

**Sendor v Chervin**

2011 NY Slip Op 32649(U)

September 13, 2011

Sup Ct, Suffolk County

Docket Number: 6261/2005

Judge: Joseph Farneti

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SUPREME COURT - STATE OF NEW YORK  
I.A.S. TERM, PART 37 - SUFFOLK COUNTY

**COPY**

PRESENT:

HON. JOSEPH FARNETI  
Acting Justice Supreme Court

MORRIS SENDOR, GREAT RESTAURANTS OF  
LONG ISLAND, INC., GREAT RESTAURANTS  
OF NEW YORK CITY, EAST SIDE EDITION,  
INC., GREAT RESTAURANTS OF NEW YORK  
CITY, WEST SIDE EDITION, INC.,

Plaintiffs,

-against-

MATTHEW CHERVIN and CARY ROSNER,

Defendants.

Index No. 6261/2005:

ORIG. RETURN DATE: APRIL 29, 2011  
FINAL SUBMISSION DATE: MAY 5, 2011  
MTN. SEQ. #: 006  
MOTION: MD

ORIG. RETURN DATE: APRIL 29, 2011  
FINAL SUBMISSION DATE: MAY 5, 2011  
MTN. SEQ. #: 007  
MOTION: MD

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MORRIS SENDOR, GREAT RESTAURANTS OF  
NEW YORK CITY, EAST SIDE EDITION, INC.,  
GREAT RESTAURANTS OF NEW YORK CITY,  
WEST SIDE EDITION, INC.,

Plaintiffs,

-against-

WHERE TO DINE IN, LLC, CARY ROSNER,  
MATTHEW CHERVIN,

Defendants.

Index No. 12656/2006:

ORIG. RETURN DATE: APRIL 21, 2011  
FINAL SUBMISSION DATE: APRIL 21, 2011  
MTN. SEQ. #: 005  
MOTION: MOT D

ORIG. RETURN DATE: APRIL 29, 2011  
FINAL SUBMISSION DATE: MAY 5, 2011  
MTN. SEQ. #: 006  
MOTION: MD

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CARY ROSNER,

Plaintiff,

-against-

MORRIS SENDOR and GREAT RESTAURANTS  
OF LONG ISLAND, INC.,

Defendants.

Index No. 34745/2009:

ORIG. RETURN DATE: JULY 1, 2010  
FINAL SUBMISSION DATE: AUGUST 19, 2010  
MTN. SEQ. #: 002  
MOTION: MG CASEDISP

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SENDOR v. CHERVIN, ET AL.  
INDEX NOS. 6261/2005; 12656/2006; 34745/2009

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**ATTORNEYS FOR MORRIS SENDOR, GREAT RESTAURANTS OF LONG ISLAND, INC., GREAT RESTAURANTS OF NEW YORK CITY, EAST SIDE EDITION, INC., AND GREAT RESTAURANTS OF NEW YORK CITY, WEST SIDE EDITION, INC.:**  
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Upon the following papers submitted to the Court in the above-captioned actions on motions to preclude, quash subpoenas, and for dismissal or summary judgment:

**Index No. 6261/2005:**

1. Plaintiffs' Notice of Motion (seq. #006) to Preclude dated April 20, 2011
2. Affirmation of Albert Kostinsky, Esq. in Opposition dated April 28, 2011
3. Plaintiffs' Notice of Motion (seq. #007) to Quash Subpoena dated April 20, 2011
4. Affirmation of Nathan C. Zezula, Esq. in Opposition dated April 28, 2011

**Index No. 12656/2006:**

5. Plaintiffs' Notice of Motion (seq. #005) for Summary Judgment dated March 25, 2011
6. Plaintiffs' Memorandum of Law in Support of Motion for Summary Judgment dated March 25, 2011
7. Affidavit of Morris Sendor in Support of Plaintiffs' Motion for Summary Judgment dated March 25, 2011
8. Affirmation of Panagiota Betty Tufariello, Esq. in Support of Plaintiffs' Motion for Summary Judgment dated March 25, 2011

