

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

----- X

JACK LEBEWOHL, JEREMY LEBEWOHL,
UNCLE ABIES DELI INC. d/b/a 2ND AVE DELI,
UNCLE ABIES DELI ON FIRST INC. d/b/a 2ND AVE DELI,
AND UNCLE ABIES DELI SANDWICH TRADEMARKS LLC,

Plaintiffs,

-against-

Index No. 11-cv-3153 (PAE)

HEART ATTACK GRILL LLC, HAG LLC,
JON BASSO, DIET CENTER LLC (TEXAS) AND
DIET CENTER LLC (DELAWARE)

Defendants.

----- X

**MEMORANDUM OF LAW IN SUPPORT OF
PLAINTIFFS' MOTION FOR SUMMARY JUDGMENT**

William W. Chuang (WC3050)
Jakubowitz & Chuang LLP
325 Broadway, Suite 301
New York, NY 10007

Attorneys For Plaintiffs

TABLE OF CONTENTS

PRELIMINARY STATEMENT..... 1

THE RELEVANT FACTS..... 3

THE APPLICABLE SUMMARY JUDGMENT STANDARD 6

ARGUMENT 9

PLAINTIFFS USE THE “INSTANT HEART ATTACK SANDWICH” MARK AS A TRADEMARK
..... 9

THERE IS NO LIKELIHOOD OF CONFUSION 10

The Similarity Of The Marks 11

Competitive Proximity Of The Products And The Sophistication Of The Buyers
..... 12

Likelihood Of Bridging The Gap 13

Actual Confusion 14

Plaintiffs Acted In Good Faith In Adopting The Marks 14

Quality Of Plaintiffs’ Services..... 15

DEFENDANTS’ REMAINING COUNTERCLAIMS SHOULD BE DISMISSED WITH RESPECT TO
THE INSTANT HEART ATTACK SANDWICH 16

IF THERE IS A LIKELIHOOD OF CONFUSION, PLAINTIFFS ARE ENTITLED UNDER
CONCURRENT USE TO SUPERIOR RIGHTS TO NEW YORK CITY 17

CONCLUSION..... 18

TABLE OF AUTHORITIES

Cases

- Anderson v. Liberty Lobby, Inc., 477 U.S. 272 (1986).
- Cadbury Beverages, Inc. v. Cott Corp., 73 F.3d 474 (2d Cir. 1996).
- Celotex Corp. v. Catrett, 477 U.S. 317 (1986).
- Coca-Cola Co. v. Stewart, 621 F.2d 287 (8th Cir. 1980).
- Dawn Donut Co. v. Hart's Food Stores, Inc., 67 F.2d 358 (2d Cir. 1959).
- Franchised Stores of New York, Inc. v. Winter, 394 F.2d 664 (2d Cir. 1968).
- Franklin Res., Inc. v. Franklin Credit Management Corp., 988 F. Supp. 322 (S.D.N.Y. 2001).
- Hormel Foods Corp. v. Jim Henson Prods, Inc., 73 F.3d 497 (2d Cir. 1996).
- Katzenbach v. McClung, 379 U.S. 294 (1964).
- Lang v. Retirement Living Publishing Co., Inc., 949 F.2d 576 (2d Cir. 1991).
- Larry Harmon Pictures Corp. v. Williams Restaurant Corp., 929 F.2d 662 (Fed. Cir. 1991).
- Omicron Capital, LLC v. Omicron Capital, LLC, 433 F.Supp.2d 382 (S.D.N.Y. 2006).
- Maier Brewing Co. v. Fleischmann Distilling Corp., 390 F.2d 117 (9th Cir. 1968).
- In Re Marriot Corp., 59 C.C.P.A. 1055 (CCPA 1972) .
- New York Stock Exchange, Inc. v. New York, New York Hotel LLC, 293 F.3d 550 (2d Cir. 2002).
- Patsy's Italian Restaurant, Inc. v. Banas, 958 F.3d 254 (2d Cir. 2011).
- Playtex Prods., Inc. v. Georgia-Pacific, Inc., 67 U.S.P.Q.2d 1923 (S.D.N.Y. 2003).
- Polaroid Corp. v. Polarad Elecs. Corp., 287 F.2d 492 (2d Cir. 1961).
- Pure Foods v. Minute Maid Corp., 214 F.2d 792 (5th Cir. 1954).
- Rescuecom Corp. v. Google, Inc., 562 F.3d 123 (2d Cir. 2009).
- In Re Silenus Wines, Inc., 557 F.2d 806 (CCPA 1977).
- Shatel Corp. v. Mao Tao Lumber and Yacht Corp., 697 F.2d 1352 (1983).

