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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

09-30-2002
U.S. Patent & TMO/c/TM Mail Rcpt Dt. #26

In the Matter of Trademark Application Serial No.: 76326769
Filed: October 18, 2001
For the Mark: L&B SPUMONI GARDENS
Published In The Official Gazette May 21, 2002

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LBSG, LLC,
Petitioner

v.

Opposition No. 91152521

LB GARDENS, INC.
a/k/a & B GARDENS, INC.,
Respondent.

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BOX TTAB
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

MOTION TO SUSPEND PROCEEDINGS or
TO EXTEND TIME TO RESPOND

02 OCT - 7 PM 12:30
TRADEMARK TRIAL AND
APPEAL BOARD

Respondent herein, LB Gardens, Inc., a/k/a/ L &B Gardens, Inc., a
New York corporation with its principal place of business at 2725 86th Street,
Brooklyn, New York 11223 filed a summons and complaint against Opposer,
LBSG, LLC in the United States District Court, Eastern District of New York,
Case # 02 Civ. 4040 (ERK) (MDG) on July 17, 2002 regarding Opposer's
infringement of respondent's L&B SPUMONI GARDENS mark. See Exhibit A.

It is submitted that the same issue that is at stake in the instant

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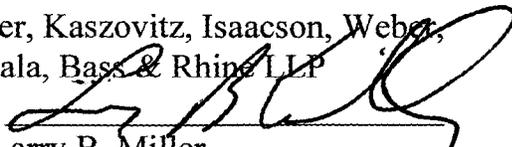
Opposition, namely, likelihood of confusion, is to be determined in the federal district case. Rather than litigate the same issue in different forums, at great cost and expense to all parties, it is hereby requested that the Trademark Trial and Appeal Board suspend proceedings herein pending the outcome of the above referenced case in federal court as permitted pursuant to 37 C.F.R. § 2.117.

This Motion is not made for the purpose of needless delay but in the desire to produce a consistent, efficient result with applicability to the pending actions.

Should the Trademark Trial and Appeal Board decide not to grant this motion, respondent requests an additional 30 (thirty) days time after receipt of the Board's decision to respond to Opposer's Notice of Opposition.

Respectfully submitted,

Feder, Kaszovitz, Isaacson, Weber,
Skala, Bass & Rhine LLP

By: 

Larry B. Miller

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Counsel for Respondent

LB GARDENS, INC. a/k/a L & B GARDENS, INC.

Dated: September 25, 2002
New York, New York

CERTIFICATE OF MAILING

It is hereby certified that the foregoing Motion to Suspend Proceedings or to Extend Time to Respond and attached exhibit of the complaint filed in the United States District Court Case # 02 Civ. 4040 (ERK) (MDG) was served by Federal Express this 9/25/02, in an envelope addressed to Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513.

A handwritten signature in black ink, appearing to be 'A. B. C.', written over a horizontal line.

Dated: September 25, 2002
New York, New York

IN CLERK'S OFFICE
U.S. DISTRICT COURT E.D.N.Y.
★ JUL 17 2002 ★
BROOKLYN OFFICE

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Attorneys for Plaintiff

GO. M.J

UNITED STATES DISTRICT COURT FOR THE
EASTERN DISTRICT OF NEW YORK

-----X		02 Civ. _____
L & B GARDENS, INC.,	:	
	Plaintiff,	:
	:	
-against-	:	COMPLAINT
	:	
LBSG, LLC	:	
	Defendant.	:
-----X		

Plaintiff, by its attorneys, complaining of the Defendants, alleges:

JURISDICTION & VENUE

1. This is an action for infringement under the Lanham Trademark Act, 15 U.S.C. § 1051, et seq.
2. This Court has jurisdiction under 15 U.S.C. § 1121, 28 U.S.C. §§ 1331, 1338(a), 1338(b) and 1367(a). Venue is proper in this judicial district pursuant to 28 U.S.C. §§ 1391 (b) and (c) in that defendant has committed torts outside New York that have caused Plaintiff injury in New York.

PARTIES

3. Plaintiff L & B GARDENS, INC. a/k/a/ L&B SPUMONI GARDENS ("L&B") is a New York corporation with its principal place of business in Brooklyn, New York.

4. Upon information and belief, Defendant LBSG, LLC (“LBSG”) is a New Jersey Limited Liability corporation with its principal place of business in Millstone, New Jersey.