9. Affidavit of Cary Rosner in Opposition to Plaintiffs' Motion for Summary Judgment dated April 14, 2011
10. Affirmation of Gary Adelman, Esq. in Opposition to Plaintiffs' Motion for Summary Judgment dated April 14, 2011
11. Defendants Where to Dine In, LLC and Cary Rosner's Memorandum of Law in Opposition to Plaintiffs' Motion for Summary Judgment dated April 14, 2011
12. Affidavit of Matthew Chervin in Opposition to Plaintiffs' Motion for Summary Judgment dated April 14, 2011
13. Affirmation of Albert Kostrinsky, Esq. in Opposition to Plaintiffs' Motion for Summary Judgment dated April 14, 2011
14. Letter of Panagiota Betty Tufariello, Esq. dated April 29, 2011 in Further Support of Plaintiff's Motion for Summary Judgment dated April 14, 2011
15. Letter of Gary Adelman, Esq. dated May 24, 2011 in Response to Letter of Panagiota Betty Tufariello, Esq. dated April 29, 2011 in Further Support of Plaintiff's Motion for Summary Judgment dated April 14, 2011
  
16. Plaintiffs' Notice of Motion (seq. #006) to Quash Subpoena dated April 20, 2011
17. Affirmation of Nathan C. Zezula, Esq. in Opposition dated April 28, 2011

**Index No. 34745/2009:**

18. Defendants' Notice of Motion (seq. #002) for Dismissal or Summary Judgment dated May 28, 2010
19. Affirmation of Panagiota Betty Tufariello, Esq. in Support of Defendants' Motion for Dismissal or Summary Judgment dated May 28, 2010
20. Defendants' Memorandum of Law in Support of Motion for Dismissal or Summary Judgment dated May 28, 2010
21. Affirmation of David E. Ross, Esq. in Opposition to Defendants' Motion for Dismissal or Summary Judgment dated July 27, 2010
22. Plaintiff's Memorandum of Law in Opposition to Defendants' Motion for Dismissal or Summary Judgment dated July 27, 2010
23. Affirmation of Marc A. Lavaia, Esq. in Opposition to Defendants' Motion for Dismissal or Summary Judgment dated July 27, 2010
24. Affirmation of Geri Henle, Esq. in Opposition to Defendants' Motion for Dismissal or Summary Judgment dated July 27, 2010
25. Reply Affirmation of Panagiota Betty Tufariello, Esq. in Further Support of Defendants' Motion for Dismissal or Summary Judgment dated August 17, 2010

It is,

**ORDERED** that this motion (seq. #006 under Index No. 6261/2005) by plaintiffs, MORRIS SENDOR, GREAT RESTAURANTS OF LONG ISLAND, INC., GREAT RESTAURANTS OF NEW YORK CITY, EAST SIDE EDITION, INC., GREAT RESTAURANTS OF NEW YORK CITY, WEST SIDE EDITION, INC. ("Sendor" or collectively "plaintiffs"), for an Order precluding defendant, MATTHEW CHERVIN ("Chervin"), from entering "recently produced materials" into evidence at trial, is hereby **DENIED** for the reasons set forth hereinafter; and it is further

**ORDERED** that this motion (seq. #007 under Index No. 6261/2005) by plaintiffs and non-party Steven Sendor for an Order, pursuant to CPLR 2304, quashing in its entirety defendant CARY ROSNER's ("Rosner") trial subpoena served upon Steven Sendor, is hereby **DENIED** for the reasons set forth hereinafter; and it is further

**ORDERED** that this motion (seq. #005 under Index No. 12656/2006) by plaintiffs, MORRIS SENDOR, GREAT RESTAURANTS OF NEW YORK CITY, EAST SIDE EDITION, INC., GREAT RESTAURANTS OF NEW YORK CITY, WEST SIDE EDITION, INC. ("Sendor" or collectively "plaintiffs"), for an Order, pursuant to CPLR 3212, granting summary judgment to plaintiffs for the relief demanded in the complaint on the grounds that: (a) plaintiffs' mark "Where to Dine" merits protection; (b) defendants' manner of use of the mark "The Bottom Line on Where to Dine" is confusingly similar to plaintiffs' mark "Where to Dine"; (c) defendants WHERE TO DINE, LLC's and Rosner's counterclaims are barred by the doctrine of *res judicata*; (d) all of defendants' counterclaims are barred by plaintiffs' prior use of their mark; (e) all of defendants' counterclaims are barred by the doctrine of waiver; (f) all of defendants' counterclaims are barred by the doctrine of unclean hands; (g) all of defendants' counterclaims are barred by the doctrine of judicial estoppel; and (h) there are no issues of fact in connection with any of the foregoing, is hereby determined as set forth hereinafter; and it is further

**ORDERED** that this motion (seq. #006 under Index No. 12656/2006) by plaintiffs and non-party Adam Elan Kornblum for an Order, pursuant to CPLR 2304, quashing in its entirety defendants WHERE TO DINE IN, LLC and CARY

Rosner's trial subpoena served upon Adam Elan Kornblum as custodian of records of Great Kosher Restaurants, LLC, is hereby **DENIED** for the reasons set forth hereinafter; and it is further

**ORDERED** that this motion (seq. #002 under Index No. 34745/2009) by defendants, MORRIS SENDOR and GREAT RESTAURANTS OF LONG ISLAND, INC., for an Order, pursuant to CPLR 3211 (a) (7), dismissing plaintiff Rosner's complaint on the grounds that it fails to state a cause of action, or, in the alternative, for an Order, pursuant to CPLR 3212, granting defendants summary judgment, is hereby **GRANTED** as set forth hereinafter.

