

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

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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.

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COUNTER-STATEMENT TO DEFENDANTS' STATEMENT OF FACTS
PURSUANT TO LOCAL RULE 56.1

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Attorneys For Plaintiffs

Exhibit	Date	Description
A	5/19/2004	Chowhound review of the Instant Heart Attack Sandwich.
B	7/2004	Morning Calm (Korean Airlines) Review of Delis Mentioning IHAS On Page PLFS004292.
C	1/13/2005	Chowhound recommendation for 2ND AVE DELI and Instant Heart Attack Sandwich on PLFS004295.
D	11/16/2011	Excerpts From Depo. Tr. Of Mike Shaldjian of MediaWatch, AZ.
E	2004-2005	2004-2005 Menu listing IHAS on PLFS000492, and address of old Deli location 156 Second Avenue that closed in late 2005 on PLFS000493 on lower left-hand corner.
F	8/10/2005	Invoice No. 2044 from Orbis Brynmore Printing dated August 10, 2005 stating "Ordered By Jack - 7-28-05".
G	1/6/2006	New York Times article discussing closure of old Deli location in late 2005/early 2006, and refers to Instant Heart Attack Sandwich.
H	12/18/2007	Bloomberg article discussing the Deli, and the Instant Heart Attack Sandwich.
I	9/29/2010	Trademark Application, Triple Bypass Sandwich
J	1/13/2012	Excerpts From Deposition Of Jon Basso

Plaintiffs submit this Counter-Statement to Defendants' Statement of Facts Pursuant to Local Rule 56.1.

1. Admit.

- a. Deny that the Instant Heart Attack Sandwich mark is confusingly similar to the Heart Attack Grill mark, which is a conclusion of law and not a statement of fact; Defendants admit that there is no likelihood of confusion. (Decl. of Jon Basso, dated 12-5-2011, ¶ 3.) Admit that the Trademark Examiner did not register the Deli's mark on the basis of likelihood of confusion.
- b. Admit that Plaintiffs have used the Instant Heart Attack Sandwich trademark since at least May 19, 2004 and that the lawsuit was filed on May 10, 2011. Deny that there are no written records to support use of the mark in 2004. Plaintiffs have submitted the May 19, 2004 Chowhound review (Ex. A), July, 2004 Morning Calm article (Ex. B), January 13, 2005 Chowhound review (Ex. C), 2004-2005 Menu (Ex. E), August 10, 2005 Invoice (Ex. F), January 6, 2006 New York Times Article (Ex. G), and December 18, 2007 Bloomberg article (Ex. H). These documents corroborate the testimony of Jack Lebewohl that he conceived of the Instant Heart Attack Sandwich in 2004 and put it on the menu at that time. (Decl. of Jack Lebewohl, ¶ 6.)

2.
 - a. Admit. Plaintiffs' sales records before April 2008 are unavailable due to a transition to a new computer system.
 - b. Admit that Plaintiffs have a May 19, 2004 Chowhound review demonstrating that the Instant Heart Attack Sandwich was sold as of that date. (Exhibit A.) Aver that Plaintiffs have produced the July, 2004 Morning Calm article (Ex. B), and

January 13, 2005 Chowhound review (Ex. C) demonstrating use of the Instant Heart Attack Sandwich trademark prior to the filing date of Defendants' marks. Deny all other allegations in Paragraph 2(b), which are legal arguments and not statements of fact.

c. Deny. The May 19, 2004 Chowhound review (Ex. A), July 2004 Morning Calm (Ex. B), and January 13, 2005 Chowhound review (Ex. C) are all dated before HAG's Critical Date. The menu bearing the address of the old Deli location and the August 10, 2005 invoice referring to a July 28, 2005 menu order corroborate an earlier date of first use in interstate commerce.

d. Admit that the application alleges first use *as early as* May 19, 2004.

