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Simone Dvoskin

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“MAMA” was Needed to Get MoMA off “MACHA[’s]” Back... But Is It A Sufficient Fix to Avoid Consumer Confusion?

BY [SIMONE DVOSKIN](#) / ON OCTOBER 12, 2018



On September 28, 2018, nearly six months after the Museum of Modern Art (“MoMA”) filed a lawsuit against art gallery-tea establishment MoMaCha, a District Court judge granted MoMA a temporary injunction enjoining MoMaCha from “using, displaying, or promoting the MOMA or MOMACHA marks, and the <https://momacha.com> domain name,” during the pendency of the lawsuit.^[1]

The MoMA was founded in 1929 as an art museum and institution that is well-regarded on a national and international level. In addition to maintaining art at its location in Manhattan, it has expanded its operations to include affiliate locations in Long Island City, numerous cafes and restaurants in Manhattan, and retail stores (the MoMA Design Store) in both New York and Japan, among other things.^[2] Since 1967, it has been using the acronym “MOMA,” and since the mid-1980s, it has been stylizing the name as “MoMA”^[3] in black and white using a specialized bold typeface adopted from Franklin Gothic.^[4] In front of the museum itself, the MoMA logo appears on a blade in a vertical format.^[5] MoMA has been using the same trademark for almost fifty years.^[6]

In April 2018, MoMA filed a complaint against MoMaCha,^[7] alleging that MoMaCha infringed on MoMA’s trademarks by creating and promoting consumer confusion.^[8] MoMaCha’s logo was in black and white, used bold Franklin Gothic typeface, and made each syllable appear on a separate line with the first letter capitalized.^[9] MoMaCha’s cups displayed “MoMaCha” stylized vertically along the cup, displayed very similarly to the MoMA blade at the front of the museum’s location.^[10] After MoMA filed a motion for preliminary injunction, MoMaCha changed the stylization of its name to “MOMACHA” using a different typeface from its predecessor.^[11] However, this was evidently not enough for the Court to allow its use to continue.

The Court determined that MoMA is a descriptive mark with secondary meaning through its fifty-year use, advertising in numerous publications, and unsolicited press coverage.^[12] The Court found that MoMaCha’s mark created a likelihood of confusion because the art gallery is located in the same city as the MoMA and its affiliated museum spaces, design stores, and cafes.^[13] It also found that the MoMaCha logo was clearly confusing to consumers due to a nearly identical typeface.^[14] The newer MOMACHA mark’s separation of syllables by itself was not enough to generate consumer confusion, but the court held the MOMACHA logo still contributed to consumer confusion because it still used bold striking letters, was in all capital letters—which resembled MoMA’s affiliates with all-caps identification, i.e. MoMA PS1 or MoMA QNS—, and intermingled the old and new logos on its platforms.^[15]

Moreover, the Court established that instances where consumers believed MOMACHA was affiliated with MoMA effectively harmed MoMA’s reputation, both before and after MOMACHA adopted the all-caps mark and imposed a disclaimer message denying affiliation with MoMA.^[16] One consumer believed MoMA infuses marijuana in its teas at its food-service establishments after seeing a social media post of MOMACHA tea, and an attorney, representing an artist whose artwork was misappropriated by MOMACHA, was concerned that MOMACHA was affiliated with the MoMA.^[17]

Since the preliminary injunction was granted, MoMaCha changed its name and is hereinafter referred to as “MAMACHA.”^[18] It has taken some steps to distance itself from MoMA’s trademark: it took down its website <https://momacha.com> and now operates

<https://mamacha.nyc>;^[19] it changed its Facebook page domain on or about October 3,^[20] from <https://facebook.com/MoMaCha> (which now presents an error message) to <https://facebook.com/MAMACHANYC>;^[21] it changed its profile picture to reflect “MAMACHA” instead of “MOMACHA”;^[22] and it changed its Instagram handle from @momachanyc to @mamacha.nyc.^[23]

Despite these updates, the *New York Times* reports that Eric Cahan, the owner of MAMACHA, received another cease and desist letter from MoMA after the preliminary injunction was issued and MAMACHA changed its name in use.^[24] Consequently, MAMACHA has not completely wiped its old name off the Internet, which may give MoMA more ammunition to argue that MAMACHA is continuing to confuse consumers.

MAMACHA has not stopped posting pictures of its cups bearing the “MOMACHA” name, indicating it has likely not stopped selling such cups yet either.^[25] However, its new website features a cup bearing the new name, “MAMACHA,” on it.^[26] No new posts have been added to the company’s Instagram bearing this aesthetic change in practice as of the date of this submission.^[27]

The tea establishment has also failed to update its Instagram link on both its website and its Facebook page. The Facebook page links to the original Instagram, @momachanyc, even though the website links to the correct, new domain (these links are presented on top of each other through Facebook’s “About” section).^[28] The website links to @momacha, an account that appears to be unrelated to the company at all, with few followers and no posts yet.^[29] This is the only social media link offered on the website’s homepage, even though below it there is an Instagram feed from the correct account.^[30] Additionally, there are still more than 1,000 hashtags on Instagram labeled “#momacha” that refer to MAMACHA’s teas, pastries, and location.^[31]

Further, it is noteworthy that in MAMACHA’s memorandum opposing the preliminary injunction (when it was using the mark “MOMACHA”), it argued emphatically that its display of the message, “* MOMACHA has no affiliation with the Museum of Modern Art or any museums *” at the beginning of its homepage on its website, the front door to the establishment, the menu, and the receipts issued to customers disclaims affiliation with the MoMA and detracts from consumer confusion.^[32] Since it moved to a different domain under the MAMACHA mark, it has removed this disclaimer.^[33]

Due to these factors, it is likely that the Court will find MAMACHA continues to confuse consumers. In determining the preliminary injunction, the Court considered that MAMACHA’s former names were used inconsistently on different platforms, and determined that its analysis had to consider the use of both MoMaCha and MOMACHA.^[34] Taking this approach, if the court must review the matter again due to the new cease and desist, the Court will have to take into consideration both the names MoMaCha and MAMACHA. Because the new logo

still contains separation of syllables, uses the same bold striking letters as in MOMACHA, is still in all capital letters, and intermingles the old and new names on its platforms, the new logo, MAMACHA, will likely be held to contribute to consumer confusion. If it fixes the cross-over of the old and new names in different media platforms, and distances itself from any use of “MO...,” then there would be a much smaller degree of confusion with MoMA and MAMACHA may be permitted to continue its use—pending its use does not confuse consumers for other similarly-sounding trademarks.