By Order dated May 3, 2011, this Court adjourned the joint trial of these actions to **September 15, 2011** so that the Court could consider all of the above-referenced submissions of the parties and render the within decision and Order addressing and determining the issues raised therein.

## I. FACTS

Sendor alleges that he is engaged in the restaurant advertising business and in connection therewith, has published and produced various restaurant guides. Sendor indicates that his original corporation was Great Restaurants of Long Island, Inc., wherein he is the sole owner, which since 1996 has published a restaurant advertising magazine entitled "Great Restaurants of Long Island." Sendor contends that the Great Restaurants of Long Island magazine became highly successful and generated substantial revenues. Sendor informs the Court that he is the owner of U.S. Federal Trademark Registration No. 2,932,355 for the trademark "Great Restaurants," and has granted a license to Great Restaurants of Long Island, Inc. to use the mark.

Thereafter, in order to expand his business interests to the New York City area, Sendor created three new corporations, to wit: Great Restaurants of New York City, East Side Edition, Inc.; Great Restaurants of New York City, West Side Edition, Inc.; and Great Kosher Restaurants Magazine, in which Sendor is the majority shareholder. Sendor informs the Court that he has granted all three corporations a license to use his trademark. Sendor further informs the Court that he hired Chervin and Rosner to work at the East Side and West Side corporations; Chervin was made an officer of both the East Side and West side

entities, and Rosner was retained as an independent consultant for the purpose of helping with sales for both New York City publications. Sendor indicates that Rosner and Chervin signed confidentiality/non-compete agreements, wherein they agreed not to disclose confidential trade secrets and information, or to start a business similar in nature to Sendor's restaurant publications anywhere in the world for fifteen years. These confidentiality agreements are the subject of the instant action pending under Index No. 6261/2005.

In or about 2004, Sendor alleges that the term "Where to Dine" was coined for use in the Great Restaurants magazines, and first appeared therein on or about November 29, 2004, and has continued to date. Such magazines have apparently been distributed in multiple states throughout the United States. Sendor alleges that on July 9, 2004, his business relationship with Rosner was terminated for, among other things, their inability to enter into a licensing agreement for Rosner to bring the Great Restaurants magazines concept to Florida.

Thereafter, on or about February 14, 2005, Rosner started a business of his own, defendant "WHERE TO DINE IN, LLC," which Sendor claims published magazines having the same or similar formats, techniques and designs as those created by Sendor. Sendor alleges that in or about December of 2005, Rosner published a magazine entitled, "Where to Dine in New York City," which was allegedly designed to compete with Sendor's New York City magazines. Moreover, Sendor claims that Rosner purposely chose the name "Where to Dine" in order to confuse and mislead the public, and attempted to convince Sendor's existing or prospective customers that his magazine was affiliated with Sendor's magazines to exploit Sendor's "good will and excellent reputation." As a result, Sendor commenced the instant action pending under Index No. 12656/2006, sounding in trademark infringement and unfair competition.

Sendor alleges that with respect to the mark "Where to Dine," he is the owner of New York State Trademark Registration No. R30732, issued on January 13, 2006, as well as a U.S. Federal Trademark application Serial No. 78/736,536, for use in connection with printed matter and publications, which both show November 1, 2004 as Sendor's first date of use. In support thereof, Sendor has submitted, among other things, copies of some of his first publications that allegedly entered the interstate stream of commerce in or about November of 2004. In contrast, Sendor argues that U.S. Trademark Registration 3,166,559

with respect to the mark "The Bottom Line On Where to Dine," owned by WHERE TO DINE, LLC for use in on-line business directories, shows a first use date of January 1, 2005, subsequent to Sendor's first use of the mark "Where to Dine," and a date of issuance of October 31, 2006. Moreover, Sendor informs the Court that defendant WHERE TO DINE, LLC owns a second U.S. Trademark application, Serial No. 77/130,430, regarding the mark "The Bottom Line On Where to Dine," for use with printed materials, which shows a first use date of January 29, 2007. Thus, Sendor argues that there is no question that his mark was adopted prior to defendants' mark, and has been in continuous use ever since.

