

UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF NEW YORK

10 CV 8861

FAMOUS JOE'S PIZZA, INC.,

10 CV 8861
BFT CASE ?
Civil Action No.

8861
JUDGE RAKOFF

Plaintiff,

-against-

COMPLAINT

GIUSEPPE VITALE, an individual,
JOE'S PIZZA OF BLEEKER ST. INC.,
JOE'S PIZZA OF BLEEKER ST. 2 LLC,
JOE'S PIZZA ON SUNSET, INC.,
and JOHN DOES 1-5

JURY TRIAL DEMANDED

NOV 23 2010
U.S.D.C. S.D. N.Y.
COT 12345

Defendants.

Plaintiff Famous Joe's Pizza, Inc., for its complaint against the defendants herein states as follows on knowledge as to plaintiff and otherwise on information and belief:

INTRODUCTION

1. In this action, plaintiff seeks preliminary and permanent injunctive relief and damages resulting from defendants' a) false designation of origin and false and fraudulent representations due to defendants' representations, inter alia, that their businesses are one and the same as plaintiff's business and /or are associated with plaintiff and its business, and that defendant Giuseppe Vitale ("Vitale") is the "Joe" of the long established Joe's Pizza, when he is not; b) infringement of plaintiff's trade name and mark JOE'S PIZZA used on and in connection with restaurant services offered at three pizza restaurants operated respectively by the defendants at locations in Brooklyn, New York; Santa Monica, California; and West Hollywood, California, which

are not in fact associated with plaintiff, including but not limited to the unauthorized use of the stylized lettering of plaintiff's JOE'S PIZZA trade name and mark which plaintiff has used for over 35 years to identify its business; c) false and fraudulent representations made by defendant Vitale to the USPTO in connection with his acquisition of two Federal Registrations of the marks JOE'S PIZZA and JOE'S PIZZA OF BLEECKER STREET, respectively, in furtherance of his scheme to deceive and defraud the public so he would have the color of authority of ownership of those marks; d) dilution of plaintiff's now famous trade name and mark JOE'S PIZZA; e) unfair competition under both State and Federal laws by, *inter alia.*, passing off defendants' respective businesses as associated with plaintiff's business on websites, including web sites at the domain names www.joespizza.com and www.joespizza.it, on FACEBOOK, and elsewhere in the trade and media and in other social and Internet networks including, for example, on YELP. All of the above acts were done deliberately and with the intent to deceive the public and usurp the goodwill belonging to plaintiff.

2. Plaintiff also seeks a transfer of the domain names www.joespizza.com and www.joespizza.it, which were registered in contravention of 15 U.S.C. §1225(c), and statutory damages for cybersquatting in violation thereof, and an admin change at any FACEBOOK pages associated with plaintiff's business.

3. Finally, plaintiff seeks the cancellation of the two Federal Registrations, namely Reg. No. 3,508,216 of the mark JOE'S PIZZA and Reg. No. 3,545,485 of the mark JOE'S PIZZA OF BLEECKER STREET, fraudulently acquired by defendant Vitale in furtherance of his scheme to defraud the public and others, and to deprive the plaintiff of its mark and the goodwill associated therewith, which plaintiff built over the course of over 35 years.

THE PARTIES

4. Plaintiff Famous Joe's Pizza, Inc. ("Joe's Pizza") is a corporation organized and existing under the laws of the State of New York with an office and principal place of business at 7 Carmine Street, New York, New York. Plaintiff operates the well established and now famous pizza restaurant called JOE'S PIZZA at that location, and also formerly, through its related company, at 233 Bleecker Street, New York, New York, which is at the corner of Bleecker and Carmine.

5. Defendant Vitale is an individual domiciled in the State of New York, with a last known address at 1444 83rd Street, Brooklyn, N.Y. 11228. Vitale is a resident alien.

6. Defendant JOE'S PIZZA OF BLEECKER ST. INC., is a corporation organized under the laws of the State of New York with a principal place of business at 1621 Kings Highway, Brooklyn, N.Y. 11229, which operates a pizza restaurant under the name JOE'S PIZZA at 1621 Kings Highway, Brooklyn, N.Y. 11229. Vitale is the controlling shareholder of the corporation operating this pizza restaurant on Kings Highway.

7. Defendant JOE'S PIZZA OF BLEECKER ST. 2 LLC, is a corporation organized under the laws of the State of California with a principal place of business at 111 Broadway Santa Monica, CA 90411, which operates a pizza restaurant under the name JOE'S PIZZA at 111 Broadway, Santa Monica, CA 90411. Vitale is the controlling shareholder of the corporation operating this pizza restaurant in Santa Monica.

8. Defendant JOE'S PIZZA ON SUNSET, INC., a corporation organized under the laws of the State of California with a principal place of business at 8539 Sunset Boulevard, West Hollywood, CA, which operates a pizza restaurant under the name JOE'S PIZZA at 8539 Sunset

Boulevard, West Hollywood, CA. Vitale is the controlling shareholder of the corporation operating this pizza restaurant in West Hollywood.

9. There exists, and at all times herein mentioned there existed, a unity of interests and ownership between each of the named defendants such that any individuality and separateness between the named defendants never existed or has ceased to exist.

10. The corporate named defendants are in each instance the alter egos of Vitale, the individual named defendant, and Vitale has used these shell corporate named defendants as vehicles to perpetuate a fraud on the public and as such the corporate veil of the corporate named defendants should be pierced for all purposes. To adhere to the fiction of the existence of the corporate named defendants as separate and distinct from the individual named defendant Vitale, who owns and controls them and who uses them to perpetuate a fraud on the public and an infringement of plaintiff's rights, would sanction a sham and a fraud on the public and would promote injustice.

