

UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF NEW YORK

JEREMY LEBEWOHL, UNCLE ABIES DELI  
INC. d/b/a 2<sup>nd</sup> AVE DELI, UNCLE ABIES  
DELI ON FIRST INC., UNCLE ABIES DELI  
SANDWICH TRADEMARKS LLC, and JACK  
LEBEWOHL

Plaintiffs,

v.

HEART ATTACK GRILL LLC, HAG LLC,  
JON BASSO, and DIET CENTER LLC (Texas),  
and DIET CENTER LLC (Delaware)

Defendants.

**CIVIL ACTION NO:** 11-CIV-3153-PAE-  
JCE

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**DEFENDANTS' OPPOSITION TO PLAINTIFFS'  
MOTION FOR SUMMARY JUDGMENT D.E. 63**

Defendants, HEART ATTACK GRILL LLC, HAG LLC, JON BASSO, DIET CENTER LLC (Texas), and DIET CENTER LLC (Delaware), (collectively, "Defendants" or "HAG"), hereby file their opposition to Plaintiffs, JEREMY LEBEWOHL, UNCLE ABIES DELI INC. d/b/a 2nd AVE DELI, UNCLE ABIES DELI ON FIRST INC., and UNCLE ABIES DELI SANDWICH TRADEMARKS LLC (collectively "Plaintiffs" or "DELI") motion for summary judgment, D.E. 63.

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## **A. Introduction**

DELI's motion should be denied (and HAG's motion for summary judgment should be granted) for the reasons set forth in HAG's reply in support of HAG's motion, D.E. 53. DELI raises no new legal arguments that are not addressed in a substantive manner in HAG's reply brief, D.E. 72, and in its original brief, D.E. 53. However since HAG is forced to defend its national rights to use HEART ATTACK GRILL and TRIPLE BYPASS BURGER as set forth in its registrations, a specific rebuttal of DELI's arguments is necessary.

In this opposition brief, HAG will show the Court that DELI's summary judgment is wholly without merit based on the facts and the law. HAG's positions as to the factual allegations made by DELI are listed in the attached appendix entitled "Defendants' Counter-Statement Responsive to Plaintiffs' Statement of Facts, D.E. 65." Herein HAG refers to DELI's factual allegations as "DELI-F #" and such reference incorporates HAG's admissions/objections/responses as well. Also to avoid confusion, DELI's INSTANT HEART ATTACK SANDWICH mark (see application at D.E. 57-13) is referred to as the "IHA mark" and HAG's mark is referred to as the "HEART ATTACK GRILL mark." Also, rather than re-filing supporting papers cited in this opposition brief, HAG cites to its previously filed summary judgment papers, see for example, the IHA trademark application at D.E. 57-13, cited in HAG's earlier brief as HAG's "S.J. Exh. 13."

## **B. The Critical Date For This Case Is June 9, 2005 - HAG's Trademark Filing Date**

No one contests that HAG has a federal trademark registration for HEART ATTACK GRILL, with a filing date of June 9, 2005. See Registration D.E. 57-1 and HAG S.J. Exh. 1, Federal Trademark Reg. No. 3,128,169 for HEART ATTACK GRILL for restaurant services; registered August 8, 2006, filed June 9, 2005. For a federally registered mark, the certificate is prima facie evidence of the facts stated thereon. 15 U.S.C. 1057(b). Also, the Lanham Act (the Federal

Trademark Act) provides that the filing date is constructive national use date for registered marks. 15 U.S.C. 1057(c).

Concurrent use rights, if any, are established as of HAG's national use rights date, herein "the critical date" of June 2005. The Act provides "concurrent registrations may be issued to such persons when they have become entitled to use such marks as a result of their concurrent lawful use in commerce prior to (1) the earliest of the filing dates ... of any registration issued under this chapter." 15 U.S.C. 1052(d)(emphasis added). In Sweetarts v. Sunline, Inc., 380 F.2d 923, 929 (8th Cir. 1967), concurrent use rights and market penetration was determined at the time of a party's national rights. Sweetarts, 380 F.2d at 929; see also Natural Footwear, Ltd. v. Hart, Schaffner & Marx, 760 F.2d 1383, 1398-99 (3d Cir. 1985) and MCCARTHY, note 7, § 26:14. An analysis of factors in these concurrent use cases shows that courts permit some limited consumer confusion in concurrent use situations by imprecisely defining a party's area of exclusive use based upon a zone of actual market penetration, reputation, advertising, and likely expansion trends.

