

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

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Mailed: June 28, 2010

Opposition No. 91186373

Roscoe M. Moore III

v.

Weather Decision Technologies,
Inc.

Cancellation No. 92050102

Cancellation No. 92050102

Weather Decision Technologies,
Inc.

v.

Roscoe M. Moore III

**Before Hairston, Kuhlke, and Wellington, Administrative
Trademark Judges:**

By the Board:

These cases come up on Weather Decision Technologies, Inc.'s motion to dismiss Opposition No. 91186373 under Fed. R. Civ. P. 12(b)(6) for lack of standing. The motion is contested but the parties requested suspension for settlement before the Board ruled on the motion. The settlement period having expired with no word from the parties, the Board addresses the motion.

CONSOLIDATION

Preliminarily, we look to whether consolidation of the three proceedings between the parties is appropriate. On September 10, 2008, Roscoe M. Moore III (Moore), an individual, filed a notice of opposition to Weather Decision Technologies, Inc.'s (WDT) application Serial No. 77193495, based on Trademark Act Sec. 1(b), for the mark CLEARPOINT HD WEATHER (HD WEATHER disclaimed) for:

high definition weather services, namely, weather forecasting, weather detecting, weather reporting, providing weather information by means of computer databases and via a global computer information network and via wired and wireless electronic communication devices, in Int. Cl. 42.

Moore pleads priority and likelihood of confusion with his Registration Nos. 3086331 for the mark WEATHER HD (WEATHER disclaimed) and 3161100 for the mark HD WEATHER on the Supplemental Register, both for:

Electronic delivery of images, pictures, video, and other data describing or displaying the earth's weather and environment which can be used for weather forecasting and weather reporting via a global computer network, in Int. Cl. 38.

Displaying images, pictures, video, and other data of others describing or displaying the earth's weather and environment which can be used for weather forecasting and weather reporting via a global computer network, in Int. Cl. 42.

On October 22, 2008, WDT filed a petition to cancel against each of Moore's pleaded registrations on the identical grounds

that the mark is generic, merely descriptive, has been abandoned, or the registration was fraudulently obtained.¹ The petition against Registration No. 3086331 was instituted as Cancellation No. 92050102, and the petition against Registration No. 33161100 was instituted as Cancellation No. 92050095.² All three proceedings were suspended during the discovery stage to allow the parties to discuss possible settlement, and in all three proceedings the suspension period has expired.³

Because the parties are the same, and the three proceedings involve common issues of law and fact, the Board believes that the interest of judicial economy will be served by consolidation of Opposition No. 91186373 and Cancellation Nos. 92050095 and 92050102. See Fed. R. Civ. P. 42(a) and TBMP §511 (2nd ed. rev. 2004). Accordingly, Opposition No. 91186373 and Cancellation Nos. 92050095 and 92050102 are consolidated, and may be presented on the same record and briefs.

The Board file will be maintained in Opposition No. 91186373 as the "parent" case, but all papers filed herein must

¹ The ESTTA petition for cancellation filed in Cancellation No. 92050102 lists "deceptively misdescriptive" instead of "merely descriptive" as a ground for cancellation but as no supporting allegations reference that ground, and the allegations do refer to mere descriptiveness, we assume it was included by mistake.

² In Cancellation No. 92050102, on October 27, 2009, the Board accepted an amended petition which corrected a typographical error.

³ As noted at the end of this order, in view of the pendency of these proceedings for more than 18 months, there will be no further suspension for settlement absent a status report on the progress of settlement.

include the proceeding numbers of all consolidated cases in ascending order. With the exception of the need for separate pleadings in each consolidated case, papers pertaining to any of the consolidated cases should be filed only in the parent case.

SUFFICIENCY OF THE PLEADINGS

1. Opposition No. 91186373

WDT moves for dismissal of the opposition under Fed. R. Civ. P. 12(b)(6) on the ground that Moore lacks standing to bring his claims. Applicant contends that the extension of time to oppose was obtained by a different entity than opposer, namely PeerStat, that only PeerStat may file the notice of opposition, and that PeerStat does not own the pleaded registrations and thus has pleaded no standing to oppose.

An opposition may be accepted if the person in whose name the extension was requested was misidentified through mistake or if the opposition is filed in the name of a person in privity with the person who requested and was granted the extension of time. Trademark Rule 2.102(b); *Custom Computer Services Inc. v. Paychex Properties Inc.*, 67 USPQ2d 1638 (Fed. Cir. 2003). In the field of trademarks, the concept of privity generally includes, inter alia, the relationship of successive ownership of a mark (e.g., assignor, assignee) and the relationship of "related companies" within the meaning of Sections 5 and 45 of

the Act. Trademark Trial and Appeal Board Manual of Procedure (TBMP) §206.02 (2nd ed. rev. 2004). Here, the ESTTA notice of opposition form filed by opposer requires an explanation of opposer's relationship to the party who filed the extension of time to oppose. Moore stated "PeerStat is wholly-owned by Roscoe M. Moore III. This opposition is directed towards the priority and likelihood of confusion associated with the WEATHER HD and HD WEATHER marks that are also owned by Roscoe M. Moore III." Inasmuch as parties are in privity if one wholly owns the other, we find no error in the decision to accept opposer's explanation and to institute the opposition. See *F. Jacobson & Sons, Inc. v. Excelled Sheepskin and Leather Coat Co.*, 140 USPQ 281 (Comr. Patents 1963) (PTO accepted request for extension of time in the name of a parent company when the opposition was filed by a wholly owned subsidiary).

