

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

coggins

Mailed: December 8, 2011

Opposition No. 91197819

I Matti Ristorante, Inc.

v.

Campo de' Fiori, LLC

Before Zervas, Wellington, and Shaw,
Administrative Trademark Judges.

By the Board:

This case comes up on applicant's motion (filed March 29, 2011¹) to dismiss the notice of opposition for failure to state a claim upon which relief can be granted under Fed. R. Civ. P. 12(b)(6).²

Motion to Dismiss

A motion to dismiss for failure to state a claim is a test solely of the legal sufficiency of the complaint. To withstand a motion to dismiss for failure to state a claim in a Board opposition proceeding, the plaintiff need only allege such

¹ Answer was due on March 25, 2011. Inasmuch as the motion to dismiss includes a certificate of mailing dated March 24, 2011, the motion is considered timely filed. Trademark Rule 2.197(a); TBMP § 110.01 (3d ed. 2011). Applicant is encouraged to file all future papers in this proceeding electronically via ESTTA at the following URL: <http://estta.uspto.gov>. See TBMP § 110.09.

² Opposer's change of correspondence (filed April 18, 2011) is noted and entered.

facts as would, if proved, establish that (1) it has standing, and (2) a valid ground exists for opposing the subject application. *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 187 (CCPA 1982). Specifically, "a complaint must contain sufficient factual matter, accepted as true, to state a claim to relief that is plausible on its face." *Ashcroft v. Iqbal*, 556 U.S. 662, ___, 129 S. Ct. 1937, 1949-50 (2009), quoting *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007). In particular, a plaintiff need only allege "enough factual matter ... to suggest that [a claim is plausible]" and "raise a right to relief above the speculative level." *Totes-Isotoner Corp. v. U.S.*, 594 F.3d 1346 (Fed. Cir. 2010).

For purposes of determining the motion, the pleading must be examined in its entirety, construing the allegations therein liberally, as required by Fed. R. Civ. P. 8(e).³ All of opposer's well-pleaded allegations must be accepted as true, and the claims must be construed in the light most favorable to opposer. See *Advanced Cardiovascular Sys. Inc. v. SciMed Life Sys. Inc.*, 988 F.2d 1157, 26 USPQ2d 1038 (Fed. Cir. 1993).

1. Standing

Opposer alleges facts that demonstrate it has a real interest, that is, a personal stake, in opposing registration

³ As a procedural matter, we note that the various articles attached to the notice of opposition are not in evidence. See Trademark Rule 2.122(c); and TBMP § 704.05(a).

of applicant's mark. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999). Applicant's arguments to the contrary are not persuasive. Opposer does not merely rely on its abandoned application Serial No. 76471175 or cancelled Registration No 2348945 to establish its real interest. Instead, opposer alleges that it has used the mark CAMPO DI FIORI for at least sixteen years for services which it contends are similar to applicant's services (paras. 1 and 16), and that it is the owner of a pending application (i.e., Serial No. 85110181) which has been suspended pending resolution of the registrability of applicant's mark (para. 14). These allegations, if proved, would be sufficient to meet the liberal threshold for determining standing, namely, whether a plaintiff's belief in damage has a reasonable basis in fact and reflects a real interest in the case. *See Id.* In view thereof, we find that opposer has properly pleaded its standing. Accordingly, applicant's motion to dismiss is denied with respect to opposer's standing.

2. Grounds for Opposition

We take up each of opposer's grounds for opposition in turn.

