

ESTTA Tracking number: **ESTTA536746**

Filing date: **05/08/2013**

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	Wiscon Corporation d/b/a Caputo Foods		
Entity	Corporation	Citizenship	Illinois
Address	1945 N. 15th Avenue Melrose Park, IL 60180 UNITED STATES		
Attorney information	William L. Niro Niro, Haller & Niro 181 West Madison Street Suite #4600 Chicago, IL 60602 UNITED STATES wniro@nshn.com, mecysne@nshn.com Phone:(312) 236-0733		

Applicant Information

Application No	85458045	Publication date	04/09/2013
Opposition Filing Date	05/08/2013	Opposition Period Ends	05/09/2013
Applicant	Caputo, Dominic 4010 Main Street Skokie, IL 60076 UNITED STATES		

Goods/Services Affected by Opposition

Class 043. First Use: 2011/09/15 First Use In Commerce: 2011/09/15 All goods and services in the class are opposed, namely: Restaurant services, including sit-down service of food and take-out restaurant services

Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1763053	Application Date	11/22/1991
Registration Date	04/06/1993	Foreign Priority Date	NONE
Word Mark	CAPUTO		
Design Mark			

Description of Mark	NONE
Goods/Services	Class 029. First use: First Use: 1979/01/01 First Use In Commerce: 1979/01/01 cheese, nondairy processed cheese, vegetable oil, corn oil, and processed peppers; namely, pepperoncini Class 030. First use: First Use: 1979/01/01 First Use In Commerce: 1979/01/01 pasta

U.S. Registration No.	4323127	Application Date	03/21/2012
Registration Date	04/23/2013	Foreign Priority Date	NONE
Word Mark	CAPUTO		
Design Mark			
Description of Mark	The mark consists of the word "CAPUTO" in fanciful script in red, with the letters outlined by thin lines in the color white and the outer edge in the color green.		
Goods/Services	Class 029. First use: First Use: 1979/01/01 First Use In Commerce: 1979/01/01 Cheese, tomato paste, canned tomatoes, processed tomatoes, edible oils, soup and soup concentrate Class 030. First use: First Use: 1979/01/01 First Use In Commerce: 1979/01/01 Pizza, pizza sauce, coffee, pizza crust, frozen dough for use as pizza, pizza dough, vinegar, pasta, tomato sauce and edible spices		

U.S. Registration No.	4237073	Application Date	03/21/2012
Registration Date	11/06/2012	Foreign Priority Date	NONE
Word Mark	CAPUTO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 029. First use: First Use: 1979/01/01 First Use In Commerce: 1979/01/01 Cheese, tomato paste, canned tomatoes, processed tomatoes, edible oils and vinegar, soup, soup concentrate Class 030. First use: First Use: 1979/01/01 First Use In Commerce: 1979/01/01 Pizza, pizza sauce, coffee, pizza crust, frozen dough for use as pizza, pizza dough, pasta, tomato sauce and edible spices		

Attachments	Opposition Notice and Exhibits A through E.pdf(597409 bytes)
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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	/William L. Niro/
Name	William L. Niro
Date	05/08/2013

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

Applicant's Ref.: TM 2527

In the Matter of Application Serial No. 85/458045
Mark: DI CAPUTO'S PIZZERIA

Wiscon Corporation d/b/a Caputo Foods, an
Illinois Corporation,

Opposer,

v.

Dominic Caputo,

Applicant.

Opposition No.: _____

NOTICE OF OPPOSITION

Opposer, Wiscon Corporation d/b/a Caputo Foods, is a corporation organized under the laws of the State of Illinois, located and doing business at 1945 N. 15th Avenue, Melrose Park, Illinois 60180. Opposer believes that it would be damaged by the issuance of a registration for the trademark DI CAPUTO'S PIZZERIA as applied for in Application Serial No. 85/458045, and therefore opposes the same. As grounds for its opposition, Opposer, by its attorney, William L. Niro, NIRO, HALLER & NIRO, alleges as follows:

1. For more than 33 years, and prior to any date upon which Applicant can rely, Opposer has used the mark CAPUTO on or in connection with cheese, canned tomatoes, tomato paste, pizza, pizza sauce, pizza crust, pizza dough and edible spices – most of which constitute typical and common ingredients in the preparation of pizza products – in the United States, and is continuing to do so. Opposer has invested substantial amount of time, effort and money in promoting the CAPUTO mark in connection with those goods. As a result, the mark has become distinctive of Opposer's goods and has come to represent enormous goodwill for Opposer.

