

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

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**GIACOMO’S, INC.**

**Plaintiff,**

**v.**

**GIACOMO’S ITALIAN  
MARKET LLC,  
AND  
KRISTIN RANDAZZO**

**Defendants.**

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**CIVIL ACTION NO. \_\_\_\_\_**

**JURY TRIAL DEMANDED**

**COMPLAINT**

Giacomo’s, Inc. (“Plaintiff”) by and through its counsel, Design IP, P.C., allege the following:

**PARTIES**

1. Plaintiff Giacomo’s, Inc. is a Commonwealth of Pennsylvania domestic business corporation with its principal place of business at 700 Cattell St., Easton, PA 18042.
2. On information and belief, Defendant Giacomo’s Italian Market LLC is a Commonwealth of Pennsylvania corporation with its principal place of business at 220 N. West End Boulevard, Quakertown, Pennsylvania 18951.
3. On information and belief, Defendant Kristin Randazzo is an individual residing at 2032 Huber Drive, Quakertown, PA 18951.
4. On information and belief, Kristin Randazzo is the owner of Giacomo’s Italian Market LLC.

5. Kristin Randazzo and Giacomo's Italian Market LLC are collectively referred to herein as "the Defendants."

### **JURISDICTION AND VENUE**

6. This action arises under the Lanham Act, 15 U.S.C. §§ 1114, 1121, and 1125(a). This Court has subject matter jurisdiction pursuant to 28 U.S.C. §§ 1331 and 1338(a), as well as under pendant jurisdiction of state law claims.

7. This Court has specific and general personal jurisdiction over the parties because the Plaintiff and Defendants conduct business and have places of business in the Eastern District of Pennsylvania.

8. Venue is proper in the Eastern District of Pennsylvania pursuant to 28 U.S.C. §§ 1391(b)(1) and (2) because all Defendants reside in the District and because Defendants' unlawful conduct occurred within the District.

### **NATURE OF THE CASE**

9. Plaintiff seeks injunctive relief and monetary relief against all Defendants for: service mark infringement, for their false designation of origin and false advertising under 15 U.S.C. § 1125(a); common law palming off, trademark and trade name infringement, and unfair competition.

### **FACTUAL ALLEGATIONS**

10. On October 2, 2002, Plaintiff was incorporated as a domestic business corporation with the Pennsylvania Department of State.

11. Plaintiff has remained a registered domestic business corporation, in good standing, with the Pennsylvania Corporations Bureau since its date of formation.

12. Since at least as early as 1975, Plaintiff has continuously operated at least retail store in Easton, Pennsylvania, providing retail delicatessen, restaurant, grocery store, and catering services featuring Italian specialties under the trade names “Giacomo’s Italian Market & Grille”, “Giacomo’s Italian Specialties & Grille”, and “Giacomo’s Italian Market” (hereinafter “Giacomo’s Business Names”).

13. Plaintiff opened its initial Giacomo’s store in the West Ward section of Easton in 1975. The West Ward location operated continuously until it closed in 2006.

14. Plaintiff opened a second Giacomo’s store in the College Hill section of Easton (hereinafter “Giacomo’s Store”) in 2003 and has operated continuously at that location through the date of this Complaint.

15. Since at least as early as 2018, Plaintiff used the stylize mark shown below (hereinafter “GIACOMO’S Logo”) in connection with the goods and services provided by the Giacomo’s Store.



16. Images of the storefront of the Giacomo’s Store are provided in Exhibit A.

17. Since at least as early as 1975, Plaintiff has used the trademark GIACOMO'S in connection with the goods and services offered at its store in the West Ward section of Easton and/or at Giacomo's Store (hereinafter "GIACOMO'S Trademark").

18. An example of use of the GIACOMO's trademark on Plaintiff's goods is shown below:



19. Plaintiff obtained and is the record owner of U.S. Trademark Registration No. 6,625,063 (the '063 Registration) for the GIACOMO'S Trademark for services including "retail grocery store services featuring Italian specialty foods." The '063 Registration issued on January 25, 2022, and claims dates of first use and first use in commerce of at least as early as 1975. A copy of the registration certificate is attached as Exhibit B.

20. The '063 Registration is entitled to a presumption of validity.

21. The Giacomo's Business Names, the GIACOMO'S Logo and the GIACOMO'S Trademark are referred to herein collectively as "the GIACOMO'S MARKS."

22. The term "GIACOMO'S" is a dominant portion of each of the GIACOMO'S MARKS.

23. Plaintiff has invested substantial effort and resources over many decades to develop and promote the GIACOMO'S MARKS.

