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JJFM Corp. v Mannino's Bagel Bakery
2020 NY Slip Op 20246
Decided on September 22, 2020
Supreme Court, Suffolk County
Emerson, J.
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<p>JJFM Corporation, Oakdale Restaurant Corp., and 2158 Restaurant Corp., Plaintiffs,</p> <p>against</p> <p>Mannino's Bagel Bakery and RAGF Food Corp., Defendants.</p>
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ANTHONY P. GALLO, PC
Attorneys for Plaintiff
6080 Jericho Turnpike, Suite 216
Commack, New York 11725

LAW OFFICES OF VINCENT J. TRIMARCO, P.C.
Attorneys for Defendants
1038 W. Jericho Turnpike
Smithtown, New York 11787

Elizabeth H. Emerson, J.

Upon the following papers read on this motion to amend and cross-motions for summary judgment ; Notice of Motion and supporting papers 8-15 ; Notice of Cross Motion and supporting papers 16-21; 23-28 ; Answering Affidavits and supporting papers 29-31; 32; 34-35; Replying Affidavits and supporting papers 36; 37-38 ; it is,

ORDERED that the motion by the plaintiffs for leave to amend the complaint is denied as academic; and it is further

ORDERED that the cross motion by the defendants for summary judgment is granted; and it is further

ORDERED that the cross motion by the plaintiffs for summary judgment is denied.

The plaintiff corporations own and operate three Italian restaurant and catering businesses in Suffolk County, New York. They are: Mannino's Pizzeria Restaurant in Smithtown, Mannino's Restaurant & Lounge in Oakdale, and Mannino's Italian Kitchen & Lounge in Commack. The three corporations are owned by the Mannino brothers, who have been operating restaurants in Suffolk County since 1996. The logos for all three restaurants have been registered as service marks in New York State since 2016. Moreover, "Mannino's Italian Kitchen & Lounge" and "Mannino's Pizzeria Restaurant" have been registered with the U.S. Patent and Trademark Office since 2017 and 2018, respectively.

The defendant RAGF Food Corp. (RAGF) was formed in 2012 and operates Mannino's Bagel Bakery in Freeport, New York. RAGF is solely owned by Roberto Mannino, who is also its sole officer. In 2015, Roberto Mannino opened a second Mannino's Bagel Bakery in Smithtown, New York. He formed ARF Food Corp. (ARF) with his wife and son to own and operate the Smithtown location.

The plaintiffs commenced this action against RAGF and Mannino's Bagel Bakery in January 2017. The plaintiffs allege that by opening a second store in Smithtown, only a few miles from Mannino's Pizzeria Restaurant, the defendants are capitalizing on the Mannino brand and its good will. The plaintiffs allege that consumers are likely to

conclude that the defendants' products are made by, endorsed by, approved by, connected to, associated or affiliated with the plaintiffs' businesses. The complaint contains causes of action for a permanent injunction and to recover damages for unfair business practices under General Business Law § 349, unfair competition, and trademark infringement under General Business Law § 360-k. The plaintiffs move to amend the complaint to add AFR as a party defendant. The defendants and the plaintiffs both cross move for summary judgment.

The defendants contend in support of their cross motion that dismissal is required because the plaintiffs have not complied with General Business Law § 130 by filing assumed-business-name certificates for all of their businesses prior to commencing this action. The record reflects that the plaintiffs have now fully complied with General Business Law § 130. Accordingly, the court declines to dismiss the complaint on this ground.

Under New York State law, a mark owner may maintain a statutory or common-law action against a party who has engaged in unauthorized use of the mark (**Tiffany [NJ] Inc. v eBay, Inc.**, 576 F Supp 2d 463, 494 [SDNY], *affd in part, revd in part* 600 F3d 93 [2nd Cir]). [*2]The elements required to prevail on trademark-infringement and unfair-competition claims under New York law mirror the Lanham Act claims for trademark infringement and unfair competition (**Id.**). As with the Lanham Act, a plaintiff suing for trademark infringement under New York General Business Law § 360-k must prove that the defendant's use of the mark is likely to cause confusion, mistake, or deception (**Biosafe One, Inc. v Hawkes**, 639 F Supp 2d 358, 367 [SDNY], *affd* 379 Fed Appx 4 [2nd Cir]). The likelihood-of-confusion inquiry turns on whether numerous ordinarily prudent purchasers are likely to be misled or confused as to the source of the product in question because of the entrance in the marketplace of the defendant's mark (**Yurman Studio, Inc. v Castaneda**, 591 F Supp 2d 471, 487 [SDNY], *reconsideration granted in part, denied in part* 2008 WL 4298582). To support a finding of infringement, there must be a probability of confusion, not just a mere possibility (**Id.**).

