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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91197819
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of:

Application Serial No.: 85,010,592

Mark: CAMPO DE' FIORI

I MATTI RISTORANTE, INC.,

Opposer,

v.

CAMPO DE' FIORI, LLC,

Applicant.

Opposition Proceeding No. 91197819

**OPPOSER'S MOTION FOR JUDGMENT ON THE PLEADINGS**

Pursuant to Federal Rule of Civil Procedure 12(c), Opposer I Matti Ristorante, Inc. ("Matti" or "Opposer") hereby moves the Board to enter judgment on the pleadings in favor of Opposer and against Applicant Campo de' Fiori, LLC ("Campo" or "Applicant"). See, TBMP §504.01. Opposer's motion for judgment on the pleadings is timely – the pleadings are closed<sup>1</sup> and the motion is being presented within such time as not to delay trial.<sup>2</sup> *Id.* Based on the facts admitted, there is no genuine issue of material fact to be resolved and Opposer is entitled to judgment as a matter of law. TBMP §504.02.

**I. BACKGROUND**

"On or about October 14, 1994, Opposer began using the mark, CAMPO DE FIORI, in interstate commerce as the name of its bar and restaurant that it opened in Aspen, Colorado." (Dkt. No. 1, Opposer's Notice of Opposition at ¶ 5). "For more than 16 years, and prior to any

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<sup>1</sup> Opposer filed its Notice of Opposition (Dkt. No. 1), Applicant filed a motion to dismiss (Dkt. No. 8), Opposer responded (Dkt. No. 9), the Board denied the motion to dismiss (except as to dilution, which Opposer no longer asserts in this proceeding) (Dkt. No. 12), and Applicant answered the Notice of Opposition (Dkt. No. 13).

<sup>2</sup> This motion is being presented four months before the commencement of Opposer's 30-day Trial Period (October 15, 2012) as set by the Board (Dkt. No. 12).

date upon which Applicant can rely, Opposer has used the mark CAMPO DE FIORI in connection with restaurant and bar services in the United States, and continues to so use the mark.” (*Id.* at ¶ 1). “Shortly after Opposer opened its bar and restaurant in Aspen, Colorado, the mark began receiving national attention in numerous national magazines and publications in association with Opposer’s business.” (*Id.* at ¶¶ 6-13, Exhibits A-G).

“On April 9, 2010, Applicant [] filed an intent to use application under Section 1(b) of the Trademark Act to register the mark CAMPO DE’ FIORI for ‘Restaurant, bar and catering services’ in International Class 43.” (*Id.* at ¶ 15).

“Opposer has a pending application for the mark CAMPO DE FIORI, Application Serial No. 85,110,181, filed on August 18, 2010 for ‘Bar and restaurant services; Restaurant and bar services’ in International Class 43.” (*Id.* at ¶ 14). “This application has a section 1(a) filing basis and claims a date of first use in commerce of October 14, 1994, long prior to any date on which Applicant relies.” (*Id.*). “Opposer’s application was suspended on December 6, 2010 pending the disposition of Applicant’s Application Serial No. 85,010,592.” (*Id.*).

## **II. LEGAL STANDARD**

“A motion for judgment on the pleadings provides a means of disposition of cases when the material facts are not in dispute and judgment on the merits can be achieved by focusing on the pleadings.” *Chatam Int’l Inc. v. Abita Brewing Co.*, 49 USPQ2d 2021, 1998 TTAB LEXIS 527, at \*3 (TTAB 1998). “A motion for judgment on the pleadings is a test solely of the undisputed facts appearing in all the pleadings, supplemented by any facts of which the Board will take judicial notice.” *Kraft Group LLC v. Harpole*, 90 USPQ2d 1837, 2009 TTAB LEXIS 254, at \*6 (TTAB 2009). Likewise, “all well pleaded factual allegations of the non-moving party must be accepted as true, while those allegations of the moving party which have been denied...are deemed false.” *Id.* at \*6-7. “All reasonable inferences from the pleadings are drawn

in favor of the non-moving party.” *Id.* at \*7. “Further, a judgment on the pleadings may be granted only where, on the facts as deemed admitted, there is no genuine issue of material fact to be resolved, and the moving party is entitled to judgment on the substantive merits of the controversy, as a matter of law.” *Id.*

### **III. THE PLEADINGS ESTABLISH THAT NO MATERIAL ISSUES OF FACT REMAIN TO BE RESOLVED AND THAT OPPOSER IS ENTITLED TO JUDGMENT AS A MATTER OF LAW**

“Section 2(d) of the [Lanham] Act prohibits the registration of ‘a mark which so resembles...a mark or trade name previously used in the United States by another and not abandoned’ as to be likely to cause confusion.” Baroid Drilling Fluids, Inc. v. Sun Drilling Prods., 24 USPQ2d 1048, 1992 TTAB LEXIS 6, at \*16 (TTAB 1992); 15 U.S.C. §1052(d). Accordingly, “[t]o prevail on a Section 2(d) ground of opposition, the movant must prove priority and likelihood of confusion.” Kraft, 2009 TTAB LEXIS 254, at \*12-13.