Therefore, the parties' rights are frozen as of June 2005. Since certain facts are not subject to reasonable dispute, enough to establish a triable fact for a jury, this Court is now called upon to determine such rights. "[T]he 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". Adams v. Ellis, 2012 U.S. Dist. LEXIS 29621 \*18 (S.D.N.Y. Mar. 1, 2012). There must be specific facts showing a genuine issue for trial with affidavits made on personal knowledge and facts that would be admissible in evidence at trial. *Id.* "[I]f the evidence is merely colorable, or is not significantly probative, summary judgment may be granted." *Id.*

**C. DELI's Pre-Critical Date Evidence Is Not Sufficient To Prove Use Of IHA**

Since many factual allegations proposed by DELI are not supported by Lebewohl's declaration or the documents filed by DELI, HAG's opposition will cite to the Lebewohl declaration, D.E. 64 and directly to the DELI documents. HAG's opposition to DELI's proposed facts are detailed in the attached Appendix and references herein to "DELI-F#" include both DELI's proposed facts integrated with HAG's limited admissions and objections.

Lebewohl says that he conceived of the IHA sandwich "around 2004" (Lebewohl's Decl. Para. 5), spoke to Chef Bobby Flay and Detective Jimmy Piccone (DELI did not submit supporting declarations from those individuals), and "added the Instant Heart Attack Sandwich to the menu the next time it was printed." Lebewohl's Decl. Para. 5. Lebewohl also says "We put the ... [IHA] on the menu in around 2004. It has remained on our menu ever since. The menu attached as Exhibit A is from 2004 - 2005." Lebewohl's Decl. Para. 8.

First, there is no corroborating evidence for Lebewohl's statements of what happened in 2004 - 2005 and his memory is necessarily clouded by the closure of DELI for nearly two (2) years in 2006 - 2007. Lebewohl's Decl. Para. 2. Oral testimony, without corroborating evidence, "should be most carefully scrutinized." Crystal Entm't & Filmworks, Inc. v. Jurado, 643 F.3d 1313, 1321-1322 (11th Cir. 2011)(quoting B.R. Baker Co. v. Lebow Bros., 150 F.2d 580, 583, 32 C.C.P.A. 1206, 1945 Dec. Comm'r Pat. 490 (C.C.P.A. 1945)); see also 2 McCarthy, supra, § 16:20, p. 16-50.3 and Rockwood Chocolate Co. v. Hoffman Candy Co., 54 C.C.P.A. 1061, 1062-1063 (C.C.P.A. 1967)("while a party is entitled to carry its date of first use back of one so asserted, proof of such earlier date must be clear and convincing and oral testimony given long after the date sought to be proved must be carefully scrutinized).

Second, the lack of clarity of the date shows the uncertainty of Lebewohl's testimony. Was the menu printed in 2004 or in the first half of 2005 or after HAG's critical date of June 2005? Truthful statements using such terms as "about" and "around" and "2004 - 2005" indicate uncertainty regarding the precise date, such uncorroborated oral statements, which retell events nine (9) years ago with an intervening 2 year closure of DELI's restaurant business, do not provide "clear and convincing" testimony to support a "date of first use" or a "date of first interstate use" of IHA. See IHA trademark application, D.E. 57-13. The two year closure of DELI's restaurant must have been much more memorable than the recounted IHA events since Lebewohl lost two years worth of income. DELI's 50 year reputation as a Kosher deli was at risk during these intervening 2 years.

