

This Opinion Is Citable
as Precedent of the
TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

wellington

Mailed: February 3, 2005

Opposition No. 91162329

PPG Industries, Inc.

v.

Guardian Industries Corp.

Before Sams, Walters, and Rogers,
Administrative Trademark Judges.
By the Board:

On September 29, 2004, opposer filed its notice of opposition to registration of applicant's proposed mark in application Serial No. 78249956.¹ The notice of opposition was filed electronically via the Board's Electronic System for Trademark Trials and Appeals (ESTTA).² It consists of the completed ESTTA notice of opposition form and an attachment also entitled "notice of opposition," which details the relevant facts and grounds for the notice of opposition. The ESTTA form contains opposer's electronic signature, although the attachment contains no signature, electronic or otherwise.

¹ The application was filed on May 14, 2003 based on an intent to use the mark, ULTRAWHITE, in commerce on goods in International Classes 19, 20, and 21. The application was published for opposition in the Trademark Official Gazette on September 28, 2004.

² ESTTA is available at the USPTO's website (www.uspto.gov) and permits the electronic filing of all papers in proceedings before the TTAB, excluding confidential documents.

In lieu of an answer, applicant filed a motion (filed November 9, 2004) to dismiss for "failure to file a timely notice of opposition." The parties have briefed the motion.

In support of its motion, applicant argues that opposer's notice of opposition is "unsigned and therefore defective, and this defect was not cured during the time for filing a notice of opposition." Applicant observes that the notice of opposition was electronically filed and that the ESTTA filing form contains an electronic signature. Applicant argues, however, that the ESTTA filing form is merely a "transmittal," not the notice of opposition itself, and the electronic signature thereon is "insufficient to meet the [signature] requirements."

Applicant also makes reference to instructions on the USPTO website regarding the electronic signature which state as follows:³

Signature of Electronically-Filed Papers

All papers submitted to the Board must be signed by the party on whose behalf the paper is filed, or by that party's attorney. Electronically-filed papers filed as ESTTA attachments may be signed (1) by signing the paper in pen, then scanning the paper for attachment and transmission or (2) by placing on the paper where it would normally be signed a symbol comprised of numbers and/or letters between two forward slashes.

Applicant construes these instructions as "reiterat[ing] the requirements for the signature of pleadings" and argues that opposer's attachment to the ESTTA filing form, which is

³ The instructions appear on an "ESTTA Help Page" on the USPTO website, www.uspto.gov.

captioned as "Notice of Opposition", is required to have an electronic signature independently of the electronic signature on the ESTTA filing form.

Finally, applicant argues that the signature "defect" was not corrected prior to the termination of the opposition period and Section 13(a) of the Trademark Act requires the Board to reject the notice of opposition as late-filed.

In its opposition to the motion, opposer argues that the ESTTA filing form is "not a mere transmittal but is rather a pleading that contains several items of necessary, substantive information required to fulfill the criteria for filing an opposition." Opposer states that the ESTTA filing form is not only titled as "Notice of Opposition" but "does in fact constitute the notice of opposition" and contains opposer's electronic signature. Opposer acknowledges that the ESTTA filing form "included an attachment setting forth eight numbered paragraphs constituting the specific grounds for opposition" and "[a]n unsigned version of this attachment was inadvertently scanned and attached when the ESTTA document was submitted."

Finally, opposer argues that applicant incorrectly concludes that an unsigned notice of opposition filed during the opposition period constitutes an untimely notice of opposition. Instead, opposer states that Trademark Rule 2.106 provides that an unsigned paper will not be refused

consideration if the filing party submits a signed copy within a time period set forth by the Board in a notification of the lack of signature. And opposer requests that "if the Board now determines that an additional signature on opposer's attachment, beyond the proper signature set forth on the ESTTA notice of opposition is required, the signed version of applicant's attachment submitted herewith and served upon applicant, should be considered by the Board, notwithstanding the expiration of the opposition period."

