

ESTTA Tracking number: **ESTTA444186**

Filing date: **12/01/2011**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	WDI Corporation		
Entity	Corporation	Citizenship	Japan
Address	ROI Bldg. 5-5-1 Roppongi Minato-ku Tokyo, JAPAN		

Attorney information	James M. Slattery Birch, Stewart, Kolasch & Birch, LLP 8110 Gatehouse Road Suite 100E Falls Church, VA 22042 UNITED STATES mailroom@bskb.com		
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Applicant Information

Application No	85107422	Publication date	11/01/2011
Opposition Filing Date	12/01/2011	Opposition Period Ends	12/01/2011
Applicant	Juan Raul Muzquiz Garcia Alfonso Reyes #400 Local 7 Col. MisiÃ³n del Valle Garza Garcia, N.L., C.P.66237 MEXICO		

Goods/Services Affected by Opposition

Class 043. All goods and services in the class are opposed, namely: Restaurant services
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Application No.	85190968	Application Date	12/06/2010
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	RISTORANTE ITALIANO CAPRICCIOSA IN TOKYO SINCE 1978		

Design Mark	<p>Ristorante Italiano Capricciosa in Tokyo since 1978</p>
Description of Mark	NONE
Goods/Services	<p>Class 035. First use: First Use: 2010/09/15 First Use In Commerce: 2010/09/15 Franchise services, namely, offering business management assistance in the establishment and operation of restaurants</p> <p>Class 043. First use: First Use: 2010/09/15 First Use In Commerce: 2010/09/15 Restaurant services</p>

U.S. Application No.	85190978	Application Date	12/06/2010
Registration Date	NONE	Foreign Priority Date	NONE

Word Mark	RISTORANTE ITALIANO CAPRICCIOSA IN TOKYO SINCE 1978
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Design Mark	
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Description of Mark	The mark consists of the wording "RISTORANTE ITALIANO" in green and "CAPRICCIOSA IN TOKYO SINCE 1978" in red.
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Goods/Services	<p>Class 035. First use: First Use: 2010/09/15 First Use In Commerce: 2010/09/15 Franchise services, namely, offering business management assistance in the establishment and operation of restaurants</p> <p>Class 043. First use: First Use: 2010/09/15 First Use In Commerce: 2010/09/15 Restaurant services</p>
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Attachments	<p>85190968#TMSN.jpeg (1 page)(bytes)</p> <p>85190978#TMSN.jpeg (1 page)(bytes)</p> <p>2011-12-01 - NOTICE OF OPPOSITION.PDF (11 pages)(408816 bytes)</p>
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address

record by First Class Mail on this date.

Signature	/James M. Slattery/
Name	James M. Slattery
Date	12/01/2011

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

In the matter of Application No. 85/107,422
For the trademark “CAPRICCIOSAS GOURMET PIZZA WWW.CAPRICCIOSAS.COM
2005”
Published in the Official Gazette on November 1, 2011

WDI CORPORATION)	
)	
Opposer)	
)	
v.)	Opposition No.
)	
JUAN RAUL MUZQUIZ GARCIA)	
)	
Applicant.)	

NOTICE OF OPPOSITION

Opposer, WDI CORPORATION (“Opposer”), a corporation organized under the laws of Japan, with a principal place of business at Japan Rio Bldg., 5-5-1 Roppongi Minato-ku, Tokyo Japan, believes it will be damaged by the issuance of a registration for the mark “CAPRICCIOSAS GOURMET PIZZA WWW.CAPRICCIOSAS.COM 2005 and Design” (the Applicant’s mark), to a Mexican citizen with a place of residence at Alfonso Reyes #400 Local 7 Col. Misión del Valle, Garza Garcia, N.L. C.P.66237 Mexico , who has applied for the mark as set forth in Application No. 85/107,422. Opposer files this Notice of Opposition pursuant to 37 CFR §2.104(b).

1. OPPOSER, its subsidiaries, related companies for many years have advertised, marketed, sold, and otherwise offered franchise services for restaurant services under its mark “CAPRICCIOSA.”

2. On information and belief, long before Applicant's first use of "CAPRICCIOSAS GOURMET PIZZA WWW.CAPRICCIOSAS.COM 2005 and Design" mark, Opposer and its subsidiaries, related companies have continuously used the trademark "RISTORANTE ITALIANO CAPRICCIOSA IN TOKYO SINCE 1978" and "RISTORANTE ITALIANO CAPRICCIOSA IN TOKYO SINCE 1978 and Design" in commerce on and in commerce with the advertising, promotion, sale of restaurant services.

