

**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

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

I am the owner of Applicant Campo de' Fiori, LLC and wish to personally respond to the Motion for Judgment on the Pleadings presented by Opposer, I Matti Ristorante, Inc. ("Matti"). I have filed this Response personally because I have discharged my attorney, Mr. Robert R. Strack.

I am forced to take this action because it has not been possible to reach a reasonable agreement with Matti that will protect my rights to the use of my trademark. Discussions with Matti's counsel have been fruitless and appear to have been prolonged in an attempt to force me to accept an Agreement that would yield only limited and unprotected rights to use my trademark. A copy of the Agreement proposed by Matti is attached as Exhibit A.

My mark is a combination of a unique logo depicting basil, mozzarella and a tomato with an integral banner containing the words "Campo de' Fiori". I have come to America from Rome, Italy. Campo de' Fiori is an existing historic plaza in Rome. A principal product of my Brooklyn, N.Y. pizzeria is Roman pizza baked with dough unique to Rome.



I developed my trademark after personally examining the public records of the Trademark Office and determining that the word mark CAMPO DE FIORI had been abandoned when the original owner failed to claim continuous use; and that a prior application for registration by Matti had been abandoned.

Over a year-and-a-half ago, after having my mark accepted by the Trademark Examiner, Matti filed an opposition and demanded that I sign a Concurrent Use Agreement that they had prepared. It was not fair. I have spent much time and money trying to get a fair agreement and cannot afford to spend more.

Matti indicates that my priority filing does not provide me with the right to register my trademark because of the eighteen years it has used the words CAMPO DE FIORI as the name of its restaurant in Colorado. I understand that this may permit Matti to continued use of the name in Colorado, but I don't believe that it should prevent my registration.

The history of Matti's activity in connection with use of the words CAMPO DE FIORI reveals that it has on numerous occasions forfeited any claim to continuity, proprietary interest, or the right to register the mark CAMPO DE FIORI.

The pleadings and record show that Matti had previously sought to have the original Trademark for CAMPO DE FIORI cancelled. It failed. Matti filed its own first application for registration of CAMPO DE FIORI. This first application was abandoned. Matti solicited and operated under a Concurrent Use Agreement with the original Trademark owner. Matti obviously did not actively pursue its role under this Concurrent Use agreement. It failed for over a year to notice

when the mark lapsed for inability to claim continuous use. Matti secured an assignment of the lapsed original trademark following the Trademark owner's bankruptcy. I understand that it acquired no proprietary rights by this assignment. Matti filed a second application for registration of the words CAMPO DE FIORI. It had this second application suspended based upon my earlier filed application.

NOW Matti seeks, with this Opposition Proceeding, to force me to forfeit rights to which I am entitled, and to prevent me from adequately protecting my mark from competitors. AND, with this Motion for Judgment on the Pleadings, Matti seeks to impose more cost and uncertainty regarding the use of my mark to force acceptance of a Concurrent Use Agreement that will not assure protection of my proprietary interests.

Matti contends that the use of my mark, which includes the name of the Italian plaza Campo de' Fiori, will confuse a national market into thinking that my Roman cuisine is provided from the same source as that of its restaurant in Colorado. In fact, my mark includes a reference to the plaza by use of the appropriate Italian expression de' as opposed to the DE forming a part of the prior registered word mark and the mark now allegedly being used by Matti.

Matti's only use of the words CAMPO DE FIORI relates to a restaurant in the State of Colorado. While I understand that a restaurant may be considered to be involved in Interstate Commerce, it is not self-evident that the customers of my Roman cuisine Pizzeria in Brooklyn would think that my Logo with its integral use of the Italian place name, Campo de' Fiori, would indicate a common

source with a restaurant in Colorado using the anglicized words CAMPO DE FIORI.

There is no evidence that the logo in my mark depicting basil, mozzarella and a tomato has ever been used by others, nor is it reasonable to suggest that this depiction along with the name of an historic Italian plaza would confuse customers being served in a restaurant in Colorado.

I understand that this tribunal is not concerned with whether or not the words CAMPO DE FIORI may be trademarked by Matti. Rather, it is concerned with whether my mark is appropriate for registration. My application was filed first. My mark is distinctive. There is no likelihood of confusion.

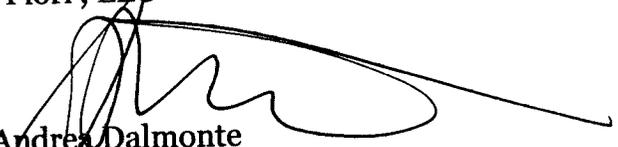
I believe that Matti's Motion for Judgment on the pleadings should be denied.