24. Since 1975, Plaintiff has extensively used its GIACOMO'S MARKS to promote its Italian specialty goods and food services in advertising campaigns throughout the Lehigh Valley.

25. Plaintiff maintains a website <https://www.giacomositalianmarket.com> to promote its goods and food services using its GIACOMO'S MARKS. A screenshot of the website is attached as Exhibit C.

26. Plaintiff also promotes its Italian specialty goods and food services on social media, e.g., Instagram and Facebook, using its GIACOMO'S MARKS.

27. As a result of its investments, advertising and its reputation for high-quality goods and food services, Plaintiff has experienced sustained growth in its customer base and revenue since its inception, and has maintained considerable customer loyalty, satisfaction and goodwill associated with its GIACOMO'S MARKS.

28. On information and belief, on or about April 15, 2020, Defendant Giacomo's Italian Market LLC was incorporated with the Pennsylvania Department of State as a domestic limited liability company.

29. On information and belief, on or about April 15, 2020, Defendants began operating a food service establishment located at 220 N. West End Boulevard, Quakertown, PA 18951 under the name "Giacomo's Italian Market" (hereinafter "Defendants' Store").

30. Images of signage for Defendants' Store are attached hereto as Exhibit D.

31. The font used on the signage shown in Exhibit D is virtually identical to that used by Plaintiff in its advertising and signage.

32. Defendants' Store offers for sale grocery items, baked goods and pastries, deli, prepared meals, made-to-order sandwiches, bagel sandwiches, and catering services.

33. On information and belief, Defendants use and maintain the website <https://giacomos-italianmarket.com> to promote Defendant's Store. A screenshot of the website is attached as Exhibit E.

34. Defendant Kristin Randazzo is identified on Defendant's website as the owner of Defendant's Store.

35. Defendants promote Defendants' Store using the "Giacomo's Italian Market" name on social media, including Instagram and Facebook.

36. Plaintiff and Defendants' places of business are both located in the Lehigh Valley.

37. Plaintiff and Defendants' places of business are less than 30 miles apart.

38. At the time Defendants adopted the Giacomo's Italian Market name, Defendants were aware of Plaintiff's use of the GIACOMO'S MARKS.

39. There has been actual consumer confusion between the GIACOMO'S MARKS and Defendants' use of the Giacomo's mark in connection with Defendant's Store.

40. On or about January of 2021, Plaintiff began observing instances of customers confusing Defendants' Giacomo's Italian Market food service establishment with Plaintiff's Giacomo's Italian Market and Grille food service establishment, including:

a. callers to Plaintiff's business phone line attempting to place food orders at Defendants' Store;

b. customers attempting to pick up food orders at Plaintiff's Giacomo's Store, from an order placed to Defendants' Store;

c. customers attempting to redeem gift cards at Plaintiff's establishment that were issued by Defendant's Store;

d. negative reviews mistakenly left on Plaintiff's website by customers of Defendants' Store; and

e. social media posts mistakenly tagging Plaintiff's Giacomo's Store as the source of goods purchased at Defendant's Store (exemplary screenshots are attached hereto as Exhibit F).

41. On or about April 6, 2021, Plaintiff's counsel sent a first cease and desist letter to Defendants. A copy of the letter is attached as Exhibit G.

42. The first cease and desist letter was personally served on Crystal Palmer, an associate at Defendants' Store, on April 6, 2021.

43. Defendants received the first cease and desist letter.

44. Defendants did not respond to the first cease and desist letter.

45. On or about June 25, 2021, Plaintiff's counsel sent a follow-up letter to the Defendants. A copy of the letter is attached as Exhibit H.

46. Defendants did not respond to the follow-up letter.

47. After receipt of both cease and desist letters, Defendants continue to use the name "Giacomo's Italian Market" and have refused to cease and desist from infringing on Plaintiff's trademark rights.

48. Since Plaintiff's counsel's most recent attempt to communicate with Defendants, Plaintiff has received notice of additional instances of consumer confusion between the GIACOMO'S MARKS and Defendants' Store.

**COUNT I**  
**INFRINGEMENT OF A FEDERALLY REGISTERED TRADEMARK UNDER §32**  
**OF THE LANHAM ACT (15 U.S.C. § 1114)**  
**by All Defendants**

49. Plaintiff incorporates by reference the previous paragraphs of this complaint as if fully set forth herein.

50. The acts of Defendants described above constitute trademark infringement in violation of Section 32 of the Lanham Act, 15 U.S.C. § 1114.

