

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

IN RE: Trademark Application Serial No. 78/077,636

MARK: "BOB'S BURGERS HOME OF THE RANCHERO BURGER"

FILED: August 6, 2001



PUBLISHED: September 17, 2002

02-20-2003

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #01

BIG BOY RESTAURANTS)
INTERNATIONAL, LLC)
(Opposer))
)
vs.)
)
CLIFFORD SALAS)
(Applicant))
)

Opposition No. 91154340

BOX TTAB – NO FEE
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

**APPLICANT'S ANSWER TO THE NOTICE OF OPPOSITION AND AFFIRMATIVE
DEFENSES AND COUNTER-CLAIMS**

In response to the Notice of Opposition ("Notice") issued by the Trademark and Trial Appeal Board ("Board") on January 10, 2003, the Applicant Clifford Salas answers the opposition identified as follows:

1. In response to the averments of paragraph 1 of the Notice, the Applicant acknowledges that the Opposer, Big Boy Restaurants International, LLC, is a Michigan limited liability company, located at 4199 Marcy, Warren, Michigan, 48091. Applicants also avers, in response to the averments of paragraph 1 of the Notice, that Applicant is a representative of "Bob's Burgers, Inc.", a family owned

business, one franchise unit of which is located at 6628 Caminito Coors, N.W., Albuquerque, New Mexico, 87120, and run by the Salas family of Albuquerque since the 1960's.

2. In response to the averments of paragraph 2 of the Notice, the Applicant acknowledges that the Applicant has applied for the registration and use of the trademark "BOB'S BURGERS HOME OF THE RANCHERO BURGER" listed as Serial No. 78/077,636, page TM 869, of the Official Gazette of the United States Patent and Trademark Office, dated September 17, 2002.

3. In response to the averments of paragraph 3 of the Notice, Applicant acknowledges that the Applicant has applied for registration of its mark "BOB'S BURGERS HOME OF THE RANCHERO BURGER" in International Class 43 for its use in connection with restaurant services that feature New Mexico red-chile and green-chile fast food products, including, but not limited to, taco burgers, ranchero burgers, namely, red-chile and/or green chile based burgers, red-chile burgers, green chile burgers, rolled taquitos, frito pie and chile cheese fries containing red or green chile, and so forth.

4. In response to the averments of paragraph 4 of the Notice, the averments of paragraph 4 are denied.

5. In response to the statements of paragraph 5 of the Notice, Applicant is without knowledge or information sufficient to form a belief as to the truth of the averments of paragraph 5.

6. In response to the statement of paragraph 6 of the Notice, Applicant is without knowledge or information sufficient to form a belief as to the truth of the averments of paragraph 6, and based thereon denies each and every such averment.

7. In response to the averments of paragraph 7 of the Notice, Applicant is without knowledge or information sufficient to form a belief as to the truth of the averments of paragraph 7, and based thereon denies each and every such averment.

8. In response to the averments of paragraph 8 of the Notice, Applicant is without knowledge or information sufficient to form a belief as to the truth of the averments of paragraph 8, and based thereon denies each and every such averment.

9. In response to the averments of paragraph 9 of the Notice, the averments of paragraph 9 are denied.

10. In response to the averments of paragraph 9 of the Notice, the averments of paragraph 10 are denied.

11. In response to the averments of paragraph 11 of the Notice, the averments of paragraph 11 are denied.

12. In response to the averments of paragraph 12 of the Notice, the averments of paragraph 12 are denied.

13. In response to the averments of paragraph 13 of the Notice, the averments of paragraph 13 are denied.

14. In response to the averments of paragraph 14 of the Notice, the averments of paragraph 14 are denied.

AFFIRMATIVE DEFENSES

In further answer to the Notice, the Applicant asserts that:

15. The Opposer has failed to allege grounds sufficient to establish its standing to maintain the present opposition.

16. Applicant affirmatively alleges that its mark as a whole creates a separate and distinct commercial impression from the pleaded marks of Opposer and is in no way similar to the pleaded marks of Opposer. Thus, confusion between the marks is unlikely.

17. Applicant affirmatively alleges that the word "BOB'S" (including all derivations thereof) of Opposer is weak when used in the restaurant services field in that it is in common use by many other sellers in the market. Applicant further alleges that many third party registrations and uses now exist and have existed of marks that contain the word "BOB'S" (and derivations thereof) in the wide-ranging restaurant services field. Applicant further alleges that descriptive portions of composite marks are to be given less weight, on the rationale that the public will look to other portions of the marks and will not be confused unless the other portions are similar. Since the only arguably similar element between Applicant's mark (BOB'S BURGERS HOME OF THE RANCHERO BURGER) and the pleaded marks of Opposer (BOB'S) is weak, confusion between the marks is unlikely.

18. Applicant affirmatively further alleges that the differences between the parties' marks, despite the related nature of the parties' services, are sufficient that purchasers are not likely to be confused by the contemporaneous use of the marks, especially in view of the sophisticated nature of the purchasers of both parties' services and the relative care with which they are likely to make their purchasing decisions. Since consumers tend to exercise a relatively high degree of care in selecting restaurant services, confusion between the marks is unlikely.