Simone Dvoskin is a second-year law student at Benjamin N. Cardozo School of Law and a Staff Editor of the Cardozo Arts & Entertainment Law Journal. She is the Co-President of the Fashion Law Society and a Committee Chair of the Cardozo Entertainment Law Society. She is interested in television, media, and advertising, and aspires to work in-house.

[1] Opinion & Injunction at 37, *Museum of Modern Art v. MoMaCha IP LLC et al.*, No. 1:18-cv-03364 (S.D.N.Y. Sept. 28, 2018), ECF No. 33.

[2] Complaint ¶¶ 7, 13-16, *Museum of Modern Art v. MoMaCha IP LLC et al.*, No. 1:18-cv-03364 (S.D.N.Y. Apr. 17, 2018), ECF No. 1.

[3] *Id.* ¶ 10.

[4] Winthrop & Weinstine, P.A., *MoMA v. MoMaCha: An Artistic Trademark Battle*, JDSupra (June 22, 2018), <https://www.jdsupra.com/legalnews/moma-v-momacha-an-artistic-trademark-33550/>. See also Opinion & Injunction, *supra* note 1, at 18.

[5] Complaint, *supra* note 2, ¶ 11.

[6] Opinion & Injunction, *supra* note 1, at 3.

[7] MoMaCha IP LLC is a company operating an art gallery and tea-themed café. The café’s name at the time of the complaint was MoMaCha. After MoMA filed a motion for preliminary injunction, MoMaCha changed its name to MOMACHA, and since the preliminary injunction was granted, has changed its name to MAMACHA.

[8] Complaint, *supra* note 2, ¶ 32.

[9] Complaint, *supra* note 2, ¶ 35; Opinion & Injunction, *supra* note 1, at 18.

[10] Complaint, *supra* note 2, ¶ 36.

[11] Complaint, *supra* note 2, ¶ 10; Defendant’s Memorandum in Opposition to Plaintiff’s Motion for Preliminary Injunction at 7, *Museum of Modern Art v. MoMaCha IP LLC et al.*, No. 1:18-cv-03364 (S.D.N.Y. May 14, 2018), ECF No. 18.

[12] Opinion & Injunction, *supra* note 1, at 15-16.

[13] Opinion & Injunction, *supra* note 1, at 16.

[14] Opinion & Injunction, *supra* note 1, at 18, 27 (“... on the present record it appears that MOMACHA’s similarity to the Museum’s mark was not accidental, but purposive” after looking at evidence that the designer of the original MoMaCha logo frequented the MoMA.).

[15] *Id.* at 19-20.

[16] *Id.* at 25-26.

[17] *Id.* at 35.

[18] MAMACHA, <https://mamacha.nyc/> (last accessed Oct. 7, 2018).

[19] *Id.*

[20] Joseph Myers, *Branded Cups at Center of Museum Versus Tea Shop Trademark Battle*, *Promo Marketing Magazine* (Oct. 3, 2018), <https://magazine.promomarketing.com/article/branded-cups-at-center-of-museum-versus-tea-shop-trademark-battle/>.

[21] MAMACHA NYC, Facebook, <https://www.facebook.com/MAMACHANYC/> (last accessed Oct. 7, 2018).

[22] *Id.*

[23] Mamacha.nyc, Instagram, <https://www.instagram.com/mamacha.nyc/> (last accessed Oct. 7, 2018).

[24] Sopan Deb, *Judge Rules in MoMA Suit: Cafe Must Change its Name*, *N.Y. Times* (Oct. 3, 2018), <https://www.nytimes.com/2018/10/03/arts/design/moma-momacha-lawsuit.html> (“The letter, which Mr. Cahan provided to *The Times*, closes by saying: ‘Changing the “O” in MOMACHA to an “A” merely indicates your clients’ continued contempt for MoMA’s trademark rights. Your clients’ decision to change to a mark of such an infringing nature will be done at their peril.’” (emphasis added) (citation omitted)).

[25] Mamacha.nyc, *supra* note 23 (posts published on September 28 and 30 depict customers holding cups that say “MOMACHA” in all capital lettering).

[26] MAMACHA, *supra* note 18; *see also* Sopan Deb, *supra* note 24 (“A spokeswoman said new cups had been ordered.”).

[27] Mamacha.nyc, *supra* note 23.

[28] MAMACHA NYC, *supra* note 21.

[29] Momacha, Instagram, <https://www.instagram.com/momacha/> (last accessed Oct. 7, 2018).

[30] MAMACHA, *supra* note 18.

[31] #momacha, Instagram, <https://www.instagram.com/explore/tags/momacha/> (last accessed Oct. 7, 2018).

[32] Defendant’s Memorandum in Opposition to Plaintiff’s Motion for Preliminary Injunction, *supra* note 11, at 9-11.

[33] *See* MAMACHA, *supra* note 18.

[34] Opinion & Injunction, *supra* note 1, at 10-11.