Further, Sendor indicates that on or about June 25, 2007, defendant WHERE TO DINE, LLC received correspondence from the United States Patent and Trademark Office in which the Examiner stated that there might be a likelihood of confusion between WHERE TO DINE, LLC's mark of "The Bottom Line On Where to Dine," and Sendor's mark of "Where to Dine." However, in response thereto on or about August 6, 2007, defendants stated that their first registration of "The Bottom Line on Where to Dine" coexisted with Sendor's first federal application with respect to "Where to Dine," and as that phrase was not a registered mark, it should not act as a bar to WHERE TO DINE, LLC's second registration application.

## II. MOTIONS UNDER INDEX NO. 6261/2005

### a. Motion to Preclude

Plaintiffs have filed a motion to preclude Chervin from entering "recently produced materials" into evidence at trial. Plaintiffs allege that on or about March 25, 2011, after the filing of a Notes of Issue under Index Nos. 6261/2005 and 12656/2006, counsel for Chervin produced to plaintiffs a summary of receivables, contracts, and deposited checks for GREAT RESTAURANTS OF NEW YORK CITY, EAST SIDE EDITION, INC., and GREAT RESTAURANTS OF NEW YORK CITY, WEST SIDE EDITION, INC. Counsel for Chervin indicated that some of the material had been produced previously, but it was now organized with an accompanying spreadsheet and back-up material. Counsel produced such material "[i]n keeping with requests for documentation up to the time of trial . . . to avoid any claim of surprise." Plaintiffs argue that Chervin failed to produce such materials pre-Note of Issue; failed to vacate the Note of Issue



previously filed; and failed to demonstrate that “unusual or unanticipated circumstances” developed subsequent to the filing of the Note of Issue which require additional pretrial proceedings to prevent substantial prejudice.

In opposition, Chervin alleges that the materials produced had been previously provided to plaintiffs with the exception of the spreadsheet, and has now merely been presented in an organized manner for use at trial to support his claims. Further, Chervin alleges that plaintiffs’ own motion for summary judgment delayed the commencement of the trial of this matter, thereby belying any claim of prejudice or surprise.

Based upon Chervin’s representation that the “recently produced materials” were previously produced to plaintiffs and were merely produced now to simplify how Chervin calculates his damages, and based upon the fact that trial of this matter is currently scheduled for September 15, 2011, approximately six months after the materials were produced, plaintiffs’ motion to preclude Chervin from entering such materials into evidence at trial, is **DENIED**.

#### b. Motion to Quash Subpoena

Plaintiffs and non-party Steven Sendor have filed a motion for an Order, pursuant to CPLR 2304, quashing in its entirety Rosner’s trial subpoena served upon Steven Sendor, plaintiff Sendor’s son. The subpoena requires Steven Sendor to appear and give testimony at trial, as well as to produce a copy of each issue of the magazine “Great Restaurants of Fairfield County” published between January 1, 2006 and February 10, 2011. Steven Sendor avers that he has no personal knowledge of, or in interest in, the facts and issues of this action. In addition, he avers that he was not given any notice as to the nature of this matter, or why his testimony and documents are necessary. Plaintiffs argue that the subpoena should be quashed because of deficiencies in the service thereof; that Steven Sendor’s testimony and documents are irrelevant to the issues presented herein; and that the subpoena was merely served for the purposes of a “fishing expedition” and to harass plaintiffs. Moreover, plaintiffs allege that the subpoena fails to state the circumstances and reasons that serve as a basis for such disclosure, and that Rosner failed to show that the requested information could not be obtained from other sources.

In opposition, Rosner argues that plaintiffs' motion is untimely; that the subpoena was properly served; that Steven Sendor is aware of and has been given notice of the circumstances and reasons for the requested disclosure; and that the testimony and documents requested are relevant and cannot be obtained from other sources. Specifically, Rosner argues that the motion was made after the return date of the subpoena; that the subpoena was properly served pursuant to CPLR 308; that Steven Sendor is aware of the circumstances surrounding this action as he is the son and business partner of plaintiff Sendor; and that Rosner intends to use Steven Sendor as a credibility and character witness to rebut the testimony of plaintiff Sendor and to establish the business practices of the "Great Restaurant" business entities to show that the Rosner's actions were not fraudulent.