A claim of trademark infringement is analyzed under a familiar two-prong test. The test looks, first, to whether the plaintiff's mark is entitled to protection and, second, to whether the defendant's use of the mark is likely to cause consumers confusion as to the origin or sponsorship of the defendant's goods (**Car Freshner Corp. v Am. Covers**,

LLC, 419 F Supp 3d 407, 421-422 [NDNY], *appeal filed* Aug. 30, 2019). The first prong of the test is satisfied since the plaintiffs have registered their three marks (*see, Lois Sportswear, U.S.A. v Levi Strauss & Co.*, 799 F2d 867, 871 [registered trademarks should be afforded the utmost protection]). The only issue, then, is the likelihood of confusion.

The likelihood of confusion is determined by a the multi-factor test set out in **Polaroid Corp. v Polarad Elecs. Corp.**(287 F2d 492, 495, [2nd Cir]). The factors include (1) the strength of the plaintiff's mark, (2) the similarity of the plaintiff's and the defendant's marks, (3) the proximity of the products, (4) the likelihood that the plaintiff will "bridge the gap," (5) actual confusion between products, (6) the defendant's good or bad faith in adopting the mark, (7) the quality of the defendant's product, and (8) the sophistication of the buyers (**Yurman, supra**). No single factor is dispositive (**Id.**).

Similarity of the Marks

When evaluating the similarity of the marks, courts consider the overall impression created by a mark (**Brennan's, Inc. v Brennan's Restaurant, L.L.C.**, 360 F3d 125, 133, [2nd Cir]). Each mark must be compared against the other as a whole. Juxtaposing fragments of each mark does not aid in deciding whether the compared marks are confusingly similar (**Id.**). The fact that the two marks appear similar is not dispositive. Rather, the question is whether such similarity is more likely than not to cause consumer confusion (**Id.**).

A comparison of the plaintiffs' marks with the defendants' sign [\[EN1\]](#) reveals no similarity [*3]beyond the common word "Maninno's." The plaintiffs' marks consist of (1) the word "Maninno's" in stylized form with the terms "Pizzeria Restaurant" in stylized form enclosed in a shaded polygon with a curved bottom, (2) the words "Maninno's Restaurant Lounge" in stylized lettering with "Maninno's" above "Restaurant Lounge" and a shaded square between the words "Restaurant" and "Lounge," and (3) the word "Maninno's" above "Italian Kitchen Lounge" and a shaded square between the words "Kitchen" and "Lounge." The defendants' sign also uses the word "Maninno's." However, the defendants do not use any of the other elements found in the plaintiffs' trademarks. They do not use the stylized lettering; the shaded polygon with a curved bottom; the shaded square; or the words "Italian," "Kitchen," "Pizzeria," "Restaurant," or "Lounge."

The only words the defendants use underneath "Mannino's" are "Bagel Bakery." Nonetheless, despite these differences in the parties' marks when they are compared as entire units, the consuming public may still be drawn or influenced by the most prominent word in the plaintiffs' marks, "Maninno's" (*see, Mother's Restaurants Inc. v Mother's Bakery, Inc.*, 498 F Supp 847, 853 [WDNY]). While the marks are not similar, the impression made by the use of the word "Maninno's" may still have some effect (*Id.*).

The Strength of the Plaintiff's Mark

In evaluating the strength of the mark, the inquiry focuses on the distinctiveness of the mark or, more precisely, its tendency to identify the goods as coming from a particular source (*Car Freshner, supra* at 423). There are two components of a mark's strength: its inherent distinctiveness and the distinctiveness it has acquired in the marketplace (*Brennan's, Inc., supra* at 130-131). Inherent distinctiveness examines a mark's theoretical potential to identify the plaintiff's goods or services without regard to whether it has actually done so (*Id.* at 131). Inherent distinctiveness is classified into four categories from the least to the most distinctive: (1) generic, (2) descriptive, (3) suggestive, and (4) arbitrary or fanciful (*Id.*; *Car Freshner Corp., supra*). Acquired distinctiveness looks solely to the recognition that the plaintiff's mark has earned in the marketplace as a designator of the plaintiff's goods or services (*Brennan's, Inc., supra* at 131).