In Re Sones, 590 F.3d 1282 (Fed. Cir. 2009).

Steele v. Bulova Watch Co., Inc., 344 U.S. 280 (1952).

United We Stand America, Inc. v. United We Stand, America New York, Inc., 128 F.3d 86 (2d Cir. 1997).

Vanity Fair Mills v. T. Eaton Co., 234 F.2d 633 (2d Cir. 1956)

World Carpets, Inc. v. Dick Littrell's New World Carpets, 438 F.2d 482 (5th Cir. 1971)

Statutes

15 U.S.C. § 1051.

15 U.S.C. § 1052.

15 U.S.C. § 1114.

15 U.S.C. § 1127.

Other Sources

Trademark Manual of Examination Procedures (TMEP) §§ 901, 1207.0(a).

Plaintiffs JACK LEBEWOHL, JEREMY LEBEWOHL, UNCLE ABIES DELI INC. d/b/a 2ND AVE DELI, UNCLE ABIES DELI ON FIRST INC. d/b/a 2ND AVE DELI, AND UNCLE ABIES DELI SANDWICH TRADEMARKS LLC (hereinafter, the “Plaintiffs” or “Deli”) respectfully submit this memorandum in support of their motion for summary judgment pursuant to Rule 56 of the Federal Rules of Civil Procedure against Defendants HEART ATTACK GRILL LLC, HAG LLC, JON BASSO, DIET CENTER LLC (TEXAS) AND DIET CENTER LLC (DELAWARE) (collectively, “Defendants” or “HAG”). Plaintiffs seek a judgment that there is no likelihood of consumer confusion between Plaintiffs’ “Instant Heart Attack Sandwich” and proposed “Triple Bypass Sandwich” marks and Defendants’ “Heart Attack Grill” and “Triple Bypass Burger” marks; that the Defendants’ remaining counterclaims be dismissed as against the Instant Heart Attack Sandwich; and that the Plaintiffs be allowed to register their marks, or in the alternative, if there is a likelihood of confusion, then Plaintiffs have exclusive use of the mark “Instant Heart Attack Sandwich” in the New York tri-state region to the exclusion of Defendants’ right to use the “Heart Attack Grill” mark in the same region.

PRELIMINARY STATEMENT

The parties agree that there is no likelihood of confusion—Jon Basso, testifying on behalf on the Defendants, admits that he does not see any confusion because “they are different things. Theirs is a sandwich, this is a burger.” Nevertheless, Defendants refuse to allow Plaintiffs to register the Instant Heart Attack Sandwich and Triple Bypass Sandwich marks. Defendants’ objections are self-contradictory and incorrect as a matter of law. As there is no likelihood of confusion, Plaintiffs are entitled to a judgment in their favor and registration of their marks.

Plaintiffs operate the 2ND AVE DELI, a well-known and well-regarded kosher deli-style restaurant which opened its doors in 1954. Around 2004, the Deli began using the “Instant Heart Attack Sandwich” mark for a *sandwich* consisting of potato latkes and the customer’s choice of meats. In October 2005, Defendants started to use the “Heart Attack Grill” mark for *restaurant services* relating to a medically-themed restaurant serving a limited, decidedly non-kosher menu of bacon cheeseburgers, butterfat milk shakes, and French fries prepared in lard served by waitresses dressed as nurses.

Defendants concede that there is no likelihood of confusion. Mr. Basso testified that even if the Deli moved to Las Vegas, there would be no likelihood of confusion. (Basso Dep. 120:23-121:12.)¹ Furthermore, the goods offered by the Deli and HAG are not competitive with each other in the marketplace; as Mr. Basso noted, they are different things. Nor do the parties spend much money advertising their respective marks. The parties do not use the marks in the same manner. Accordingly, Plaintiffs are entitled to summary judgment that there is no likelihood of confusion and that their mark should be registered. As Defendants’ counterclaims rely on a finding that there is a likelihood of confusion, they should be dismissed.

Alternatively, if there is a likelihood of confusion, Plaintiffs are entitled to continue its use of the “Instant Heart Attack Sandwich” mark in the New York tri-state area to the exclusion of Defendants’ use of the mark “Heart Attack Grill.” Concurrent use applies only when there is a finding that the marks are likely to confuse consumers. In that event, the Deli, as the party who is senior in time but junior in registration, may continue its use of the

¹ Basso Dep. refers to the transcript of the deposition of Jon Basso held on January 13, 2012. The testimony bound all defendants. Relevant excerpts of the transcript are attached as Exhibit A to the SUF.