CPLR 3101 (a) (4) provides that there shall be full disclosure of all matter material and necessary in the prosecution or defense of an action by a non-party "upon notice stating the circumstances or reasons such disclosure is sought or required" (CPLR 3101 [a] [4]). What is material and necessary is in the "sound discretion" of the trial court and includes "any facts bearing on the controversy which will assist preparation for trial by sharpening the issues and reducing delay and prolixity. The test is one of usefulness and reason" (*Andon ex rel. Andon v 302-304 Mott Street Assocs.*, 94 NY2d 740 [2000], quoting *Allen v Crowell-Collier Publ. Co.*, 21 NY2d 403 [1968]). The Second Department has previously equated the catch-all provision of CPLR 3101 (a) (4) with the more stringent requirements of CPLR 3101 (d) (1) (iii), by requiring that the moving party show adequate special circumstances to warrant disclosure (see *Attinello v DeFilippis*, 22 AD3d 514 [2005]; *Lanzello v Lakritz*, 287 AD2d 601 [2001]; *Dioguardi v St. John's Riverside Hosp.*, 144 AD2d 333 [1988]). Special circumstances are shown by establishing that the information sought is not only relevant, but also cannot be obtained through other sources (see *Tannenbaum v Tenenbaum*, 8 AD3d 360 [2004]; *Murphy v Macarthur Holding B.*, 269 AD2d 507 [2000]). Whether "special circumstances" have been shown to exist in a particular case is a question committed to the sound discretion of the court to which the application for discovery is made (see *Brady v Ottaway Newspapers*, 63 NY2d 1031 [1984]; *Dioguardi v St. John's Riverside Hosp.*, 144 AD2d 333 [1988]).

Notwithstanding the foregoing, the Second Department has held that although many of its decisions continued to apply the "special circumstances" standard to obtain discovery from a non-party despite the 1984 amendment to

CPLR 3101 (a) (4) eliminating such language, “[w]e hereby disapprove the further application of the ‘special circumstances’ standard in this context. We, nevertheless, look behind that language in our cases and find underlying considerations which are appropriate and relevant to the trial court’s exercise of its discretion in determining whether a request for discovery from a nonparty should go forward or be quashed” (*Kooper v Kooper*, 74 AD3d 6, 8 [2010]). The Second Department further held that “[w]e decline, here, to set forth a comprehensive list of circumstances or reasons which would be deemed sufficient to warrant discovery from a nonparty in every case. Circumstances necessarily vary from case to case” (*id.* at 17). However, the Second Department emphasized that “[i]nclusion of the language ‘circumstances or reasons such disclosure is sought or required’ from a nonparty indicates that something more than mere relevance is required if the discovery request is challenged” (*id.* at 18).

Nevertheless, an application to quash a subpoena should be granted only “where the futility of the process to uncover anything legitimate is inevitable or obvious” . . . “or where the information sought is utterly irrelevant to any proper inquiry” (*Anheuser-Busch, Inc. v Abrams*, 71 NY2d 327 [1988] [citations omitted]; see *Tech. Multi Sources v Stack Global Holdings, Inc.*, 2007 NY Slip Op 8062, *supra*; *Myrie v Shelley*, 237 AD2d 337 [1997]; *Ayubo v Eastman Kodak, Co.*, 158 AD2d 641 [1990]).

On this record, the Court finds that plaintiffs’ motion to quash was not made “promptly,” i.e., before the return date of the subpoena (see *Brunswick Hosp. Center, Inc. v Hynes*, 52 NY2d 333 [1981]; *Santangelo v. People*, 38 NY2d 536 [1976]), and that plaintiffs and Steven Sendor have failed to establish that the information sought by the subpoena is utterly irrelevant to any proper inquiry (*Anheuser-Busch, Inc. v Abrams*, 71 NY2d 327, *supra*). Accordingly, plaintiffs’ and Steven Sendor’s motion to quash is **DENIED**.

### III. MOTIONS UNDER INDEX NO. 12656/2006

#### a. Motion for Summary Judgment

Based upon the statement of facts recited hereinabove, plaintiffs argue that there are no issues of material fact in connection with any of plaintiffs’ claims for trademark infringement and unfair competition. Plaintiffs allege that

they have set forth evidentiary facts sufficient to show that there is a likelihood of confusion between their mark and defendants' mark. Furthermore, plaintiffs argue that there are no issues of material fact in connection with defendants' counterclaims for trademark infringement and frivolous action.