51. Plaintiff owns valid and legally protectable rights in the GIACOMO'S Trademark.

52. Plaintiff's GIACOMO'S Trademark has been in continuous use for providing the services identified in the '063 Registration since at least the date of first use printed on the registration certificate, i.e., at least as early as 1975.

53. Plaintiff commenced use of the GIACOMO'S Trademark prior to the date upon which Defendants began offering food services under the name "Giacomo's Italian Market."

54. On information and belief, Defendants had actual knowledge of Plaintiff's ownership and use of the GIACOMO'S Trademark prior to Defendants' adoption and use of the confusingly similar name "Giacomo's Italian Market" in connection with the promotion and sale of its food services.

55. Defendants caused the infringing use of the GIACOMO'S Trademark in interstate commerce, at least, through their promotion of food services under the name "Giacomo's Italian Market" via their website and on social media which reach consumers throughout the United States.

56. Plaintiff has not consented, permitted, licensed, or authorized Defendants to use the GIACOMO'S Trademark.

57. Defendants' unauthorized use of the GIACOMO'S Trademark has resulted in Defendants unfairly and unlawfully benefiting from Plaintiff's goodwill.

58. Defendants' unauthorized use and promotion of the GIACOMO'S Trademark is likely and will likely continue to cause confusion, mistake, or deception on the part of consumers about the source, nature, and quality of the food services Defendants are offering, constituting trademark infringement in violation of 15 U.S.C. § 1114.

59. Several instances of actual consumer confusion between the GIACOMO's Trademark and Defendants' Store have already been documented.

60. Defendants have caused, and unless restrained and enjoined by this Court, will continue to cause irreparable harm, damage, and injury to Plaintiff, including but not limited to injury to Plaintiff's goodwill and business reputation.

61. By reason of Defendants' bad faith and willful infringement, Plaintiff is entitled to recover actual damages, treble damages, an accounting for profits, attorneys' fees and the costs of this litigation pursuant to 15 U.S.C. §1117.

## **COUNT II**

### **UNFAIR COMPETITION BY FALSE DESIGNATION OF ORIGIN BY TRADE NAME AND SERVICE MARK INFRINGEMENT UNDER 15 U.S.C §1125(a)(1)(A) by All Defendants**

62. Plaintiff incorporates by reference the previous paragraphs of this complaint as if fully set forth herein.

63. The GIACOMO'S MARKS are owned by Plaintiff and are valid and legally enforceable in association with Italian specialty goods and food services in the geographic region known as the Lehigh Valley, which includes both Easton, PA and Quakertown, PA.

64. At all relevant times, through Plaintiff's exclusive and extensive use, GIACOMO'S MARKS have acquired secondary meaning because the marks are interpreted by the consuming public not only as an identification of the goods and services, but also as a representation of the origin of those goods and services.

65. Plaintiff has extensively advertised the relevant goods and services using its GIACOMO'S MARKS in publications distributed throughout the Lehigh Valley region of Pennsylvania and New Jersey and on the internet through its website and social media.

66. At all relevant times, Plaintiff has continuously used the GIACOMO'S MARKS in interstate commerce by advertising on the internet and in printed media circulated throughout eastern Pennsylvania and New Jersey and by selling goods and rendering services under the GIACOMO'S MARKS in Pennsylvania and New Jersey.

67. Plaintiff has been the owner and exclusive user of its GIACOMO'S MARKS for its Italian specialty goods and food services in the Lehigh Valley since at least 1975 and is, therefore, the senior user of these marks.

68. Defendants were aware that Plaintiff has been providing Italian specialty goods and food services under the GIACOMO'S MARKS within the Lehigh Valley marketplace of Pennsylvania and New Jersey before Defendants entered the same marketplace.

69. On information and belief, Defendants copied Plaintiff's business name and trademarks when they chose a confusingly similar name for its business, offering very similar goods and services as Plaintiff, in the same geographic area.

70. Defendants' use of the name "Giacomo's Italian Market" to sell very similar goods and provide very similar services in the same geographic area as Plaintiff, has caused actual consumer confusion and is likely to create ongoing confusion regarding the origin of the goods and services.

71. On information and belief, Defendants use the name "Giacomo's Italian Market" with the deliberate intent of diverting business from Plaintiff and capitalizing and trading on the good will and reputation developed by Plaintiff over many years.

72. Defendants' use of the name "Giacomo's Italian Market" has caused, and will continue to cause, consumers of goods and services in the Lehigh Valley to erroneously believe

that Defendants' goods and services are being provided by, endorsed by, or associated with Plaintiff.

73. Defendants are committing the acts complained of above, and have continued to do so, in defiance of Plaintiff's requests that they cease such acts, and in spite of Plaintiff's reasonable offers to reach an amicable resolution.