“Instant Heart Attack Sandwich” mark in the New York tri-state region subject to limitations against expansion of its use to prevent confusion. Defendants, who are junior in time but senior in registration, may not use the “Heart Attack Grill” mark in New York tri-state region, as this encroachment onto the Deli’s territory would only amplify any consumer confusion. Therefore, if there were a likelihood of confusion, Plaintiffs are entitled to summary judgment that it can continue the use of the mark “Instant Heart Attack Sandwich” in the New York tri-state region and prevent Defendants from using the mark “Heart Attack Grill” there.

THE RELEVANT FACTS

The facts relevant to this motion are fully set forth in the Statement Pursuant to Local Rule 56.1 in Support of Plaintiffs’ Motion For Summary Judgment (the “SUF”) and the accompanying declaration of Jack Lebewohl. For the convenience of the Court, the most salient facts are summarized below.

The 2ND AVE DELI opened in 1954 at 156 Second Avenue in the Lower East Side of Manhattan. (Declaration of Jack Lebewohl In Support ¶ 2.) It has always been a traditional kosher deli restaurant that serves a full menu of food and drink. (Id. ¶¶ 3, 4.) In accordance with dietary kosher law, the Deli has never served any dairy or pork products. (Id. ¶ 4.) The Deli has become well-known in the United States as a kosher deli, especially as competing delis such as Carnegie, Katz’s, and Stage are not kosher. (Id. ¶ 3.) Articles have been written about the restaurant in national publications such as the New York Times and Wall Street Journal, and featured on the Daily Show with Jon Stewart, CBS News, and other national and local media. (Id ¶ 5.) A 2ND AVE DELI cookbook was published in 1999. (Id.)

On January 1, 2006, the Deli closed its Second Avenue location. (Id. ¶ 2.) In November, 2007, the Deli reopened at 162 East 33rd Street in Midtown, and in August 2011, it opened a second location at 1442 First Avenue on the Upper East Side. (Id.)

The Deli introduced the Instant Heart Attack Sandwich in 2004 and put it on its menu the same year. (Id. ¶ 6.) The “Instant Heart Attack Sandwich” mark is used in relation to a sandwich made from two large potato pancakes (*latkes*) packed with the customer’s choice of corned beef, pastrami, turkey, or salami. (Id.)

The sandwich was an instant hit. A review of the Deli published on Chowhound on May 19, 2004 said that it was “flavourful and good.” (SUF Ex. B.) The sandwich also received a mention in the July 2004 issue of the Morning Calm newsletter of Korean Airlines, which reviewed New York delis. (SUF Ex. C.) That article also noted that the Deli is kosher. (Id.) On January 13, 2004, a commenter on Chowhound recommended the Deli and the Instant Heart Attack Sandwich to a prospective visitor asking for the “quintessential NY experience.” (SUF Ex. D.)

Plaintiffs filed an application to register “Instant Heart Attack Sandwich” mark with the United States Patent and Trademark Office on September 29, 2010. (SUF Ex. E.) Plaintiffs also filed an intent-to-use application for the proposed mark “Triple Bypass Sandwich.” (SUF Ex. F.) The Deli was not aware of Defendants’ Triple Bypass Burger when it conceived of the mark, and had no intention of pursuing a medical theme with its long-established kosher deli restaurant. (Lebewohl Decl. ¶¶ 9, 11.)

On March 29, 2011, the Deli received a letter from Defendants alleging trademark infringement and threatening to sue if the Deli did not withdraw the application and stop using the “Instant Heart Attack Sandwich” and “Triple Bypass Sandwich” marks. (SUF Ex.

G.) Negotiations between the parties were not successful, and Plaintiffs filed this lawsuit on May 10, 2011. (Complaint, D.E. 1.)

Defendants counterclaimed on July 11, 2011. (Answer With Counterclaims, D.E. 6.) In Count I, HAG alleged that its marks were diluted by blurring and tarnishment in violation of the Federal Trademark Dilution Act. (Id.) In Count II, HAG sought to prevent the Deli from registering the IHAS and TBS marks because there was a likelihood of consumer confusion. (Id.) In Count III, HAG sought to stop the Deli from using the “Instant Heart Attack Sandwich” and “Triple Bypass Sandwich” marks outside of New York City. (Id.) In Count IV, HAG sought concurrent use limiting the Deli to New York City while allowing itself to use “Heart Attack Grill” for restaurant services by HAG throughout the United States, including New York. (Id.) On January 5, 2012, the Court granted HAG’s request to voluntarily dismiss Count I. (D.E. 41.)