Respectfully submitted,

Campo de' Fiori, LLC

Dated: *August 15th, 2012*

By:


/s/ Andrea Dalmonte
President

187 5th Avenue

Brooklyn NY 11217-1503

Phone: 347-821-0755

Email: andrea.dalmonte@gmail.com

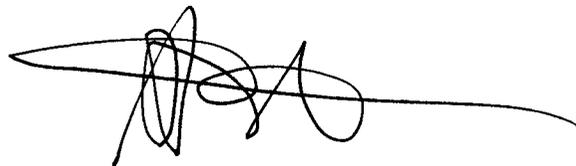
CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing
**RESPONSE TO OPPOSER'S MOTION FOR JUDGMENT ON THE
PLEADINGS** has been served on Gabriel I. Opatken, counsel for Opposer I
Matti Ristorante, Inc., by forwarding said copy on August 1st, 2012 via electronic
mail to:

gopatken@nshn.com.

Gabriel I. Opatken
Niro, Haller & Niro
181 W. Madison Street, Suite 4600
Chicago, Illinois 60602
(312) 236-0733
gopatken@nshn.com
Attorney for Opposer,
I Matti Ristorante, Inc.

Robert R. Strack, Esq.
Law Offices of Robert R. Strack
410 Jericho Turnpike, Suite 220
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(516)938-1633
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/s/Andrea Dalmonte
President
Campo de' Fiori, LLC
187 5th Avenue
Brooklyn NY 11217-1503
Phone: 347-821-0755
Email: andrea.dalmonte@gmail.com

CONCURRENT USE AGREEMENT

This Concurrent Use Agreement (“Agreement”) made this ___ day of March, 2012, between I MATTI RISTORANTE, INC. (“Matti”), a corporation incorporated under the laws of the State of Colorado and CAMPO DE’ FIORI LLC (“Fiori”), a limited liability company organized under the laws of the State of New York.

RECITALS:

WHEREAS, Fiori is the applicant for a trademark for the words CAMPO DE’ FIORI in conjunction with an image comprising basil, garlic and tomato (the “Fiori Mark”) for restaurant, bar and catering services – Serial No. 85,010,592;

WHEREAS, the Fiori Mark includes an image comprising basil, garlic, and tomato only (for clarification, the image alone, not including the words “Campo de’ Fiori,” is defined herein as the “Fiori Logo”);

WHEREAS, Matti has been continuously using the trademark CAMPO DE FIORI (the “Matti Mark”) since October 14, 1994 to identify its restaurant and bar services and is the applicant for the Matti Mark for its restaurant and bar services – Serial No. 85,110,181;

WHEREAS, said words in the Fiori Mark are identical in sound and meaning to the Matti Mark and identical in appearance such that it is likely to cause confusion as to the source of the goods and services provided; and

WHEREAS, Matti and Fiori have reached an agreement which would allow use of the Matti Mark by Matti and use of the Fiori Mark by Fiori, in limited geographic areas pursuant to this Agreement.

EXHIBIT A

NOW, THEREFORE, it is mutually agreed as follows:

1. Fiori hereby agrees to withdraw its currently pending application for the registration of the Fiori Mark with the United States Patent and Trademark Office (the "USPTO"), currently published for opposition in the Official Gazette.

2. Matti hereby agrees to not contest Fiori's registration of, and/or rights to, the Fiori Logo. For clarification, the Fiori Logo SHALL NOT include the words "Campo de' Fiori," or any similar derivation thereof.

3. Matti hereby agrees to pursue registration of the Matti Mark until such registration is granted and maintain the registration of the Matti Mark thereafter.

4. Fiori hereby agrees to not contest Matti's registration of and/or rights to the Matti Mark.

5. Matti hereby agrees to file this Agreement with the USPTO in conjunction with its currently pending application for the registration of the Matti Mark.

6. Matti hereby agrees that Fiori shall have the exclusive right to use the Fiori Mark in association with its restaurant, bar and catering business or businesses located or to be located in:

- a. the State of New York,
- b. the State of New Jersey,
- c. the State of Connecticut,
- d. the State of Rhode Island and Providence Plantations,
- e. the Commonwealth of Massachusetts, and

f. the state of Vermont;

in accordance with, and provided Fiori is not in breach of, the terms and conditions of this Agreement.