74. Defendants, after due notice, have displayed a willful and wanton course of conduct toward appropriation and destruction of Plaintiff's rights in the GIACOMO'S MARKS.

75. Defendants' wrongful acts and conduct as alleged herein have permitted and will continue to permit Defendants to generate substantial sales and profits on the strength of Plaintiff's substantial advertising, sales, customer recognition and goodwill in connection with the GIACOMO'S MARKS.

76. Defendants' acts and conduct constitute unfair competition that has caused, and unless restrained and enjoined by this court, will continue to cause irreparable harm, damage and injury to Plaintiff's good will and business reputation.

**COUNT III**  
**UNFAIR COMPETITION BY FALSE ADVERTISING AND SERVICE MARK**  
**INFRINGEMENT UNDER 15 U.S.C §1125(a)(1)(B)**  
**by All Defendants**

77. Plaintiff incorporates by reference the facts and allegations in the previous paragraphs of this complaint as if fully set forth herein.

78. The Defendants' use of the name "Giacomo's Italian Market" to promote and provide goods and food services in the Lehigh Valley is confusingly similar to Plaintiff's senior rights in the GIACOMO'S MARKS and is therefore a false and misleading statement as to the source of the goods and services. The misleading statements constitute actual deception and a tendency to deceive a substantial portion of consumers of the relevant goods and services. The

deception is material because it is likely to influence purchasing decisions made by those consumers. The misleading advertised services travel in interstate commerce via the internet, through the Defendants' own website and social media. There is a likelihood of injury to the Plaintiff in terms of declining sales and loss of goodwill as a result of the false and misleading advertising.

79. Defendants' advertising of its goods and services under the name "Giacomo's Italian Market" is a misleading statement because the name is confusingly similar to the GIACOMO'S MARKS and the goods and services offered under Defendants' "Giacomo's Italian Market" are in no way connected to, endorsed by or provided by Plaintiff.

80. Defendants' advertising of goods and services under the name "Giacomo's Italian Market" misrepresents the nature, characteristics and quality of the goods and services because the goods and services are in no way connected to, endorsed by, or provided by Plaintiff.

81. The similarity of each of the GIACOMO'S MARKS to Defendants' "Giacomo's Italian Market," used to advertise the substantially the same goods and services in the same geographic area will tend to deceive a substantial portion of the intended audience because of the similarity of the marks, the similarity of the goods and services and similar channels of trade.

82. The deception is material because local advertising influences the purchasing decisions made by consumers of food related goods and services in the Lehigh Valley.

83. On information and belief, evidence of actual deception has arisen in the form of customers believing that Plaintiff is affiliated with Defendants' goods and services.

84. The advertised goods and services travel in interstate commerce because they are advertised on websites and social media platforms that are available to customers in the

Pennsylvania and New Jersey portions of the Lehigh Valley and to visitors to the Lehigh Valley located in other states.

**COUNT IV**  
**COMMON LAW UNFAIR COMPETITION, PALMING OFF,**  
**AND TRADEMARK INFRINGEMENT**  
**by All Defendants**

85. Plaintiff incorporates by reference the facts and allegations stated in the previous paragraphs of this complaint as though set forth at length herein.

86. Plaintiff's GIACOMO'S trademark and service mark are owned by Plaintiff and are valid and legally enforceable in association with Plaintiff's goods and services in the Lehigh Valley.

87. Defendants' use of "Giacomo's Italian Market" to provide very similar goods and services in the same marketplace using the same channels of trade is likely to create confusion with the GIACOMO'S MARKS regarding the origin of the goods and services.

88. At all relevant times, through Plaintiff's exclusive and extensive use of the GIACOMO'S MARKS, the GIACOMO'S MARKS have acquired secondary meaning because the name is interpreted by the consuming public not only as an identification of the goods and services, but also as a representation of the origin of those goods and services.

89. Plaintiff has been the owner and exclusive user of the GIACOMO'S MARKS for Italian specialty foods and food services in the Lehigh Valley since at least 1975.

90. Defendants' use of the name "Giacomo's Italian Market" will tend to cause and, on information and belief, has actually caused, the relevant consumers to erroneously believe that Defendants' goods and services are being provided by or associated with Plaintiff.

91. Defendants are intentionally, and with malice aforethought, causing confusion in the Lehigh Valley marketplace as to who is providing goods and services under the name “Giacomo’s Italian Market”.

92. Defendants’ actions and conduct as alleged herein constitute palming off of its goods and services as Plaintiff’s goods and services offered under the GIACOMO’S MARKS and Defendants’ actions and conduct have caused and are likely to cause consumers of Defendants’ goods and services to believe that said goods and services are being provided by or are associated with Plaintiff.

