

ESTTA Tracking number: **ESTTA1141281**

Filing date: **06/18/2021**

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

Proceeding	92077163
Party	Defendant ADP, Inc.
Correspondence Address	ADP, INC. ONE ADP BOULEVARD ROSELAND, NJ 07068 UNITED STATES Primary Email: trademarks@adp.com No phone number provided.
Submission	Motion to Dismiss - Rule 12(b)
Filer's Name	Sharoni S. Finkelstein
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Signature	/Sharoni S. Finkelstein/
Date	06/18/2021
Attachments	Motion to Dismiss Wisepay Cancellation re WISELY_WISELY Design.pdf(173851 bytes ) Motion to Dismiss Wisepay Cancellation - EXHIBIT A.pdf(156501 bytes )

**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**

**Marks: WISELY and** 

**Wisepay Inc.,**

**Petitioner,**

**v.**

**ADP, Inc.,**

**Respondent.**

**Cancellation No. 92077163**

Attorney's Reference: 27319.540887

**RESPONDENT'S MOTION TO DISMISS**

Respondent ADP, Inc. (“**ADP**”), through its undersigned counsel, hereby moves the Trademark Trial and Appeal Board (the “**Board**”) to dismiss the Petition for Cancellation and Modification filed by Wisepay Inc. (“**Petitioner**”) pursuant to the Federal Rules of Civil Procedure and TBMP § 503.

**I. BACKGROUND**

Founded in 1949, ADP is one of the world's leading providers of human capital management (“**HCM**”) solutions that unite human resources, payroll, talent, and benefits administration, as well as business outsourcing services, analytics and compliance expertise. For over seventy years, ADP has helped reimagine the workplace with cutting-edge payment solutions that touch millions of lives daily. ADP was the first in HCM to deliver automation, move to the cloud, provide a mobile app, and create an online marketplace, leading the industry in innovation.

In recognition of innovations like this, ADP is proud to be named one of Fortune's "World's Most Admired Companies" for fourteen consecutive years. Today, ADP is the payroll source for one in six U.S. workers, and nearly 37 million workers worldwide, with 860,000 clients in 140 countries.

ADP launched its WISELY brand in 2017 in connection with alternative banking solutions, including debit cards and a mobile application, designed to give businesses a faster way to put money in the hands of employees while giving individuals faster and more flexible choices for how they access and manage their pay and other sources of income. The goods and services offered under the WISELY Marks combine to create modern financial solutions featuring accounts, debit cards and a mobile application which makes it easy for workers to manage, spend or save their money.

On April 12, 2021, ADP filed a Notice of Opposition against Petitioner's U.S. Trademark Application No. 88/181,764 for WISEPAY based on a likelihood of confusion with ADP's federally registered WISELY marks, namely, WISELY (Reg. No. 5984501), WISELY & Design (Reg. No. 5986500), and WISELY BY ADP (Reg. No. 5705333). *ADP, Inc. v. Wisepay Inc.*, Opposition No. 91268677 (hereafter, the "**Opposition**").

More than a month later, on May 17, 2021, Petitioner filed in the Opposition an unconsented Motion to Amend Application Serial No. 88/181,764. That same day, Petitioner filed two separate actions petitioning to cancel the WISELY registrations pleaded in the Opposition: (1) *Wisepay Inc. v. ADP, Inc.*, Cancellation No. 92077163, and (2) *Wisepay Inc. v. ADP, Inc.*, Cancellation No. 92077222. In the instant action, Cancellation No. 92077163 (the "**Cancellation**"), Petitioner seeks to modify the goods and services in ADP's WISELY and WISELY & Design registration, and to modify the dates of first use.

On May 21, 2021, Petitioner filed an Answer in the Opposition in which it denied the salient allegations of the Notice of Opposition, and asserted purported “affirmative defenses” that did not mention the Cancellation. Among these “defenses” is an allegation that the WISELY and WISELY & Design mark were not in use as of September 25, 2018—the first-use date stated in the Registrations. This “affirmative defense” indicates that Petitioner knew enough about its theory of the case at the time it filed its Answer in the Opposition, and was in a position to assert its compulsory counterclaim with or as part of its Answer. Attached hereto as Exhibit A is a copy of Petitioner’s Answer in the Opposition.

On June 10, 2021, Petitioner filed in the Opposition an unconsented Motion to Suspend Proceedings, seeking to suspend the Opposition on grounds that Cancellation Nos. 92077163 and 92077222 “may have a bearing on [the Opposition].” Taken together, the above actions were a thinly veiled attempt to sidestep the Opposition.

