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

Proceeding	91221726
Party	Plaintiff Patsy's Brand, Inc.
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Date	04/04/2016
Attachments	OPPOSER_REQUEST_REHEARING_PURSUANT.pdf(99785 bytes ) FORM C.pdf(64299 bytes )

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

-----X	)	
PATSY’S BRAND, INC.,	)	
	)	
Opposer,	)	
	)	
v.	)	Opposition No. 91221726
	)	
ISA BRIJA,	)	
	)	
Applicant.	)	
-----X	)	

**OPPOSER’S REQUEST FOR REHEARING PURSUANT  
TO TRADEMARK RULES 2.117(a) AND 2.127(b)**

In an Order dated April 3, 2016, the Board denied Opposer’s motion to suspend the proceedings on the ground that the counterclaim petition for cancellation of Opposer’s Reg. No. 3,090,551 for the mark PATSY’S OF NEW YORK is not the subject of a parallel civil action. It is respectfully submitted that the Board misapprehended or overlooked the appeal filed by the Applicant herein’s related company in the Second Circuit Court of Appeals, No. 16-405, which was called to the Board’s attention by Opposer’s communication dated February 25, 2016.

In the Second Circuit appeal, Applicant’s related company stated the following issue proposed to be raised on appeal:

“2. Did the District Court abuse it [sic, its] discretion in failing to order the cancellation of U.S. Registration No. 3,090,551 for the mark PATSY’S OF NEW YORK when the owner of the registration, Appellee Patsy’s Brand, Inc., is prohibited from using the mark and has admitted it is not using the mark PATSY’S OF NEW YORK.”

A copy of the civil appeal Pre-Argument Statement (Form C) filed by Applicant’s related company, mailed February 25, 2016, and stating that ground, is attached hereto.

Although Opposer herein certainly does not agree with Applicant's stated issue in any way, the point is that the issue of whether the aforesaid registration should be cancelled currently is pending before the Second Circuit.

Therefore, it is respectfully submitted that the Board's Order should be vacated until after the Second Circuit's decision and suspension of this proceeding should remain in effect.

COOPER & DUNHAM LLP

Dated: April 4, 2016

By: /norman h. zivin/  
Norman H. Zivin  
Robert T. Maldonado  
Tonia A. Sayour  
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Attorney for Opposer  
PATSY'S BRAND, INC.

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that the foregoing OPPOSER'S REQUEST FOR REHEARING PURSUANT TO TRADEMARK RULES 2.117(a) AND 2.127(b) was served on this 4<sup>th</sup> day of April 2016 by First Class Mail, postage prepaid, addressed to the following counsel of record:

Paul Grandinetti, Esq.  
Rebecca J. Stempien Coyle, Esq.  
Levy & Grandinetti  
1120 Connecticut Avenue, N.W., Suite 304  
Washington, D.C. 20036

\_\_\_\_\_  
/norman h. zivin/  
Norman H. Zivin

**UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT  
CIVIL APPEAL PRE-ARGUMENT STATEMENT (FORM C)**

1. SEE NOTICE ON REVERSE.

2. PLEASE TYPE OR PRINT.

3. STAPLE ALL ADDITIONAL PAGES

Case Caption:  Patsy's Italian Restaurant v. Banas	District Court or Agency:  Eastern District of New York	Judge:  Reyes
	Date the Order or Judgment Appealed from was Entered on the Docket:  01/12/2016	District Court Docket No.:  06-cv-0729 (RER)
	Date the Notice of Appeal was Filed:  02/10/2016	Is this a Cross Appeal?  Yes <input checked="" type="checkbox"/> No

<b>Attorney(s) for Appellant(s):</b>	Counsel's Name:	Address:	Telephone No.:	Fax No.:	E-mail:
Plaintiff	Paul Grandinetti	Levy & Grandinetti	(202) 429-4560	(202) 429-4564	
<input checked="" type="checkbox"/> Defendant	Rebecca Stempien Coyle	1120 Connecticut Ave NW, Ste 304		mail@levygrandinetti.com	
		Washington, D.C. 20036			

<b>Attorney(s) for Appellee(s):</b>	Counsel's Name:	Address:	Telephone No.:	Fax No.:	E-mail:
<input checked="" type="checkbox"/> Plaintiff	Norman H. Zivin	Cooper & Dunham LLP	(212) 278-0400	(212) 391-0525	
Defendant	Robert T. Maldonado	30 Rockefeller Plaza		nzivin@cooperdunham.com	
		New York, N.Y. 10112		rmaldonado@cooperdunham.com	

Has Transcript Been Prepared?	Approx. Number of Transcript Pages:	Number of Exhibits Appended to Transcript:	Has this matter been before this Circuit previously? <input checked="" type="checkbox"/> Yes      No
Yes			If Yes, provide the following: Case Name: Patsy's Italian Restaurant, Inc. v. Banas 2d Cir. Docket No.: 08-4487; 08-4774      Reporter Citation: (i.e., F.3d or Fed. App.) 658 F.3d 254