2. Opposer owns the following U.S. Trademark Registrations:

a. Registration No. 1,763,053, issued April 6, 1993, for the mark CAPUTO (word and stylized design) for "cheese, nondairy processed cheese, vegetable oil, corn oil, and processed peppers, namely pepperoncini " in International Class 29, and "Pasta" in International Class 30, with a date of first use in commerce of January 1, 1979, long prior to any date on which Applicant relies. Opposer's right to use the registered trademark for the goods described is incontestable under Section 15 of the Trademark Act, 15 U.S.C. § 1065. (*See Exhibit A, attached.*)

b. Registration No. 4,323,127, issued April 23, 2013, for the mark CAPUTO (word and stylized design) for "cheese, tomato paste, canned tomatoes, processed tomatoes, edible oils and vinegar, soup, soup concentrate" in International Class 29, and "Pizza, pizza sauce, coffee, pizza crust, frozen dough for use as pizza, pizza dough, pasta, tomato sauce and edible spices" in International Class 30, with a date of first use in commerce of January 1, 1979, long prior to any date on which Applicant relies. (*See Exhibit B, attached.*)

c. Registration No. 4,237,073, issued November 6, 2012, for the standard character word mark CAPUTO for "cheese, tomato paste, canned tomatoes, processed tomatoes, edible oils and vinegar, soup, soup concentrate" in International Class 29 and "Pizza, pizza sauce, coffee, pizza crust, frozen dough for use as pizza, pizza dough, pasta, tomato sauce and edible spices" in International Class 30, with a date of first use in commerce of January 1, 1979, long prior to any date on which Applicant relies. (*See Exhibit C, attached.*)

Opposer's registrations are valid, subsisting, and in full force and effect. As such, these registrations serve as conclusive evidence of Opposer's exclusive rights to use the CAPUTO mark on or in connection with the goods identified in the registrations. An example of Opposer's use of its marks in connection with pizza is attached as Exhibit D.

3. On October 27, 2011, Applicant, Dominic Caputo, filed an application under Section 1(a) of the Trademark Act to register the mark DI CAPUTO'S PIZZERIA (words and stylized design) which at publication lists the "restaurant services," in International Class 43 for which registration is sought. The mode and manner of Applicant's actual use of the mark is shown on its specimen of use attached as Exhibit E.

4. Applicant produces and sells pizzas using the DI CAPUTO mark (in stylized format) as shown on its Application for the exact goods produced and sold by Opposer under its CAPUTO marks.

5. Applicant selected its mark with full knowledge of Opposer's long-standing use, registrations and common law rights in the mark CAPUTO with intent to confuse, mislead and deceive the public into believing that Applicant's goods and services are in some way sponsored by, associated with, emanate from or are endorsed by Opposer, or are otherwise related to Opposer as the source of those goods and services.

6. The mark that Applicant seeks to register has as its predominant feature the word CAPUTO and is similar in sound, meaning and commercial impression to Opposer's CAPUTO mark, and will be used in connection with restaurant services serving pizza which are closely related to the goods on which the Opposer uses its registered marks. Based on the similarities of the marks and the goods, the public is likely to associate the goods offered by Applicant under the mark DI CAPUTO'S PIZZERIA with Opposer or with Opposer's goods, or to believe that Applicant's goods are sponsored, endorsed or licensed by Opposer, or that there is some relationship between Applicant and Opposer.

7. Applicant's mark DI CAPUTO PIZZERIA is used in connection with goods and services that fall within natural areas of expansion of the goods produced and sold by Opposer.

8. For the above reasons, any use of the mark DI CAPUTO'S PIZZERIA by Applicant is likely to cause confusion, cause mistake or deceive the public, and cause the public

to believe that the services offered under the DI CAPUTO'S PIZZERIA mark emanate from or are otherwise sponsored by or endorsed by Opposer, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d). By reason of the foregoing, Opposer will be damaged by the registration of the mark DI CAPUTO'S PIZZERIA to Applicant.

WHEREFORE, it is respectfully requested that this opposition be sustained and that the registration sought by Application Serial No. 85458045 be denied.

Respectfully submitted,

/s/ William L. Niro

William L. Niro
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(312) 236-0733
Fax: (312) 236-3137
wniro@nshn.com

Attorneys for Wiscon Corporation d/b/a Caputo Foods

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of this paper has been served upon the below listed parties at the respective addresses by U.S. First Class Mail on May 8, 2013:

Ms. Brooke L. Lewis
Seiden Law Group
115 S. LaSalle Street, Suite 2600
Chicago, IL 60603

/s/ William L. Niro
Attorneys for Wiscon Corporation
d/b/a Caputo Foods
NIRO, HALLER & NIRO

EXHIBIT A



Trademarks > Trademark Electronic Search System (TESS)

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Word Mark CAPUTO

Goods and Services IC 029. US 046. G & S: cheese, nondairy processed cheese, vegetable oil, corn oil, and processed peppers; namely, pepperoncini. FIRST USE: 19790101. FIRST USE IN COMMERCE: 19790101

