

**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	:	
Filing Date: April 9, 2010	:	
Publication Date: Dec. 14, 2010	:	Opposition No. 91197819

I MATTE RISTORANTE, INC.	:	APPLICANT'S MOTION TO
	:	DISMISS OPPOSITION
Opposer	:	PURSUANT TO OPPOSER'S
	:	FAILURE TO STATE A CLAIM
CAMPO DE' FIORI, LLC	:	AGAINST APPLICANT UPON
	:	WHICH RELIEF MAY BE
Applicant	:	GRANTED

Trademark Trial and Appeal Board

1. Applicant Campo De' Fiori, Inc. ("Applicant") pursuant to Federal Rule of Civil Procedure 12(b)(6) and TBMP §503 et seq., respectfully moves the Board for an Order dismissing this Opposition proceeding based upon the failure of Opposer I Matte Ristorante, Inc. ("Opposer") to state a claim against Applicant upon which relief may be granted.

2. Applicant's Intent-to-Use mark Campo de' Fiori, covered by application Serial No. 85,010,592 was published December 14, 2010. Opposer does not have a registered mark; but has currently suspended application Serial No. 85,110,181, that was filed on August 18, 2010.

3. In support of its Motion to Dismiss, Applicant states as follows:



**03-29-2011**

## **This Opposition Should Be Dismissed**

### **Background**

4. 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 including green basil, a white mozzarella cheese and a red tomato. The words Campo de' Fiori may be translated from Italian as "field of flowers". These words also conjure up an historic and familiar plaza in Rome.

5. The expression Campo de' Fiori, with or without capitalization or use of an apostrophe after "de", is distinctive in its representation of Applicant's restaurant business which concentrates on food and food preparation finding its genesis in Rome. Use of the expression by the Opposer in the same field as Applicant would cause confusion and damage Applicant's trade and operation.

6. In good faith, before filing the subject application for Intent-to-Use the mark Campo de' Fiori, Applicant searched the available records and determined that there was no prior active registration of "Campo De Fiori" in any relevant International Class. At that time it was noted that Registration No. 2,348,945, filed on June 20, 1997 by Campo De Fiori, Inc. - no relation to the Applicant- had been cancelled for failure to file the necessary Section 8 Declaration of Continued Use. In addition, it was noted that application Serial No. 76,471 had been filed and abandoned by Opposer. Based upon this investigation, it was conclude that the mark Campo de' Fiori was available for registration and use in the restaurant business that Applicant proposed to commence.

7. 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.

8. The Trademark Office confirmed Applicant's understanding regarding the absence of any extant mark that was confusingly similar to Campo de' Fiori, and approved the application for Publication on December 14, 2010.

9. The consequent opening and on-going activity of Applicant's restaurant has been recognized by reviews in the New York Times and Village Voice, both prestigious publications with national distribution.

**OPPOSER DOES NOT POSSESS THE STANDING REQUIRED TO  
BRING THIS OPPOSITION PROCEEDING BEFORE THE  
TRADEMARK TRIAL AND APPEAL BOARD,**

10. Opposer does not possess the standing required to bring this Opposition Proceeding before the Trademark Trial and Appeal Board, and, as a result, is unable to state a claim upon which relief may be granted. In consideration of Opposer's lack of legal standing, the present Opposition proceeding should be dismissed with prejudice.

11. To have the necessary standing to bring an Opposition Proceeding before the Trademark Trial and Appeal Board, Opposer must have a right of priority as well as an actual right and/or interest in a valid trademark/service mark such that it would be

capable of possessing the belief that it would be harmed should the registration of Applicant's trademark be granted.<sup>1</sup>

**OPPOSER'S LACK A RIGHT OF PRIORITY IN THE MARK  
CAMPO DE FIORI PREVENTS IT FROM HAVING THE  
NECESSAARY LEGAL STANDING TO BRING THIS PROCEEDING**

12. The history of Opposer's activity demonstrates that on multiple occasions it has failed to act with due diligence and has abandoned attempts to register the Campo De Fiori mark. Chronologically:

- Another party obtained Registration No. 2,348,945 for the mark Campo de Fiori in May 9, 2000;
- Opposer filed its own application Serial No. 26,471,175 for the mark Campo De Fiori on November 29, 2002;
- Opposer entered into a Concurrent Use Agreement with the owner of Registration No. 2,348,945 on or about February 2004;
- Opposer abandoned it's own application Serial No. 26,471,175 on or about February 2004;
- Though Opposer asserts having been in business continuously for almost 17 years, Registration 2.348,945 for which Opposer had rights under a Concurrent Use Agreement was cancelled for failure to file a Section 8 Declaration of Continued Use as of May 9, 2006;
- Opposer was did not arrange assignment of Registration 2.348,945 (by a Bankruptcy Trustee) until over a year had elapsed following cancellation of the registration, i.e. until May 14, 2007;

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<sup>1</sup> 15 U.S.C. §1127 (2005); 15 U.S.C. 1057© (2005); and 37 C.F.R. §2.111(b)(2007)

- Applicant filed the subject Application Serial No. 85,010,592 for Intent –to – Use the mark Campo de’ Fiori on April 9, 2010;
- Opposer did not file its second application Serial Number 85,110,181 for the mark CAMPO DE FIORI for over three years after the cancellation of original Registration 2.348,945, and more than four months after Applicant’s filing, i.e. on August 18, 2010;
- The subject application Serial No. 85,010,592 was published December 14, 2010
- This Opposition was filed December 14, 2010.