The sufficiency of Lebewohl's oral testimony is not adequate because: (1) the 9 year delay between event and trial is significant, especially given the 2 year closure of DELI operations in 2006 - 2007, immediately after the recounted "less memorable IHA" events in 2004 - 2005; (2) Lebewohl has a direct economic interest in the outcome of this litigation and no other corroborative testimony is offered; (3) Lebewohl's own statement, using terms as "about" and "around" and "2004 - 2005," tend to contradict DELI's alleged "first use date of 2004;" (4) the lack of any testimonial or documentary corroborative evidence (the menu D.E. 64-1 is not dated) does not support a pre-critical date use; (5) Lebewohl's familiarity with details of the alleged "first use date" is cloudy as noted by the ambiguous terms "about" and "around" and "2004 - 2005." E. I. Du Pont de Nemours & Co. v. Berkley & Co., 620 F.2d 1247, 1261, n20 (8th Cir. 1980)(sufficiency of uncorroborated oral testimony questioned).

Undoubtably, DELI will point to the three (3) Internet articles as evidence of corroboration. However, those articles are not admissible at trial because they contain hearsay and are not authenticated as to when they were posted on the Internet, who is the author, and whether they are



truthful. These Internet articles are no different than newspaper articles which are typically excluded as evidence at trial. DELI's summary judgment evidence must meet this evidentiary standard.

Adams v. Ellis, 2012 U.S. Dist. LEXIS 29621 \*18 (S.D.N.Y. Mar. 1, 2012)( there must be specific facts showing a genuine issue for trial, affidavits made on personal knowledge and facts that would be admissible in evidence at trial).

"The wrinkle for authenticity purposes is that, because internet data is electronic, it can be manipulated and offered into evidence in a distorted form." However, the authentication standard for chat room or other internet evidence is not different from the authentication requirements for any other types of evidence. "[A]ll that is ultimately required is evidence sufficient to support a finding that the matter in question is what its proponent claims." U.S. v. Simpson, 152 F.3d 1241, 1250, 49 Fed. R. Evid. Serv. 1631 (10th Cir. 1998). The authenticity of electronic evidence is governed by Federal Rule of Evidence 901(a) and methods of authentication are listed in 901(b). Under Rule 901(b)(4), electronic evidence may be authenticated by reference to its "appearance, contents, substance, internal patterns, or other distinctive characteristics, taken in conjunction with the circumstances."

100 AMJUR POF 3d 89 *Proof of Instant Message, Blog, or Chat as Evidence*

While plaintiff's declaration purports to cure his inability to authenticate the documents printed from the internet, he in fact lacks the personal knowledge required to set forth with any certainty that the documents obtained via third-party websites are, in fact, what he proclaims them to be. . . . As Novak proffers neither testimony nor sworn statements attesting to the authenticity of the contested web page exhibits by any employee of the companies hosting the sites from which plaintiff printed the pages, such exhibits cannot be authenticated as required under the Rules of Evidence. ...Therefore, in the absence of any authentication of plaintiff's internet printouts, combined with the lack of any assertion that such printouts fall under a viable exception to the hearsay rule....

Novak v. Tucows, Inc., 2007 WL 922306, 73 Fed. R. Evid. Serv. 331, at \*5 (E.D.N.Y., 2007) see also Sam's Riverside, Inc. v. Intercon Solutions, Inc., 790 F.Supp.2d 965, 981 (S.D.Iowa 2011)(“affidavit was insufficient to authenticate specific screen shots submitted by owner which had not been attached to affidavit, since affiant had no personal knowledge of when or how the screen shots had been obtained.”).

The article [discussing fees] is inadmissible hearsay, see United States v. Difeaux, 163 F.3d 725, 729 (2d Cir. 1998) (holding that newspaper articles alleging improper motivations of prosecutor's office were impermissible hearsay), and, as such, cannot defeat summary judgment. See Fed. R. Civ. P. 56(e). Even if the article were admissible, however, Rosner fails to link the reported 2003 events to the lease she signed in 1997 so as to raise a triable factual issue of deceptive business practices or fraudulent inducement.

Tokio Marine & Fire Ins. Co. v. Rosner, 206 Fed. Appx. 90 (2d Cir. N.Y. 2006); see also Hotel Emples. & Rest. Emples. Union, Local 100 v. City of N.Y. Dep't of Parks & Rec., 311 F.3d 534 (2d Cir. N.Y. 2002)(newspaper articles not admissible to defeat a motion for summary judgment ruling that the district court found “that the newspaper articles proffered by the Union were inadmissible hearsay, and that in any event they showed only that various events were either located near Lincoln Center or had yet to take place when the articles were written”).

