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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REPLY MEMORANDUM OF LAW IN FURTHER SUPPORT OF PLAINTIFFS' MOTION FOR SUMMARY JUDGMENT

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Patsy's Italian Restaurant, Inc. v. Banas, 958 F.3d 254 (2d Cir. 2011).

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

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15 U.S.C. § 1052.

15 U.S.C. § 1127.

PRELIMINARY STATEMENT

The Deli seeks a judgment that its marks "Instant Heart Attack Sandwich" and "Triple Bypass Sandwich" are not confusingly similar to any marks owned by HAG. HAG cross-moves for a judgment that there is currently no likelihood of confusion, and also moved for its own counterclaims to be dismissed without prejudice. HAG does not apply the Polaroid analysis to contradict the Deli's claim that there is no likelihood of confusion.[1] Therefore, the Court should grant the Deli's motion on the merits.

I. CONCURRENT USE DOES NOT APPLY ABSENT A LIKELIHOOD OF CONFUSION

HAG maintains that concurrent use doctrine can be applied absent a likelihood of confusion. (Memo In Opp. pp. 17-18.) That is plainly incorrect. The Southern District has rejected the notion that concurrent use registration is available in the absence of confusion. Omicron Capital, LLC v. Omicron Capital, LLC, 433 F.Supp.2d 382, 395 (S.D.N.Y. 2006). HAG does not discuss Omicron Capital, and fails to cite any case law to support of its interpretation of the statute. The language of the Lanham Act clearly states that concurrent use registration is an exception to the general rule that marks that are likely to cause confusion with an existing mark cannot be registered. 15 U.S.C. § 1052(d).

The filing date of the HAG's Marks is relevant only if the concurrent use doctrine applies. 15 U.S.C. § 1052(d)(3). The parties agree that there is no likelihood of confusion. Therefore, the concurrent use doctrine does not apply, per Omicron Capital, and the filing date of the HAG Marks is irrelevant.

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

II. THE DELI HAS SUFFICIENT PRE- AND POST-CRITICAL DATE EVIDENCE TO ESTABLISH TRADEMARK RIGHTS IN ITS MARKS.

Jack Lebewohl states that he conceived of the Instant Heart Attack Sandwich in 2004, and after talking to Bobby Flay, put it onto the menu the next time it was printed. (Lebewohl Decl. ¶¶ 5, 8.) His testimony is corroborated by a Chowhound article dated May 19, 2004 (SUF Ex. B), an article appearing in the July 2004 issue of the Morning Calm newsletter of Korean Airlines (SUF Ex. C), and a January 13, 2005 post on Chowhound recommending the Deli and its Instant Heart Attack Sandwich to tourists. (SUF Ex. D.) A Yelp review shows that the Sandwich was sold at the Deli's new location from its opening day. (SUF Ex. M PLFS000704.) A New York Times article dated January 6, 2006 refers to the Sandwich. (SUF Ex. N.) A Bloomberg article dated December 18, 2007 also reviews the Sandwich. (SUF Ex. O.) A copy of the Deli menu for the location that closed at the end of 2005 and an invoice for the printing of the menus dated August 10, 2005 further corroborates Jack's story. (SUF Ex. E, PLFS000089-92).

HAG's attacks on the admissibility of these documents are misplaced. In considering whether or not a trademark was used in interstate commerce, the Second Circuit has considered articles from the New York Times, reviews for tourist guides such as the 2003 Not For Tourists Guide to New York City and the 2004 Zagat Survey for New York City Restaurants. Patsy's Italian Restaurant, Inc. v. Banas, 658 F.3d 254, 268 (2d Cir. 2011). The Deli offers articles from the New York Times, Chowhound, Bloomberg, and Yelp reviewing the Sandwich. The Chowhound article from January 13, 2005 and the Morning Calm newsletter are reviews for tourists planning to visit New York. The Deli offers these documents to show that Bloomberg, Chowhound, Yelp, the New York Times, and the

Morning Calm Newsletter have all reviewed the Deli and the Instant Heart Attack Sandwich, which is relevant under Patsy's Restaurant. 658 F.3d at 268.

HAG asserts that the Deli offers the documents in the SUF Exhibits as advertisements. (Memo. In. Opp. ¶ 10-11.) That is not the case. The Deli offers these documents—which include a menu listing the Sandwich—to corroborate Jack Lebewohl's testimony that the Deli was using the Instant Heart Attack Sandwich mark in reference to a sandwich made with latkes.

HAG also attacks the authenticity of the Chowhound documents and the Morning Calm review. (Memo. In Opp. pp. 9-10.) As an initial matter, the Internet documents challenged contain the date it was printed out from the Internet and the URL that was printed out. The documents were, in fact, copies of the URLs contained on the documents and printed out on the dates contained therein. (Chuang Decl. ¶¶ 2-8).

The cases HAG cites in support are inapplicable. The plaintiff in Novak v. Tucows, Inc. tried to introduce pages from a third-party website, the Wayback Machine, to show that the defendant's website contained certain allegedly infringing material. 2007 WL 922306 *5 (E.D.N.Y. 2007). The court struck these documents because the Novak plaintiff did not offer any sworn statements from the owners and managers of the Wayback Machine to show that the contents of the Wayback Machine were an accurate depiction of the defendant's website. Id. Similarly, the plaintiff in Sam's Riverside, Inc. v. Intercon Solutions, Inc. tried to introduce printouts of its own website from the Wayback Machine to establish the earliest date of use of his mark. 790 F.Supp.2d 965, 979-80 (S.D.Iowa 2011). An affidavit from the plaintiff's employee was insufficient to authenticate the document, but the court admitted the document based on an affidavit from an employee of the Wayback Machine. Id. at 981.

