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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92063185
Party	Plaintiff John Tacconelli
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Date	01/31/2019
Attachments	TTAB_Request_for_continued_suspension.pdf(3135447 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Registration No. 2,700,210
Issued March 25, 2003

John Tacconelli,
Petitioner,

v.

Tacconelli's Empire, LLC
Respondent.

Cancellation No: **92063185**

Registration No: **2700210**

REQUEST FOR CONTINUED SUSPENSION OF PROCEEDINGS

Petitioner requests a continued suspension of the proceedings at the TTAB pending resolution of the civil proceedings in the US District Court for the Eastern District of Pennsylvania. In June 2018, the US District Court granted petitioner's motion for leave (Exhibit A) and allowed the filing of a second amended complaint (Exhibit B). The most recent scheduling order for the matter is shown in Exhibit C. The parties have exchanged expert reports. Neither party filed a dispositive motion or rebuttal expert report. Petitioner is currently waiting for the issuance of a pre-trial/trial schedule.

Petitioner requests the continued suspension of the Cancellation proceeding pending the resolution of the District Court litigation.

Respectfully submitted
Obermayer, Rebmann Maxwell & Hippel, LLP

Dated: 31 January 2019

By: /Joseph F. Aceto/

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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing REQUEST FOR CONTINUED SUSPENSION OF PROCEEDINGS has been served on Norman E. Lehrer, counsel for Defendant, by electronic mail on 31 January 2019.

Norman Lehrer, Esq.
Norman E. Lehrer, P.C.
1205 North Kings Highway
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Respectfully submitted

/Joseph F. Aceto/

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Exhibit A

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF PENNSYLVANIA**

JOHN TACCONELLI
Plaintiff,

v.

TACCONELLI'S EMPIRE, LLC et al.
Defendants.

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:

CIVIL ACTION

NO.: 16-2348

ORDER

AND NOW, this 1st day of June, 2018, upon consideration of Plaintiff's Motion to Amend the Complaint (ECF No. 64) and Defendants' Response in Opposition thereto (ECF No. 66), it is hereby **ORDERED** that Plaintiff's Motion (ECF No. 64) is **GRANTED**.¹ The Clerk of Court is directed to file Plaintiff's Amended Complaint, as appended to Plaintiff's Motion (ECF No. 64-1).

A Case Management Order will issue forthwith.

BY THE COURT:

/s/ C. Darnell Jones, II

C. Darnell Jones, II J.

¹ The Court assumes the parties' familiarity with the complex procedural background of the above-captioned matter. Federal Rule of Civil Procedure 15(a)(2) instructs that where justice so requires, the court should freely grant leave to amend. The instant amendment will be Plaintiff's first, and Plaintiff previously advised all parties of his intention to seek amendment at the in-person status conference held on March 21, 2017. As such, this Court finds that amendment serves the interest of justice, here.

Exhibit B

IN THE UNITED STATES DISTRICT COURT FOR THE
EASTERN DISTRICT OF PENNSYLVANIA

JOHN TACCONELLI,

Plaintiff

v.

**TACCONELLI'S EMPIRE, LLC,
SUGARHOUSE HSP GAMING, L.P. and
VINCENT TACCONELLI, JR.**

Defendants.

Civil Action No. 16:2348

**JOHN TACCONELLI'S SECOND AMENDED
COMPLAINT AGAINST TACCONELLI'S EMPIRE, LLC,
SUGARHOUSE HSP GAMING, L.P. AND VINCENT TACCONELLI, JR.**

Plaintiff, John Tacconelli ("John" or "Plaintiff"), by and through his undersigned counsel, hereby files his Second Amended Complaint against defendants, Tacconelli's Empire, LLC ("Tacconelli's Empire"), Vincent Tacconelli, Jr. ("Vincent Jr."), and Sugarhouse HSP Gaming, L.P. ("Sugarhouse," collectively with Tacconelli's Empire and Vincent Jr., "Defendants"), as follows:¹

1. Plaintiff John Tacconelli seeks to rectify the register with respect to Service Mark No. 2,700,210 because it was procured through fraud on the United States Patent & Trademark Office ("USPTO") and because it falsely suggests a connection with John's business, Tacconelli's Pizzeria located 2604 East Somerset Street, Philadelphia, PA (the "Original Tacconelli's"), of which there is none. John also seeks declaratory relief that the license agreement entered into between Tacconelli's Empire and Sugarhouse is void *ab initio* and

¹ On March 21, 2017, this Court entered an order dismissing with prejudice all claims between Tacconelli's Empire and Mercer Café II, LLC. Pursuant to this Court's March 21, 2017 Order, on March 28, 2017, the remaining parties entered into a stipulation re-captioning the action to identify John Tacconelli as plaintiff and Tacconelli's Empire, Vincent Jr., and Sugarhouse as defendants.

unenforceable because Tacconelli's Empire and Vincent Jr. have no valid or enforceable rights in the TACCONELLI'S PIZZERIA mark, as the mark was procured through fraud on the USPTO and/or by falsely suggesting a connection with the Original Tacconelli's. Lastly, John asserts various statutory and common law claims related to his mark, TACCONELLI'S PIZZERIA, specifically for infringement, dilution, unjust enrichment and unfair competition. With respect to his statutory and common law claims, John seeks injunctive relief, as well as recovery of his damages sustained, disgorgement of Defendants' profits, and reimbursement of his attorneys' fees and costs.

2. This Court has jurisdiction over John's claims against Defendants pursuant to 28 U.S.C. § 1331, 28 U.S.C. § 1338(a) and 15 U.S.C. § 1121(a) because they arise under the Lanham Act. This Court has jurisdiction over John's requests to rectify the register pursuant to 15 U.S.C. § 1119, as there are independent grounds for subject matter jurisdiction, including a claim herein for unfair competition under the Lanham Act, 15 U.S.C. § 1125(a), as well as pendent state law claims. This Court has subject matter jurisdiction over John's pendent state common law claims under 28 U.S.C. § 1367(a) because they are so related to the federal claims in that they form part of the same case or controversy and derive from a common nucleus of operative fact.

3. Defendant Tacconelli's Empire is a New Jersey limited liability company with a principal place of business at 27 W. Main Street, Maple Shade, NJ 08052.

4. Defendant Vincent Tacconelli, Jr. ("Vincent Jr.") is an adult citizen with an address of 15 Woodbine Avenue, Maple Shade, New Jersey 08052. Vincent Jr. is the owner of Tacconelli's Pizzeria located at 27 W. Main Street, Maple Shade, NJ 08052 ("Tacconelli's New Jersey").

5. Defendant Sugarhouse HSP Gaming, L.P. (“Sugarhouse”) is a Delaware limited liability company with a principal place of business at 1001 N. Delaware Avenue, Philadelphia, Pennsylvania.

6. This Court has personal jurisdiction over Defendants because Vincent Tacconelli, Jr.’s residence is within 100 miles from the District Courthouse, Tacconelli’s Empire’s principal place of business is within 100 miles from the District Courthouse, and Sugarhouse’s principal place of business is within the District.

BACKGROUND

7. Plaintiff John Tacconelli is the current owner of Tacconelli’s Pizzeria, located at 2604 East Somerset Street, Philadelphia, Pennsylvania (Original Tacconelli’s).

8. John, his parents, and his grandparents have invested decades and a substantial amount of money in creating, developing, and promoting the Original Tacconelli’s, and the professional quality of its goods and services, and John Tacconelli continues to spend substantial amounts of time and money in the promotion of same.

9. The mark TACCONELLI’S PIZZERIA has been in continuous use at the Original Tacconelli’s for over seventy years since 1946.

10. John, his parents, and his grandparents have created secondary meaning and brand recognition since 1946 around their pizza and tomato pies uniquely cooked in their custom-designed brick oven to give their pizzas and tomato pies a crisp light taste. The Original Tacconelli’s pizza and tomato pies have received numerous awards and accolades, including “Best in Philly.” The Original Tacconelli’s was also named by *Food and Wine Magazine* as one of the top pizza places in the United States.

11. Vincent Jr. never owned the Original Tacconelli's. Though Vincent Jr. paid rent for the right to operate the Original Tacconelli's from 1998 to 2002, only five years out of the more than seventy years of continuous operation, his parents, Barbara Tacconelli ("Barbara") and Vincent Tacconelli, Sr. ("Vincent Sr.") owned the business.

12. During the five year period from 1998 to 2002 when Vincent Jr. operated the Original Tacconelli's, he was required to remit rent to his parents for the business.

13. At the end of 2002, suddenly, and with little notice, Vincent Jr. left the Original Tacconelli's. Vincent Sr. and Barbara were forced to come out of retirement to operate the Original Tacconelli's after Vincent Jr. left.

14. Vincent Jr. has not returned to the Original Tacconelli's since he ceased renting the business from his parents in 2002. Vincent Jr. abandoned the Original Tacconelli's as of the time he left in December 2002.

15. From the time Vincent Jr. left the Original Tacconelli's he made no more payments to his parents for rent for the business.

16. From the time Vincent Jr. left the Original Tacconelli's, no revenue ever appeared on his tax returns nor were there deductions of expenses from the Original Tacconelli's.

17. Shortly before leaving the Original Tacconelli's, Vincent Jr., in June 2002, after having rented the business from his parents for four and half years, and just six months before he left, sought federal registration for the servicemark TACCONELLI'S PIZZERIA with the USPTO.

18. At the time the application was filed with the USPTO, Vincent Jr.'s father and mother, Vincent Sr. and Barbara owned the Original Tacconelli's.

19. In applying for federal registration of the mark, Vincent Jr. knowingly made false statements and/or concealed the truth as to material facts in connection with his application for the servicemark TACCONELLI'S PIZZERIA with the intent to deceive the USPTO. Vincent Jr.'s Application and Declaration, attached hereto as Exhibit 1 ("Original Application").

20. Vincent Jr. knew at the time he sought to register the servicemark that he did not own the Original Tacconelli's, which was at all material times owned by his parents, Vincent Sr. and Barbara Tacconelli, and then by John.

21. Nonetheless, Vincent Jr. falsely declared and/or concealed the truth, with an intent to deceive the USPTO, that he was the true owner of the Original Tacconelli's, and/or the TACCONELLI'S PIZZERIA mark. Ex. 1.

22. Vincent Jr. also falsely declared and/or concealed the truth, with an intent to deceive the USPTO, that he was authorized to seek registration for the TACCONELLI'S PIZZERIA mark.

23. Vincent Jr., knowingly and falsely submitted as his own and/or concealed the truth, with an intent to deceive, a restaurant article on the best pizza in America, which describes his parents' Original Tacconelli's with images of his parents' oven and facility taken from an article in *Expedia Travel* magazine, and also, knowingly and falsely submitted as his own and/or concealed the truth, with an intent to deceive, his parents' Original Tacconelli's "Best in Philly" award. Ex. 1.

24. Vincent Jr. also falsely claimed to the USPTO and/or concealed the truth, with an intent to deceive, that he possessed rights in the TACCONELLI'S PIZZERIA mark based on the use of the mark in interstate commerce since as early as 1929. Ex. 1.

25. However, Vincent Jr. knew these statements to be false and intentionally misrepresented and/or concealed the truth, with an intent to deceive the USPTO, as he possessed no ownership interest in the Original Tacconelli's and could not claim the benefit of any prior or current use of the TACCONELLI'S PIZZERIA mark in connection with the operation of that business.

26. Vincent Jr. also intentionally misrepresented to the USPTO and/or concealed the truth, with an intent to deceive, that no one else had a right to use the TACCONELLI'S PIZZERIA mark in commerce. At the time Vincent Jr. made such declaration to the USPTO, he knew that his parents, Vincent Sr. and Barbara, had a right to use the TACCONELLI'S PIZZERIA mark.

27. Vincent Jr. identified his home address for all correspondence from the USPTO, rather than the business address of the Original Tacconelli's so that he could conceal from his parents, the owners of the Original Tacconelli's, that he had applied for a federal servicemark.

28. On or about August 30, 2002, the USPTO issued an Office Action, refusing to register the TACCONELLI'S PIZZERIA mark because the mark was merely a surname. Office Action, attached hereto as Exhibit 2.

29. In response to the Office Action, on or about September 30, 2002, Vincent Jr. asserted that the mark had acquired distinctive recognition beyond its surname. Supplemental Declaration, attached hereto as Exhibit 3.

30. Vincent Jr. concealed his departure from the Original Tacconelli's in December 2002 from the USPTO with an intent to deceive. Specifically, he never advised the USPTO that he was no longer affiliated with the Original Tacconelli's. He further concealed the truth from

the USPTO, with an intent to deceive, that he was no longer using the TACCONELLI'S PIZZERIA mark in commerce after he left the Original Tacconelli's.

31. On or about March 4, 2003, Vincent Jr. formed Tacconelli's Pizzeria, LLC, a limited liability company registered under the laws of New Jersey. Vincent Jr. formed Tacconelli's Pizzeria, LLC to open and run a new pizzeria he intended on opening in New Jersey, which was to have no connection with the Original Tacconelli's.

32. On March 25, 2003, the USPTO issued Service Mark Registration No. 2,700,210 for the TACCONELLI'S PIZZERIA mark to Vincent Jr. Registration, attached hereto as Exhibit 4.

33. Vincent, Jr. knowingly failed to advise the USPTO that he intended to use the mark "TACCONELLI'S PIZZERIA" for his New Jersey pizzeria ("Tacconelli's New Jersey"), which had no connection or affiliation to the Original Tacconelli's and did not open until July of 2003.

34. On or about August 11, 2008, Vincent Jr. knowingly, and with an intent to deceive, made false statements as to material facts to and/or concealed the truth from the USPTO in conjunction with the 2008 Combined Declaration of Use and Incontestability (Sections 8 & 15) (the "2008 Combined Declaration"). Exhibit 5.

35. In the 2008 Combined Declaration, Vincent Jr., with intent to deceive, failed to correct the intentional falsehoods and concealments as set forth above in connection with his Original Application and Registration.

36. In the 2008 Combined Declaration, Vincent Jr. falsely claimed and/or concealed the truth from the USPTO, with an intent to deceive, that he continuously used the mark in commerce for five consecutive years after the date of registration. Vincent Jr. was not using the

mark in commerce as of the date of registration in March 2003. Tacconelli's New Jersey did not even open until later that year.