## **II. ARGUMENT**

The Cancellation must be dismissed with prejudice because the allegations amount to compulsory counterclaims that should have been pleaded in the Opposition.

The TTAB Manual of Procedure is clear: “If the defendant knows the grounds for a counterclaim to cancel a pleaded registration when the answer is filed, the counterclaim must be pleaded with or as part of the answer,” not as a freestanding proceeding. TBMP § 313.04 (emphasis added). “A defendant who fails to timely plead a compulsory counterclaim cannot avoid the effect of its failure by thereafter asserting the counterclaim grounds in a separate petition to cancel. In such a case, the separate petition will be dismissed. . . .” *Id.* (emphasis added). Indeed, the Trademark Rules of Practice provide for compulsory counterclaims to “avoid piecemeal litigation of a multiplicity of actions and counteractions relating to a single conflict or

controversy.” Trademark Opposition and Cancellation Proceedings: Compulsory Counterclaims, Final Rule, 46 Fed. Reg. 6934, 6935 (Jan. 22, 1981) (emphasis added).

There is no question that Petitioner knew the grounds for a potential counterclaim to cancel Registration Nos. 5984501 and 5986500 when it filed its Answer in the Opposition. First, Petitioner filed the Cancellation *four days prior* to filing its Answer in the Opposition. As such, Petitioner certainly knew of the grounds for cancellation when the Answer was ultimately filed. Second, Petitioner’s Answer in the Opposition included “affirmative defenses” on the same grounds as those asserted in the Cancellation. *See Exhibit A.*<sup>1</sup> Under these circumstances, the Trademark Rules of Practice mandate that the grounds for cancellation be pleaded as a counterclaim in the Opposition.

Finally, permitting the Cancellation to proceed as a separate proceeding will undoubtedly cause unnecessary delay and needlessly increase the cost of litigation and burden on the Board. Indeed, Petitioner’s unconsented Motion to Suspend the Opposition will effectively delay ADP relief in the Opposition. Further, because each of the proceedings involves the same parties and the same marks, forcing ADP to engage in duplicative discovery in each of the proceedings will certainly increase the cost of litigation. A multiplicity of actions in this case will also burden the Board and its resources.

In sum, Petitioner failed to file a compulsory counterclaim in the Opposition, despite that it was aware of the precise facts that form the basis of its Petition in the Cancellation. Petitioner

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<sup>1</sup> In its Answer, Petitioner asserted the following affirmative defenses:

¶ 33 – “Upon information and belief, [ADP] does not use the WISELY and WISELY (plus design) marks in connection with the broad description of goods and services listed in associated Reg. No. 5,984,501 and Reg. No. 5,986,500, respectively.”

¶ 34 – “Upon information and belief, WISELY and WISELY (plus design) were not in use as of September 25, 2018, which is the date [ADP] provided to the USPTO as a date of first use for each mark.”

cannot now seek relief on its claims in the Cancellation as a thinly veiled attempt to sidestep the Opposition, and its Petition must be dismissed with prejudice.

### **III. CONCLUSION**

Based on the foregoing, ADP respectfully requests that the Board dismiss this Cancellation with prejudice.

Dated: June 18, 2021

Respectfully submitted,

/s/ Sharoni S. Finkelstein

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*Attorneys for Respondent ADP, Inc.*

## CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing **RESPONDENT'S MOTION TO DISMISS** has been served on Wisepay Inc. by forwarding said copy on June 18, 2021, via email to the following counsel of record:

Katherine Koenig  
Koenig IP Works PLLC  
2208 Mariner Drive  
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/s/ Sharoni S. Finkelstein  
Sharoni S. Finkelstein

# **EXHIBIT A**



ESTTA Tracking number: **ESTTA1135669**

Filing date: **05/21/2021**

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

Proceeding	91268677
Party	Defendant Wisepay Inc
Correspondence Address	KATHERINE KOENIG KOENIG IP WORKS, PLLC 2208 MARINER DR. FORT LAUDERDALE, FL 33316 UNITED STATES Primary Email: mail@koenigipworks.com 954-903-1699
Submission	Answer
Filer's Name	Katherine Koenig
Filer's email	mail@koenigipworks.com
Signature	/Katherine Koenig/
Date	05/21/2021
Attachments	IC-3000-2TO_Answer.pdf(168378 bytes )

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

In the matter of Trademark Application Serial No.: 88/181,764  
For the Mark: WISEPAY  
Filed: November 5, 2018  
Published in the *Official Gazette* on: October 13, 2020

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<b>ADP, Inc.,</b>	:	
	:	
	:	
<i>Opposer,</i>	:	
	:	Opposition No. 91268677
vs.	:	
	:	
<b>Wisepay Inc,</b>	:	
	:	
<i>Applicant.</i>	:	

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**ANSWER**

The following is the Answer of Applicant Wisepay Inc, owner of U.S. Trademark Application Serial No. 88/181,764 (“Subject Application”) for the mark WISEPAY in International Class 036, by and through Koenig IP Works, PLLC, to the Notice of Opposition filed April 12, 2021 (“Opposition”), by ADP, Inc. (“Opposer”) and assigned Opposition No. 91268677.