93. Such actions and conduct by Defendants constitute unfair competition under the common law of the Commonwealth of Pennsylvania.

94. Defendants’ actions and conduct in adopting and using the name “Giacomo’s Italian Market” in the Lehigh Valley constitutes trademark infringement under Pennsylvania common law.

95. Plaintiff has no adequate remedy at law and Plaintiff is being irreparably damaged by Defendants’ acts in violation of Pennsylvania common law.

96. Defendants have caused and, unless restrained and enjoined by this Court, will continue to cause irreparable harm, damage, and injury to Plaintiff, including but not limited to injury to Plaintiff’s good will and business reputation.

**COUNT V**  
**PERSONAL LIABILITY**  
**by Defendant Kristin Randazzo**

97. Plaintiff incorporates by reference the facts and allegations stated in the previous paragraphs of this complaint as though set forth at length herein.

98. On information and belief, Kristin Randazzo knowingly and significantly participated in committing acts of infringement and unfair competition as set forth above in this complaint.

99. On information and belief, Kristin Randazzo, as the owner of Defendant Giacomo's Italian Market LLC and/or as a manager holding controlling interest in said company, participated in the selection of the name "Giacomo's Italian Market" and otherwise caused Defendant Giacomo's Italian Market LLC to infringe and violate Plaintiff's right to utilize Plaintiff's GIACOMO'S MARKS in the Lehigh Valley marketplace.

100. Kristin Randazzo has ignored Plaintiff's request to cease and desist Defendant Giacomo's Italian Market LLC's infringing and unfair conduct.

101. Kristin Randazzo is personally liable to Plaintiff for any acts of infringement or unfair competition as this Court may find.

**PRAYER FOR RELIEF**

WHEREFORE, Plaintiff respectfully prays as follows:

- A. That it is decreed that Plaintiff's rights in the GIACOMO'S MARKS for food services within the Lehigh Valley Region of eastern Pennsylvania and western New Jersey, are valid and enforceable;
- B. That a permanent injunction be issued enjoining Defendants, and/or their officers, directors, partners, agents, servants, employees, attorneys, confederates, affiliates, franchisees, and all persons acting for, with, by, through or under them, and any others within their control or supervision, and all others in active concert or participation with the above, from directly or indirectly:

- i. Using the name, term, or mark “GIACOMO” or “GIACOMO’S” in association with food services, or any other similar derivation of such a mark which is likely to cause confusion in any manner in connection with the advertising, promotion, sale or rendering food services or food products;
- ii. Using the name, term, or mark “GIACOMO” or “GIACOMO’S”, or any other similar derivation of such a mark which is likely to cause confusion in any manner in connection with the advertising, promotion, sale or rendering of food services or food products, including using any such name, term or mark on internet websites, on social media platforms, or within any domain name;
- iii. Representing by any means whatsoever that Defendants and their food services or food products are associated in any way with Plaintiff or its GIACOMO’S MARKS;
- iv. Doing any other acts calculated or likely to cause confusion or mistake in the mind of the public or to lead others to believe that Defendants’ food services and food products come from or are the services or products of Plaintiff, or are somehow sponsored by or associated with Plaintiff;
- v. Otherwise unfairly competing with Plaintiff or misappropriating Plaintiff’s reputation and good will; and
- vi. Ordering Defendants to deliver up for destruction all goods, packaging, labels, wrappers, signs, prints, advertisements,

electronic files and other articles bearing any such name or term that infringes the GIACOMO'S MARKS.

vii. Ordering that Defendant's transfer ownership of the domain name giacomos-italianmarket.com to Plaintiff.

C. That Plaintiff is awarded actual damages, treble damages, an accounting for profits, attorneys' fees and the costs of this litigation.

D. That Plaintiff be awarded such further relief as this Court shall deem just and proper.

**DEMAND FOR JURY TRIAL**

Plaintiff Giacomo's, Inc. under Rule 38 of the Federal Rules of Civil Procedure, requests a trial by jury of any issues so triable by right.

Respectfully submitted,

**DESIGN IP**

Date: May 9, 2023

s/Damon A. Neagle  
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ATTORNEYS FOR GIACOMO'S, INC.

**VERIFICATION**

I, Salvatore Famularo, hereby verify that the factual statements and averments made in the foregoing Complaint are true and correct to the best of my knowledge, information and belief. I understand that the statements therein are made subject to the penalties of 28 U.S.C. § 1746 relating to unsworn falsification to authorities.

Date: 5-7-23

Signature: 