

ESTTA Tracking number: **ESTTA484696**

Filing date: **07/20/2012**

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	Netpay Plus+, Inc.
Granted to Date of previous extension	07/22/2012
Address	2600 Foothill Boulevard, Suite 208 Glendale, CA 91214 UNITED STATES

Attorney information	Belinda K. Orem Paul Hastings LLP 515 South Flower Street Twenty-Fifth Floor Los Angeles, CA 90071 UNITED STATES belindaorem@paulhastings.com, joelhernandez@paulhastings.com Phone:213-683-6202
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Applicant Information

Application No	85241921	Publication date	01/24/2012
Opposition Filing Date	07/20/2012	Opposition Period Ends	07/22/2012
Applicant	Netpay Payroll Inc. suite 601 367 Van Ness Way, Torrance, CA 91803 UNITED STATES		

Goods/Services Affected by Opposition

Class 035. All goods and services in the class are opposed, namely: Accounting services; Administrative accounting; Employee administration services; Employee relations information services; Human resources consultancy; Insurance lead collection and matching services, namely, matching consumer requests for insurance policy quotes collected over the internet to pre-qualified insurance brokers, agents and agencies interested in those requests; Promotion of financial and insurance services, on behalf of third parties
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		

Word Mark	NETPAY
Goods/Services	Marketing and providing a variety of employment and human resources services, including without limitation, employee leasing, human resources management outsourcing, employee administration services, employee health and benefits administration, workers' compensation administration, payroll and tax services, accounting, bookkeeping services, and collection of third party quotations and evaluation of quotes - including without limitation for health (medical, dental, vision) insurance, general liability insurance, life insurance, errors and omission policies, and workers' compensation insurance - provided by vendors for recommendation to clients

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	NETPAY PLUS+		
Goods/Services	Marketing and providing a variety of employment and human resources services, including without limitation, employee leasing, human resources management outsourcing, employee administration services, employee health and benefits administration, workers' compensation administration, payroll and tax services, accounting, bookkeeping services, and collection of third party quotations and evaluation of quotes - including without limitation for health (medical, dental, vision) insurance, general liability insurance, life insurance, errors and omission policies, and workers' compensation insurance - provided by vendors for recommendation to clients		

Attachments	Notice of Opposition - NETPAY.pdf (5 pages)(172571 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Belinda K. Orem/
Name	Belinda K. Orem
Date	07/20/2012

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

In the Matter of Application Serial No. 85/241,921
Published in the Official Gazette on January 24, 2012
Mark: NETPAY

NETPAY PLUS+, INC.,

Opposer,

v.

NETPAY PAYROLL, INC.,

Applicant.

Opposition No.

NOTICE OF OPPOSITION

NetPay Plus+, Inc. ("Netpay Plus+" or "Opposer") believes that it will be damaged by registration of the mark NETPAY by Applicant Netpay Payroll, Inc. ("Applicant") for "Accounting services; Administrative accounting; Employee administration services; Employee relations information services; Human resources consultancy; Insurance lead collection and matching services, namely, matching consumer requests for insurance policy quotes collected over the internet to pre-qualified insurance brokers, agents and agencies interested in those requests; Promotion of financial and insurance services, on behalf of third parties" in International Class 35 as shown in Application Serial No. 85/241,921, and hereby opposes same on the following grounds:

1. Netpay Plus+ is a California S corporation with a principal place of business at Suite 208, 2600 Foothill Boulevard, Glendale, California 91214-4579.
2. Netpay Plus+ is a professional employer organization that is now and for many years has been engaged in the business of marketing and providing a variety of employment and human

resources services, including without limitation, employee leasing, human resources management outsourcing, employee administration services, employee health and benefits administration, workers' compensation administration, payroll and tax services, accounting, bookkeeping services, and collection of third party quotations and evaluation of quotes – including without limitation for health (medical, dental, vision) insurance, general liability insurance, life insurance, errors and omission policies, and workers' compensation insurance – provided by vendors for recommendation to clients (the "Netpay Plus+ Services"). Netpay Plus+ conducts business throughout the State of California and other states.