In opposition to plaintiffs' motion for summary judgment, Rosner claims that he did not create the phrase "Where to Dine," but he never heard it from Sendor or Chervin. Instead, Rosner contends that he previously saw the phrase used descriptively in "Where Magazine" and thought it would work well as the name of an entire magazine. Thus, Rosner argues that he did not copy plaintiffs in any way. Rosner alleges that plaintiffs had a prototype of his magazine "since at least February of 2004," and therefore alleges that plaintiffs stole the design and format elements of "Where to Dine" from him. Rosner alleges that he did not take or use any confidential or proprietary information from plaintiff, and argues that plaintiffs' motion is devoid of any facts or evidence to demonstrate that he used plaintiffs' confidential information. Thus, Rosner contends that plaintiffs have failed to make a *prima facie* showing which would entitle them to summary judgment.

In addition, Rosner alerts the Court that on or about April 24, 2008, the United States Patent and Trademark Office refused to register "Where to Dine" as a trademark, finding that the applied-for mark "is merely informational matter; it does not function as a trademark to identify and distinguish applicant's goods from those of others and to indicate the source of applicant's goods." On or about January 7, 2010, the USPTO Trial Trademark and Appeal Board dismissed Sendor's appeal thereof for failure to timely file a brief. Finally, Rosner indicates that on or about December 21, 2009, Sendor filed a second identical application with the USPTO to register "Where to Dine," which was refused on or about April 15, 2010 based upon a likelihood of confusion with the mark "The Bottom Line on Where to Dine."

Chervin has also submitted opposition to plaintiffs' motion for summary judgment, and informs the Court that he was never an owner of WHERE TO DINE IN, LLC, but merely an employee, and that his employment with that entity terminated in late 2005. Prior thereto, Chervin was a fifty (50%) percent owner of GREAT RESTAURANTS OF NEW YORK CITY, EAST SIDE EDITION, INC. and GREAT RESTAURANTS OF NEW YORK CITY, WEST SIDE EDITION, INC., along with Sendor. Chervin alleges that any claim that Sendor taught him the sales and advertising business is completely false, as he had

almost eight years of previous experience in that field. Furthermore, Chervin contends that the concept or idea of having restaurants advertise in a magazine is not exclusively Sendor's, as it has been in existence for many years and in many publications. Chervin additionally contends that in 2004 and 2005, Sendor failed to pay Chervin the expenses and commissions to which he was entitled. Regarding the confidentiality agreement that Chervin signed, he alleges that Sendor cannot prove that he exposed anything of Sendor's that was confidential or exclusive, as all the magazines in that field have similar formats and editorials. With respect to the non-compete clause, Chervin alleges that the duration of fifteen years is too long and that the geographical area of "all over the world" is too broad, and therefore the clause against public policy. Accordingly, Chervin argues that there are numerous issues of fact herein that preclude the granting of summary judgment to plaintiffs.

On a motion for summary judgment, the test to be applied is whether or not triable issues of fact exist or whether on the proof submitted a court may grant judgment to a party as a matter of law (CPLR 3212 [b]; *Zuckerman v City of New York*, 49 NY2d 557 [1980]; *Andre v Pomeroy*, 35 NY2d 361 [1974]; *Akseizer v Kramer*, 265 AD2d 356 [1999]). It is well-settled that a proponent of a motion for summary judgment must make a *prima facie* showing of entitlement to judgment as a matter of law, tendering evidentiary proof in admissible form to demonstrate the absence of any material issues of fact (*Dempster v Overview Equities, Inc.*, 4 AD3d 495 [2004]; *Washington v Community Mut. Sav. Bank*, 308 AD2d 444 [2003]; *Tessier v N.Y. City Health and Hosps. Corp.*, 177 AD2d 626 [1991]). Once this showing has been made, the burden shifts to the party opposing the motion for summary judgment to produce evidentiary proof in admissible form sufficient to establish the existence of material issues of fact which require a trial of the action (*Gong v Joni*, 294 AD2d 648 [2002]; *Romano v St. Vincent's Med. Ctr.*, 178 AD2d 467 [1991]; *Comms. of the State Ins. Fund v Photocircuits Corp.*, 2 Misc 3d 300 [Sup Ct, NY County 2003]). Summary judgment is a drastic remedy and should only be granted in the absence of any triable issues of fact (see *Rotuba Extruders, Inc. v Ceppos*, 46 NY2d 223 [1978]; *Andre v Pomeroy*, 35 NY2d 361, *supra*).

