

ESTTA Tracking number: **ESTTA402109**

Filing date: **04/06/2011**

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

Proceeding	91197819
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Date	04/06/2011
Attachments	opp.brief.mot.dismiss.pdf (11 pages)(53525 bytes)

**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 BRIEF IN OPPOSITION TO APPLICANT'S
MOTION TO DISMISS FOR FAILURE TO STATE A CLAIM**

I. INTRODUCTION AND RELEVANT BACKGROUND

Applicant seeks dismissal of this Opposition based on its claim that I Matti Ristorante, Inc. ("Opposer") does not have standing to bring this action before the Trademark Trial and Appeal Board. But, Applicant's motion fails to recognize that trademark rights derive from continuous use of a mark in interstate commerce regardless of Federal registration.

Applicant's motion (after two extensions to answer and a three-month delay), mischaracterizes applicable law and fails to recognize that facts pleaded in Opposer's Notice of Opposition must be accepted as true. Those facts clearly establish the requisite standing to bring this action. Further, Applicant's motion seeks the extreme remedy of dismissal with prejudice, despite Opposer's compliance with the applicable rules and the Board's preference to allow amendment.

For the reasons cited below, Opposer hereby requests that this Board deny Applicant's motion to dismiss for failure to state a claim upon which relief may be granted.

II. LEGAL STANDARD

“A motion to dismiss for failure to state a claim upon which relief can be granted is a test solely of the legal sufficiency of a complaint.” TBMP § 503.02 (last updated 03/12/2004); citing Advanced Cardiovascular Systems, Inc. v. SciMed Life Systems, Inc., 988 F.2d 1157, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993) (Rule 12(b)(6) challenges the legal theory of the complaint not the sufficiency of the evidence that might be adduced).

Unlike a motion for summary judgment, a plaintiff “need not respond by submitting proofs in support of its pleading.” TBMP § 503.02. Further, “all of the plaintiff’s well-pleaded allegations must be accepted as true, and the complaint must be construed in the light most favorable to the plaintiff.” Id. Hence, “[d]ismissal for insufficiency is appropriate only if it appears certain that the plaintiff is entitled to no relief under any set of facts that could be proved in support of its claim.” Id.

The Lanham Act unambiguously identifies the requirements to oppose the registration of a trademark on the principal register:

Any person who believes that he would be damaged by the registration of a mark upon the principal register, including as a result of dilution under section 43(c) [15 USC 1125(c)], may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office, stating the grounds therefor, within thirty days after the publication under subsection (a) of section 12 of this Act [15 USC 1062] of the mark sought to be registered.

15 U.S.C. § 1063(a).

Further, the Trademark Trial and Appeal Board Manual of Procedure (“TBMP”) clearly and succinctly identifies Opposer’s obligations in filing a Notice of Opposition:

A notice of opposition must include (1) a short and plain statement of the reason(s) why opposer believes it would be damaged by the registration of the opposed mark (i.e., opposer’s standing to maintain the proceeding (see TBMP §§ 303.03 and 309.03(b)), and (2) a short and plain statement of one or more grounds for opposition.

TBMP § 309.03(a)(2).

Thus, there are only two requirements that must be satisfied to proceed with an Opposition: (1) standing and (2) valid grounds for the opposition.

The TBMP provides that: “Any person who believes it is or will be damaged by registration of a mark has standing to file a complaint.” TBMP § 309.03(b); citing 15 U.S.C. § 1063. “At the pleading stage, all that is required [to provide standing] is that a plaintiff allege facts sufficient to show a ‘real interest’ in the proceeding, and a ‘reasonable basis for its belief of damage.’” *Id.* (citing Ritchie v. Simpson, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999)). And “[t]o plead a ‘real interest,’ plaintiff must [only] allege a ‘direct and personal stake’ in the outcome of the proceeding. *Id.* The allegations in support of plaintiff’s belief of damage must have a reasonable basis ‘in fact.’” *Id.* However, “there is no requirement that actual damage be pleaded or proved in order to establish standing or to prevail in an opposition.” *Id.*; see also TBMP § 303.03.

