

ESTTA Tracking number: **ESTTA1134439**

Filing date: **05/17/2021**

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

Petition for Cancellation

Notice is hereby given that the following party has filed a petition to cancel the registration indicated below.

Petitioner Information

Name	Wisepay Inc		
Entity	Corporation	Citizenship	Minnesota
Address	9217 17TH AVE S BLOOMINGTON, MN 55425 UNITED STATES		

Correspondence information	KATHERINE KOENIG KOENIG IP WORKS, PLLC 2208 MARINER DR. FORT LAUDERDALE, FL 33316 UNITED STATES Primary Email: mail@koenigipworks.com 9549031699		
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Registrations Subject to Cancellation

Registration No.	5984501	Registration date	02/11/2020
Registrant	ADP, INC. ONE ADP BOULEVARD ROSELAND, NJ 07068 UNITED STATES		

Goods/Services Subject to Cancellation

Class 009. First Use: 2018/09/25 First Use In Commerce: 2018/09/25 All goods and services in the class are subject to cancellation, namely: Magnetically encoded debit cards
Class 036. First Use: 2018/09/25 First Use In Commerce: 2018/09/25 All goods and services in the class are subject to cancellation, namely: Debit card services, namely, processing of debit card transactions and payments; payment processing services, namely, debit card transaction processing services; prepaid purchase card services, namely, processing electronic payments through prepaid cards, issuing prepaid credit cards; on-line prepaid card services, namely, processing of prepaid card transactions and payments; issuing prepaid debit cards for electronic cash transactions

Grounds for Cancellation

Other	Petition for relief under Section 18 of the Lanham Act, 15 U.S.C. § 1068 that the Board modify and/or limit the goods and services specified in the Subject Registrations and correct the date of first use listed in the Subject Registra-
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Registration No.	5986500	Registration date	02/11/2020
Registrant	ADP, INC. ONE ADP BOULEVARD ROSELAND, NJ 07068 UNITED STATES		

Goods/Services Subject to Cancellation

Class 009. First Use: 2018/09/25 First Use In Commerce: 2018/09/25 All goods and services in the class are subject to cancellation, namely: Magnetically encoded debit cards
Class 036. First Use: 2018/09/25 First Use In Commerce: 2018/09/25 All goods and services in the class are subject to cancellation, namely: Debit card services, namely, processing of debit card transactions and payments; payment processing services, namely, debit card transaction processing services; prepaid purchase card services, namely, processing electronic payments through prepaid cards, issuing prepaid credit cards; on-line prepaid card services, namely, processing of prepaid card transactions and payments; issuing prepaid debit cards for electronic cash transactions

Grounds for Cancellation

Other	Petition for relief under Section 18 of the Lanham Act, 15 U.S.C. § 1068 that the Board modify and/or limit the goods and services specified in the Subject Registrations and correct the date of first use listed in the Subject Registrations.
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Related Proceedings	Opp. No. 91268677
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Attachments	IC-3000-5TC_Petition_Cancellation_5984501_and_5986500.pdf(32215 bytes)
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Signature	/Katherine Koenig/
Name	Katherine Koenig
Date	05/17/2021

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

In the matter of Registration Nos. 5,984,501 and 5,986,500
For the mark: WISELY and WISELY (plus design)

_____)	
Wisepay Inc)	
)	
)	
Petitioner)	
)	
v.)	Cancellation No.
)	
ADP, INC.,)	
)	
Registrant)	
_____)	

CONSOLIDATED PETITION FOR CANCELLATION AND MODIFICATION

Wisepay Inc (“Petitioner”) believes it has been and will continue to be damaged by U.S. Trademark Registration Nos. 5,984,501 and 5,986,500 for the marks WISELY and WISELY (plus design) (“Subject Registrations”), and hereby petitions for relief under Section 18 of the Lanham Act, 15 U.S.C. § 1068, requiring ADP INC. (“Registrant”) to modify and/or limit the goods and services specified in the Subject Registrations and correct the date of first use listed in the Subject Registrations.

As grounds for partial cancellation and/or modification, Petitioner alleges as follows:

1. Petitioner is a Minnesota Company domiciled in Minnesota.
2. Petitioner’s Application Serial No. 88/181,764, for the mark WISEPAY, has been opposed by Registrant on the basis of priority and likelihood of confusion with a number of registered trademarks owned by Registrant, including the Subject Registrations, Registration Nos. 5,984,501 and 5,986,500.