The uncertain nature of these three Internet articles is highlighted by the recently located Morning Calm - Korean Airlines article. What evidence exists that Korean Airlines posted this article on the Internet in 2004? Why not post the article in 2005 or 2012? Maybe Korean Airlines back-dated the article. Maybe the article appeared in the Korean language in 2004, then was later translated and then, even later, posted on the Internet listing the original Korean language publication date.

More importantly, if the Court finds that IHA was used by DELI as a mark on latke sandwiches in 2004 or 2005 prior to HAG’s critical date (June 2005), then DELI’s evidence of concurrent use fails because it has not established any geographic scope of use of IHA as of the June 2005 critical date.

DELI argues that use of IHA on a menu is trademark use and cites In re Marriott, 59 C.C.P.A. 1055, 459 F.2d 525 (C.C.P.A. 1972). HAG agrees that use on a menu can be trademark use, however, DELI must also show, but has not shown, that the menu and/or the IHA sandwich was transported in interstate commerce (or for that matter, distributed anywhere other than in the two DELI restaurants). Further DELI has not shown that the IHA sandwich itself had an effect on interstate commerce. The following cases by the USPTO Trademark Trial and Appeals Board (TTAB) are illustrious on the point that DELI must show it used the IHA mark, not that some other commentators noting that the IHA was sold by DELI. The following case notes that ads alone may not prove up use in interstate commerce but a trade show appearance with the ads may support such interstate use.

The inclusion of the "Oil-Master" mark in advertising materials designed by Correlated is not sufficient in itself to confer trademark rights. See Consumers Petroleum Co. v. Consumers Co. of Illinois, 169 F.2d 153, 161, 78 USPQ 227, 233-234 (7th Cir. 1948), cert. denied, 335 U.S. 902, 80 USPQ 600 (1949). A mark is not used in commerce unless "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 and the goods are sold or transported in commerce \* \* \*." 15 U.S.C. § 1127. See In Re Marriott Corp., 459 F.2d 525, 173 USPQ 799 (C.C.P.A. 1972). Plaintiff may be able to show that the Correlated Oil-Master display at the International Machine Tool Show in September, 1978, established its use of the mark in commerce, ... Combined Oil Industries, Ltd. v. Oil Master, Inc., 1980 U.S. Dist. LEXIS 9692\*18 (N.D. Ill. 1980).

To prevail, DELI must show, but has not yet shown, that the mark IHA was in use in interstate commerce or that the IHA mark is intimately associated with goods effecting interstate commerce. The following case illustrates that the trademark applicant failed to prove up use of the mark effected interstate commerce, even though the USPTO - TTAB did find the mark was used albeit not used in or effecting interstate commerce because no sales of flowers by phone or wire were proven up.

We do not believe that this slogan [THIS BUD'S FOR YOU for flowers], seen in the eyes of a typical customer who may have purchased flowers in a members' store at that time, would have been considered as a trademark for the flowers he or she had just purchased in that store. However, we believe that applicant's use of the truncated slogan THIS BUD'S FOR YOU in October 1984 was trademark use. Contrary to opposer's [Anheuser-Busch] argument, we believe that the use of this [truncated] slogan on streamers displayed in those stores can be considered a display associated with the goods. In this regard, we note that, while the [truncated] slogan was used on a banner which mentioned the Sweetest Week, it also prominently displayed the words "Fresh Floral Blossoms." Unlike the inherent meaning of the entire slogan used in 1982, this [truncated] slogan on a streamer did not, in our view, promote only the Sweetest Week contest but also identified flowers in the stores where it may have been displayed. See In re Marriott Corp., 459 F.2d 525, 173 USPQ 799 (CCPA 1972) and In re Bright of America, 205 USPQ 63 TTAB 1979). Use in Commerce - However, **while we find that this use was sufficient to constitute trademark use in connection with fresh-cut flowers, we find other serious problems with applicant's use and its application. First, opposer's argument that the slogan was not used in commerce is well taken.** The testimony of record reveals only that **this [truncated slogan] banner was displayed in a single flower shop (Gali's Florist Shop) in October 1984.** While there is testimony that two streamers were distributed to all of the member flower shops at the time, we have no direct testimony that the streamers or posters were in fact displayed in those shops. **Moreover, even if they were displayed, we would have to make an inference that, during the week in question, sales under the mark were more than limited local sales but were in**