**ADDENDUM "A": COUNSEL MUST ATTACH TO THIS FORM: (1) A BRIEF, BUT NOT PERFUNCTORY, DESCRIPTION OF THE NATURE OF THE ACTION; (2) THE RESULT BELOW; (3) A COPY OF THE NOTICE OF APPEAL AND A CURRENT COPY OF THE LOWER COURT DOCKET SHEET; AND (4) A COPY OF ALL RELEVANT OPINIONS/ORDERS FORMING THE BASIS FOR THIS APPEAL, INCLUDING TRANSCRIPTS OF ORDERS ISSUED FROM THE BENCH OR IN CHAMBERS.**

**ADDENDUM "B": COUNSEL MUST ATTACH TO THIS FORM A LIST OF THE ISSUES PROPOSED TO BE RAISED ON APPEAL, AS WELL AS THE APPLICABLE APPELLATE STANDARD OF REVIEW FOR EACH PROPOSED ISSUE.**

**PART A: JURISDICTION**

1. <u>Federal Jurisdiction</u>		2. <u>Appellate Jurisdiction</u>	
U.S. a party	Diversity	<input checked="" type="checkbox"/> Final Decision	Order Certified by District Judge (i.e., Fed. R. Civ. P. 54(b))
<input checked="" type="checkbox"/> Federal question (U.S. not a party)	Other (specify): _____	Interlocutory Decision Appealable As of Right	Other (specify): _____

**IMPORTANT. COMPLETE AND SIGN REVERSE SIDE OF THIS FORM.**

**PART B: DISTRICT COURT DISPOSITION (Check as many as apply)**

1. <u>Stage of Proceedings</u>	2. <u>Type of Judgment/Order Appealed</u>	3. <u>Relief</u>
<input type="checkbox"/> Pre-trial <input type="checkbox"/> During trial <input checked="" type="checkbox"/> After trial	<input type="checkbox"/> Default judgment <input type="checkbox"/> Dismissal/FRCP 12(b)(1) lack of subj. matter juris. <input type="checkbox"/> Dismissal/FRCP 12(b)(6) failure to state a claim <input type="checkbox"/> Dismissal/28 U.S.C. § 1915(e)(2) frivolous complaint <input type="checkbox"/> Dismissal/28 U.S.C. § 1915(e)(2) other dismissal	<input type="checkbox"/> Dismissal/other jurisdiction <input type="checkbox"/> Dismissal/merit <input checked="" type="checkbox"/> Judgment / Decision of the Court <input type="checkbox"/> Summary judgment <input type="checkbox"/> Declaratory judgment <input type="checkbox"/> Jury verdict <input type="checkbox"/> Judgment NOV <input type="checkbox"/> Directed verdict <input checked="" type="checkbox"/> Other (specify):
		Damages: <input type="checkbox"/> Injunctions: <input checked="" type="checkbox"/> Sought: \$ _____ Granted: \$ _____ Denied: \$ _____ Preliminary <input type="checkbox"/> Permanent <input checked="" type="checkbox"/> Denied <input type="checkbox"/>

**PART C: NATURE OF SUIT (Check as many as apply)**

1. <u>Federal Statutes</u>	2. <u>Torts</u>	3. <u>Contracts</u>	4. <u>Prisoner Petitions</u>
Antitrust Bankruptcy Banks/Banking Civil Rights Commerce, Energy Commodities Other (specify): _____	Communications Consumer Protection Copyright <input type="checkbox"/> Patent <input checked="" type="checkbox"/> Trademark Election Soc. Security Environmental	Freedom of Information Act Immigration Labor OSHA Securities Tax	Admiralty/ Maritime Assault / Defamation FELA Products Liability Other (Specify):
		Admiralty/ Maritime Arbitration Commercial Employment Insurance Negotiable Instruments Other Specify	Civil Rights Habeas Corpus Mandamus Parole Vacate Sentence Other
5. <u>Other</u> Forfeiture/Penalty Real Property <input type="checkbox"/> Treaty (specify): _____ <input type="checkbox"/> Other (specify): _____	6. <u>General</u> Arbitration Attorney Disqualification Class Action Counsel Fees Shareholder Derivative Transfer	7. Will appeal raise constitutional issue(s)? Yes <input type="checkbox"/> No <input checked="" type="checkbox"/> Will appeal raise a matter of first impression? Yes <input type="checkbox"/> No <input checked="" type="checkbox"/>	

1. Is any matter relative to this appeal still pending below? Yes, specify: \_\_\_\_\_  No

2. To your knowledge, is there any case presently pending or about to be brought before this Court or another court or administrative agency which:

(A) Arises from substantially the same case or controversy as this appeal?  Yes  No

(B) Involves an issue that is substantially similar or related to an issue in this appeal?  Yes  No

If yes, state whether "A," or "B," or  both are applicable, and provide in the spaces below the following information on the *other* action(s):

Case Name: Patsy's Brand, Inc. v. Brija	Docket No. 91221726	Citation:	Court or Agency: U.S. PTO Trademark Trial and Appeal Board
Name of Appellant: Patsy's Brand, Inc.			

