UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

JEREMY LEBEWOHL et al.,

Plaintiff,

-v-

HEART ATTACK GRILL, LLC et al.,

Defendants.

11 Civ. 3153 (PAE)

ORDER

PAUL A. ENGELMAYER, District Judge:

The Court has received defendants' letter requesting oral argument on defendants' motion for summary judgment, and plaintiffs' letter requesting oral argument on plaintiffs' motion for summary judgment (attached).

The parties are hereby directed to appear for oral argument on both motions on May 22, 2012, at 2:45 p.m. in Courtroom 9A at the U.S. Courthouse, 500 Pearl Street, New York, New York 10007.

SO ORDERED.

Paul A. Engelmayer
United States District Judge

Dated: May 7, 2011
New York, New York

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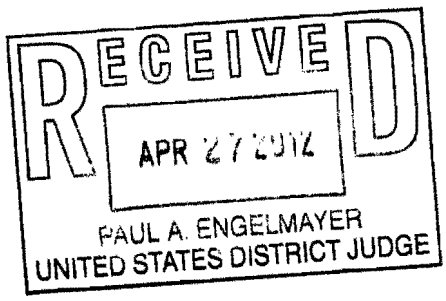

April 25, 2012
(Federal Express)

Paul A. Engelmayer
United States District Judge
United States District Court
Southern District of New York
500 Pearl Street, Room 670
New York, NY 10007
(212) 805-4893

Re: Lebewohl, 2nd Ave Deli v. Heart Attack Grill, LLC., HAG, LLC, and Jon Basso
U.S. District Court, S.D. New York, Case No. 11-CIV-3153-PAE-JCF
Our Ref.: 5087-23

Dear Judge Engelmayer:

We represent Defendants HAG in this action. HAG requests hearing for oral argument on its Motion for Summary Judgment, D.E. 53. If possible, HAG requests that the hearing be scheduled no earlier than 11:00 AM such that lead counsel for HAG can fly from Fort Lauderdale, Florida to New York early that morning. Also, counsel is not available May 10-11 (California court hearing), May 17-18 (short weekend vacation), May 21 (court hearing in Ocala, Florida) and June 7 through June 18 (annual vacation), but is otherwise available.

An oral hearing is reasonable since the facts in this case are well established and oral argument on the application of legal principles to the facts may assist the Court in its deliberations.

Sincerely,
/s/RobertKain
Robert C. Kain, Jr., for the Firm

RCK/cjp
cc: William Chuang, Esq. via email

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April 26, 2012

BY HAND

Hon. Paul A. Engelmayer
United States District Judge
500 Pearl Street
New York, NY 10007

RE: Lebewohl, et al, v. Heart Attack Grill, et al, 11-CV-3153 (ECF)

Dear Judge Engelmayer:

My firm represents the Plaintiffs in this action. I write in response to Defendants' April 25 letter requesting oral arguments. I agree that oral arguments would aid the Court in deciding the motions, and thereby request oral arguments for Plaintiffs' motion for summary judgment of non-infringement as well.

I believe that the key legal issues in dispute are as follows:

- The Lanham Act permits the registration of trademarks except for, inter alia, those that are likely to confuse. 15 U.S.C. § 1052(d). The parties agree that there is no likelihood of confusion. Why shouldn't the Deli be permitted to register its marks?

- The Lanham Act states that trademarks shall not be denied registration except in certain situations. 15 U.S.C. § 1052. Registration is not enumerated as a basis for denying registration, nor is it a factor in the Polaroid test for determining the likelihood of confusion.[1] Why should HAG retain the right to oppose registration of the IHAS mark on the grounds that registration itself would make confusion likely?

- The parties agree that concurrent use doctrine is meant to prevent the likelihood of confusion. HAG believes that concurrent use doctrine applies in this case, and that it can use its marks in New York City under that doctrine. This is only possible if HAG's use in NYC would not be likely to confuse. If that is so, then why would the Deli's use of the mark in Las Vegas—or anywhere in the the United States—be likely to confuse?

[1] Polaroid Corp. v. Polarad Elecs. Corp., 287 F.2d 492, 495 (2d Cir. 1961).

- The Lanham Act provides for concurrent use registration in the event of a likelihood of confusion, in language HAG omits from its Reply in Support.[2] The Southern District has held that concurrent use registration does not apply if there is no likelihood of confusion, in a case that HAG does not address.[3] On what basis does HAG argue that concurrent use doctrine applies in an absence of a likelihood of confusion?

Therefore, I respectfully request that the Court hear oral arguments for both parties' respective motions for summary judgment once all briefing is complete.

Very Truly Yours,

William W. Chuang, Esq.

CC: Robert C. Kain, Jr. (by email)

[2] 15 U.S.C. § 1052 reads, in relevant part: "No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it— *** (d) *Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive*: Provided, That if 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..."

[3] Omicron Capital LLC v. Omicron Capital LLC, 433 F.Supp.2d 382, 395 (S.D.N.Y. 2005) ("Because there is no likelihood that Defendant's use of 'Omicron Capital' will result in confusion among relevant consumers and because Defendant has no intention to expand its services to include any similar to Plaintiff's, no concurrent use registration is appropriate at this time.") (Sweet, J.).