

This Order 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

**In re: Börlind Gesellschaft
für kosmetische Erzeugnisse
mbH**

Bruce O. Bradford
Sara Lee Corporation
1000 E. Hanes Mill Road
Winston-Salem, NC 27105

Mailed: January 13, 2005

Serial No. 79000042

David Mermelstein, Interlocutory Attorney:

The above-referenced application was published for opposition on November 16, 2004. On December 20, 2004, under certificate of mailing dated December 16, 2004, Sara Lee Direct, LLC and Sara Lee Corporation (collectively referred to as "Sara Lee") filed a request for a ninety-day extension of time to oppose. By order dated December 29, 2004, the Board granted opposer's request. For the reasons set out below, the Board's December 29, 2004, order is VACATED, and Sara Lee's request for an extension of time to oppose is DENIED.

The subject application is a request for extension of protection filed pursuant to Trademark Act § 66(a), 15

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U.S.C. § 1141f(a).¹ Trademark Act § 66(a) and related provisions of the Trademark Act were enacted by Congress to implement the Madrid Protocol into U.S. law. See Madrid Protocol Implementation Act of 2002, Pub. Law 107-273, 116 Stat. 1758, 1913-1921 ("MPIA"). The Madrid Protocol is an international system permitting trademark applicants in member states to file for trademark protection in any other member state by filing an international application with the International Bureau of the World Intellectual Property Organization ("IB") and one or more requests to extend trademark protection to other member states.

Pursuant to the MPIA, the USPTO promulgated regulations governing practice under the Madrid Protocol. See Rules of Practice for Trademark-Related Filings Under the Madrid Protocol Implementation Act, 68 Fed. Reg. 55,747 (Sept. 26, 2003). The new regulations, effective November 2, 2003, included extensive changes to Trademark Rule 2.102, 37 C.F.R. § 2.102, which applies to extensions of time to file an opposition. Under the amended rule, "[a] written request to extend the time for filing an opposition to an application filed under section 66(a) of the Act must be filed through ESTTA."² Trademark Rule 2.102(a)(2)(emphasis

¹ Applications pursuant to Trademark Act § 66(a) can be distinguished in the Official Gazette by the identification of applicant as the owner of an international registration.

² ESTTA is the Electronic System for Trademark Trials and Appeals. Trademark Rule 2.2(g), 37 C.F.R. § 2.2(g). ESTTA, available at the USPTO's website (www.uspto.gov), permits the

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added). The new rule makes clear that the requirement for ESTTA filing is mandatory when the subject application is based on Trademark Act § 66(a). Compare Trademark Rule 2.102(a)(1) ("A written request to extend the time for filing an opposition to an application filed under section 1 or 44 of the Act must be filed either on paper or through ESTTA." (emphasis added)).

Sara Lee's December 20, 2004, request to extend time to oppose the subject application was not filed via ESTTA, but rather was sent by mail to the USPTO. Because the request to extend time to oppose was not filed via ESTTA, as required by Trademark Rule 2.102(a)(2), it must be denied.

While this may seem at first glance to be a harsh result, the requirement for mandatory ESTTA filing enables the Board to fulfill its obligations under the Madrid Protocol and the MPIA. Pursuant to the Madrid Protocol and the MPIA, when an opposition to registration is filed against a request for the extension of trademark protection, the USPTO must notify the IB of the opposition within seven months from the date the opposition period begins or within one month after the end of the opposition period, whichever is earlier. Trademark Act § 68(c)(2), 15 U.S.C.

electronic filing of all papers in proceedings before the Trademark Trial and Appeal Board (except confidential documents). As noted, ESTTA is mandatory for filing extensions of time to oppose (and notices of opposition) against § 66(a) applications. While optional for other papers, the Board encourages all filers to use ESTTA because it eliminates delays and errors associated with the delivery and handling of paper filings.

§ 1141h(c)(2).³ A failure to timely notify the IB of the filing of an opposition requires dismissal of the opposition and issuance of a registration to the applicant. Trademark Act § 68(c)(4).

Even under the best of circumstances, extension requests and notices of opposition filed by mail may take up to two or three weeks to be delivered and processed. And despite the USPTO's best efforts, papers filed with the Board by mail are subject to delays. Normally, a delay caused by a misdirected - or even lost - filing is regrettable, but of no procedural effect. However, because Trademark Act § 68(c)(2) requires timely notification of the filing of an opposition,⁴ a processing delay of longer than

³ Among other things, the USPTO notification to the IB must include "the number of the international registration" upon which the opposed request for extension of protection is based; "all the grounds upon which the [opposition] is based, together with a reference to the corresponding essential provisions of the law"; if the asserted ground for opposition is based on a prior application or registration, the application number, registration number, filing and registration date of the application or registration, the name and address of the owner, a reproduction of the mark, and the goods or services for which the mark has been applied for or registered; a statement of the goods or services being opposed; and the name and address of the opposer. Common Regulations Under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement 17(2) and 17(3) (2004). When a notice of opposition against a request for extension of protection is filed via ESTTA, all of this information is collected electronically.

⁴ As a general matter, a filing mailed by its due date is considered timely, regardless of how long it takes to reach the Board, if it is accompanied by a certificate of mailing. See Trademark Rule 2.197. However, the time for the USPTO to send notice to the IB under Trademark Act § 68(c) runs from the date the opposition period begins or ends, regardless of any delay in receipt or processing of the filing.

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one month would be fatal to an opposition against an application under Trademark Act § 66(a).

Further, if oppositions to applications filed under the Madrid Protocol were accepted on paper, the USPTO would require additional time to prepare and forward the notice required by Trademark Act § 68(c) to the IB. When opposers use ESTTA, the filer enters the required information, which is then automatically collected in a suitable form and sent directly to the IB within 24 hours of filing, without the need for intervention by Board personnel.

Filing of notices of opposition by ESTTA is thus a practical necessity when the subject application is based on Trademark Act § 66(a). And while no notice is given to the IB upon the filing of an extension of time to oppose, a delay in acting on an extension can also defeat a potential opposer's right to oppose. This is because a notice of opposition may not be instituted until all necessary prior extensions have been received and granted. Because of the strict time frame in which the USPTO must notify the IB of the filing of an opposition, it would be virtually impossible to assure potential opposers that their rights would be preserved if the Board accepted paper filing of either extensions of time to oppose or notices of opposition against § 66(a) applications.

Sara Lee's request for extension of time to oppose is accordingly DENIED for failure to comply with the

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requirements of Trademark Rule 2.102(a)(2). The subject application will issue as a registration in due course.⁵

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⁵ Sara Lee may file a petition to cancel any resulting registration, if otherwise appropriate. See Trademark Act § 14, 15 U.S.C. § 1064.