Beyond the requirement that the opposer have standing to maintain the Opposition Proceeding, “a plaintiff must also plead (and later prove) a statutory ground or grounds for opposition.” TBMP § 309.03(c). The TBMP sets forth several available grounds for opposition including Section 2(d) of the Act, 15 U.S.C. § 1052(d), which establishes as an appropriate ground for opposition, that defendant’s mark so resembles a mark “previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods or services of the defendant, to cause confusion, or to cause mistake, or to deceive.” *Id.* (citing Opryland USA Inc. v. The Great American Music Show Inc., 970 F.2d 847, 23 USPQ2d 1471, 1473 (Fed. Cir. 1992)); see also 15 U.S.C. § 1052(d). Other available grounds for opposition include dilution of the distinctive quality of the opposer’s mark. TBMP § 309.03(c).

To satisfy a pleading based on 15 U.S.C. § 1052(d), a plaintiff must assert that the defendant’s mark so resembles plaintiff’s previously used mark as to be likely to cause confusion, mistake or deception. *Id.* Further, the plaintiff must “allege facts showing proprietary

rights in its pleaded mark that are prior to defendant's rights in the challenged mark." *Id.* Such rights may be shown by evidence of prior trademark or service mark *use*. *Id.* (emphasis added).

In this case, all of this has been done.

III. ARGUMENT

A. Opposer's Notice of Opposition Includes a Short and Plain Statement of the Reasons Why Opposer Believes it Would be Damaged by the Registration of the Opposed Mark

In its Notice of Opposition, Opposer identifies a "real interest" in this opposition proceeding and a "reasonable basis for its belief of damage." Opposer properly pleaded a "direct and personal stake" in the outcome of the proceeding and its allegations in support of its belief of damage have a reasonable basis in fact.

Applicant argues that Opposer lacks an actual right or interest in a valid trademark in an effort to establish lack of standing in the present action (Motion to Dismiss, ¶¶ 14-16). Again, Applicant mischaracterizes applicable law. Even if Opposer did not have an interest in the mark at dispute, which it does, the law requires that Opposer have a "real interest" in the proceedings, not an actual right in the mark at dispute. See TBMP § 309.03(b). More importantly, Applicant fails to recognize Opposer's common law trademark rights that were maintained through Opposer's continuous use of the mark CAMPO DE FIORI (the "Senior Mark") in interstate commerce for 16 years. Applicant further appears to make arguments inappropriate for a 12(b)(6) motion in asserting that Opposer's use of the mark was limited to Colorado, and that Opposer has never opened any establishments in any other state (Mot. to Dismiss at ¶ 17). Of course, those arguments are completely undermined by Opposer's Notice of Opposition which cites to and attaches articles from national publications, including *USA Today*, which demonstrate Opposer's use and prominence throughout the United States (Notice of Opposition, ¶ 7; see also Notice of Opposition, Exhibit A). Opposer will not address evidentiary matters outside of the scope of the pleadings as to do so would be inappropriate on a motion to dismiss.

If Applicant wishes to file a motion for summary judgment, Opposer is prepared to address evidentiary issues at that time with the necessary declarations and other evidentiary support.

Despite Applicant's mischaracterizations, Opposer's Notice of Opposition clearly contains a short and plain statement that demonstrates a "real interest" in this proceeding. Opposer's Notice of Opposition asserts, in pertinent part, that "[f]or more than 16 years, and prior to any 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" (Notice of Opp'n at ¶ 1). Further, "Opposer has invested substantial time, effort and money in promoting and maintaining the value of the CAMPO DE FIORI mark." *Id.* "As a result, the mark has become distinctive of Opposer's goods and has come to represent enormous goodwill for Opposer." *Id.* That is sufficient to demonstrate a "real interest" and a "direct and personal stake in the outcome of this opposition." See Guantanamo Cigar Co. v. Corporacion Habanos, S.A., Civ. No. 08-0721 (D.C. August 5, 2010) (finding standing where Opposer had a pending application for a United States trademark for the same mark and sold goods labeled with the same mark in other countries); see also Ritchie, 170 F.3d 1092 (finding standing where Opposer was a "family man" who believed the marks were threatening to family values).

With respect to Opposer's pending application, the Notice of Opposition asserts that "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" (Notice of Opp'n at ¶ 14). Most importantly, the Notice of Opposition asserts that "Opposer's application was suspended on December 6, 2010 pending the disposition of Applicant's Application Serial No. 85,010,592 [the application subject to this opposition]." *Id.* That alone shows the "real interest" of Opposer.