Defendants opened the Heart Attack Grill in late 2005 as a medically-themed restaurant where waitresses are dressed as nurses, and customers, who are called “patients,” are given a medical armband upon entrance. (SUF ¶ 15, Ex. I.) The Heart Attack Grill opened in Tempe, Arizona, before closing and moving to Phoenix, Arizona. (SUF ¶ 15.) Thereafter, the Heart Attack Grill closed that location and moved to Chandler, Arizona. (Id.) Eventually, that location closed as well and the restaurant moved to Dallas, Texas. (Id.) The Dallas location was closed within six months of opening. Defendants then opened a location in Las Vegas, Nevada, which is the only location currently in operation. (Id.)

The hospital theme of the Heart Attack Grill is evidenced by its limited menu, which consists of the Single Bypass Burger, the Double Bypass Burger, the Triple Bypass Burger, and the Quadruple Bypass Burger. (SUF ¶ 17.) All burgers are served with cheese and

bacon. (Id.) The only side items served is the “Flatliner Fries,” which is deep fried in pure lard. (Id.) The ButterFat Shake is made from pure cream. (Id.) In continuing the theme, all customers need to wear a hospital gown while in the Grill. (Id.)

Under these facts, there is no likelihood of consumer confusion.

THE APPLICABLE SUMMARY JUDGMENT STANDARD

Under Rule 56 of the Federal Rules of Civil Procedure, summary judgment shall be granted “if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue of material fact and that the moving party is entitled to judgment as a matter of law.” Summary judgment is appropriate when the nonmoving party cannot establish each element of its claim “since a complete failure of proof concerning an essential element of the nonmoving party’s case necessarily renders all other facts immaterial.” Celotex Corp. v. Catrett, 477 U.S. 317, 323 (1986). Disputes over immaterial facts should be disregarded on summary judgment because “only disputes over facts that might affect the outcome of the suit under the governing law will properly preclude the entry of summary judgment. Factual disputes that are irrelevant or unnecessary will not be counted.” Anderson v. Liberty Lobby, Inc., 477 U.S. 272, 247 (1986). “If the evidence is merely colorable, or is not significantly probative, summary judgment may be granted.” Id. At 249-250.

Summary judgment is appropriate when the holder of the mark fails to raise a genuine issue of material fact on the existence of a likelihood that the other party’s use of its mark will confuse reasonably prudent purchasers. New York Stock Exchange, Inc. v. New York, New York Hotel LLC, 293 F.3d 550, 554-555 (2d Cir. 2002) (granting summary

judgment of non-infringement where there is no genuine issue of material fact about the likelihood of confusion).

ARGUMENT

I. PLAINTIFFS USE THE “INSTANT HEART ATTACK SANDWICH” MARK AS A TRADEMARK

The Deli uses the “Instant Heart Attack Sandwich” mark as a trademark. The mark is used to distinguish the sandwich from competing sandwiches, and to indicate that the Deli is the source of the sandwich. 15 U.S.C. § 1127 (a trademark is a word or other device used by a person to “identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.”)

Use of the mark “Instant Heart Attack Sandwich” on menus along with a description of the sandwich constituted use on “displays associated” with goods within the scope of the Lanham Act. In Re Marriot Corp., 59 C.C.P.A. 1055, 1056 (CCPA 1972) (menu describing sandwich’s ingredients sufficiently associate a trademark with the sandwich). There is no requirement for a product to be labeled or wrapped with the mark. The Lanham Act provides that if placement of tags or labels on a product is impracticable, then the mark can be used on documents associated with the product. 15 U.S.C. § 1127. There is no requirement that there be a picture of the sandwich on the menu or that the trademark be used on a store sign. In Re Sones, 590 F.3d 1282, 1287 (Fed. Cir. 2009) (use of trademark without picture of product sufficient).

