

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

Ryan

MAILED: February 11, 2005

Opposition No. 91162195

Leo Stoller

v.

Northern Telepresence  
Corporation

Before Quinn, Chapman, and Drost, Administrative Trademark  
Judges.

By the Board:

This proceeding was instituted by the Board on September 22,  
2004. This case now comes up for consideration of the following  
matters:

- (1) applicant's motion to dismiss the opposition as  
untimely and for sanctions against opposer;
- (2) opposer's motion to consolidate the opposition with  
Cancellation No. 92043666; and,
- (3) applicant's motion to extend and to suspend its time  
for filing its answer to the notice of opposition and  
its responsive brief on opposer's motion to  
consolidate.

We consider first the dispositive motion to dismiss and  
begin with a review of the relevant case filings. See Trademark  
Rule 2.117(b); *Boyd's Collection Ltd. v. Herrington & Co.*, 65  
USPQ2d 2017 (TTAB 2003); and TBMP § 510.02(a) (2d. ed. rev.  
2004).

Background

On January 28, 2003, the subject application, Serial No. 76308975, was published for opposition in the *Official Gazette*. See Trademark Rule 2.80. Pursuant to Section 13(a) of the Trademark Act, 15 U.S.C. § 1063(a), any notice of opposition or extension of time to file an opposition was due by February 27, 2003.

On April 3, 2003, the Board received an extension of time to oppose filed by Central Mfg. Co., through which the individual opposer Leo Stoller claims privity<sup>1</sup> as plaintiff in this proceeding (hereinafter "the first extension submission"). By this extension, Central Mfg. Co., as potential opposer, requested a ninety-day extension, up to and including May 27, 2003, within which to oppose the involved application. At the end of this request is a blank (or unsigned) signature block, but bearing the typewritten date, "February 25, 2003." Below the signature block is a certificate of mailing which also includes a typewritten date of "February 25, 2003." This, too, is unsigned.

On April 18, 2003, the Board issued an order, noting the filing on April 3, 2003 of the first extension submission and the fact that it was unsigned. The Board allowed potential opposer thirty days, i.e., until May 18, 2003, to submit a signed copy of its first extension request, failing which the unsigned paper

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<sup>1</sup> Whether opposer Leo Stoller, individually, has established any right to claim privity through potential opposer Central Mfg. Co. need not be considered herein in view of the Board's decision to dismiss this proceeding, as explained infra.

would be refused consideration. Within the allotted time, photocopies of two signed requests to extend were separately submitted (hereinafter, "the second extension submission"<sup>2</sup> and "the third extension submission.")

The second extension submission was signed in the main signature block by "Leo Stoller" as "Pres." of "Central Mfg. Co." and includes Mr. Stoller's signature again in the certificate of mailing. This extension submission is identical to the first, except there are no references to the "February 25, 2003" date and the certificate of mailing in the second submission bears a handwritten date of "4/29/03."

A photocopy of the third extension submission was received by the Board as an attachment to the notice of opposition, which appears to have been filed on May 16, 2003.<sup>3</sup> The third extension submission is identical to the first, except "Leo Stoller," as "Pres." of "Central Mfg. Co," signed it on behalf of potential opposer. Mr. Stoller's signature appears in both the

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<sup>2</sup> The record contains only a photocopy of the second extension submission. The original signed paper was never associated with the Board's proceeding file. A photocopy was faxed to the Board on February 26, 2004 with proof of receipt on May 5, 2003 by the USPTO, consisting of a postcard affixed with a USPTO mailroom label.

<sup>3</sup> A review of the prosecution history for this proceeding reveals inconsistencies in the filing date entered by the Board's clerical staff for the notice of opposition and its corresponding exhibits. Nevertheless, inasmuch as the record includes a postcard with a USPTO mailroom label of May 16, 2003, we shall consider these documents as having been received by the USPTO on that date.

main signature block and in the certificate of mailing. As with the first, the third extension submission includes the typewritten date "February 25, 2003" near the signature lines in the main signature block and again, in the certificate of mailing. However, the record contains no evidence that this third extension submission, i.e., a fully signed extension request bearing the February 25, 2003 date, was ever received by the Board or otherwise mailed to the Board by the deadline.