37. In the 2008 Combined Declaration, Vincent Jr. made a false statement as to a material fact and/or concealed the truth from the USPTO, with an intent to deceive, when he submitted to the USPTO a business card from Tacconelli's New Jersey as the specimen requirement.

38. In his Original Application and Supplemental Declaration, Vincent Jr. submitted evidence related to the Original Tacconelli's as evidence for the mark's use in commerce. Exhibits 1, 3. Additionally, in his communications with the USPTO in 2002, he described the mark's acquired distinctive recognition through its use at the Original Tacconelli's, which was then owned by his parents, Vincent Sr. and Barbara, and, in fact, was still owned by his parents at the time he submitted the 2008 Combined Declaration.

39. Absent from Vincent Jr.'s filing for the 2008 Combined Declaration was any mention of the Original Tacconelli's, despite the fact that, as set forth above, the prior specimens submitted during the application process in 2002 were representative of the Original Tacconelli's. Exhibit 5.

40. In his 2008 Combined Declaration, Vincent Jr. made no reference to the Original Tacconelli's in order to intentionally deceive the USPTO into believing that both restaurants (i.e., the Original Tacconelli's and Tacconelli's New Jersey) were one-in-the-same, which they were not then, and are not now.

41. On or about April 12, 2012, Vincent Jr. knowingly, and with an intent to deceive, made false statements as to material facts to and/or concealed the truth from the USPTO in

conjunction with the 2012 Combined Declaration of Use and/or Excusable Nonuse/Application for Renewal of Registration (Section 8 & 9) (the “2012 Combined Declaration”). Exhibit 6.

42. In the 2012 Combined Declaration, Vincent Jr., with intent to deceive, failed to correct the intentional falsehoods and concealments as set forth above in connection with his Original Application and Registration and the 2008 Combined Declaration.

43. In the 2012 Combined Declaration, Vincent Jr. made a false statement as to a material fact to the USPTO and/or concealed the truth from the USPTO, with an intent to deceive, when he submitted to the USPTO a website image of Tacconelli’s New Jersey as the specimen requirement.

44. In his original Application and Supplemental Declaration, Vincent Jr. submitted evidence related to the Original Tacconelli’s as evidence for the mark’s use in commerce. Exhibits 1, 3. Additionally, in his communications with the USPTO in 2002, he described the mark’s acquired distinctive recognition through its use at the Original Tacconelli’s, which was then owned by his parents, Vincent Sr. and Barbara, and in fact, was owned by his brother John at the time he submitted the 2012 Combined Declaration.

45. Absent from Vincent Jr.’s filing for the 2012 Combined Declaration was any mention of the Original Tacconelli’s, despite the fact that, as set forth above, the prior specimens submitted in his original Application and Supplemental Declaration were representative of the Original Tacconelli’s. Exhibit 6.

46. In his 2012 Combined Declaration, Vincent Jr. made no reference to the Original Tacconelli’s in order to intentionally deceive the USPTO into believing that both restaurants (i.e., the Original Tacconelli’s and Tacconelli’s New Jersey) were one-in-the-same, which they were not then, and are not now.

47. On or about August 24, 2015, Vincent Jr. purportedly assigned the TACCONELLI'S PIZZERIA mark to his own entity, Tacconelli's Empire.

48. On October 14, 2015, Tacconelli's Empire entered into a purported Restaurant Consulting Agreement with Sugarhouse, whereby Tacconelli's Empire purported to license the TACCONELLI'S PIZZERIA mark to Sugarhouse.

49. At the time Sugarhouse entered into the aforesaid agreement, Sugarhouse was aware of the Original Tacconelli's, but intentionally and in bad faith ignored the rights of John Tacconelli, the owner of the Original Tacconelli's, which is located less than two miles from the Sugarhouse Casino.

50. Sugarhouse has since been selling inferior pizzas under its purported licensing agreement with Tacconelli's Empire.

51. A purchaser of pizza sold by Sugarhouse under the TACCONELLI'S PIZZERIA mark attempted to return Sugarhouse's inferior pizza to the Original Tacconelli's under the mistaken belief that there is some affiliation between the Original Tacconelli's and Sugarhouse, of which there is none.

52. On or about July 11, 2016, John caused a cease and desist letter to be sent to Sugarhouse, advising Sugarhouse that its use of the mark was improper. July 11, 2016 letter, attached hereto as Exhibit 7.

53. By way of letter dated July 18, 2016, Sugarhouse advised John Tacconelli that, *inter alia*, it had every legal right to continue its business under the TACCONELLI'S PIZZERIA mark pursuant to the licensing agreement. July 18, 2016 letter from Sugarhouse, attached hereto as Exhibit 8.

54. In March 2017, after the Original Tacconelli's was awarded a place on *Food and Wine Magazine's* listing of the top Pizza Places in the United States, and while this this litigation was pending, Sugarhouse congratulated "Tacconelli Pizzeria for being named one of Food & Wine's Best Pizza Places in the U.S.," on Sugarhouse's Facebook page knowing full well that the accolade had been awarded to the Original Tacconelli's, and not to Vincent Jr. with whom it had entered into the purported licensing agreement.

COUNT I

**RECTIFY THE REGISTER WITH RESPECT TO SERVICE MARK
REGISTRATION NO. 2,700,210 DUE TO FRAUD OR, IN THE ALTERNATIVE,
CANCELLATION OF THE SERVICEMARK DUE TO FRAUD**

John Tacconelli v. Tacconelli's Empire, LLC and Vincent Tacconelli, Jr.

55. John incorporates by reference the preceding paragraphs 1 through 54, inclusive, as if fully set forth herein.

56. As set forth above, Vincent Jr. made fraudulent statements with an intent to deceive the USPTO in registering and in his filings for the mark "TACCONELLI'S PIZZERIA."

57. Accordingly, John seeks the register to be rectified with respect to Service Mark Registration No. 2,700,210, or in the alternative, that the mark be cancelled pursuant to 15 U.S.C. § 1064(3) because Vincent Jr. procured the registration, the 2008 Combined Declaration and the 2012 Combined Declaration by committing fraud on the USPTO.

58. Tacconelli's Empire and Vincent Jr. must be enjoined from using or attempting to license the mark "TACCONELLI'S PIZZERIA."

59. John has suffered irreparable harm and does not have an adequate remedy at law.

60. Tacconelli's Empire's and Vincent Jr.'s actions are intentional and willful, extreme and outrageous, warranting the imposition of treble and/or punitive damages.

61. Tacconelli's Empire's and Vincent Jr.'s actions warrant this being declared an exceptional case.

62. Accordingly, this Court should exercise its power under 15 U.S.C. § 1119 to rectify the register due to fraud, which would include, but not be limited to, changing ownership of the servicemark on the register, creating a constructive trust, or in the alternative, cancelling the registration due to fraud.

WHEREFORE, John Tacconelli respectfully requests judgment in his favor and demands that this Court rectify the register with respect to Service Mark Registration No. 2,700,210 due to fraud, or, in the alternative, cancel Service Mark Registration No. 2,700,210 pursuant to 15 U.S.C. § 1064(3) because the mark was procured by fraud on the United States Patent and Trademark Office. John Tacconelli further respectfully requests that Tacconelli's Empire, LLC and Vincent Tacconelli, Jr. be permanently enjoined from using or licensing the TACCONELLI'S PIZZERIA mark anywhere and everywhere that John Tacconelli possesses rights in that mark, including but not limited to enjoining Tacconelli's Empire, LLC and Vincent Tacconelli, Jr. from further authorizing the use of the TACCONELLI'S PIZZERIA mark, along with this case being declared exceptional, an award of treble and/or punitive damages, attorneys' fees, costs, interest and such other and further relief as permitted by law and/or which the Court may deem just and proper.

COUNT II

**RECTIFY THE REGISTER WITH RESPECT TO SERVICE MARK
REGISTRATION NO. 2,700,210 DUE TO FALSE SUGGESTION
OF A CONNECTION, OR, IN THE ALTERNATIVE, CANCELLATION OF THE
MARK DUE TO FALSE SUGGESTION OF A CONNECTION**

John Tacconelli v. Tacconelli's Empire, LLC and Vincent Tacconelli, Jr.

63. John incorporates by reference the preceding paragraphs 1 through 62, inclusive, as if fully set forth herein.

64. Vincent Jr.'s registration falsely suggests a connection with the Original Tacconelli's in that: (a) the mark TACCONELLI'S PIZZERIA is identical or at least a very close approximation of John's (and his parents' and grandparents') business, the Original Tacconelli's, which always has been known, and is still known, as "Tacconelli's Pizzeria," (b) the mark TACCONELLI'S PIZZERIA is recognized as such, in that it points uniquely and unmistakably to the Original Tacconelli's, (c) John and the Original Tacconelli's is not connected with the goods sold or the activities performed by Vincent Jr. and Tacconelli's Empire under the mark, and (d) the Original Tacconelli's is of sufficient fame or reputation that, when the TACCONELLI'S PIZZERIA mark is used on its goods or services, a connection with the Original Tacconelli's would be presumed.

65. Accordingly, John seeks the register to be rectified with respect to Service Mark Registration No. 2,700,210, or in the alternative, that the mark be cancelled pursuant to 15 U.S.C. § 1052(a) and 15 U.S.C. § 1064(3), because the mark TACCONELLI'S PIZZERIA falsely suggests a connection with the Original Tacconelli's, of which there is none.

66. Tacconelli's Empire and Vincent Tacconelli, Jr. must be enjoined from using or attempting to license the mark "TACCONELLI'S PIZZERIA."

67. John Tacconelli has suffered irreparable harm and does not have an adequate remedy at law.

68. Tacconelli's Empire's and Vincent Tacconelli, Jr.'s actions are intentional and willful, extreme and outrageous, warranting the imposition of treble and/or punitive damages.

69. Tacconelli's Empire's and Vincent Tacconelli, Jr.'s actions warrant this being declared an exceptional case.

70. Accordingly, this Court should exercise its power under 15 U.S.C. § 1119 to rectify the trademark register due to false suggestion of a connection, which would include, but not be limited to, changing ownership of the service mark on the register, creating a constructive trust, or in the alternative, canceling the registration due to false suggestion of a connection.

WHEREFORE, John Tacconelli respectfully requests judgment in his favor and demands that this Court rectify the register with respect to Service Mark Registration No. 2,700,210 because the mark falsely suggests a connection with Tacconelli's Pizzeria located at 2604 E. Somerset Street, Philadelphia, PA 19134, or, in the alternative, cancel Service Mark Registration No. 2,700,210 pursuant to 15 U.S.C. § 1052(a) and § 1064(3) for the aforesaid reason. John Tacconelli further respectfully requests that Tacconelli's Empire, LLC and Vincent Tacconelli, Jr. be permanently enjoined from using or licensing the TACCONELLI'S PIZZERIA mark anywhere and everywhere that John Tacconelli possesses rights in that mark, including but not limited to enjoining Tacconelli's Empire, LLC and Vincent Tacconelli, Jr. from further authorizing the use of the TACCONELLI'S PIZZERIA mark, along with this case being declared exceptional, and an award of treble and/or punitive damages, attorneys' fees, costs and such other and further relief as permitted by law and/or which the Court may deem just and proper.

COUNT III

DECLARATORY JUDGMENT

**John Tacconelli v. Tacconelli's Empire, LLC, Vincent Tacconelli, Jr. and
Sugarhouse HSP Gaming, L.L.C.**

71. John incorporates by reference the preceding paragraphs 1 through 70, inclusive, as if fully set forth herein.

72. Declaratory relief is appropriate pursuant to the Federal Declaratory Judgment Act, 28 U.S.C. §§ 2201-02, and this Court has the authority to declare the rights and obligations of John, Tacconelli's Empire, Vincent Jr. and Sugarhouse as there is an actual controversy over the validity of the Restaurant Consulting Agreement and the extent of John's rights to the use the mark.

73. As set forth above, Vincent Jr. and Tacconelli's Empire have no rights or interest in the TACCONELLI'S PIZZERIA mark as the mark was procured through fraud on the USPTO and/or by falsely suggesting a connection with the Original Tacconelli's, of which there is none.

74. Vincent Jr. and Tacconelli's Empire, therefore, had and have no right to license the TACCONELLI'S PIZZERIA mark and the Restaurant Consulting Agreement between Tacconelli's Empire and Sugarhouse is therefore void *ab initio* and unenforceable.

75. Vincent Jr. and Tacconelli's Empire also had and have no right to license the TACCONELLI'S PIZZERIA mark and enter into the Restaurant Consulting Agreement with Sugarhouse, thereby rendering that agreement void *ab initio* or unenforceable, because whatever rights Vincent Jr. and Tacconelli's Empire may possess, if any, are junior and subordinate to the rights of the mark's senior user, John.

76. Specifically, notwithstanding the federal registration, John owns and enjoys superior common law rights in the mark TACCONELLI'S PIZZERIA for use in conjunction

with providing goods/services as a restaurant pizzeria in the protected trading area of the Original Tacconelli's which existed at the time of federal registration of the mark.

77. Given the geographic proximity between the Original Tacconelli's and Sugarhouse, the Restaurant Consulting Agreement between Tacconelli's Empire and Sugarhouse is also void *ab initio* and unenforceable because Sugarhouse is located well within John's protected trading area as the senior user of the mark.

78. As Vincent Jr. and Tacconelli's Empire claim they are entitled to use the mark within the protected trading area of the Original Tacconelli's owned by John, John requests a determination of the extent of the protected trading area of the Original Tacconelli's.

79. An actual controversy exists regarding (1) the validity and enforceability of the Restaurant Consulting Agreement between Tacconelli's Empire and Sugarhouse by virtue of the filing of the First Amended Complaint and John's Amended Answer and Defenses to the allegations asserted therein; and (2) the extent of the protected trading area of the Original Tacconelli's, which is owned by John.

80. Tacconelli's Empire, Vincent Jr. and Sugarhouse must be enjoined from using or attempting to license the mark "TACCONELLI'S PIZZERIA."

81. John has suffered irreparable harm and does not have an adequate remedy at law.

82. Despite informing Sugarhouse that it has no rights to use the mark TACCONELLI'S PIZZERIA, Sugarhouse continues to use said mark and/or unauthorized reproductions, counterfeits, copies and colorable imitations of language nearly identical or at least a very close approximation.

83. Because Sugarhouse has done so after having been informed that it has no right to the use of said mark, Sugarhouse is continuing its conduct intentionally and deliberately and, further, with a specific intention to harm John.

