

THIS ORDER IS A  
PRECEDENT OF THE TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451  
General Contact Number: 571-272-8500

Butler

Mailed: March 8, 2017

Applicant: Coyle, Brian  
Serial No.: 87086860  
Filed: 6/28/2016  
Mark: SODA CITY FIRE DEPT.

Potential Opposer: DFC EXPO LLC

**By the Trademark Trial and Appeal Board:**

On December 20, 2016, DFC Expo LLC (“Potential Opposer”) filed via ESTTA a “First 30 Day Request for Extension of Time to Oppose” against Application Serial No. 87086860. This request was granted on the same date; and Potential Opposer’s filing deadline was extended until February 4, 2017. Because that date was a Saturday, a notice of opposition, or further extension of time to file a notice of opposition, would be considered timely if filed by Monday, February 6, 2017. Trademark Rule 2.196, 37 C.F.R. § 2.196.

Potential Opposer filed a notice of opposition in paper form with a cover letter, but without a Petition to the Director, dated February 6, 2017, stating in pertinent part:

Today was the last day that I could file a Notice of Opposition to registration of Serial No. 87086860, due to the extension of time that I filed earlier.

I went on the ESTTA website, and tried five different times to file the Notice of Opposition; however, the website would not provide me access to make payment for the Notice of Opposition. I have filed dozens of

actions through ESTTA before, and I have never had this problem before.

I spoke to someone from the TTAB, and was told that I could mail the pleading, so please find it attached. I am actually out of town now and travelling to a court hearing tomorrow, so I do not have any extra business checks with me. I will contact the TTAB this Wednesday when I get back in town, and make payment at that time.

The notice of opposition in paper form was received by the USPTO on February 9, 2017, as documented by the USPTO Mail Receipt stamp, a copy of which is shown below:



The paper filing is not acceptable for three separate reasons. First, it is not timely, inasmuch as it was received after the deadline and was not accompanied by a certificate of mailing. Second, it was not accompanied by the required fee. Both of these are longstanding requirements for a notice of opposition. *See, e.g.*, 15 U.S.C. § 1063, 37 C.F.R. § 2.102(a); TBMP § 302 (June 2016) (“An opposition proceeding is commenced by the timely filing of a notice of opposition, together with the required fee, in the USPTO.”).<sup>1</sup> Third, the paper submission was not filed with a Petition to the Director, as required by the TTAB amended rules of practice, which became effective January 14, 2017.

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<sup>1</sup> A copy of the June 2016 TBMP is available at the TTAB home page, [www.uspto.gov](http://www.uspto.gov), under Archives.

In regard to timeliness, because the filing was not accompanied by a certificate of mailing, the date of receipt is considered the effective date of filing, not the date on the cover letter or notice of opposition. Trademark Rule 2.195(a), 37 C.F.R. § 2.195(a) (“Trademark correspondence received in the Office is given a filing date as of the date of receipt ...”). Trademark Rule 2.197(a), 37 C.F.R. § 2.197(a), copied in relevant part below, sets forth the procedure whereby correspondence will be considered timely filed on the date deposited with the U.S. Postal Service.

[C]orrespondence required to be filed in the Office within a set period of time will be considered as being timely filed if the procedure described in this section is followed. The actual date of receipt will be used for all other purposes. ... (ii) The correspondence includes a certificate for each piece of correspondence stating the date of deposit or transmission. The person signing the certificate should have a reasonable basis to expect that the correspondence would be mailed or transmitted on or before the date indicated.

As stated, if the procedure is not followed, the date of receipt in the USPTO is considered the filing date. As further explained in TBMP § 109 (Jan. 2017):

When correspondence intended for the Board is filed by first-class mail with a certificate of mailing, in accordance with the procedure described in 37 C.F.R. § 2.197(a), it is stamped with the date of receipt of the correspondence in the Office. The mailing date specified in the certificate of mailing is used for purposes of determining the timeliness of the correspondence.

*See also* TBMP §§ 306.01, 306.04.