3. a. Admit.

b. Admit.

c. Admit that the Heart Attack Grill mark is used on Defendants' website, but deny that this constitutes trademark use for restaurant services, which is a conclusion of law and not a statement of fact. Aver that Defendants only offer restaurant services in its single restaurant location in Las Vegas. (Depo. Tr. Of Jon Basso pp. 74:13-75:2.) (Ex. J.)

Further deny the statements of Sub-Paragraph 3(c) on the basis that Defendants' SJ Exhibits 9 and 10 are inadmissible. These documents purport to be from Media Watch AZ but they were not authenticated by that company's custodian of records. (Exhibit C, Excerpts From Depo. Tr. of Mike Shaldjian pp. 6:7-15, pp. 9:15-11:1.)

Furthermore, the documents contain "Nielsen Audience" statistics that were obtained by Media Watch AZ from Nielsen and are hearsay. (Shaldjian Depo. Tr. 8:8-

17.) Also, the Nielsen statistics are inadmissible without expert witness testimony on how they were tabulated. The HAG SJ Exhibits are themselves the result of technical compilation without accompanying expert testimony as to the methods used. (Shaldjian Depo. Tr. 10:5-11:1.) Mike Shaldjian was not admitted as an expert, and no expert report was produced.

Deny the contents of this Sub-Paragraph to the extent the Declaration of Jon Basso dated March 26, 2012 is based on HAG SJ Exhibits 9 and 10.

d. Admit that the Heart Attack Grill has been referred to on television and radio shows but deny that this constitutes trademark use for restaurant services, which is a conclusion of law and not a statement of fact. Aver that Defendants only offer restaurant services in its single restaurant location in Las Vegas. (Depo. Tr. Of Jon Basso pp. 74:13-75:2) (Ex. J.)

Further deny the statements of Sub-Paragraph 3(d) on the basis that Defendants' SJ Exhibits 8, 9, and 10 are inadmissible. Exhibits 9 and 10 purport to be from Media Watch AZ but they were not authenticated by that company's custodian of records. (Exhibit C, Excerpts From Depo. Tr. of Mike Shaldjian pp. 6:7-15, pp. 9:15-11:1.)

Furthermore, HAG SJ Exhibits 8, 9, and 10 contain "Nielsen Audience" statistics that were obtained by Media Watch AZ from Nielsen and are hearsay. (Shaldjian Depo. Tr. 8:8-17.) Also, the Nielsen statistics are inadmissible without expert witness testimony on how they were tabulated. HAG SJ Exhibits 8-10 are themselves the result of technical compilation without accompanying expert testimony as to the methods used. (Shaldjian Depo. Tr. 10:5-11:1.) Mike Shaldjian was not admitted as an expert, and no expert report was produced.

Deny the contents of this Sub-Paragraph to the extent the Declaration of Jon Basso dated March 26, 2012 is based on HAG SJ Exhibits 8, 9, and 10.

- e. Admit that Defendants' website and various TV shows are accessible to a national audience, including those in New York. Deny that Defendants offer restaurant services outside of Las Vegas, Nevada. (Basso Depo. Tr. pp. 74:13-75:2.) (Ex. J.)
4. Deny the statements in Paragraph 4. Plaintiffs have multiple documents showing that it has been using the Instant Heart Attack Sandwich trademark continuously since 2004. Plaintiffs have submitted the May 19, 2004 Chowhound review (Ex. A), July, 2004 Morning Calm article (Ex. B), January 13, 2005 Chowhound review (Ex. C), 2004-2005 Menu (Ex. E), August 10, 2005 Invoice (Ex. F), January 6, 2006 New York Times Article (Ex. G), and December 18, 2007 Bloomberg article (Ex. H). These documents corroborate the testimony of Jack Lebewohl that he conceived of the Instant Heart Attack Sandwich in 2004 and put it on the menu at that time. (Decl. of Jack Lebewohl, ¶ 6.)
5. Admit that the website content referring to the Instant Heart Attack Sandwich was uploaded after June 2005 and that the menus are not dated. However, the accompanying invoice for the menus is dated August 10, 2005 (Ex. F) and the menu has the address of the Deli location that closed in late 2005/early 2006. However, deny that there is no evidence of interstate use of the mark, which is a conclusion of law and not a statement of fact. Plaintiffs have documents corroborating their use of the trademark as of 2004. (Exhibits A, B, and C.)
6. Admit that there is no evidence that the documents were published.

