ACTIVE

Basis: 1(a)

First Use: Dec. 31, 2005

Use in Commerce: Dec. 31, 2005

Basis Information (Case Level)

Filed Use: No

Currently Use: Yes

Filed ITU: Yes

Currently ITU: No

Filed 44D: No

Currently 44E: No

Filed 44E: No

Currently 66A: No

Filed 66A: No

Currently No Basis: No

Filed No Basis: No

Current Owner(s) Information

Owner Name: Paylocity Corporation

Owner Address: 1400 American Lane
Schaumburg, ILLINOIS UNITED STATES 60173

Legal Entity Type: CORPORATION

State or Country Where Organized: ILLINOIS

Attorney/Correspondence Information

Attorney of Record

Attorney Name: James Michael Faier

Docket Number: 9230

Attorney Primary Email Address: jmfaier@faier.com

Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: JAMES MICHAEL FAIER
FAIER & FAIER P.C.
566 W ADAMS ST STE 600
CHICAGO, ILLINOIS UNITED STATES 60661-3632

Phone: 312-382-9400

Fax: 312-382-9200

Correspondent e-mail: jmfaier@faier.com ipdocket@faier.com

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Sep. 10, 2020	TEAS SECTION 8 & 15 RECEIVED	
Sep. 16, 2019	COURTESY REMINDER - SEC. 8 (6-YR) E-MAILED	
Sep. 16, 2014	REGISTERED-PRINCIPAL REGISTER	
Aug. 14, 2014	NOTICE OF ACCEPTANCE OF STATEMENT OF USE E-MAILED	
Aug. 13, 2014	ALLOWED PRINCIPAL REGISTER - SOU ACCEPTED	
Aug. 13, 2014	ASSIGNED TO EXAMINER	67604
Jul. 07, 2014	STATEMENT OF USE PROCESSING COMPLETE	71034
Jun. 10, 2014	USE AMENDMENT FILED	71034
Jul. 03, 2014	CASE ASSIGNED TO INTENT TO USE PARALEGAL	71034
Jun. 10, 2014	TEAS STATEMENT OF USE RECEIVED	

Dec. 10, 2013	NOA E-MAILED - SOU REQUIRED FROM APPLICANT	
Oct. 15, 2013	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Oct. 15, 2013	PUBLISHED FOR OPPOSITION	
Sep. 25, 2013	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
Sep. 10, 2013	LAW OFFICE PUBLICATION REVIEW COMPLETED	70884
Sep. 06, 2013	APPROVED FOR PUB - PRINCIPAL REGISTER	
Aug. 22, 2013	TEAS/EMAIL CORRESPONDENCE ENTERED	70884
Aug. 22, 2013	CORRESPONDENCE RECEIVED IN LAW OFFICE	70884
Aug. 15, 2013	ASSIGNED TO LIE	70884
Aug. 13, 2013	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Feb. 13, 2013	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Feb. 13, 2013	NON-FINAL ACTION E-MAILED	6325
Feb. 13, 2013	NON-FINAL ACTION WRITTEN	74645
Feb. 12, 2013	ASSIGNED TO EXAMINER	74645
Oct. 19, 2012	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Oct. 19, 2012	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: PUBLICATION AND ISSUE SECTION

Date in Location: Aug. 13, 2014

Assignment Abstract Of Title Information

Summary

Total Assignments: 1

Registrant: Paylocity Corporation

Assignment 1 of 1

Conveyance: SECURITY INTEREST

Reel/Frame: 6696/0153

Pages: 15

Date Recorded: Jul. 17, 2019

Supporting Documents: [assignment-tm-6696-0153.pdf](#)

Assignor

Name: PAYLOCITY CORPORATION

Execution Date: Jul. 17, 2019

Legal Entity Type: CORPORATION

State or Country: ILLINOIS

Where Organized:

Assignee

Name: PNC BANK, NATIONAL ASSOCIATION (AS ADMINISTRATIVE AGENT)

Legal Entity Type: NATIONAL BANKING ASSOCIATION

State or Country: UNITED STATES

Where Organized:

