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

Proceeding	92045271
Party	Plaintiff Wiscon Corp. Wiscon Corp 1945 N 15th Ave Melrose Pk, IL 60160 UNITED STATES
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IN THE UNITED STATES PATENT & TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Wiscon Corp., Petitioner v. CANTINE CAPUTO, S.p.A. Registrant	Cancellation No. 92,045,271 Registration No. 2,984,449
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PLAINTIFF'S MOTION FOR DEFAULT SUMMARY JUDGMENT FOR FAILURE TO
ANSWER PLAINTIFF'S REQUESTS TO ADMIT

NOW COMES THE Petitioner, Wiscon Corp. by and through the undersigned counsel of record, and requests that this Board enter an Order for Summary Judgment cancelling the above trademark Registration, based on the fact that there is no triable issue as to any material fact, and that Petitioner is entitled to its Judgment as a matter of law.

The grounds for this Motion are as follows:

- 1) Petitioner served its Requests for Admission on Registrant on January 30, 2006.
- 2) Registrant failed to provide any answers to these Requests for Admission, nor was any Extension of Time requested from the undersigned counsel of record, and hence all Requests for Admission have been automatically admitted by Registrant by operation of law.
- 3) Since all facts are admitted in favor of Petitioner, there is no genuine issue of material

fact to be resolved, and the above trademark registration of Cantine Caputo should be cancelled from the U.S. trademark register forthwith.

WHEREFORE, the Petitioner prays that the Board enter the following Order.

(1) The Board should cancel Registrant's Registration No. 2,984,449 for the CAPUTO mark.

In conclusion, where Registrant failed to Answer Petitioner's Motion for Request to Admit, the prescribed admissions are incontestable and the relief sought is proper and warranted.

Based on these facts, this court should grant Petitioner its Motion for Summary Judgment and issue an Order accordingly.

Respectfully submitted,

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Counsel of Record for Applicant

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TTAB

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

<p>WISCON CORP. Petitioner</p> <p>v.</p> <p>CANTINE CAPUTO, S.p.A. Registrant</p>	<p>Cancellation No. 9,2045,271 Serial No. 76/468,593</p>
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PETITIONERS FIRST SET OF REQUESTS FOR ADMISSION

Pursuant to 37 CFR 2.120(a), and Rules 33, 34, and 36 (a) and (b) of the Federal Rules of Civil Procedure incorporated thereby, Petitioner, Wiscon Corp., hereby requests that Registrant, Cantine Caputo S.p.A. answer the following Interrogatories under oath, produce for inspection and copying each of the following documents requested, and admit or deny the following. Answers and documents are due within thirty (30) days after service.

INSTRUCTIONS

You are instructed to use the instructions provided in the accompanying Request for Interrogatories.

ADMISSIONS

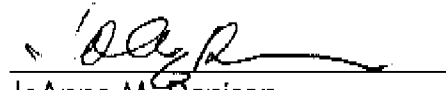
1. The term CAPUTO as related to wines and food products is arbitrary.
2. The mark CAPUTO is well known as used in connection with food products.
3. The mark CAPUTO is highly valuable.
4. The mark CAPUTO has established secondary meaning in the marketplace.
5. Petitioner's first use date for the "CAPUTO" mark was as early as 1978.
6. The mark "CAPUTO" was used by Petitioner on wines prior to the date on which Registrant first commenced using the mark "CAPUTO" in connection with wine.
7. Registrant was aware that prior to the adoption of the mark "CAPUTO," Petitioner had a full line of grocery products including class 29 for cheese with registration no. 2,009,696; class 29&30 for cheese, nondairy processed cheese, vegetable oil, corn oil, and processed peppers, namely pepperoncini and pasta with Registration No. 1,763,053; and cheese, processed cheese, edible oils, spices and vinegar with Registration No. 2,464,986.
8. Registrant's mark is identical to Petitioner's mark.
9. Registrant's mark "creates a likelihood of confusion in the relevant marketplace" to Registration No. 2,899,306.
10. Registrant's uses its CAPUTO mark on the same goods which Petitioner uses its mark upon.
11. Registrant's Goods are targeted to the same consumers as Petitioner's goods.
12. Registrant's Goods are offered through the same channels of trade as Petitioner's

goods.