A. Priority and Likelihood of Confusion

In order to properly state a ground of priority and likelihood of confusion, opposer must plead that (1) applicant's mark, as applied to its services, so resembles

opposer's mark as to be likely to cause confusion, mistake or deception; and (2) opposer has priority of use. See Fed. R. Civ. P. 8(a); *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Applicant's argument that opposer cannot have priority because it has not been diligent in pursuing its own registration is more in the nature of an affirmative defense than a proper attack on the legal sufficiency of the complaint.⁴

In the notice of opposition opposer alleges that it has continuously used the mark CAMPO DE FIORI in connection with restaurant and bar services in interstate commerce since October 14, 1994 (para. 4); that applicant filed the subject application on December 6, 2010, and has used the mark since July 2010 (para. 15); that the parties' marks are identical in sound, meaning, and commercial impression (para. 16); that the parties' services are identical (para. 16); and that any use of the mark by applicant is likely to cause confusion (para. 17). In view thereof, we find that opposer has properly pleaded a claim of likelihood of confusion. Accordingly, applicant's motion to dismiss is denied with respect to opposer's ground of priority and likelihood of confusion.

⁴ To the extent applicant intends to raise the defense of laches or acquiescence, we remind applicant that laches and acquiescence are not usually available as defenses in an opposition proceeding. See *Nat'l Cable Television Ass'n Inc. v. Am. Cinema Editors Inc.*, 19 USPQ2d 1424, 1432 (Fed. Cir. 1991); *DAK Industries, Inc. v. Daiichi Kosho Co.*, 25 USPQ2d 1622, 1624 (TTAB 1992); and TBMP § 311.02.

B. Dilution

In order to properly assert a ground of dilution, a plaintiff must plead that its mark became famous prior to the applicant's filing date and/or use of the mark. See *Toro Co. v. ToroHead, Inc.*, 61 USPQ2d 1164 (TTAB 2001).

In the notice of opposition, opposer alleges that its mark has received national attention in various publications (para. 6), and that use of the mark by applicant "is likely to... dilute [o]pposer's mark...." (para. 17); however, opposer has not alleged that its mark is famous or that the mark became famous prior to applicant's filing date. Accordingly, applicant's motion to dismiss is granted with respect to opposer's ground of dilution.

In view thereof, opposer is allowed until December 29, 2011, in which to file an amended notice of opposition that properly pleads dilution.⁵ Applicant is allowed until January 20, 2012, in which to file an answer to either the notice of opposition or the amended notice of opposition if one is filed.

Summary

⁵ While it is permissible for opposer to replead a proper dilution claim, we remind opposer that "[f]ame for dilution purposes is difficult to prove ... The party claiming dilution must demonstrate by the evidence that its mark is truly famous." See *Toro Co. v. ToroHead Inc.*, *supra*, at 1180 (TTAB 2001). See also *Avery Dennison Corp. v. Sumpton*, 189 F.3d 1868, 51 USPQ2d 1801, 1805 (9th Cir. 1999) ("The Federal Trademark Dilution Act of 1995 applies only to a very select class of marks - those with such powerful consumer

Applicant's motion to dismiss is (1) denied as to opposer's standing, (2) denied as to the ground of priority and likelihood of confusion, and (3) granted as to the ground of dilution. However, opposer is allowed until December 29, 2011, in which to file an amended notice of opposition that properly pleads dilution, failing which this proceeding will move forward only on the ground of priority and likelihood of confusion. Applicant is allowed until January 20, 2012, in which to file an answer to the amended notice of opposition or to the current notice of opposition if no amended notice is filed.

Schedule

Proceedings are resumed, and dates are reset on the following schedule.

Amended Complaint Due, if Filed	12/29/2011
Time to Answer	1/20/2012
Deadline for Discovery Conference	2/19/2012
Discovery Opens	2/19/2012
Initial Disclosures Due	3/20/2012
Expert Disclosures Due	7/18/2012
Discovery Closes	8/17/2012
Plaintiff's Pretrial Disclosures	10/1/2012
Plaintiff's 30-day Trial Period Ends	11/15/2012
Defendant's Pretrial Disclosures	11/30/2012
Defendant's 30-day Trial Period Ends	1/14/2013
Plaintiff's Rebuttal Disclosures	1/29/2013
Plaintiff's 15-day Rebuttal Period Ends	2/28/2013

associations that even non-competing uses can impinge upon their value.").

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.