In accordance with the applicable rules and the USPTO receipt label, the notice of opposition, had the fee therefor been paid, could only have been considered filed on February 9, 2017, which was three days after the previously extended period expired. For this reason, the notice of opposition is untimely and cannot be considered. *See*

Section 13 of the Trademark Act, 15 U.S.C. § 1063, and Trademark Rule 2.101(c), 37 C.F.R. § 2.101(c). The fact that the filing is untimely alone is a basis for not instituting an opposition proceeding. Trademark Rule 2.101(a), 37 C.F.R. § 2.101(a). In the case at hand, the failure to pay the fee provides another basis.

With respect to the fee, Potential Opposer indicates that the ESTTA electronic filing application would not provide access to the screen used for making the fee payment for the notice of opposition. As discussed below, it appears Potential Opposer attempted to upload a Microsoft Word document. However, ESTTA accepts only a PDF, text or TIFF document as an upload, as explained on the ESTTA landing page under “Click Here for ESTTA Technical Requirements.” *See also* TBMP § 110.02(b). Thus, it does not appear that Potential Opposer’s inability to complete the process of filing by ESTTA when first attempted was due to unavailability of the system, or any technical problem at the USPTO. Potential Opposer may have been successful in accessing the payment screen had it used the correct format for the accompanying upload.

Potential Opposer chose to submit the notice of opposition in paper form. However, the paper filing was not accompanied by the required fee. Potential Opposer recognized this deficiency in its cover letter. Trademark Rule 2.101(a), 37 C.F.R. § 2.101(a), provides that “[a]n opposition proceeding is commenced by filing in the Office a timely notice of opposition with the required fee.” *See also* 15 U.S.C. § 1063 (setting forth the time within which an opposition must be filed and the requirement that the fee be paid). In the rare instances a submission requiring a fee

is filed by mail, a fee may be paid by check, money order, credit card (using the credit card payment form) or a USPTO deposit account. See “Methods of Payment,” available at <https://www.uspto.gov/trademark/view-fee-schedule-trademark-fee-information>.

Inasmuch as the opposition was not accompanied by the required fee, the notice of opposition cannot be given consideration. A filer’s failure to include the required fee, alone, is a basis for not instituting an opposition proceeding. *Vibe Records Inc. v. Vibe Media Group LLC*, 88 USPQ2d 1280 (TTAB 2008) (fee did not accompany notice of opposition, opposition dismissed as a nullity). See also TBMP § 308.01(a) (“The required fee must be submitted with the opposition; the filing date of an opposition (and, hence, the date of commencement of the opposition proceeding) is the date of electronic receipt in the Office of ... the opposition with the required fee.”).

Importantly, the deadline and payment requirements are statutory and cannot be waived by the Office. See Trademark Act Section 13, 15 U.S.C. § 1063:

Any person who believes that he would be damaged by the registration of a mark upon the principal register, including the registration of any mark which would be likely to cause dilution by blurring or dilution by tarnishment under section 1125(c) of this title, may, *upon payment of the prescribed fee*, file an opposition in the Patent and Trademark Office, stating the grounds therefor, *within thirty days after the publication* [or within a granted extension period] under subsection (a) of section 1062 of this title of the mark sought to be registered. (Emphasis added.)

Finally, the filing is unacceptable under the recent amendments to the TTAB rules of practice that went into effect on January 14, 2017. On October 7, 2016, the Board published its NOTICE OF FINAL RULEMAKING at 81 Fed. Reg. 69950, thereby providing the public three months advance notice of these changes to the rules of

practice. The NOTICE alerted the public that Trademark Rule 2.126, 37 C.F.R. § 2.126, was being amended to state affirmatively that filing via ESTTA is mandatory for all filings and that a Petition to the Director is required for certain submissions filed in paper form, including a notice of opposition.<sup>2</sup> Regarding the filing of notices of opposition in particular, Trademark Rule 2.101(b), 37 C.F.R. § 2.101(b), provides in pertinent part:

(1) An opposition to an application must be filed by the due date set forth in paragraph (c) of this section through ESTTA.

(2) In the event that ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, an opposition against an application based on Section 1 or 44 of the Act may be filed in paper form. A paper opposition to an application based on Section 1 or 44 of the Act must be filed by the due date set forth in paragraph (c) of this section and be accompanied by a Petition to the Director under § 2.146, with the fees therefor and the showing required under this paragraph. Timeliness of the paper submission will be determined in accordance with §§ 2.195 through 2.198.

