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AMSTER, ROTHSTEIN & ENGELBERG

COUNSELORS AT LAW
PATENTS · TRADEMARKS · COPYRIGHTS

90 PARK AVENUE
NEW YORK, NEW YORK 10016

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NEIL M. ZIPKIN
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JOEL E. LUTZKER
MILTON SPRINGUT
LAWRENCE B. GOODWIN (D.C. BAR)
TERRY S. ZISOWITZ

Speck
Esy
CABLE ADDRESS
AMROTHPAT

TWX NUMBER
710-581-4766

TELECOPIER NO.
212-286-0854

TELEPHONE NO.
212-697-5995

February 24, 1982

Ms. Marcy Syms
Syms Haberdashery Inc.
300 Chubb Avenue
Lyndhurst, New Jersey 07071

Re: The Maresca/Wolff Organization, Inc.
v. Syms Haberdashery, Inc.
Civil Action No. 81 Civ 8109 (VLB)

Dear Marcy:

Confirming our telephone conversation of yesterday, the suit commenced by Maresca/Wolff in the United States District Court for the Southern District of New York against Syms was voluntarily dismissed by Maresca/Wolff, following our service of a Motion for Dismissal. I enclose for your records a copy of the Notice of Dismissal and of our Motion.

This dismissal does not affect the Opposition which Syms has brought against Maresca/Wolff in the United States Patent and Trademark Office.

Sincerely,

AMSTER, ROTHSTEIN & ENGELBERG

Joel E. Lutzker
Joel E. Lutzker

JEL/bbs
Encl.

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

-----X
THE MARESCA/WOLFF ORGANIZATION,
INC.,

Plaintiff,

v.

SYMS HABERDASHERY, INC.,

Defendant.

X

:

:

:

:

:

Civil Action No.

81 CIV 8109 (VLB)

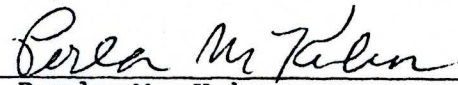
NOTICE OF DISMISSAL

-----X

Plaintiff hereby dismisses the above entitled
action pursuant to Rule 41(a)(1) of the Federal Rules of
Civil Procedure.

Dated: February 22, 1982

OFFNER AND KUHN

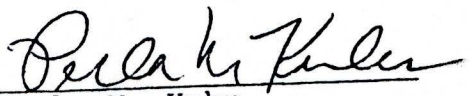

Perla M. Kuhn

Attorneys for Plaintiff
The Maresca/Wolff Organization,
Inc.

1412 Broadway
New York, New York 10018
(212) 221-0864

CERTIFICATE OF SERVICE

It is hereby certified that on the date set forth below a copy of the foregoing NOTICE OF DISMISSAL HEREIN PURSUANT TO RULE 41(a)(1) FED.R.CIV.P. was served, by hand, upon Joel E. Lutzker, Esq., Attorney for Defendant, AMSTER, ROTHSTEIN & ENGELBERG, 90 Park Avenue, New York, New York 10016.


Perla M. Kuhn

Dated: February 22, 1982

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

- - - - -x

THE MARESCA/WOLFF ORGANIZATION, :
INC., :

Plaintiff, :

v. : Civil Action No.

81 Civ 8109 (VLB)

SYMS HABERDASHERY, INC., :

Defendant. :

- - - - -x

NOTICE OF MOTION AND MOTION FOR AN ORDER
DISMISSING THE COMPLAINT HEREIN
PURSUANT TO RULE 12, FED.R.CIV.P.

PLEASE TAKE NOTICE that on March 1, 1982 at 9:30 A.M.,
defendant Syms Haberdashery, Inc. will move this Court for an Order:
(1) dismissing the Complaint herein with prejudice, pursuant to
Rule 12(b)(1) and (6), Fed.R.Civ.P., on the grounds that this Court
lacks jurisdiction over the subject matter of the Complaint and that
the Complaint fails to state a claim upon which relief can be
granted; and (2) granting its reasonable costs and attorneys' fees
in making this Motion.

This Motion is supported by the accompanying Memorandum of
Law.