The TBMP recognizes the Trademark Office's action as evidence of a proper pleading applicable to the present circumstances:

A real interest in the proceeding and a reasonable belief of damage may be found, for example, where plaintiff pleads (and later proves): A claim of likelihood of confusion that is not wholly without merit; Plaintiff has been refused registration of its mark because of defendant's registration, or *has been advised that it will be refused registration when the defendant's application matures into a registration, or has a reasonable belief that registration of its application will be refused because of defendant's registration.*"

Id. (emphasis added).

Registration in the name of Applicant of the mark CAMPO DE' FIORI ("the Junior Mark") on the principal register and use of the Junior Mark by Applicant will likely lead not only to confusion, but also to dilution of Opposer's distinctive Senior Mark (See Notice of Opp'n at ¶ 17). Further, as Opposer asserted, "the public is likely to incorrectly associate the goods and services offered by Applicant...with Opposer or Opposer's goods and services" (Notice of Opp'n at ¶ 16). Likewise, "the public is likely to incorrectly believe that Applicant's [g]oods and services are sponsored, endorsed, or licensed by Opposer." Id. In light of the substantial similarities of the marks, as the Notice of Opposition clearly asserts, "Opposer will be damaged by the registration of the mark CAMPO DE' FIORI to Applicant" (Notice of Opp'n at p. 4). And, Applicant itself admits that use of the mark in the same field (restaurants) "would cause confusion and damage" (Mot. to Dismiss at ¶ 5).

In short, there is a real interest and a belief in damages that have a reasonable basis in fact. That is enough to establish standing.

B. Opposer's Notice of Opposition Also Includes a Short and Plain Statement of One or More Grounds for Opposition

In its Notice of Opposition, Opposer properly pleaded a valid statutory ground for opposition, namely Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d). In order to properly assert a claim pursuant to Section 2(d) of the Lanham Act, Opposer was only required to assert that Applicant's mark, "as applied to its goods or services, so resembles plaintiff's *previously used or registered mark* or its previously used trade name as to be *likely to cause confusion.*"

TBMP § 309.03(c) (emphasis added). Here, the marks are identical. Opposer properly pleaded (1) priority of use and (2) that Applicant's Junior Mark is identical to Opposer's Senior Mark such that it is likely to cause confusion – a fact Applicant itself admits (Mot. to Dismiss at ¶ 5).

In arguing that Opposer lacks a right of priority, Applicant argues that “[t]he 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” (Mot. to Dismiss at ¶ 12). This is irrelevant and not properly considered on a 12(b)(6) motion to dismiss. But, even if relevant, it does not take into account that Opposer has in fact used the Senior Mark continuously since October 14, 1994. Opposer's allegations of continuous use in commerce stand undisputed.

Opposer's Notice of Opposition states, in pertinent part, that “[f]or more than 16 years, and prior to any 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” (Notice of Opp'n at ¶ 1). Furthermore, “Opposer has continuously used the mark CAMPO DE FIORI in connection with bar and restaurant services in interstate commerce since its date of first use in commerce on October 14, 1994” (Notice of Opp'n at ¶ 4). Opposer attached articles from national publications which unquestionably support that allegation (Id., Exhibits A-C).

In contrast to Opposer's sixteen years of actual and continuous use, Applicant has only just recently expressed an intention to use the disputed mark: “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” (Notice of Opp'n at ¶ 15) (emphasis added). Further, Opposer pleaded on information and belief that “Applicant only first began using the mark in commerce in mid-July, 2010.” Id. That is nearly sixteen years after Opposer's undisputed first use in commerce.

Applicant argues 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,” that “Opposer abandoned its application for its own rights to the CAMPO DE FIORI MARK on or about seven years ago,” 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,” and that “Opposer’s second application for registration was filed over four months after Applicant filed its Intent-to-Use application” (Mot. to Dismiss at ¶ 13). Applicant’s arguments regarding priority are wholly without merit and fail to recognize that *use*, not registration, is sufficient to establish common law trademark rights and priority sufficient to withstand a Rule 12(b)(6) motion.

Hence, despite Applicant’s misplaced arguments, it is evident that Opposer properly pleaded priority of *use*, which clearly satisfies the first prong of establishing a claim under Section 2(d) of the Lanham Act. See Herbko Int’l, Inc. v. Kappa Books, Inc., 308 F.3d 1156, 1162 (Fed. Cir. 2002) (priority in a mark for purposes of cancellation [or opposition] under 15 U.S.C. § 1052(d) may arise from prior trademark or service mark *use*).