**fact sufficient to affect commerce and therefore permit the mark to be federally registered.** That evidence is lacking. In other words, **this record is simply insufficient to show that, for example, the slogan was used in connection with wire service orders or that sales of goods affecting commerce were made under the mark.** (Footnote 5: We have no question that retail flower shops typically do business which affects commerce. There is adequate testimony of record to show that a florist's activities typically involve ordering flowers from across state lines and arranging for flowers to be delivered elsewhere at a customer's request by use of wire services. There is also testimony that a florist sometimes receives direct orders from out-of-state customers to deliver flowers locally. **However, the question which we have here is whether this record shows that during a relatively short time period there was commercial activity under the mark which affects commerce.**)

Anheuser-Busch, Inc. v. The Florists Assn of Greater Cleveland, Inc. 1993 TTAB LEXIS 28, 11-13 (Trademark Trial & App. Bd. Sept. 29, 1993)(emphasis added).

Therefore, DELI has not proven, with any evidence, that the IHA sandwich was shipped over state lines, that the 2004 - 2005 menu was shipped over state lines or that some persons, other than local customers, knew about, ate, or even saw the IHA sandwich listed on a one-half inch side bar on an 8 ½ by 11 inch undated menu. The two pre-critical date ChowHound Internet articles show that locals may have eaten the IHA sandwich, but this does not show DELI's use of IHA. The Korean Airlines "Morning Calm" article is not authentic enough to warrant a finding of interstate use.

Lebewohl's declaration on interstate use is not credible as to the "time of use." Lebewohl's declaration para. 6 discusses events in 2004, but does not mention any interstate use. In paragraph 7, Lebewohl states that patrons ordered and ate the sandwich but does not identify when that occurred. Given the 9 year passage of time from the recounted events, the 2 year closure of DELI's restaurant and the catastrophic result of losing 50 years of good will associated with the 2<sup>ND</sup> AVENUE DELI name, HAG appreciates that Lebewohl cannot truthfully state that out-of-state travelers bought the IHA sandwich in the undefined period of 2004 - 2005. HAG's characterization of "undefined period in 2004 - 2005" is accurate because Lebewohl himself cannot clearly establish whether the subject menu was printed in 2004 or the first half of 2005 or post-critical date. No DELI customers could order the IHA sandwich unless the same was listed on the menu. If the menu was

printed post-critical date, then sales to out-of-state travelers or interstate shipment of the subject menu are irrelevant to the issues at trial.

Lebewohl's declaration paragraph 10 does not prove-up interstate use because he does not identify when the DELI website was launched with the subject menu. No date is provided.

As for Lebewohl's paragraph 13 and 14, he never states that the IHA was sold pre-critical date. The recounting of FedEx shipments "to out-of-state customers" does not mention that the IHA sandwich was shipped to out-of-state customers. Also, the FedEx receipts themselves do not list the IHA. Again, Lebewohl is being truthful about his recollection of events because he does not recall if the IHA was shipped out of state prior to the critical date. He only knows that DELI made some shipment of some type of food product to out-of-state customers in the indefinite 2004 - 2005 time frame. The fact that DELI is close to interstate highways (Lebewohl's Decl. Para. 13) is not a relevant fact unless Lebewohl ties a sale of an IHA sandwich to a customer traveling on the interstate highway, which he has not done nor suggested in his declaration. In the event DELI submits additional evidence of use subsequent to HAG's attacks on the sufficiency of evidence, such back-fill evidence is not credible. Upon being prompted by counsel, Lebewohl may change his story and clarify the missing evidentiary points raised by HAG herein. Simply put, it is too easy for Lebewohl to recall events and correct the record once the inadequacies in his testimony are pointed out by HAG. He has much at stake in this litigation and his recollection given the catastrophic 2 year closure of DELI in 2006 - 2007 easily clouds his memory. Closing a 50 year old restaurant must be a difficult thing.