13. Consumers encountering Registrant's Goods are likely to believe that such goods are affiliated with or emanate from Petitioner.
14. Use of Petitioner's Mark for Registrant's goods creates a likelihood of confusion, mistake or deception.
15. Registrant selected Registrant's mark with the knowledge that Petitioner had already the same mark for its goods.
16. Registrant's selected Petitioner's mark with the intent to cause a likelihood of confusion , mistake or deception with Petitioner's mark.
17. Registrant was aware that the mark CAPUTO was used prior to its applying for registration for the same mark.
18. Registrant is aware that the mark CAPUTO is well recognized for Italian wine and food products distribution marketplace.
19. Registrant intended to infer a false suggestion of a connection between the Registrant and the Petitioner by using CAPUTO for wines.
20. Petitioner's mark CAPUTO is an indicator of very high quality Italian products.
21. Registrant was aware, prior to selecting its CAPUTO mark, that Petitioner's food products branded with the mark CAPUTO are sold nationwide.
22. Registrant's use of the mark "Caputo.it.com" as its domain name creates a likelihood of confusion in the relevant marketplace due to Petitioner's heavy useage of the mark CAPUTO in the area of food products and food distribution and sales services.

23. Registrant is aware that by its use of CAPUTO for wines as Petitioner using its "CAPUTO" mark, will dilute the value, scope and/or effect of the Petitioner's line of CAPUTO brand products.
24. Registrant is aware of actual confusion that has occurred, or is occurring, between Registrant's Goods and Petitioner's goods.
25. Instances of actual confusion between Registrant's mark and Petitioner's mark have damaged Petitioner.
26. Continued Federal Registration of Registrant's mark would cause damage to Petitioner.
27. Registrant is aware that a trademark search should have been conducted prior to its adoption of the CAPUTO mark in the United States for use on its wines.

Respectfully submitted,



JoAnne M. Denison
Counsel of Record for Wiscon Corp.

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CERTIFICATE OF SERVICE

I certify that I have mailed a copy of the foregoing pleadings, Interrogatories to Defendants, Requests to Admit, and Request for Documents first class mail postage prepaid to:

Mr. Andrew C. Aitken in care of Cantine Caputo S.p.A.
Venable, LLP
P.O.Box 34385
Washington, DC 20043-9998

this January 30, 2006.



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

Wiscon Corp., Petitioner v. CANTINE CAPUTO, S.p.A. Registrant	Cancellation No. 9,2045,271 Registration No. 2,984,449
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PLAINTIFF'BRIEF IN SUPPORT OF DEFAULT SUMMARY JUDGMENT FOR FAILURE TO ANSWER PLAINTIFF'S REQUESTS TO ADMIT

Petitioner, Wiscon Corp. (hereinafter sometimes "Wiscon"), herewith submits its Motion for Summary Judgment against Cantine Caputo, S.p.A in favor of Wiscon. The Honorable Board should grant Summary Judgment in favor of Wiscon, as a matter of law on the following grounds: a) Registrant provided no answers to Wiscon's Request to Admit which was served on January 30, 2006 attached hereto as Exhibit A, and it has been twenty-six (26) days since these answers were due on March 2, 2006, and b) consequently these answers are duly admitted so there is no issue of material fact remaining to be resolved. Also, Registrant did not seek or obtain any Extensions of Time to answer these Requests for Admission from the undersigned counsel of record. The Board should therefore grant Summary Judgment in favor of Wiscon and order that Registrant's Federal Trademark Registration No. 2,984,449 be cancelled.

FACTS

Wiscon Corp. (Hereinafter "Wiscon") has been in business for over 25 years selling goods with the CAPUTO trademark on various Italian food products including cheese products, edible oils, shortening, vinegar, pepperocini, pasta, spices, meat products and wines. Wiscon Corp. is the lawful owner of the entire right, interest and title to the following U.S. trademark registrations.