In order to register a mark, the applicant must show that the trademark has been used in commerce. 15 U.S.C. § 1051(a); Trademark Manual of Examination Procedures (TMEP) § 901. Similarly, in order to demonstrate infringement, the holder of a trademark

must show that the allegedly-infringing mark was used in commerce. 15 U.S.C. § 1114(1); Rescuecom Corp. v. Google, Inc., 562 F.3d 123, 127 (2d Cir. 2009) (a complainant fails to state a claim under the Lanham Act unless it alleges that the alleged infringer has made “use in commerce” of the mark within the meaning of 15 U.S.C. § 1127).

The Lanham Act defines “use in commerce” as: “

the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark. For purposes of this chapter, a mark shall be deemed to be in use in commerce— (1) on goods when— (A) it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale and (B) the goods are sold or transported in commerce...” 15 U.S.C. § 1127.

This definition of “use in commerce” applies to both registration and infringement. In Re Silenus Wines, Inc., 557 F.2d 806, 812 (CCPA 1977); 15 U.S.C. § 1127. Therefore, if the use of a mark satisfies the test of “use in commerce” for infringement purposes assuming there is likelihood of confusion, then the same use of the mark would also be sufficient for registration if there is no likelihood of confusion.

The Lanham Act defines commerce as “all commerce which may lawfully be regulated by Congress,” which reflects congressional intent to legislate to the limits of its authority under the Commerce Clause. E.g. United We Stand America, Inc. v. United We Stand, America New York, Inc., 128 F.3d 86, 92 (2d Cir. 1997); Steele v. Bulova Watch Co., Inc., 344 U.S. 280, 283-284 (1952).

Therefore, Courts have consistently held that purely intrastate activities may constitute “use in commerce” within the meaning of the Lanham Act. Dawn Donut Co. v. Hart’s Food Stores, Inc., 67 F.2d 358, 365 (2d Cir. 1959); United We Stand America, Inc., *supra*; Larry Harmon Pictures Corp. v. Williams Restaurant Corp., 929 F.2d 662, 665 (Fed.

Cir. 1991); In Re Silenus, 557 F.2d at 666. There is no requirement that trademarked goods must be sold or transported across state lines in order to be subject to the protections of the Lanham Act. See, e.g., Dawn Donuts, supra at 361-362 (intrastate sale of packages of donut mix bearing trademark subject to Lanham Act); Franchised Stores of New York, Inc. v. Winter, 394 F.2d 664 (2d Cir. 1968) (intrastate sale of unlicensed ice cream in licensed Carvel store constitutes Lanham Act use in commerce); Coca-Cola Co. v. Stewart, 621 F.2d 287, 290-91 (8th Cir. 1980) (intrastate sale of soda); Maier Brewing Co. v. Fleischmann Distilling Corp., 390 F.2d 117 (9th Cir. 1968) (intrastate sale of beer bearing trademark); Pure Foods v. Minute Maid Corp., 214 F.2d 792 (5th Cir. 1954) (intrastate sale of meat bearing trademark); World Carpets, Inc. v. Dick Littrell's New World Carpets, 438 F.2d 482, 489 (5th Cir. 1971) (intrastate sales of carpets bearing trademark); Shatel Corp. v. Mao Tao Lumber and Yacht Corp., 697 F.2d 1352, 1356-57 (advertising and solicitation of sales of a boat across state lines).

Purely intrastate activities become subject to the provisions of the Lanham Act and Commerce Clause when they have a substantial effect on interstate commerce. E.g. Vanity Fair Mills v. T. Eaton Co., 234 F.2d 633, 641 (2d Cir. 1956); Franchised Stores of New York, Inc., 394 F.2d at 669-70; Katzenbach v. McClung, 379 U.S. 294, 302 (1964) (Congress can regulate under the Commerce Clause restaurants offering to serve interstate travelers or serving food, a substantial portion of which has moved in interstate commerce).

The Deli provides its services in interstate commerce, and the Instant Heart Attack Sandwich was sold as part of that service. Sales of goods do not need to be substantial in order to fall under the scope of the Lanham Act. In Franchised Stores, the de minimis sale of non-Carvel products was found to justify Commerce Clause jurisdiction. Supra at 671. The

Second Circuit found that restaurant services were provided in interstate commerce when the restaurant was accessible from several nearby interstate highways, and there were numerous articles about the restaurant in publications which require an interstate audience. Patsy's Italian Restaurant, Inc. v. Banas, 958 F.3d 254, 268 (2d Cir. 2011).

These factors all apply here. The Deli serves many interstate travelers, and it is located near several nearby interstate highways. (Lebewohl Decl. ¶ 13.)