On June 3, 2004, the Board issued an order which notified potential opposer that, *inter alia*, its "request to extend time to oppose filed on April 16, 2004 [sic - April 18, 2003] on behalf of Central Mfg. Co. is granted" and the subject application had inadvertently proceeded to registration due to a clerical error. On July 6, 2004, application Serial No. 76308975 was restored to pendency and the Board issued an order instituting this opposition proceeding on September 22, 2004.<sup>4</sup>

Applicant's Motion to Dismiss

The main issue before us is whether the opposition is untimely and is thus barred by Section 13(a) of the Trademark

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<sup>4</sup> A review of the notice of opposition reveals inconsistencies in the identification of the opposer and/or opposers intended to be named as party plaintiff(s) herein. Inasmuch as \$300 was submitted with the notice of opposition, an amount sufficient to cover the required filing fee for one opposer to oppose registration in one class, the Board instituted this proceeding only in the name of the "first named" party, i.e., in the name of "Leo Stoller," individually. See Trademark Rules 2.101(d)(1) and (3)(iii) and TBMP § 308.01(a) (2d. ed. rev. 2004). See also footnote 1, *supra*, regarding privity.

Act, 15 U.S.C. §1063(a). Applicant argues that the opposition is untimely because potential opposer failed to file a signed request to extend with a signed certificate of mailing within the statutorily prescribed thirty-day period following publication (i.e., by the February 27, 2003 deadline). Applicant further argues that the Board erred as a matter of law in allowing potential opposer additional time to file a signed copy of its extension request. Applicant questions opposer's credibility and the veracity of the February 25, 2003 certificate of mailing date, given the extensive delay between the asserted mailing date of the first extension submission and the April 3, 2003 USPTO mailroom sticker affixed thereto. Applicant has also questioned opposer's conduct in this case based on his "history" of "bad-faith conduct and material misrepresentations in papers filed before the Board."

Opposer responds to applicant's motion with a declaration, attesting to the timely filing on February 25, 2003 of the first, unsigned, extension submission. Opposer also relies on Trademark Rule 2.119(e) which authorizes the Board to allow a party time to furnish a signed copy of a previously filed request to extend time to oppose. Opposer implicitly asserts that his opposition is timely because any signature defects were rectified within the time permitted by the Board.

Opposer counters applicant's attack on his credibility in this case, asserting that bad actions in other, unrelated

litigations do not automatically confer "bad actor" status on opposer in this proceeding.

Analysis

In reviewing the parties' arguments, we observed some confusion by both opposer and applicant as to proper Board procedure governing timeliness and signature of filings. A review of the applicable procedures is believed to be in order.

It is well understood that trademark-related correspondence shall be considered timely if received in the USPTO on or before the expiration of the set period. Ordinarily, the actual date of receipt controls. See Trademark Rule 2.195(a). It is standard practice for the USPTO mailroom to affix a label to incoming correspondence indicating the date of actual receipt in the Office which, generally speaking, may serve as adequate proof of the filing date. However, if the correspondence is not received until after the expiration of the set period, the Board will consider it timely filed if the "certificate of mailing" procedure described in Trademark Rule 2.197 is properly followed.<sup>5</sup> See also TBMP §110.01 (2d. ed. rev. 2004).

The certificate of mailing procedure is applicable to all types of filings in Board proceedings, including a request for an extension of time to oppose. See TBMP §110.07 (2d. ed. rev.

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<sup>5</sup> Other methods of obtaining a filing date other than the "actual date of receipt" are set forth in Trademark Rule 2.195. However, none of these apply to the circumstances of this case.

