

UNITED STATES DISTRICT COURT  
FOR THE SOUTHERN DISTRICT OF NEW YORK

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LATTANZIO & DE RUVO CORP. d/b/a )  
PANZEROTTI BITES OF BROOKLYN, )  
) )  
Plaintiff, )  
) )  
v. )  
) )  
I LOVE PANZEROTTI NY, LLC, )  
ANGELO MAGNI, )  
MICHELE CEA, )  
) )  
Defendants. )  


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Case 1:20-cv-02080-AKH

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DEFENDANT, MICHELE CEA’S MEMORANDUM OF LAW  
IN SUPPORT TO HIS MOTION TO DISMISS

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## INTRODUCTION

Defendant, Michele Cea, Esquire (hereinafter “Cea”), by and through the undersigned attorney, hereby moves to dismiss Plaintiff’s complaint under Fed. R. Civ. P. 12(b)(1), (b)(3), and (b)(6).

Preliminarily, it is noted that the Complaint does not allege a proper basis of venue, since Cea is not a resident of New York.

In September 2019, Plaintiff, Panzerotti Bites of Brooklyn, asked ILP to make certain modifications to its mark, signage, store decorations, and serving boards, in order to avoid customer confusion. After several negotiations, Plaintiff’s counsel drafted and proposed terms for a settlement in an email. ILP accepted and timely performed all the terms and conditions. A settlement agreement with the same terms was drafted by Plaintiff’s counsel but never signed. In its agreement, Plaintiff agreed to “refrain from taking any further legal action” against ILP.

Ironically, Plaintiff’s Amended Complaint now seeks to enforce many of the same terms and conditions which Plaintiff expressly acknowledged as having already been performed pursuant to the agreement. Plaintiff’s Amended Complaint attempts to mislead the Court by posting pictures of ILP’s old mark and signage which Plaintiff is aware was changed in October of 2019. Plaintiff never mentions the settlement in its Complaint or Amended Complaint, but instead waits until page 17, paragraphs 62-64, to concede the fact that ILP *already* changed its mark and signage. ILP’s new Mark, as

displayed on page 17, looks nothing like Plaintiff's marks. ILP fully performed the settlement agreement.

The bulk of Plaintiff's Amended Complaint is moot—the remainder is frivolous. Plaintiff seeks protection for items that the USPTO already ruled were not protectable. Plaintiff first sought registration of its "Flag Mark" displayed in Paragraph 9 of its Amended Complaint. But Plaintiff's registration of the Flag Mark was rejected by the USPTO because of its use of the Italian Flag, and as such, it is not entitled to any protection as a matter of law.

After its Flag Mark was rejected, Plaintiff revised the Mark as is shown in Paragraph 8 of the Amended Complaint. However, the USPTO required Plaintiff to disclaim the unregistrable parts of the Mark including the wording: (1) "PANZEROTTI BITES"; (2) "ORIGINAL APULIAN FOOD"; and (3) "BROOKLYN." The USPTO explicitly ruled that "PANZEROTTI BITES" was not inherently distinctive and at best was descriptive. Basically, only the design elements of Plaintiff's registered Mark are possibly protectable. And ILP changed its Mark prior to Plaintiff's Mark becoming registered, and looks nothing like Plaintiff's registered Mark.

Plaintiff leaves out the above salient facts, in an attempt to mislead this Court into granting protection for something the USPTO already told them was not protectable.

Additionally, Plaintiff now asks for trade dress protection of its restaurant's "open kitchen" layout with white tiles and the use of wooden serving boards—design elements which are basic and commonplace. If Plaintiff was to succeed on its trade dress claim, they could potentially sue thousands of restaurants in New York City for a common look that was used years before Plaintiff opened its restaurant in 2018.

Cea respectfully submits that the Settlement Agreement is legally binding; and even assuming *arguendo*, that it is not, Plaintiff's Complaint is moot, frivolous, and should be dismissed.

Finally, the cause of action for breach of fiduciary duty cannot survive a motion to dismiss because, as explained *infra*, it fails to allege the existence of a fiduciary relationship with Plaintiff and it fails to allege enough plausible facts to suggest that Cea misappropriated and divulged Plaintiff's *confidential* information.

**I. THE COMPLAINT SHOULD BE DISMISSED FOR LACK OF VENUE**

Plaintiff's Complaint alleges that "[V]enue is proper in this judicial district pursuant to 28 U.S.C. 1391(b)(1) and/or (b)(2) because Panzerotti Bites is located in this judicial district and/or a substantial part of the events and omissions giving rise to the Plaintiff's claims occurred in this judicial district. See **Pl. Am. Compl.** ¶ 21.

First, Cea is *not* a resident of New York. See **Declaration of Michele Cea** herein attached as **Exhibit H**. Thus, under 28 U.S.C. 1391(b)(1) this District is not a proper venue as to Defendant Cea.

Second, Plaintiff's Complaint alleges that Cea, *as an officer* of Defendant I Love Panzerotti (hereinafter "ILP"), directly participated in creating ILP's Infringing Marks, Infringing Trade Dress, business plan and decor. See, e.g., Pl. Am. Compl. ¶ 37.

Under 28 U.S.C. 1391(b)(2), venue in this District would be proper as to Cea in his capacity or corporate officer. However, Cea has been sued personally, and the Complaint does not allege any fact to suggest a pierce of the corporate veil.

The authorities are clear that entry into the forum state by a nonresident corporate officer, for corporate business purposes, will justify jurisdiction only over the corporation. The corporate officer is not amenable to suit in his personal capacity, but is entitled to the benefit of the so-called fiduciary shield doctrine. The leading case in this area holds:

It is well established that a corporate officer acting on corporate business does not thereby become amenable to suit in his or her personal capacity in that jurisdiction. The corporate veil is not thrust aside so readily.

*Luis Marx & Co. v. Fuji Seiko Co.*, 453 F. Supp. 385, 389 (S.D.N.Y. 1978) (granting officer's motion to dismiss for lack of personal jurisdiction). *Accord Trafalgar Capital Corp. v. Oil Producers Equipment Corp.*, 555 F. Supp. 305, 310 (S.D.N.Y. 1983); *See also, Lehigh Valley Indus. Inc. v. Birenbaum*, 527 F.2d 87, 92 (2d Cir. 1975) (dictum; affirming dismissal on other grounds, but indicating that if defendant acted in his corporate capacity "there [would be] no basis to find personal jurisdiction")<sup>1</sup>.

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<sup>1</sup> *SHOPPING MALL Inv'rs v. E.G. FRANCES & CO.*, No. 84 Civ. 1469 (JFK), 1985 U.S. Dist. LEXIS 23199, at \*22-23 (S.D.N.Y. Jan. 23, 1985).