3. Opposer owns the below listed U.S. trademark applications:

A. "RISTORANTE ITALIANO CAPRICCIOSA IN TOKYO SINCE 1978" in U.S.

Application No. 85/190,968 filed on December 6, 2010, in International Classes 35 for "Franchise services, namely, offering business management assistance in the establishment and operation of restaurants and International Class 42 for Restaurant services; with a first date of use in commerce as September 15, 2010.

B. "RISTORANTE ITALIANO CAPRICCIOSA IN TOKYO SINCE 1978

(stylized)" in U.S. Application No. 85/190,978 filed on December 6, 2010, in International Classes 35 for "Franchise services, namely, offering business management assistance in the establishment and operation of restaurants and International Class 42 for Restaurant services; with a first date of use in commerce as September 15, 2010.

4. Opposer owns common law rights in the mark "RISTORANTE ITALIANO CAPRICCIOSA IN TOKYO SINCE 1978" and "RISTORANTE ITALIANO CAPRICCIOSA IN TOKYO SINCE 1978 and Design." which have been continuously, prominently, and

conspicuously in use on its restaurant services, web site, marketing and other business materials in foreign commerce between the United States and Japan since at least as early as September 19, 2010. Said common law trademark includes:

“RISTORANTE ITALIANO CAPRICCIOSA IN TOKYO SINCE 1978” and “RISTORANTE ITALIANO CAPRICCIOSA IN TOKYO SINCE 1978 and Design” used in connection with “Franchise services, namely, offering business management assistance in the establishment and operation of restaurants”, in International Class 35; and “Restaurant services” in International Class 43

5. Opposer filed an application for the mark “RISTORANTE ITALIANO CAPRICCIOSA IN TOKYO SINCE 1978” in the USPTO on December 6, 2010 in connection with “franchise services, namely, offering business management assistance in the establishment and operation of restaurants in International Class 35 under Application No. 85/190,978, based on use of the mark at least as early as September 15, 2010 in foreign commerce between Japan and the United States.

6. Opposer also filed an application for the mark “RISTORANTE ITALIANO CAPRICCIOSA IN TOKYO SINCE 1978 and Design” in the USPTO on December 6, 2010 in connection with “franchise services, namely, offering business management assistance in the establishment and operation of restaurants in International Class 35 under Application No. 85/190,968, based on use of the mark at least as early as September 15, 2010 in foreign commerce between Japan and the United States.

7. On October 19, 2011, the Examiner Issued a Notice of Suspension in Opposer’s Application No. 85/190,968, and cited Application 85/107,422 to potentially refuse the

registrations of the Opposer's "RISTORANTE ITALIANO CAPRICCIOSA IN TOKYO SINCE 1978."

8. On October 19, 2011, the Examiner Issued a Notice of Suspension in Opposer's Application No. 85/190,978, and cited Application 85/107,422 to potentially refuse the registrations of the Opposer's "RISTORANTE ITALIANO CAPRICCIOSA IN TOKYO SINCE 1978 and Design."

9. All Opposer's marks are inherently distinctive.

10. Opposer itself and through its subsidiaries, related companies have promoted, offered for sale, and conducted business with regards to restaurant services, under its "RISTORANTE ITALIANO CAPRICCIOSA IN TOKYO SINCE 1978" and "RISTORANTE ITALIANO CAPRICCIOSA IN TOKYO SINCE 1978 and Design" marks and has spent substantial sums in advertising and promoting these trademarks.

11. On August 13, 2010, Applicant filed a trademark application for the mark "CAPRICCIOSAS GOURMET PIZZA WWW.CAPRICCIOSAS.COM 2005 and Design" in connection with the following goods in International Class 43 the USPTO: "Restaurant services," based on an intent-to-use of the mark in commerce. This application corresponds to Serial No. 85/107,422 which was published for opposition on November 1, 2011.

