

Sandwich Lawsuit Outlines Main Ingredients of Trademark Infringement

by Robert Levy on August 1, 2012

The Heart Attack Grill in Las Vegas is sparring with New York City's Second Ave. Deli over the rights to a very unhealthy sandwich. The Heart Attack Grill has alleged that the Second Ave. Deli's Instant Heart Attack Sandwich and Triple Bypass Sandwich violate its registered trademarks.

The New York trademark litigation began when the Heart Attack Grill sent a cease and desist letter demanding that the New York City deli stop selling the sandwiches. The restaurant holds marks for its name as well as its Single, Triple, and Quadruple Bypass Burger.

In response, the Second Ave. Deli filed a declaratory judgment action. The deli sought a ruling that neither of its two pending marks for its own Instant Heart Attack Sandwich and Triple Bypass Sandwich infringed any of the Heart Attack Grill's marks and, therefore, the deli should be able to register those marks.

Aside from the not so subtle bashes on the health value of either sandwich, the court's opinion clearly outlines the factors to be considered in evaluating a claim of trademark infringement. As in many cases, the court focused on whether there was a likelihood of confusion between the trademark and the offending product; in this case, the Deli's Instant Heart Attack Sandwich mark and HAG's Heart Attack Grill.

The court specifically addressed the following eight factors, as set forth in *Polaroid Corp. v. Polarad Elecs. Corp.*:

- The strength of the trademark;
- The similarity of the marks;
- The proximity of the products and their competitiveness with one another;
- The evidence that the senior user may "bridge the gap" by developing a product for sale in the market of the alleged infringer's product;
- The evidence of actual consumer confusion;
- The evidence that the imitative mark was adopted in bad faith;
- The respective quality of the products; and
- The sophistication of consumers in the relevant market.

The federal court ultimately concluded that there was no likelihood of confusion. While the court acknowledged that the Heart Attack Grill had a strong mark and that similarities did exist between the marks, these factors were outweighed by other factors that pointed against customer confusion.

As highlighted by the court, “It is safe to say that even an unsophisticated customer could readily differentiate between a Manhattan kosher deli and its latke-based sandwich and a Las Vegas ‘medically themed’ restaurant that features gluttonous cheeseburgers.”