3. Petitioner’s Application Serial No. 88/181,764, which was filed on November 5, 2018, covers the following services:

Class	Goods and Services
International Class 36	Financial transaction services, namely, providing secure commercial transactions and payment options; Electronic transfer of money

4. On information and belief, Registrant is a Delaware Company with a principal place of business in New Jersey.

5. On information and belief, Registrant offers payroll processing and payment services for others, and the goods and services offered in connection with the Subject Registrations are offered as a component of its payroll services and allow card holders and account holders to receive early payment of paychecks if such payments are deposited directly to an account associated with the marks of the Subject Registrations.

6. The current offerings of Registrant all advertise a direct deposit feature from an employer to an account and debit card offered under the marks of the Subject Registrations. This benefit corresponds with Registrant’s traditional payroll processing services offered under the mark ADP, for which it is well known.

7. Registrant’s website, <https://info.mywisely.com/about-us>, which was accessed on May 16, 2021, states the following: *“Wisely® is a suite of personalized payment solutions designed to give consumers faster and more flexible choices for how they access their pay and other sources of income.”*

8. The Subject Registrations cover the following goods and services:

Class	Goods and Services
International Class 9	Magnetically encoded debit cards
International Class 36	Debit card services, namely, processing of debit card transactions and payments; payment processing services, namely, debit card transaction processing services; prepaid purchase card services, namely, processing electronic payments through prepaid cards, issuing prepaid credit cards; on-line prepaid card services, namely, processing of prepaid card transactions and payments; issuing prepaid debit cards for electronic cash transactions

9. On information and belief, Registrant does not use the subject marks in connection with the broad description of goods and services in the Subject Registrations.

10. On information and belief, Registrant uses the marks of the Subject Registrations, Wisely and Wisely (plus design), marks in connection with the following goods and services:

Class	Goods and Services
International Class 9	Magnetically encoded debit cards offered as a component of a bank account with the ability for employer direct deposit funding
International Class 36	Debit card services, namely, processing of debit card transactions and payments; payment processing services, namely, debit card transaction processing services; prepaid purchase card services, namely, processing electronic payments through prepaid cards, issuing prepaid credit cards; on-line prepaid card services, namely, processing of prepaid card transactions and payments; issuing prepaid debit cards for electronic cash transactions; all of the services in international class 36 being offered as a component of a bank account with the ability for employer direct deposit funding

21. On information and belief, this narrower description of goods and services is commercially significant and could avoid a likelihood of confusion finding in the Opposition proceeding involving Petitioner's WISEPAY mark, Application Serial No. 88/181,764.

22. On information and belief, although the marks Wisely By ADP (plus design) and Wisely Direct by ADP appear to have been in use as of November 29, 2018, which is the date at least one specimen submitted to the USPTO was printed from the web, **the marks of the Subject Registrations, WISELY and WISELY (plus design) were not in use as of September 25, 2018, which is the date Registrant provided to the USPTO as a date of first use for the marks of the Subject Registrations.**

23. Registrant's submitted allegations of use, which purported to show use of the marks of the Subject Registrations, mutilated the marks and did not show evidence of the marks of the Subject Registrations being used in commerce.

24. Research confirms that, as of June 10, 2019, the marks Wisely by ADP (plus design) and MyWisely were being used in connection with Registrant's goods and services, and WISELY and WISELY (plus design) were not in use in commerce.

25. Notably and serving as confirmation of these findings, Registration No. 5,984,501 was filed based upon use in commerce on August 28, 2019, and Registration 5,986,500 was filed on March 28, 2019, based upon intent to use in commerce.

26. Use of the marks of the Subject Registrations commenced at some point between June 10, 2019, and August 28, 2019.

27. Accordingly, the dates of first use for the Subject Registrations should be amended until at least after June 10, 2019, or to a date determined as a correct date of first use by the Trademark Trial and Appeal Board.

11. The correction to the dates of first use for the Subject Registrations is significant, as Registrant has opposed Petitioner's Application Serial No. 88/181,764, for the mark WISEPAY, on the basis of priority and likelihood of confusion with the Subject Registrations. Petitioner has a filing date of November 5, 2018, and Registrant relies upon the inaccurate September 25, 2018, date of first use as the basis for the opposition.

12. A modification of the date of first use of the Subject Registrations until after September 25, 2018, would therefore prevent a finding of a likelihood of confusion in favor of Registrant and render the opposition proceeding involving Application Serial No. 88/181,764 moot.

28. The goods, services and dates of first use in the Subject Registrations should be modified pursuant to Section 18 of the Lanham Act, 15 U.S.C. § 1068.

PRAYER FOR RELIEF

WHEREFORE, Petitioner respectfully requests that, pursuant to 15 U.S.C. § 1068, Registrant be required to modify the goods and services and dates of first use of the Subject Registrations.

Dated: Fort Lauderdale, FL
May 17, 2021

Respectfully submitted,

By: /s/Katherine Koenig/_____

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WISEPAY INC