12. Applicant's "CAPRICCIOSAS GOURMET PIZZA WWW.CAPRICCIOSAS.COM 2005 and Design" mark is likely to be confused with and mistaken for Opposer's marks "RISTORANTE ITALIANO CAPRICCIOSA IN TOKYO SINCE 1978" and "RISTORANTE ITALIANO CAPRICCIOSA IN TOKYO SINCE 1978 and Design." for restaurant services. Applicant's mark is confusingly similar in sight, sound and

commercial impression to Opposer's marks for "RISTORANTE ITALIANO CAPRICCIOSA IN TOKYO SINCE 1978" and "RISTORANTE ITALIANO CAPRICCIOSA IN TOKYO SINCE 1978 (stylized)." Applicant's and Opposer's marks share the same wording "CAPRICCIOSA."

13. Applicant's mark is intended for use in connection with services that overlap with and are related to the Opposer's marks for "RISTORANTE ITALIANO CAPRICCIOSA IN TOKYO SINCE 1978" and "RISTORANTE ITALIANO CAPRICCIOSA IN TOKYO SINCE 1978 (stylized)."

14. Applicant currently has not claimed use of the mark "CAPRICCIOSAS GOURMET PIZZA WWW.CAPRICCIOSAS.COM 2005 and Design" in conjunction with restaurant services.

15. Applicant's targeted customer base overlaps with the customers of Opposer's and restaurant services marketed and sold under the Opposer's marks.

16. As Applicant's service description contains no restrictions or limitations as to Applicant's channels of trade, Opposer may assume that Applicant's mark, like Opposer's own marks, will be used in all accepted channels of trade. Therefore, in addition to overlapping consumer bases, Applicant's intended channels of trade for its restaurant services overlap with the channels of trade used by Opposer's in sales and marketing of its restaurant services under the Opposer's marks.

17. Opposer is neither affiliated nor connected with Applicant or its services; nor has OPPOSER endorsed or sponsored Applicant or any of its goods or services.

18. There is no issue as to priority of use. OPPOSER began using its "RISTORANTE ITALIANO CAPRICCIOSA IN TOKYO SINCE 1978" and "RISTORANTE

ITALIANO CAPRICCIOSA IN TOKYO SINCE 1978 (stylized)” marks at least as early as September 15, 2010, and enjoys priority well prior to Applicant’s first use of the “CAPRICCIOSAS GOURMET PIZZA WWW.CAPRICCIOSAS.COM 2005 and Design” mark. On information and belief, Applicant has not established use prior to Opposer’s first use of the marks “RISTORANTE ITALIANO CAPRICCIOSA IN TOKYO SINCE 1978” and “RISTORANTE ITALIANO CAPRICCIOSA IN TOKYO SINCE 1978 (stylized).”

FIRST GROUND FOR OPPOSITION:

LIKELIHOOD OF CONFUSION

19. Opposer incorporates by reference paragraphs 1-18, inclusive, as if fully set forth herein.
20. Applicant’s mark is confusingly similar in sight, sound and commercial impression to Opposer’s marks. Applicant’s “CAPRICCIOSAS GOURMET PIZZA WWW.CAPRICCIOSAS.COM 2005 and Design” mark and Opposer’s “RISTORANTE ITALIANO CAPRICCIOSA IN TOKYO SINCE 1978” and “RISTORANTE ITALIANO CAPRICCIOSA IN TOKYO SINCE 1978 (stylized)” marks share the identical dominant wording “CAPRICCIOSA.”
21. Applicant’s mark is intended for use in connection with services that overlap with and are related to Opposer’s services marketed and sold under the Opposer’s marks.
22. Opposer is not affiliated or connected with Applicant or its services, nor has Opposer endorsed or sponsored Applicant or its goods.

23. Applicant's targeted customer base overlaps with the customers of Opposer's services marketed and sold under the Opposer's marks.

24. Applicant's intended channels of trade for its services offered under "CAPRICCIOSAS GOURMET PIZZA WWW.CAPRICCIOSAS.COM 2005 and Design" mark overlap with the channels of trade used by OPPOSER in marketing and selling its services marketed and sold under the Opposer's marks.

25. If Applicant is permitted to register Applicant's mark for the services specified in the application herein opposed, confusion resulting in damage and injury to Opposer would likely occur. Persons familiar with Opposer's marks would likely perceive Applicant's products as associated, affiliated with, or sponsored by Opposer.

26. Opposer's customers and the relevant public are likely to misapprehend Applicant's mark as the Opposer's trademarks and/or believe in error that services offered under the Applicant's "CAPRICCIOSAS GOURMET PIZZA WWW.CAPRICCIOSAS.COM 2005 and Design" mark is offered by, in association with, or under license from Opposer.