Registered trademarks are presumed to be distinctive and should be afforded the utmost protection (*Lois Sportswear, supra*). However, in this case, the parties share a common last name. While the law recognizes the unfairness of letting one person trade on the reputation or name of another, it also recognizes that one's surname given at birth creates associations attached to that name which identify the individual (*Brennan's Inc., supra* at 131). Because the thrust of trademark law is to avoid confusion as to the product's source, it is not helpful to draw rigid rules when dealing with a common last name (*Id.*). It would be incorrect to insist that the defendant is always entitled to use his own name in business (*Id.*). It would be equally incorrect to insist that the defendant is never entitled to use his own name to compete with the same, and perhaps more famous, business name of the plaintiff (*Id.*). As a consequence, courts generally are hesitant to

afford strong protection to proper names, since to do so preempts others with the same name from trading on their own reputation (**Id.**). Thus, a proper name such as "Maninno's" is inherently weak and accorded only minimal protection as a descriptive mark unless it has [*4]acquired a secondary meaning (**Id.** at 131-132).

A mark that is not inherently distinctive may acquire distinctiveness by developing a secondary meaning in the public's mind (**Christian Louboutin S.A. v Yves Saint Laurent Am. Holdings, Inc.**, 696 F3d 206, 216 [2nd Cir], *mod denied* 709 F3d 140). A mark has acquired a secondary meaning when, in the minds of the public, the primary significance of a product feature is to identify the source of the product rather than the product itself (**Id.**). When there is widespread recognition of a mark among consumers, there is an increased likelihood that consumers will assume it identifies the previously familiar user and, therefore, an increased likelihood of consumer confusion if the new user is, in fact, not related to the first (**Car Freshner Corp.**, *supra* at 423). Some last names achieve such a degree of secondary meaning that they become strong identifiers of source, such as "Bacardi" for rum, "Ford" for automobiles, and "Smucker" for jam (**Brennan, Inc.**, *supra* at 132).

A party seeking to establish a secondary meaning must meet vigorous evidentiary requirements and show that the mark acquired the secondary meaning by the time the allegedly infringing mark came onto the market (**Lopez v Gap, Inc.**, 883 F Supp 2d 400, 425 [SDNY]). Courts consider six factors in determining whether a mark has established a secondary meaning: (1) advertising expenditures, (2) consumer studies linking the mark to a source, (3) unsolicited media coverage of the product, (4) sales success, (5) attempts to plagiarize the mark, and (6) the length and exclusivity of the mark's use. (**Id.**). Although the Second Circuit has stated that courts should be cautious in weighing these factors at the summary judgment stage, it has nonetheless supported summary judgment in cases where the proponent of the alleged trademark failed to produce any evidence or failed to raise a material issue of fact on the question of secondary meaning (**Jewish Sephardic Yellow Pages, Ltd. v DAG Media, Inc.**, 478 F Supp 2d 340, 344-345 [EDNY] [and cases cited therein]).

Here, the plaintiffs contend that the Maninnos have been operating restaurants in Suffolk County using their own name since 1996, that they have expended significant resources to promote their restaurants, and that their brand has become well-known among

consumers for high-quality Italian food and outstanding service. In support thereof, the plaintiffs submit the affidavit of Francesco Mannino. The court finds that the generalized assertions found therein are insufficient to establish that the name "Mannino" has acquired a secondary meaning.

Finally, the more common a last name is, the lower the likelihood that a competitor will effectively appropriate the goodwill of the senior user since customers will be unlikely to assume that the two brands with the same name refer to the same goods (**Brennan's, Inc.**, *supra* at 132). The record reflects that "Mannino" is a relatively common Sicilian family name and that 16 other corporations and LLC's, including a few that sell Italian food, are registered with that name in New York State.

In view of the foregoing, the court finds that the plaintiffs' marks are weak and that they are entitled to only minimal protection.

[*5] Proximity

In terms of the products' proximity, courts consider whether the products compete with each other (**Car Freshner Corp.**, *supra* at 441). Just because products share the same channel of trade does not necessarily make them proximate (**Id.**).

The record reflects that, although the parties are both in the restaurant and catering business, their businesses are vastly different. The plaintiffs' restaurants serve high-quality Italian food in elegant settings. The defendants sell bagels and delicatessen items such as pastries, muffins, hamburgers, salads, sandwiches (including Italian heros), paninis, and wraps. They also sell baked ziti and chicken parmesan on their catering menu. They do not sell any other Italian foods. The court finds that, under these circumstances, the defendants' products do not compete with the plaintiffs products.