In sum, the Complaint does not allege any valid basis of venue as to Defendant Cea, and it should be dismissed under F.R.C.P. § 12(b)(3).

## **II. THE COMPLAINT SHOULD BE DISMISSED FOR LACK OF SUBJECT-MATTER JURISDICTION**

Plaintiff's Complaint should be dismissed because the issues presented are no longer "live," and Plaintiff lacks a legally cognizable interest in the outcome.

The correspondence exchanges by the parties' former attorneys amount to a binding contract. And even if no binding contract was formed, the conduct complained by Plaintiff was abandoned by ILP roughly 6 months ago.

### **A. The unexecuted agreement between the parties is an enforceable contract.**

Under New York law, parties are free to enter into a binding contract without memorializing their agreement in a fully executed document. This freedom to contract orally remains even if the parties contemplate a writing to evidence their agreement. In such a case, the mere intention to commit the agreement to writing will not prevent contract formation prior to execution.<sup>2</sup>

In any given case it is the intent of the parties that will determine the time of contract formation. To discern that intent a court must look to the words and deeds of

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<sup>2</sup> *Winston v. Mediafare Entm't Corp.*, 777 F.2d 78, 80-81 (2d Cir. 1985) (quoting *R. G. Group, Inc. v. Horn & Hardart Co.*, 751 F.2d 69, 74 (2d Cir. 1984); *Municipal Consultants and Publishers, Inc. v. Town of Ramapo*, 47 N.Y.2d 144, 149, 417 N.Y.S.2d 218, 220, 390 N.E.2d 1143, 1145 (1979); *V'Soske v. Barwick*, 404 F.2d 495, 499 (2d Cir. 1968), cert. denied, 394 U.S. 921, 89 S. Ct. 1197, 22 L. Ed. 2d 454 (1969).

the parties which constitute objective signs in a given set of circumstances. The court uses the test set forth in *Winston v. Mediafare Entm't Corp.*, 777 F.2d 78, 80 (2d Cir. 1985) to consider:

1. whether there has been an express reservation of the right not to be bound in the absence of a writing;
2. whether there has been partial performance of the contract;
3. whether all of the terms of the alleged contract have been agreed upon; and
4. whether the agreement at issue is the type of contract that is usually committed to writing.<sup>3</sup>

Here, Plaintiff's former counsel, Ellen Simpson, Esquire made no initial reservation of the right not to be bound in the absence of a writing. In her letter dated September 17, 2019, herein enclosed as **Exhibit A**, Ms. Simpson wrote:

We appreciate that I Love Panzerotti is willing to settle the matter on the following terms:

1. Your client agrees to change the font of all of the words I LOVE PANZEROTTI in its trademark to one that is dissimilar to the font of our client's trademark;
2. Your client agrees to remove the promotional photos of the wooden cutting boards from its website, any social media, and anywhere else such photos appear;
3. Your client agrees to remove any wooden cutting boards from its restaurant, decorative or otherwise.

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<sup>3</sup> *Id.* at 80. See also Restatement (Second) of Contracts § 27 comment c (1981).

We understand that your client has requested a period of ninety (90) days to comply with the terms of settlement, which is agreeable to our client.

However, in our letter of August 27, 2019, we also requested the following term in order to settle the matter:

4. Your client agrees to change the color scheme of its mark to eliminate the black with yellow/gold shading used in association with the words I LOVE PANZEROTTI of the trademark.

Please confirm that this fourth term is a part of this proposed settlement. Assuming that the settlement will encompass all four of these terms, and that such changes will be made within ninety (90) days, our client is willing to settle this matter. We will forward a draft settlement agreement with these terms for your review.

Promptly thereafter, ILP agreed to the terms and fully performed all its obligations. See **Declaration of Angelo Magni** herein enclosed as **Exhibit G**.

Later, on October 15, 2019—after ILP's performance—Ms. Simpson wrote in an email: "Absent a settlement agreement, there is no actual agreement." A true and accurate copy of that email is herein enclosed as **Exhibit B**.

In that same October 15 email, Ms. Simpson wrote:

"While we understand that your client has taken steps to alleviate the confusion that has existed between our client's mark and your client's mark and the related trade dress, I do not understand your client's unwillingness to memorialize the verbal affirmations in a written settlement agreement, which, as your know, is the usual next step after two parties have agreed on terms."

See **Exhibit B**.

By her own words, Plaintiff's counsel was merely requesting the execution of the Settlement Agreement to "memorialize" "agreed on terms" which counsel acknowledged had already been performed by ILP. The terms of proposed Settlement Agreement, herein enclosed as **Exhibit C**, mirror those of the letter sent by email on September 17, 2019.

In *Hostcentric Techs., Inc. v. Republic Thunderbolt, LLC*, 2005 U.S. Dist. LEXIS 11130, (S.D.N.Y. June 9, 2005), the Court opined that an emailed offer and acceptance between attorneys formed a valid and binding contract:

As then-District (now Circuit) Judge Leval stated almost twenty years ago (and the Second Circuit later adopted), a "preliminary" agreement is binding, despite the desire for a later formal document, "when the parties have reached complete agreement (including the agreement to be bound) on all the issues perceived to require negotiation.

*Such an agreement is preliminary only in form - only in the sense that the parties desire a more elaborate formalization of the agreement. The second stage is not necessary; it is merely considered desirable."*<sup>4</sup> (*emphasis added*)

While it may have been desirable for Plaintiff to memorialize and sign the agreed upon terms, their intent to be bound, along with ILP's full performance of those terms,

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<sup>4</sup> *Id.* At 17-18 (quoting *Teachers Ins. & Annuity Ass'n v. Tribune Co.*, 670 F. Supp. 491, 498 (S.D.N.Y. 1987) (Leval, D.J.); accord, e.g., *Krauth v. Executive Telecard, Ltd.*, 890 F. Supp. 269, 293 (S.D.N.Y. 1995) (quoting Judge Leval's *Teachers* decision); *Weinreich v. Sandhaus*, 850 F. Supp. 1169, 1176-77 (S.D.N.Y. 1994) (same).

created a valid and enforceable contract even if that settlement agreement has never been signed. The application of the *Mediafare* test in our case leads to the conclusion that the parties had settled their dispute long before this Complaint was filed.