As for Lebewohl's paragraph 14, showing payments to out-of-state vendors in the indefinite 2004 - 2005 period, Lebewohl never states that any of these vendors supplied ingredients used in the IHA. More importantly, where is the re-order for the 2004 - 2005 DELI menu? If DELI has all these

other commercial documents, it seems strange that it cannot locate the purchase order or the check for the 2004 - 2005 menu. Maybe the purchase order exists but it is post-critical date.

HAG does not contest that DELI's restaurant services were provided in interstate commerce but, just like Anheuser-Busch, Inc. v. The Florists Assn of Greater Cleveland, Inc., DELI has not shown that interstate consumers bought the IHA goods or that the IHA goods were shipped out of state. Further, DELI has not show that the IHA itself effected interstate commerce.

With respect to DELI's claim for trademark rights in the tri-state area, there is no evidence that the latke IHA sandwich was shipped throughout New Jersey or shipped to any points in Connecticut or carried to those locations by out-of-state travelers. In fact, DELI has not submitted any evidence that others (consumers or vendors) in the Bronx, Brooklyn, Staten Island or any points north of Manhattan had anything to do with the IHA sandwich, whether to eat the sandwich or supply ingredients for the sandwich.

The pre-critical date evidence is not sufficient to support a claim of first use prior to HAG's critical date because: (a) the testimony of Lebewohl is not definite enough to pin-point a pre-critical date event for the IHA sandwich and the IHA menu (he uses terms such as about, around and 2004-2005); (b) Lebewohl's oral testimony is not corroborated by other dis-interested parties or anyone else in DELI's management; (c) DELI has not shown the "date of first use" of IHA with clear and convincing evidence; (d) the Internet articles are not admissible at trial because they are not authenticated by author, or by date of posting and include hearsay; (e) the Internet articles do not show the geographic extent of any use of IHA product; and (f) Lebewohl's testimony does not state that IHA product was bought by out-of-state customers or that the product was shipped to out-of-state customers. Also Lebewohl does not state that IHA out-of-state ingredients were used in the IHA product.

**D. DELI's Discovery Responses Are Consistent With HAG's Factual Analysis**

DELI admitted, in its response to HAG's Requests to Admit ("RTA")(for DELI's response, see D.E. 56-1 filed by HAG with its summary judgment motion), that: (a) DELI has no documents showing sales of IHA prior to 2008 (RTA 1); (b) DELI has no documents relating to "receipts ... materials and inventory" for the IHA (RTA 3 and 16)(note that this admission conforms with Lebewohl's ambiguous statements of vendors in paragraphs 13, 14); (c) DELI has no documents showing how or when Lebewohl adopted the IHA mark or when it was first used (RTA 32, 33, 50, 51, 51A, 52, 53, 54, 55, 56);(d) DELI has never used IHA on any signs or in-store displays in the DELI restaurant (RTA 73, 75, 77, see also Lebewohl's Decl. Para. 10); and (e) DELI has never used IHA in any commercials or on TV or in radio ads (RTA 79, see also Lebewohl's Decl. Para. 10).

In response to RTAs 89 and 91 for magazine and newspaper use of IHA, respectively, (D.E. 56-1 p. 14), DELI explains that "Plaintiffs have not had any ... [magazine/newspaper] articles prepared for them in which the term ... [IHA] appears." Therefore, DELI admits that they did nothing to advertise the IHA pre or post the critical date. Others may have discussed the IHA but the Lanham Act requires that a trademark application include "the date of the applicant's first use of the mark," 15 U.S.C. 1051 (a)(2)(emphasis added). What others may have done is not relevant to DELI's actions. The evidence presented by DELI with its motion and DELI's admissions prove that DELI did not use IHA of its own accord prior to HAG's critical date. DELI has no advertising or promotional expenses for IHA. RTA 93.