The pleadings clearly establish (1) that Opposer is the prior user of the mark and has never abandoned its use, and (2) that Applicant’s use of the mark is likely to cause confusion.

#### **A. Priority of Use**

Filing an application for federal registration of a mark does not carry any substantive advantage in law; “the mere act of filing an application for federal trademark registration is accompanied by no statutory presumption of entitlement.” Hydro-Dynamics, Inc. v. George Putnam & Company, Inc., 811 F.2d 1470, 1472 (Fed. Cir. 1987). Instead, it places on the subsequent filer “the burden of pleading facts and going forward with proof of its claim to prior use of the trademark.” *Id.* “The common law and the Lanham Act require that trademark ownership be accorded to the first bona fide *user*.” *Id.* (emphasis added); citing New England Duplicating Co. v. Mendes, 190 F.2d 415, 417, 90 USPQ 151, 152 (1<sup>st</sup> Cir. 1951) (“the exclusive right to the use of a mark...claimed as a trademark is founded on priority of appropriation”).

In the present action, there is no doubt that Opposer is the prior user of the mark CAMPO DE FIORI in interstate commerce. Applicant's earliest date for priority is April 9, 2010, the date that Applicant filed its intent-to-use application. On the other hand, Opposer claims priority at least as early as October 14, 1994; and as discussed in detail below, Applicant's pleadings admit that Opposer first used the mark as early as 1995 (and has never abandoned such use), and Applicant provides no evidence or argument that Applicant used the mark on a prior date.

**1. Applicant's First Date of Use in Commerce was April 9, 2010**

"A party that has filed an intent-to-use application may rely on the filing date of its application to establish priority." Kraft, 2009 TTAB LEXIS 254, at \*13; citing Zirco Corp. v. American Telephone & Telegraph Co., 21 USPQ2d 1542, 1544 (TTAB 1991).

Applicant admits that "On April 9, 2010, Applicant, Campo de' Fiori, LLC, filed an intent to use application under Section 1(b) of the Trademark Act to register the mark CAMPO DE' FIORI for 'Restaurant, bar and catering services' in International Class 43." (Dkt. No. 1 at ¶ 15; Dkt. No. 13, Applicant's Answer to Notice of Opposition with Affirmative Defenses at ¶ 15. See also, Dkt. No. 8, Applicant's Motion to Dismiss at ¶ 4 (stating incorrectly that "On April 29, 2010 Applicant filed Application Serial No. 85,010,592 for the Intent-to-Use its mark displaying the words CAMPO de' FIORI and a design....")).

Applicant has not, however, claimed any date of priority earlier than April 9, 2010. Instead, Applicant admits that it only first commenced business under the mark after filing its intent-to-use application:

Applicant thereupon took the steps of establishing a business enterprise, selecting a location, committing to leasing, assembling equipment and personnel, contacting vendors and suppliers, and effectively doing all of the basic chores including committing the necessary finances to launch its business under the Campo de' Fiori name.

(Dkt. No. 8 at ¶ 7).

Accordingly, Applicant may rely on the April 9, 2010 filing date to establish its priority, but no earlier.

## 2. Opposer's First Date of Use in Commerce was 1995 or Earlier

Whereas Applicant can only claim a date of priority back until April 9, 2010, Opposer has sufficiently pled, and Applicant has admitted, Opposer's prior use back to at least as early as 1995. In its Notice of Opposition, Opposer attached several articles that clearly establish Opposer's continuous use of the mark CAMPO DE FIORI since at least as early as 1994. (Dkt. No. 1 at ¶¶ 6-13). Applicant did not challenge Opposer's allegations, but instead, admitted that Opposer had used the mark continuously since at least as early as 1995. (Dkt. No. 13 at ¶¶ 7-13).

