



TTAB3

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451
www.uspto.gov

Re: Trademark Application of :
Rock Revolution Clothing :
Serial No. 78/703298 :
Filing Date: August 30, 2005 : On Petition
Mark: ROCK REVOLUTION :
Petition Filed: December 14, 2006 :

Boulevard Liquidation, Inc., d.b.a. Rock Revolution (petitioner), has petitioned the Director to direct the Trademark Trial and Appeal Board (TTAB) to accept a notice of opposition to the registration of the above-identified mark as timely filed. Trademark Rules 2.146(a)(3) and 2.146(a)(5), 37 C.F.R. §§2.146(a)(3)(5), provide authority for the requested review. The petition is denied.

FACTS

The above-mentioned application was published for opposition in the *Official Gazette* on October 17, 2006. Petitioner states that it attempted to file a notice of opposition using the Electronic System for Trademark Trials and Appeals (ESTTA) on November 15, 2006, the 29th day of the opposition period. Petitioner asserts that the attempted filing was blocked because ESTTA “denied recognition of west coast normal business hours.”

Petitioner states further that it mailed the notice of opposition to the TTAB via the United States Postal Service (USPS) because it was unable to complete the filing through ESTTA. Petitioner asserts, however, that “a certificate of mailing was inadvertently left out of the package.” The following day, petitioner states that it sent an e-mail to the Office, “attesting to the mailing by electronic signature” and attaching a copy of the opposition papers. The TTAB received the notice of opposition sent via the USPS on November 21, 2006. On November 28, 2006, the TTAB notified petitioner that the notice of opposition was untimely because the opposition period had expired on November 16, 2006. This petition was filed on December 14, 2006.

Petitioner argues that an extraordinary situation exists because (1) “[o]pposition guidelines do not provide adequate notice that electronic filings of oppositions must be done according to east coast time;” (2) “this vital information is not easily accessible, resulting in unreasonable expectations on the part of west coast users of the site;” and (3) the blocking of the filing was an “unforeseeable circumstance which caused unintentional delay.” Petitioner also asserts that parties commonly use the opposition period to conduct negotiations and that a reasonable accommodation should be made available.

Petitioner argues further that its filing was in compliance with 37 C.F.R. §§2.101 and 2.197, because the package was postmarked within the opposition period and the certificate of

mailing was submitted via e-mail on the 30th day of the opposition period, and should, therefore, be accepted as timely. Finally, petitioner contends that “[t]he omission of the certificate of mailing until the following day could not have been reasonably avoided despite our exercise of reasonable care.”

ANALYSIS

Section 13 of the Trademark Act, 15 U.S.C. §1063, provides that a party who believes he would be damaged by the registration of a mark may file a notice of opposition within thirty days after the date of publication of the mark. The time period for filing an opposition or requesting an extension of time to oppose is prescribed by statute, and the Director has no authority to waive this requirement. *In re Kabushiki Kaisha Hitachi Seisakusho*, 33 USPQ2d 1477 (Comm'r Pats. 1994); *In re Cooper*, 209 USPQ 670 (Comm'r Pats. 1980); see also 15 U.S.C. §1063; *Trademark Trial and Appeal Board Manual of Procedure* (TBMP) §306 *et seq.* In this case, a notice of opposition (or extension of time to oppose) would have been timely if received any time before midnight on November 16, 2006.

An opposition to an application based on §1 or §44 of the Trademark Act must be filed either on paper or through ESTTA. 37 C.F.R. §2.101(a)(2). The filing date of an opposition is the date of receipt in the Office of the opposition together with the required fee. 37 C.F.R. §2.101(d)(4). Oppositions transmitted electronically through ESTTA are stamped with the date and time the payment process is completed. The TBMP explicitly states that “Eastern time controls the filing date.” TBMP §109.

The following warnings are also prominently displayed on the opening page of the ESTTA website:

PLAN AHEAD. Because unexpected problems can occur, you should keep filing deadlines in mind and allow plenty of time to resolve any issue which might arise. The Board will provide general assistance to ESTTA filers (see contact information below), but we cannot guarantee that any problem will be resolved prior to a deadline. Except when filing extensions of time to oppose or oppositions to Madrid Protocol applications (see below), ESTTA filing is optional. If ESTTA filing is not possible prior to a deadline for any reason, parties should submit their filings in paper.

Filing Date. Eastern Time controls the filing date. ESTTA filings are time-stamped with the official filing date when the ESTTA filing, including any required fee is received on the USPTO server. The time the transmission began is not a factor we consider when we assign the filing date. The official filing date and time can be found on the confirmation web screen and in your e-mail confirmation.

Both the TBMP and the warnings on the ESTTA website put petitioner on notice regarding the filing date constraints related to Eastern Standard Time (EST). If petitioner ignored the warnings when it entered the ESTTA website, it did so at its peril. Therefore, petitioner’s assertions that it did not have adequate notice regarding this issue and that the information was not easily accessible are without merit. Moreover, petitioner has not asserted that the system was not functioning properly and nothing in ESTTA would have prevented a filing on November 15th (or until 11:59 p.m. EST on November 16th) because of timeliness.¹

¹ A review of the ESTTA server logs revealed that the system was successfully used from late on the day of November 15, 2006 and throughout November 16, 2006.