Applicant hereby responds, solely for the purpose of this proceeding, to each of the grounds set forth in the Notice of Opposition, as follows:

1. Admitted.
2. Admitted.
3. Admitted.
4. Applicant is without knowledge or information sufficient to form a belief as to the

truth of the allegations contained in paragraph 4 of the Notice of Opposition.

5. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 5 of the Notice of Opposition.

6. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 6 of the Notice of Opposition.

7. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 7 of the Notice of Opposition, and therefore denies them.

8. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 8 of the Notice of Opposition, and therefore denies them.

9. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 9 of the Notice of Opposition, and therefore denies them.

10. Admitted.

11. Admitted.

12. This paragraph states a legal conclusion, and therefore does not require a response. To the extent that a response is required, the allegations are denied.

13. This paragraph states a legal conclusion, and therefore does not require a response. To the extent that a response is required, the allegations are denied.

14. Denied.

15. Applicant admits the allegations of paragraph 15, but denies any implication by Opposer that Applicant's mark is likely to cause confusion with Opposer's marks.

16. Denied.

17. Denied.

18. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 18 of the Notice of Opposition, and therefore denies them.

19. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 19 of the Notice of Opposition, and therefore denies them.

20. This paragraph states a legal conclusion, and therefore does not require a response. To the extent that a response is required, the allegations are denied.

21. Denied.

22. Denied.

23. Denied as to any allegation that Opposer would be damaged and injured by registration of Applicant's WISEPAY mark.

### **AFFIRMATIVE DEFENSES**

FURTHERMORE, Applicant alleges and asserts the following in support of its defense:

24. Opposer's marks and Applicant's mark differ in appearance.

25. Opposer's marks and Applicant's mark differ in spelling.

26. Opposer's mark WISELY BY ADP includes "BY ADP" which clearly identifies the source of the goods and services and distinguishes Opposer's mark from Applicant's mark.

27. Opposer's goods and services and Applicant's services are different.

28. Upon information and belief, Opposer's goods and services and Applicant's services are in different channels of trade.

29. Upon information and belief, Applicant has priority in the United States.

30. The Subject Application was filed on November 5, 2018, which predates the filing date of the application for Opposer's WISELY mark, August 28, 2019.

31. The Subject Application was filed on November 5, 2018, which predates the filing date of the application for Opposer's WISELY (plus design) mark, March 28, 2019.

32. Upon information and belief, Opposer has abandoned its WISELY BY ADP mark.

33. Upon information and belief, Opposer does not use the WISELY and WISELY (plus design) marks in connection with the broad description of goods and services listed in associated Reg. No. 5,984,501 and Reg. No. 5,986,500, respectively.

34. Upon information and belief, WISELY and WISELY (plus design) were not in use as of September 25, 2018, which is the date Opposer provided to the USPTO as a date of first use for each mark.

35. Upon information and belief, the allegations of use submitted to the USPTO by Opposer for the WISELY and WISELY (plus design) marks mutilated the marks and did not show evidence of the marks being used in commerce.

36. Applicant's mark and Opposer's marks are not likely to cause confusion, mistake, or deception among purchasers as to the source of Opposer's and Applicant's respective goods and services.

37. Opposer is not likely to be damaged by Applicant's registration and use of the WISEPAY mark.

38. Applicant reserves the right to assert any and all other affirmative defenses of which Applicant becomes aware during the pendency of this matter.

WHEREFORE, Applicant requests that the Trademark Trial and Appeal Board deny the Notice of Opposition.

Respectfully submitted,

KOENIG IP WORKS, PLLC

Date: May 21, 2021

/Katherine Koenig/  
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*Attorney for Opposer*

**CERTIFICATE OF SERVICE**

The undersigned, Applicant's Attorney, hereby certifies that on the 21st day of May 2021, she caused a true and correct copy of the foregoing ANSWER to be served upon Opposer by email at the following addresses:

Sharoni S. Finkelstein, [ssfinkelstein@venable.com](mailto:ssfinkelstein@venable.com)  
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/Katherine Koenig/  
Katherine Koenig  
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Wisepay Inc