11. Plaintiff also believes there are other persons that are involved in the infringement of plaintiff's rights and sues them by fictitious names Does 1 through 5.

12. Other than as is alleged in this Complaint, plaintiff has yet to confirm the true identities and acts of participation of Does 1 through 5, inclusive, and therefore sues them by such fictitious names. Plaintiff is informed and believes that each of the defendants designated as a Doe is liable in some manner for the acts and omissions, damages and injuries of which plaintiff alleges in this Complaint. Plaintiff will seek to amend this Complaint to state the true identities of Does 1 through 5 when ascertained.

JURISDICTION AND VENUE

13. This action arises under the trademark laws of the United States, the Lanham Trademark Act of the United States, 15 U.S.C. § 1051 et seq., and under the statutory and common laws of the State of New York.

14. Jurisdiction over the subject matter of this action is conferred on this Court pursuant to 28 U.S.C. § 1338(a), the Lanham Trademark Act of the United States, 15 U.S.C. § 1121, et seq., and under this Court's supplemental jurisdiction.

15. Upon information and belief, the corporate named defendants and/or their alter ego defendant Vitale, do business in this district and also transact business within this district on the Internet and otherwise, derive revenue from intrastate and interstate commerce which has an effect in this district, and are otherwise within the jurisdiction of this Court.

16. Venue is properly placed in this judicial district pursuant to 28 U.S.C. §§ 1391(b), (c) and (d).

BACKGROUND

A. History of Joe's Pizza

17. Plaintiff's principal and sole shareholder Pino Pozzuoli ("Pozzuoli"), now 71 years of age and semi-retired, first opened pizza restaurants in Boston in the 1960s, when he moved to the USA from Italy. Those restaurants were successful and Pozzuoli sold the businesses, anticipating a move out of Boston. In 1974, Pozzuoli settled in NYC, and by late 1974, he opened a pizza restaurant at 233 Bleecker Street, NY, NY, corner of Bleecker and Carmine in Greenwich Village. He named the business JOE'S PIZZA because his legal name "Pino," in Italian, is the equivalent of "Joe." All friends and customers know Pozzuoli as "Joe." Attached as **Exhibit A** is a

photocopy of a photo of the 233 Bleecker Street signage which was adopted by the business in 1974 and subsequent signage at that location, by which JOE'S PIZZA became recognized by its customers. The signage – logo and font style – shown in Exhibit A has been used to identify the business since 1974, first at 233 Bleecker Street and then at plaintiff's second (Carmine Street) location (see *infra*).

18. In 1980, Pozzuoli incorporated the business under the name P&A, Inc., and renewed his Bleecker Street lease for 25 more years. The new lease would run till the end of 2004. Pozzuoli was the sole shareholder of P&A, Inc.

19. With many more years of hard work and long hours, Pozzuoli made JOE'S PIZZA the well-known pizza restaurant that it is today, as popular with the local residents as with the bridge and tunnel crowd that would form lines out the door to get a quick bite after a night on the town.

20. To keep up with kitchen demand, in 1996, Pozzuoli opened a second location of JOE'S PIZZA a few doors down the street on Carmine Street -- at 7 Carmine Street. A Google map showing the first and second location is annexed as **Exhibit B**.

21. The Carmine Street location lease was signed by a second corporation formed by Pozzuoli in 1996 which he named Famous Joe's Pizza, Inc., the plaintiff herein. Pozzuoli was then and is now the sole shareholder of Joe's Pizza.

22. Both locations co-existed for about 8 years until Pozzuoli directed all of the Bleecker Street business to the Carmine Street location, three doors away. This happened when Pozzuoli decided not to renew the expiring 25 year Bleecker Street lease at end of 2004 due to the exorbitant rent being asked and closed the corner location after operating there for over 30 years.

23. A smart businessman, Pozzuoli actually closed the Bleecker Street location a few months prior to lease expiration so he could put up a sign at the location and direct anyone not already familiar with the Carmine Street location to Carmine Street. Plaintiff's business still operates today at 7 Carmine Street. After the Bleecker Street location closed, the very signage from Bleecker Street was put up on Carmine Street. The phone number for takeout and delivery stayed the same.

24. When the Bleecker Street location closed, Pozzuoli transferred all of the business and goodwill of the Bleecker Street location of JOE'S PIZZA to the Carmine Street location and to the corporation doing business at that address, the plaintiff herein, which he solely owned. The Carmine Street location is the sole location from which plaintiff operates its business today.

25. The closing of the Bleecker Street location received much publicity as JOE'S PIZZA had been an institution. It was widely reported that while JOE'S PIZZA was closing its Bleecker Street address, the Carmine address a few doors away would remain open.

26. The October 23, 2004 NEW YORK POST included a story about the closing of JOE'S PIZZA's Bleecker's address. The article quoted Pozzuoli and informed readers that: *"Fans of the famous \$2.25 thin-crust slices will still get their fill three doors down at the other Joe's locale on Carmine Street."*

27. The decision not to renegotiate the lease and to operate solely at the 7 Carmine Street location was also widely written about on the Internet. Websites like the Gothamist.com and Curbed NY covered the story. Slice.seriousseats.com informed its readers: *"Fans of the little joint will be glad to know that the location three doors down will remain open. And, yes, it's the same owner, not some Ray's/Famous Ray's/Original Rays thing."*

28. Today, at the Carmine Street location, plaintiff continues to sell the same excellent product that plaintiff and its principal has sold for over 35 years.

B. The Popularity and Fame of Joe's Pizza

29. Through the years, JOE'S PIZZA received much publicity, acclaim and was written about and reviewed in many publications.