Address: 500 FIRST AVE., 4TH FLOOR
PITTSBURGH, PENNSYLVANIA 15219

Correspondent

Correspondent Name: STEPHANIE A. MARTINEZ, MCGUIREWOODS LLP

Correspondent Address: GATEWAY PLAZA, 800 EAST CANAL STREET
RICHMOND, VA 23219

Domestic Representative - Not Found

United States of America
United States Patent and Trademark Office

PAYLOCITY

Reg. No. 4,606,104

Registered Sep. 16, 2014

Int. Cls.: 35, 36, and 42

SERVICE MARK

PRINCIPAL REGISTER

PAYLOCITY CORPORATION (ILLINOIS CORPORATION)
1331 GREENLEAF AVENUE
ELK GROVE VILLAGE, IL 60007

FOR: HUMAN RESOURCE SERVICES, NAMELY, SERVING AS A HUMAN RESOURCES DEPARTMENT FOR OTHERS, HUMAN RESOURCES MANAGEMENT, HUMAN RESOURCES CONSULTATION, PERSONNEL SELECTION FOR OTHERS; PAYROLL SERVICES FOR OTHERS, NAMELY, ADMINISTRATION OF BUSINESS PAYROLL FOR OTHERS, PAYROLL PREPARATION, PAYROLL PROCESSING SERVICE; RESELLING SERVICES, NAMELY, DISTRIBUTORSHIP SERVICES IN THE FIELD OF COMPUTER SOFTWARE, NAMELY, BENEFIT ADMINISTRATION SOFTWARE AND APPLICANT TRACKING SOFTWARE, IN CLASS 35 (U.S. CLS. 100, 101 AND 102).

FIRST USE 12-31-2005; IN COMMERCE 12-31-2005.

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

FIRST USE 12-31-2005; IN COMMERCE 12-31-2005.

FOR: COMPUTER SERVICES, NAMELY, PROVIDING TEMPORARY USE OF ONLINE NON-DOWNLOADABLE SOFTWARE FOR USE IN THE FIELDS OF PAYROLL AND HUMAN RESOURCES, NAMELY, FOR USE IN PAYROLL PREPARATION AND HUMAN RESOURCES MANAGEMENT; APPLICATION SERVICE PROVIDER (ASP) FEATURING SOFTWARE FOR USE IN THE FIELDS OF PAYROLL AND HUMAN RESOURCES, NAMELY, FOR USE IN PAYROLL PREPARATION AND HUMAN RESOURCES MANAGEMENT; PROVIDING ON-LINE, NON-DOWNLOADABLE, INTERNET-BASED SOFTWARE APPLICATION FOR ATTENDANCE SOFTWARE WHICH IS ALSO KNOWN AS TIME AND LABOR MANAGEMENT SOFTWARE FOR USE IN MANAGING TIME AND ATTENDANCE FOR BUSINESS AND THEIR EMPLOYEES, IN CLASS 42 (U.S. CLS. 100 AND 101).

FIRST USE 12-31-2005; IN COMMERCE 12-31-2005.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NOS. 3,326,870, 3,867,921, AND 3,867,922.



Michelle K. Lee

Deputy Director of the United States
Patent and Trademark Office

Reg. No. 4,606,104 SN 85-755,905, FILED 10-16-2012.

J. LESLIE BISHOP, EXAMINING ATTORNEY

**REQUIREMENTS TO MAINTAIN YOUR FEDERAL
TRADEMARK REGISTRATION**

**WARNING: YOUR REGISTRATION WILL BE CANCELLED IF YOU DO NOT FILE THE
DOCUMENTS BELOW DURING THE SPECIFIED TIME PERIODS.**

Requirements in the First Ten Years*
What and When to File:

First Filing Deadline: You must file a Declaration of Use (or Excusable Nonuse) between the 5th and 6th years after the registration date. See 15 U.S.C. §§1058, 1141k. If the declaration is accepted, the registration will continue in force for the remainder of the ten-year period, calculated from the registration date, unless cancelled by an order of the Commissioner for Trademarks or a federal court.

Second Filing Deadline: You must file a Declaration of Use (or Excusable Nonuse) and an Application for Renewal between the 9th and 10th years after the registration date.*
See 15 U.S.C. §1059.

Requirements in Successive Ten-Year Periods*
What and When to File:

You must file a Declaration of Use (or Excusable Nonuse) and an Application for Renewal between every 9th and 10th-year period, calculated from the registration date.*

Grace Period Filings*

The above documents will be accepted as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

**The United States Patent and Trademark Office (USPTO) will NOT send you any future notice or
reminder of these filing requirements.**

***ATTENTION MADRID PROTOCOL REGISTRANTS:** The holder of an international registration with an extension of protection to the United States under the Madrid Protocol must timely file the Declarations of Use (or Excusable Nonuse) referenced above directly with the USPTO. The time periods for filing are based on the U.S. registration date (not the international registration date). The deadlines and grace periods for the Declarations of Use (or Excusable Nonuse) are identical to those for nationally issued registrations. See 15 U.S.C. §§1058, 1141k. However, owners of international registrations do not file renewal applications at the USPTO. Instead, the holder must file a renewal of the underlying international registration at the International Bureau of the World Intellectual Property Organization, under Article 7 of the Madrid Protocol, before the expiration of each ten-year term of protection, calculated from the date of the international registration. See 15 U.S.C. §1141j. For more information and renewal forms for the international registration, see <http://www.wipo.int/madrid/en/>.

NOTE: Fees and requirements for maintaining registrations are subject to change. Please check the USPTO website for further information. With the exception of renewal applications for registered extensions of protection, you can file the registration maintenance documents referenced above online at <http://www.uspto.gov>.