Articles about the Deli and the Instant Heart Attack Sandwich have been published in the New York Times, Chowhound, and the newsletter for Korean Airlines. (SUF ¶. The Deli has shipped products to customers across the country since at least 2004. As in Katzenbach, a substantial portion of the food sold by the Deli has moved in interstate commerce. Financial documents show that in 2003 to 2004, the Deli paid hundreds of thousands of dollars for the out-of-state provision of sausages, meats, wines, and groceries.

II. THERE IS NO LIKELIHOOD OF CONFUSION

To prevail on a claim of trademark infringement, the owner of a trademark has to show a probability, not just a possibility, of confusion. Playtex Prods., Inc. v. Georgia-Pacific, Inc., 67 U.S.P.Q.2d 1923, 1926 (S.D.N.Y. 2003). Confusion exists where there is a likelihood that an appreciable number of ordinarily prudent purchasers are likely to be misled or confused as to the source of the goods in question. Id., citing New York Stock Exchange, 293 F.3d at 554-555.

To determine whether or not such likelihood of confusion exists, courts in this circuit employ the eight-factor test in Polaroid Corp. v. Polarad Elecs. Corp.: (1) the strength of the allegedly-infringed mark; (2) the similarity of the marks; (3) the competitive proximity of the products; (4) the likelihood that the owner of the allegedly-infringing

mark will “bridge the gap” and offer a product like the allegedly-infringing product; (5) actual confusion between services; (6) good faith on the allegedly-infringing mark; (7) the quality of the allegedly-infringing products; and (8) the sophistication of the buyers. 287 F.2d 492, 495 (2d Cir. 1961), cert. denied, 368 U.S. 820 (1961).

The application of these factors to this case reveals that there is no genuine issue of material fact with regard to whether the Deli’s use of the mark “Instant Heart Attack Sandwich” is likely to cause consumer confusion with the Defendants’ use of the mark “Heart Attack Grill.” Plaintiffs will not discuss the first Polaroid factor.

a. The Similarity Of The Marks.

This element of the Polaroid test “looks to whether the similarity of the marks is likely to provoke confusion among prospective purchasers. In making this determination, a court should look at the general impression created by the marks, taking into account all factors that potential purchasers will likely perceive and remember.” Franklin Res., Inc. v. Franklin Credit Management Corp., 988 F. Supp. 322, 328 (S.D.N.Y. 2001) citing Lang v. Retirement Living Publishing Co., Inc., 949 F.2d 576, 581 (2d Cir. 1991) (citation omitted).

The mark “Instant Heart Attack Sandwich” is not similar to the mark “Heart Attack Grill” ; the former describes a sandwich, and the latter describes a type of medically-themed restaurant. Furthermore, Plaintiffs’ mark is prepended by the word “Instant.”

The proposed mark “Triple Bypass Sandwich” resembles the “Triple Bypass Burger” mark. However, sandwiches are distinct from burgers in the marketplace. (Basso Depo, pp. 104:20-105:2). The market distinguishes between restaurants such as McDonald’s, which serves burgers and fries, and Subway’s, which serves sandwiches and chips.

There are also significant differences in the overall impressions created by the parties' use of their respective marks. Defendants use the "Heart Attack Grill" mark as the name of their eponymous restaurant. The Heart Attack Grill mark is used on the exterior signage of the restaurant, on the Internet, and on various T-shirts, almost always with a reference to its Bypass Burgers and Flatliner Fries, and logos furthering the medical/hospital theme of the restaurant. (Basso Transcript pp. 79: 22). The Triple Bypass Burger mark is used throughout the restaurant in conjunction with pictures of the burger and the other products. (Basso Transcript pp. 79: 22).

On the contrary, Plaintiffs use the "Instant Heart Attack Sandwich" mark only on their menu and website along with the "2ND AVE DELI" mark and a description of the sandwich. The Deli plans to use the Triple Bypass Sandwich mark in the same way. Therefore, the general impressions created by the parties' trademarks are very dissimilar. See Franklin Res., Inc., 988 F. Supp. at 328-329 (holding that general and overall impressions of "Franklin Credit" and "Franklin Resources" are dissimilar when the former used its mark on stationary, and the latter used its mark extensively in advertising, promotion, and in conjunction with other marks and images not used by Franklin Credit); (Basso Depo. pp. 105:1-6) ("A: They are different things. Theirs is a sandwich, this is a burger. They – I use marks, my marks are widely publicized. They use terms. Their terms are little known outside the person actually reading the menu. No, I don't think there is any confusion.")

b. Competitive Proximity Of The Products And The Sophistication Of The Buyers

The "proximity of the products" inquiry concerns the extent the two products compete with each other. Cadbury Beverages, Inc. v. Cott Corp., 73 F.3d 474, 480 (2d Cir.