Applicant's motion to dismiss for lack of standing is denied.⁴

2. Cancellation No. 92050095

Upon review of the pleadings, the Board notes that the petition to cancel in Cancellation No. 92050095 requires

⁴ The Board has erred in using PeerStat to refer to opposer, apparently a result of PeerStat appearing in opposer's mailing address. The Board regrets the error, and its records have been corrected.

deletion of the claim that the mark is merely descriptive, and amendment of the fraud claim. The Trademark Act expressly provides that the statutory bars of Section 2(e), relating to merely descriptive, deceptively misdescriptive and primarily merely surnames, are not applicable as bars to the registration of marks on the Supplemental Register. Trademark Act Sec. 26; *R. J. Reynolds Foods, Inc. v. Borden, Inc.*, 163 USPQ 300, 301 fn5 (TTAB 1969) ("We need only consider the question of whether or not these terms are the name of opposer's goods since merely descriptive or deceptively misdescriptive marks are not barred from registration on the Supplemental Register.").

With respect to fraud, the relevant allegations are set forth at ¶11 of the petition to cancel, which states:

Upon information and belief, Respondent committed fraud on the U.S. Patent and Trademark Office ("USPTO") by filing false declarations claiming exclusive rights in and to and to the merely descriptive or generic terms HD and WEATHER, and including Respondent's memorialized statement of record in his underlying application and/or its companion application for WEATHER HD (the subject of United States Registration No. 3086331, which registration Petitioner also seeks cancellation of and has concurrently filed in the USPTO Trademark Trial and Appeal Board a Petition for Cancellation) that HD has no corresponding meaning or significance in response to the USPTO's examination thereof, a copy of which is enclosed as Exhibit 1 hereto.

This pleading does not meet the standard for pleading fraud established by the Board's primary reviewing court. See *In re*

Bose Corp., 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009).

"Fraud in procuring a trademark registration or renewal occurs when an applicant knowingly makes false, material representations of fact in connection with his application." *In re Bose Corp.*, 91 USPQ2d at 1939, citing *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 1 USPQ2D 1483, 1484 (Fed. Cir. 1986). Intent to deceive is an indispensable element of the analysis in a fraud case. *Daimlerchrysler Corporation and Chrysler, LLC v. American Motors Corporation*, 94 USPQ2D 1086, 1089 (TTAB 2010) citing *In re Bose*. Here, the petition to cancel merely alleges false statements by applicant, does not properly plead intent to deceive, and thus is an insufficient pleading of fraud.

3. Cancellation No. 92050102

Inasmuch as the petition to cancel in Cancellation No. 92050102 varies from the petition to cancel in Cancellation No. only as to the specifics related to the subject registrations, the fraud pleading in ¶11 is deficient for the same reasons set forth above.

PROCEEDINGS HEREIN ARE RESUMED

Proceedings herein are resumed, and WDT is allowed until twenty days from the mailing date of this order in which to file

Opposition No. 91186373 and Cancellation Nos. 92050095 and 92050102

amended petitions to cancel, failing which Cancellation No. 92050095 (on the Supplemental Register) will go forward only as to the claims that the mark is generic and has been abandoned, and Cancellation No. 92050102 will go forward only as to the claims that the mark is generic, merely descriptive, and has been abandoned.

Moore is allowed until forty days from the date of service of any amended petition to cancel in which to file his answer.

In view of the pendency of each proceeding for more than 18 months, no further consented motion to extend or suspend for settlement should be filed or will be granted unless the parties show good cause for continued suspension or extension for settlement in the form of a detailed report on progress. The report must include a statement as to whether agreement on any provisions has been reached, the date on which the last proposal was submitted, and when a response is expected.

Dates are reset below:

Deadline for Discovery Conference	9/3/10
Discovery Opens	9/3/10
Initial Disclosures Due	10/3/10
Expert Disclosures Due	1/31/11
Discovery Closes	3/2/11
Plaintiff's Pretrial Disclosures	4/16/11
Plaintiff's 30-day Trial Period Ends	5/31/11
Defendant's Pretrial Disclosures	6/15/11
Defendant's 30-day Trial Period Ends	7/30/11
Plaintiff's Rebuttal Disclosures	8/14/11
Plaintiff's 15-day Rebuttal Period	9/13/11

Ends

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

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