The Notice of Opposition also shows that Applicant’s Junior Mark so resembles Opposer’s previously used mark as to be likely to cause confusion, mistake or deception. See TBMP § 309.03(c). In its Notice of Opposition, Opposer asserts:

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 provided under Opposer’s mark.

(Notice of Opp’n at ¶ 16).

In fact, this issue is clearly not in dispute as Applicant’s 12(b)(6) motion admits that Applicant’s Junior Mark is confusingly similar to Opposer’s Senior Mark: “Use of the expression [Campo de Fiori] by the Opposer in the same field as Applicant would cause confusion and damage Applicant’s trade and operation” (Mot. to Dismiss at ¶ 5).

Opposer's Notice of Opposition properly pleaded (and Applicant does not dispute) that Applicant's Junior Mark so resembles Opposer's previously used mark as to be likely to cause confusion, mistake or deception. Thus, in light of the foregoing, Opposer has pleaded a valid ground for opposition, namely Section 2(d) of the Lanham Act, and Applicant's motion to dismiss should be denied.

C. Applicant's Requested Relief is Unreasonable

Applicant seeks unreasonable relief in its Rule 12(b)(6) motion to dismiss in asserting that "the present Opposition proceeding should be dismissed *with prejudice*" (Mot. to Dismiss at ¶ 10) (emphasis added).

Such relief would be unnecessarily extreme and out of line with justice and the guidelines set forth in the TBMP. The TBMP clearly states that a plaintiff may amend its complaint after an answer has been served (which has not yet occurred in this action) with leave of the Board, "*which is freely given when justice so requires.*" TBMP § 503.03 (emphasis added). Furthermore, if the Board finds, upon determination of a motion to dismiss, that the complaint fails to state a claim upon which relief can be granted, "the Board generally will allow the plaintiff an opportunity to file an amended pleading." *Id.*

In light of the foregoing analysis of Applicant's unmeritorious motion to dismiss, it is clear that Applicant's motion should be denied. Nonetheless, if the Board determines that Opposer's Notice of Opposition fails to sufficiently state a claim upon which relief can be granted, Opposer respectfully requests an opportunity to file an amended pleading.

D. Applicant's Motion is Nothing More Than A Delay Tactic

This is yet another in a long line of Applicant's attempts to unnecessarily delay litigation of this trademark dispute. Opposer promptly notified Applicant of its prior and continuous use of the Senior Mark in interstate commerce upon publication of Applicant's Junior Mark in the *Official Gazette*. Under the guise of settlement discussions, Applicant sought not one, but two

extensions to answer Opposer's Notice of Opposition. During the over three months of opportunity for Applicant to engage in settlement discussions with Opposer, Applicant failed to return several telephone calls and only once took any time to address settlement potential. It was only at the eleventh hour on the eve of each deadline that Applicant bothered to make any attempts at communication. Most recently, with an impending answer due on Friday, March 25, 2011, Applicant again sought to unnecessarily delay this litigation by tolling its time to answer by filing the present Rule 12(b)(6) motion to dismiss.

IV. CONCLUSION

Applicant's motion to dismiss is clearly without merit. Other than a single footnote, Applicant fails to cite any law, and that law which Applicant appears to rely upon in its arguments is completely mischaracterized and misleading. Opposer's Notice of Opposition establishes standing sufficient to maintain the present action. Opposer clearly asserts a real interest in the present proceeding and a reasonable belief that it will be damaged should Applicant's mark obtain registration on the principal register. Further, Opposer properly asserted a valid ground for opposition, namely Section 2(d) of the Lanham Act.

Therefore, Opposer, I Matti Ristorante, Inc., hereby requests that this Board deny Applicant's motion to dismiss for failure to state a claim upon which relief may be granted so that the parties may proceed in a timely manner and resolve the present trademark dispute.

Dated: April 6, 2011

Respectfully submitted,

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CERTIFICATE OF SERVICE

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

**OPPOSER'S BRIEF IN OPPOSITION TO APPLICANT'S
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has been served on Robert R. Strack, counsel for Applicant Campo de' Fiori, LLC, by mailing said copy on April 6, 2011, via electronic mail to: rrstracklaw@optonline.net.

/s/ Dean D. Niro

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