Applicant's motion presents the Board with the question of whether an electronic signature on an ESTTA filing form is a signature also of the attachments submitted therewith. As explained in this order, the Board views the electronic signature on the ESTTA filing form as pertaining to all attachments thereto. Because the ability to file documents through ESTTA is relatively new and as yet unfamiliar to many practitioners before the Board, clarification of the Board's signature requirement for ESTTA-filed papers is in order.

Initially, we note that regardless of whether a paper is filed through ESTTA or by mail, Trademark Rule 2.119(e) is applicable and requires every paper in an *inter partes* proceeding to be signed by the party filing it, or by the party's attorney or any other authorized representative. The rule further provides that "an unsigned paper will not be refused consideration if a signed copy is submitted to the

Patent and Trademark Office within the time limit set in the notification of this defect by the Office."

Trademark Rule 2.193(c)(1)(iii) provides that where an electronically transmitted trademark filing is permitted or required, the person who signs the filing must either:

- (A) Place a symbol comprised of numbers and/or letters between two forward slash marks in the signature block on the electronic submission; or
- (B) Sign the verified statement using some other form of electronic signature specified by the Director.

Thus, when a paper is filed via ESTTA, it must be signed in conformance with Rule 2.193(c)(1)(iii). As a practical matter, ESTTA will allow the filing party to complete the submission process only after the required electronic signature has been entered.

For every submission filed via ESTTA, a filing form is generated. Depending on the type of filing, the filing form either stands alone and serves as the paper being filed, e.g., requests for extensions of time to file a notice of opposition, or the filing form and the attachment thereto are considered a single, integrated filing, e.g., notice of opposition. In the latter case, the entire paper being filed consists of the ESTTA filing form page(s) and the attached document.

All ESTTA filing forms contain information identifying the filing date for the submission, the proceeding number, the filing party's name, a description of the actual

submission, and the actual filer's name and electronic signature. If there is an attachment, the filing form will also identify the file name for the attachment. When a notice of opposition is filed via ESTTA, additional information, some substantive, is included on the ESTTA filing form, namely, it is captioned "Notice of Opposition" and has the address of opposer and its counsel; opposer's entity type and citizenship; name of applicant; the opposed application's serial number and publication date; the date of expiration for the opposition period; and the goods and/or services which are affected by the notice of opposition. The electronic signature, name of signer and signature date are located at the end of the filing form.

Since ESTTA's inception, the Board has viewed the ESTTA filing form and any attachments thereto as comprising a single document or paper being filed with the Board. Because an ESTTA filing with attachments is considered to be a single submission, the electronic signature on the ESTTA filing form pertains to any attachments, whether or not the attachments are separately signed by the individual signing the ESTTA form.⁴ In this regard, we note that the signer of the ESTTA form is responsible for the content of the attachments, for

⁴ The electronic signature of one person obviously may not serve as a signature for attachments that should properly be signed by another person. For example, if an unsigned affidavit is filed as an attachment to the ESTTA filing form, the electronic signature of a person other than the affiant on the ESTTA filing form cannot serve for signature purposes as attesting to the truth of the statements in the affidavit.

purposes of applicable provisions of Patent and Trademark Rules, such as Patent and Trademark Rule 10.18, and for purposes of other applicable rules or laws, for example, Rule 11 of the Federal Rules of Civil Procedure.

Accordingly, in the matter at hand, applicant's motion to dismiss is denied because opposer's electronic signature on the ESTTA filing form for the notice of opposition serves as the signature for the entire document being filed, including the attachment which is also captioned "notice of opposition," and opposer's notice of opposition was timely filed.⁵

Proceedings are resumed. **Applicant is allowed thirty (30) days from the mailing date on this order to file an answer to the notice of opposition.**

The testimony periods, including the close of discovery, remain as set forth in the Board's September 30, 2004 institution order.

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⁵ The Board acknowledges applicant's reference to the USPTO website instructions regarding electronic signatures. While, as explained herein, the Board does not agree with applicant's conclusion that these instructions "reiterate" a separate signature requirement for attachments, we find these instructions to be a potential source of confusion. Accordingly, in due course, the Office will amend the instructions to better reflect the Board policy explained in this decision.