Owner	Reg. No.	Mark	Reg. Date	Goods/Services
Wiscon Corp.	2,009,696	CAPUTO	10-22-96	cheese
Wiscon Corp.	1,763,053	CAPUTO & Design	4-6-93	pasta, cheese, nondairy processed cheese, vegetable oil, corn oil, and processed peppers; namely pepperocini
Wiscon Corp.	2,464,986	CAPUTO	7-3-01	cheese, processed cheese and edible oils, spices and vinegar
Wiscon Corp.	2,899,306	CAPUTO	11-2-04	wines, namely red, white and rose

Wiscon has offered, sold and distributed food products with the CAPUTO trademark in both interstate and intrastate commerce. Specifically, Wiscon's cheese products which are sold using the CAPUTO trademark was first used in commerce on August 9, 1979, Registration No. 2,009,696 and registered in 1996. The date of first use in commerce of the CAPUTO trademark for wine goods was on December 18, 2001, Registration No.

2,899,306. Wiscon sells nationwide to food manufacturerers and distributors. It sells its products locally in interstate commerce in grocery stores and retail outlets. Wiscon's complex distribution operations include centers in the Midwest, East Coast and West Coast.

In addition, Wiscon has spent thousands of dollars over the years on advertising its CAPUTO brand food products by imprinting the mark on brochures and flyers, and maintaining various websites: CAPUTO.net, CAPUTOcheese.Com, CAPUTOcheesemarket.com, CAPUTOfoods.com, Wiscon.net, Wisconcorp.com, and CAPUTOitalia.it. Further, Wiscon has printed its CAPUTO mark for advertising purposes in connection with foods and sales services in: Chef Magazine, Nation's Restaurant News, Pizza Quarterly, Chicago Magazine, Chicago Tribune-Good Eating Section, Chicago Reader, Food Arts Magazine, Food Industry News, Fra Noi Newspaper, Nation's Restaurant News, and Sunbelt Foodservice Magazine. Wiscon maintains a sales force of three (3) full-time sales personnel who contact both long-time and new customers for new and repeat business of CAPUTO brand food products. Overall, Wiscon's advertising use of the CAPUTO trademark has been continuous, heavy and extensive over the five past years.

On December 19, 2005, Wiscon filed a Petition for Cancellation of Registration No. 2,984,449. Since then, discovery requests consisting of Admissions, Production and Interrogatories dated January 30, 2006 have been served on Defendant via USPS, 1st class postage prepaid. (Exhibit A) Defendant to date has failed to answer by the due date and thereby should be defaulted.

LEGAL ANALYSIS

A. Registrant failed to timely file an answer to Applicant's Request to Admit and therefore they have been deemed admitted by operation of law.

"Rule 36 . . . means 'precisely what it says,' i.e. , "[i]n order to avoid having requests for admissions deemed admitted, a party must respond within the period of the rule if there is any objection whatsoever to the request." Town of Chapel Hill v. Burchette, 100 N.C. App. 157, 394 S.E.2d 698 (1990) Otherwise, failure to so respond dictates that the facts in question are "judicially established." Id. at 162, 394 S.E.2d at 701.

On January 30, 2006, Registrant served its First Set of Requests for Admission on Registrant, Cantine Caputo which Cantine Caputo failed to answer. Cantine Caputo never sought any Extension of Time from the undersigned counsel of record to provide any late answers to these Requests. According to Federal Rule of Civil Procedure 36(a), "[t]he matter is admitted unless, within 30 days after service of the request, ... the party to whom the request is directed serves upon the party requesting the admission a written answer or objection addressed to the matter, signed by the party or by the party's attorney." Registrant did not provide a written answer or objection to Applicant's Request to Admit, nor was an Extension of Time filed or sought out in order to answer the Requests for Admission. Accordingly, Registrant has admitted the following material facts by operation of law.