19. Applicant affirmatively further alleges that a secondary meaning has attached to "BOB'S BURGERS HOME OF THE RANCHERO BURGER" over the last thirty years or more throughout the New Mexico geographical region and beyond because patrons of "BOB'S BURGERS HOMER OF THE RANCHERO BURGER" have come to know "BOB'S BURGERS HOME OF THE RANCHERO BURGER" as a provider of New Mexico based red-chile and green chile fast food products.

17. Applicant affirmatively further alleges that that the use of the "BOB'S BURGERS HOME OF THE RANCHERO BURGER" trademark is not confusingly similar to or likely to be confused with Opposer's various "BOB'S" trademarks because Applicant's trademark "BOB'S BURGERS HOME OF THE RANCHERO BURGER" has developed a distinctiveness of its known, also known as secondary meaning, throughout the United States, but particularly in the New Mexico geographical region, which includes Texas, Colorado and Arizona, wherein such distinctiveness and secondary meaning is associated with "fast food" restaurant services, specifically fast food restaurant services that feature New Mexico red-chile and green-chile products, such as taco burgers, ranchero burgers (i.e., New Mexico style red and/or green chile hamburgers), chile cheese fries, and so forth. The type of restaurant services provided by Applicant are very different from those provided by Opposer, and therefore confusion or likelihood of confusion would not ensue.

17. Applicant affirmatively further alleges that Opposer's trademark "BOB'S" is not associated with "fast food" restaurant services, and has never offered and does not presently offer New Mexico style green-chile and red-chile products, such as the aforementioned exemplarily products, to its customers. Additionally, none of the Opposer's "BOB'S" trademarks are associated with New Mexico style green-chile or red-chile products in the minds of the consuming public in the same manner associated with Applicant's "BOB'S BURGERS HOME OF THE RANCHERO BURGER" and therefore would not be confused nor likely to be confused with "BOB'S BURGERS HOME OF THE RANCHERO BURGER."

17. Applicant affirmatively further alleges that the Applicant's mark "BOB'S BURGERS HOME OF THE RANCHERO BURGER" does not infringe upon Opposer's mark "BOB'S" because the Opposer has acquiesced to the Applicant's use of its mark "BOB'S BURGERS HOME OF THE RANCHERO BURGER". Applicant's company, "Bob's Burgers, Inc." has been operating in New Mexico since the 1960's. Opposer, as a trademark owner has had a duty to police its mark since the 1960's, if it believed that its mark was being infringed. Opposer has waited over 30 years to try police it's marks in the region in which Applicant has utilized "BOB'S BURGERS HOME OF THE RANCHERO BURGER". Because New Mexico is a state within the geographical area of the United States, Opposer should have known of the use of a mark that it believes would infringe one or any of it's marks. Because Opposer has not properly policed its marks, and additionally has not operated any business under the mark "BOB'S" in New Mexico for many years (if ever), Opposer has in essence acquiesced to the use of the mark "BOB'S BURGERS HOME OF THE RANCHERO BURGER" by Applicant.

18. Applicant affirmatively further alleges that the company "Bob's Burgers, Inc." represented by Applicant, has utilized the mark "BOB'S BURGERS HOME OF THE RANCHERO BURGER" since 1967 in the New Mexico geographical region, during which time Opposer's BOB'S trademarks were not publicized in the New Mexico geographical area and were not well known in the New Mexico geographical area. On the other hand, the business "Bob's Burgers, Inc.," of which Applicant represents, has been operating continuously in New Mexico since the 1960's. Additionally, since at least 1967, Applicant's mark "BOB'S BURGERS HOME OF THE RANCHERO BURGER" has become prevalent and continuous and well known to the public and is associated by consumers with "fast food" restaurant services, specifically New Mexico "type" green-chile and red-chile fast food products such as taco burgers, rancho burgers, chile cheese fries and so forth.

19. Applicant affirmatively further alleges the consuming public is unlikely to confuse the mark "BOB'S BURGERS HOME OF THE RANCHERO BURGER" with Opposer's "BOB'S" mark because Applicant has not made a claim to the exclusive

right to the use the phrase "Home of the Ranchero Burger" and the word "Burgers" apart from the mark as shown.

20. Applicant affirmatively further alleges that the Opposer has effectively abandoned its use of the Opposer's "BOB'S" marks with respect to the New Mexico geographical region described herein, because Opposer has not used one or more of its federally registered "BOB'S" trademarks in the New Mexico geographical region to offer restaurant services thereof. Applicant, on the other hand, has used its mark "BOB'S BURGERS HOME OF THE RANCHERO BURGER" in connection with the operation and promotion of its restaurant services in the New Mexico geographical region since at least 1967 or earlier, wherein the New Mexico geographical region is generally considered to include Texas, Arizona, and Colorado and the State of New Mexico, given the historical and commercial connections of these regions to the State of New Mexico and former Territory of New Mexico, which once included all of the state of Arizona, and portions of the present states of Texas and Colorado. Additionally, Applicant's family business "Bob's Burgers, Inc." has operated in the New Mexico geographical region since the 1960's.