More particularly, Applicant admits that (1) the "1995 edition of The Aspen Times...promote[d] Opposer's mark in connection with its bar and restaurant and business" (Dkt. No. 1 at ¶ 8; Dkt. No. 13 at ¶ 8); (2) "the "2004 edition of Aspen Daily News, Mountain Marketplace section, celebrat[ed] the 10<sup>th</sup> anniversary of Opposer's bar and restaurant services" (Dkt. No. 1 at ¶ 9; Dkt. No. 13 at ¶ 9); (3) "the June 2007 edition of 5280 Magazine...promote[d] Opposer's mark in connection with its bar and restaurant services" (Dkt. No. 1 at ¶ 10; Dkt. No. 13 at ¶ 10); (4) "the Summer 2009 edition of Vaildaily.com...promote[d] Opposer's mark in connection with its bar and restaurant services" (Dkt. No. 1 at ¶ 11; Dkt. No. 13 at ¶ 11); (5) "the Friday, June 18, 2010 edition of Vail Mountaineer...promote[d] Opposer's mark in connection with its bar and restaurant services" (Dkt. No. 1 at ¶ 12; Dkt. No. 13 at ¶ 12); and finally, (6) that "Opposer's website at <http://www.campodefiori.net/he.html>...list[s] press releases in connection with Opposer's mark from November 1994 through July 2007." (Dkt. No. 1 at ¶ 13; Dkt. No. 13 at ¶ 13) (emphasis added throughout).

Accordingly, Applicant has admitted that Opposer first used the mark in commerce at least as early as 1995 and that nationally recognized publications confirmed that continuous use

in 2004, 2007, 2009 and 2010. The evidence is clear, and nowhere in the pleadings does Applicant allege or suggest that Opposer ever abandoned its *use* of the mark.

Nonetheless, because all reasonable inferences are construed in favor of Applicant, it must be noted that a party “establishes a prima facie case of abandonment by showing proof of nonuse for three consecutive years.” On-Line Careline, Inc. v. America Online, Inc., 229 F.3d 1080, 1087 (Fed. Cir. 2000). However, based on Applicant’s admissions above, it is indisputable that, at least since 2007 (well before Applicant filed its intent-to-use application), there has never been a consecutive three-year lapse in use. Accordingly, Applicant cannot even rely on a presumptive abandonment based on nonuse to rebut Opposer’s obvious priority.

Based on the foregoing, the pleadings irrefutably establish (even in the light most favorable to Applicant) that (1) Applicant cannot claim priority of use prior to April 9, 2010 and (2) Opposer can claim priority of use (and continuous priority without abandonment) as early as at least 1995. Accordingly, the pleadings are clear that Opposer has priority of use and satisfies the first of the two necessary elements to prevail on its Opposition as a matter of law.

#### **B. Likelihood of Confusion**

In addition to establishing priority of use, Opposer must also establish a likelihood of confusion. Kraft, 2009 TTAB LEXIS 254, at \*12-13. “Whether a likelihood of confusion exists is a question of law, based on underlying factual determinations.” On-Line Careline, 229 F.3d at 1084. Typically, “[w]hether a likelihood of confusion exists between two marks is determined on a case-by-case basis, aided by the application of the factors set out in *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973).” On-Line Careline, 229 F.3d at 1084. In this case, the inquiry is simple and the Board need not even turn to any factual determinations or consider the *DuPont* factors. Instead, the Board need only consider Applicant’s own admissions in the pleadings.

Opposer alleged in its Notice of Opposition that:

The mark that Applicant seeks to register, CAMPO DE' FIORI, is identical in sound, meaning and commercial impression to Opposer's mark, CAMPO DE FIORI, and will be used in connection with goods and services that are both identical and closely related to the goods and services that are both identical and closely related to the goods and services provided under Opposer's mark. Based on the similarities of the marks and goods, the public is likely to incorrectly associate the goods and services offered by Applicant under the mark CAMPO DE' FIORI with Opposer or with Opposer's goods and services. Furthermore, the public is likely to incorrectly believe that Applicant's foods [sic] and services are sponsored, endorsed, or licensed by Opposer, or that there is some relationship between Applicant and Opposer.

(Dkt. No. 1 at ¶ 16).

Applicant answered: "Applicant denies the allegations of Paragraph 16." (Dkt. No. 13 at ¶ 16). This denial, however, must have been made tongue-in-cheek because Applicant immediately followed with this admission:

Applicant denies the allegations of Paragraph 17 with the exception that **Opposer's use of its CAMPO DE FIORI mark is likely to cause confusion, cause mistake, deceive the public...and cause the public to incorrectly believe that the goods sold under the CAMPO DE FIORI mark emanate from or are otherwise sponsored or endorsed by Applicant** in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

(Id. at ¶ 17) (emphasis added).

Apparently Applicant would have the Board believe that Opposer's use of the mark is likely to cause confusion with respect to Applicant's mark, but not vice versa. This argument simply ignores rationality and logic. The marks are identical save for a single apostrophe and both Applicant and Opposer use the marks in relation to restaurant and bar services.

Based on Applicant's incontrovertible admission that the two marks – CAMPO DE FIORI and CAMPO DE' FIORI – so resemble each other that confusion is likely, and based on Opposer's indisputable priority of use and lack of abandonment, Opposer respectfully requests that the Board grant this motion for judgment on the pleadings and refuse Applicant's request for registration of its mark.