30. In 1996, NEW YORK MAGAZINE named JOE'S PIZZA "*Best of New York*." This was NEW YORK MAGAZINE'S yearly double issue that features some of the most popular restaurants, bars, clubs etc. The article describes plaintiff's pizza as "*the quintessential New York slice*."

31. JOE'S PIZZA was also a stop on several tour bus lines that bring in tourists from all over the world. Scott's Pizza Tours (see <http://www.scottspizzatours.com>) featured JOE'S PIZZA as one of the key stops on their New York walking tour.

32. JOE'S PIZZA has appeared in many films, TV Shows and various other print media through the years. The business is often scouted by filmmakers seeking an authentic New York backdrop. Over the years, there were several instances where filming was also done inside the location. Films and TV shows where JOE'S PIZZA can be seen include:

Fatso (1980)

Law & Order (1990s)

The Night We Never Met (1993)

Along Came Polly (2004)

Looking For Kitty (2004)

33. JOE'S PIZZA was also seen on popular morning talk shows such as the REGIS AND KELLY show. There was a segment on the staff's favorite places to eat in Manhattan. Kelly interviewed Pozzuoli and introduced him as "the Joe" of JOE'S PIZZA.

34. Extensive shooting at JOE'S PIZZA was done for the film SPIDERMAN 2 in 2004. JOE'S PIZZA is in fact one of the key locations for the movie, as (in the storyline) it is where the central character, Peter Parker (aka Spiderman) works. JOE'S PIZZA is prominent in the entire opening sequence of the film as the central character is faced with the daunting task of delivering some of JOE'S PIZZA pies through the crowded New York City streets.

35. SPIDERMAN 2 was a tremendous box office success and the third highest-grossing film of that year. According to the Internet Movie Data Base (imdb.com) it is 14th in all-time USA box office gross. The SPIDERMAN film series remains very popular. JOE'S PIZZA still receives phone calls from comedy radio shows asking (in good fun) why the business "fired" Peter Parker?

36. Over the years, JOE'S PIZZA has gotten many reviews, write-ups and mentions in many magazines and newspapers. New York Magazine has given JOE'S PIZZA many positive reviews over the years. In one review, they referred to JOE'S PIZZA as "*a Greenwich Village institution.*"

37. Time Out New York, a magazine that focuses on arts, leisure, recreation and dining in New York, often lists JOE'S PIZZA as one of the top Pizza shops. In the November 30, 2006 issue, which featured a cover story about pizza, JOE'S PIZZA is ranked as number 5.

38. JOE'S PIZZA has appeared several times also in The New York Post, where it is often cited by celebrities in the paper's PULSE section as a favorite place to eat. Also, the New

York Post printed an article called "PIZZA WARS" and included a photograph of JOE'S PIZZA and competitor Dominos.

39. JOE'S PIZZA was also used in a subway ad campaign for the popular HBO series, Sex and the City. This ad campaign showed the star of the series Sarah Jessica Parker playing Carrie Bradshaw, immersed in the daily New York City experience. Some of the posters showed her in a yellow taxi cab. Others showed her on a pay phone (this is late 90s when cell phone use was not as common as it is today) and in other ads, she was shown eating a pizza slice at JOE'S PIZZA outside tables.

40. JOE'S PIZZA has received many unsolicited celebrity endorsements. Film star Ben Affleck has often stated how he is a fan. In the April 10, 2004 NEW YORK POST, he said, *"There are tons of pizza places all over New York. It definitely has the best pizza in the world. But Joe's is the best of the best."*

41. Academy Award winning actor, Kevin Spacey, when asked if he missed New York while living in London, told TIME OUT NEW YORK: *"I really miss JOE'S PIZZA on Bleecker and Carmine."*

C. Defendants Unlawfully Competing Acts and Operations

42. Vitale, the individual named defendant in this action, began working as an employee at JOE'S PIZZA sometime around 1984. The circumstances of his hiring were as follows: he was to marry the daughter of Pozzuoli. Vitale did not have many marketable skills or experience at the time, and had lost a previous job. Vitale asked Pozzuoli to employ him at the pizza restaurant, although he had never before worked in the pizza business.

43. Vitale's separated from Pozzuoli's daughter about 18 years later, in about

2003, and got divorced in 2004. This is about the time that Pozzuoli decided to forgo renewal of the lease at the Bleecker Street location and consolidate the business at the Carmine Street location, which had been operating as the second location for JOE'S PIZZA since about 1996.

44. Pozzuoli recalls that at around this time, 2003-2004, during the divorce, Vitale became noticeably dissatisfied with "just working" at JOE'S PIZZA. Despite drawing a salary that was much higher than any of the other employees, due solely to his family connection, he claimed he was entitled to more given the continued success and fame that his employer had achieved since opening in 1974. On the eve of divorce, Vitale asked Pozzuoli to give Vitale a percentage of the business. Pozzuoli absolutely denied the request. Vitale did not take no for an answer. Denied a percentage of the business, he decided to simply steal, at first surreptitiously, from his ex-father-in-law what he was denied, and then some.

45. While Pozzuoli's family did their best to maintain a cordial relationship with Vitale, including allowing Vitale to work part-time subsequent to the divorce while paying him a full time salary, Vitale secretly schemed to take the most important asset of the business, its trade name and mark JOE'S PIZZA and the goodwill of the business, and began secretly and surreptitiously taking actions to make his scheme a reality.

46. The part time work and full time salary allowed Vitale time to do "his own thing," and that is what Vitale told Pozzuoli he was doing. Vitale was not only secretive; he actively went out of his way to feed Pozzuoli misinformation so that Pozzuoli would not learn what Vitale was in fact doing – trading on the goodwill of plaintiff.

a. The Brooklyn Location

47. While still an employee of plaintiff, Vitale's first foray was to open a pizza

restaurant in Brooklyn, NY at King's Highway which he named JOE'S PIZZA, to trade on the goodwill of plaintiff.