7. Admit.
8. Admit.
9. Deny the statements in Paragraph 9. Plaintiffs have submitted the May 19, 2004 Chowhound review (Ex. A), July, 2004 Morning Calm article (Ex. B), January 13, 2005 Chowhound review (Ex. C), 2004-2005 Menu (Ex. E), August 10, 2005 Invoice (Ex. F), January 6, 2006 New York Times Article (Ex. G), and December 18, 2007 Bloomberg article (Ex. H). These documents corroborate the testimony of Jack Lebewohl that he conceived of the Instant Heart Attack Sandwich in 2004 and put it on the menu at that time. (Decl. of Jack Lebewohl, ¶ 6.)
10. Deny. Newspaper articles and reviews from nationally-distributed publications have been produced. The Chowhound reviews are published online and accessible throughout the United States. (Exhibits A and C.) The July 2004 Morning Calm review is published for a newsletter distributed by Korean Airlines. (Ex. B.) The Instant Heart Attack Sandwich is mentioned in a New York Times article dated January 6, 2006, (Ex. G.), and a Bloomberg article dated December 18, 2007 (Ex. H).
11. Admit that there is no likelihood of confusion.
12. Admit that Plaintiffs operate their restaurants only in New York, but aver that they have shipped products across the country since at least 2004, as demonstrated by the Declaration of Jack Lebewohl. Deny that there is no use in interstate commerce, which is a conclusion of law and not a statement of fact. Admit the quotes in subparagraphs (a) to (d).
13. Admit that Plaintiffs operate its restaurants only in New York City, and that all relevant activities by Plaintiffs took place in New York City.

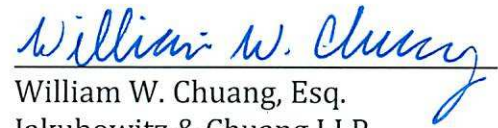
14. Admit that Plaintiffs have not shipped the Instant Heart Attack Sandwich out of New York State. However, menus have been shipped throughout the United States as part of Plaintiff's mail order business. Plaintiffs have submitted the May 19, 2004 Chowhound review (Ex. A), July, 2004 Morning Calm article (Ex. B), January 13, 2005 Chowhound review (Ex. C), 2004-2005 Menu (Ex. E), August 10, 2005 Invoice (Ex. F), January 6, 2006 New York Times Article (Ex. G), and December 18, 2007 Bloomberg article (Ex. H). These documents corroborate the testimony of Jack Lebewohl that he conceived of the Instant Heart Attack Sandwich in 2004 and put it on the menu at that time. (Decl. of Jack Lebewohl, ¶ 6.) Deny the statement regarding interstate use, which is a conclusion of law and not a statement of fact.
15. Deny the statements of Paragraph 15, which is a conclusion of law and not a statement of fact.
16. Admit the contents of Basso's Declaration D.E. 28-1 are correctly summarized in Paragraph 18.
17. Admit the contents of Basso's Declaration D.E. 28-1 are correctly summarized in Paragraph 17.
18. Admit the contents of Basso's Declaration D.E. 28-1 are correctly summarized but deny the statements of Paragraph 18, which are conclusions of law and not statements of fact.
19. Admit that Plaintiffs have never sold a product under the "Triple Bypass Sandwich" trademark but have a bona fide intent to do so, and therefore have a right to file an intent-to-use application. (Ex. I, Excerpts From Triple Bypass Sandwich Trademark Application, PLFS000170.)

Deny the remainder of the statements in Paragraph 19, which are conclusions of law and not statements of fact.

20. Admit.

Dated: New York, New York
April 16, 2012

Respectfully Submitted,



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