Respectfully submitted,
AMSTER, ROTHSTEIN & ENGELBERG
Attorneys for Defendant
Syms Haberdashery, Inc.
90 Park Avenue
New York, New York 10016

New York, New York
February 19, 1982

By _____
Joel E. Lutzker

CERTIFICATE OF SERVICE

It is hereby certified that on the date set forth below a copy of the foregoing NOTICE OF MOTION AND MOTION FOR AN ORDER DISMISSING THE COMPLAINT HEREIN PURSUANT TO RULE 12, FED.R.CIV.P. was served, by first class mail, postage prepaid, upon attorneys for Plaintiff, OFFNER AND KUHN, 1412 Broadway, New York, New York 10018.

Joel E. Lutzker

Dated: February 19, 1982

Syms sued over service mark

NEW YORK (FNS) — The Maresca-Wolff Organization, Inc., has filed suit in federal court against Syms Haberdashery, Inc., for \$5 million because Syms is trying to block Maresca-Wolff's registration of its service mark, The Educated Consumer.

Maresca-Wolff organizes promotional campaigns to increase effectiveness of cooperative advertising between its clients and their retail outlets.

Federal registration of its service mark was applied for in 1979, but Syms did not raise objections until two years later, the suit says.

Syms owns a federal registration for its slogan, An Educated Consumer Is Our Best Customer. It claims Maresca-Wolff's service mark is an imitation, according to an affidavit filed by Alfred Hemingway Jr., attorney for Maresca-Wolff.

The affidavit charges Syms' slogan is defective in context because "Syms retails clothing of 'seconds' quality and clothing made to order for it, but leaving the labels of others without advising its customers of such facts."

Maresca-Wolff also claims its use of The Educated Consumer would not hurt Syms but Syms' attempt to block registration of the service mark is hurting Maresca-Wolff.

Maresca-Wolff is seeking registration of its service mark, cancellation of Syms' slogan registration and the \$5 million in punitive damages.

Judge Vincent Broderick has been assigned to the case. Offner & Kuhn is representing Maresca-Wolff.

Maresca-Wolff Sues Syms on Service Mark

NEW YORK (FNS) — The Maresca-Wolff Organization Inc., has filed suit in Federal Court against Syms Haberdashery, Inc., for \$5 million because Syms is trying to block Maresca-Wolff's registration of its service mark, "The Educated Consumer."

Maresca-Wolff organizes promotional campaigns to increase effectiveness of cooperative advertising between its clients and its clients' retail outlets.

Federal registration of its service mark Consumer was applied for in June 1979, but Syms did not raise its objections until two years later, the suit says.

Syms owns a Federal registration for its slogan, "An Educated Consumer Is Our Best Customer." It claims that Maresca-Wolff's service mark is an imitation, according to an affidavit filed by Alfred Hem-

ingway, Jr., an attorney for Maresca-Wolff.

The affidavit charges that Syms' slogan is defective in context because "Syms retails clothing of 'seconds' quality and clothing made to order for it, but leaving the labels of others without advising its customers of such facts."

Maresca-Wolff also claims that its use of "The Educated Consumer" would not hurt Syms but that Syms' attempt to block registration on the service mark is hurting Maresca-Wolff.

Maresca-Wolff is seeking registration of its service mark, cancellation of Syms' slogan registration and the \$5 million in punitive damages.

Judge Vincent Broderick has been assigned to the case. Offner & Kuhn is representing Maresca-Wolff.

Sir:-Please take notice that the within is a (*certified*) true copy of a Judgment and Order duly entered in the office of the clerk of the within named court on December 24, 19 91

Dated, December 26, 1991

Yours, etc.,

HELLER, HOROWITZ & FEIT, P.C.

Attorneys for defendants

Office and Post Office Address

292 MADISON AVENUE

NEW YORK, N.Y. 10017

To S. Herman Klarsfeld, Esq.

Attorney(s) for Plaintiff

NOTICE OF SETTLEMENT

Sir:-Please take notice that an order

of which the within is a true copy will be presented for settlement to the Hon.

one of the judges of the within named Court, at

on 19

at M.

Dated,

Yours, etc.,

HELLER, HOROWITZ & FEIT, P.C.

Attorneys for

Office and Post Office Address

292 MADISON AVENUE

NEW YORK, N.Y. 10017

To

Attorney(s) for

Index No. 21521

Year 1989

SUPREME COURT OF THE STATE OF NEW YORK
COUNTY OF NEW YORK

RICHARD SYMS (formerly k/a
RICHARD MERNS),

Plaintiff,

-against-

SY SYMS (formerly k/a SY SYMS
MERNS) and IRWIN M. ROSENTHAL,

Defendants.