IC 030. US 046. G & S: pasta. FIRST USE: 19790101. FIRST USE IN COMMERCE: 19790101

Mark Drawing Code (3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS

Design Search Code 02.01.01 - Busts of men facing forward; Heads of men facing forward; Men - heads, portraiture, or busts facing forward; Portraiture of men facing forward
02.01.20 - Bakers (men); Butchers (men); Chefs (men); Men, butchers, chefs, and bakers

Serial Number 74224508

Filing Date November 22, 1991

Current Basis 1A

Original Filing Basis 1A

Published for Opposition January 12, 1993

Registration Number 1763053

Registration Date April 6, 1993

Owner (REGISTRANT) Wisconsin Cheese Inc. CORPORATION ILLINOIS 1931 North 15th Avenue Melrose Park ILLINOIS 60160

(LAST LISTED OWNER) WISCON CORPORATION CORPORATION BY ASSIGNMENT ILLINOIS 777 BANK LANE LAKE FOREST ILLINOIS 60045

Assignment Recorded ASSIGNMENT RECORDED

Attorney of Record JOANNE M. DENISON

EXHIBIT A

Type of Mark TRADEMARK
Register PRINCIPAL
Affidavit Text SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20030610.
Renewal 1ST RENEWAL 20030610
Live/Dead Indicator LIVE

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EXHIBIT A

EXHIBIT B

**Trademarks > Trademark Electronic Search System (TESS)**

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Word Mark CAPUTO

Goods and Services IC 029. US 046. G & S: Cheese, tomato paste, canned tomatoes, processed tomatoes, edible oils, soup and soup concentrate. FIRST USE: 19790101. FIRST USE IN COMMERCE: 19790101

IC 030. US 046. G & S: Pizza, pizza sauce, coffee, pizza crust, frozen dough for use as pizza, pizza dough, vinegar, pasta, tomato sauce and edible spices. FIRST USE: 19790101. FIRST USE IN COMMERCE: 19790101

Mark Drawing Code (5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM

Serial Number 85575491

Filing Date March 21, 2012

Current Basis 1A

Original Filing Basis 1A

Published for Opposition February 5, 2013

Registration Number 4323127

Registration Date April 23, 2013

Owner (REGISTRANT) Wiscon Corporation DBA Caputo Foods CORPORATION ILLINOIS 1945 N. 15th Avenue Melrose Park ILLINOIS 60160

Attorney of Record William L. Niro

Prior Registrations 1763053

Description The color(s) red, white and green is/are claimed as a feature of the mark. The mark consists of the word "CAPUTO"

EXHIBIT B

of Mark in fanciful script in red, with the letters outlined by thin lines in the color white and the outer edge in the color green.

Type of Mark TRADEMARK

Register PRINCIPAL-2(F)

Live/Dead Indicator LIVE

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EXHIBIT C

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CAPUTO

Word Mark	CAPUTO
Goods and Services	IC 029. US 046. G & S: Cheese, tomato paste, canned tomatoes, processed tomatoes, edible oils and vinegar, soup, soup concentrate. FIRST USE: 19790101. FIRST USE IN COMMERCE: 19790101 IC 030. US 046. G & S: Pizza, pizza sauce, coffee, pizza crust, frozen dough for use as pizza, pizza dough, pasta, tomato sauce and edible spices. FIRST USE: 19790101. FIRST USE IN COMMERCE: 19790101
Standard Characters Claimed	
Mark Drawing Code	(4) STANDARD CHARACTER MARK
Serial Number	85575424
Filing Date	March 21, 2012
Current Basis	1A
Original Filing Basis	1A
Published for Opposition	August 21, 2012
Registration Number	4237073
Registration Date	November 6, 2012
Owner	(REGISTRANT) Wiscon Corporation DBA Caputo Foods CORPORATION ILLINOIS 1945 N. 15th Avenue Melrose Park ILLINOIS 60160
Attorney of Record	William L. Niro
Prior Registrations	1763053
Type of Mark	TRADEMARK

EXHIBIT C

Register PRINCIPAL-2(F)
Live/Dead Indicator LIVE

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EXHIBIT C

EXHIBIT D

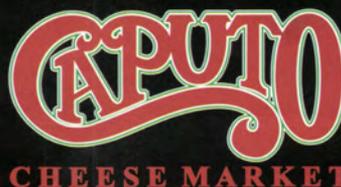


Drew, of Berwyn, IL, our 2010 Latticini Kid Photo Contest Winner

Pizza Perfetta...

Make your own pizza dough from scratch using *Caputo Flour Tipo "00,"* or pick up Caputo's already made *dough balls or pizza crust* for a delicious pizza in a snap. Don't forget *Caputo's sauce* and *Award Winning Fresh Mozzarella* to top off your irresistible creation.

231 E. Wisconsin Ave.
Lake Forest, IL 60045
847-482-0100



1931 N. 15th Ave.
Melrose Park, IL 60160
708-450-0469

EXHIBIT D

EXHIBIT E



EXHIBIT E