84. Tacconelli's Empire's, Vincent Jr.'s and Sugarhouse's actions are intentional and willful, extreme and outrageous warranting the imposition of treble and/or punitive damages.

85. Tacconelli's Empire's, Vincent Jr.'s and Sugarhouse's actions warrant this being declared an exceptional case.

WHEREFORE, John Tacconelli respectfully requests judgment in his favor and demands a declaratory judgment that the Restaurant Consulting Agreement between Tacconelli's Empire, LLC and SugarHouse HSP Gaming, L.P. is void and unenforceable, and further respectfully requests that Tacconelli's Empire, LLC, Vincent Tacconelli, Jr. and Sugarhouse HSP Gaming, L.L.C. be permanently enjoined from using or licensing the TACCONELLI'S PIZZERIA mark anywhere and everywhere that John Tacconelli possesses rights in that mark, including but not limited to enjoining Tacconelli's Empire, LLC, Vincent Tacconelli, Jr. and Sugarhouse HSP Gaming, L.L.C. from further authorizing the use of the TACCONELLI'S PIZZERIA mark, along with this case being declared exceptional and an award of treble and/or punitive damages, attorneys' fees, costs, interest and such other and further relief as permitted by law and/or which the Court may deem just and proper.

COUNT IV

**DECLARATORY JUDGMENT THAT THE ASSIGNMENT OF SERVICE
MARK REGISTRATION NO. 2,700,210 IS INVALID UNDER 15 U.S.C. §
1060 AND THAT TACCONELLI'S EMPIRE, LLC HAS NO RIGHTS IN
THE MARK OR STANDING TO SUE JOHN TACCONELLI FOR
DECLARATORY RELIEF.**

John Tacconelli v. Tacconelli's Empire, LLC and John Tacconelli, Jr.

86. John incorporates by reference the preceding paragraphs 1 through 85, inclusive, as if fully set forth herein.

87. Declaratory relief is appropriate pursuant to the Federal Declaratory Judgment Act, 28 U.S.C. §§ 2201-02 and this Court has the authority to declare the rights of Tacconelli's Empire under the Assignment of Trademark.

88. Vincent Jr.'s assignment of Service Mark No. 2,700,210 is invalid under 15 U.S.C. § 1060 because Vincent Jr. did not assign to Tacconelli's Empire any assets or goodwill of the business connected with the use of and symbolized by the mark.

89. Although the Assignment of Trademark nominally states that Vincent Jr. transferred Service Mark No. 2,700,210 and all rights and goodwill attaching thereto to Tacconelli's Empire, Vincent Jr. did not, in fact, assign to Tacconelli's Empire any assets or goodwill of the business connected with the use of and symbolized by the mark "TACCONELLI'S PIZZERIA."

90. Tacconelli's Empire therefore has no rights in Service Mark No. 2,700,210 or standing to sue John for declaratory judgment.

91. An actual controversy exists regarding the validity and enforceability of the Assignment between Vincent Jr. and Tacconelli's Empire given their claim that they can use the mark "TACCONELLI'S PIZZERIA" anywhere they choose.

92. Tacconelli's Empire must be enjoined from using or attempting to license the mark "TACCONELLI'S PIZZERIA."

93. John has suffered irreparable harm and does not have an adequate remedy at law.

94. Tacconelli's Empire's actions are intentional and willful, extreme and outrageous, warranting the imposition of treble and/or punitive damages.

95. Tacconelli's Empire's actions warrant this being declared an exceptional case.

WHEREFORE, John Tacconelli respectfully requests judgment in his favor and demands a declaratory judgment that the Assignment of Trademark between Vincent Tacconelli, Jr. and Tacconelli's Empire, LLC is void and unenforceable, and further respectfully requests that Tacconelli's Empire, LLC be permanently enjoined from using or licensing the TACCONELLI'S PIZZERIA mark anywhere and everywhere that John Tacconelli possesses rights in that mark, including but not limited to enjoining Tacconelli's Empire, LLC from further authorizing the use of the TACCONELLI'S PIZZERIA mark, along with this case being declared exceptional and an award of treble and/or punitive damages, attorneys' fees, costs and such other and further relief as permitted by law and/or which the Court may deem just and proper.

COUNT V

COMMON LAW INFRINGEMENT

**John Tacconelli v. Tacconelli's Empire, LLC, Vincent Tacconelli, Jr. and
Sugarhouse HSP Gaming, L.P.**

96. John incorporates by reference the preceding paragraphs 1 through 95, inclusive, as if fully set forth herein.

97. John owns and enjoys common law rights in the mark TACCONELLI'S PIZZERIA for use in conjunction with providing goods/services as a restaurant pizzeria.

98. Inherently, and as the result of John's and his parents' and grandparents' continuous use, sales, advertising and promotion of the TACCONELLI'S PIZZERIA mark, the TACCONELLI'S PIZZERIA mark has obtained secondary meaning, acquired strong commercial distinctiveness and symbolizes the business goodwill of John Tacconelli and the Original Tacconelli's.

99. Indeed, through John's and his parents' and grandparents' continuous use, sales, advertising and promotion of the TACCONELLI'S PIZZERIA mark, the TACCONELLI'S PIZZERIA mark enjoys widespread recognition and a famous reputation, and are recognized by the public as emanating from John and the Original Tacconelli's.

100. Sugarhouse's, Vincent Jr.'s and Tacconelli's Empire's unauthorized use of the mark TACCONELLI'S PIZZERIA for the purpose of promoting and soliciting business for themselves is likely to cause confusion, mistake and deception in the minds of the public and is likely to cause the public to mistakenly believe that the services and solicitations offered by Sugarhouse, Vincent Jr. and Tacconelli's Empire originate from, are sponsored by, or is in some way associated with John and the services he provides at the Original Tacconelli's.

101. Sugarhouse, Vincent Jr. and Tacconelli's Empire have engaged in trademark infringement at common law.

102. Sugarhouse, Vincent Jr. and Tacconelli's Empire have earned revenue as a direct and proximate result of using the mark Tacconelli's Pizzeria, which revenue must be disgorged and awarded to John as damages.

103. John has been, and continues to suffer irreparable harm to his valuable TACCONELLI'S PIZZERIA mark, his and the Original Tacconelli's reputation, and other damages in an amount to be proven at trial.

104. Unless Sugarhouse, Vincent Jr. and Tacconelli's Empire are restrained from further infringement, use and licensing of the TACCONELLI'S PIZZERIA mark, John will continue to be irreparably harmed.

105. John does not have an adequate remedy at law.

106. Furthermore, Tacconelli's Empire, Vincent Jr. and Sugarhouse's infringement of John's mark TACCONELLI'S PIZZERIA is willful and committed with knowledge of such infringement and in bad faith.

107. Tacconelli's Empire's, Vincent Tacconelli, Jr.'s and Sugarhouse's actions are intentional and willful, extreme and outrageous, warranting the imposition of treble and/or punitive damages.

108. Tacconelli's Empire's, Vincent Jr.'s and Sugarhouse's actions warrant this being declared an exceptional case.

WHEREFORE, John Tacconelli respectfully requests judgment in his favor and against Tacconelli's Empire, LLC, Vincent Tacconelli, Jr. and Sugarhouse HSP Gaming, L.P., along with this case being declared exceptional and an award of treble and/or punitive damages, attorneys' fees, costs, interest and such other and further relief as the Court may deem just and proper. John Tacconelli further respectfully requests that Tacconelli's Empire, LLC, Vincent Tacconelli, Jr. and Sugarhouse HSP Gaming, L.P. be permanently enjoined from using or licensing the TACCONELLI'S PIZZERIA mark anywhere and everywhere that John Tacconelli possesses rights in that mark, including but not limited to enjoining Tacconelli's Empire, LLC, Vincent Tacconelli, Jr. and Sugarhouse HSP Gaming, L.P. from further authorizing the use of the TACCONELLI'S PIZZERIA mark.

COUNT VI

UNFAIR COMPETITION UNDER 15 U.S.C. § 1125

**John Tacconelli v. Tacconelli's Empire, LLC, Vincent Tacconelli, Jr. and
Sugarhouse HSP Gaming, L.P.**

109. John incorporates by reference the preceding paragraphs 1 through 108, inclusive, as if fully set forth herein.

110. John owns and enjoys common law rights in the mark TACCONELLI'S PIZZERIA for use in conjunction with providing goods/services as a restaurant pizzeria.

111. Inherently, and as the result of John's and his parents' and grandparents' continuous use, sales, advertising and promotion of the TACCONELLI'S PIZZERIA mark, the TACCONELLI'S PIZZERIA mark has obtained secondary meaning, acquired strong commercial distinctiveness and symbolizes the business goodwill of John and the Original Tacconelli's.

112. Indeed, through John's and his parents' and grandparents' continuous use, sales, advertising and promotion of the TACCONELLI'S PIZZERIA mark, the TACCONELLI'S PIZZERIA mark enjoys widespread recognition and a famous reputation, and is recognized by the public as emanating from John and the Original Tacconelli's.

113. Sugarhouse, Vincent Jr. and/or Tacconelli's Empire have knowingly used and continue to use the mark "TACCONELLI'S PIZZERIA" in commerce, and in connection with the services that Sugarhouse, Vincent Jr. and/or Tacconelli's Empire offer, advertise, promote and sell.

114. Sugarhouse's, Vincent Jr.'s and Tacconelli's Empire's unauthorized use of the mark TACCONELLI'S PIZZERIA for the purpose of promoting and soliciting business for themselves is likely to cause confusion, mistake and deception in the minds of the public and is

likely to cause the public to mistakenly believe that the services and solicitations offered by Sugarhouse, Vincent Jr. and/or Tacconelli's Empire originate from, are sponsored by, or is in some way associated with John and the services he provides at the Original Tacconelli's.

115. Sugarhouse, Vincent Jr. and Tacconelli's Empire have therefore engaged in unfair competition under 15 U.S.C. § 1125(a).

116. Sugarhouse, Vincent Jr. and Tacconelli's Empire have earned revenue as a direct and proximate result of using the mark Tacconelli's Pizzeria, which revenue must be disgorged and awarded to John as damages.

117. As a direct and proximate result of the foregoing, John has been, and continues to suffer irreparable harm to his valuable TACCONELLI'S PIZZERIA mark, his and the Original Tacconelli's reputation, and other damages in an amount to be proven at trial.

118. Unless Tacconelli's Empire, Vincent Jr. and Sugarhouse are restrained from further unfair competition, John will continue to be irreparably harmed.

119. John does not have an adequate remedy at law.

120. Tacconelli's Empire's, Vincent Jr.'s and Sugarhouse's actions are intentional and willful, extreme and outrageous, warranting the imposition of treble and/or punitive damages.

121. Tacconelli's Empire's, Vincent Jr.'s and Sugarhouse's actions warrant this being declared an exceptional case.

122. Tacconelli's Empire's, Vincent Jr.'s and Sugarhouse's actions were knowing and intentional and thus render this case exceptional within the meaning of 15 U.S.C. § 1117(a).

WHEREFORE, John Tacconelli respectfully requests judgment in his favor and against Tacconelli's Empire, LLC, Vincent Tacconelli, Jr. and Sugarhouse HSP Gaming, L.P., along with this case being declared exceptional and an award of treble and/or punitive damages,

attorneys' fees, costs, interest and such other and further relief as the Court may deem just and proper. John Tacconelli further respectfully requests that Tacconelli's Empire, LLC, Vincent Tacconelli, Jr. and Sugarhouse HSP Gaming, L.P. be permanently enjoined from using or licensing the TACCONELLI'S PIZZERIA mark anywhere and everywhere that John Tacconelli possesses rights in that mark, including but not limited to enjoining Tacconelli's Empire, LLC, Vincent Tacconelli, Jr. and Sugarhouse HSP Gaming, L.P. from further authorizing the use of the TACCONELLI'S PIZZERIA mark.

COUNT VII

COMMON LAW UNFAIR COMPETITION

John Tacconelli v. Tacconelli's Empire, LLC, Vincent Tacconelli, Jr. and Sugarhouse HSP Gaming, L.P.

123. John incorporates by reference the preceding paragraphs 1 through 122, inclusive, as if fully set forth herein.

124. John owns and enjoys common law rights in the mark TACCONELLI'S PIZZERIA for use in conjunction with providing goods/services as a restaurant pizzeria.

125. Inherently, and as the result of John's and his parents' and grandparents' continuous use, sales, advertising and promotion of the TACCONELLI'S PIZZERIA mark, the TACCONELLI'S PIZZERIA mark has obtained secondary meaning, acquired strong commercial distinctiveness and symbolizes the business goodwill of John and the Original Tacconelli's.

126. Indeed, through John's and his parents' and grandparents' continuous use, sales, advertising and promotion of the TACCONELLI'S PIZZERIA mark, the TACCONELLI'S PIZZERIA mark enjoys widespread recognition and a famous reputation, and are recognized by the public as emanating from John and the Original Tacconelli's.

127. Sugarhouse, Vincent Jr. and/or Tacconelli's Empire have knowingly used and continue to use the mark "TACCONELLI'S PIZZERIA" in commerce, and in connection with the services that Sugarhouse, Vincent Jr. and/or Tacconelli's Empire offer, advertise, promote and sell.

128. Sugarhouse, Vincent Jr. and/or Tacconelli's Empire's unauthorized use of the mark "TACCONELLI'S PIZZERIA" for the purpose of promoting and soliciting business for themselves is likely to cause confusion, mistake and deception in the minds of the public and is likely to cause the public to mistakenly believe that the services and solicitations offered by Sugarhouse, Vincent Jr. and/or Tacconelli's Empire originate from, are sponsored by, or is in some way associated with John and the services he provides at the Original Tacconelli's.

129. Sugarhouse's, Vincent, Jr.'s and/or Tacconelli's Empire's use of the TACCONELLI'S PIZZERIA mark is unauthorized and therefore constitutes unfair competition at common law.

130. Sugarhouse, Vincent Jr. and Tacconelli's Empire have earned revenue as a direct and proximate result of using the mark Tacconelli's Pizzeria, which revenue must be disgorged and awarded to John as damages.

131. As a direct and proximate result of the foregoing, John has been, and continues to suffer irreparable harm to his valuable TACCONELLI'S PIZZERIA mark, his and the Original Tacconelli's reputation, and other damages in an amount to be proven at trial.

