UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

az Mailed: September 24, 2002

Opposition No. 151,014

Pizza Donini, Inc. (a Massachusetts corporation)

v.

Pizza Donini, Inc. (a Canadian corporation)

Before Seeherman, Chapman and Bucher, Administrative Trademark Judges.

By the Board.

This case now comes up on applicant's motion to dismiss (filed April 17, 2002). The motion has been fully briefed by the parties.[1]

In order to expedite our decision on the motion, we presume familiarity with the notice of opposition and the parties' briefs and do not provide a full recitation of the allegations and contentions of each party.

A motion to dismiss for failure to state a claim upon which relief can be granted is a test solely of the legal

[1] Opposer's motion (filed May 8, 2002) to correct the service date on its response to the motion to dismiss is granted.

sufficiency of a complaint. See *Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, 26 USPQ2d 1038 (Fed. Cir. 1993). In order to withstand such a motion, a pleading need only allege such facts as would, if proven, establish that the plaintiff is entitled to the relief sought, that is, that (1) the plaintiff has standing to maintain the proceeding, and (2) a valid ground exists for opposing the involved application. See *Lipton Industries, Inc. v. Ralston Purina Co.*, 213 USPQ 185 (CCPA 1982); and TBMP §503.02.

We first consider opposer's pleading as to standing. In order to properly plead standing, a plaintiff need only plead facts sufficient to show that it has a direct and personal stake in the outcome of the proceeding and a reasonable basis for its belief that it will be damaged. See *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999). In its two-page notice of opposition containing only half a page of text, opposer has pleaded the following:

> As grounds, Opposer states that it has been using an identical mark, i.e., PIZZA DONINI, in interstate commerce in the United States, in connection with similar goods/services, and Applicant's use and/or registration of the mark will damage Opposer.

By pleading that opposer "has been using an identical mark … in connection with similar goods/services," and that "Applicant's use and/or registration of the mark will

damage Opposer," we find that opposer has sufficiently pleaded a direct and personal stake in the outcome of the opposition and a reasonable basis for its belief that it will be damaged.

We next consider whether opposer has suitably alleged a valid ground for opposing the involved application.

Section 2(d) of the Trademark Act precludes the registration of a mark that so resembles a registered mark "or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive …." In an opposition founded on Section 2(d), the opposer must establish its own prior proprietary rights in the same or a confusingly similar designation in order to defeat the application. See 3 J. T. McCarthy, *McCarthy on Trademarks and Unfair Competition,* Section 20.15 (4th ed. 2000).

Applicant has conceded that the notice of opposition "can be construed as an allegation of likelihood of confusion." We agree that it can be so construed. Thus, we turn to whether opposer has properly pleaded priority. Opposer maintains that it has suitably alleged priority because "Opposer stated that it has 'been using' the mark" and applicant's application was filed as an intent-to-use application. Opposer is wrong. Nowhere in opposer's

pleading does opposer specify any particular point in time when it began using its mark.[2] In order to properly state a claim under Section 2(d), an opposer must plead that it has a proprietary interest in its mark which was obtained prior to the filing date of applicant's application. See *Zirco Corp. v. American Telephone and Telegraph Co*., 21 USPQ2d 1542 (TTAB 1991); and *Miller Brewing Co. v. Anheuser-Busch Inc*., 27 USPQ2d 1711 (TTAB 1993). We therefore conclude that this notice of opposition does not state a claim upon which relief can be granted.

Accordingly, applicant's motion to dismiss is hereby granted. However, opposer is allowed until **thirty days** from the mailing date of this order to file an amended notice of opposition which properly pleads a claim of priority and likelihood of confusion. See TBMP §503.03 and cases cited therein.[3]

If opposer files an amended notice of opposition, applicant is hereby allowed until **thirty days** from the date of service of any amended notice of opposition to file an

[2] The notice of opposition is so vague that it can be read to claim that opposer's alleged use of "PIZZA DONINI" began sometime after the filing of applicant's application, but before the filing of the notice of opposition, just as easily as it can be read to claim that opposer's alleged use of "PIZZA DONINI" began before the filing of the application.

[3] As explained earlier, although construed as including a pleading of likelihood of confusion, the Board strongly urges opposer to plead its claim under Section 2(d) more clearly, perhaps using the language of Section 2(d) of the Trademark Act.

answer thereto. (If necessary and appropriate, the Board will reset the discovery and trial periods at the appropriate time in this case.)

If opposer does not file an amended notice of opposition, this opposition will be dismissed with prejudice.

Proceedings herein remain otherwise suspended.