48. Vitale incorporated that Brooklyn business on or about February 2, 2007 as JOE'S PIZZA OF BLEECKER ST. INC, one of the named corporate defendants herein, with a partner named Francesco Carollo. So that Vitale's involvement in the restaurant would fall under the radar, only the "Francesco Carollo" name appeared in the public corporate filings. See **Exhibit C** annexed hereto.

49. The Brooklyn location not only copied plaintiff's name, it also copied plaintiff's logo and font style, which plaintiff was using and had used since 1974. The signage at the unauthorized Brooklyn location is shown in **Exhibit D**.

50. Plaintiff and its principal Pozzuoli had no knowledge of the business operating at King's Highway under the name JOE'S PIZZA until very recently.

b. Vitale Goes to California

51. Vitale at some point in time informed Pozzuoli that he would be spending time in California and would no longer come into work as he planned on opening "his own" pizza business in California someday. Vitale nevertheless asked to remain listed as an employee of plaintiff so he could retain his health insurance benefits. Unsuspecting of the activities of Vitale, plaintiff agreed to keep Vitale's health insurance in place.

52. Vitale continued to keep the true nature of what he was doing from plaintiff by always feeding Pozzuoli misinformation. When Vitale talked about his plans to open a business in California, he would say he was opening a business "of my own." And even when Vitale talked about the pizza restaurant he had opened in California, he would say: "I'm doing my own thing in

California." Pozzuoli, at this point semi-retired and spending two months a year in Italy, was totally unsuspecting of Vitale, a man whom he always treated so well and to whom he gave a profession.

c. The Fraudulently Obtained Federal Registrations

53. While in California, Vitale retained an attorney to file a Federal Trademark application to register JOE'S PIZZA OF BLEECKER STREET for "pizza" in his personal name as owner and applicant. The application was filed on October 12, 2007. Vitale claimed first use in commerce and in interstate commerce of that mark on September 9, 2004, perhaps to make it appear that "he" had the right to continue the business of the Bleecker Street location being closed at about that time by Pozzuoli due to non renewal of the lease. Vitale intended to capitalize on the news that had preceded plaintiff's closing of that location and schemed to deceive the public, the trade and the USPTO that the business at that location belonged to him.

54. Vitale's application to register the mark JOE'S PIZZA OF BLEECKER STREET encountered initial rejections which Vitale and his lawyer overcame by submitting statements and documents to the USPTO which were material in misleading the USPTO to issue the registration.

55. To overcome the rejections, during prosecution of the application, Vitale by his attorney deliberately deceived the USPTO by submitting fraudulent specimens showing use of the mark JOE'S PIZZA OF BLEECKER STREET and making fraudulent misrepresentations to the USPTO. The first specimen submitted shows the mark JOE'S PIZZA OF BLEECKER STREET on a sheet of paper with reviews of both plaintiff's business and the King's Highway Brooklyn business, which in fact was not related to plaintiff. Further, the mark on the specimen is plaintiff's logo and stylized font for the words JOE'S PIZZA. See **Exhibit E** annexed hereto. Because that specimen

did not show use of the mark on "pizza," the USPTO requested another specimen and Vitale then submitted a photo of a pizza box on which appeared plaintiff's logo and stylized font for the words JOE'S PIZZA. See **Exhibit F** annexed hereto.

56. In one of Vitale's submissions to the USPTO in connection with the prosecution of this application, Vitale makes a material misstatement to the USPTO. Vitale claims to have founded his "*first restaurant on Bleecker Street*" when in actuality he became employed there nearly 10 years after plaintiff opened at that location. Vitale was never an owner of plaintiff's business. Vitale's attorney stated the following to the USPTO:

The Examining Attorney requested a written statement explaining whether the goods have a geographical significance. The Applicant, which owns and operates pizza restaurants in New York and California, founded its first restaurant on Bleecker Street in New York and therefore has a connection to Bleecker Street. During the period in which the Applicant maintained a restaurant on Bleecker Street, it produced pizza at that location and became known for its pizza. At present, the Applicant no longer has a restaurant on Bleecker Street and does not currently produce pizza at that location but patrons primarily in New York recall and identify the restaurant with its prior location on Bleecker Street. ...

Applicant further submits that the geographic connotation is obscure and unknown to the average consumer especially consumers who patron the Santa Monica, California restaurant.

A copy of the Response filed by Vitale on February 20, 2009 making such material misrepresentations to intentionally and deliberately deceive the USPTO into issuing the application to registration is annexed as **Exhibit G**. The application issued to registration on June 30, 2009. See USPTO computerized record of Registration No. 3,645,485 annexed as **Exhibit H**.

57. Perhaps in anticipation of the possibility that the refusal of Vitale's first filed application would not be overcome because of the geographical designation in the mark, the

specimens or otherwise, Vitale also engaged his attorney to file a second Federal application in his personal name as owner and applicant.

58. A second application for the mark JOE'S PIZZA was filed on February 26, 2008 for restaurant services featuring pizza. The application averred that the mark JOE'S PIZZA of that application was first used in commerce and in interstate commerce since September 9, 2004, as did the first application.