132. Unless Tacconelli's Empire, Vincent Jr. and Sugarhouse are restrained from further unfair competition, John will continue to be irreparably harmed.

133. John does not have an adequate remedy at law.

134. Tacconelli's Empire's, Vincent Jr.'s and Sugarhouse's actions are intentional and willful, extreme and outrageous, warranting the imposition of treble and/or punitive damages.

WHEREFORE, John Tacconelli respectfully request judgment in his favor and against Tacconelli's Empire, LLC, Vincent Tacconelli, Jr. and Sugarhouse HSP Gaming, L.P., along with this case being declared exceptional and an award of treble and/or punitive damages, attorneys' fees, costs, interest and such other and further relief as the Court may deem just and proper. John Tacconelli further respectfully requests that Tacconelli's Empire, LLC, Vincent Tacconelli, Jr. and Sugarhouse HSP Gaming, L.P. be permanently enjoined from using or licensing the TACCONELLI'S PIZZERIA mark anywhere and everywhere that John Tacconelli possesses rights in that mark, including but not limited to enjoining Tacconelli's Empire, LLC, Vincent Tacconelli, Jr. and Sugarhouse HSP Gaming, L.P. from further authorizing the use of the TACCONELLI'S PIZZERIA mark.

COUNT VIII

TRADEMARK DILUTION UNDER 15 PA.C.S.A. § 1124 AND COMMON LAW TRADEMARK DILUTION

John Tacconelli v. Tacconelli's Empire, LLC, Vincent Tacconelli, Jr. and Sugarhouse HSP Gaming, L.P.

135. John incorporates by reference the preceding paragraphs 1 through 134, inclusive, as if fully set forth herein.

136. Through prominent, long and continuous use in commerce, including commerce within Philadelphia and the surrounding areas, John's and his parents' and grandparents' use of the TACCONELLI'S PIZZERIA mark has achieved secondary meaning and has become, and continues to become, famous and distinctive.

137. Long after John and his parents' TACCONELLI'S PIZZERIA mark became famous, Sugarhouse, Vincent Jr. and Tacconelli's Empire, without authorization, used unauthorized reproductions, counterfeits, copies and colorable imitations of John's mark TACCONELLI'S PIZZERIA.

138. Sugarhouse's, Vincent Jr.'s and/or Tacconelli's Empire's unauthorized use of John's mark TACCONELLI'S PIZZERIA dilutes and/or is likely to dilute the distinctive quality of John's mark TACCONELLI'S PIZZERIA under 54 Pa. Stat. Ann. § 1124 and at common law.

139. The continued use lessens the capacity of the mark to identify and distinguish the services of John and the Original Tacconelli's.

140. As a direct and proximate result of the foregoing, John has been, and continues to be, injured and continues to suffer irreparable harm to his valuable TACCONELLI'S PIZZERIA mark and other damages in an amount to be proven at trial.

141. Unless Tacconelli's Empire, Vincent Jr. and Sugarhouse are enjoined, the valuable TACCONELLI'S PIZZERIA mark will continue to be irreparably harmed and John will continue to suffer a likelihood of dilution.

142. John does not have an adequate remedy at law.

143. Tacconelli's Empire's, Vincent Jr.'s and Sugarhouse's actions are intentional and willful, extreme and outrageous, warranting the imposition of treble and/or punitive damages.

WHEREFORE, John Tacconelli respectfully requests judgment in his favor and against Tacconelli's Empire, LLC, Vincent Tacconelli, Jr. and Sugarhouse HSP Gaming, L.P., along with this case being declared exceptional and an award of treble and/or punitive damages, attorneys' fees, costs, interest and such other and further relief as the Court may deem just and

proper. John Tacconelli further respectfully requests that Tacconelli's Empire, LLC, Vincent Tacconelli, Jr. and Sugarhouse HSP Gaming, L.P. be permanently enjoined from using or licensing the TACCONELLI'S PIZZERIA mark anywhere and everywhere that John Tacconelli possesses rights in that mark, including but not limited to enjoining Tacconelli's Empire, LLC, Vincent Tacconelli, Jr. and Sugarhouse HSP Gaming, L.P. from further authorizing the use of the TACCONELLI'S PIZZERIA mark.

COUNT IX

UNJUST ENRICHMENT

John Tacconelli v. Tacconelli's Empire, LLC, Vincent Tacconelli, Jr. and Sugarhouse HSP Gaming, L.P.

144. John incorporates by reference the preceding paragraphs 1 through 143, inclusive, as if fully set forth herein.

145. Sugarhouse, Vincent Jr. and Tacconelli's Empire wrongfully traded upon the goodwill of John's mark TACCONELLI'S PIZZERIA, and continue to do so.

146. John has obtained for his services a salability which Sugarhouse, Vincent Jr. and/or Tacconelli's Empire would not have otherwise had.

147. Sugarhouse, Vincent Jr. and/or Tacconelli's Empire willfully and deliberately infringed upon John's servicemark in order to gain an advantage in the marketplace.

148. Sugarhouse, Vincent Jr. and Tacconelli's Empire have earned revenue as a direct and proximate result of using the mark Tacconelli's Pizzeria, which revenue must be disgorged and awarded to John as damages.

149. Sugarhouse, Vincent Jr. and/or Tacconelli's Empire were unjustly enriched under common law as they were aware of and/or knowingly retained the proceeds or other benefits and

continued to trade on the goodwill of John's servicemark, TACCONELLI'S PIZZIA, and has thereby deprived John of revenue to which he is entitled.

WHEREFORE, John Tacconelli respectfully requests judgment in his favor and against Tacconelli's Empire, LLC, Vincent Tacconelli, Jr. and Sugarhouse HSP Gaming, L.P. along with costs, interest and such other and further relief as permitted by law and/or which the Court may deem just and proper.

COUNT X

INJUNCTIVE RELIEF

**John Tacconelli v. Tacconelli's Empire, LLC, Vincent Tacconelli, Jr. and
Sugarhouse HSP Gaming, L.P.**

150. John incorporates by reference the preceding paragraphs 1 through 149, inclusive, as if fully set forth herein.

151. As Vincent Jr., Tacconelli's Empire and Sugarhouse claim they are entitled to use the mark within the protected trading area of the Original Tacconelli's owned by John, John requests that Vincent Jr., Tacconelli's Empire and Sugarhouse be enjoined from utilizing the mark TACCONELLI'S PIZZERIA within the protected trading area of the Original Tacconelli's.

152. John requests a determination of the extent of the protected trading area of the Original Tacconelli's.

153. By reason for the foregoing, unless Tacconelli's Empire, Vincent Jr. and Sugarhouse are enjoined, the valuable TACCONELLI'S PIZZERIA mark, John will continue to be irreparably harmed.

154. John does not have an adequate remedy at law.

WHEREFORE, John Tacconelli respectfully requests judgment in his favor and against Tacconelli's Empire, LLC, Vincent Tacconelli, Jr. and Sugarhouse HSP Gaming, L.P. and that

Taconelli's Empire, LLC Vincent Tacconelli, Jr. and Sugarhouse HSP Gaming, L.P. be permanently enjoined from using or licensing the TACCONELLI'S PIZZERIA mark anywhere and everywhere that John Tacconelli possesses rights in that mark, including but not limited to enjoining Tacconelli's Empire, LLC from further authorizing the use of the TACCONELLI'S PIZZERIA mark.

Respectfully Submitted,

OBERMAYER REBMANN MAXWELL & HIPPEL LLP

By: /s/ Gary M. Samms
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John Tacconelli

Dated:

Exhibit 1

Exhibit 1

**FLAMM,
BOROFF
& BACINE, PC**

ATTORNEYS AT LAW

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ADMITTED TO PRACTICE IN PA, FL & DC

LLM IN TAXATION & LLM IN TRIAL ADVOCACY

CERTIFIED PUBLIC ACCOUNTANT

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June 27, 2002

Assistant Commissioner for Trademarks
Box New App/Fee
2900 Crystal Drive
Arlington, VA 22202-3513

RE: Vincent Tacconelli
Trademark: Tacconelli's Pizzeria

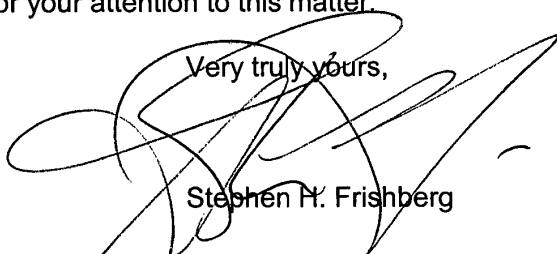
Dear Sir/Madam:

Enclosed herewith please find a Trademark Application for Tacconelli's Pizzeria along with a check in the amount of Three Hundred and Twenty-five Dollars (\$325.00) representing the Application Fee. Please be advised that I have enclosed three (3) copies of the use of the proposed trademark.

Please send all relevant information to my attention at the above listed address in Blue Bell, Pennsylvania.

Thank you for your attention to this matter.

Very truly yours,


Stephen H. Frishberg

SHF:mg

Enclosures

Cc: Vincent Tacconelli

TRADEMARK/SERVICE MARK APPLICATION, PRINCIPAL REGISTER, WITH DECLARATION	MARK (Word(s) and/or Design) Tacconelli's Pizzeria	CLASS NO. (If known)
TO THE ASSISTANT COMMISSIONER FOR TRADEMARKS:		
APPLICANT'S NAME: Vincent Tacconelli		
APPLICANT'S MAILING ADDRESS: 15 Woodbine Avenue (Display address exactly as it should appear on registration) Maple Shade, NJ 08052		
APPLICANT'S ENTITY TYPE: (Check one and supply requested information)		
X	Individual - Citizen of (Country): U.S.A.	
	Partnership - State where organized (Country, if appropriate): _____ Names and Citizenship (Country) of General Partners: _____	
	Corporation - State (Country, if appropriate) of Incorporation: _____	
	Other (Specify Nature of Entity and Domicile): _____	
GOODS AND/OR SERVICES:		
Applicant requests registration of the trademark/service mark shown in the accompanying drawing in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. 1051 et. seq., as amended) for the following goods/services (SPECIFIC GOODS AND/OR SERVICES MUST BE INSERTED HERE): S043 - Restaurant - Pizzeria		
BASIS FOR APPLICATION: (Check boxes which apply, but never both the first AND second boxes, and supply requested information related to each box checked.)		
<input checked="" type="checkbox"/>	Applicant is using the mark in commerce on or in connection with the above identified goods/services. (15 U.S.C. 1051(a), as amended.) Three specimens showing the mark as used in commerce are submitted with this application. <ul style="list-style-type: none"> • Date of first use of the mark in commerce which the U.S. Congress may regulate (for example, interstate or between the U.S. and a foreign country): 1929 • Specify the type of commerce: Interstate (for example, interstate or between the U.S. and a specified foreign country) • Date of first use anywhere (the same as or before use in commerce date): 1929 • Specify intended manner or mode of use of mark on or in connection with the goods/services: Restaurant - Pizzeria (for example, trademark is applied to labels, service mark is used in advertisements) 	
<input type="checkbox"/>	Applicant has a bona fide intention to use the mark in commerce on or in connection with the above identified goods/services. (15 U.S.C. 1051(b), as amended.) <ul style="list-style-type: none"> • Specify manner or mode of use of mark on or in connection with the goods/services: _____ (for example, trademark will be applied to labels, service mark will be used in advertisements) 	
<input type="checkbox"/>	Applicant has a bona fide intention to use the mark in commerce on or in connection with the above identified goods/services, and asserts a claim of priority based upon a foreign application in accordance with 15 U.S.C. 1126(d), as amended. <ul style="list-style-type: none"> • Country of foreign filing: _____ • Date of foreign filing: _____ 	
<input type="checkbox"/>	Applicant has a bona fide intention to use the mark in commerce on or in connection with the above identified goods/services and, accompanying this application, submits a certification or certified copy of a foreign registration in accordance with 15 U.S.C 1126(e), as amended <ul style="list-style-type: none"> • Country of registration: _____ • Registration number: _____ 	
NOTE: Declaration, on Reverse Side, MUST be Signed		

DECLARATION

The undersigned being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or if the application is being filed under 15 U.S.C. 1051(b), he/she believes the applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the above identified mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true and that all statements made on information and belief are believed to be true.

DATE

6-4-02

SIGNATURE

Vincent Tacconelli

215/425-4983

TELEPHONE NUMBER

Vincent Tacconelli

PRINT OR TYPE NAME AND POSITION

INSTRUCTIONS AND INFORMATION FOR APPLICANT

TO RECEIVE A FILING DATE, THE APPLICATION MUST BE COMPLETED AND SIGNED BY THE APPLICANT AND SUBMITTED ALONG WITH:

1. The prescribed **FEE** (~~\$325.00~~) for each class of goods/services listed in the application;
2. A **DRAWING PAGE** displaying the mark in conformance with 37 CFR 2.52;
3. If the application is based on use of the mark in commerce, **THREE (3) SPECIMENS** (evidence) of the mark as used in commerce for each class of goods/services listed in the application. All three specimens may be the same. Examples of good specimens include: (a) labels showing the mark which are placed on the goods; (b) photographs of the mark as it appears on the goods, (c) brochures or advertisements showing the mark as used in connection with the services.
4. An **APPLICATION WITH DECLARATION** (this form) - The application must be signed in order for the application to receive a filing date. Only the following persons may sign the declaration, depending on the applicant's legal entity: (a) the individual applicant; (b) an officer of the corporate applicant; (c) one general partner of a partnership applicant; (d) all joint applicants.

SEND APPLICATION FORM, DRAWING PAGE, FEE, AND SPECIMENS (IF APPROPRIATE) TO:

**Assistant Commissioner for Trademarks
Box New App/Fee
2900 Crystal Drive
Arlington, VA 22202-3513**

Additional information concerning the requirements for filing an application is available in a booklet entitled **Basic Facts About Registering a Trademark**, which may be obtained by writing to the above address or by calling: (703) 308-HELP.

This form is estimated to take an average of 1 hour to complete, including time required for reading and understanding instructions, gathering necessary information, recordkeeping, and actually providing the information. Any comments on this form, including the amount of time required to complete this form, should be sent to the Office of Management and Organization, U.S. Patent and Trademark Office, U.S. Department of Commerce, Washington, D.C. 20231. Do NOT send completed forms to this address.