3. Netpay Plus+ is the owner of common law rights in the NETPAY and NETPAY PLUS+ service marks (collectively, the "NETPAY Marks") in connection with the Netpay Plus+ Services.

4. Netpay Plus+'s rights in the NETPAY Marks predate and are superior to any priority date that may properly be asserted by Applicant with respect to the subject intent-to-use application.

5. Netpay Plus+, including its related companies and predecessors-in-interest, has used the NETPAY Marks in the United States at least as early as 1996, long prior to the February 14, 2011 filing date of the subject intent-to-use application.

6. For sixteen years, Netpay Plus+, including its related companies and predecessors-in-interest, continuously has used and currently is using the NETPAY Marks in the United States in connection with providing, selling, advertising, and promoting the Netpay Plus+ Services.

7. Netpay Plus+ has exercised great care, skill, and diligence in providing high quality employment and human resources services, and other related services in connection with its NETPAY Marks.

8. Netpay Plus+ has expended considerable time, effort, and resources, to develop, advertise, market, sell and otherwise promote its services under its NETPAY Marks over many years. As a result, Netpay Plus+ has developed substantial consumer recognition and valuable goodwill in its NETPAY Marks, and consumers have come to recognize the services offered in connection with the NETPAY Marks as originating only with Opposer, and its related companies and predecessors in interest.

9. On information and belief, Applicant is a California limited liability company with a principal place of business at Suite 601, 367 Van Ness Way, Torrance, California 91803.

10. On February 14, 2011, Applicant filed the intent-to-use application at issue herein, Serial No. 85/241,921, seeking to register the mark NETPAY for "Accounting services; Administrative accounting; Employee administration services; Employee relations information services; Human resources consultancy; Insurance lead collection and matching services, namely, matching consumer requests for insurance policy quotes collected over the internet to pre-qualified insurance brokers, agents and agencies interested in those requests; Promotion of financial and insurance services, on behalf of third parties" in International Class 35 ("Applicant's Mark").

11. The services identified in the subject application are the same as or closely related to the Netpay Plus+ Services provided by Opposer under its NETPAY Marks.

12. Applicant's Mark so resembles Opposer's NETPAY Marks and trade name as to be likely, when applied to Applicant's services, to cause confusion or mistake or to deceive as to source, affiliation, connection, or association with, or approval, endorsement, or sponsorship by, Netpay Plus+. As such, Applicant's Mark is not entitled to registration pursuant to 15 U.S.C. § 1052(d).

13. For the foregoing reasons, Netpay Plus+ believes it will be damaged by the registration of the mark NETPAY shown in Application Serial No. 85/241,921 for the services identified therein.

14. Netpay Plus+ requested and received extensions of time to oppose, to and including July 22, 2012.

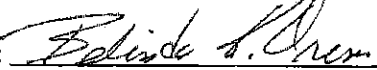
15. This Opposition is timely filed and accompanied with a filing fee of \$300.00.

16. WHEREFORE, Netpay Plus+ requests that the registration sought by Applicant be refused, that the Notice of Opposition be sustained, and that the Trademark Trial and Appeal Board grant such other relief as it deems just and proper.

Dated: July 20, 2012

Respectfully submitted,

PAUL HASTINGS LLP


By: 

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CERTIFICATE OF SERVICE

I hereby certify that on July 20, 2012, a true and complete copy of the foregoing **NOTICE OF OPPOSITION** has been served on Applicant by mailing said copy, via U.S. Mail to:

J. Curtis Edmondson
J. Curtis Edmondson Attorney at Law
15490 NW Oak Hills Dr.
Beaverton OR 97006
Phone Number: (503) 336-3749


Edith R. Lopez