59. The specimen submitted with the application to register JOE'S PIZZA also used plaintiff's logo and stylized font and used plaintiff's publicity -- all as if plaintiff was the applicant and was opening Vitale's locations. In addition, the specimen contains quotes referring to "NYC's fabled Joe's Pizza" and to "The legendary slice joint Joe's Pizza has opened a new pizzeria in Santa Monica from the original New York City, Bleecker Street location." A copy of the specimen submitted with that application is annexed as **Exhibit I** hereto. The application, despite the fraudulent specimen representing applicant Vitale as having plaintiff's rights in the mark JOE'S PIZZA, issued to registration on September 30, 2008. See USPTO computerized record of Registration No. 3,508,216, annexed hereto as **Exhibit J**.

d. The Santa Monica Location

60. Vitale formed defendant Joe's Pizza of Bleecker St. 2 LLC, to operate the Santa Monica, California "branch" of JOE'S PIZZA. The records of the California Secretary of State indicate that the filing for said entity was on July 7, 2005. See annexed as **Exhibit K**. Sometime thereafter, Vitale opened a Santa Monica, California location of JOE'S PIZZA pretending that it was being opened by plaintiff. He used the famous signage used since 1974 at plaintiff's pizza restaurant to promote the Santa Monica location as an authentic JOE'S PIZZA. See **Exhibit L**

annexed hereto.

e. The West Hollywood Location

61. Fully comfortable in his impersonation of "Joe," Vitale then formed defendant Joe's Pizza on Sunset, Inc., on about June 12, 2009. He is identified as the agent for service of process of that entity. See annexed as **Exhibit M**. In February of this year, he opened a third unauthorized "branch" of JOE'S PIZZA in West Hollywood, California.

f. The Websites

62. The domain name joespizza.com was registered in 2001 and updated March 24, 2007, when it is believed Vitale acquired the domain name. See annexed as **Exhibit N**.

63. Vitale at some point put up a website at that domain name promoting his businesses and their association to plaintiff's business. There, he listed 4 branches of JOE'S PIZZA, namely 111 Broadway, Santa Monica CA; 8539 Sunset Blvd, West Hollywood CA; 1621 Kings Highway, Brooklyn, NY and of course 7 Carmine Street, New York, NY. 7 Carmine Street (off Bleecker) is and has always been plaintiff's location and Vitale is not now, nor was he ever, the owner of plaintiff's restaurant! A copy of select pages of the website at www.joespizza.com as that website appeared on October 6, 2010 is annexed as **Exhibit O**.

64. Vitale included a press kit on his website at www.joespizza.com. The press kit included photographs, press clippings and reviews of plaintiff's prior restaurant at 233 Bleecker and plaintiff's restaurant at 7 Carmine Street. The press kit showed Vitale when he was working as an employee of plaintiff's business, but Vitale pretends those materials belong to him, as he pretends that the Bleecker/Carmine businesses belong to him

65. The domain name www.joespizza.com now redirects to www.joespizza.it,

where Vitale now has his website, as well as the press kit referred to above. Vitale registered that domain name on October 6, 2010. See annexed as **Exhibit P**.

66. A copy of select pages of the website at www.joespizza.it is annexed as **Exhibit Q**. The press kit referred to above, also up at this site, is included in the exhibit.

67. As is evident from both websites, Vitale is leading the public and the media to believe that Vitale is "Joe" of plaintiff Joe's Pizza and that his three businesses are one and the same as plaintiff's business. Vitale is leading the public and the media to believe that Vitale is the owner of plaintiff's business, and that the newly opened branches in Brooklyn, Santa Monica and West Hollywood are plaintiff's businesses and that he is the owner of all of them.

68. This confusion, association, endorsement is evident in postings available at YELP.com and CITYSEARCH, among others. One reviewer posted on YELP, regarding Vitale's Brooklyn location, "*I saw the Zagat ratings and the pictures of Spiderman and the mom from Everybody Loves Raymond.....Well, it's a franchise of a Carmine Street pizzeria.*" The consensus on these public review sites is that Vitale's locations are branches of plaintiff's businesses, and that Vitale is the owner of plaintiff's business, when in reality this is simply not true. Also evident is that Vitale's businesses do not serve the same quality product. See select pages from YELP annexed as **Exhibit R**.

g. Vitale on Facebook & In the Media

69. Vitale has also created at least two pages on FACEBOOK which use plaintiff's trade name and mark, including the logo and stylized lettering long used by plaintiff to distinguish its business. See annexed **Exhibit S** printed on November 9, 2010 of a FACEBOOK group page – a member page. See also **Exhibit T** which is Vitale's JOE'S PIZZA's fan page.

70. Vitale has used various other Internet websites and print publications to promote his new businesses usually drawing on plaintiff's fame and recognition. He has used publications such as L.A. Weekly, sortuv.com, la.curbed.com, la.eater.com and many others to promote his businesses using plaintiff's identity. See **Exhibit U** annexed hereto. He clearly states his is the same business and aggressively uses plaintiff's name to promote himself and his businesses. From la.eater.com: "*Roughly a year and a half after he opened his first West Coast outpost of the famed NYC pizzeria, Giuseppe Vitale—aka THE Joe of JOE'S PIZZA—plans to open up his second location at 8539 Sunset.*"

71. Even Vitale's son pretends that he is an owner of plaintiff's business. See annexed **Exhibit V** which is publicity available information where the young Vitale claims to be an owner of the Carmine Street location, as well as the owner of Vitale's other three locations of JOE'S PIZZA. On his FACEBOOK page, the young Vitale posts a photo of the West Hollywood signage, which copies plaintiff's logo exactly. See **Exhibit W** annexed hereto.

h. Vitale Has No Remorse In Stealing His Ex-Father-In-Law's Business

72. Plaintiff recently lost an opportunity to license the very brand that it has developed over the course of over 35 years in business because Vitale registered fraudulent trademarks and committed the unlawful activities described herein. Plaintiff learned about the unlawful activities of the named defendants after engaging counsel to understand this lost opportunity and investigating the activities of Vitale and his alias to prepare for this litigation.