**B. Plaintiff's Complaint and Amended Complaint are moot.**

The U.S. Supreme Court opined that “[A] case becomes moot—and therefore no longer a ‘Case’ or ‘Controversy’ for purposes of Article III—‘when the issues presented are no longer live or the parties lack a legally cognizable interest in the outcome.’”<sup>5</sup>

Where there is no unresolved case or controversy, mootness occurs and the court loses jurisdiction over the suit, which therefore must be dismissed.<sup>6</sup>

Dismissal under Rule 12(b)(1) is therefore proper when a case becomes moot.<sup>7</sup>

Here, as set forth at length in Section A above, and in the Declaration of Angelo Magni, the Complaint and Amended Complaint are moot because ILP already complied with all the requests made by Plaintiff through their former attorney.

Most notably, ILP changed its Mark prior to Plaintiff's Mark becoming registered. And ILP's new Mark looks nothing like either of Plaintiff's Marks.

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<sup>5</sup> *Already, LLC v. Nike, Inc.*, 133 S. Ct. 721, 726 (2013).

<sup>6</sup> *Radha Geismann, MD., P.C. v. ZocDoc, Inc.*, 850 F.3d 507, 511 (2d Cir. 2017) (quoting *Russman v. Bd. of Educ. of Enlarged City Sch. Dist. of City of Wateroliet*, 260 F.3d 114, 118-19 (2d Cir. 2001)).

<sup>7</sup> See *Doyle v. Midland Credit Mgmt., Inc.*, 722 F.3d 78, 80 (2d Cir. 2013) (“Under Article III of the U.S. Constitution, when a case becomes moot, the federal courts lack subject matter jurisdiction over the action.” (alteration and internal quotation marks omitted)).

### III. THE COMPLAINT SHOULD BE DISMISSED FOR FAILURE TO STATE A CLAIM

Plaintiff's complaint alleges trademark infringement, unfair competition, and trade dress infringement. As explained *infra*, these allegations fail as a matter of law because Plaintiff does not have any legally protectable interest in selling fried Calzones in an "open kitchen" restaurant with a white tiles pattern.

Because the Complaint does not state any federal cause of action, the Court should decline to exercise supplemental jurisdiction over the remaining counts of the Complaint.

Defendant respectfully requests that the Court takes judicial notice of facts outside of the Complaint, as described *infra*.<sup>8</sup>

#### **A. Plaintiff's Trademark infringement, false designation of origin, unfair competition, and common law infringement claims all fail.**

Plaintiff's Amended Complaint alleges infringement of its marks in Count One, under § 32 of the Lanham Act , 15 U.S.C. § 1114(a); in Count Three, under § 43(a) of the

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<sup>8</sup> *Becdelievre v. Anastasia Musical LLC*, 2018 U.S. Dist. LEXIS 55815, at \*23 n.8 (S.D.N.Y. Apr. 2, 2018) [citing Weinstein's Federal Evidence, § 201.12[5] at 201-44 ("Courts may take judicial notice of historical facts revealed in authoritative writings when there is no dispute about the authenticity of the materials and judicial notice is limited to factual matters that are incontrovertible."); 1-4 Weinstein's Evidence Manual § 4.02 (explaining that courts may "take judicial notice of facts that various newspapers, magazines, and books were published solely as an indication of information in the public realm at the time, not whether the contents of those articles were, in fact, true")].

Lanham Act, 15 U.S.C. § 1125(a); and in Count Two, under New York common law. (**Pl. Am. Compl.** ¶¶ 65-101).

To prevail on a claim for infringement of a registered trademark under Section 1114(a) of the Lanham Act, a plaintiff must establish: 1) that it has a valid mark entitled to protection; and 2) a likelihood of consumer confusion resulting from the defendant's use.<sup>9</sup>

In addition to the protection afforded registered trademarks under 15 U.S.C. § 1114(1)(a), the Lanham Act also protects “unregistered, common law trademarks.”<sup>10</sup>

As to a claim of false designation of origin, the Lanham Act prohibits any misrepresentation likely to cause confusion about the source of a product, in particular the use by any person of any word, term, name, symbol, or device, or any combination thereof ... likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association ... with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person.<sup>11</sup>

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<sup>9</sup> *Christian Louboutin S.A. v. Yves Saint Laurent America Holding, Inc.*, 696 F.3d 206, 216 (2d Cir. 2012); *Van Praagh v. Gratton*, 993 F. Supp. 2d 293, 301 (E.D.N.Y. 2014).

<sup>10</sup> *Time, Inc. v. Petersen Publ'g Co.*, 173 F.3d 113, 117 (2d Cir. 1999) (citing 15 U.S.C. § 1125(a)).

<sup>11</sup> *Van Praagh v. Gratton*, 993 F. Supp. 2d at 301 (quoting *L'Oreal USA, Inc. v. Trend Beauty Corp.*, No. 11 CV 4147, 2013 U.S. Dist. LEXIS 115795, 2013 WL 4400532, at \*14 (S.D.N.Y. Aug. 15, 2013)).

The standards for false designation of origin claims under the Lanham Act, 15 U.S.C. § 1125(a), are identical to those for claims of registered trademark infringement under the Lanham Act, 15 U.S.C. § 1114(a).<sup>12</sup>

As to common law trademark infringement and unfair competition claims, “it is well-established that the elements necessary to prevail on causes of action for trademark infringement and unfair competition under New York common law mirror the Lanham Act claims.”<sup>13</sup>

Thus, since courts “employ substantially similar standards” for each of these claims, see *Van Praagh v. Gratton*, 993 F. Supp. 2d at 301, the Court proceeds to analyze them together.<sup>14</sup>

### **1. The Flag Mark is not protectable as a matter of law.**

Here, Plaintiff seeks protection for items that the USPTO already ruled were not protectable. Plaintiff first sought registration of its “Flag Mark” displayed in Paragraph 9 of its Amended Complaint. But on June 26, 2019, the USPTO rejected Plaintiff’s Flag Mark because of its use of the Italian Flag, and as such, it is not entitled to any

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<sup>12</sup> See *Van Praagh v. Gratton*, 993 F. Supp. 2d at 301 (citing *Twentieth Century Fox Film Corp. v. Marvel Enters., Inc.*, 220 F. Supp. 2d 289, 297 (S.D.N.Y. 2002)).

<sup>13</sup> *Id.* at 302 (quoting *Allied Interstate LLC v. Kimmel & Silverman P.C.*, No. 12 CV 4204, 2013 U.S. Dist. LEXIS 113465, 2013 WL 4245987, at \*5 (S.D.N.Y. Aug. 12, 2013)): see also *Canon U.S.A., Inc. v. F & E Trading LLC*, No. 15 CV 6015, 2017 U.S. Dist. LEXIS 4223, 2017 WL 112515, at \*5 (E.D.N.Y. Jan. 11, 2017) (quoting *Lorillard Tobacco Co. v. Jamelis Grocery, Inc.*, 378 F. Supp. 2d 448, 456 (S.D.N.Y. 2005)).