2004). Parties seeking to invoke this procedure must, prior to the expiration of the set period:

- (1) deposit the correspondence with the U.S. Postal Service, with sufficient postage as first-class mail, with the proper USPTO address, and
- (2) include a certificate on or with the correspondence which states the date of deposit and is signed (separate and apart from any signature for the piece of correspondence itself) by a person who has a reasonable basis to expect that the correspondence will be mailed on or before the date indicated.

See Trademark Rule 2.197(a). See also TBMP §110.02 (2d. ed. rev. 2004). The procedure does not apply in certain instances specified in Trademark Rule 2.197(a), as amplified by Trademark Rule 2.195(c), and the USPTO may require additional evidence to determine if correspondence which bears a certificate of mailing was timely filed, e.g., was mailed on the date stated in the certificate. See *S Industries Inc. v. Lamb-Weston Inc.*, 45 USPQ2d 1293 (TTAB 1997).

Additionally, we look to Trademark Rule 2.119(e) which states, in pertinent part, that:

"every paper filed in an inter partes proceeding and every request for an extension of time to file an opposition must be signed by the party filing it, or by the party's attorney, but an unsigned paper will not be refused consideration if a signed copy is submitted to the Board within the time limit set forth in the Board's notification of the signature defect."

Thus, the rules require that both the submission and the certificate of mailing thereon must be signed in order for the submission to be given consideration. The Board will not refuse consideration if a signed copy is submitted within the time limit

set forth in the notification of the signature defect by the Office. See Trademark Rules 2.119(e) and 2.197; see also TBMP §106.02 (2d. ed. rev. 2004). Inasmuch as a signature on a certificate of mailing operates to certify the date and manner of mailing on or before the applicable deadline, it is axiomatic that Trademark Rule 2.119(e) only authorizes the Board to obtain a copy of the original certificate that was properly signed on or before the expiration of the applicable period.<sup>6</sup>

Potential opposer's first extension submission was not received by the Board until April 3, 2003, or approximately five weeks after the statutory deadline for its submission. Because this request was unsigned, yet bore a typewritten date which preceded the statutory deadline, the Board on April 18, 2003 allowed potential opposer additional time to submit a signed copy of its request which might establish timeliness *vis-à-vis* the certificate of mailing procedure and otherwise satisfy the USPTO's signature requirements for submissions.

The second extension submission includes a certificate of mailing on April 29, 2003, more than eight weeks after the statutory deadline, and thus, does not establish that potential opposer timely filed a request to extend time to oppose on or before the February 27, 2003 deadline.

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<sup>6</sup> This general signature rule should not be confused with the evidentiary requirements of Trademark Rule 2.197(b)(3), applicable to proof of timeliness of certain lost filings, and should not be misconstrued to give opposer authorization to execute a certificate of mailing *ex post facto*.



Finally, there is the third extension submission, which has been signed and includes a signed certificate of mailing on February 25, 2003. As we consider this submission in relation to the first and second, we become concerned with the fact that the record now includes three different extension papers, all seeking the same ninety-day extension until May 27, 2003, with two different certified mailing dates, in varying degrees of execution.

Moreover, we are concerned with the absence of any explanation by opposer regarding the glaring discrepancies among these three papers. Specifically, opposer provides no evidence that might explain the discrepancies between the April 29, 2003 certificate of mailing date on the second extension submission and the February 25, 2003 certificate of mailing date on the first (unsigned) extension submission and third (signed) extension submission. We cannot overlook these contradictions.

Put simply, the record does not support a conclusion that an extension request bearing a signed certificate of mailing was filed on or before the statutory deadline of February 27, 2003. Thus, potential opposer missed the statutory deadline to file an opposition.

Nor does the record support a finding that the certificate of mailing for potential opposer's third extension submission was actually signed on February 25, 2003. Opposer's declaration falls short of establishing this.