07-01-2002

U.S. Patent & TMOtc/TM Mail Rcpt Dt. #64

VINCENT TACCONELLI

DRAWING PAGE:

TACCONELLI'S PIZZERIA

U.S. Patent & TMOtc/TM



76426632

WELCOME TO TACCONELLI'S PIZZERIA

(A Little History)

In 1918 Giovanni Tacconelli came to Philadelphia from Italy. After a few years working as a laborer, he decided to do what he had done in his native Italy. "Bake Bread". The best and only way, he said, was to bake it in a brick oven. So along with a few of his friends he built his 20' by 20' brick oven. The bread business went well until the outbreak of World War II when all of his sons who had helped him in the business were drafted into military service. Having no one to help and since the bread business was so very time consuming, he stopped baking bread.

In 1946, still having the brick oven, Giovanni pondered over what to do with it since everyone had come home from the War and had different careers in mind. He decided to make tomato pies, something that his mother had taught him to do many years before. They were and still are tomato pies to our family consisting of fresh made dough, little cheese and a lot of sauce cooked in our brick oven to give it a crisp light taste.

In 1992, we realized that our oven, which had given us 72 years of service, needed a face-lift. We never thought that what was supposed to be a 3 month "project" would turn out to be a 7 month "nightmare". Thanks to your loyal patronage The Tacconelli family, now in its 5th generation, is still baking tomato pies the Giovanni Tacconelli way.

(Please keep in mind we are a one-man, one-oven operation. Waiting time may vary. Please be assured each pie is made fresh and to order.)

MENU

- *Tomato pie consists of no cheese and a lot of sauce*
- *Regular pie consists of little cheese and sauce*
- *White pie consists of salt, black pepper, cheese and plenty of garlic*

Toppings include:

Spinach, Whole Tomatoes, Mushrooms, Pepperoni, Sausage, Sweet Peppers, Anchovies, Onions, Prosciutto, Basil, Black Olives, and Extra Cheese

You may wish to order all of one topping on a pie or half and half. We do not suggest more than three toppings on a pizza.

- ***Beverages are Coke, Diet Coke, Sprite, Dr. Pepper, Cream Soda, Root Beer and Iced Tea.***
- ***You are welcome to bring beer and wine only!***

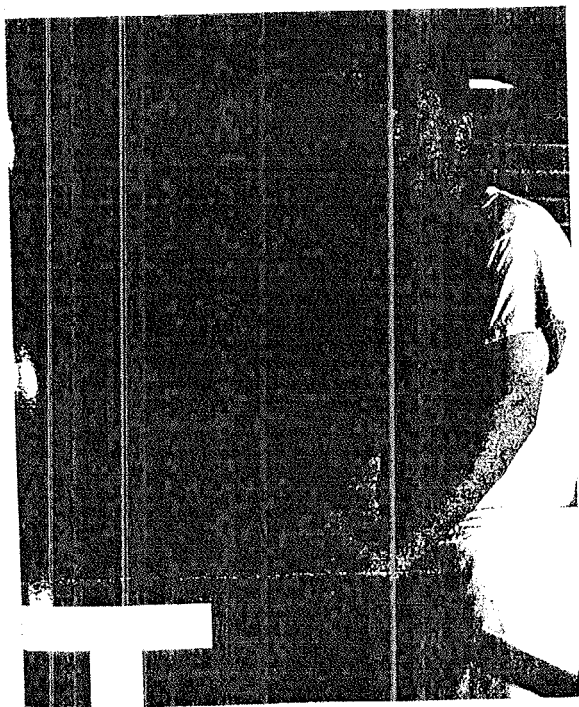
PLEASE NOTE: *Since your pies have been reserved for you, we kindly ask that you take what you have reserved. Thank you and enjoy.*

Well-behaved children are always welcome!

matters of taste

Rounds of Applause

AN HOMAGE TO THE BEST PIZZA PIE IN AMERICA BY DAVID ROSENGARTEN



Vince Tacconelli (left), the pizza maker at Tacconelli's, stands before the 1918 brick oven that gives the pies such marvelous flavor and texture. The Tacconelli's pizza reaches its zenith in the "white pie" (above), this one topped with sautéed spinach and chunks of tomato.

THERE IS A DEEP RELATIONSHIP IN AMERICA BETWEEN pizza and local pride. New Yorkers take it as an article of faith that their chewy, gooey, 18-inch neighborhood pie is the gold standard. Chicagoans, on the other hand, are dogmatic about their deep-dish pie, so thick, so obviously superior. For Californians, size and shape are not as important as star billing. Why settle for the rudimentary old toppings used back East when duck confit, avocado, and smoked salmon can transform a pie into a glamorous designer pizza?

So let me, an obsessive pizzaphile, a restless sampler of the holy dough-tomato sauce-mozzarella trinity wherever I go (and no matter what three-star dinner lies just hours

already set the record straight: The best pizza in America is found in Philadelphia at Tacconelli's, a small, plain-looking neighborhood pizza joint where the oven has been brick-bred for a little more than 80 years now.

That's right, Philly is not just about the cheese steak. In fact, the city's Italian neighborhoods—where the checkered tablecloths aren't stage props—have better food than the country's most famous Italian enclave, New York's Little Italy, now a perfect example of menus once vital turned into tourist fare. Like Rocky Balboa, Philadelphia's neighborhood Italian restaurants are perennial underdogs in the fight for restaurant respect, even though the food is a knockout.

matters of taste



The dough (above left) at Tacconelli's is made fresh every day. It is turned into pies in the age-old manner—by being rolled out and then tossed (above center). Above right: Tacconelli's is untraditional in dousing its pies with soy, not olive, oil before baking them.

It was the quest for great neighborhood Italian food, not necessarily pizza, that led me to Tacconelli's a few years ago. At about 3 P.M. on a Friday I asked my friend Gideon Umile, then the Ritz-Carlton concierge, master of all things Philly-Italian, my very own Deep Manicotti, to find a dinner adventure for me that included Italian food. "Well, first on the list would be Tacconelli's Pizzeria," he said, with just a hint of sadness in his eyes, "but there isn't time to reserve the dough." I thought my hearing was off. "Reserve the *what*?" I said. "The dough," he answered. "Did you call up and reserve the dough? No, so Tacconelli's is out."

It's Friday afternoon, I want a pizza five hours later, and I'm locked out? Who reserves anything at a pizza place, anyway...even a table? My appetite whetted. I went to my room, looked up Tacconelli's, and prepared to talk my way into a pie. The polite but not sympathetic voice on the other end of the line, with an accent reminiscent of Joe Pesci's, uttered the same maddening words: "Did you reserve the dough?"

I later discovered that you should call the day before to reserve your dough (the phones open at 9:30 A.M.). And so the morning of the day before my next trip to Philly, I was on the line. "I'd...uh...like to reserve some dough," I said in my best loading-dock accent. "Okay," said Pesci. "How much dough you need?" I started to smile. The dough was mine.

There's nothing about Tacconelli's to tip you off that it's ground-zero of American pizza. The Port Richmond neighborhood in northeast Philadelphia, is not, like South Philly, famously Italian. Abutting the old commercial docks along the Delaware River, the area was home to longshoremen when the shipping industry was thriving. Today, those dock-

workers' children live in what looks like Archie Bunker territory: a neighborhood with all the lower-middle-class look of solidity that aluminum siding and faux stone can provide.

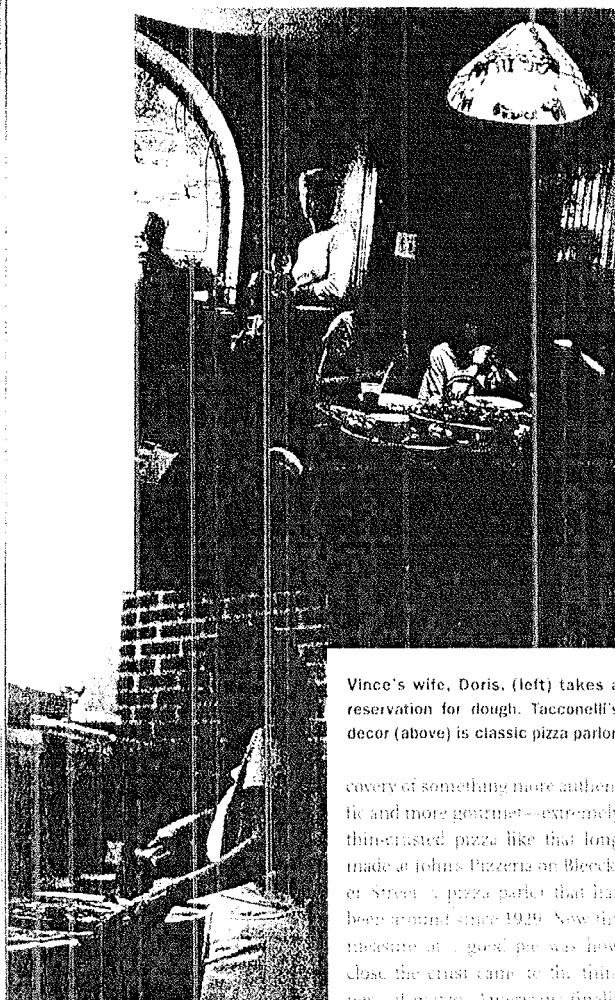
At Tacconelli's, a glaring red neon sign in the window flashes "Pizzeria." The much smaller words, "This is Tacconelli's" flash above. To say that no effort has been expended on interior design would be a lie; to say that the place may have been better off with less effort expended may be the truth. Inside are Formica tables, linoleum floors, and dropped ceilings, artificial plants and flowers (sunflowers are big), Tiffany-style lamps, stained glass windows that might charitably be called primitivist, and a rash of botanical prints on the walls. In the back room, the path is strewn with Igloos—the cold boxes in which the regulars put their beer and wine.

The most important room of all is the one that contains the 20-by-20-foot oven, made of heat-holding bricks, each three inches thick. Built in 1918 by Giovanni Tacconelli to bake great southern Italian-style bread, the oven contains the secrets of America's best pizza. But to understand why, a quick primer on American pizza history is necessary.

The development of American pizza began in New York City in the early part of the 20th century. The classic New York pie is round, large, made with tomato sauce from canned tomatoes, strewn with shredded mozzarella, sprinkled with oregano. Most important, the dough is medium-thin in the center of the pie, quite thick and heavy around the rim. New York-style pizza is still the standard pie across the country, thanks to Pizza Hut and Domino's. But it's unlike any pizza you'll find in Italy.

In the late 1970s, New Yorkers led the country in the redis-

matters of taste



Vince's wife, Doris, (left) takes a reservation for dough. Tacconelli's decor (above) is classic pizza parlor.

covery of something more authentic and more gourmet—extremely thin-crust pizza like that long made at John's Pizzeria on Bleecker Street, a pizza parlor that has been around since 1929. Now the measure of a good pie was how close the crust came to the thinness of *marzo*. Americans finally

had a pizza like that served in Italy from Rome northwards.

However, if you ask an Italian where the best pizza in Italy is made, he will steer you immediately to Naples, about 120 miles south of Rome. A Neapolitan pizza, like a traditional New York pie, has a medium-thin crust in the middle and a high crust around the edge (called the *cornicione*). But the perimeter crust is entirely different from its Manhattan cousin's. It's crackling crisp on the outside, miraculously lighter than air inside, and soft as a pillow, owing in part to the use of very soft flour. It is the finest pizza I have ever eaten. Moreover, to Neapolitans topping is almost irrelevant. Cheese went on only about 100 years ago, and many locals still feel that a pie should be topped only with salt and olive oil. To paraphrase James Carville, "It's the crust, stupid."

That crust is achieved through the unrelenting attention paid to the ovens and the pies baking in them by the justly heralded pizza bakers of Naples, the *pizzaioli*. They hand-cook each pie by moving it around the oven on a wooden paddle. Moreover they cook pizza only for a limited time each day. If you want pizza for lunch, you're out of luck, because the ovens aren't properly heated and ready to go until around 5 p.m. (They shut down around 10 p.m.) Neapolitan pizza is an artisanal product *sans pareil*; without such obsessive care it turns into mediocre New York pizza.

Although its pies are not dead-ringer facsimiles of Neapolitan ones, Tacconelli's goes to the head of the American pizza class principally because of the attention each pie gets. Vince Tacconelli, Giovanni's great-grandson—who has been making pizza here for 24 years, though he's only 38—arrives in the oven room, at 9 a.m. Wednesday through Sunday (the days the restaurant's open). He mixes 100 pounds of flour into a dough, enough for about 180 pies, which is what Tacconelli's sells on a good night. Around 10 a.m., Vince turns on a blower that shoots tremendous flames into the old oven for the next five hours. At 3 p.m., when the oven reaches roughly 810 degrees, the flame is extinguished. The oven is too hot at that point to cook pizza; it has to cool down for 90 minutes before the first pie can go in. The oven stays hot enough to bake pizza for about five and a half hours. "Stay simple," says Vince, "and you won't go wrong."

Well, it may sound simple, but Vince has to lavish the artisanal care of a Neapolitan *pizzaiolo* to get those 180 pizzas right, because the oven changes temperature over the course of an evening. When Tacconelli's opens, at about 4:30 p.m., the oven, at 700 degrees, takes only three to four minutes to cook a pie. It will have the crispest, smokiest, most blackened crust of the evening. If that's how you like pizza, come early.

As the evening progresses, the oven cools; the pies take longer to cook, and their texture grows softer and softer. By 8 p.m., the oven's at about 620 degrees. By 10 p.m., it's fallen to 570 degrees and it takes Vince nine minutes to cook a pie. To my taste, the late-evening pies are the best—tremendously flavored by their sojourn in the oven, but now much more tender, much, more flutty, much, more like Naples pizza. Throughout, Vince uses a 16-foot-long paddle to manipulate as many as 10 pies at a time in the oven, moving them to hot and cool spots as needed.

Most pizzerias heap on the topping to disguise the inferior quality of the dough. Vince is Neapolitan in using quieter ingredients on top so that the dough remains the star. "I love olive oil," he says, "but it's too much on my pizza. I use soy oil instead." He also uses a simple, one-dimensional tomato sauce, and a local mozzarella, in slices, that will never cause the mozzarella makers of southern Italy to fear for their jobs. So don't expect big, gloppy, college-town add-ons at Tacconelli's. This is pizza for grown-ups.