<sup>14</sup> *Arifee v. Palace on Broadway, Inc.*, No. 16 CV 4144 (DLI) (CLP), 2017 U.S. Dist. LEXIS 108127, at \*9 (E.D.N.Y. July 11, 2017).

protection as a matter of law. See USPTO Office Action Official Letter attached as

**Exhibit D.**

**2. The USPTO ruled that many elements of Plaintiff's registered Mark are not inherently distinctive.**

After its Flag Mark was rejected, Plaintiff revised the Mark as is shown in Paragraph 8 of the Amended Complaint. However, the USPTO required Plaintiff to disclaim the unregistrable parts of the Mark including the wording: (1) "PANZEROTTI BITES"; (2) "ORIGINAL APULIAN FOOD"; and (3) "BROOKLYN." The USPTO explicitly ruled that "PANZEROTTI BITES" was not inherently distinctive and at best was descriptive:

In this case, applicant has already disclaimed the wording "ORIGINAL APULIAN FOOD" and "BROOKLYN", which is proper. Applicant must also disclaim the wording "PANZEROTTI BITES" because it is not inherently distinctive. These unregistrable term(s) at best are merely descriptive of an ingredient, quality, characteristic, function, feature, purpose, or use of applicant's goods and/or services. See 15 U.S.C. §1052(e)(1); *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1251, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012); TMEP §§1213, 1213.03(a).

See **Exhibit D.**

After the disclaimer, Plaintiff's Mark was registered on December 17, 2019. See Status Page on USPTO website attached as **Exhibit E.**

To echo the USPTO's ruling, Plaintiff's registered Mark is weak. "Panzerotti" is generic because it identifies a certain food product, like "Pasta", "Calzone", or "Pizza".

Plaintiff does not allege that they invented Panzerotti. And even their claim of being the first ones of introducing Panzerotti in the New York market is a blatant lie.<sup>15</sup>

Indeed, a few other restaurants in New York have Panzerotti in their menu. See for example:

- Brooklyn Pizza Masters: <https://slicelife.com/restaurants/ny/new-york/10022/brooklyn-pizza-masters/menu> (defining it a "fried calzones stuffed with various toppings, Italian street food, Puglia");
- I Trulli: <https://menupages.com/i-trulli/122-e-27th-st-new-york> (defining it as a "baby calzones stuffed with mozzarella and tomato");
- Bella Blu: <https://direct.chownow.com/order/12654/locations/17704>;
- Rome To Brooklyn Pizza: <https://www.rometobrooklynpizza.com/menu> (defining it as "fried calzones stuffed with various toppings, Italian street food, Puglia region style").

### **3. Plaintiff never even alleged how its registered Mark and ILP's new Mark are similar.**

Basically, only the design elements of Plaintiff's registered Mark are possibly protectable. And ILP changed its Mark in October of 2019, prior to Plaintiff's Mark

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<sup>15</sup> A New York restaurant named "Mr. Panzerotto" (now closed) purported to be the "first ever panzerotti store in New Nork". See their former website on the WayBack Machine: <https://web.archive.org/web/20170701232632/https://mrpanzerotto.com/>

becoming registered on December 17, 2019. ILP's new Mark and Plaintiff's registered Mark look nothing alike.

ILP's revised Mark:



And Plaintiff's registered Mark:



**4. Plaintiff never even alleged how its registered Mark is used in commerce.**

Plaintiff alleged that it “prominently features the Flag Mark on its signage and elsewhere throughout Panzerotti Bites.” Pl. Am. Compl., ¶28.

Curiously, however, Plaintiff never alleged how it uses the revised Mark which was registered in December of 2019. Plaintiff only offers the bare conclusory statement that it “has been using the [revised] Mark in commerce since on or about March 15, 2018.” See Pl. Am. Compl. ¶67.

Looking at photographs posted on the restaurant website Yelp, it appears that Plaintiff does not use the revised Mark anywhere, as all signage and logos involve the Flag Mark. See Yelp photographs of Panzerotti Bites attached as **Exhibit F**.<sup>16</sup>

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<sup>16</sup> See [https://www.yelp.com/biz\\_photos/panzerotti-bites-brooklyn](https://www.yelp.com/biz_photos/panzerotti-bites-brooklyn) (as shown on May 7, 2020).

On April 1, 2020, Plaintiff started a fundraising campaign and, again, they only used their Flag Mark.<sup>17</sup>

The sole exception is a paper bag which uses a logo similar to the revised Mark, but uses only the color black, whereas the registered Mark uses black and gold coloring, and two-tone lettering. The USPTO advised that “the colors black and gold are claimed as a feature of the mark.” See USPTO Office Action Official Letter attached as **Exhibit D**.

So, it seems that Plaintiff’s failure to allege how the registered Mark is used in commerce is based upon the fact that it does not actually use the registered Mark in commerce. Accordingly, Counts One, Two, and Three must be dismissed.

**B. Plaintiff’s trade dress claims fail.**

Although not originally classified under “trademarks,” the concept of “trade dress” — the overall appearance or image of goods — has been incorporated into the general trademark law, including § 43(a).<sup>18</sup>

Trade dress claims under § 43(a) traditionally referred to claims where “the manner in which a product was ‘dressed up’ to go to market with a label, package, display card, [or] similar packaging elements” could confuse the customer as to source of the product.<sup>19</sup>

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<sup>17</sup> See <https://www.gofundme.com/f/help-panzerotti-bites> (retrieved May 7, 2020).

<sup>18</sup> See *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 209, 120 S.Ct. 1339, 146 L.Ed.2d 182 (2000); *Restatement (Third) of Unfair Competition* § 16 cmt. a (1995).

<sup>19</sup> *Jeffrey Milstein, Inc. v. Greger, Lawlor, Roth, Inc.*, 58 F.3d 27, 31 (2d Cir.1995).

The scope of trade dress claims has expanded to include “the totality of any elements in which a product or service is packaged or presented.”<sup>20</sup>

More recently, the scope of trade dress even includes claims, involving the design of a product itself.<sup>21</sup>

In a trade dress action under § 43(a), the plaintiff bears the burden to prove three things: first, “that the mark is distinctive as to the source of the good,” *Yurman Design*, 262 F.3d at 115; second, “that there is a likelihood of confusion between its good and the defendant’s;” *Id*; and third, “that the matter sought to be protected is not functional.” 15 U.S.C. § 1125(a)(3).

Here, Plaintiff’s allegations of trade dress infringement by ILP are blatantly frivolous and should be dismissed. First, Plaintiff’s Complaint fails to articulate a specific trade dress. Second, even if the allegations in the Complaint were sufficient, they should be dismissed because Plaintiff’s trade dress is common and lacks secondary meaning.