PLAINTIFF’S TRADEMARK AND TRADE DRESS

6. L&B is the owner of U.S. Trademark Application Serial No. 76/326,769 for the mark L&B SPUMONI GARDENS (the “SPUMONI GARDENS Mark”), for pizza delivery services, catering services and restaurant services featuring home delivery (the “Services”).

7. The SPUMONI GARDENS Mark has been used throughout the New York and New Jersey area for over sixty (60) years and through widespread and favorable public acceptance and recognition, the SPUMONI GARDENS Mark is an asset of substantial value as a symbol of Plaintiff, its quality products and services and its good will. The SPUMONI GARDENS Mark has always been used on products of the highest quality, and has developed secondary meaning and significance in the minds of the purchasing public. Products bearing the SPUMONI GARDENS Mark are well-known and are immediately identified by the purchasing public with Plaintiff.

DEFENDANTS’ ACTIONS

8. LBSG has applied to register the mark SPUMONI GARDENS EXPRESS, Serial No. 76/401,426 with the United States Patent and Trademark Office (“PTO”) for restaurant services and ice cream, and has alleged use of the mark in commerce since October 10, 2001.

9. LBSG has advertised publicly claiming an association between themselves and L&B, thereby deceiving prospective purchasers to believe that L&B sponsors, is associated with, or is the source of the services and goods offered by LBSG.

10. Upon information and belief, LBSG has been telling prospective customers that LBSG’s proposed restaurant is part of an “Italian chain restaurant” associated with plaintiff.

11. Upon information and belief, LBSG has been telling prospective customers that it is the original "Spumoni Gardens" and that plaintiff is a subsequent user of the mark.

12. In March 2002, LBSG posted a sign in front of the construction site for the proposed store stating, "You no longer have to travel over two bridges for the best pizza in the world. Coming soon - Spumoni Gardens."

13. In furtherance of its deception of the public, LBSG has caused to be printed virtually identical copies of L&B's menus to deceive potential purchasers into the belief that LBSG is associated with L&B.

14. Upon information and belief, agents of LBSG have gone to L&B's premises and taken pictures of L&B's premises both inside and outside, announcing their intention to copy L&B's trade dress.

Count I

FEDERAL UNFAIR COMPETITION

(False Designation of Origin in Violation of 15 U.S.C. § 1125(a))

15. The plaintiff repeats, reiterates, and realleges the allegations contained in paragraphs 1 through 14 above as if fully set forth herein.

16. Plaintiff's SPUMONI GARDENS Mark has become uniquely associated with and hence identifies Plaintiff's Services.

17. Defendant's use in interstate commerce of the SPUMONI GARDENS EXPRESS mark along with menus with plaintiff's trade dress has misled and is misleading potential purchasers of plaintiff in that it has wrongfully and falsely designated defendants' products and services as originating from or being connected to Plaintiff.

18. Defendants use of the SPUMONI GARDENS EXPRESS mark in interstate

commerce without the consent of Plaintiff, for the purpose of selling infringing services and products, has caused and continues to cause confusion, mistake and deception in the minds of the public.

19. Defendant's use of the SPUMONI GARDENS EXPRESS mark has misled, and will continue to mislead, the public into believing that Defendant's infringing restaurant services and ice cream originate with Plaintiff, are licensed by Plaintiff, or are in some way sanctioned by, or affiliated with, Plaintiff.

20. By so imitating and infringing the SPUMONI GARDENS Mark, Defendants have violated Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a).

21. By offering to sell ice cream and to provide restaurant services in commerce with respect to the SPUMONI GARDENS EXPRESS mark, Defendants have willfully infringed Plaintiff's SPUMONI GARDENS mark in violation of Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a).

22. These acts of infringement will cause further irreparable injury to Plaintiff if Defendants are not restrained by this Court from further violation of Plaintiff's rights.

23. By reason of the foregoing, Plaintiff has no adequate remedy at law and continues to suffer irreparable harm and danger as a result of the acts of Defendants and has suffered and is suffering financial injury in an amount to be determined at trial, and is entitled to the remedies provided for in 15 U.S.C. § 1117 et seq.

Count II
COMMON LAW UNFAIR COMPETITION

24. The plaintiff repeats, reiterates, and realleges the allegations contained in paragraphs 1 through 24 above as if fully set forth herein.