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That being said, there are a number of toppings and permutations that work especially well with Tacconelli's dough. My favorite is the sausage, made by a local company, Maglio Sausage Co. Also fine are full slices of prosciutto, which get curly and crumbly when cooked; spinach sautéed with garlic for great kick; and whole chunks of tomato.

And now we come to the quirkiest aspect of pizza at Tacconelli's. There are, in fact, three different pizzas: the tomato pie, the regular pie, and the white pie. The trick to ordering is to match the right toppings with the right pie—and toward that end, I have done the research for you.

The tomato pie, which has no cheese and plenty of sauce, is the family's traditional pie. Never order it plain; the simple tomato sauce is, by itself, too lean and tart. But add some peppers and the fireworks begin. Ask for sausage, too, and you'll bring this pie to its highest level.

The regular pie, as the name says, is a sort of little cheese and sauce—the usual mix of mozzarella and tomato sauce. If you're going to order a pie with no optional toppings, make it this one—but treat it a bit and ask for extra cheese. Go one step further and adding sausage and basil will bring the pie as close as a Tacconelli's pie can come to being an ordinary pizza.

PIE CHART

www.italianfood.about.com

Explains how Italian pizza differs from American.

www.mamamarys.com/Pages/new_recipes6.html


From the company behind *The Best Pizza Recipes in America* cookbook. Recipes include Parmesan and Black Pepper Pizza and the dubious-sounding Cherry Cheesecake Pizza.

www.mayoclinic.org/mayo/9911/htm/pizza.htm

The Mayo Clinic's Pizza Counter tool lets you create a virtual pizza, then gives you the nutritional breakdown (cali, Bake), Click Clear to remove toppings—and calories. Too much work? Then just refer to the Pizza Nutrition chart.


www.ghgcorp.com/coyej/links.htm

An everything you'd ever-care-to-know-about-pizza page with a directory of links (including some nonfunctional ones), about pizza history, recipes, online delivery, and humor. Worth checking out: the Story of Pizza, a historical ramble, and The World's Greatest Pie, about Naples. If you want to make your own pizza, look at Equipment, Recipes, and Ingredients.



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I have saved the best for last: Tacconelli's white pie, which the menu says "consists of salt, black pepper, cheese and plenty of garlic." To my taste the Tacconelli's crust gets a better showcase when the pie isn't covered with puddles of tomato sauce. However, most customers order the white pie with a topping of whole canned tomatoes, and they are right to do so. The tomatoes themselves are much better than the tomato sauce, and they blend supremely well with the "white" cheese. (In fact most Tacconelli's customers will tell you that the greatest pie of all is the white pie with spinach and whole tomatoes. If you go to Tacconelli's for only one pizza, make it this one.) I also adore the white pie with whole tomatoes, onions, and prosciutto.

There is one more thing you need to know to be a Tacconelli's connoisseur. When the menu lists the sky (that's pizza talk for the pie hitting your table), resist the urge to dive right in. Tacconelli's pies are subtle creations, and the flavors are not at their best when the pie is piping hot. Wait five minutes or so and you'll be rewarded with better, more intense flavors and a fluffier, lighter crust.

At 11 p.m., on the Saturday night I visited, with nary a slice remaining of my pizza and the doors closing, I tried to find

out if there was any dough left. Vince wouldn't tell me. "We could save dough for up to three days," he confided, "but the pies are not as good if the dough isn't made the same day."

Come on, Vince! I remonstrated. Is it absolutely necessary to reserve the dough? "That started in the early '80s," he said. "We had just been named Best Philly Pizza in *Philadelphia* magazine, and people started driving here for hours to have the pizza. We were constantly running out of dough, so making this rule about reserving the dough was the only way to prevent them from being disappointed."

And what if it's 10 p.m. I'm in Philadelphia, and the only thing on earth that I want is a white pie with spinach and whole tomatoes? "Well," Vince began, with a reserve that made me think something big was coming, "if we have some dough left, we may call our regular customers to let them know." And what if you're not a regular? "Most nights," Vince revealed, "if you call during business hours you'll get a recording telling you that we're out of dough. But if you leave a message at, say, 7 p.m., and let us know that you're available for pizza any time that night...well, stranger things have happened."

Tacconelli's Pizzeria, 2604 E. Somerset St., Philadelphia; 215-425-4983. No website, no e-mail address.



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Exhibit H

2604 E. Somerset Street
Philadelphia, PA 19134

(215) 425-4983

Taconelli's Pizzeria *"Best of Philly"*

Brick Oven

Closed Monday & Tuesday
Open at 4:30 P.M.

Directions

From Center City or South Philadelphia: Take I-95 North to Exit 18 (Girard Ave./Lehigh Ave.). Follow signs to Richmond Street. Take Richmond Street to Somerset Street. Make a left turn on Somerset Street to Taconelli's.

From Northeast Philadelphia: Take I-95 South to Allegheny Avenue Exit. Turn right at light at bottom of ramp and left at next light (Richmond Street). Go 3 blocks to Somerset Street. Make a right hand turn on Somerset Street to Taconelli's.

2604 East Somerset Street

76426632

TRADEMARK APPLICATION SERIAL NO. _

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE
FEE RECORD SHEET

07/08/2002 SWILSON1 00000233 76426632

01 FC:361

325.00 OP

Exhibit 2

Exhibit 2

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 76/426632

APPLICANT: Tacconelli, Vincent

AUG 30 2002

CORRESPONDENT ADDRESS:
VINCENT TACCONELLI
15 WOODBINE AVENUE
MAPLE SHADE, NJ 08052

RETURN ADDRESS:
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513
ecom114@uspto.gov

MARK: TACCONELLI'S PIZZERIA

CORRESPONDENT'S REFERENCE/DOCKET NO: N/A

CORRESPONDENT EMAIL ADDRESS:
N/A

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

OFFICE ACTION

TO AVOID ABANDONMENT, WE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF OUR MAILING OR E-MAILING DATE.

RE: Serial Number 76/426632

The examining attorney refuses registration on the Principal Register because the mark is primarily merely a surname. Trademark Act Section 2(e)(4), 15 U.S.C. §1052(e)(4); TMEP §1211. The examining attorney must consider the primary significance of the mark to the purchasing public to determine whether a term is primarily merely a surname. *In re Kahan & Weisz Jewelry Mfg. Corp.*, 508 F.2d 831, 184 USPQ 421 (C.C.P.A. 1975). Please see the attached evidence from infoUSA, establishing the surname significance of the mark. TMEP §§1211 *et seq.*

The inclusion in a mark of the generic name for the goods or services does not overcome its surname significance. *In re Hamilton Pharmaceuticals Ltd.*, 27 USPQ2d 1939 (TTAB 1993) (HAMILTON PHARMACEUTICALS for pharmaceutical products held primarily merely a surname); *In re Cazes*, 21 USPQ2d 1796, 1797 (TTAB 1991) (BRASSERIE LIPP held primarily merely a surname where "brasserie" is a generic term for applicant's restaurant services"); *In re Woolley's Petite Suites*, 18 USPQ2d 1810 (TTAB 1991) (WOOLLEY'S PETITE SUITES for hotel and motel services held primarily merely a surname); *In re Possis Medical, Inc.*, 230 USPQ 72, 73 (TTAB 1986) (POSSIS PERFUSION CUP held primarily merely a surname, the Board finding that

“[a]pplicant’s argument that PERFUSION CUP is not a generic name for its goods ... is contradicted by the evidence the Examining Attorney has pointed to”); *In re E. Martinoni Co.*, 189 USPQ 589 (TTAB 1975) (LIQUORE MARTINONI is primarily merely a surname despite addition of term LIQUORE). TMEP §1211.01(b)(vi).

An applicant may register a surname under Trademark Act Section 2(f), 15 U.S.C. §1052(f), by establishing acquired distinctiveness. The applicant may present any of the following to establish distinctiveness. TMEP §§1211 and 1212.02(a).

(1) The applicant may rely on a claim of ownership of one or more prior registrations on the Principal Register for a mark which is the same as the mark in this application for the same or related goods. 37 C.F.R. §2.41(b); TMEP §§1212.04 *et seq.*

(2) The applicant may provide a statement that the mark has become distinctive of the applicant’s goods/services by reason of substantially exclusive and continuous use in commerce by the applicant for the five years next preceding the date of the statement. The applicant must verify this statement with an affidavit or a declaration under 37 C.F.R. §2.20. 37 C.F.R. §2.41(b); TMEP §§1212.05 *et seq.*

(3) The applicant may submit actual evidence of acquired distinctiveness. 37 C.F.R. §2.41(a); TMEP §§1212.06 *et seq.*

Applicant’s claim of distinctiveness would only be applicable to TACCONELLI since pizzeria is not susceptible to a claim of distinctiveness and is required to be disclaimed apart from the mark pursuant to Section 6 of the Act.

The computerized printing format for the *Trademark Official Gazette* requires a standard form for a disclaimer. TMEP §1213.08(a)(i). A properly worded disclaimer should read as follows:

No claim is made to the exclusive right to use Pizzeria, apart from the mark as shown.

See In re Owatonna Tool Co., 231 USPQ 493 (Comm’r Pats. 1983).

The applicant must insert the required disclaimer even if registration of the mark is sought on the Supplemental Register or on the Principal Register under Section 2(f), because of the generic character of the word as applied to the recited services. *In re Wella Corp.*, 565 F.2d 143, 196 USPQ 7 (C.C.P.A. 1977); *In re Creative Goldsmiths of Washington, Inc.*, 229 USPQ 766 (TTAB 1986); *In re Carolyn’s Candies, Inc.*, 206 USPQ 356 (TTAB 1980); TMEP §1213.03(b).

The examining attorney has searched the Office records and has found no similar registered or pending mark which would bar registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d). TMEP §704.02.

The following authorities govern the processing of trademark and service mark applications: The Trademark Act, 15 U.S.C. §§1051 *et seq.*, the Trademark Rules of Practice, 37 C.F.R. Part 2, and the *Trademark Manual of Examining Procedure* (TMEP).



Edward Nelson
Examining Attorney
Law Office 114
(703) 308-9114 ext.144
ecom114@uspto.gov
(703)746-8114 (fax no.)

How to respond to this Office Action:

To respond formally using the Office's Trademark Electronic Application System (TEAS), visit <http://www.uspto.gov/teas/index.html> and follow the instructions.

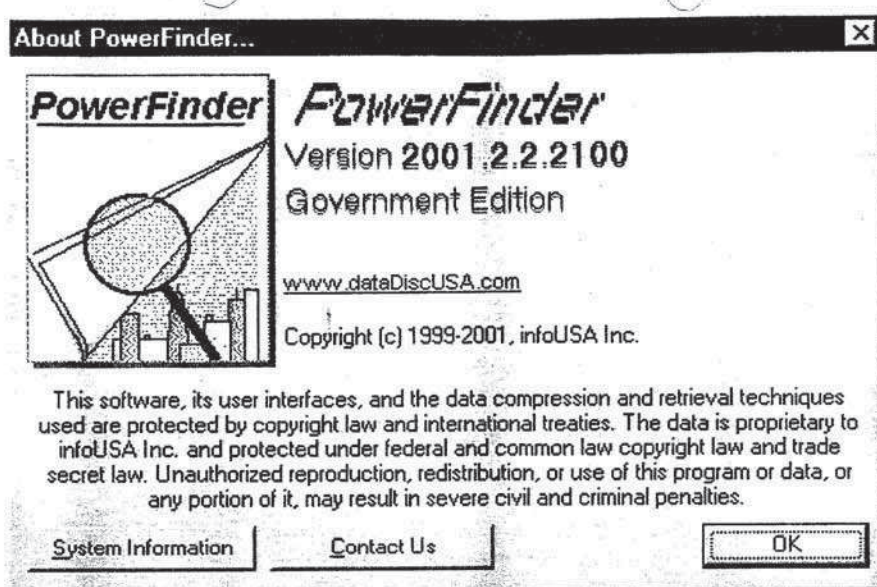
To respond formally via E-mail, visit <http://www.uspto.gov/web/trademarks/tmelecresp.htm> and follow the instructions.

To respond formally via regular mail, your response should be sent to the mailing Return Address listed above and include the serial number, law office and examining attorney's name on the upper right corner of each page of your response.

To check the status of your application at any time, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at <http://tarr.uspto.gov/>

For general and other useful information about trademarks, you are encouraged to visit the Office's web site at <http://www.uspto.gov/main/trademarks.htm>

FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY.



