

CHARLES N. INTERNICOLA, ESQ.

CASE LITIGATION REPORT



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*** RE: SUCCESSFUL OPPOSITION TO INJUNCTION MOTION WHERE CLAIMED TRADEMARK WAS FOUND TO BE DESCRIPTIVE.**

In the State of New York and New Jersey trademarks are subject to common law protection. Additional protections are afforded under the New York State Anti-Dilution Statute.

In a litigated matter where a plaintiff corporation sued the defendant competitor for trademark infringement and violation of the New York Anti-Dilution Statute Mr. Internicola successfully obtained the dismissal of the lawsuit. Representing the defendant, Mr. Internicola successfully demonstrated that the claimed trademark was “descriptive” and “lacked secondary meaning”. A copy of Mr. Internicola, Esq’s Memorandum of Law is attached.

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SUPREME COURT OF THE STATE OF NEW YORK
COUNTY OF RICHMOND

RAPID SEWER & SEPTIC TANK CLEANERS, INC.

Plaintiff,

-against-

Index No.: 14141/01

ANGELO CHIAPPERINO d/b/a RAPID ROOTER
SEWER & DRAIN CLEANING,

Defendant.

**MEMORANDUM OF LAW IN OPPOSITION TO PLAINTIFF'S
MOTION FOR A PRELIMINARY INJUNCTION**

PRELIMINARY STATEMENT

This memorandum of law is submitted on behalf of Defendant Angelo Chiapperino, Jr. d/b/a Rapid Rooter Sewer & Drain Cleaning in opposition to plaintiff's motion for a preliminary injunction and in support of defendant's cross-motion for summary judgment. In the instant action plaintiff seeks a preliminary injunction enjoining defendant from (i) using the word "rapid" in defendant's business name and (ii) using the word "rapid" to describe defendant's services.

As will be demonstrated at length herein, it is respectfully submitted that, as a matter of law, the plaintiff's alleged use of the word "rapid" in its business operations (i.e. "Rapid Sewer Cleaners") constitutes nothing more than a descriptive use for which the plaintiff cannot claim a protectable right or trademark interest. To permit otherwise, would be tantamount to removing the word "rapid" from commercial usage and granting plaintiff a monopoly to its exclusive use and license.

STATEMENT OF FACTS

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The relevant factual history is set forth in the accompanying Affidavit of Angelo Chapperino, Jr. sworn to on the 14th day of January, 2002 (the “Defendant’s Aff.”) and will not be restated herein.

ARGUMENT

A preliminary injunction is a “drastic remedy” appropriate only where the moving party demonstrates a likelihood of success on the merits, irreparable harm and a balance of the equities in its favor. *In re Non-Emergency Transporters of NY*, 249 A.D.2d 124, 127, 672 N.Y.S.2d 16, 19 (1st Dept. 1998); *Camarado v. Board of Education*, 50 A.D.2d 1073, 376 N.Y.S.2d 344, 346 (4th Dept. 1975)(“The grant of a preliminary injunction is a drastic remedy to be used sparingly... the plaintiff must establish that the right to the ultimate relief requested is not in doubt”).

To state a claim for trademark infringement or unfair competition under The New York Anti-Dilution Statute (NY General Business Law §360-1) a plaintiff must demonstrate that (i) it possesses a “strong” trade mark or trade name and (ii) there is a likelihood of dilution. *Allied Maintenance Corp. v. Allied Mechanical Trades, Inc.*, 42 N.Y.2d 538, 545 (1977). A strong mark is one which is either (a) distinctive or (b) has acquired secondary meaning. *Id.* at 545-546 (“...only those trade names which are of truly distinctive quality or which have acquired secondary meaning in the mind of the public should be entitled to protection under the anti-dilution statute”). Descriptive marks, by definition, are not distinctive and require a showing of secondary meaning. *Id.* at 545-546.

Moreover, it is of no legal consequence that the disputed mark is utilized in a corporate name granted upon incorporation by the New York Secretary of State. *See, Christian Dior, Cleaners, Inc. v. Miss Dior of Flatbush, Inc.*, 173 USPQ 416 (EDNY 1972).

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**PLAINTIFF CANNOT STATE A CLAIM FOR UNFAIR COMPETITION
OR TRADEMARK INFRINGEMENT UNDER THE ANTI-DILUTION
STATUTE BECAUSE THE WORD “RAPID” IS DESCRIPTIVE AND
CANNOT ACQUIRE SECONDARY MEANING**

Under the New York Anti-Dilution Statute the law is settled that a claim for relief does not exist where the alleged mark is descriptive and lacks secondary meaning. *Allied Maintenance Corp.*, 42 N.Y.2d 538, 544-546. In such instance an application for injunctive relief must be denied irrespective of any similarity between the disputed marks or allegations of possible consumer confusion. *Allied Maintenance Corp.*, 42 N.Y.2d at 544-546.