73. Vitale received a letter from counsel for plaintiff on or about October 13, 2010 complaining of his unlawful activities. A copy of plaintiff's counsel's letter is annexed as **Exhibit X**. That letter sought a response from Vitale and/or his lawyer on or before October 25, 2010, but in

flagrant disregard of plaintiff's rights, Vitale made no response and did not authorize a lawyer to respond on his behalf.

74. On October 24, 2010, before response to that letter was due, Pozzuoli and Pozzuoli's son Pino Jr. confronted Vitale in NYC about what they had just learned.

75. When Vitale was asked why he had yet to respond to the letter he had gotten from plaintiff's lawyer requesting that he cease his unlawful activities as particularized in that letter, Vitale responded: "*Why are you wasting my time?*"

76. During that conversation, Vitale said the following with respect to the two fraudulently issued USPTO registrations: "*Well I got it now and there's nothing you can do about it.*"

77. Vitale thereafter informed plaintiff that because he worked for plaintiff's JOE'S PIZZA business for many years, Vitale believed he is entitled to open locations using the same name, appearance and logo and to use plaintiff's reviews, press, etc. Vitale also informed plaintiff that he plans to use the mark JOE'S PIZZA to procure licensing and franchising deals and that he wants plaintiff: "*out of the way.*"

78. Vitale -- and his shell corporations operating the illicit JOE'S PIZZA businesses and serving as his alter egos -- continue to operate without regard of public confusion or damage to plaintiff's business.

79. Vitale has stolen the business goodwill of JOE'S PIZZA by advertising that he and his businesses are the JOE PIZZA's of Bleecker Street. Vitale is using all of plaintiff's publicity as if it was his own. He uses photos taken during his time as an employee of plaintiff to claim his ownership of plaintiff's business and to give plaintiff's goodwill to Vitale's businesses.

80. Vitale is blatantly stealing plaintiff's identity and shows no signs of stopping.

To the contrary, now that plaintiff has discovered it and has confronted Vitale about it, Vitale has taken actions to protect his fraudulently developed interests. For example, he recently transferred a 49% share of the West Hollywood restaurant to one of his sons.

D. The Irreparable Harm

81. It has taken plaintiff decades of dedication, hard work and consistent customer satisfaction to become famous. Vitale's willful and deceitful scheme to appropriate plaintiff's business goodwill, name and mark has resulted in plaintiff being associated with restaurants over which plaintiff has no control and according to several reports, produce an inferior pizza product.

82. One of plaintiff's customers recently advised plaintiff's employee: "Oh this is much better than what you served me at your Kings Highway store." While the employee that the customer made this comment to thought that the customer was mistaken or confused, it is clear to plaintiff now that this comment referred to Vitale's Brooklyn restaurant.

83. Vitale's actions are harming plaintiff's business and preventing plaintiff from controlling and licensing its own trade name and mark to other for profit. The damage from such loss of opportunity cannot be quantified and is irreparable.

84. Vitale's actions are deceiving the public and the media into thinking that his businesses are plaintiff's business and/or are associated with plaintiff's business. Because of Vitale's behavior, plaintiff is experiencing difficulty controlling how plaintiff's own trade name and mark is being used. Plaintiff's reputation is being damaged as obviously plaintiff now has no control of what Vitale does or says to the public. Plaintiff's night manager informed plaintiff recently that as of late customers have been inquiring about plaintiff's alleged "California restaurants."

85. Vitale's aspirations are only getting bigger and more grand. Plaintiff has just

learned that Vitale anticipates a potential big transaction in January 2011 in which he plans to license or franchise JOE'S PIZZA to others so they can open restaurants where he has no ownership interest in the business itself, just a license/franchise interest in them. So not only is he harming plaintiff and plaintiff's business and confusing the public with his own businesses, he now intends to defraud potential investors. His schemes must be stopped immediately as the harm he is doing is irreparable.

COUNT I

VIOLATION OF 15 U.S.C. § 1125(a)

(False Designation of Origin and False and Fraudulent Representations)

86. Paragraphs 1 through 85 are incorporated herein to the same extent and in the same manner as if herein repeated in their entirety.

87. The foregoing activities of defendants in opening and operating one or more restaurants utilizing the trade name and mark JOE'S PIZZA in commerce constitutes false designation of origin and false and fraudulent representations, in violation of Section 43(a) of the Lanham Trademark Act of 1946, 15 U.S.C. Section 1125(a).

88. Customers, prospective customers and the trade have been and are likely to think that there is an association, sponsorship or endorsement between the defendants and plaintiff when in fact there is none.

89. Defendants foregoing activities have irreparably damaged plaintiff and has further caused plaintiff monetary damages in an amount as yet unknown, but if defendant's foregoing activities continue, the damage to plaintiffs will exceed \$10,000,000.

90. Unless defendants are restrained from their continuing acts as described

above, defendants' actions will continue to cause plaintiff irreparable harm.

91. Plaintiff has no adequate remedy at law.

COUNT II

VIOLATION OF 15 U.S.C. § 1125(a) (Trademark Infringement)

92. Paragraphs 1 through 85 are incorporated herein to the same extent and in the same manner as if herein repeated in their entirety.

93. The foregoing activities of defendants in opening and operating one or more restaurants utilizing the trade name and mark JOE'S PIZZA in commerce constitutes trademark infringement, in violation of Section 43(a) of the Lanham Trademark Act of 1946, 15 U.S.C. Section 1125(a).

94. Customers, prospective customers and the trade have been and are likely to be confused, deceived and misled by defendants' actions and have purchased and are likely to purchase pizza from defendants as a result thereof.

95. Defendant's foregoing activities have irreparably damaged plaintiff and have further caused plaintiff monetary damages in an amount as yet unknown, but if defendant's foregoing activities continue, the damage to plaintiffs will exceed \$10,000,000.