Date: 02/24/2016	Signature of Counsel of Record: /s Paul Grandinetti/
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**NOTICE TO COUNSEL**

Once you have filed your Notice of Appeal with the District Court or the Tax Court, you have only 14 days in which to complete the following important steps:

1. Complete this Civil Appeal Pre-Argument Statement (Form C); serve it upon all parties, and file it with the Clerk of the Second Circuit in accordance with LR 25.1.
2. File the Court of Appeals Transcript Information/Civil Appeal Form (Form D) with the Clerk of the Second Circuit in accordance with LR 25.1.
3. Pay the \$505 docketing fee to the United States District Court or the \$500 docketing fee to the United States Tax Court unless you are authorized to prosecute the appeal without payment.

**PLEASE NOTE: IF YOU DO NOT COMPLY WITH THESE REQUIREMENTS WITHIN 14 DAYS, YOUR APPEAL WILL BE DISMISSED. SEE LOCAL RULE 12.1.**

**Patsy's Italian Restaurant v. Banas**  
**Form C. Addendum A**

1. Description of the Nature of the Action

In 2006 Patsy's Italian Restaurant, Inc., and Patsy's Brand, Inc. (collectively, the "Plaintiff" or the "Appellees") brought two related litigations in the United States District Court for the Eastern District of New York asserting trademark infringement and related causes of action against Anthony Banas and Anthony & Patsy's Inc. (collectively, the "Staten Island Defendants") and Anthony Banas, Allan Zyller, and Al & Anthony's Patsy's Inc. (collectively, the "Long Island Defendants"), for their use of the mark PATSY'S PIZZERIA. The Appellees' assertions were based on their alleged claim to the mark PATSY'S and other marks including the term PATSY'S. I.O.B. Realty, Inc., and Patsy's Inc. (collectively, the "Intervening Defendants" or the "Appellants"), intervened as the owners of the mark PATSY'S PIZZERIA.

A jury trial occurred from March 31, 2008, through April 10, 2008. On April 10, 2008, the jury returned its verdict. Among the findings in the jury's verdict was the determination that the Appellants had prior rights to the mark PATSY'S and PATSY'S PIZZERIA for pizzeria services but not restaurant services. On September 9, 2008, the District Court issued its Opinion and Order which included the cancellation of Appellees' U.S. Registration Nos. 3,009,836 and 3,009,866 for the marks PATSY'S PR (stylized) and PATSY'S, and a permanent injunction prohibiting the Parties from using the term PATSY'S as a trademark other than PATSY'S ITALIAN RESTAURANT for restaurant services for the Appellees, or PATSY'S PIZZERIA for pizzeria services for the Appellants. On September 10, 2008, the District Court issued its Final Judgment.

The Appellees appealed the District Court's decision to the United States Appellate Court for the Second Circuit and the Appellants brought a cross-appeal. The Second Circuit issued its opinion on August 24, 2011, affirming the District Court's ruling including the injunction on the Parties' use of PATSY'S.

Appellant I.O.B. Realty had owned a federal registration for the mark PATSY'S PIZZERIA for restaurant services. However, that registration was canceled in 2003 due to confusion and error resulting from an earlier litigation and Trademark Trial and Appeal Board cancellation proceeding between I.O.B. Realty, Inc., and the Appellee Patsy's Brand, Inc. While U.S. District Court Judge Irizzary had ordered at summary judgment on August 28, 2007, in the below proceeding that I.O.B. Realty's registration be reinstated, the Office of the Commissioner for

Trademarks with the United States Patent and Trademark Office stated that no action would be taken on the registration until the District Court's order became final. Then, as part of its Opinion and Order, the District Court ruled that the United States Patent and Trademark Office should not restore I.O.B. Realty's prior registration.

On October 25, 2005, I.O.B. Realty, Inc., filed a trademark application for PATSY'S PIZZERIA based on use with the United States Patent and Trademark Office. The application was refused registration due to an asserted likelihood of confusion with the U.S. Registration No. 3,090,551, for the mark PATSY'S OF NEW YORK for restaurant services. The PATSY'S OF NEW YORK registration is owned by Appellee Patsy's Brand, Inc. I.O.B. Realty, Inc., ultimately appealed the refusal to register to the Trademark Trial and Appeal Board.