JUDGMENT and ORDER

with NOTICE OF ENTRY

HELLER, HOROWITZ & FEIT, P.C.

Attorneys for Defendants

Office and Post Office Address, Telephone

292 MADISON AVENUE

NEW YORK, N.Y. 10017

(212) 685-7600

To

Attorney(s) for

Service of a copy of the within

is hereby admitted.

Dated,

Attorney(s) for

STATE OF NEW YORK, COUNTY OF

SS.:

I, the undersigned, an attorney admitted to practice in the courts of New York State,

☐ Certification By Attorney certify that the within
has been compared by me with the original and found to be a true and complete copy.
☐ Attorney's Affirmation state that I am
the attorney(s) of record for
action; I have read the foregoing
the same is true to my own knowledge, except as to the matters therein alleged to be on information and belief, and as to those matters I believe it to be true. The reason this verification is made by me and not by

in the within
and know the contents thereof;

The grounds of my belief as to all matters not stated upon my own knowledge are as follows:

I affirm that the foregoing statements are true, under the penalties of perjury.

Dated:

.....
The name signed must be printed beneath

STATE OF NEW YORK, COUNTY OF

SS.:

I, being duly sworn, depose and say: I am

☐ Individual Verification in the within action; I have read the foregoing
and know the contents thereof; the same is true to my own knowledge, except
as to the matters therein stated to be alleged on information and belief, and as to those matters I believe it to be true.
☐ Corporate Verification the of
a corporation and a party in the within action; I have read the foregoing
and know the contents thereof; and the same is true to my own knowledge,
except as to the matters therein stated to be alleged upon information and belief, and as to those matters I believe it to be true. This
verification is made by me because the above party is a corporation and I am an officer thereof.

The grounds of my belief as to all matters not stated upon my own knowledge are as follows:

Sworn to before me on

19

.....
The name signed must be printed beneath

STATE OF NEW YORK, COUNTY OF

SS.:

(If more than one box is checked — indicate after names type of service used.)

I,
of age and reside at

being sworn, say: I am not a party to the action, am over 18 years

On 19 I served the within

☐ Service By Mail by depositing a true copy thereof enclosed in a post-paid wrapper, in an official depository under the exclusive care and custody of the U.S. Postal Service within New York State, addressed to each of the following persons at the last known address set forth after each name:
☐ Personal Service on Individual by delivering a true copy thereof personally to each person named below at the address indicated. I knew each person served to be the person mentioned and described in said papers as a party therein:
☐ Service By Electronic Means by transmitting the papers by electronic means to the telephone number listed below, which number was designated by the attorney for such purpose. I received a signal from the equipment of the attorney served indicating that the transmission was received. I also deposited a true copy of the papers, enclosed in a post-paid wrapper, in an official depository under the exclusive care and custody of the U.S. Postal Service, addressed to the attorney at the address set forth after the name:
☐ Overnight Delivery Service by depositing a true copy thereof, enclosed in a wrapper addressed as shown below, into the custody of
for overnight delivery, prior to the latest time designated by that service for overnight delivery.

Sworn to before me on

19

.....
The name signed must be printed beneath

Bernard S. Black, all sworn to May 31, 1991 and Irwin M. Rosenthal, sworn to June 4, 1991, the supplemental affidavit of Richard F. Horowitz, sworn to October 11, 1991 and the letter to the Court of Richard F. Horowitz, sworn to October 23, 1991, all in support of defendants' motion for summary judgment and in opposition to plaintiff's cross-motion for summary judgment; and plaintiff's Notice of Cross-Motion for Summary Judgment, dated April 7, 1991, and the affidavits of Richard Syms, sworn to April 7, 1991 and Alfred L. Simon, sworn to March 23, 1991 and the affirmation of S. Herman Klarsfeld, dated April 7, 1991, the reply affidavits of Richard Syms and Ruth Merns, both sworn to September 10, 1991, and Alfred L. Simon, sworn to September 3, 1991 and the supplemental affirmation of S. Herman Klarsfeld, dated October 22, 1991 and the supplemental affidavit of Alfred L. Simon, sworn to October 21, 1991, all in opposition to defendants' motion for summary judgment and in support of plaintiff's cross-motion for summary judgment; and upon this Court's decision, dated October 24, 1991, it is, upon motion of Heller, Horowitz & Feit, P.C., attorneys for defendants,

ORDERED ^{and} ADJUDGED ~~AND DECIDED~~ as follows:

1. Defendants' motion for summary judgment dismissing the Complaint with prejudice is granted, and the Complaint is dismissed on the merits and with prejudice.