96. Unless defendants are restrained from their continuing acts as described above, defendants' actions will continue to cause plaintiff irreparable harm.

97. Plaintiff has no adequate remedy at law.

COUNT III

VIOLATION OF 15 U.S.C. § 1064

(Cancellation of Federal Registrations against Defendant Vitale)

98. Paragraphs 1 through 85 are incorporated herein to the same extent and in the same manner as if herein repeated in their entirety.

99. This cause of action arises under 15 U.S.C. §§ 1064 and 1119 and seeks the cancellation of the two federal trademark registrations granted to defendant Vitale by the USPTO.

100. Defendant Vitale deceived and intended to deceive the USPTO when he claimed that he was the owner of the marks JOE'S PIZZA and JOE'S PIZZA OF BLEECKER STREET. Defendant Vitale knew that he was not the owner of these marks when he applied to register them. Defendant Vitale knew that his former employer, the plaintiff herein, was the owner of the mark JOE'S PIZZA and he also knew that the mark JOE'S PIZZA OF BLEECKER STREET was a reference to the business of his former employer, plaintiff herein. Defendant Vitale knew that his former employer, the plaintiff herein, has prior rights in the trade name and marks. Despite such knowledge, defendant Vitale committed fraud on the USPTO by claiming ownership of said marks. Since such registrations vest Defendant Vitale with the color of authority as the owner of these marks and accord him rights, and the registrations were acquired by material misstatements made to the USPTO and fraudulent specimens of use of the marks, they should be cancelled.

101. Defendant Vitale's foregoing activities have irreparably damaged plaintiff and has further caused plaintiff monetary damages in an amount as yet unknown, but if defendant's foregoing activities continue, the damage to plaintiffs will exceed \$10,000,000.

102. Unless defendant Vitale is restrained from its continuing acts as described

above, defendant Vitale's actions will continue to cause plaintiff irreparable harm.

103. Plaintiff has no adequate remedy at law.

COUNT IV

VIOLATION OF 15 U.S.C. § 1125(c) (Dilution)

104. Paragraphs 1 through 85 are incorporated herein to the same extent and in the same manner as if herein repeated in their entirety.

105. This cause of action arises under the Federal Trademark Dilution Act, 15 U.S.C. § 1125 (c) (1).

106. Plaintiff's mark is famous as that term is defined in 15 U.S.C. § 1125 (c) (1). Defendants' acts have diluted or are likely to dilute the distinctive quality of plaintiff's mark.

107. Defendants' use of a mark that is identical to plaintiff's mark dilutes the distinctive quality of said mark by tarnishing or blurring, and is thereby likely to injure plaintiff.

108. Defendants foregoing activities have irreparably damaged plaintiff and have further caused plaintiff monetary damages in an amount as yet unknown, but if defendant's foregoing activities continue, the damage to plaintiffs will exceed \$10,000,000.

109. Unless defendants are restrained from its continuing acts as described above, Defendants' actions will continue to cause plaintiff irreparable harm.

110. Plaintiff has no adequate remedy at law.

COUNT V

VIOLATION OF 15 U.S.C. § 1125(a)
(Unfair Competition)

111. Paragraphs 1 through 85 are incorporated herein to the same extent and in the same manner as if herein repeated in their entirety.

112. This cause of action for unfair competition arises under 15 U.S.C. § 1125 (a).

113. Defendants acts alleged herein constitute unfair competition and will injure the business reputation and business of plaintiff.

114. Defendants foregoing activities have irreparably damaged plaintiff and have further caused plaintiff monetary damages in an amount as yet unknown, but if defendant's foregoing activities continue, the damage to plaintiffs will exceed \$10,000,000.

115. Unless defendants are restrained from its continuing acts as described above, Defendants' actions will continue to cause plaintiff irreparable harm.

116. Plaintiff has no adequate remedy at law.

COUNT VI

VIOLATION OF 15 U.S.C. § 1125(d)
(CyberSquatting)

117. Paragraphs 1 through 85 are incorporated herein to the same extent and in the same manner as if herein repeated in their entirety.

118. This cause of action for federal trademark cyber piracy arises under Section 43(d) of the Lanham Act, 15 U.S.C. § 1125(d).

119. Defendants registered and have maintained the domain name <joespizza.com>

and <joespizza.it> with the knowledge of plaintiff's rights in the JOE'S PIZZA trade name and mark and plaintiff's longstanding use of the name and mark in connection with the operation of pizza restaurants.

120. Defendants have registered and maintained the said domain names with the intent to divert customers from plaintiff and to deprive plaintiff from using that domain name and upload its own site.

121. Defendants have registered and maintained these domain names with the intent to profit from the fame and notoriety of plaintiff's name and mark.

122. For the reasons described herein and to be discovered in this case, defendants have acted in bad faith in registering and maintaining the domain names <joespizza.com> and <joespizza.it>

123. Defendants acts have and will continue to irreparably injure plaintiff, for which plaintiff has no adequately remedy at law.

124. Defendants have profited by the activities complained of herein, and plaintiff has been damaged by such activities in an amount as yet unknown but believed to be in excess of \$10,000,000.00.

COUNT VII

VIOLATION OF SECTION 349 OF THE NEW YORK GENERAL BUSINESS LAW

125. Paragraphs 1 through 85 are incorporated herein to the same extent and in the same manner as if herein repeated in their entirety.

126. This cause of action arises under Section 349 of the New York General

Business Law. Jurisdiction over this count is proper under the doctrine of supplemental jurisdiction.

127. Defendants without permission, willfully, and with the intention of benefitting from the reputation and goodwill of plaintiff are passing themselves off as businesses and persons associated with plaintiff and defendant Vitale is passing himself off as the "Joe" of Joe's Pizza, in contravention of plaintiff's trade name and mark.

