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UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
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Mailed: May 30, 2013

Opposition No. **91184316**

Opposition No. 91184319

Fox News Network, LLC

v.

Chicago Tribune Company

**By the Board:**

As background, on August 5, 2008, applicant filed a motion to dismiss in both proceedings. Proceedings were thereafter suspended on August 15, 2008. In response to the motion to dismiss, in both proceedings, opposer filed motions to amend its pleading and amended notices of opposition, to which applicant objected. Applicant argued that the amended pleadings remain insufficient. Opposer then filed a response to this filing, arguing that it exercised its right to amend the opposition, and that "[t]o the extent that the Tribune Response may be treated as a motion to dismiss the Amended Opposition, such motion is unfounded, is premature and should be denied."

On October 16, 2012, opposer filed motions to consolidate in both proceedings. Applicant objected, filing a letter on October 27, 2008 advising that it was not responding to the motions to consolidate which were not

germane to the motions to dismiss. Opposer subsequently filed a letter on November 11, 2008, in response thereto, directing its arguments as to why the Board in its discretion, should consider the motion.

On December 15, 2008, applicant notified the Board of its bankruptcy, and proceedings were suspended on February 17, 2009 pending disposition of the bankruptcy proceeding. On January 22, 2013, applicant advised of its emergence from bankruptcy<sup>1</sup> and opposer moved to resume proceedings on the same day.

Accordingly, proceedings are resumed to the extent that the Board will now consider the pending motions to dismiss.

A party may file an amended pleading in response to a motion to dismiss so as to correct the defects identified in the motion to dismiss. TBMP Section 503.03 (3d ed. rev. 2012). Applicant has objected to the amended notices of opposition. The Board construes this objection as a renewed motion to dismiss with respect to the amended pleadings. Thus, the Board will consider the parties' arguments as to sufficiency with respect to the amended notices of opposition.

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<sup>1</sup> Applicant has advised that Chicago Tribune Company, LLC is the successor-in-interest to Chicago Tribune Company, the applicant as presently identified in these proceedings. However, it does not appear that any assignment papers have been filed with the Office's Assignment Branch to reflect the assignment; the only papers filed in the Office's Assignment Branch are one's that reflect security interests in the involved marks.

The Board has considered the parties' submissions and presumes the parties' familiarity with the factual bases for the motion to dismiss, and does not recount the facts or arguments here.

At the motion to dismiss stage, the Board does not consider the merits of opposer's standing or its claims, but only considers whether the pleading is sufficient to state a claim to relief that is plausible on its face. *Bell Atl. Corp. v Twombly*, 550 U.S. 544, 570 (2007); *Libertyville Saddle Shop Inc. v. E. Jeffries & Sons, Ltd.*, 22 USPQ2d 1594, 1597 (TTAB 1992) ("A motion to dismiss does not involve a determination of the merits of the case"). To the extent the parties have argued the merits of the allegations in the amended notices of opposition, these arguments have not been considered.

In order to avoid dismissal at this stage of the proceeding, opposer need only allege such facts as would, if proved, establish that opposer is entitled to the relief sought. Therefore, opposer must allege that (1) it has standing to bring the proceeding, and (2) a valid ground exists for denying the registration sought. *Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1538 (TTAB 2007). For purposes of a motion to dismiss, all of opposer's well-pleaded allegations in the notices of opposition must be accepted as true and the complaint must be construed in a

Opposition Nos. 91184316 and 91184319

light most favorable to opposer. *See Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, 988 F.2d 1157, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993).

### Standing

With respect to the question of standing, all that is required is that opposer have a "real interest" in the opposition proceedings. *Int'l Order of Job's Daughters v. Lindeburg & Co.*, 727 F.2d 1087, 220 USPQ 1017, 1020 (Fed. Cir. 1984).

To allege standing based on fraud, opposer must allege that it is using the same or similar mark on the same or similar goods or services, along with a direct or hypothetical pleading of confusion in trade. *See Yard-Man, Inc. v. Getz Exterminators, Inc.*, 157 USPQ 100 (TTAB 1968). Standing may also be alleged by an allegation of a refusal to register a pending application. *See Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982) (standing based on filing of application and rejection of registration); *Fiat Group Automobiles S.p.A. v. ISM Inc.*, 94 USPQ2d 1111, 1112 (TTAB 2010), *citing Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1959 (TTAB 2008), ("The filing of opposer's application and the Office's action taken in regard to that application provides opposer with a basis for pleading its standing ...").

Opposer has sufficiently alleged its standing by its allegations in the amended notices of opposition of its use of REDEYE in connection with cable television services, and the potential refusal to register based on likelihood of confusion grounds by the examining attorney of its pending trademark applications.

Ground for Opposition

*Fraud*

Fed. R. Civ. P. 9(b) provides that the circumstances constituting the alleged fraud shall be stated with particularity. *See also King Automotive, Inc. v. Speedy Muffler King, Inc.*, 667 F.2d 1008, 212 USPQ 801 (CCPA 1981) (“[t]he pleadings [must] contain explicit rather than implied expressions of the circumstances constituting fraud”). “Pleadings of fraud which rest solely on allegations that the trademark applicant or registrant made material representations of fact in connection with its application or registration which it ‘knew or should have known’ to be false or misleading are an insufficient pleading of fraud because it implies mere negligence and negligence is not sufficient to infer fraud or dishonesty.” *In re Bose*, 580 F.3d 1240, 91 USPQ2d 1938, 1940 (Fed. Cir. 2009) (citations omitted). Intent to deceive the Office, whether to procure or maintain a registration is an indispensable element of the analysis in a fraud case. *Id*

at 1941. "The preferred practice for a party alleging fraud in a Board opposition or cancellation proceeding is to specifically allege the adverse party's intent to deceive the U.S. Patent and Trademark Office (USPTO), so that there is no question that this indispensable element has been pled." *DaimlerChrysler Corp. v. American Motors Corp.*, 94 USPQ2d 1086, 1089 (TTAB 2010).