7. Fiori hereby agrees that Matti shall have the exclusive right to use the Matti Mark in association with its restaurant and bar business or businesses located in or to be located in:

- a. the State of Alabama,
- b. the State of Alaska,
- c. the State of Arizona,
- d. the State of Arkansas,
- e. the State of California,
- f. the State of Colorado,
- g. the State of Delaware,
- h. the State of Florida,
- i. the State of Georgia,
- j. the State of Hawaii,
- k. the State of Idaho,
- l. the State of Illinois,
- m. the State of Indiana,
- n. the State of Iowa,
- o. the State of Kansas,
- p. the Commonwealth of Kentucky,
- q. the State of Louisiana,
- r. the State of Maine,

- s. the State of Maryland,
- t. the State of Michigan,
- u. the State of Minnesota,
- v. the State of Mississippi,
- w. the State of Missouri,
- x. the State of Montana,
- y. the State of Nebraska,
- z. the State of Nevada,
- aa. the State of New Hampshire,
- bb. the State of New Mexico,
- cc. the State of North Carolina,
- dd. the State of Ohio,
- ee. the State of Oklahoma,
- ff. the State of Oregon,
- gg. the Commonwealth of Pennsylvania,
- hh. the State of South Carolina,
- ii. the State of South Dakota,
- jj. the State of Tennessee,
- kk. the State of Texas,
- ll. the State of Utah,
- mm. the Commonwealth of Virginia,
- nn. the State of Washington,
- oo. the State of West Virginia,
- pp. the State of Wisconsin,

- qq. the State of Wyoming,
- rr. the District of Columbia, and
- ss. the United States Territory of Puerto Rico;

in accordance with, and provided Matti is not in breach of, the terms and conditions of this Agreement.

8. The parties agree that, with the exception of Arizona, Colorado, California, Illinois, Nevada and Texas (which states shall belong exclusively to Matti regardless of presence), if Fiori has a bona fide intent to open a restaurant or bar in another state enumerated in Paragraph 7, and if Fiori takes affirmative steps to open a restaurant or bar in said other state, Fiori shall be entitled to exclusive use of the Fiori Mark in said state, provided that Matti has not already commenced operations in said state.

9. Matti acknowledges that Fiori has an interest in assuring that its goodwill and reputation associated with its name and trademark are maintained. Therefore, Matti agrees that at all times during the term of this Agreement, Matti shall ensure that the products produced and services rendered by all of Matti's restaurants, businesses, and other operations bearing the Matti Mark shall be consistent with the quality of its products produced and services rendered bearing the Matti Mark as of the date of this Agreement. Fiori acknowledges that the quality of the products produced and services rendered by Matti bearing the Matti Mark as of the date of this Agreement is satisfactory.

10. Fiori acknowledges that Matti has an interest in assuring that its goodwill and reputation associated with its name are maintained. Therefore, Fiori agrees that at all times during the term of this Agreement, Fiori shall ensure that the products produced and services

rendered by all of its restaurants, businesses, and other operations bearing the Fiori Mark shall be consistent with the quality of Fiori's products produced and services rendered bearing the Fiori Mark as of the date of this Agreement. Matti acknowledges that the quality of the products produced and services rendered by Fiori bearing the Fiori Mark as of the date of this Agreement is satisfactory.

11. Upon the reasonable request of Fiori, Matti shall allow Fiori, or its duly authorized representatives, to sample the products produced and services rendered by Matti's businesses bearing the Matti Mark for the purpose of ascertaining or determining compliance with the quality standards set forth in Paragraph 9, provided that such sampling occurs at the location of one of Matti's businesses bearing the Matti Mark or another agreed upon location.

12. Upon the reasonable request of Fiori, Matti shall submit to Fiori, or its duly authorized representatives, samples of any advertising and promotional materials bearing the Matti Mark for the purpose of ascertaining or determining compliance with the quality standards set forth in Paragraph 9. Approval of advertising and promotional materials shall not be unreasonably withheld by Fiori.

13. Upon the reasonable request of Matti, Fiori shall allow Matti, or its duly authorized representatives, to sample the products produced and services rendered by Fiori's businesses bearing the Fiori Mark for the purpose of ascertaining or determining compliance with the quality standards set forth in Paragraph 10, provided that such sampling occurs at the location of one of Fiori's businesses bearing the Fiori Mark or another agreed upon location.

14. Upon the reasonable request of Matti, Fiori shall submit to Matti, or its duly authorized representatives, samples of any advertising and promotional materials bearing the Fiori Mark for the purpose of ascertaining or determining compliance with the quality standards set forth in Paragraph 10. Approval of advertising and promotional materials shall not be unreasonably withheld by Matti.