The Potential Opposer did not file a Petition to the Director with its notice of opposition in paper form. A Petition to the Director requires a petition fee, the necessary showing, and verification of statements supporting the petition. Although Potential Opposer included an explanation in the cover letter, the explanation cannot be considered because it is not a petition. However, even were the Board to consider Potential Opposer's explanation, as mentioned earlier, no evidence was included and the reasons stated for filing in paper do not set forth with sufficient clarity that

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<sup>2</sup> To be clear, the timely filing of a notice of opposition and payment of the appropriate fee have been longstanding requirements, whether filed in paper or electronically via ESTTA. On those bases alone, Potential Opposer's filing is unacceptable. A Petition to the Director for certain paper filings with the TTAB is an additional requirement as of January 14, 2017.

ESTTA was unavailable due to technical problems or that extraordinary circumstances were present.<sup>3</sup> In addition, the facts are not verified. Petitions to the Director seeking to file on paper are subject to Trademark Rule 2.146, 37 C.F.R. § 2.146, including the requirement for verified facts. Trademark Rule 2.146(c) provides in pertinent part:

When facts are to be proved on petition, the petitioner must submit proof in the form of verified statements signed by someone with firsthand knowledge of the facts to be proved, and any exhibits.

A verified statement is defined in Trademark Rule 2.2(n), 37 C.F.R. § 2.2(n):

The term *verified statement*, and the terms *verify*, *verified*, or *verification* as used in this part refers to a statement that is sworn to, made under oath or in an affidavit, or supported by a declaration under § 2.20 or 28 U.S.C. 1746, and signed in accordance with the requirements of § 2.193.

“Paper filings not accompanied by the requisite petition will not be considered.” 81 Fed. Reg. 69966.

In order to ascertain whether ESTTA was unavailable, the Board looked to information from USPTO systems reflecting ESTTA activity for application Serial No. 87086860 on February 6, 2017. Information from the systems reflects that Potential Opposer attempted to upload a Microsoft Word document at 1:45 p.m. Eastern Time, but the attempt was not completed. ESTTA subsequently was unavailable due to technical problems from approximately 2:11 p.m. to 4 p.m. Eastern Time. After 4 p.m., when ESTTA became available, USPTO systems reflect no further activity with respect to the application.

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<sup>3</sup> When a filer is prevented from online filing due to technical difficulties with ESTTA, the petition fee still must be provided. The filer may concurrently request that the fee be waived and reimbursed.

In sum, Potential Opposer's submission of the notice of opposition in paper form is not acceptable because it was not timely-filed, it was not accompanied by the requisite fee, and it was not accompanied by a Petition to the Director. The remedy for Potential Opposer lies in filing a petition to cancel once a registration issues. *Vibe Records Inc.*, 88 USPQ2d at 1283 n.4.

As a reminder, ESTTA users are strongly urged to plan ahead. TBMP § 110.01(b). Brief outages of ESTTA, as with any computerized system, occur from time to time without prior notice.<sup>4</sup> In this instance, it appears that proper utilization of the ESTTA system prior to 2 p.m. or after 4 p.m. Eastern Time on February 6 could have resulted in successful filing of the notice of opposition. Because unexpected problems can occur, users should keep filing deadlines in mind and allow plenty of time to resolve any issue which may arise. In addition, when the press of business or other circumstances result in counsel, or a pro se party, being away from a home or office where resources for alternative filings may not be available, an extension of time to oppose may be obtained prior to departure in order to secure additional time to file an opposition after travel has been completed. In the case at hand, Potential Opposer, upon a showing of good cause, and payment of the fee therefor, could have obtained a

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<sup>4</sup> A user may check system status and planned outages from the TTAB homepage at [www.uspto.gov](http://www.uspto.gov). Instructions for filing documents with the TTAB during an outage are also available. Such instructions provide useful information pertinent to filing in paper.



further 60-day extension of the period for filing an opposition and completed the filing of an opposition after counsel's travel had been concluded.<sup>5</sup>

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<sup>5</sup> The opposition period may be extended for 30 days with no fee, as it was in this case, and, upon a showing of good cause, for an additional 60 days for a \$100 fee if filed electronically through ESTTA. 37 C.F.R. §§ 2.102(c)(2) and 2.6(a)(22).