128. The acts alleged herein are a deceptive business practice undertaken by defendants, the dominant purpose and effect of which is to pass off and palm off their businesses as associated with plaintiff and to confuse buyers as to the source or origin of their pizza restaurants, in violation of the laws of New York. Customers, prospective customers and the trade have been and are likely to be confused, deceived and misled by defendants' actions and have purchased and are likely to purchase pizza from defendants as a result thereof.

129. The conduct of the defendants violates Section 349 of the New York General Business Law.

130. Defendants foregoing activities have irreparably damaged plaintiff and has further caused plaintiff monetary damages in an amount as yet unknown, but if defendant's foregoing activities continue, the damage to plaintiffs will exceed \$10,000,000.00.

131. Unless defendants are restrained from their continuing acts as described above, defendants' actions will continue to cause plaintiff irreparable harm.

132. Plaintiff has no adequate remedy at law.

133. Defendants have been unjustly enriched and plaintiff is entitled to an accounting of defendants' profits.

COUNT VIII

VIOLATION OF NEW YORK COMMON LAW

134. Paragraphs 1 through 85 are incorporated herein to the same extent and in the same manner as if herein repeated in their entirety.

135. This count arises under the common law of trademarks and unfair competition of the State of New York. Jurisdiction over this count is proper under the doctrine of supplemental jurisdiction.

136. Defendants' aforesaid activities constitute unfair competition and an infringement of plaintiff's common law trademark and trade name rights. Such unfair competition and infringement has caused, and unless enjoined will continue to cause, plaintiff irreparable harm.

WHEREFORE, plaintiffs pray for:

1. A temporary restraining order, preliminary and permanent injunction restraining and enjoining defendants, their agents, servants, employees and attorneys, and those persons in active concert and participation with them, from:

(a) Using the business name and mark JOE'S PIZZA, either alone or in conjunction with other words that connote plaintiff, including but not limited to words such as "of Bleecker Street," "of Carmine Street," "of the Village," "the Original," "of New York City," and "the legendary" in connection with restaurant services;

(b) Using the business name and mark JOE'S PIZZA OF BLEECKER STREET, either alone or in conjunction with other words that connote plaintiff including but not limited to words such as "of Carmine Street," "of the Village," "the Original," "of New York City," and "the legendary" in connection with restaurant services;

(c) Using any terms similar to the term JOE'S PIZZA, either alone or in conjunction with other words, including but not limited to use of the term "JOSEPH," or the terms "GIUSEPPE" or "GIO" or "PINO" or other Italian equivalent nicknames for JOE or JOE'S, in connection with restaurant services, with other modifiers such as "of Bleecker Street" or "of the Village" or "the Original," "of New York City," or "the legendary" that would associate defendants or any one of them with plaintiff and plaintiff's business;

(d) Engaging in any course of conduct likely to cause confusion, deception or mistake or injure plaintiff's business, reputation or appropriate the goodwill and reputation associated with plaintiff's business and the name and mark of plaintiff's business including but not limited to:

i) using plaintiff's logo and/or stylized lettering to identify defendants' businesses;

ii) using photographs or other indicia of the plaintiff's business and store front in the promotion or marketing of defendants' businesses;

iii) listing or otherwise identifying plaintiff's business as one of defendants' businesses;

iv) informing or otherwise leading persons to believe that defendant Vitale is the "Joe" of Joes's Pizza;

v) trading on the reputation, fame and the media/publicity belonging to plaintiff,

vi) advertising or promoting defendants' businesses as originating in "the Village" or on "Carmin Street" or on "Bleecker Street" or in "NYC;"

vii) using references to "Joe" or "Joe's" or any similar term in association with the word "Pizza" in the corporate names of the defendants;

viii) using the trade dress or "look" of plaintiff's business;

ix) using celebrity photos taken at plaintiff's business location and

store front in the advertisement and promotion of defendants' businesses;

x) closing the Joe's Pizza fan and member pages established at www.facebook.com or removing defendants as admin of those pages and transferring admin responsibilities solely to plaintiff or plaintiff's designee;

(e) Directing the USPTO to cancel the two Federal Registrations that it issued to defendant Vitale, namely Reg. No. 3, 645,485 issued on June 6, 2009 of the mark JOE'S PIZZA OF BLEEKER STREET, and Reg. No. 3,508,216 issued on September 30, 2008 of the mark JOE'S PIZZA;

(f) Directing defendants to transfer to plaintiff any and all domain name registrations that include the words "joe" and "pizza" including but not limited to <joespizza.com> and <joespizza.it> domain name registrations;

(g) Directing that the corporate veil of the corporate named defendants be pierced and finding that Vitale is the alter ego of those shell corporate entities and liable personally for the conduct of those entities, as well as his own conduct; and

(h) Otherwise infringing plaintiff's trade name or mark or competing unfairly with plaintiff.

2. An accounting for profits and damages resulting from defendants activities as aforesaid, such award to be trebled in view of the willful and wanton nature of defendants' acts,

3. An award for statutory damages for cyber piracy;

4. An award for of plaintiff's attorneys' fees and costs;

5. Punitive damages as determined by the Court; and

6. Such other and further relief as may be just and appropriate under the circumstances.

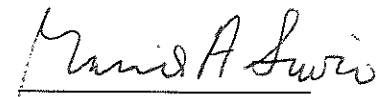
JURY TRIAL DEMANDED

Plaintiff demands a jury trial on all issues triable by jury.

Dated: New York, New York
November 23, 2010

GOTTLIEB, RACKMAN & REISMAN, P.C.

Attorneys for Plaintiff

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