13, It is clear that Opposer does not have a priority right to registration based upon ownership or legal consanguinity with the original registrant of the CAMPO DE FIORI mark. It is clear that Opposer abandoned its application for its own rights to the CAMPO DE FIORI mark on or about seven years ago. It is clear that Opposer did not obtain rights to a registered mark when it arranged and accepted the Assignment of the cancelled mark over three years ago. It is clear that Opposer’s second application for registration was filed over four months after Applicant filed its Intent-to-Use application.

**OPPOSER’S LACK OF AN ACTUAL RIGHT AND/OR INTEREST IN A VALID TRADEMARK/SERVICE MARK PREVENTS IT FROM HAVING THE NECESSAARY LEGAL STANDING TO BRING THIS PROCEEDING**

14. Opposer’s currently suspended application Serial No. 85,110,181 was not filed until after Applicant’s Intent–to-Use application and is not entitled to claim antecedent basis from assignment of the previously cancelled Registration No.2,348,945.

15. Upon information and belief, and as confirmed by the Opposer’s Notice of Opposition, Opposer is not the applicant of the original Campo De Fiori Registration No. 2,348,945. Opposer suggests a right to ownership of the mark through a February 27,

2007 assignment (from a Trustee in Bankruptcy) after Registration 2,348, 945 been cancelled., but this does not support a dating prior to the date on which it has filed application Serial No. 85, 110, 181.

16. Opposer claims to have been in business in Colorado using the mark CAMPO DE FIORI for almost 17 years; but this does not establish priority for its later filed application Serial No. 85,110,181 over Applicant's application, nor its right and/or interest in a valid trademark/service mark

**OPPOSER CANNOT BELIEVE THAT IT WOULD  
BE HARMED SHOULD THE REGISTRATION OF  
APPLICANT'S TRADEMARK BE GRANTED.**

17. Opposer notes that it has been in business in Colorado since 1994 and that during that time it has opened several establishments in Colorado. Throughout this time it has never opened business establishments in any other State. It is noted that Opposer's many Exhibits fail to disclose recent interstate activity. It would appear that Opposer would be able to continue use of the name Campo de Fiori in Colorado, irrespective of Applicant's registration of the mark. Consequently, Opposer will not be harmed by Applicant's registration of the subject mark.

18. Whatever rights Opposer may have to use the business name of CAMPO DE FIOIRI in Colorado, it does not have the necessary right to register the Trademark Campo de Fiori in preference to Applicant nor to deny Applicant the right register and use the mark for which it has priority as a result of its early filing.

**CONCLUSION**

19. Opposer's abandonment, many years ago, of its own application for the mark CAMPO DE FIORI; Opposer's failure to obtain ownership by assignment of the

registered mark CAMPO DE FIORI until after it had been cancelled; Opposer's failure and lack of diligence in pursuing registration of the mark CAMPO DE FIORI, after said assignment; and Opposer's failure to file its second application for the mark CAMPO DE FIORI until after the filing of Applicant's Intent-to-Use application, all preclude it from participation in this Opposition proceeding and support this Applicant's Motion to Dismiss with prejudice

Dated March 24, 2011



Respectfully submitted,

Campo de' Fiori, LLC

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I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:  
Commissioner for Trademarks,  
P.O. Box 1451, Alexandria, VA  
22313-1451

On March 24, 2011



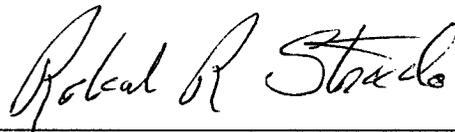
Robert R. Strack

**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing Applicant's Motion to Dismiss Opposition Pursuant to Opposer's Failure to State a Claim Against Applicant Upon Which Relief May be Granted has been served on Raymond P. Niro by forwarding said copy on this 24<sup>th</sup> day of March, 2011, via First Class U.S. mail to:

Raymond P. Niro  
NIRO, HALLER & NIRO  
181 W. Madison Street, Suite 4600  
Chicago, Illinois 60602

Date March 24, 2011



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Robert R. Strack  
Attorney for Applicant