27. Applicant's use and intended use of the mark shown in Application Serial No. 85/107,422 ("CAPRICCIOSAS GOURMET PIZZA WWW.CAPRICCIOSAS.COM 2005 and Design") is without Opposer's consent or permission.

28. Any defect, objection to, or fault found with Applicant's products or services marketed under its "CAPRICCIOSAS GOURMET PIZZA WWW.CAPRICCIOSAS.COM 2005 and Design" mark would necessarily reflect on and seriously injure the reputation that OPPOSER has established for its restaurant services marketed and sold under the

“RISTORANTE ITALIANO CAPRICCIOSA IN TOKYO SINCE 1978” and “RISTORANTE ITALIANO CAPRICCIOSA IN TOKYO SINCE 1978 (stylized)” marks.

29. Registration of Applicant’s mark would give Applicant *prima facie* evidence of the validity and ownership of Applicant’s mark and of Applicant’s exclusive rights to use its “CAPRICCIOSAS GOURMET PIZZA WWW.CAPRICCIOSAS.COM 2005 and Design” mark, all to the detriment of Opposer.

30. Registration of the mark herein opposed will damage Opposer because Applicant’s “CAPRICCIOSAS GOURMET PIZZA WWW.CAPRICCIOSAS.COM 2005 and Design” mark is likely, when used on or in connection with the services described in the opposed application, to cause confusion, or to cause mistake, or to deceive. Thus, the “CAPRICCIOSAS GOURMET PIZZA WWW.CAPRICCIOSAS.COM 2005 and Design” mark is unregistrable under Section 2(d) and 3 of the Trademark Act, as amended, 15 USA §§ 1052(d) and 1053, and should be refused registration.

SECOND GROUND FOR OPPOSITION:

PRIOR USE

31. Opposer has used its mark “CAPRICCIOSA” since at least as early as 1985 for “restaurant services,” in International Class 43.

32. Opposer’s marks “RISTORANTE ITALIANO CAPRICCIOSA IN TOKYO SINCE 1978” and “RISTORANTE ITALIANO CAPRICCIOSA IN TOKYO SINCE 1978 (stylized)” were filed based on use in commerce at least as early as September 15, 2010.

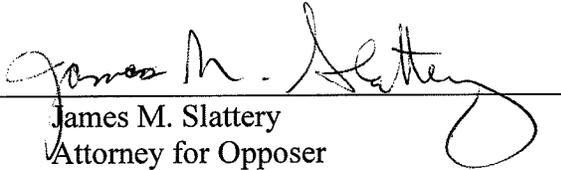
33. Opposer has used these marks in at least as early as September 15, 2010 in conjunction with restaurant services and franchise services, namely, offering business management assistance in the establishment and operation of restaurants in the Opposer's two applications for "RISTORANTE ITALIANO CAPRICCIOSA IN TOKYO SINCE 1978" (Application No. 85/190,968) and "RISTORANTE ITALIANO CAPRICCIOSA IN TOKYO SINCE 1978 and Design" (Application No. 85/190,978) in foreign commerce with Japan and the United States.

34. There is no issue as to priority of use since Opposer began using the marks "RISTORANTE ITALIANO CAPRICCIOSA IN TOKYO SINCE 1978" and "RISTORANTE ITALIANO CAPRICCIOSA IN TOKYO SINCE 1978 and Design" on at least as early as September 15, 2010 and has enjoyed priority as a result of using the mark.

35. Accordingly, Applicant's mark is unregistrable pursuant to Sections 2(a)(d), 3, 13, and 43(e) of the United States Trademark Act, as amended, 15 USC §§ 1052(a)(d), 1053, 1063, 1125, and should be refused registration.

Wherefore, Opposer prays that this opposition be sustained and that Application No. 85/107,922 be denied and refused registration.

Respectfully submitted,

By 
James M. Slattery
Attorney for Opposer

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Dated: December 1, 2011

CERTIFICATE OF SERVICES

It is hereby certified that a true and correct copy of the foregoing NOTICE OF OPPOSITION has been served on the attorneys for the Applicant:

THEODORE A. BREINER
BREINER & BREINER, L.L.C.
PO BOX 320160
ALEXANDRIA, VA 22320-4160

by first class mail, postage prepaid, and email, on this 1st day of December, 2011,

By  _____