1. The Petitioner's mark CAPUTO is highly valuable. (Exh. A, p.2, ¶13)
2. Registrant's mark creates a likelihood of confusion in the relevant marketplace to Wiscon's CAPUTO mark, Registration No. 2,899, 306. (Exh. A, p.2, ¶ 9)
3. The Petitioner's mark CAPUTO'S has established secondary meaning in the

marketplace. (Exh. A, p.2, ¶ 4)

4. Registrant uses its CAPUTO mark on the same goods which Petitioner uses its mark upon. (Exh. A, p.2, ¶10)

5. Registrant selected its mark with the knowledge that Petitioner had already the same mark for its goods. (Exh. A, p.3, ¶15)

6. Registrant selected Petitioner's mark with the intent to cause a likelihood of confusion, mistake or deception with Petitioner's mark. (Exh. A, p.3, ¶16)

7. Registrant's use of the mark "Caputo.it.com" as its domain name creates a likelihood of confusion in the relevant marketplace due to Petitioner's heavy usage of the mark CAPUTO in the area of food products and food distribution and sales services. (Exh. A, p.3, ¶22)

8. Continued Federal Registration of Registrant's mark causes damage to Petitioner. (Exh. A, p.4, ¶26)

9. Registrant is aware that a trademark search should have been conducted prior to its adoption of the CAPUTO mark in the United States for use on its wines. (Exh. A, p.4, ¶27)

B. There is no genuine issue of material fact and therefore Wiscon is entitled to judgment as a matter of law.

Summary Judgment is appropriate when the pleadings, depositions, answer to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law. FRCP 56(c). The mere existence of some alleged factual dispute between the parties will not defeat an otherwise properly supported motion for summary judgment; the requirement is that there be no genuine issue of material fact. Anderson et al. v. Liberty Lobby, Inc., et al. 477 U.S. 242, 247 (1986). Furthermore, summary judgment is an appropriate remedy in trademark matters. See Blanchard Importing & Distributing Co. v. Society E. Blanchard Et Fils, 402 F.2d 797; 159

USPQ 523 (C.C.P.A. 1968). Moreover, “[i]n deciding a motion for summary judgment, the function of the Board is not to try issues of fact, but to determine instead if there are any genuine issues of material fact to be tried.” (TMEP 528, p.102 quoting, Dyneer Corpo. V. Automative Products plc, 37 USPQ 1251, 1254 (TTAB 1995), and University Book Store v. University of Wisconsin Board of Regents, 33 USPQ 2d 185, 1389 (TTAB 1994))

A prima facie trademark infringement action requires that defendant, without authorization, uses a mark similar to plaintiff’s mark and that it causes a likelihood of confusion. Here, Registrant admits that they were “aware that the mark CAPUTO was used prior to its applying for registration for the same mark.” (Exh. A, p.3 ¶17) Defendant sought registration of the CAPUTO mark for its own goods knowing that they were not authorized to use it, nor did they ever receive a license or assignment by the rightful owner of the CAPUTO mark for their own usage of the CAPUTO mark. Hence, it is clear that the Registrant used the CAPUTO mark without authorization by Wiscon Corp. satisfying the first prong of the prima facie case.

Moreover, Registrant admits they “selected Petitioner’s mark with the intent to cause a likelihood of confusion, mistake or deception with Petitioner’s mark.” (Exh. A, p.3, ¶16) In addition, Registrant further admits that “Registrant’s mark creates a likelihood of confusion in the relevant marketplace to Wiscon’s CAPUTO mark, Registration No. 2,899, 306.” (Exh. A, p.2, 3¶ 9,

16) Consequently, the second prong of the prima facie case of proving likelihood of confusion is satisfied here in favor of Wiscon. Therefore, entry of summary judgment is appropriate here because there are no genuine issues as to material facts and judgment may be rendered as a matter of law based on the undisputed facts above and accordingly, Cantine Caputo's trademark registration must be cancelled.

By operation of law they should now, at this time be acknowledged as having been deemed admitted. Based on these facts, this court should grant Applicant its Motion for Summary Judgment and issue an Order accordingly.

/JoAnne Denison/
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CERTIFICATE OF SERVICE

I certify that I have mailed a copy via first class mail, postage prepaid of the following pleadings

a) PLAINTIFF'S MOTION FOR DEFAULT SUMMARY JUDGMENT FOR FAILURE TO ANSWER PLAINTIFF'S REQUESTS FOR ADMISSION

to

*Mr. Andrew C. Aitken in care of Cantine Caputo S.p.A.
Venable, LLP
P.O.Box 34385
Washington, DC 20043-9998*

on this April 28, 2006

JoAnne Denison

JoAnne M. Denison

Hazel Espinar

Counsel of Record for Applicant