As noted hereinabove, plaintiffs have asserted two causes of action in the instant matter, to wit: trademark infringement and unfair competition. Defendants WHERE TO DINE IN, LLC and Rosner have interposed two counterclaims, to wit: trademark infringement on their mark "The Bottom Line on Where to Dine" and frivolous action. In an action for trademark infringement

brought pursuant to either New York law or federal law, it is necessary that a plaintiff demonstrate that it has a valid mark entitled to protection, and that the defendant's use of the mark is likely to cause confusion, mistake or to deceive; actual confusion need not be shown. Similarly, it has been held that in an action for unfair competition a showing of a likelihood of confusion, rather than actual confusion, is all that is required to state a cause of action (see General Business Law § 360-k; 15 USC § 1114; *Allied Maintenance Corp. v Allied Mechanical Trades, Inc.*, 42 NY2d 538 [1977]; *Beverage Mktg. USA v S. Beach Bev. Co.*, 20 AD3d 439 [2005]; *Eagle Comtronics, Inc. v Pico Prods., Inc.*, 256 AD2d 1202 [1998]; *Time, Inc. v Petersen Publ. Co.*, 173 F 3d 113 [2d Cir 1999]).

To determine whether there is a likelihood of confusion between two or more marks, courts have applied the following factors, which are not exhaustive: (1) the strength of the mark; (2) the degree of similarity between the two marks; (3) the proximity of the products; (4) the likelihood that the prior owner will "bridge the gap" between the products; (5) the existence of actual confusion; (6) the defendant's good faith in adopting its own mark; (7) the quality of the defendant's product; and (8) the sophistication of the consumers (*Polaroid Corp. v Polarad Electronics Corp.*, 287 F 2d 492 [2d Cir 1961]).

To prevail on a claim for unfair competition under New York common law, a plaintiff must couple its evidence supporting liability under the Lanham Act with additional evidence demonstrating a defendant's bad faith. The essence of an unfair competition claim is that the defendant has misappropriated a commercial advantage which belongs exclusively to the plaintiff (*LoPresti v Mass. Mut. Life Ins. Co.*, 30 AD3d 474 [2006]). Central to this notion is some element of bad faith (see *Tiffany Inc. v eBay, Inc.*, 576 F Supp 2d 463 [SDNY 2008]; *Omicron Capital, LLC v Omicron Capital, LLC*, 433 F Supp 2d 382 [SDNY 2006]).

In the case at bar, the Court finds that the plaintiffs have failed to make an initial *prima facie* showing of entitlement to judgment as a matter of law for the relief demanded in the complaint (see e.g. *Alvarez v Prospect Hosp.*, 68 NY2d 320 [1986]; *Andre v Pomeroy*, 35 NY2d 361, *supra*; *Rodriguez v N.Y. City Transit Auth.*, 286 AD2d 680 [2001]). With respect to the trademark infringement claim, as discussed hereinabove, the United States Patent and Trademark Office refused to register "Where to Dine" as a trademark, finding that it is merely informational matter and does not function as a trademark to identify and distinguish applicant's goods from those of others. Further, plaintiffs have failed to unequivocally demonstrate that defendants' use of their mark, "The Bottom

Line on "Where to Dine" is likely to cause confusion, mistake or deceive consumers. With respect to plaintiffs' second cause of action for unfair competition, the Court finds that on this record plaintiffs have failed to demonstrate that defendants misappropriated a commercial advantage which belongs exclusively to the plaintiffs, or that defendants acted in bad faith. In contrast, Rosner claims that Sendor stole ideas and designs for the magazines from him, and the Court notes that there are many such restaurant review guides in existence. On this record, the usage of the phrase as alleged occurred so close in time that the Court is unable to declare a truly prior use (i.e., actual publication).

Accordingly, plaintiffs' motion for summary judgment for the relief demanded in the complaint is **DENIED**. Regarding plaintiffs' arguments for dismissal of Rosner's counterclaims, to wit: *res judicata*, waiver, unclean hands, or judicial estoppel, the Court refers these issues to the trial of this matter, which is scheduled to begin imminently on September 15, 2011.

#### b. Motion to Quash Subpoena

Plaintiffs and non-party Adam Elan Kornblum ("Kornblum") have filed a motion for an Order, pursuant to CPLR 2304, quashing in its entirety Rosner's trial subpoena served upon Kornblum, Sendor's business partner in an entity known as "Great Kosher Restaurants Magazine, LLC." The subpoena requires Kornblum to appear and give testimony at trial, as well as to produce: (1) a copy of all contracts between Great Kosher Restaurants, LLC and any magazine advertiser from 2006 to the present; (2) any and all documents that reflect payments between Great Kosher Restaurants, LLC and Sendor; (3) any and all documents that reflect payments between Great Restaurants, LLC and Sendor; and (4) all contracts between Sendor and Great Kosher Restaurants, LLC. Kornblum avers that he has no knowledge of the facts and issues of this action. In addition, he avers that he was not given any notice as to why his testimony and documents are necessary for the establishment of plaintiffs' allegations and defendants' claims. Plaintiffs argue that the subpoena should be quashed because it was directed to a company that does not exist, to wit: "Great Kosher Restaurants, LLC"; that there are deficiencies in the service thereof upon the LLC; that Kornblum's testimony and documents are irrelevant to the issues presented herein; and that the subpoena was merely served for the purposes of a "fishing expedition" and to harass plaintiffs. Moreover, plaintiffs allege that the

subpoena fails to state the circumstances and reasons that serve as a basis for such disclosure, and that Rosner failed to show that the requested information could not be obtained from other sources.

