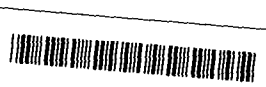
TTAB

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

In the Matter of Application of Serial No. 76-105,450
Published in the Official Gazette of December 11, 2001



05-08-2002
U.S. Patent & TMOfc/TM Mail Rcpt Dt. #26

PIZZA DONINI, Inc.,	)	
	)	
Opposer,	)	
	)	
v.	)	Opposition No. 91151014
	)	
PIZZA DONINI, INC.,	)	
	)	
Applicant.	)	
	)	

Box TTAB - No Fee
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

TRADEMARK TRIAL AND APPEAL BOARD
02 MAY 2 AM 1:41

OPPOSER'S OPPOSITION TO APPLICANT'S MOTION TO DISMISS

Pizza Donini, Inc. (Massachusetts) ("Opposer") hereby opposes the Motion to Dismiss filed by Pizza Donini, Inc. (Canada) ("Applicant"), and submits that Applicant's motion lacks merit, and should be denied.

LEGAL STANDARD

A motion to dismiss under 12(b)(6) cannot be granted unless it is certain beyond any doubt that the non-moving party cannot, under any circumstances, prevail. Cardinal Engineering Corp. v. Champion Mfg. Co., 300 F.2d 957, 133 USPQ 197 (C.C.P.A. 1962); Saks, Inc. v. Saks & Co., 141 USPQ 307 (T.T.A.B. 1964); Pulpedent Corp. of America v. Precision Medical Instrument, Inc., 161 USPQ 47 (T.T.A.B. 1970). *See* TMTB Manual of Procedure § 503. For purposes of determining a motion to dismiss for failure to state a claim upon which relief can be granted, 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. See Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc., 988

F.2d 1157, 26 USPQ2d 1038 (Fed. Cir. 1993); Stanspec Co. v. American Chain & Cable Co., 531 F.2d 563, 189 USPQ 420 (CCPA 1976); Kelly Services Inc. v. Greene's Temporaries Inc., 25 USPQ2d 1460 (TTAB 1992); Space Base Inc. v. Stadis Corp., 17 USPQ2d 1216 (TTAB 1990); and No Nonsense Fashions, Inc. v. Consolidated Foods Corp., 226 USPQ 502 (TTAB 1985). Dismissal for insufficiency is appropriate only if it appears certain that the plaintiff is entitled to no relief under any set of facts which could be proved in support of its claim. See Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc., supra; Scotch Whiskey Ass'n v. United States Distilled Products Co., 952 F.2d 1317, 21 USPQ2d 1145 (Fed. Cir. 1991); Stabilisierrungsfonds fur Wein v. Zimmermann-Graeff KG, 199 USPQ 488 (TTAB 1978); and National Ass'n of Blue Shield Plans v. Standard Mattress Co., 176 USPQ 29 (TTAB 1972). In the instant proceeding, Applicant alleges that its Motion to Dismiss should be granted based on its assertion that Opposer "does not set forth a cognizable claim for relief." (Motion to Dismiss, p. 1.) Applicant's motion should be denied.

I. Opposer's Notice of Opposition States a Claim for Relief.

In its Motion to Dismiss, Applicant asserts that the Opposer fails to state a cognizable claim for relief. Whenever the sufficiency of any complaint has been challenged by a motion to dismiss, it is the duty of the Trademark Trial and Appeal Board (the "Board") to examine the complaint in its entirety, construing the allegations therein liberally, as required by Federal Rules of Civil Procedure 8(f), to determine whether it contains any allegations which, if proved, would entitle the plaintiff to the relief sought. See Miller Brewing Co. v. Anheuser-Busch Inc., 27 USPQ2d 1711 (TTAB 1993); Delta Tire Corp. v. Sports Car Club of America, Inc., 186 USPQ 431 (TTAB 1975); and National Semiconductor Corp. v. Varian Associates, 184 USPQ 62 (TTAB 1974). In the Notice of Opposition, Opposer states that:

1. Opposer has been using an identical mark in interstate commerce in connection with similar goods/services; and

2. Opposer believes it will be damaged by the registration of Applicant's mark for similar goods/services.

Applicant conceded in its Motion to Dismiss that Opposer has essentially pled likelihood of confusion, but argues that Opposer has failed to plead, e.g., priority of use, or other similar grounds. However, in the Notice of Opposition Opposer stated that it has "been using" the mark. Applicant's application was filed on an intent-to-use basis (Sec. 1(b)). Under the doctrine of liberal construction of pleadings, and construing the allegations in the light most favorable to the Opposer, Opposer has pled a priority of use. Further, the Board can easily determine that if Opposer can, in the course of this proceeding, prove the allegations contained in the Notice of Opposition, i.e., that Opposer has been using an identical mark on similar goods/services, and should Opposer be able to prove that its use was prior to the Applicant's application date, Opposer will prevail in this proceeding. Because Applicant has pled that it is using the mark, and presumably Opposer merely has an intention to use the mark (as construed from its Sec. 1(b) filing basis), it is more than plausible that Opposer's use was prior to Applicant's use. If this proves to be the case as discovered during the course of this proceeding, Opposer shall prevail. Clearly, the Notice of Opposition sufficiently states a claim upon which relief can be granted.

Petitioner respectfully requests that the Board deny Applicant's Motion to Dismiss.

Respectfully submitted,

PIZZA DONINI, INC. (Massachusetts)
("Opposer")
By its attorneys,

Date: April 6, 2002

Maggie A. Lange

Peter J. Borghetti, Esquire
Maggie A. Lange, Esquire
Perkins, Smith & Cohen, L.L.P.
One Beacon Street
Boston, Massachusetts 02108-3106
(617) 854-4000

CERTIFICATE OF MAILING

I, Maggie A. Lange, counsel for Petitioner, hereby certify that this pleading is being deposited on April 6, 2002, with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner of Trademarks, Box TTAB-No Fee, 2900 Crystal Drive, Arlington, VA 22202.

Maggie A. Lange

CERTIFICATE OF SERVICE

I, Maggie A. Lange, counsel for Petitioner, hereby certify that on April 6, 2002, I served a copy of this filing, by first class, postage prepaid, upon Respondent's counsel, Marcia G. Gentner, Esq., Jacobson Holman, LLC, 400 Seventh Street, N.W., Washington, D.C. 20004, at her address of record.

Maggie A. Lange