25. By virtue of Defendants' acts, above pleaded, Defendants' have engaged in unfair competition with Plaintiff under the common law of the State of New York.

26. By reason of the foregoing, Plaintiff has no adequate remedy at law and continues to suffer irreparable harm and danger as a result of the acts of Defendants and has suffered financial injury in an amount not yet ascertained.

Count III
NEW YORK DECEPTIVE PRACTICES VIOLATION
(N.Y. Gen. Bus. L. sec. 133)

27. The plaintiff repeats, reiterates, and realleges the allegations contained in paragraphs 1 through 26 above as if fully set forth herein.

28. Defendants and Plaintiff are in the business of providing restaurant services and associated products to a degree where there is a likelihood of confusion if Defendants use Plaintiff's SPUMONI GARDENS Mark.

29. Defendants' misappropriation and infringement of the Marks constitutes the assumption, adoption or use, with intent to deceive or mislead the public, for advertising purposes or for the purposes of trade of a symbol or simulation thereof, or a part of a symbol or simulation thereof, which may deceive or mislead the public into believing that a connection exists between Defendants and Plaintiff, in violation of the New York Uniform Deceptive Trade Practices Act (N.Y. Gen. Bus. L. sec. 133).

30. By reason of the foregoing, Plaintiff has no adequate remedy at law and continues to suffer irreparable harm and danger as a result of the acts of Defendants and has suffered financial injury in an amount not yet ascertained.

Count III
NEW YORK ANTIDILUTION VIOLATION
(N.Y. Gen. Bus. L. sec. 360-1)

31. The plaintiff repeats, reiterates, and realleges the allegations contained in paragraphs 1 through 30 above as if fully set forth herein.

53. Defendants are in violation of the New York Antidilution Statute (N.Y. Gen. Bus. L. sec. 360-1).

54. By reason of the foregoing, Plaintiff has no adequate remedy at law and continues to suffer irreparable harm and danger as a result of the acts of Defendants and has suffered financial injury in an amount not yet ascertained.

55. Plaintiff hereby demands a trial by jury on all of its claims.

WHEREFORE, Plaintiff demands that judgment be entered against Defendants as follows:

(1) That Defendants, their officers, agents, servants, employees and all persons in concert or participation with Defendants be preliminarily and permanently enjoined from:

(a) infringing Plaintiff's registered SPUMONI GARDENS Mark;

(b) selling or marketing merchandise in any way that tends to deceive, mislead or confuse the public into believing that Defendants' merchandise is in any way sanctioned by or affiliated with Plaintiff;

(c) otherwise competing unfairly with Plaintiff; and

(d) diluting the distinctive quality of Plaintiff's SPUMONI GARDENS Mark.

(2) That Defendants be directed to file with this Court and serve on Plaintiff within thirty days after service of the injunction, a report in writing, under oath, setting forth in detail the manner and form in which Defendants has complied with the injunction;

(3) That Defendants be required to account for and pay over to Plaintiff all gains, profits and advantages realized from the sale of infringing merchandise;

(4) That Defendants be required to pay to Plaintiff such damages as Plaintiff has sustained as a consequence of Defendants' acts of unfair competition, deceptive and unfair practices, trademark dilution including multiple damages in the amount of three times the damages sustained by Plaintiff pursuant to Section 35 of the Lanham Act, 15 U.S.C. § 1117;

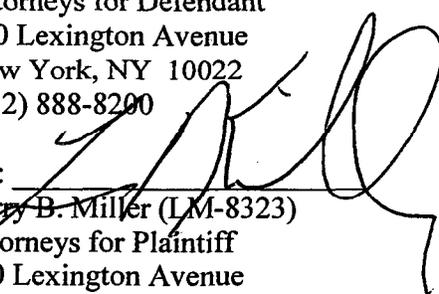
(5) That Defendants be required to deliver up for destruction all products, packaging, labels, menus, literature, advertising and other material bearing imitations or reproductions, including confusingly similar variations of, the SPUMONI GARDENS Mark;

(6) That Defendants be required to pay Plaintiff's costs, expenses and reasonable attorney fees in connection with this action as provided in 15 U.S.C. § 1117; and,

(7) That Plaintiff have such other, further and different relief as this Court deems just and proper.

Dated: New York, New York
July 16, 2002

Respectfully Submitted,
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