A total number of

53

residential listing(s) was/were found on PowerFinder
(also known as PhoneDisc)

TACCONELLI

The evidence attached includes either the entire listing from names with fewer than 100 matches or only the first 100 matches as representative of the entire listings from the disc. This search was performed on

TACCONELLI, A 2198 E HUNTINGDON ST PHILADELPHIA, PA 19125-1820
 TACCONELLI, AL 9203W E BISCAYNE DR OCEAN CITY, MD 21842-5017
 TACCONELLI, ALAN 41421 ROMEO PLANK RD CLINTON TOWNSHIP, MI 48038-2192
 TACCONELLI, ALBERT 13527 IRVINGTON DR WARREN, MI 48093-4747
 TACCONELLI, ANNETTE 6310 N ROCKWELL ST CHICAGO, IL 60659-1800
 TACCONELLI, ANTHONY J 2729 E SOMERSET ST PHILADELPHIA, PA 19134-5621
 TACCONELLI, B 624 SALMA TER MAYS LANDING, NJ 08330-9501
 TACCONELLI, B V 213 W MAIN ST SMETHPORT, PA 16749-1259
 TACCONELLI, D J 5819 W HOUGHTON LAKE DR HOUGHTON LAKE, MI 48629-9701
 TACCONELLI, D P 12328 FRANK DR ROMEO, MI 48065-4486
 TACCONELLI, DANIEL 2227 CAMDEN AVE WESTWOOD, CA 96137
 TACCONELLI, DOMINIC 2448 N CHANNEL DR HARSSENS ISLAND, MI 48028-9506
 TACCONELLI, DOMINIC 16314 GREENLAND DR MACOMB, MI 48044-3902
 TACCONELLI, E 3840 BERKLEY AVE DREXEL HILL, PA 19026-2804
 TACCONELLI, ED 6861 HOMER ST WESTMINSTER, CA 92683-3742
 TACCONELLI, ELIZABETH 10221 VIA HIBISCUS BOCA RATON, FL 33428-1315
 TACCONELLI, EVA M 2613 W ROBINO DR WILMINGTON, DE 19808-2248
 TACCONELLI, G E 3518 CALEY RD NEWTOWN SQUARE, PA 19073-3428
 TACCONELLI, GAIL 5909 BERWYN RD BERWYN HEIGHTS, MD 20740-2614
 TACCONELLI, GAIL 9203W E BISCAYNE DR OCEAN CITY, MD 21842-5017
 TACCONELLI, GUIDO 54890 STARDUST CT SHELBY TOWNSHIP, MI 48316-1661
 TACCONELLI, H J 5 TAMPICO TER WOODBURY, NJ 08096-3942
 TACCONELLI, HELEN 9 MEADOW DR FRANKFORD, DE 19945-9714
 TACCONELLI, I 1335 CHILTON DR SILVER SPRING, MD 20904-1513
 TACCONELLI, JOHN 26403 JOE DR WARREN, MI 48091-3953
 TACCONELLI, JOHN VALENCIA, CA 91355
 TACCONELLI, JOPESH P WEST PALM BEACH, FL 33404
 TACCONELLI, JOSEPH 16 CLIFF ST MONTROSE, PA 18801-1420
 TACCONELLI, JOSEPH 125 BRANDON RD NORRISTOWN, PA 19403-3394
 TACCONELLI, JOSEPH A 11 ARONIMINK DR NEWARK, DE 19711-3801
 TACCONELLI, JOSEPH A 10 S WYNWYD DR NEWARK, DE 19711-7427
 TACCONELLI, JULIO NONSOLICIT SHELBY TOWNSHIP, MI 48315
 TACCONELLI, L M DEVON, PA 19333
 TACCONELLI, LORRAINE 129 ARCHBISHOP DR PLYMOUTH, PA 18651
 TACCONELLI, M A BLACK HORSE RD CHESTER SPRINGS, PA 19425
 TACCONELLI, MARIO 2238 N CYPRESS BEND DR POMPANO BEACH, FL 33069-5618
 TACCONELLI, P 624 SALMA TER MAYS LANDING, NJ 08330-9501
 TACCONELLI, PAUL 223 E GREEN VAL CIR GREEN VLY NEWARK, DE 19711
 TACCONELLI, PETER 103 RADCLIFF DR HOUGHTON LAKE, MI 48629-9180
 TACCONELLI, PETER 215 S SUFFOLK ST IRONWOOD, MI 49938-2174
 TACCONELLI, PING 2227 CAMDEN AVE WESTWOOD, CA 96137
 TACCONELLI, QUINTO 9 MEADOW DR FRANKFORD, DE 19945-9714
 TACCONELLI, R 49559 ROXBURY CT SHELBY TOWNSHIP, MI 48315-3851
 TACCONELLI, RICHARD 500 SHORE RD GLEN HEAD, NY 11545
 TACCONELLI, ROBERT 4641 HORSESHOE PIKE HONEY BROOK, PA 19344-1059
 TACCONELLI, ROSEMARIE 1154 BLUEBIRD DR ROCHESTER HILLS, MI 48307-4693
 TACCONELLI, RUDY 129 ARCHBISHOP DR PLYMOUTH, PA 18651
 TACCONELLI, T 43 ARCH LN HICKSVILLE, NY 11801-4438
 TACCONELLI, TRISTA 103 RADCLIFF DR HOUGHTON LAKE, MI 48629-9180
 TACCONELLI, VICTOR A 231 W PUEBLO ST SANTA BARBARA, CA 93105-3800

piz·ze·ri·a

piz·ze·ri·a (pēt'sə-rē'ə) *noun*

A place where pizzas are made and sold.

[Italian, from *pizza*, pizza, pie.]

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Exhibit 3

Exhibit 3

**FLAMM,
BOROFF
& BACINE, PC**

ATTORNEYS AT LAW

STEPHEN H. FRISHBERG
(215) 239-6005

shfrishberg@flammlaw.com

ADMITTED TO PRACTICE IN PA, FL & DC

LLM IN TAXATION & LLM IN TRIAL ADVOCACY

CERTIFIED PUBLIC ACCOUNTANT

UNION MEETING CORPORATE CENTER • 925 HARVEST DRIVE, SUITE 220 • BLUE BELL, PA 19422
VOICE (215) 239-6000 • FACSIMILE (215) 239-6060 • WWW.FLAMMLAW.COM

NEW JERSEY OFFICE

WILLOW RIDGE EXECUTIVE OFFICE PARK, SUITE 301 • 750 ROUTE 73, SOUTH • MARLTON, NJ 08053
VOICE (856) 810-2299 • FACSIMILE (856) 810-2266

LEHIGH VALLEY OFFICE

3055 COLLEGE HEIGHTS BOULEVARD • ALLENTOWN, PA 18104
VOICE (610) 434-1138 • FACSIMILE (610) 434-1350

SOUTH CAROLINA OFFICE

1404 LAUREL STREET • P.O. BOX 72 • COLUMBIA, SC 29202
VOICE (803) 256-9664 • FACSIMILE (803) 256-3056

September 30, 2002

Mr. Edward H. Nelson
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Re: Tacconelli's Pizzeria
Serial No: 76/426632

Dear Ed:

As a follow-up to our telephone conversation, enclosed please find the Declaration claiming that the surname, Tacconelli, should be registered as it has established acquired distinctiveness.

Very truly yours,


Stephen H. Frishberg

SHF/sd
Enclosure

cc: Vincent Tacconelli

2/A
RECEIVED
2002 OCT 16 A 10:25
TMED
LAW OFFICE 114

****Please place on Upper-Right Corner****
of Response to Office Action ONLY.
Examining Attorney: NELSON, EDWARD H.
Serial Number: 76/426632



DECLARATION
Vincent Tacconelli
Mark: TACCONELLI'S PIZZERIA
Serial No. 76/426632

2/17
Paw

The above reference mark has been exclusive and in continuous use in commerce since 1929 and as such has become distinctive of the goods being offered.

2/17

Paw

No claim is made to the exclusive right to use Pizzeria, apart from the mark as shown.

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both under 18 U.S.C. §1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that the facts set forth in this application are true; all statements made of his/her own knowledge are true; and all statements made on information and belief are believed to be true.

Signature

STEPHEN H. FRISHBERG, ESQUIRE

Name and Position: Attorney for Applicant

Date: 9-30-2002

Incoming Correspondence Routing Sheet

To: TMO LAW OFFICE 114 - AWAITING RESPONSE DOCKET

Word Mark: TACCONELLI'S PIZZERIA

Serial No: 76426632



Mail Date: 10022002



Doc. Type: Responses to Office Actions



No Fee

RAM Mail Date: 100202



10

Exhibit 4

Exhibit 4

Int. Cl.: 43

Prior U.S. Cls.: 100 and 101

United States Patent and Trademark Office

Reg. No. 2,700,210

Registered Mar. 25, 2003

**SERVICE MARK
PRINCIPAL REGISTER**

TACCONELLI'S PIZZERIA

TACCONELLI, VINCENT (UNITED STATES IN-
DIVIDUAL)
15 WOODBINE AVENUE
MAPLE SHADE, NJ 08052

FOR: RESTAURANT PIZZERIA, IN CLASS 43
(U.S. CLS. 100 AND 101).

FIRST USE 0-0-1929; IN COMMERCE 0-0-1929.

NO CLAIM IS MADE TO THE EXCLUSIVE
RIGHT TO USE "PIZZERIA", APART FROM THE
MARK AS SHOWN.

SEC. 2(F) AS TO "TACCONELLI'S".

SER. NO. 76-426,632, FILED 7-1-2002.

EDWARD NELSON, EXAMINING ATTORNEY

Exhibit 5

Exhibit 5

Combined Declaration of Use and Incontestability under Sections 8 & 15

The table below presents the data as entered.

Input Field	Entered
REGISTRATION NUMBER	2700210
REGISTRATION DATE	03/25/2003
SERIAL NUMBER	76426632
MARK SECTION	
MARK	TACCONELLI'S PIZZERIA
OWNER SECTION (current)	
NAME	Taconelli, Vincent
STREET	15 Woodbine Avenue
CITY	Maple Shade
STATE	New Jersey
ZIP/POSTAL CODE	08052
COUNTRY	United States
ATTORNEY SECTION (new)	
NAME	Norman E. Lehrer
FIRM NAME	Norman E. Lehrer, P.C.
STREET	1205 North Kings Highway
CITY	Cherry Hill
STATE	New Jersey
POSTAL CODE	08034
COUNTRY	United States
PHONE	856.429.4100
FAX	856.429.8819
EMAIL	patents@pobox.com
AUTHORIZED TO COMMUNICATE VIA E-MAIL	Yes
ATTORNEY DOCKET NUMBER	6841
GOODS AND/OR SERVICES SECTION	
INTERNATIONAL CLASS	043
GOODS OR SERVICES	KEEP ALL LISTED
SPECIMEN FILE NAME(S)	\\TICRS\EXPORT3\IMAGEOUT3\764\266\76426632\xml3\81_50002.JPG
SPECIMEN DESCRIPTION	business card
PAYMENT SECTION	

NUMBER OF CLASSES	1
NUMBER OF CLASSES PAID	1
SUBTOTAL AMOUNT	300
TOTAL FEE PAID	300
SIGNATURE SECTION	
SIGNATURE	/Norman E. Lehrer/
SIGNATORY'S NAME	Norman E. Lehrer
SIGNATORY'S POSITION	Attorney
DATE SIGNED	08/11/2008
PAYMENT METHOD	CC
FILING INFORMATION	
SUBMIT DATE	Mon Aug 11 13:59:41 EDT 2008
TEAS STAMP	USPTO/S08N15-XX.XXX.XX.XX -20080811135941988332-270 0210-4004895ba896fceed2fd 2f951fb32b2a51-CC-7552-20 080811135346789648

Combined Declaration of Use and Incontestability under Sections 8 & 15

To the Commissioner for Trademarks:

REGISTRATION NUMBER: 2700210

REGISTRATION DATE: 03/25/2003

MARK: TACCONELLI'S PIZZERIA

The owner, Tacconelli, Vincent, having an address of

15 Woodbine Avenue

Maple Shade, New Jersey 08052

United States

is filing a Combined Declaration of Use and Incontestability under Sections 8 & 15.

For International Class 043, the mark is in use in commerce on or in connection with **all** of the goods or services listed in the existing registration for this specific class; **and** the mark has been continuously used in commerce for five (5) consecutive years after the date of registration, or the date of publication under Section 12(c), and is still in use in commerce on or in connection with **all** goods or services listed in the existing registration for this class. Also, no final decision adverse to the owner's claim of ownership of such mark for those goods or services exists, or to the owner's right to register the same or to keep the same on the register; and, no proceeding involving said rights pending and not disposed of in either the U.S. Patent and Trademark Office or the courts exists.

The owner is submitting one specimen for this class showing the mark as used in commerce on or in connection with any item in this class, consisting of a(n) business card.

[Specimen File1](#)

The registrant hereby appoints Norman E. Lehrer of Norman E. Lehrer, P.C.

1205 North Kings Highway

Cherry Hill, New Jersey 08034

United States

to file this Combined Declaration of Use and Incontestability under Sections 8 & 15 on behalf of the registrant. The attorney docket/reference number is 6841.

A fee payment in the amount of \$300 will be submitted with the form, representing payment for 1 class(es), plus any additional grace period fee, if necessary.

Declaration

The owner, or its related company, is using the mark in commerce on or in connection with the goods and/or services identified above, as evidenced by the attached specimen(s) showing the mark as used in commerce. The owner, or its related company, has continuously used the mark in commerce on or in connection with the goods and/or services identified above, for five (5) consecutive years after the date of registration, or the date of publication under Section 12(c), and is still using the mark in commerce on or in connection with the identified goods and/or services. There has been no final decision adverse to the owner's claim of ownership of such mark for such goods and/or services, or to the owner's right to register the same or to keep the same on the register; and there is no proceeding involving said rights pending and not disposed of either in the U.S. Patent and Trademark Office or in the courts.

The undersigned being hereby warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements and the like may jeopardize the validity of this document, declares that he/she is properly authorized to execute this document on behalf of the Owner; and all statements made of his/her own knowledge are true and that all statements made on information and belief are believed to be true.

Signature: /Norman E. Lehrer/ Date: 08/11/2008

Signatory's Name: Norman E. Lehrer

Signatory's Position: Attorney

Mailing Address:

Norman E. Lehrer, P.C.
1205 North Kings Highway
Cherry Hill, New Jersey 08034

Serial Number: 76426632

Internet Transmission Date: Mon Aug 11 13:59:41 EDT 2008

TEAS Stamp: USPTO/S08N15-XX.XXX.XX.XX-20080811135941

988332-2700210-4004895ba896fced2fd2f951

fb32b2a51-CC-7552-20080811135346789648



ROUTING SHEET TO POST REGISTRATION (PRU)**Registration Number:** 2700210**Serial Number:** 76426632**RAM Sale Number:** 7552**RAM Accounting Date:** 20080811**Total Fees:** \$300

Note: Process in accordance with Post Registration Standard Operating Procedure (SOP)

<u>Transaction</u>	<u>Fee Code</u>	<u>Transaction Date</u>	<u>Fee per Class</u>	<u>Number of Classes</u>	<u>Number of Classes Paid</u>	<u>Total Fee</u>
§8 affidavit	7205	20080811	\$100	1	1	\$100
§15 affidavit	7208	20080811	\$200	1	1	\$200

Physical Location: 900 - FILE REPOSITORY (FRANCONIA)

Lost Case Flag: False

In TICRS (AM-FLG-IN-TICRS): False

Transaction Date: 20080811

Exhibit 6

Exhibit 6

Combined Declaration of Use and/or Excusable Nonuse/Application for Renewal of Registration of a Mark under Sections 8 & 9

The table below presents the data as entered.