Plaintiff failed to meet its initial burden to articulate a specific trade dress, and

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<sup>20</sup> 1 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 8:1, at 8-2 (4th ed.2001); see also *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 112 S.Ct. 2753, 120 L.Ed.2d 615 (1992) (upholding trade dress claim regarding the “total image” of a restaurant chain).

<sup>21</sup> See *Wal-Mart*, 529 U.S. at 209, 120 S.Ct. 1339 (citing, among other cases, *Knitwaves, Inc. v. Lollytogs, Ltd.*, 71 F.3d 996 (2d Cir.1995)); McCarthy, *supra*, § 8:5.

then to demonstrate that it has, in fact, consistently used that trade dress.<sup>22</sup>

Here, Plaintiff alleged that their trade dress consists of (1) having an “open kitchen” with a white tiles pattern, (2) serving food on wooden boards, and (3) cutting the Panzerotti in half.

These allegations are insufficient as a matter of law to establish the existence of a trade dress. More importantly, even if a trade dress was validly alleged, it is unprotectable because it is not distinctive.

As a way of example, a restaurant named Open Kitchen, with two locations in New York City, happens to have an “open kitchen” with a white tile pattern.<sup>23</sup>

Restaurants with an “open kitchen” are certainly not a novelty.

An article published on the New York Times on July 27, 2005 reads:

“There was a time when much of the point of fine dining was to be liberated from the frenetic, clangorous, sweaty making of a meal, to have it magically appear, an unlabored gift from unseen elves.

Not these days. Not even close. Now you are primed to ooh as chefs simmer and aah as they sauté. You are prodded to watch the sausage being made (not literally, but almost) and feel the heat.

In many New York restaurants, the wall between dining room and kitchen has tumbled to the point where the

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<sup>22</sup> See e.g., *Life Industries Corp. v. Star Brite Distributing, Inc.*, 31 F.3d 42, 46 (2d Cir. 1994); *Clinique Laboratories, Inc. v. Dep Corp.*, 945 F. Supp. 547, 559 (S.D.N.Y. 1996).

<sup>23</sup> <http://openkitchenfood.com/>; see also a picture of this restaurant found on Google and herein enclosed as **Exhibit I**.

kitchen is not merely open to your view, a kind of arrangement that has lurched in and out of vogue for decades. The kitchen demands your attention, bears down on you, wrests the focus of an evening from the beets before you to the beads of perspiration on a not-so-distant line cook's brow.

And it stands as more than just a whimsical design option, an interesting architectural variation. It represents a multifaceted metaphor for the way many diners regard the experience of eating out and the way many chefs regard their roles".<sup>24</sup>

Open kitchens with white tiles are commonplace. In addition, the use of wooden serving boards is commonplace in the restaurant industry and not protectable.

Finally, Plaintiff's allegations that their practice of cutting the Panzerotti in half constitutes a protectible trade dress go way beyond the threshold for imposition of sanctions under Rule 11. Cutting sandwiches, pizza pies, calzones, burritos or other finger food is so widespread, so that there is really nothing distinctive about it.

Moreover, cutting food in half is not protectible because it is "functional" to the use of the Panzerotti, namely to avoid the steam that releases from the Panzerotti which can make the crust soggy,<sup>25</sup> and burn a customer's mouth.<sup>26</sup>

Accordingly, Count Four of Plaintiff's Complaint must be dismissed.

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<sup>24</sup> <https://www.nytimes.com/2005/07/27/dining/yes-the-kitchens-open-too-open.html>

<sup>25</sup> See popular internet cooking show: "Binging with Babish: Calzones from Seinfeld" at 7:20 to 7:32, <https://www.youtube.com/watch?v=zWuWrdaYMIY>

<sup>26</sup> See USA Today 10 Best article <https://www.10best.com/interests/food-culture/the-story-of-panzarottis-south-jerseys-beloved-fried-pizza-pockets/>

**C. Plaintiff's claims under N.Y. Gen. Bus. Law § 360-1 fail.**

**1. Injunctive Relief is Moot.**

N.Y. Gen. Bus. Law § 360-1 provides that:

Likelihood of injury to business reputation or of dilution of the distinctive quality of a mark or trade name *shall be a ground for injunctive relief* in cases of infringement of a mark registered or not registered or in cases of unfair competition, notwithstanding the absence of competition between the parties or the absence of confusion as to the source of goods or services. (*emphasis added*)

Accordingly, “the sole relief possible on a dilution claim under either federal or state law is injunctive relief, rather than monetary damages.”<sup>27</sup>

Here, Count Six of Plaintiff's Amended Complaint for claims arising from N.Y. Gen. Bus. Law § 360-1 fail as a matter of law. ILP already changed its Mark, — which looks nothing like Plaintiff's Marks. An injunction is moot.

**2. Plaintiffs' Marks are not truly distinctive, nor have they acquired secondary meaning, nor are they substantially similar to Plaintiff's Marks.**

To establish a dilution claim under section 360-1, a plaintiff must show “(1) that the trademark is truly distinctive or has acquired secondary meaning, and (2) a likelihood of dilution either as a result of ‘blurring’ or ‘tarnishment.’”<sup>28</sup>

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<sup>27</sup> See *All R's Consulting, Inc. v. Pilgrims Pride Corp.*, No. 06 CIV. 3601, 2008 WL 852013, at \*15 (S.D.N.Y. Mar. 28, 2008) (quoting *Scholastic, Inc. v. Stouffer*, 124 F. Supp.2d 836, 848 (S.D.N.Y. 2000)).

<sup>28</sup> See *New York Stock Exchange, Inc. v. New York, New York Hotel, LLC*, 293 F.3d 550, 557 (2d Cir.2002); *U-Neek, Inc. v. Wal-Mart Stores, Inc.*, 147 F.Supp.2d 158, 175 (S.D.N.Y.2001).

Most important to the distinction here, New York law does not permit a dilution claim unless the marks are “substantially” similar.<sup>29</sup>

In numerous instances, Courts have dismissed Plaintiff’s dilution claims due to their mark being generic, and not unique.

For instance, a bank named Greenpoint could not enjoin a marketing program named Greenpoints “because ‘GREENPOINT’ is not unique nor has it achieved secondary meaning throughout state”. *GreenPoint Fin. Corp. v Sperry & Hutchinson Co.*, 116 F. Supp. 2d 405, 2000 U.S. Dist. LEXIS 13584 (S.D.N.Y. 2000).