In or about 2013 the Appellants became aware of multiple activities by the Appellees in violation of the District Court's injunction prohibiting their use of the mark PATSY'S unless it was for PATSY'S ITALIAN RESTAURANT. These activities included the Appellees' use of PATSY'S OF NEW YORK and its maintenance of the associated federal registration. The Appellants' efforts to resolve their concerns of contempt with the Appellees provide futile. On October 28, 2013, the Appellants requested permission from the District Court to bring a motion for contempt against the Appellees. The District Court granted the Appellants permission and subsequently granted the Appellees' later cross-motions for contempt and Rule 11 violation.

During the briefing the Appellees argued that the District Court only prohibited them from using the mark PATSY'S "alone" and that so long as anything else appeared with PATSY'S the use of the mark was permitted. On January 6, 2015, the District Court held a hearing on the Parties' competing motions. During this hearing the District Court made it clear that Appellees' argument was incorrect and that they could use the mark PATSY'S only if it was part of the mark PATSY'S ITALIAN RESTAURANT.

The District Court then referred the Parties' competing motions and various allegations of contempt activities to a Special Master. After meeting with the Parties on numerous occasions, the Special Master issued its Report and Recommendation. Prior to the issuance of the Special Master's Report and Recommendation the Parties provided written submission detailing their remaining concerns of contemptuous actions and other matters. The Appellants explained in

their written submission that the Appellees' registration for PATSY'S OF NEW YORK must be canceled since the Appellee was no longer permitted to use the mark in the registration and that a federal registration cannot be maintained if the mark is not being used.

2. The Results Below

On May 15, 2015, the Special Master issued his Report and Recommendation finding, among other things, that the PATSY'S OF NEW YORK registration should not be canceled because the PATSY'S OF NEW YORK mark was "beyond the scope of the present litigation" and the Appellants "have another available route to appeal [the refusal of its application] and/or to seek cancellation of the PATSY'S OF NEW YORK mark." The Special Master also stated he "acknowledges that usage is not necessarily a prerequisite to maintain a federal registration."

The Appellants requested a modification to the Report and Recommendation to require the cancellation of the PATSY'S OF NEW YORK registration, again stressing that use of a mark is required to maintain a federal registration and that the Appellee Patsy's Brand, Inc., was prohibited by the District Court's injunction from using the registered mark.

On January 12, 2016, the District Court adopted the Special Master's Report and Recommendation with one modification, removing the prohibition on surveillance.

On January 26, 2016, the District Court issued its Order denying the Appellants' Motion to Amend/Correct/Supplement the Special Master's Report and Recommendation.

3. Notice of Appeal and Docket Sheet

A copy of the Notice of Appeal filed February 10, 2016, and copies of the docket sheets in the Staten Island and Long Island cases are attached.

4. Relevant Opinions/Orders

Copies are attached.

**Patsy's Italian Restaurant v. Banas**  
**Form C. Addendum B**

**Issues Proposed to Be Raised on Appeal**  
**and Applicable Appellate Standards of Review**

1. Did the District Court err in adopting the Special Master's Report and Recommendation which stated that usage of a trademark is not necessarily a prerequisite to maintain a federal registration and suggested that a party can maintain a federal registration once it has been prohibited from using that mark?

Standard of review: de novo.

2. Did the District Court abuse its discretion in failing to order the cancellation of U.S. Registration No. 3,090,551 for the mark PATSY'S OF NEW YORK when the owner of the registration, Appellee Patsy's Brand, Inc., is prohibited from using the mark and has admitted it is not using the mark PATSY'S OF NEW YORK?

Standard of review: abuse of discretion

**IN THE UNITED STATES COURT OF APPEALS  
FOR THE SECOND CIRCUIT**

PATSY’S ITALIAN RESTAURANT, INC.,	)	
	)	
Plaintiff-Appellant,	)	
	)	
v.	)	<b>No. 16-405</b>
	)	
ANTHONY BANAS et al.,	)	
	)	
Defendants-Appellees.	)	
	)	
	)	
PATSY’S ITALIAN RESTAURANT, INC., and	)	
PATSY’S BRAND, INC.,	)	
	)	
Plaintiffs-Appellants,	)	
	)	
v.	)	
	)	
ANTHONY BANAS et al.,	)	
	)	
Defendants-Appellees.	)	
	)	

**PROOF OF SERVICE**

I certify that a true copy of the foregoing **CIVIL APPEAL PRE-  
ARGUMENT STATEMENT (FORM C)** was served this date by e-mail and  
February 25, 2016, by first class mail, postage pre-paid, on:

Mr. Norman H. Zivin  
Mr. Robert Thomas Maldonado

COOPER & DUNHAM LLP  
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Dated: February 24, 2016

/s/ Paul Grandinetti

Paul Grandinetti

Attorneys for Defendants-Appellants  
I.O.B. REALTY, INC., and  
PATSY'S INC.