"Bridging the Gap"

This factor examines the likelihood that the plaintiffs will enter the defendants' market in the future (**Hypnotic Hats, Ltd. v Wintermantel Enter., LLC**, 335 F Supp 3d

566, 590 [SDNY]). A plaintiff's intention to "bridge the gap" helps to establish a future likelihood of confusion as to source (**Id.**). There is no evidence in the record the plaintiffs intend to enter either the bagel or the delicatessen business.

Actual Confusion

The plaintiffs point to only one instance in which they claim actual confusion existed. On one occasion, a check from Smithtown High School for services provided by ARF was sent to the plaintiff JJFM Corporation. One incident of actual confusion is insufficient to conclude that actual confusion exists in any widespread way (**Car Freshner Corp.**, *supra* at 442).

In addition, Roberto Mannino testified that, when he first opened in Smithtown, some people asked him if he was affiliated with the plaintiffs, and he replied, "No." Inquiries about the source of goods is not necessarily evidence of actual confusion (**Id.**[and cases cited therein]; *but see*, **Virgin Enters. Ltd. v Nawab**, 335 F3d 141, 151 [2nd Cir]). Moreover, the plaintiffs do not point to any evidence indicating that the actual purchase of the defendants' products was driven by the mistaken impression that they came from the plaintiffs (**Car Freshner Corp.**, *supra*). Accordingly, the court finds that the evidence of actual confusion is de minimis.

Bad Faith

Contrary to the plaintiffs' contentions, the record does not reflect that Roberto Mannino opened a bagel bakery in Smithtown in order to capitalize on the Mannino brothers' reputation. Roberto Mannino testified that he and his family have been living in Smithtown for 20 years and that, when they were looking to open a second store, they chose to open it in Smithtown because [*6]they live there. Moreover, as previously noted, when asked if he was affiliated with the plaintiffs, he answered in the negative.

Quality of the Product

Generally, quality is weighed as a factor when there is an allegation that a low quality product is taking unfair advantage of the public goodwill earned by a well-established high-quality product (**Id.** at 443). While the plaintiffs allege that the defendants are taking advantage of their reputation as purveyors of high-quality Italian food, the record reflects that, except for a few menu items, the defendants do not sell Italian food. They sell bagels and deli food. The court finds that, under these circumstances, the relative quality of the products does not play a significant role in the existence of a likelihood of confusion between the parties' products (**Id.** at 444).

Sophistication of the Buyers

The parties have not provided any particular information on the sophistication of their typical buyers. However, the court may consider the type of product and its cost in assessing the role that the buyers' sophistication plays in the likelihood of consumer confusion (**Id.**). The court finds that, in view of the differences between the type and cost of the parties' products, it is unlikely that even an unsophisticated buyer would be confused as to the source of the defendants' products.

Conclusion

On balance, the **Polaroid** factors favor the defendants. The court finds that, the defendants' use of the parties' common surname coupled with the de minimis evidence of actual confusion is insufficient for a reasonable trier of fact to conclude that numerous ordinarily prudent purchasers are likely to be misled or confused as to the source of the defendants' products (**Yurman, supra** at 487). Accordingly, the court grants summary judgment to the defendants dismissing the fourth cause of action for trademark infringement.

The law of trademark infringement is part of the law of unfair competition, and the same test is applied in determining each claim (**Car Freshner Corp., supra** at 449). Accordingly, the court also grants summary judgment to the defendants dismissing the second cause of action for unfair competition.

Corporate competitors may bring a claim under General Business Law §349 as long as some harm to the public at large is at issue, such as potential dangers to public health or safety (**DO Denim, LLC v Fried Denim, Inc.**, 634 F Supp 2d 403, 408-409). The record does not reflect that the defendants' use of the name "Maninno" poses a risk of that sort of injury to the public at large. Accordingly, the court grants summary judgment to the defendants dismissing the first cause of action for unfair business practices under General Business Law §349.

In the absence of a cognizable claim, the court grants summary judgment to the defendants dismissing the third cause of action for injunctive relief.

In view of the foregoing, the plaintiffs' motion for leave to amend the complaint is denied as academic. The plaintiffs' cross motion for summary judgment is also denied.

Dated: September 22, 2020

Footnotes

Footnote 1: The defendants' do not have a registered trade or service mark. The plaintiffs submit a photograph of the sign on the facade outside the Smithtown bagel bakery.

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