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## Domino's Loses Pizza Trademark Battle In 5th Circ.

By **Mike Cherney**

Law360, New York (October 01, 2009) -- A small Dallas-area pizza chain has won a victory in a trademark battle against Domino's Pizza LLC, as a federal appeals court has overturned a lower court's ruling that Domino's did not infringe the chain's "Brooklyn-style pizza" marks.

The U.S. Court of Appeals for the Fifth Circuit ruled Wednesday that the district court erred in granting summary judgment because there were enough facts in dispute that the case should go to trial. The appeals court did not weigh in on the merits of the case.

The Great American Restaurant Co., which owns Brooklyn's Old Neighborhood Style Pizzeria, sued Domino's after the pizza colossus unveiled its own "Brooklyn-style pizza" and touted it as "a taste of the old neighborhood." Great American owns registered trademarks for its chain name and for the latter phrase, which it uses as a slogan.

Richard Smith, an attorney for Great American, said the company has opened five Brooklyn pizzeria locations in the past five years. He said he was pleased the Fifth Circuit "got it right."

"They've used this name and this phrase on all of their advertising since the beginning, and suddenly you've got the largest pizza delivery chain in the country doing a nationwide advertisement that uses a descriptor that's very, very close to Brooklyn's own trademark and that is identical to its actual slogan," Smith said.

"When that happens, you decide you're just going to roll over and give up those marks that you've worked so hard to establish, or you fight for them."

An attorney for Domino's was not immediately available for comment Thursday.

Domino's had argued that "Brooklyn-style pizza" was a descriptive mark and was not subject to trademark protection. It also argued that survey results showed consumers would not confuse Domino's product with Great American's pizza chain.

But the Fifth Circuit sided with Great American, saying that there was substantial evidence that there is no such thing as "Brooklyn-style pizza," meaning that the trademark is not descriptive and is potentially subject to trademark protection.

The Fifth Circuit also said there was evidence that consumers confused Domino's and Great American's marks, noting that Great American presented testimony from its managers who received calls from customers attempting to use Domino's coupons.

"Evidence of the likelihood of confusion also arose from the fact that the Domino's phrase was so similar to Brooklyn's trademark," the ruling said. "Domino's use of the exact words of Brooklyn's trademarked slogan 'a taste of the old neighborhood' for 10 months can lead to an additional inference of likely confusion, notwithstanding Domino's eventual discontinuation of the slogan."

Great American sought \$30 million from Domino's, the amount of Domino's revenues from nationwide sales of "Brooklyn-style" pizzas, plus other damages, according to court documents. It first sued in 2007.

Domino's stopped printing ads with the phrase "a taste of the old neighborhood" after it learned of Great American's initial allegations, but it continued to use the name "Brooklyn-style pizza," it said.

Domino's was represented in this matter by Brooks & Kushman PC and Siebman Reynolds Burg Phillips & Smith LLP.

Great American was represented by Lynn Tillotson Pinker & Cox LLP.

The case is *The Great American Restaurant Co. v. Domino's Pizza LLC et al.*, case number 08-40654, in the U.S. Court of Appeals for the Fifth Circuit.

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