Input Field	Entered
REGISTRATION NUMBER	2700210
REGISTRATION DATE	03/25/2003
SERIAL NUMBER	76426632
MARK SECTION	
MARK	TACCONELLI'S PIZZERIA
ATTORNEY SECTION (current)	
NAME	Norman E. Lehrer
FIRM NAME	NORMAN E. LEHRER, P.C.
STREET	1205 NORTH KINGS HIGHWAY
CITY	CHERRY HILL
STATE	New Jersey
POSTAL CODE	08034
COUNTRY	United States
PHONE	856.429.4100
FAX	856.429.8819
EMAIL	patents@pobox.com
AUTHORIZED TO COMMUNICATE VIA E-MAIL	Yes
ATTORNEY SECTION (proposed)	
NAME	Norman E. Lehrer
FIRM NAME	NORMAN E. LEHRER, P.C.
STREET	1205 NORTH KINGS HIGHWAY
CITY	CHERRY HILL
STATE	New Jersey
POSTAL CODE	08034
COUNTRY	United States
PHONE	856.429.4100
FAX	856.429.8819
EMAIL	patents@pobox.com
AUTHORIZED TO COMMUNICATE VIA E-MAIL	Yes
DOCKET/REFERENCE NUMBER	6841

CORRESPONDENCE SECTION (current)

NAME	NORMAN E. LEHRER
FIRM NAME	NORMAN E. LEHRER, P.C.
STREET	1205 NORTH KINGS HIGHWAY
CITY	CHERRY HILL
STATE	New Jersey
POSTAL CODE	08034
COUNTRY	United States
PHONE	856.429.4100
FAX	856.429.8819
EMAIL	patents@pobox.com
AUTHORIZED TO COMMUNICATE VIA E-MAIL	Yes

CORRESPONDENCE SECTION (proposed)

NAME	NORMAN E. LEHRER
FIRM NAME	NORMAN E. LEHRER, P.C.
STREET	1205 NORTH KINGS HIGHWAY
CITY	CHERRY HILL
STATE	New Jersey
POSTAL CODE	08034
COUNTRY	United States
PHONE	856.429.4100
FAX	856.429.8819
EMAIL	patents@pobox.com
AUTHORIZED TO COMMUNICATE VIA E-MAIL	Yes
DOCKET/REFERENCE NUMBER	6841

GOODS AND/OR SERVICES SECTION

INTERNATIONAL CLASS	043
GOODS OR SERVICES	Restaurant pizzeria
SPECIMEN FILE NAME(S)	\\TICRS\EXPORT11\IMAGEOUT 11\764\266\76426632\xml1\S890002.JPG
SPECIMEN DESCRIPTION	web page advertisement

OWNER SECTION (current)

NAME	Taconelli, Vincent
STREET	15 Woodbine Avenue
CITY	Maple Shade
STATE	New Jersey
ZIP/POSTAL CODE	08052
COUNTRY	United States

LEGAL ENTITY SECTION (current)	
TYPE	individual
COUNTRY OF CITIZENSHIP	United States
PAYMENT SECTION	
NUMBER OF CLASSES	1
NUMBER OF CLASSES PAID	1
SUBTOTAL AMOUNT	500
TOTAL FEE PAID	500
SIGNATURE SECTION	
SIGNATURE	/Norman E. Lehrer/
SIGNATORY'S NAME	Norman E. Lehrer
SIGNATORY'S POSITION	Attorney
DATE SIGNED	04/12/2012
SIGNATORY'S PHONE NUMBER	856.429.4100
PAYMENT METHOD	CC
FILING INFORMATION	
SUBMIT DATE	Thu Apr 12 12:40:13 EDT 2012
TEAS STAMP	USPTO/S08N09-XX.XXX.XX.XX -20120412124013251715-270 0210-490b760b3ccd73744333 725689b1913aafb-CC-14871- 20120412123326512728

Combined Declaration of Use and/or Excusable Nonuse/Application for Renewal of Registration of a Mark under Sections 8 & 9

To the Commissioner for Trademarks:

REGISTRATION NUMBER: 2700210

REGISTRATION DATE: 03/25/2003

MARK: TACCONELLI'S PIZZERIA

The owner, Vincent Tacconelli, a citizen of United States, having an address of
15 Woodbine Avenue
Maple Shade, New Jersey 08052
United States

is filing a Combined Declaration of Use and/or Excusable Nonuse/Application for Renewal of Registration of a Mark under Sections 8 & 9.

For International Class 043, the mark is in use in commerce on or in connection with **all** goods/services, or to indicate membership in the collective membership organization, listed in the existing registration for this specific class: Restaurant pizzeria ; or, the owner is making the listed excusable nonuse claim.

The owner is submitting one(or more) specimen(s) showing the mark as used in commerce on or in connection with any item in this class, consisting of a(n) web page advertisement.

[Specimen File1](#)

The registrant's current Attorney Information: Norman E. Lehrer of NORMAN E. LEHRER, P.C.

1205 NORTH KINGS HIGHWAY
CHERRY HILL, New Jersey (NJ) 08034
United States

The registrant's proposed Attorney Information: Norman E. Lehrer of NORMAN E. LEHRER, P.C.

1205 NORTH KINGS HIGHWAY
CHERRY HILL, New Jersey (NJ) 08034
United States

The docket/reference number is 6841.

The phone number is 856.429.4100.

The fax number is 856.429.8819.

The email address is patents@pobox.com.

The registrant's current Correspondence Information: NORMAN E. LEHRER of NORMAN E. LEHRER, P.C.

1205 NORTH KINGS HIGHWAY
CHERRY HILL, New Jersey (NJ) 08034
United States

The registrant's proposed Correspondence Information: NORMAN E. LEHRER of NORMAN E. LEHRER, P.C.

1205 NORTH KINGS HIGHWAY
CHERRY HILL, New Jersey (NJ) 08034
United States

The docket/reference number is 6841.

The phone number is 856.429.4100.

The fax number is 856.429.8819.

The email address is patents@pobox.com.

A fee payment in the amount of \$500 will be submitted with the form, representing payment for 1 class(es), plus any additional grace period fee, if necessary.

Declaration

Section 8: Declaration of Use and/or Excusable Nonuse in Commerce

Unless the owner has specifically claimed excusable nonuse, the mark is in use in commerce on or in connection with the goods and/or services identified above, as evidenced by the attached specimen(s) showing the mark as used in commerce.

The undersigned being hereby warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements and the like may jeopardize the validity of this document, declares that he/she is properly authorized to execute this document on behalf of the Owner; and all statements made of his/her own knowledge are true and that all statements made on information and belief are believed to be true.

Section 9: Application for Renewal

The registrant requests that the registration be renewed for the goods/services/collective organization identified above.

Signature: /Norman E. Lehrer/ Date: 04/12/2012

Signatory's Name: Norman E. Lehrer

Signatory's Position: Attorney

Signatory's Phone Number: 856.429.4100

Mailing Address (current):

NORMAN E. LEHRER, P.C.
1205 NORTH KINGS HIGHWAY
CHERRY HILL, New Jersey 08034

Mailing Address (proposed):

NORMAN E. LEHRER, P.C.
1205 NORTH KINGS HIGHWAY
CHERRY HILL, New Jersey 08034

Serial Number: 76426632

Internet Transmission Date: Thu Apr 12 12:40:13 EDT 2012

TEAS Stamp: USPTO/S08N09-XX.XXX.XX.XX-20120412124013

251715-2700210-490b760b3ccd7374433372568

9b1913aafb-CC-14871-20120412123326512728



ROUTING SHEET TO POST REGISTRATION (PRU)**Registration Number:** 2700210**Serial Number:** 76426632**RAM Sale Number:** 14871**RAM Accounting Date:** 20120412**Total Fees:** \$500

Note: Process in accordance with Post Registration Standard Operating Procedure (SOP)

<u>Transaction</u>	<u>Fee Code</u>	<u>Transaction Date</u>	<u>Fee per Class</u>	<u>Number of Classes</u>	<u>Number of Classes Paid</u>	<u>Total Fee</u>
§8 affidavit	7205	20120412	\$100	1	1	\$100
Application for Renewal (§9)	7201	20120412	\$400	1	1	\$400

Physical Location: 900 - FILE REPOSITORY (FRANCONIA)

Lost Case Flag: False

In TICS (AM-FLG-IN-TICS): True

Transaction Date: 20120412

Exhibit 7

Exhibit 7

OBERMAYER

REBMANN MAXWELL & HIPPEL LLP

ATTORNEYS AT LAW

JOSEPH F. ACETO, Ph.D., Esq.
P 215-665-3217
Joseph.Aceto@obermayer.com

Centre Square West, Suite 3400
1500 Market Street
Philadelphia, PA 19102
P 215-665-3000
F 215-665-3165
www.obermayer.com

July 11, 2016

SugarHouse HSP Gaming, L.P.
d/b/a SugarHouse Casino
Legal Department
1080 N. Delaware Avenue
Philadelphia, PA 19125

RE: Demand to Cease and Desist

To Whom It May Concern:

Our Firm represents the Original Tacconelli's Pizzeria located at 2804 E. Somerset Street, Philadelphia, PA ("Tacconelli's Pizzeria"). It has been brought to my client's attention that your company has been using the trademark and trade name "TACCONELLI'S PIZZERIA" in connection with the sale of pizza and tomato pies at your facility.

The purpose of this letter is to notify you that such unauthorized use violates my client's intellectual property rights under current trademark law and to demand that you immediately cease and desist from such use.

Tacconelli's Pizzeria has been operating as a pizzeria restaurant since 1946. The restaurant has achieved success and is well recognized for its award-winning signature pizzas and tomato pies, made in a brick oven at its Philadelphia restaurant. As such, my client prides itself in the recognition and prominence of the mark TACCONELLI'S PIZZERIA along with the significant and valuable goodwill it has attained in the restaurant industry.

We recently learned that your company has been using the mark TACCONELLI'S PIZZERIA to promote its restaurant services as indicated on your website. More specifically, your website, <https://www.sugarhousecasino.com/dining/tacconelli-s-pizzeria#sm.00001aepebtjdted1qt170zn8j6ju>, associates the mark TACCONELLI'S PIZZERIA with a restaurant that provides pizza and tomato pies connected with "a family owned Philadelphia Pizzeria in it's 5th generation" and further describes a "thin-crust, brick oven baked tomato pie" as a signature pie which "has been around for decades." Such use has a high likelihood of causing consumer confusion between your activities and those of our client. Your use of TACCONELLI'S PIZZERIA constitutes trademark infringement of our client's mark.

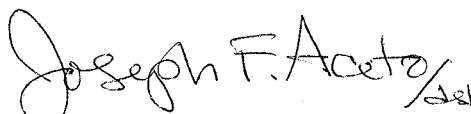
Demand is hereby made that you immediately cease and desist all use of the name and mark TACCONELLI'S PIZZERIA and any variations thereof. This includes the demand that you change your

pizzeria name to a name that does not include the word TACCONELLI and to cease all use of this mark in connection with selling pizza or tomato pies.

We wish to receive assurances no later than by 5:00 pm (ET), July 25, 2016 of your compliance with the demands contained in this letter. Your failure to promptly comply with such demands will, without further notice to you, result in our client pursuing against you any and all available remedies, including but not limited to, the enforcement of its legal rights by filing legal action against you, and seeking injunctive, compensatory, and other applicable relief if our client finds such remedies advisable.

Please govern yourself accordingly.

Very truly yours,

A handwritten signature in black ink that reads "Joseph F. Aceto". The signature is fluid and cursive, with a small mark at the end that looks like a stylized "J" or "A".

Joseph F. Aceto, Ph.D., Esq.

Attorney for Tacconelli's Pizzeria

Obermayer Rebmann Maxwell & Hippel, LLP

215-665-3217

Joseph.aceto@obermayer.com

Via Certified Mail Return Receipt Requested & First Class Mail

Exhibit 8

Exhibit 8



NIRO LAW GROUP

William L. Niro
bill@nirolaw.com

Christopher W. Niro
chris@nirolaw.com

July 18, 2016

VIA EMAIL: Joseph.Aceto@obermayer.com

Joseph F. Aceto, Ph.D.
Obermayer Rebmann Maxwell & Hippel, LLP
Centre Square West, Suite 3400
1500 Market Street
Philadelphia, P.A. 19102

RE: *Tacconelli's Pizzeria* ®

Dear Mr. Aceto:

We represent SugarHouse Casino and have been asked by our client to consider, investigate and respond to your July 11, 2016 cease and desist letter.

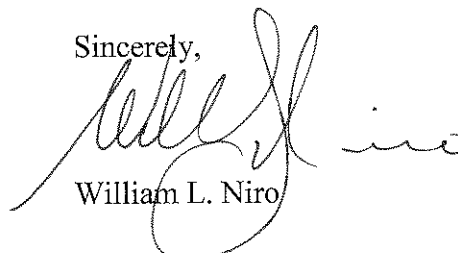
Please be advised that our client has a valid and enforceable license to use the registered trademark *Tacconelli's Pizzeria*® from Tacconelli's Empire LLC. We note that the registration has been in existence since 2003 and is incontestable. Your client appears to be claiming common law rights based on its assertion of use prior to Tacconelli's Empire. As you can appreciate, the registration pre-empts your client's common law rights as they pertain to third parties such as our client. In point of fact, we found that your client's application to register its *Tacconelli's Pizzeria*® mark has been refused by the USPTO.

We understand that your client, John Tacconelli is a relative of Vincent Tacconelli and they are engaged in a family feud over the rights to exploit the *Tacconelli's Pizzeria* mark. We also understand including a proceeding to cancel the registration has been initiated by your client.

SugarHouse has no interest in placing itself between your client and his relative in the dispute over rightful and/or exclusive ownership of the *Tacconelli's Pizzeria* brand. Until such time as the respective rights of the warring parties is resolved, our client has every legal right to continue its business at its facility under the *Tacconelli's Pizzeria*® brand.

Please keep us advised of progress in your dispute with Tacconelli's Empire. Our client will respect the rights of the rightful owner once your dispute has been resolved.

Sincerely,



William L. Niro

135 S. LaSalle Street, Suite 3025 | Chicago, IL 60603-4112
312.767.2086 | www.nirolaw.com

Exhibit C

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF PENNSYLVANIA**

JOHN TACCONELLI

Plaintiff,

v.

TACCONELLI'S EMPIRE, LLC et al.

Defendants.

:
:
:
:
:
:
:

CIVIL ACTION

NO.: 16-2348

ORDER

AND NOW, this 23rd day of August, 2018, upon consideration of the representations made by counsel in the letter dated August 8, 2018, it is hereby **ORDERED** as follows:

1. Expert reports in the above-captioned matter shall be exchanged by November 15, 2018.
2. Dispositive motions shall be filed by December 31, 2018.
3. Responses to dispositive motions shall be filed by January 14, 2019.

BY THE COURT:

/s/ C. Darnell Jones, II

C. Darnell Jones, II J.