As for the geographic scope of use of IHA, the following RTAs show that the FedEx invoices and the out-of-state vendor invoices and payments are not related to the IHA sandwich but are instead related to DELI's general restaurant business. The RTAs are therefore consistent with the points raised by HAG above regarding the insufficiency of these documents as they relate to the IHA usage.

103. Admit that Plaintiffs have no documents relating to the channels of trade through which 2ND AVE DELI markets INSTANT HEART ATTACK SANDWICH goods.

DENY. Plaintiffs have produced documents relating to the channels of trade through which 2ND AVE DELI markets the Instant Heart Attack Sandwich, including the press release, website pages, draft menus, and menus.

104. Admit that Plaintiffs have no documents relating to the channels of trade through which 2ND AVE DELI markets its INSTANT HEART ATTACK SANDWICH goods in New York.

DENY. Plaintiffs have produced documents relating to the channels of trade through which 2ND AVE DELI markets the Instant Heart Attack Sandwich in New York, including the press release, website pages, draft menus, and menus.

The Court should note that DELI explains in these RTAs that the channel of trade is “in New York” and therefore its current claim for the tri-state area, unsupported by specific averments by Lebewohl, are not supported by the evidence nor DELI’s earlier stated position. If DELI, at any time prior to the close of discovery, had indicated that it was seeking trademark rights in the tri-state area, HAG would have pursued additional discovery. Discovery ended Feb. 15, 2012 (see Order, D.E. 50) and now HAG is prejudiced by this sudden change in DELI’s position.

If the Court accepts DELI’s position for a claim for trademark rights in the tri-state area, HAG requests that the Court re-open discovery for 60 days to permit HAG to conduct an investigation. DELI never updated these responses to HAG’s requests to admit.

More importantly, these RTA facts regarding channels of trade are conclusively established. Fed.R.Civ.P. 36(b) states “A matter admitted under this rule is conclusively established unless the court, on motion, permits the admission to be withdrawn or amended.” (Emphasis added). Therefore, DELI cannot back-fill on this evidentiary point by now submitting further evidence that the FedEx data and the out-of-state vendor data shows the channels of trade or geographic scope of the IHA product in the tri-state area. DELI admitted that its channel of trade was only in New York. As stated earlier herein, the FedEx data and the out-of-state vendor data shows DELI’s interstate restaurant



services, not interstate use of the IHA mark. See Anheuser-Busch, Inc. v. The Florists Assn of Greater Cleveland, Inc. 1993 TTAB LEXIS 28, 11-13 (TTAB Sept. 29, 1993).

**E. DELI's Post-Critical Date Evidence is Irrelevant**

The Lanham Act (the Federal Trademark Act) provides that the filing date is constructive national use date for registered marks, 15 U.S.C. 1057(c), that HAG has an evidentiary presumption that its national date of first use is June 2005 (15 U.S.C. 1057(b) and concurrent use rights, if any, are established as of HAG's critical date of June 2005. 15 U.S.C. 1052(d) ("concurrent registrations may be issued to such persons when they have become entitled to use such marks as a result of their concurrent lawful use in commerce prior to (1) the earliest of the filing dates ... of any registration issued under this chapter").

As for DELI website, Lebewohl never explains in his declaration, D.E. 64, when the website was launched. Lebewohl's Decl. Para. 10 (no dated website). Therefore, one can assume this was post-critical date.

All the other evidence submitted by DELI is post-critical date. Further, the Internet articles in the New York Times and Bloomberg, D.E. 65-15, D.E. 65-16, are not admissible evidence as stated earlier herein.

**F. DELI's Argument of No Confusion Is Misplaced**

DELI argues that there is no confusion. See motion D.E. 63, pp. 10-15. HAG has moved for declaratory judgment against it as to DELI's single count complaint by affirming that "there is no confusion in New York at this time." See HAG's relief in its motion, D.E. 53, p. 18.

DELI's position, that this Court cannot rule on concurrent use because there is no confusion, is wrong as a matter of law. Concurrent use orders are permitted only if "confusion, mistake, or deception is not likely." 15 U.S.C. 1052(d) ("[I]f the Director determines that confusion, mistake, or

deception is not likely to result from the continued use by more than one person of the same or similar marks under conditions and limitations as to the mode or place of use of the marks or the goods on or in connection with which such marks are used, concurrent registrations may be issued”).

