

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

coggins

Mailed: March 19, 2009

Opposition No. 91188933

Veronica Infelice

77/585,269

v.

Wal-Mart Stores, Inc.

Before Bucher, Kuhlke, and Bergsman,
Administrative Trademark Judges.

This case now comes up on opposer's motion (filed February 21, 2009) to amend the notice of opposition.¹ By way of the motion, opposer alerts the Board that the notice of opposition was filed as a consolidated opposition against application Serial Nos. 77585269 and 77585270.

Consolidated Opposition

On February 19, 2009, two days prior to the close of the opposition period as extended, opposer filed, via the Board's Electronic System for Trademark Trials and Appeals (ESTTA) a consolidated notice of opposition against

¹ Opposer's change of correspondence address (filed February 24, 2009) is noted and entered.



05-11-2009

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involved application Serial Nos. 77585269 and 77585270.²

Opposer paid the appropriate fee for opposing both applications. However, the Board's February 20, 2009 order instituting this proceeding identified only application Serial No. 77585269 as the subject of the opposition, and inadvertently failed to identify application Serial No. 77585270 as also being a subject of the opposition.

Normally, the Board would issue a corrective order resetting applicant's time to answer and acknowledging that both applications were the subject of this opposition; however, for the reasons discussed below, such an order will not issue as this opposition will be dismissed as a nullity.

Service Requirement

On March 17 and 18, 2009, opposer telephoned the Board to determine the status of her motion to amend. During the course of the telephone calls, the Board discovered that opposer did not send a service copy of the notice of opposition to applicant.

As mentioned above, on February 19, 2009, opposer filed, via ESTTA, a notice of opposition against involved

² Opposer's December 24, 2008 requests for an extension of time to oppose the involved applications were granted until February 21, 2009.

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application Serial Nos. 77585269 and 77585270. When she filed the opposition, opposer checked the applicable box on the ESTTA form to indicate that she had effected service on applicant, absent which ESTTA would not have allowed opposer to complete the electronic filing process that resulted in institution of this proceeding. However, opposer stated in her March 17 and 18, 2009 telephone calls to the Board that she did not, in fact, comply with the service requirements set forth in Trademark Rules 2.101(a), 2.101(b), and 2.101(d)(4), in that she did not serve a copy of the notice of opposition on applicant.

On February 21, 2009, on the last day of the opposition period, as extended, opposer filed a motion to amend her notice of opposition. The motion to amend fails to include proof of service of a copy of same upon applicant. Although the motion to amend the notice of opposition could be considered as opposer's substitute notice of opposition because it was filed within the opposition period as extended, it, too, is fatally defective because it lacks proof of service as required by Trademark Rules 2.101(a), 2.101(b), and 2.101(d)(4).

Amended Trademark Rule 2.101(b), effective November 1, 2007, provides that a notice of opposition must be served on the attorney of record for the applicant or, if there is

no attorney, on the applicant at the correspondence address of record in the Office.³ Opposer has conceded that her February 19, 2009 filing did not comply with the service requirement for proceedings commenced on or after November 1, 2007. Thus, because the rules now require that the opposer serve the notice of opposition by forwarding a copy thereof to the applicant, and include proof of service on the applicant, opposer has failed to satisfy the service requirements in this case. See *Schott AG v. L'Wren Scott*, 88 USPQ2d 1862 (TTAB 2008).

Although opposer checked the applicable box on the ESTTA form to indicate that she had effected service on applicant when she filed the original notice of opposition

³ The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 Fed. Reg. 42242. By this notice, various rules governing Trademark Trial and Appeal Board inter partes proceedings were amended. Certain amendments had an effective date of August 31, 2007, while most had an effective date of November 1, 2007. Prior to November 1, 2007, an opposer was not required to serve its notice of opposition upon its adversary. Instead, until that effective date, the opposer was able, under Trademark Rule 2.104(a), to simply file its notice of opposition, and any exhibits thereto, in duplicate form with the Board; upon receipt, the Board would then forward the duplicate or service copy of the notice of opposition, and any exhibits thereto, directly to the applicant along with an order instituting proceedings.

The final rule and a chart summarizing the affected rules, their changes, and effective dates, are viewable on the USPTO website at these web addresses:

<http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf>

http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf.

on February 19, 2009, and the ESTTA form then automatically generated a proof of service statement, opposer has now stated that she did not, in fact, effect service on applicant but believed that the Board would effect service for her. In *Schott AG v. L'Wren Scott*, 88 USPQ2d at 1863 fn.3, the Board pointed out that "any plaintiff who files through ESTTA is viewed by the Board as having included proof of service with its pleading. **Actual forwarding of the service copy, however, is the responsibility of the filer, as the ESTTA system does not effect service for the filer.**" (Emphasis added.)

The proof of service requirement under Trademark Rule 2.120(a)

assumes actual service on applicant or its attorney. Proof of service is meaningless in the absence of actual service in accordance with the statements contained in the proof of service. ... In the instant case, as discussed above, the notice of opposition included proof of service, but there was no actual service on applicant. Thus, opposer did not comply with the service requirement of the rules. Accordingly, opposer's notice of opposition should not have received a filing date, and this proceeding should not have been instituted.

Springfield Inc. v. XD, 86 USPQ2d 1063, 1064 (TTAB 2008).

This failure to follow the amended Trademark Rules invalidates the filing of February 19, 2009 as well as the amended notice filed February 21, 2009.

Specifically, in contravention of the amended rules, opposer's February 21, 2009 amended notice of opposition failed to include proof of service on applicant. Because the rules now require that an opposer include a proof of service certificate with the notice of opposition, the February 21, 2009 amended notice does not meet the requirements for a complete notice of opposition and therefore cannot be the basis for instituting a proceeding against application Serial Nos. 77585269 and 77585270. See *Id.*

Because the opposition period has ended, opposer cannot correct her failure to serve applicant with a copy of the notice of opposition and to include proof of service thereon. See *The Equine Touch Foundation, Inc. v. Equinology, Inc.*, ___ USPQ2d ___ at fn. 6 (TTAB 2009), 2009 WL 625593 ("...if opposer's service of a notice of opposition ... occurs after the close of the opposition period, including any granted extensions, the filing date would fall outside the opposition period and the Board would refuse the opposition as untimely.").

Dismissed as Null

Accordingly, this opposition is dismissed as a nullity. Application Serial Nos. 77585269 and 77585270

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will proceed to registration, and opposer's filing fee will be refunded.⁴

⁴ Opposer is not without recourse, as she may file a petition to cancel if and when the marks in the involved applications register. See Section 14 of the Trademark Act, 15 U.S.C. § 1064.

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