The documents sought to be admitted in this case are not archives from a third-party website but rather are direct printouts from Chowhound and the Morning Calm Review. (Chuang Decl. ¶¶ 2-4). Therefore, the documents are properly authenticated and admissible.

The documents whose authenticity is not challenged—the New York Times and Bloomberg articles, as well as the menu and invoice—sufficiently corroborate Jack Lebewohl's testimony to support summary judgment.

III. THE COURT HAS JURISDICTION OVER THIS CASE; INTRASTATE USE IS SUFFICIENT TO OBTAIN TRADEMARK RIGHTS.

HAG continues to assert that a sandwich or menu has to be shipped over state lines in order to constitute trademark use. (Memo. In Opp. ¶ 12.) That is certainly not the case. The Deli's memorandum of law in support contains a multitude of cases in the Dawn Donut vein holding that the intrastate sale of a good is sufficient to invoke the jurisdiction of the Lanham Act.[2] (Memo. In Supp. pp. 8-11.) Furthermore, In Re Silenus Wines, Inc. held that there is only one definition of "commerce" in the Lanham Act, which applies to registration and infringement, and to goods and services. 557 F.2d 806, 811-812 (CCPA 1977). Therefore, the Deli's use of the mark was in commerce within the meaning of the Lanham Act even though the use was purely intrastate.

Furthermore, the Deli seeks a declaratory judgment that there is no likelihood of confusion. The cases cited in the Deli's memo make clear that jurisdiction exists under the Lanham Act for HAG to bring a trademark infringement lawsuit against the Deli's purely intrastate activities. Therefore, jurisdiction exists for this Court to issue a declaratory

[2] Dawn Donut Co. v. Hart's Food Stores, Inc., 67 F.2d 358, 365 (2d Cir. 1959).

judgment that there is no likelihood of confusion, which HAG does not contest and actually agrees with.

Lastly, HAG does not address Patsy's Restaurant, which considers newspaper articles, reviews, and proximity to interstate highways to determine the effects on interstate commerce by purely intrastate activities. 658 F.3d at 268. The articles offered by the Deli include the newsletter for Korean Airlines, the New York Times, and Bloomberg News, which all reach national if not international audiences. The Deli is located in proximity to major interstate highways. As part of its restaurant services, the Deli necessarily offers to sell the Instant Heart Attack Sandwich to all of its customers. Therefore, the Sandwich has sufficient effect on interstate commerce for jurisdiction under the Lanham Act.

To put this another way, and not to belabor the point, if the IHAS was named the "Heart Attack Grill Sandwich," and everything else remained the same, HAG would definitely claim jurisdiction to sue the Deli, and one would be hard-pressed to disagree in light of Dawn Donut and its progeny. 267 F. 2d at 365. If there is jurisdiction to bring a Lanham Act claim, then there is an apprehension of suit, and the Deli is entitled to a declaratory judgment that it is not infringing.

Alternatively, if there is jurisdiction to sue, then there is jurisdiction under the Lanham Act because there is only one definition of commerce and use in commerce in the Lanham Act, 15 U.S.C. § 1127, as confirmed by In Re Silenus Wines, 557 F.2d at 811-812.

HAG requests the Court to re-open jurisdiction for 60 days based on the Deli's responses to Requests to Admit Nos. 103-104. (Memo In Opp. pp. 16.) The argument lacks any merit. HAG's Request to Admit No. 104 asks for an admission that the Deli has no

documents relating to the channels of trade through which the Deli *markets* the Sandwich in New York. The Deli denied the allegation, and responded that the Deli does in fact have documents showing that it *markets* the Sandwich in New York. The Deli never admitted that New York is the *only* channel where it marketed the Sandwich. Moreover, the FedEx invoices and other vendor data are not *marketing* documents. Similarly, HAG's RTA No. 103 asks for an admission that there are no documents relating to the channels of trade through which the Deli *markets* the Sandwich. The invoices and other vendor data are not *marketing* documents.

In any event, HAG fails to point out what it could have done differently, or what discovery it would undertake if its request were granted. Therefore, its request should be denied and the case should proceed.

IV. JON BASSO TESTIFIED THAT THERE IS A DIFFERENCE BETWEEN SANDWICHES AND HAMBURGERS

Jon Basso stated, with regard to the Instant Heart Attack Sandwich and HAG's products: "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." (Basso Depo. pp. 105:1-6.) The Court should not take judicial notice of the USPTO website when the Defendants' principal very clearly states that sandwiches and burgers are different things in the marketplace.

V. THE COURT HAS AUTHORITY TO ISSUE A DECLARATORY JUDGMENT OF NON-INFRINGEMENT

Both parties concede that the Court has power to rule on this issue. (Memo. In Opp. pp. 19.) The Deli seeks a declaration that there is no infringement anywhere. HAG does not

seriously contest this, failing to cite to Polaroid or to apply its factors. 287 F.2d at 495. In fact, HAG claims that there would be no likelihood of confusion even if it were to open a restaurant in New York. If that is the case, why would there be confusion if the Deli sold the Sandwich in Las Vegas?

VI. CONCLUSION

The Deli respectfully requests that the Court grant its motion for summary judgment of non-infringement.

Dated: New York, New York
May 7, 2012

Respectfully Submitted,

/s/

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