**G. DELI’s Argument That Hamburgers Are Different Goods Than Sandwiches Is Erroneous**

DELI argues that hamburgers are different than sandwiches and that, on this basis, there is no confusion. This is wrong because the USPTO Trademark Examining Attorney rejected DELI’s trademark application for IHA in light of HAG’s registered mark HEART ATTACK GRILL and rejected DELI’s TRIPLE BYPASS application in light of HAG’s TRIPLE BYPASS registration. See D.E. 57-13, HAG’s SJ Exh. 13 (finding that HAG’s restaurant services would be confused with the IHA sandwich); and see D.E. 65-7, p. 53, USPTO Office Action dated Jan. 13, 2011 (finding that DELI’s TRIPLE BYPASS sandwich is a similar product to HAG’s TRIPLE BYPASS hamburger).

Further, the USPTO website has a classification of goods for “hamburger sandwiches.” See USPTO website at uspto.gov, “Identification of Goods and Services Manual,” Class 30 “hamburger sandwiches” (see attached website screen shot, Appendix B, attached). HAG requests that the Court take judicial notice of this “hamburger sandwiches” identification of goods, Fed.R.Evd. 201(b)(“The court may judicially notice a fact that is not subject to reasonable dispute because it: (1) is generally known within the trial court’s territorial jurisdiction; or (2) can be accurately and readily determined from sources whose accuracy cannot reasonably be questioned).

**H. DELI’s Motion Seeking Dismissal of Counterclaim Count II Relative to DELI’s Pending Applications Is Erroneous**

DELI seeks dismissal of HAG’s Count II wherein HAG seeks a declaration from the Court that DELI’s pending trademark applications be denied. DELI argues that “no confusion in New York” means that HAG is barred from having a court enforce national rights throughout the U.S.

As stated earlier, once a mark is registered, the national rights of the registrant relate back to the filing date of the application. For a federally registered mark, the certificate is prima facie evidence of the facts stated thereon. 15 U.S.C. 1057(b). The Lanham Act (the Federal Trademark Act) provides that the filing date is constructive national use date for registered marks. 15 U.S.C. 1057(c).

If this Court dismisses HAG's Count II (other than granting HAG's motion for voluntary dismissal, without prejudice), the result is: (a) DELI's marks get registered; (b) DELI has national rights; and (c) those national rights directly conflict with HAG's long ago established national rights to HEART ATTACK GRILL and TRIPLE BYPASS BURGER. For DELI to argue that "no confusion in New York" translates into "no confusion anywhere in the U.S." is not supportable by logic or the Lanham Act. See Lanham Act, "Opposition to Registration," 15 U.S.C. 1063. This Court has power over "any action involving a registered mark," 15 U.S.C. 1119, and since HAG may oppose DELI's applications for a federal trademark registration and assert as a basis HAG's earlier federal registrations, then the opposition in counterclaim Count II involves a registered mark. This Court has authority over the opposition Count II and DELI's applications. DELI has recognized the power of this Court over its applications in its suspension requests filed with the USPTO. See D.E. 65-7, p. 49 and 65-5, p. 16. DELI is legally estopped from taking a different position now before this Court.

#### **I. Conclusion**

In conclusion, DELI has not shown use of IHA in interstate commerce and, in fact, has not shown by any evidence that the IHA was sold to any out of town traveler, or a visitor from a neighboring state, or that the menu went out over state lines, PRIOR TO HAG's critical date.

DELI's request for tri-state rights to IHA is not supported by any admissible evidence. DELI's motion must be denied.

Dated: April 30, 2012

Respectfully submitted,

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### **CERTIFICATE OF SERVICE**

I hereby certify that on April 30, 2012, I electronically filed the foregoing document with the Clerk of the Court using CM/ECF. I also certify that the foregoing document is being served this day on all counsel of record or pro se parties identified on the attached Service List in the manner specified, either via transmission of Notices of Electronic Filing generated by CM/ECF or in some other authorized manner for those counsel or parties who are not authorized to receive electronically Notices of Electronic Filing.

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