Regarding petitioner's claim that ESTTA "denied recognition of west coast normal business hours," it is noted that ESTTA permits West Coast filers seeking a certain filing date to transmit the e-document until just before 9 p.m. Pacific Standard Time (PST),² well after normal business hours. The Trademark Rules of Practice (37 C.F.R. § 2.195(a)(2)) state that "correspondence transmitted electronically will be given a filing date as of the date on which the Office receives the transmission," and documents may be filed electronically 24 hours a day, every day of the year. When filing from the West Coast, an e-document must be filed prior to 9 p.m. PST to be received before 12 a.m. EST, and therefore be deemed to have been filed with the USPTO on that day. Given that the USPTO receives e-filings from all over the world, it is not practicable to consider an e-document filed at a time other than the time of receipt of the transmission at the USPTO. Moreover, West Coast filers who wish to submit a Notice of Opposition at 9 p.m. PST or later to meet a filing deadline have the option of submitting a paper document and ensuring a timely filing by using the certificate of mailing procedure, which is discussed in greater detail below. Also, filers may ensure a timely filing of a Notice of Opposition by using the Express Mail service of the USPS and following the procedure set forth in Trademark Rule 2.198 (37 C.F.R. § 2.198).

Petitioner has argued that attorneys submit filings close to the due date because they are engaged in negotiations, or as a means of protecting a client's interests, and that a reasonable accommodation should be available in light of this reality. If petitioner was engaged in negotiations with the applicant in this case, petitioner could have filed a request for an extension of time to oppose at any time prior to the expiration of the 30-day period after publication of the mark. 37 C.F.R. §2.102; TBMP §202.01. A first request for a 30-day extension is granted upon request. Petitioner could subsequently have filed a request for an additional 60-day extension, which is granted only for good cause shown. Had petitioner requested and received extensions totaling 90 days, petitioner could have filed one final request for an additional 60 days. These extensions would have given petitioner additional time to conduct the negotiations or to conclude that the filing of an opposition was necessary.

Under 37 C.F.R. §2.197(a)(1)(i), correspondence required to be filed within a set period of time is considered timely, even if received by the Office after the expiration of the set period, if, prior to the expiration of the set period, (1) the correspondence is mailed to the Office by first-class mail, to the address set forth in 37 C.F.R. §2.190(a), and (2) a proper certificate of mailing is placed on the correspondence prior to mailing. TBMP §110.01; *Trademark Manual of Examining Procedure* (TMEP) §305.02 *et seq.* The requirements of 37 C.F.R. §2.197 are strictly enforced, and the Office denies petitions to consider a document timely filed as of the date on the certificate if a party fails to comply with these requirements. TMEP §305.02(h). In this case, the certificate of mailing clearly does not meet the requirements of 37 C.F.R. §2.197(a)(1)(i) because it was not placed on the correspondence prior to mailing. This requirement is explicit. Moreover, Trademark Rule 2.197 neither allows nor contemplates the use of an e-mailed certificate, sent separately from the original correspondence, as proof of timely filing. See 37 C.F.R. 2.197 (a)(1)(ii) (stating that the document must include the certificate of mailing).

Trademark Rules 2.146(a)(5) and 2.148 permit the Director to waive any provision of the Rules that is not a provision of the statute, where an extraordinary situation exists, justice requires and no other party is injured thereby. All three of these conditions must be satisfied before a waiver will be granted. However, an inadvertent omission is not considered an extraordinary situation that would

² During the period of the year in which daylight saving time is in effect, West Coast filers may transmit documents until just before 9 p.m. Pacific Daylight Time (PDT) to ensure that the transmission is received at the USPTO before 12 a.m. Eastern Daylight Time (EDT).

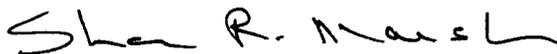
warrant waiver of a rule under 37 C.F.R. §2.146(a)(5) or §2.148. *In re Buckhead Marketing & Distribution, Inc.*, 71 USPQ2d 1620 (Dir USPTO 2004); *In re Merck & Co. Inc.*, 24 USPQ2d 1317 (Comm'r Pats. 1992); *B and E Sales Co. Inc. v. Andrew Jergens Co.*, 7 USPQ2d 1906 (Comm'r Pats. 1988); *Gustafson v. Strange*, 227 USPQ 174 (Comm'r Pats. 1985). See TMEP §1708 and cases cited therein.

Here, petitioner first states that “the certificate of mailing was inadvertently left out of the package” and then appears to contradict that statement by asserting that “omission of the certificate of mailing until the following day could not have been reasonably avoided despite our exercise of reasonable care.” As noted above, an inadvertent omission is not an extraordinary situation that would warrant waiver of a rule. The TMEP provides that a party’s inadvertent failure to strictly comply with certificate of mailing requirements does not constitute an extraordinary situation. TMEP §305.02(h). Furthermore, there is no basis for petitioner’s assertion that omission of the certificate could not have been avoided. Had petitioner exercised reasonable care, petitioner could have ensured that a proper certificate of mailing was placed on the opposition papers, in accordance with Trademark Rule 2.197, prior to depositing them with the USPS.

DECISION

As petitioner has not established that the failure to comply with the requirements of 37 C.F.R. §2.197 was the result of an extraordinary situation, the petition is denied. The application will be forwarded to the Publication and Issue section for issuance of a registration.

Petitioner is not without a remedy. When the mark in question registers, petitioner may file a petition to cancel the registration under 15 U.S.C. §1064.



Sharon R. Marsh
Deputy Commissioner for
Trademark Examination Policy

SRM:CPC

Date: APR 30, 2007
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