Thus, to assert a viable claim of fraud, the plaintiff must allege the circumstances of fraud with particularity as well as allege that the defending party knowingly made a false, material representation in the procurement of or renewal of a registration with the intent to deceive the USPTO. *In re Bose Corp.*, 91 USPQ2d at 1942; *Enbridge Inc. v. Excelerate Energy LP*, 92 USPQ2d 1537 (TTAB 2009).

In this case, opposer alleges knowing misrepresentation, (paragraphs 1-3, 19, 47, 48) but also uses the insufficient "knew or should have known" language in its pleading, (see e.g. paragraphs 20, 33, 44). However, based on the rest of the fraud allegations, the Board construes the pleading as a whole to allege a knowing material misrepresentation of fact in connection with applicant's applications i.e., that applicant "knew" and not merely that it "should have known." *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 1 USPQ2d 1483, 1485 (Fed.

Cir. 1986). Nonetheless, the Board strikes the "should have known" language from the pleading.

With regard to fraud, statements regarding the use of the mark on goods and services are material to issuance of a registration. *Hurley International LLC v. Volta*, 82 USPQ2d 1339 (TTAB 2007). The Board finds that opposer has essentially alleged fraud based on non-use of the marks in connection with the services set forth in the applications, and that applicant's only use of the marks is in connection with ancillary promotional services, which services are not for others.<sup>2</sup> As to opposer's allegations regarding dates of use and specimens, the Board does not view these allegations as asserting separate bases for fraud, but merely allegations which go to the fraud claim based on non-use of the mark in connection with the services as identified in the applications.<sup>3</sup> In addition, opposer has alleged intent

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<sup>2</sup> To qualify as a "service," a service must be a real activity; a service must be performed to the order of, or for the benefit of, someone other than the applicant or registrant; and the activity performed must be qualitatively different from anything necessarily done in connection with the sale of the applicant's goods or the performance of another service. *In re Canadian Pacific Limited*, 754 F.2d 992, 224 USPQ 971 (Fed. Cir. 1985). The fact that an activity is ancillary to a principal service or to the sale of goods does not in itself mean that it is not a separately registrable service. The statute makes no distinction between primary, incidental or ancillary services. *In re Universal Press Syndicate*, 229 USPQ 638 (TTAB 1986).

<sup>3</sup> It is well settled that a misstatement of a date of first use in commerce is not fraudulent nor is it otherwise fatal to the securing of a valid registration provided that there has been use of the mark in commerce prior to the filing date of the application; such use may include technical trademark use. See e.g., *Colt Industries Operating Corp. v. Olivetti Controllo*

to deceive the USPTO to procure a registration by its allegation that the "representations to the PTO were knowingly false and were designed to induce the PTO to give Tribune a registration to which it is not entitled."

The Board finds that opposer has sufficiently alleged a claim of fraud. In view thereof, the motions to dismiss are denied.

*Consolidation*

The amended notices of opposition evidence that these oppositions involve the same parties, similar marks and common question of law and fact. Although answers have not yet been filed in these proceedings, the Board, in its discretion, finds consolidation appropriate.

In view thereof, Opposition Nos. 91184316 and 91184319 are hereby consolidated. Although each proceeding retains its separate character, the cases may be presented on the same record and briefs. The record will now be maintained at the Board in Opposition No. 911184316 as the "parent" case. Answers should be filed in each separate opposition proceeding, but thereafter, all other papers filed in these cases only should be filed in the parent case. All papers filed should include all proceeding numbers in the ascending

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*Numerico S.p.A.*, 221 USPQ 73, 76 (TTAB 1983); *Girard Polly-Pig, Inc. v. Polli-Pig by Knapp, Inc.*, 217 USPQ 1338 , (TTAB 1983); *Hecon Corp. v. Magnetic Video Corp.*, 199 USPQ 502, 504 (TTAB 1978) at n. 3; and *Autac Inc. v. Walco Systems, Inc.*, 195 USPQ 11, 13 (TTAB 1977) at n. 4.

order. If there are any other related proceedings involving the parties, the Board should be so advised.

Accordingly, opposer's motion to consolidate is moot.

Proceedings are resumed.

Dates are reset as follows:

Time to Answer	6/28/2013
Deadline for Discovery Conference	7/28/2013
Discovery Opens	7/28/2013
Initial Disclosures Due	8/27/2013
Expert Disclosures Due	12/25/2013
Discovery Closes	1/24/2014
Plaintiff's Pretrial Disclosures Due	3/10/2014
Plaintiff's 30-day Trial Period Ends	4/24/2014
Defendant's Pretrial Disclosures Due	5/9/2014
Defendant's 30-day Trial Period Ends	6/23/2014
Plaintiff's Rebuttal Disclosures Due	7/8/2014
Plaintiff's 15-day Rebuttal Period Ends	8/7/2014

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.

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