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

Proceeding	92077163
Party	Plaintiff Wisepay Inc
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**UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Wisepay Inc.,	:	
	:	
Petitioner,	:	
	:	
v.	:	Cancellation No. 92077163
	:	
ADP, Inc.,	:	
	:	
Registrant.	:	
	:	

OPPOSITION TO MOTION TO DISMISS

Wisepay Inc. (“Wisepay”), by and through its undersigned counsel, hereby opposes the motion to dismiss filed by ADP, Inc. (“ADP”) on the grounds that the Trademark Trial and Appeal Board (the “TTAB”) Manual of Procedure specifically permits a defense attacking the validity of a plaintiff’s pleaded registration to be raised either as a counterclaim **or** as a separate petition to cancel. Accordingly, there is no basis in law for ADP’s mistaken assertion that the petition for cancellation must have been pleaded as a counterclaim.

I. FACTUAL AND PROCEDURAL BACKGROUND

On April 12, 2021, ADP filed a Notice of Opposition (No. 91268677) against Wisepay’s U.S. Trademark Application No. 88/181,764 for WISEPAY (the “Opposition”). As a basis for its Opposition, ADP pleads rights in the following applications and registrations: (1) WISELY (Reg. No. 5,984,501); (2) Wisely (Design) (Reg. No. 5,986,500); and (3) WISELY BY ADP (Reg. No. 5,705,333) (collectively the “WISELY Marks”).

Prior to filing an Answer, on May 17, 2021, Wisepay filed two separate actions petitioning to cancel the WISELY Marks (Cancellation Nos. 92077222 and the instant proceeding)

(collectively the “Petitions for Cancellation”). The Petitions for Cancellation were grounded on the basis that (1) WISEPAY has priority of use *vis a vis* the WISELY and Wisely (Design) marks because the latter marks were not used in commerce until a date long after the alleged first use date provided to the USPTO; (2) the WISELY and Wisely (Design) marks are used only in a narrow range of goods and services – negating any likelihood of confusion with WISEPAY; and (3) WISELY BY ADP has been abandoned with no intent to resume use. Both Petitions for Cancellation reference the original Opposition proceeding.

II. ARGUMENT

ADP’s motion to dismiss must be denied because the basis of the motion rests on a misreading of the applicable rules and procedures. The TTAB Manual of Procedure “specifically permit[s] a defense attacking the validity of a plaintiff’s pleaded registration to be raised either as a counterclaim **or as a separate petition to cancel.**” TBMP § 313.01 (emphasis added). The TTAB Manual of Procedure further states that “[i]f the defense is raised as a separate petition to cancel, however, the petition itself and any cover letter should include a reference to the original proceeding.” *Id.*

Here, Wisepay’s decision to attack the validity of the WISELY Marks in separate Petitions for Cancellation is explicitly permitted by the TTAB Manual of Procedure. Indeed, the language “or as a separate petition to cancel” expressly provides that the Petitions for Cancellation are properly instituted. Wisepay was presented with a choice of filing a counterclaim or a separate petition to cancel. It chose to file a separate petition.

Further, if accepted, ADP’s tortured reading of the applicable rules would render the TTAB Manual of Procedure incomprehensible. As set forth above, the TTAB Manual of Procedure requires that if a defense is raised as a separate petition to cancel, the petition should include a reference to the original proceeding. However, under ADP’s erroneous reading of the rules, no

separate petition to cancel would be permitted whatsoever. Accordingly, ADP's position directly conflicts with the TTAB's well established procedures.

Moreover, ADP's reliance on TBMP § 313.04 is misplaced. Rule 313.04 states that "[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." However, that is not what happened here. Wisepay did not fail to timely plead a counterclaim and then belatedly attempt to assert it in a separate petition to cancel. Rather, Wisepay timely filed its Petitions for Cancellation in response to ADP's Opposition. Indeed, as ADP admits, Wisepay filed the Petitions for Cancellation before it filed a responsive pleading to the Opposition. As a result, it is indisputable that the Petitions for Cancellation were filed in a timely manner and not in an attempt to assert claims that had otherwise lapsed. Accordingly, ADP's reliance on Rule 313.04 is inapposite.

Finally, there is no basis to ADP's assertion that the Petitions for Cancellation will have any adverse impact on the parties or the Board. To the contrary, the Petitions for Cancellation will narrow the disputed issues and potentially render the Opposition moot if the WISELY Marks are invalidated. Thus, far from increasing the burden on the Board, the Petitions for Cancellation will have the opposite effect and lighten the Board's workload. Moreover, there is no basis to ADP's assertion that the Petitions for Cancellation will duplicate discovery and increase costs. As an initial matter, Wisepay already filed a motion to suspend the Opposition. If granted, no additional costs will be incurred in that proceeding and no discovery will be duplicated.¹ Further, there are other tools at the Board's disposal to prevent needless costs, such as consolidation of the two

¹ As noted, if the Petitions for Cancellation are successful, the parties may never have to incur any costs in connection with the Opposition because it will be rendered moot.

Petitions for Cancellation, if appropriate. ADP's request that this proceeding be dismissed without recourse is a draconian measure that must be rejected by the Board.

III. CONCLUSION

Based on the foregoing, Wisepay respectfully requests that the Board deny ADP's motion to dismiss.

Dated: Fort Lauderdale, Florida
June 25, 2021

Respectfully Submitted,

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CERTIFICATE OF SERVICE

On this 25th day of June, 2021, a true and correct copy of the foregoing document was served by e-mailing a copy to Registrant's counsel: Sharoni S. Finkelstein and Andrew D. Price, at the addresses of: ssfinkelstein@venable.com, adprice@venable.com, ipdocketingsf@venable.com, as required by the Trademark Trial and Appeal Board.

KOENIG IPWORKS, PLLC

 /s/ Katherine Koenig
Katherine Koenig
Attorney for Applicant
Wisepay Inc