In opposition, Rosner argues that plaintiffs' motion is untimely; that the subpoena was properly served; that Kornblum is aware of and has been given notice of the circumstances and reasons for the requested disclosure; and that the testimony and documents requested are relevant and cannot be obtained from other sources. Specifically, Rosner argues that the motion was made after the return date of the subpoena; that the subpoena was properly served upon the LLC pursuant to CPLR 311-a; that Kornblum is aware of the circumstances surrounding this action as he is the business partner and co-owner of Great Kosher Restaurants Magazine, LLC with Sendor, and both were named as defendants in a federal action commenced by WHERE TO DINE, LLC; that Kornblum is the only person that actually works for Great Kosher Restaurants Magazine, LLC; and that Rosner intends to use Kornblum's testimony to establish the trademarks of Great Kosher Restaurants Magazine, LLC. Furthermore, Rosner contends that Sendor testified at his deposition that he is personally the owner of the trademark "Where to Dine" and utilized such trademark under a license agreement with Great Kosher Restaurants Magazine.

The relevant statutes and case law have been cited hereinabove.

On this record, the Court finds that plaintiffs' motion to quash was not made "promptly," i.e., before the return date of the subpoena (see *Brunswick Hosp. Center, Inc. v Hynes*, 52 NY2d 333 [1981]; *Santangelo v. People*, 38 NY2d 536 [1976]), and that plaintiffs and Kornblum have failed to establish that the information sought by the subpoena is utterly irrelevant to any proper inquiry (*Anheuser-Busch, Inc. v Abrams*, 71 NY2d 327, *supra*). Accordingly, plaintiffs' and Kornblum's motion to quash is **DENIED**.

#### IV. MOTION UNDER INDEX NO. 34745/2009

##### a. Motion for Dismissal or Summary Judgment

In this action sounding in defamation in connection with a letter drafted by Sendor dated May 4, 2005, defendants, MORRIS SENDOR and



GREAT RESTAURANTS OF LONG ISLAND, INC. (collectively "defendants"), move for an Order, pursuant to CPLR 3211 (a) (7), dismissing Rosner's complaint on the grounds that it fails to state a cause of action, or, in the alternative, for an Order, pursuant to CPLR 3212, granting defendants summary judgment. Defendants argue, among other things, that the first cause of action for trade libel must be dismissed because Rosner failed to comply with the pleading requirements of CPLR 3016 (a), failed to establish that the alleged libelous statements are "of and concerning" Rosner himself, and failed to allege special damages. Further, defendants argue that the statements contained in the May 4, 2005 letter are true in their entirety.

In opposition to this motion, counsel for Rosner indicates that on or about July 20, 2010, he contacted defendants' counsel to advise them that Rosner was willing to discontinue this action with prejudice, and had been willing to discontinue since 2008. Defendants' counsel refused. Apparently, defendants sought conditions with respect to such discontinuance, to wit: (1) an affidavit from Rosner that this action has no merit, never had any merit, and that Rosner never suffered any damages; and (2) an agreement to pay all of defendants' litigation fees attributable to this action. Indeed, Rosner has submitted an affirmation of his former counsel, which annexes an unsigned stipulation of discontinuance dated May 2008, as well as an affirmation of Rosner's per diem counsel who appeared in Court on March 4, 2010 and advised defendants' counsel that Rosner was willing to discontinue this action with prejudice. However, defendants allegedly rejected this offer and advised Rosner's counsel and the Court that they would instead move for summary judgment.

As Rosner has indicated that he is willing to discontinue this action with prejudice, and as defendants have not asserted any counterclaims and have not sought an award of litigation fees in their notice of motion (see CPLR 2214), this motion by defendants to dismiss is **GRANTED**, and the action under Index No. 34745/2009 is hereby dismissed in its entirety with prejudice.

The foregoing constitutes the decision and Order of the Court.

Dated: September 13, 2011

  
HON. JOSEPH FARNETI  
Acting Justice Supreme Court

\_\_\_\_ FINAL DISPOSITION

  X   NON-FINAL DISPOSITION