Similarly, Allied Maintenance Corporation was not entitled to enjoin Allied Mechanical Trades, Inc., from using “Allied” in connection with its business, where Allied Maintenance was engaged in cleaning and maintenance of large office buildings, while Allied Mechanical Trades was engaged in installation and repair of heating, ventilating and air-conditioning equipment, there was nothing in Allied Mechanical’s name which indicated that it was inherently strong trade name susceptible of dilution, and, in light of large number of business entities using generic term “allied” in their trade name, it could not be said that word had acquired secondary meaning and was associated by public with Allied Maintenance’s service. *Allied Maintenance Corp. v Allied Mechanical Trades, Inc.*, 42 N.Y.2d 538, 399 N.Y.S.2d 628, 369 N.E.2d 1162, 1977 N.Y.

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<sup>29</sup> See *Playtex Prods., Inc.*, 390 F.3d 158, 167 (2d Cir. 2004) (“A plaintiff cannot prevail on a [New York] state or [pre-TDRA] federal dilution claim unless the marks at issue are ‘very’ or ‘substantially similar.’”).

LEXIS 2429 (N.Y. 1977).

In our case, the word Panzerotti is simply descriptive of a generic type of food, as opposed to a unique product sold by Plaintiff.

More importantly, to establish secondary meaning, it must be shown that, through exclusive use in advertising by one entity, a name or mark has become so associated in mind of public with that entity or its product that it identifies goods sold by that entity and distinguishes them from goods sold by others. *Allied Maintenance Corp. v Allied Mechanical Trades, Inc.*, 42 N.Y.2d 538, 399 N.Y.S.2d 628, 369 N.E.2d 1162, 1977 N.Y. LEXIS 2429 (N.Y. 1977).

Here, Plaintiff does not offer any detail on how their mark has acquired secondary meaning. The Complaint does not (and could not) allege that Plaintiff is the only business selling Panzerotti in New York. And stated above, the reality is that countless other businesses have Panzerotti in their menus.

### **3. Plaintiff's 360-I claims are preempted.**

“Though generally speaking, a plaintiff may plead facts to make out an independent claim under section 360-I, see *Eliya, Inc. v. Kohl's Dep't Stores*, 2006 WL 2645196 at \*7, where a plaintiff can only plead facts to allege harm from copying, a claim under section 360-I should be considered preempted.” *Eyal R.D. Corp. v. Jewelex New York Ltd.*, 784 F.Supp.2d 441, 449 (S.D.N.Y. 2011) where copyright infringement and trade dress infringement claims couched as a 360-I claim were preempted.

Here, Plaintiffs 360-1 claim alleges the same exact facts as the trademark infringement claims, and thus should be preempted.

**D. Plaintiff's claims under N.Y. Gen. Bus. Law §§ 349(a) and 350 fail.**

Section 349 of the New York General Business Law prohibits “[d]eceptive acts or practices in the conduct of any business, trade or commerce or in the furnishing of any service in this state.” N.Y. Gen. Bus. Law § 349(a).

Section 350 of the New York General Business Law prohibits “[f]alse advertising in the conduct of any business, trade or commerce or in the furnishing of any service in this state.” N.Y. Gen. Bus. Law § 350.

In order to state a claim under Sections 349 and 350, a plaintiff must allege that “(1) the defendant's act, practice or advertisement was consumer-oriented; (2) it was materially deceptive and misleading; and (3) that [the moving party] was injured as a result.”<sup>30</sup> Although Sections 349 and 350 are designed to protect consumers, competitors may recover for violations of these Sections if there is “some harm to the public at large.”<sup>31</sup>

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<sup>30</sup> *Verizon Directories Corp. v. Yellow Book USA, Inc.*, 309 F. Supp. 2d 401, 405 (E.D.N.Y. 2004) (citing cases); see also *New World Solutions, Inc. v. NameMedia Inc.*, No. 11-CV-2763(KMK), 2015 WL 8958390, at \*25 (S.D.N.Y. Dec. 15, 2015) (“The standard for recovery under General Business Law § 350, while specific to false advertising, is otherwise identical to section 349.”)

<sup>31</sup> *Boule v. Hutton*, 328 F.3d 84, 94 (2d Cir. 2003) (citing *Securitron Magnalock Corp. v. Schnabolk*, 65 F.3d 256, 264 (2d Cir. 1995)); see also *Coach, Inc. v. Horizon Trading USA Inc.*, 908 F. Supp. 2d 426, 435 (S.D.N.Y. 2012) (Trademark claims are not cognizable under Sections 349 and 350 unless “there is a *specific and substantial injury to the public*”)

Here, Count Seven of Plaintiff's Amended Complaint sues for damages arising under N.Y. Gen. Bus. Law §§ 349(a) and 350. The claims fail as a matter of law. Plaintiff completely failed to allege "a *specific and substantial injury to the public interest* over and above ordinary trademark infringement or dilution." *Coach, Inc.* at 435 (*emphasis added*).

#### **IV. THE COURT SHOULD NOT EXERCISE SUPPLEMENTAL JURISDICTION OVER THE BREACH OF FIDUCIARY DUTY CLAIM**

As stated above, the Court should dismiss Plaintiff's complaint against Cea for lack of venue, lack of subject-matter jurisdiction, and failure to state a claim.

The Court should decline to exercise supplemental jurisdiction over the breach of fiduciary duty claim.

Under 28 U.S.C. § 1367(c)(3), a district court may decline to exercise supplemental jurisdiction if it has dismissed all claims over which it has original jurisdiction. Once the federal claims in a case have been dismissed, the court, in its discretion, should consider whether the considerations of judicial economy, convenience, and fairness to litigants require that supplemental jurisdiction be exercised. *Castellano v. Bd. of Trustees*, 937 F.2d 752, 758 (2d Cir. 1991).<sup>32</sup>

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*interest over and above ordinary trademark infringement or dilution" (emphasis added) Gucci Am., Inc. v. Duty Free Apparel, Ltd.*, 277 F. Supp. 2d 269, 273 (S.D.N.Y. 2003) ("Claims that arise out of a trademark infringement action, and disputes between competitors where the core of the claim is harm to another business as opposed to consumers, both constitute situations which courts have found to reflect a public harm that is too insubstantial to satisfy the pleading requirements of § 349.")

<sup>32</sup> *Barnes v. CCH Corp. Sys.*, 2004 U.S. Dist. LEXIS 12504, at \*23-24 (S.D.N.Y. July 6, 2004).

**V. THE COMPLAINT DOES NOT ALLEGE SUFFICIENT FACTS TO SUPPORT A CAUSE OF ACTION FOR BREACH OF FIDUCIARY DUTY**

The breach of fiduciary duty claim should be dismissed even if the Court decides to exercise supplemental jurisdiction.