15. Fiori assumes no liability with respect to the products produced or services rendered by Matti in association with the Matti Mark and Matti shall indemnify and save Fiori for all claims of third persons arising out of Matti's products or services associated with the Matti Mark.

16. Matti assumes no liability with respect to the products produced or services rendered by Fiori in association with the Fiori Mark and Fiori shall indemnify and save Fiori for all claims of third persons arising out of Fiori's products or services associated with the Fiori Mark.

17. The obligations of Fiori and Matti set forth in this Agreement shall exist for only so long as either Fiori or Matti continue to use the Fiori Mark or Matti Mark in their respective businesses. Should either Fiori or Matti discontinue use of the Fiori Mark or Matti Mark for a continuous period of two (2) years, both Fiori and Matti shall be relieved of all obligations set forth in this Agreement.

18. It is in the interests of both Matti and Fiori to prevent any likelihood of confusion that may potentially arise from the concurrent use of the Matti Mark and Fiori Mark by each of the parties in their respective geographical areas as set forth in Paragraphs 6, 7 and 8 of this

Agreement. Therefore, the parties agree that they will not advertise in each other's territory, but if spillover advertising should occur, then the parties will take appropriate action to avoid any likelihood of confusion, such as by use of a disclaimer that specifically states that the parties are separate entities that have no affiliation or association or by other appropriate means.

19. Matti acknowledges Fiori's right, title, and interest in and to its name and the Fiori Mark for the locations identified in Paragraph 6, and Fiori acknowledges Matti's right, title, and interest in and to its name and the Matti Mark for the locations identified in Paragraph 7 (subject to the provisions of Paragraph 8), and neither party will at any time do or cause any act or thing contesting or in any way impairing or tending to impair any part of the right, title, and interest of the other.

20. Matti and Fiori agree to their continued use of the domain names, "campodefiori" and "pizzacampodefiori," respectively.

21. Matti agrees that Fiori may continue use of the Fiori Logo appearing in Trademark Application Serial No. 85,010,592.

22. Should either party having rights to the mark "CAMPO DE FIORI," or any mark that may be deemed confusingly similar thereto, abandon said rights, it will notify the other party and offer said other party right of first refusal to use the "CAMPO DE FIORI" mark exclusively throughout the United States.

23. In the event this Agreement fails to be accepted by the TTAB and/or the Trademark Office, as a suitable resolution of the present Opposition Proceeding or of the current

grounds for suspending prosecution of Trademark Application Serial No. 85,110,181, the parties agree to accept reasonable and appropriate modifications to effect said resolution.

24. Any notices required or permitted to be given under this Agreement shall be deemed sufficiently given if sent by prepaid courier, facsimile or electronic mail to the party to be notified at its address below, or to such other address as may be furnished in writing by such party to the notifying party:

a. In the case of Fiori:

Law Offices of Robert R. Strack
410 Jericho Turnpike, Suite 220
Jericho, NY 11753
Facsimile: (516) 942-3758
E-Mail: rrstracklaw@optonline.net

b. In the case of Matti:

Raymond P. Niro
Niro, Haller & Niro, Ltd.
181 West Madison Street, Suite 4600
Chicago, IL 60602
Facsimile: (312)236-3137
E-Mail: gopatken@nshn.com

25. Because it is a central location for the parties, this Agreement shall be interpreted in accordance with the laws of the State of Illinois, irrespective of its rules concerning conflicts

of laws. The parties agree to submit themselves to the jurisdiction of the United States District Court for the Northern District of Illinois to resolve any conflict relating to the subject matter of this Agreement.

26. Any changes or alterations to this Agreement must be provided in writing and agreed upon by both Fiori and Matti in writing.

27. This is the entire agreement between the parties concerning its subject matter and supersedes all prior negotiations and agreements, oral or written. There are no other contemporaneous agreements between the parties relating to the subject matter hereof.

28. This Agreement is not assignable by either party without the consent of the other party.

29. This Agreement may be executed by the parties in separate counterparts and exchanged by facsimile, with the same effect as if all parties had signed the same instrument.

WHEREFORE, the parties hereby acknowledge their agreement and consent to the terms and conditions set forth above through their respective signatures as contained below:

I MATTI RISTORANTE, INC.

CAMPO DE' FIORI LLC

By: _____

By: _____

Its: Vice President

Its: Owner

Date: _____

Date: _____