1996). The “sophistication of the buyers” factor recognizes that the likelihood of confusion depends in part on the sophistication of the relevant purchasers, and is considered with the proximity factor as they are analogous. Id.

The parties serve vastly different client bases. The Deli is widely known as a kosher restaurant, and markets itself as a kosher restaurant on its menu. Meanwhile, Defendants strongly promote the Heart Attack Grill as a hospital-themed restaurant with waitresses dressed as seductive nurses, and serves greasy, caloric, unhealthy cheeseburgers and fries prepared with lard, none of which is kosher.

As a result, prospective purchasers of the Heart Attack Grill’s restaurant services will not accidentally seek out or become confused with the Instant Heart Attack Sandwich or the proposed Triple Bypass Sandwich served by Plaintiffs’ kosher restaurant, and vice versa, even if the two establishments were to be across the street from each other. The products in question are not competitively proximate at all.

c. Likelihood of Bridging the Gap.

This Polaroid factor considers the trademark holder’s “interest in preserving avenues of expansion and entering into related fields.” Hormel Foods Corp. v. Jim Henson Prods, Inc., 73 F.3d 497, 504 (2d Cir. 1996). Defendants have no plans to expand their restaurant, or to expand to New York. Furthermore, there is no likelihood that the Heart Attack Grill can offer a kosher burger, because it serves dairy products on its burgers and shakes, puts bacon on its burgers, and serves fries prepared with lard. It is unlikely that the Heart Attack Grill will ever serve a sandwich with potato latke pancakes, pastrami, corned beef, turkey, or salami.

Similarly, Plaintiffs have no desire to expand into a medically-theme restaurant, or to stop being a kosher restaurant, which it has been since its inception in 1954. It will not stop serving the Instant Heart Attack Sandwich with potato latkes, and will not serve it or any products with cheese or bacon. Neither will the Deli sell the Triple Bypass Sandwich with cheese or bacon. The Deli has no plans to offer any sandwiches using the word “Bypass” other than the TBS.

Therefore, there is no likelihood that the gap between the products will be bridged.

d. Actual Confusion.

There is no evidence of actual confusion between the Heart Attack Grill and the Instant Heart Attack Sandwich. The parties have been concurrently selling their respective products for over six years. There has not been a single incidence of actual confusion during that entire period. The lack of any actual confusion during the six years the parties have been selling the products is very strong evidence that there is no likelihood of consumer confusion. Playtex Prods., Inc., 67 U.S.P.Q.2d at 1929 (no incidents of actual confusion in fourteen months strong evidence against likelihood of confusion) (citing Nabisco Inc. v. PF Brands, Inc., 191 F.3d 208, 228 (2d Cir. 1999)).

e. Plaintiff Acted In Good Faith In Adopting the Marks

This factor concerns whether the alleged infringer adopted its mark with the intention of capitalizing on the trademark owners reputation and goodwill and any confusion between his and the senior user’s product. Franklin Res., Inc., 988 F. Supp. at 336, citing Cadbury Beverages, Inc., 73 F.3d at 482-83. As Plaintiffs adopted the Instant Heart Attack Sandwich mark prior to Defendants used the Heart Attack Grill, Plaintiff clearly adopted the IHAS mark in good faith.

The Deli was not aware of the Defendants or the Triple Bypass Burger when it selected the TBS mark. The Deli did not intend to trade on the goodwill of the Defendants' medically-themed restaurant. Rather, the Deli saw the TBS as a natural progression of its long-running Instant Heart Attack Sandwich. Plaintiffs did not register and have no intention of registering the Single, Double, or Quadruple Bypass Sandwiches or any other trademarks with a medical theme.

f. Quality Of Plaintiffs' Services.

This factor considers whether the trademark holder's reputation can be tarnished by the merchandise of the alleged infringer. Franklin Res., Inc., Id. at 337, citing Cadbury Beverages, Inc., Id. at 483. The Instant Heart Attack Sandwich has been well-reviewed by many consumers. There is no evidence that the Heart Attack Grill's reputation can be tarnished, and in fact, Defendants voluntarily dismissed their tarnishment claims with prejudice.