The Complaint alleges that Defendant Michele Cea misappropriated and divulged Plaintiff's "confidential information, including its business plan, descriptions of its equipment and the identity of its architect, logo designer and public relations agency."

In New York, "[I]n order to establish a breach of fiduciary duties, a plaintiff must prove the existence of a fiduciary relationship, misconduct by the defendant, and damages that were directly caused by the defendant's misconduct."<sup>33</sup>

In addition, a breach of fiduciary duty claim must be pleaded with particularity.<sup>34</sup>

Here, Plaintiff's complaint should be dismissed for failure to state the existence of a fiduciary relationship. And even if the Court were to find that a fiduciary relationship existed, Plaintiff's complaint fails to allege sufficient facts to support any misconduct by Cea.

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<sup>33</sup> *Kurtzman v. Bergstol*, 40 A.D.3d 588, 590, 835 N.Y.S.2d 644 (2nd Dep't 2007).

<sup>34</sup> *Litvinoff v. Wright*, 150 AD 3d 714, 715 (2d Dep't 2017).

**A. The Complaint does not allege the existence of a fiduciary relationship.**

Plaintiff's Complaint alleges:

Before Plaintiff could open Panzerotti Bites, however, Plaintiff was required to obtain E-2 visas for Vittoria Lattanzio and Pasquale De Ruvo, as they are citizens of Italy.

In or about June 2016, to help obtain E-2 visas for Ms. Lattanzio and Mr. De Ruvo, Plaintiff retained ExportUSA, which is an Italian company that provides services for potential investors in the United States.

ExportUSA helped Plaintiff prepare the documents required to obtain the E-2 visas for Ms. Lattanzio and Mr. De Ruvo, and ExportUSA hired Defendant Cea, an attorney, on behalf of Plaintiff, to file the documents with the Department of Homeland Security.

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Preliminarily, it is noted that there is no law or regulation requiring a corporation to obtain Visas for its owners as a requirement to open and operate. At best, it could be said that Vittoria Lattanzio and Pasquale De Ruvo were required to obtain E-2 Visas to be allowed *to perform labor* for Plaintiff in the United States.

It is suspected that this misstatement might not have been unintended.<sup>35</sup> After all, it is undisputed that E-2 Visa applications are filed by aliens, and not corporations.

In fact, as a way of example, the Foreign Affairs Manual states:

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<sup>35</sup> The Complaint also mistakenly stated that Visas applications were submitted to the "Department of Homeland Security, while Vittoria Lattanzio and Pasquale De Ruvo applied with the U.S. Embassy of Rome, which is part of the U.S. Department of State.

Treaty Trader (E-1) and Treaty Investor (E-2) visas are for *citizens of countries with which the United States maintains treaties of commerce and navigation.*

The *applicant* must be coming to the United States solely to engage in substantial trade, including trade in services or technology, in qualifying activities, principally between the United States and the treaty country (E-1), or to develop and direct the operations of an enterprise in which the applicant has invested a substantial amount of capital (E-2), or to work in the enterprise as an executive, supervisor, or essentially skilled employee.<sup>36</sup> (*emphasis added*)

In other words, there was no Visa requirement for Plaintiff, a corporation, to start its operations. And the E-2 Visa applications had to be filed by Vittoria Lattanzio and Pasquale De Ruvo (the “citizens of countries with which the United States maintains treaties of commerce and navigation,” or “applicants”).

The distinction is crucial because the complaint alleges that Cea breached fiduciary duties owed to Plaintiff, while Visa applications were submitted for Vittoria Lattanzio and Pasquale De Ruvo, which are not even named as Plaintiffs in the complaint.

Plaintiff is aware of this, and that is why the Complaint also alleges that Cea was retained by Plaintiff in connection with a liquor license application and the negotiation of a lease. Interestingly, the complaint fails to allege that the business plan, or any knowledge of it, was required to enter into a lease or apply for a liquor license.

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<sup>36</sup> See 9 FAM 402.9-2 (*emphasis added*); see also INA 101(a)(15)(E) (8 U.S.C. 1101(a)(15)(E)).

More importantly, as explained *infra* in more details, the Complaint alleges that Cea was retained by “Export USA,” a third-party company—not a law firm—as opposed to Plaintiff. Notably, the Complaint does not allege the existence of a confidentiality agreement between Plaintiff and Export USA or between Plaintiff and its shareholders.

Simply put, Cea preliminarily objects that Plaintiff has no standing to bring a claim for breach of fiduciary duty because, as a matter of law, Cea was retained by Export USA, the Visa applicants were Vittoria Lattanzio and Pasquale De Ruvo, and not Plaintiff, and the Complaint fails to allege that Cea had to use the business plan in connection to the liquor license application or the lease agreement.

**B. The Complaint does not allege sufficient plausible facts to conclude that the information allegedly misappropriated and disclosed by Cea was confidential.**

Comment “e” of Section 16 of the Third Restatement Governing Lawyers state that “[A] lawyer may not use or disclose sensitive information about the client, except in appropriate circumstances.”

Here, Plaintiff’s allegations are insufficient to support a breach of fiduciary duty claim because it alleges misappropriation and disclosure of information that is not sensitive, confidential, or secret as a matter of law, namely: (1) “confidential information”, (2) a business plan, (3) descriptions of its equipment, the identity of its

architect, logo designer and public relations agency. We will address each category separately.

### **“Confidential Information”**

The Complaint’s allegation that Cea misappropriated “confidential information”. This allegation is insufficient as a matter of law to support Plaintiff’s breach of fiduciary duty claim because it is a legal conclusion couched as a factual allegation.

While a complaint attacked by a Rule 12(b)(6) motion to dismiss does not need detailed factual allegations, a plaintiff's obligation to provide the "grounds" of his "entitle[ment] to relief" requires more than labels and conclusions, and a formulaic recitation of the elements of a cause of action will not do, see *Papasan v. Allain*, 478 U.S. 265, 286, 106 S. Ct. 2932, 92 L. Ed. 2d 209 (1986) (on a motion to dismiss, courts "are not bound to accept as true a legal conclusion couched as a factual allegation").

*Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 555, 127 S. Ct. 1955, 1964-65 (2007) (internal citations omitted).

In other words, it is not enough for Plaintiff to allege that Cea breached his fiduciary duty by disclosing “confidential information,” because there is no plausible *factual* allegation suggesting that such information is confidential as a matter of law.

### **Business plan**

Plaintiff’s Complaint alleges that Cea misappropriated and disclosed the business plan submitted to the U.S. government along with the E-2 Visa applications of Vittoria Lattanzio and Pasquale De Ruvo.