2. Defendants Sy Syms and Irwin M. Rosenthal shall have judgment against the plaintiff Richard Syms of Alpine, New Jersey

At an IAS Part 9 of the Supreme Court
of the State of New York, held in and
for the County of New York at 80
Centre Street, New York, New York on
the 11 day of December 1991.

Present: Honorable Karla Moskowitz, Justice

-----X
RICHARD SYMS (formerly k/a
RICHARD MERNS),

Plaintiff,

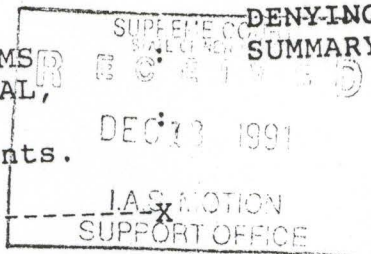
-against-

SY SYMS (formerly k/a SY SYMS
MERNS) and IRWIN M. ROSENTHAL,

Defendants.

Index No. 21521/89

JUDGMENT AND ORDER
DISMISSING COMPLAINT
WITH PREJUDICE AND
DENYING PLAINTIFF'S
SUMMARY JUDGMENT MOTION



Defendants having moved for summary judgment dismissing
the Complaint and plaintiff having cross-moved for summary judgment
for the relief demanded in the Complaint and a hearing having been
held on said motions on October 24, 1991 and, after due
deliberation, the Court having rendered its decision in open court
granting defendants' motion for summary judgment and denying
plaintiff's cross-motion for summary judgment.

Now, upon reading and filing defendants' Notice of Motion
for Summary Judgment, dated September 7, 1990 and the affidavits of
Marcy Syms Merns, Sy Syms and Adrienne Merns, all sworn to August
27, 1990, Stephen Merns and Richard F. Horowitz, both sworn to
September 6, 1990, all in support of defendants' motion for summary
judgment; and the reply affidavits of Marcy Syms Merns, Sy Syms and

in the sum of \$633.50, representing the costs and disbursements of this action as taxed.

3. Defendants shall have execution for that amount.

4. Plaintiff's cross-motion for summary judgment is denied.

ENTERED

[Handwritten signature]

~~Justice of the Supreme Court~~

V.S.C.

Judgment entered this day
of November 1991.

Clerk

AMSTER, ROTHSTEIN & EBENSTEIN

COUNSELORS AT LAW

PATENTS • TRADEMARKS • COPYRIGHTS

90 PARK AVENUE

NEW YORK, NEW YORK 10016

(212) 697-5995

INTERNATIONAL DEPARTMENT

DAVID R. BROWN*

CABLE ADDRESS

AMROTHPAT

TWX NUMBER

710-581-4766

FACSIMILE NOS.

212-286-0854

212-286-0082

*NON-LAWYER

**NOT ADMITTED

IN NEW YORK

MORTON AMSTER
JESSE ROTHSTEIN
DANIEL S. EBENSTEIN
PHILIP H. GOTTFRIED
MICHAEL J. BERGER
NEIL M. ZIPKIN
ANTHONY F. LOCICERO
JOEL E. LUTZKER
KAREN ARTZ ASH
KENNETH P. GEORGE
DANIEL N. CALDER
NEAL L. ROSENBERG
LEONARD S. SORGI
ABRAHAM KASDAN
IRA E. SILFIN
BARBARA KOLSUN
LAURIE J. GENTILE
CINDY M. ZELSON
DOLORES A. MORO
PATRICIA A. PASQUALINI
JAMES TRAMONTANA
CHESTER ROTHSTEIN
KENNETH K. CHO
ANNE VACHON DOUGHERTY**
NEIL S. GOLDSTEIN
DAVID H. KAGAN
RUTH E. LAZAR
SHERYL D. JASSEN
GARY H. MONKA
DENISE A. LINDENAUER
VALERIE G. DUGAN**
JAMES E. HANFT
DARYL K. NEFF