In conclusion, the Polaroid test strongly favors the Deli, demonstrating that there is no likelihood of confusion that Defendant's use of the marks "Instant Heart Attack Sandwich" or "Triple Bypass Sandwich" will result in consumer confusion. Therefore, the Deli's motion for summary judgment that there is no likelihood of confusion should be granted.

III. DEFENDANTS' REMAINING COUNTERCLAIMS SHOULD BE DISMISSED WITH RESPECT TO THE INSTANT HEART ATTACK SANDWICH

Defendants have filed counterclaims requesting that the Deli should not be allowed to register the mark "Instant Heart Attack Sandwich", and have sought a judgment preventing the Deli from expanding its use of the mark, and a judgment for concurrent use beyond New York City. As there is no likelihood of confusion, the Plaintiffs' registration for

the “Instant Heart Attack Sandwich” and “Triple Bypass Sandwich” marks should issue, and the Defendants’ counterclaims should be dismissed.

All of Defendants’ counterclaims fail if there is no likelihood of confusion.² In Count II, Defendants claim that there would be a likelihood of consumer confusion if the mark “Instant Heart Attack Sandwich” were to be registered. As shown above, Plaintiffs have already used the Instant Heart Attack Sandwich mark in interstate commerce, and intend to use the “Triple Bypass Sandwich” mark in interstate commerce. They are therefore entitled to registration of the trademarks. Defendants are incorrect to the extent they allege that registration would expand Plaintiffs’ rights in the mark. Registration of a mark is not a use of the mark. 15 U.S.C. § 1127. Nor is registration an act of infringement under the Lanham Act. 15 U.S.C. § 1114. Registration is not a Polaroid factor. Therefore, if there is no likelihood of confusion, Plaintiffs are entitled to registration of their marks.

In Count III, Defendants claim that allowing the mark to expand to outside of New York would cause a likelihood of confusion. Defendants cite no basis whereupon a mark is limited in use in the face of a non-conflicting mark. As shown above, there is no likelihood of confusion even if the Deli were across the street from a Heart Attack Grill. Defendants tacitly agree to the extent they claim they can expand to New York without a likelihood of confusion. Without a likelihood of confusion, there is no reason to limit Plaintiffs to New York City while allowing Defendants to open right across the street from the Deli in New York. If there is no likelihood of confusion, Count III should be dismissed.

² Defendants’ Counterclaims state that Plaintiffs’ filing demonstrate a plan to expand its use of the mark “Instant Heart Attack Sandwich” to restaurant services. That is not the case. The Instant Heart Attack Sandwich was filed under International Class 30 for sandwiches.

In Count IV, Defendants claim for concurrent use. However, concurrent use does not apply when there is no likelihood of confusion. 15 U.S.C. § 1052(d) (though a mark cannot be registered if it is likely to cause confusion with another mark, the USPTO can issue concurrent registrations of conflicting marks if it determines that there are certain conditions and limitations as to the mode or place of use of the marks or the goods that would prevent that confusion); Omicron Capital, LLC v. Omicron Capital, LLC, 433 F.Supp.2d 382, 395 (S.D.N.Y. 2006) (concurrent use registration cannot be sought where there was no likelihood of confusion and no intent to bridge the gap) (holding that there is no likelihood of confusion between two users of the identical trademark “Omicron Capital, LLC.”); TMEP § 1207.04(a) (concurrent use application applies to a “conflicting mark”).

Therefore, because there is no likelihood of confusion, Defendants’ remaining counterclaims should be dismissed.

IV. IF THERE IS A LIKELIHOOD OF CONFUSION, PLAINTIFFS ARE ENTITLED UNDER CONCURRENT USE TO SUPERIOR RIGHTS TO NEW YORK CITY

In the alternative, if its motion for summary as to likelihood of confusion is denied, Plaintiffs request a summary judgment that if there is a likelihood of confusion, it may continue to use the mark “Instant Heart Attack Sandwich” in New York City, and may exclude Defendants from expanding to New York City.

Plaintiffs have adopted the mark “Instant Heart Attack Sandwich” since at least 2004, more than a year before Defendants first began to use the mark “Heart Attack Grill.” Even though Defendants were first to register, they are junior users of the mark who only use the Heart Attack Grill at a single location in Nevada. Therefore, if there is a likelihood of confusion and the doctrine of concurrent use applies, Plaintiffs are entitled to exclusive use of the mark “Instant Heart Attack Sandwich” in the New York tri-state region, and