Moreover, there is unexplained delay in the filing of an extension paper herein which bears a signed certificate of timely mailing. The record is devoid of any excuse why potential opposer postponed such filing until May 16, 2003 and until after potential opposer had ostensibly responded to the Board's April 18, 2003 order. When compliance with the certificate of mailing procedure is at issue, the Board cannot accept a request to extend months after it is due without explanation or further evidence of timely signature and filing.

Under the circumstances, we find opposer has not met its burden of establishing the timeliness of the request to extend time to oppose filed by the entity under which opposer claims privity. As such, we hold that the Board's June 3, 2004 action (approving the extension request) was erroneous and it is accordingly vacated. The request to extend time to oppose is denied and consequently, the notice of opposition, filed May 16, 2003, is untimely.

Applicant's motion to dismiss is granted and this opposition proceeding is dismissed as a nullity.<sup>7</sup>

Mandatory use of ESTTA for all future filings in this proceeding

As we reviewed the record of this proceeding, we observed delays in the entry of a number of papers filed by the parties herein which have unnecessarily complicated the administration of this proceeding.

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<sup>7</sup> In view of the dismissal of this proceeding as a nullity, all other pending motions are now moot and have been given no consideration.

The Board has recently introduced an Internet-based filing system referred to as "ESTTA."<sup>8</sup> Use of the ESTTA filing system aids in the efficient processing of papers filed in Board proceedings, eliminates problems associated with lost or mislaid paper filings, minimizes delays associated with paper entry, and affords the parties a means of contemporaneously verifying timely receipt of their submissions by the Board.

In order to simplify matters with regard to the timeliness and entry of any papers which might be filed in this now-nullified proceeding, and in an effort to efficiently manage any post-dismissal filings to avoid unnecessary effort by the parties and undue delay, the Board, in exercising its inherent authority to manage the cases on its docket,<sup>9</sup> will consider only those papers filed herein via the ESTTA system. This requirement shall govern all filings in this proceeding from this date forward by all parties, including but not limited to notification of any petition to the Commissioner, notification of appeal, or request for reconsideration filed by opposer or potential opposer. Any responsive submissions or future filings by applicant herein also are covered by this requirement.

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<sup>8</sup> This Internet-based filing system is also known as the Board's "Electronic System for Trademark Trials and Appeals." Instructions for electronic submission of inter partes filings with the Board are available at <http://estta.uspto.gov/>.

<sup>9</sup> See *Opticians Ass'n of America v. Independent Opticians of America Inc.*, 734 F. Supp. 1171, 14 USPQ2d 2021 (D.N.J. 1990), rev'd on other grounds, 920 F.2d 187, 17 USPQ2d 1117 (3d Cir. 1990) and *S. Industries Inc. v. Lamb-Weston Inc.*, supra.

NOTE: For determining timeliness of future filings, both parties are prohibited from relying on the certificate of mailing or certificate of express mailing procedures for submissions made herein.

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

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**Notice Regarding TTAB Electronic Resources and New Rules**

- TTAB forms for electronic filing of extensions of time to oppose, notices of opposition, and inter partes filings are now available at <http://estta.uspto.gov>. Images of TTAB proceeding files can be viewed using TTABVue at <http://ttabvue.uspto.gov>.
- Parties should also be aware of changes in the rules affecting trademark matters, including rules of practice before the TTAB. See Rules of Practice for Trademark-Related Filings Under the Madrid Protocol Implementation Act, 68 Fed. R. 55,748 (September 26, 2003) (effective November 2, 2003) Reorganization of Correspondence and Other Provisions, 68 Fed. Reg. 48,286 (August 13, 2003) (effective September 12, 2003). Notices concerning the rules changes are available at [www.uspto.gov](http://www.uspto.gov).
- The second edition of the Trademark Trial and Appeal Board Manual of Procedure (TBMP) has been posted on the USPTO web site at [www.uspto.gov/web/offices/dcom/ttab/tbmp/](http://www.uspto.gov/web/offices/dcom/ttab/tbmp/).