#### **IV. APPLICANT'S AFFIRMATIVE DEFENSES DO NOT RAISE ANY RELEVANT GENUINE ISSUES OF MATERIAL FACT**

As demonstrated above, the pleadings clearly establish (1) Opposer's prior use of the mark and lack of abandonment and (2) that Applicant's mark so resembles Opposer's mark that Applicant's use of the mark is likely to cause confusion. However, Applicant raised three affirmative defenses that should be discussed to establish conclusively that there are no unresolved genuine issues of material fact.

##### **A. Applicant's First Affirmative Defense**

Applicant states as its First Affirmative Defense "that it is entitled to the registration of its CAMPO DE' FIORI mark on the Principal Register of the United States Patent and Trademark Office." (Dkt. No. 13 at p. 2). Applicant further states that it "performed a search of the available trademark records and found that there were no active or pending registrations of the CAMPO DE' FIORI mark in any relevant International Class." (*Id.*). Applicant does not state – nor can it state – that it conducted a search for CAMPO DE FIORI on the internet or elsewhere and found no *use* of the mark in commerce.

Applicant further argues that "Opposer did not file its trademark application for its CAMPO DE FIORI mark until August 18, 2010. As a result, the April 9, 2010 filing date of Applicant's trademark application has priority over that of Opposer's." (*Id.* at p. 3). Again, Applicant does not state – nor can it – that Applicant *used* the mark in commerce prior to Opposer.

The facts remain that Opposer was a prior *user* of the mark (without abandonment) and that Applicant's use of the mark will lead to confusion. Applicant's *attempted* registration does not provide any genuine issue of material fact for the Board to consider.

**B. Applicant's Second Affirmative Defense**

Applicant states as its Second Affirmative Defense:

Opposer's prior interest in the canceled Trademark Registration No. 2,348,945 (CAMPO DE FIORI) and the willfully abandoned trademark application Serial No. 76,471,175 (CAMPO DE FIORI) does not grant Opposer's current trademark application Serial No. 85110181 (CAMPO DE FIORI) priority over that of Applicant.

(Dkt. No. 13 at p. 3).

Again, Applicant's affirmative defense is not relevant to the present opposition proceeding, which must focus on two elements: (1) priority of *use* and (2) likelihood of confusion. Opposer does not request that Applicant's mark be refused because Opposer has a prior registration, but rather, because Opposer is a prior *user* of the mark and has continuously used the mark since at least as early as 1995. Applicant does not state – nor can it – that Opposer abandoned *use* of the mark.

Applicant's Second Affirmative Defense does not change the facts that (a) Opposer was a prior *user* of the mark, (b) Opposer has continuously used the mark in interstate commerce since at least as early as 1995, and (c) Applicant's use of the mark will lead to confusion. Opposer's alleged lack of registration does not create any genuine issues of material fact.

**C. Applicant's Third Affirmative Defense**

Applicant states as its Third Affirmative Defense “that the assignment of Trademark Registration No. 2,348,945 (CAMPO DE FIORI) to Opposer was invalid.” (Dkt. No. 13 at p. 4).

Again, this argument is not relevant to the present opposition proceeding. Opposer is not requesting that Applicant's mark be refused because Opposer has a prior registration, but rather, because Opposer is a prior *user* of the mark and has continuously used the mark since at least as early as 1995.

Accordingly, Applicant's Third Affirmative Defense in no way alters the facts that Opposer is a prior *user* of the mark and has continuously used the mark in interstate commerce since at least as early as 1995, or that Applicant's use of the mark will lead to confusion. Whether Opposer was properly assigned a prior registration for the mark is of no consequence and does not create any genuine issues of material fact for the Board's consideration.

## V. CONCLUSION

In light of the foregoing, the pleadings clearly establish Opposer's priority of use and continued use, as well as the likelihood of confusion if registration of the mark is granted to Applicant. Applicant's affirmative defenses do not any genuine issues of material fact and Opposer is entitled to judgment on the substantive merits of this controversy as a matter of law.

Therefore, Opposer respectfully requests that the Board enter judgment on the pleadings pursuant to Federal Rule of Civil Procedure 12(c) and find that the registration sought by Application Serial No. 85,010,592 should be refused pursuant to § 2(d) of the Lanham Act.

Dated: June 14, 2012

Respectfully submitted,

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**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing

**OPPOSER'S MOTION FOR JUDGMENT ON THE PLEADINGS**

has been served on Robert R. Strack, counsel for Applicant Campo de' Fiori, LLC, by mailing said copy on June 14, 2012, via electronic mail to: [rrstracklaw@optonline.net](mailto:rrstracklaw@optonline.net).

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