First, the business plan is an integral part of first-time E-2 Visa applications submitted to the U.S. Embassy of Rome, where Vittoria Lattanzio and Pasquale De Ruvo applied.<sup>37</sup>

The business plan was submitted simply to comply with Visa filing requirements, and not to elaborate the complexity of opening and operating a small shop making fried Calzones. Because that is not complicated.

Second, most government records (such as Visa applications) can be obtained by filing a request under the Freedom of Information Act (“FOIA”), 5 U.S.C. § 552.

The complaint fails to identify how the Visa applications of Vittoria Lattanzio and Pasquale De Ruvo would be exempted from disclosure under FOIA.

Third, the Complaint does not allege that any action was taken by Plaintiff to establish and/or preserve the confidentiality of their business plan.

The party who wishes to claim the attorney-client privilege must take appropriate action to preserve the confidentiality of the documents.

The U.S. Court of Appeals for the Second Circuit opined:

It is difficult to be persuaded that the documents were intended to remain confidential in the light of the fact that they were indiscriminately mingled with the other routine documents of the corporation and that no special effort to preserve them in segregated files with special protections was made.

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<sup>37</sup> See <https://it.usembassy.gov/visas/niv/e/e2/> (under Tab G “A concise business plan that analyzes the local market and competition and gives a 5-year projection of profit and loss.”)

One measure of their continuing confidentiality is the degree of care exhibited in their keeping, and the risk of insufficient precautions must rest with the party claiming the privilege.<sup>38</sup>

In our case, the complaint does not even *allege* that the business plan was marked as “confidential,” *or* that Cea was told that the business was confidential, *or* that Plaintiff had a confidentiality agreement with Export USA or its shareholders *or*, simply put, that *any action whatsoever* was taken to establish or preserve its confidentiality.

Instead, the Complaint alleges that the business plan and the entire Visa applications were handled with Export USA, which is not a law firm and therefore not bound by any rule of confidentiality towards Plaintiff or its shareholders. See **Pl. Am. Compl.** ¶¶ 25, 26.

Fourth, the Complaint fails to explain how the information on the business plan remained secret or “confidential” after the restaurant opened, with their “open kitchen” in plain view to the general public.

Finally, Plaintiff’s bare conclusion that their business plan was confidential because it contained “trade secret” is insufficient to survive a motion to dismiss under *Twombly*.

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<sup>38</sup> *In re Horowitz*, 482 F.2d 72, 82 (2d Cir. 1973); see also, *Teachers Ins., Etc. v. Shamrock Broadcasting Co.*, 521 F. Supp. 638, 645 (S.D.N.Y. 1981).

New York has substantially adopted the approach of the original Restatement of Torts (1939) to the law of trade secrets.<sup>39</sup>

The New York Appellate Division opined that, under the rationale of the Restatement, a trade secret is generally defined as a formula, process, device or compilation of information used in one's business which confers a competitive advantage over those in similar businesses who do not know or use it (Restatement of Torts § 757 comment b [1939]).

An essential requisite to legal protection against misappropriation of such a formula, process, device or compilation of information is the element of secrecy.

Secrecy is used in the Restatement in two related senses:

- (1) as substantial exclusivity of knowledge of the formula, process, device or compilation of information ("Matters of public knowledge or of general knowledge in an industry cannot be appropriated by one as his secret" [*id.*]); and
- (2) as the employment of precautionary measures to preserve such exclusive knowledge by limiting legitimate access by others ("Nevertheless, a substantial element of secrecy must exist, so that, except by the use of improper means, there would be difficulty in acquiring the information" [*id.*]).<sup>40</sup>

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<sup>39</sup> See *Eagle Comtronics v Pico, Inc.*, 89 AD2d 803, 804, lv denied 58 NY2d 601; *Ferranti Elec. v Harwood*, 43 Misc 2d 533, 539; *Minnesota Min. & Mfg. Co. v Technical Tape Corp.*, 23 Misc 2d 671, 678-679, affd 15 AD2d 960, affd 18 AD2d 679).

<sup>40</sup> *Delta Filter Corp. v. Morin*, 108 A.D.2d 991, 992, 485 N.Y.S.2d 143, 144 (App. Div. 1985).

Although there is no one-size-fits all definition to a trade secret, New York courts generally consider the following factors to determine its contours:

- (1) the extent to which the information is known outside of the business;
- (2) the extent to which it is known by employees and others involved in the business;
- (3) the extent of measures taken by the business to guard the secrecy of the information;
- (4) the value of the information to the business and its competitors;
- (5) the amount of effort or money expended by the business in developing the information;
- (6) the ease or difficulty with which the information could be properly acquired or duplicated by others.<sup>41</sup>

Here, not surprisingly, Plaintiff's Complaint fails to allege *a single factor* under either the Restatement of Torts or the 6-prong judicial test.

The subject matter of a trade secret must be secret. Matters of public knowledge or of general knowledge in an industry cannot be appropriated by one as his secret. Matters which are completely disclosed by the goods which one markets cannot be his secret. *Speedry Chem. Prods., Inc. v. Carter's Ink Co.*, 306 F.2d 328, 331 (2d Cir. 1962).

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<sup>41</sup> *In re Document Techs. Litig.*, 275 F. Supp. 3d 454, 462 (S.D.N.Y. 2017); *Ashland Mgmt., Inc. v. Janien*, 82 N.Y.2d 395 (1993); see also *Eagle Comtronics, Inc. v. Pico, Inc.*, 453 N.Y.S. 2d 470 (N.Y. App. Div. 1982)

There is nothing secret about fried Calzones, which are sold in countless other places in New York, both under the name of “Panzerotti” and “Calzone.”

**Descriptions of Plaintiff’s equipment, and the identity of its architect, logo designer and public relations agency.**

The last and most blatantly frivolous category of “confidential” information allegedly misused by Cea includes a description of Plaintiff’s equipment, and the identity of its architect, logo designer and public relations agency.

As stated above, matters of public knowledge cannot be appropriated by one as his secret. Plaintiff’s Complaint alleges that they have an “open kitchen” so it is undisputed that their equipment is in plain view. And open kitchen’s with rectangular white tiles are commonplace in restaurants throughout New York City.

With respect to the identity of Plaintiff’s architect, logo designer and public relation agency, Counsel has been unable to locate any case stating that such information could be considered confidential. But in any event, the Complaint fails to allege that said architect, logo designer and public relation agency executed a confidentiality agreement with Plaintiff.

**CONCLUSION**

For the foregoing reasons, Plaintiff’s complaint should be dismissed in its entirety.

Dated: May 7, 2020

Respectfully submitted,

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