November 14, 1994

Mr. Sy Syms
Syms Corp.
Syms Way
Secaucus, New Jersey 07094

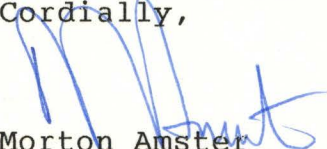
Re: SYL, Inc. and Syms Corp. v.
Syms Real Estate, Inc. and Richard W. Syms
Case No. 94-8586-Civ-Ryskamp
Our File 87800/84

Dear Sy:

Further to our letter of November 4, 1994 and our subsequent related telephone discussions, we note your agreement to insist upon the restrictions set forth in par. 4.4(b) of the Litigation Settlement Agreement (110494). Thus, if you receive any further calls from Richard, please direct him to communicate with us through his counsel.

We enclose for your information an article which appeared in the Palm Beach Daily Business Review as a result of a call by the staff writer to me. This type of publicity is good since it announces to people in Florida who seem to have a propensity toward using your slogan that Syms will take strong legal action.

Cordially,


Morton Amster

MA/mv
Encl.
2649B
cc: Ms. Marcy Syms

BUSINESS

Retailer Syms takes on Syms, the realty firm

BY PAT DUNNIGAN
REVIEW STAFF

WHEN it comes to its name and slogan, New Jersey-based Syms Corp. gets a little possessive.

Twice in the past nine months, the clothing retailer has taken aim at South Florida businesses whose names and slogans sounded a bit too familiar — even if the businesses themselves couldn't have been more dissimilar.

In the first case, it was a West Palm Beach-based carpet and upholstery cleaner whose use of the expression "become an educated consumer" in a newspaper advertisement was too close to Syms' trademarked slogan: "an educated consumer is our best customer." Syms filed suit for trademark infringement in U.S. District Court in West Palm Beach.

And though it may seem unlikely that consumers would confuse the two businesses, Syms attorney Morton Amster, of Amster, Rothstein & Ebenstein in New York, says the law is pretty clear: "If your use of somebody else's slogan brings to mind the first company, then you lose."

The case was closed Sept. 21, after Homemaid Team Cleaning Inc. and Homemaid Carpet & Upholstery Cleaning agreed to a permanent injunction against using the phrase in its advertising. No damages were awarded, and each side paid its own legal fees.

Now, Boca Raton realty firm principal Richard W. Syms could be facing a similar and possibly more expensive dilemma if Syms Corp. prevails in the federal trademark suit it filed against

Clothier Syms finds some slogans too snug a fit, sues over trademark

SYMS, FROM PAGE A1

Syms Real Estate last month.

In addition to Syms Realty's use of the slogan "because well-informed buyers are our best clients" in a newspaper ad, Syms Corp. also objects to the name of the firm and the way the name looks in print.

According to Amster, the typeface and sizing is similar to that used in brochures and advertising for the clothing retailer, which has stores in Fort Lauderdale, Miami, West Palm Beach and Tampa, and in 13 other states.

The fact that Syms happens to be Richard Syms' name is not necessarily a defense, Amster said. Richard Syms declined to comment on the suit.

According to the case law, "if it was a very common name like Smith or Jones, you can't quarrel about it," Amster said. But trademarked names that have become synonymous with another business are protected.

A classic example is the old case involving a Florida realty firm whose owners happened to be named Disney, Amster said.

West Palm Beach attorney Michael J. McHale, who represented Gary Goldstein in the Homemaid case, agrees the law on the subject is fairly strict, and says a more recent example involved a Boca Raton dog grooming salon named for its owners, the Burdines.

From a realty company's ad:
'Because well-informed buyers are our best clients.'

Amster said one of the tests the courts apply in such cases is whether there is a likelihood of confusion between the two corporations.

"Would the average person think there is some connection between Syms Realty and the Syms stores? We think the answer is yes. I would think that in the state of Florida, where Syms is a very strong retailer, they would think that Syms, the retailer, has gone into the realty business."

A second test applied by the courts is whether the defendant's use of the similar slogan "dilutes" the slogan's value to the original business, Amster said.

According to the suit, Syms Real Estate has used the Syms logo and slogan "with the express intent of causing confusion or mistake and to deceive and mislead the purchasing public and trade into believing that there is some association" between the two companies.

Syms Corp. is seeking a permanent injunction, unspecified damages, court costs and legal fees.

Slogan, logo of Boca company said to infringe on well-known trademarks