In *Allied Maintenance Corp.*, a decision directly on point to the case *sub judice*, the Court of Appeals held that the term “Allied” and the plaintiff’s trade name “Allied Maintenance” was descriptive, lacked secondary meaning and therefore afforded the plaintiff no rights, whatsoever, against the defendants use of the competing trade name “Allied Mechanical”. In doing so the Court of Appeals affirmed the denial of injunctive relief and held:

It is quite apparent that the name “allied” is a weak trade name. Rather than being distinctive, arbitrary, fanciful or coined, it is, in essence, generic or *descriptive*. Although the name “Allied” bespeaks of more originality than “maintenance”, it is never the less a common word in English usage today. There is nothing in the name “Allied Maintenance” itself which indicates that it is an inherently strong trade name susceptible to dilution. Nor can it be said that the name Allied Maintenance has acquired secondary meaning. To establish secondary meaning it must be shown through *exclusive use and advertising by one entity a name has become so associated in the mind of the public with that entity or its product that it identifies the goods sold by that entity and distinguishes them from goods sold by others...* In light of the large number of businesses using the generic term allied in their trade name, it cannot be said that the name “allied” has acquired a secondary meaning. We remain unconvinced that the public associates the word “allied” with the plaintiff’s cleaning and maintenance services.

Allied Maintenance Corp., 42 N.Y.2d at 545-546 (emphasis added). Due to the descriptive

nature of the plaintiff’s mark, it was of no consequence to the Court of Appeals that the plaintiff **Charles N. Internicola, Esq.** is a Business and Franchise Litigation Lawyer. Licensed in the States of New York and New Jersey, Mr. Internicola represents entrepreneurs and non-public corporations in commercial litigation matters. For more information about Mr. Internicola, visit www.BusinessandFranchiseLaw.com or call (800) 976.4904. * Prior Results do not guarantee a similar outcome

had utilized the “Allied” trade name more than eighty (80) years prior to even the defendant’s existence and corporate formation. *Id.* at 541.

In *Dell Publishing Co. v. Stanley Publications, Inc.*, 9 N.Y.2d 126 (1961), the Court of Appeals held that the term “Modern” and the plaintiff’s trade name “Modern Romances” was descriptive and lacked secondary meaning. Accordingly, the Court of Appeals affirmed the Appellate Division’s reversal of the trial court’s decision that initially enjoined the defendant from publishing a competing magazine titled “Modern Confessions”. In evaluating the competing mark’s the court noted:

While “confessions” and “romances” convey much the same meaning, “this is necessarily so because both are descriptive of the articles to which they are applied”

* * * *

For example, in the *Collegiate World* case (14 F.2d 158, 160) in denying an injunction against the use of a similar descriptive title (i.e., “College Humor” – “College Comics”), the court noted that: “Similarity in names of [products] dealing with the same subject is not unusual, but on the contrary is quite common, such as Popular Science, Popular Mechanics; Outdoor Life, Outdoor Recreation; Field and Stream, Forest and Stream; Boy’s Life, Boy’s Magazine...

Dell Publishing Co., 9 N.Y.2d. 126, 137-138 (Quoting, *Collegiate World Pub. Co. v. Du Pont Pub. Co.*, 14 F.2d 158, 160).

In *Dell Publishing Co.*, due to the descriptive nature of the plaintiff’s trade name (“Modern Romances”) the Court of Appeals held the following factors to be irrelevant to its analysis of the plaintiff’s dilution claim: (i) the plaintiff’s “Modern Romance” trade name was registered with the United States Patent and Trademark Office; (ii) the plaintiff’s “Modern Romance” publications exceeded over one million copies per month generating annual revenue in excess of \$800,000.00; (iii) the plaintiff spent in excess of \$1,140,000.00 advertising and promoting its “Modern Romance” publications; (iv) the plaintiff and defendant were

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competitors; and (v) the defendant was aware of the plaintiff's "Modern Romance" publication prior to introducing its competing publication using the similar "Modern Confessions" trade name. *See, Dell Publishing Co.*, 9 N.Y.2d at 129.

In *Sir Speedy, Inc. v. Speedy Printing Centers, Inc.*, 746 F.2d 1479 (6th Cir. 1984) a trademark dispute involving the competing trade names of "Sir Speedy" and "Speedy Printing", the court held that the term "speedy" was descriptive and that the plaintiff failed to meet the threshold burden of establishing secondary meaning, *viz.*, that the public associates the word "speedy" solely with the plaintiff's business and services. *Id.* at 1479 ("The burden to establish secondary meaning is greater when the mark suggests the basic nature of the services to be rendered... [t]he truth of the matter is, however, that both the plaintiff and the defendant and a host of their competing national franchisers are offering, for all practical purposes, to the consuming public the same service. And this is a service which is identified in the minds of the public with the name "speedy", "quick" or instant printing).

As demonstrated in the Defendant's Aff. the term "Rapid" like "Allied", "Modern" and "Speedy", constitutes nothing more than a descriptive term used to describe the emergency radio dispatched drain cleaning services offered by the plaintiff and hundreds of other competitors. See Defendant's Aff. ¶¶ 16-22. Additionally, the word "rapid" is used to describe hundreds of other businesses and services ranging from ambulances to tax preparation centers. See Defendant's Aff. ¶¶ 16-22. Accordingly, it is respectfully submitted that as a matter of law the plaintiff cannot demonstrate that it has acquired secondary meaning in the word "rapid" – to do so the plaintiff would be required to demonstrate that the public associates the word "Rapid" exclusively with the plaintiffs drain cleaning services. It is respectfully submitted that the plaintiff has not and cannot meet this burden.

CONCLUSION

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Based upon the foregoing, and all of the accompanying submissions, the defendant respectfully requests that plaintiff's instant application for injunctive relief be denied in all respects.

Respectfully Submitted,

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