21. Applicant affirmatively further alleges that for the Applicant, the trademark "BOB'S BURGERS HOME OF THE RANCHERO BURGER" is one of its most identifying marks as to the quality and origin of the goods and services it offers to the consuming public. In particular, the company "Bob's Burgers, Inc.," of which the Applicant represents, is known by the public and consumers as the "Home of the Ranchero Burger," wherein a "Ranchero Burger" is a type of "fast food" product based on New Mexico style red-chile and/or green-chile sauces. Opposer's mark "BOB'S" does not have any such familiarity with these type of restaurant services, nor the preparation and serving of such food products, nor do the public and consumers at large associate Opposer's mark "BOB'S" with these type of restaurant services and or food products thereof.

22. Applicant affirmatively further alleges that neither Opposer's "BOB'S", registration number 1,230,137, nor "BOB'S," registration number 1,3000,991, are

registered in class 43 and/or are provide restaurant services specifically featuring New Mexico red-chile and green-chile fast food products, including taco burgers, ranchero burgers, red-chile burgers, green chile burgers, rolled taquitos, frito pie, and so forth. Therefore, the restaurant services associated with the mark BOB'S BURGERS HOME OF THE RANCHERO BURGER have not been confused with nor are likely to be confused with restaurant services associated with "BOB'S", registration number 1,230,137, or "Bob's," registration number 1,3000,991.

23. Applicant affirmatively further alleges that the Opposer will not be damaged by Applicant's use of the mark "BOB'S BURGERS HOME OF THE RANCHERO BURGER" because said mark is not a confusingly similar trademark in connection with restaurant services. Applicant's mark "BOB'S BURGERS HOME OF THE RANCHERO BURGER" is associated with restaurant services, featuring New Mexico red-chile and green-chile fast food products, including but not limited taco burgers, ranchero burgers, namely, red-chile and/or green chile based burgers, red-chile burgers, green chile burgers, rolled taquitos, frito pie and chile cheese fries containing red or green chile. The Opposer's various "BOB'S" marks are not associated with restaurant services, featuring New Mexico red-chile and green-chile fast food products, including but not limited taco burgers, ranchero burgers, namely, red-chile and/or green chile based burgers, red-chile burgers, green chile burgers, rolled taquitos, frito pie and chile cheese fries containing red or green chile. Therefore, the use of Applicant's mark "BOB'S BURGERS HOME OF THE RANCHERO BURGER" is not a confusingly similar trademark in connection with restaurant services.

24. Applicant affirmatively further alleges that the public will not be confused or deceived by Applicant's use of "BOB'S BURGERS HOME OF THE RANCHERO BURGER" because Opposer's various "BOB'S" marks have not achieved the distinctiveness and secondary meaning of Applicant's mark, particularly in the same region in which Applicant operates. For example, both native and non-native New Mexicans of the State of New Mexico, whether "Hispano," "Native American," "Anglo" or otherwise, have come to associate "BOB'S BURGERS HOME OF THE

RANCHERO BURGER" over the last thirty years or more with fast food restaurant services, particularly in connection with restaurant services, featuring New Mexico red-chile and green-chile fast food products, such as, but not limited to taco burgers, ranchero burgers, namely, red-chile and/or green chile based burgers, red-chile burgers, green chile burgers, rolled taquitos, frito pie and chile cheese fries containing red or green chile, most of which is actually grown in the State of New Mexico.

25. Applicant affirmatively further alleges that Applicant will not achieve an unfair competitive advantage because Applicant has not appropriated any goodwill established by the Opposer's user of the "BOB'S" mark. Opposer has not itself earned goodwill from the public based on restaurant services that feature New Mexico red-chile and green-chile fast food products, such as, but not limited to taco burgers, ranchero burgers, namely, red-chile and/or green chile based burgers, red-chile burgers, green chile burgers, rolled taquitos, frito pie and chile cheese fries containing red or green chile. Applicant, on the other hand, has earned goodwill from the consuming public via its mark "BOB'S BURGERS HOME OF THE RANCHERO BURGER" independent of any activities or uses of the Opposer's mark "BOB'S".

26. Applicant affirmatively further alleges that the Opposer will not mislead the consuming public into believing that Opposer is part of the restaurant services used in connection with those of Applicant's restaurant services, nor would Applicant ever desire to do so. To do so would erode or undermine the very goodwill that the Applicant has worked for over 30 years to achieve. The consuming public, since the 1960's, has come to associate restaurant services that feature New Mexico red-chile and green-chile fast food products, such as, but not limited to taco burgers, ranchero burgers, namely, red-chile and/or green chile based burgers, red-chile burgers, green chile burgers, rolled taquitos, frito pie and chile cheese fries containing red or green chile, with Applicant's mark "BOB'S BURGERS HOME OF THE RANCHERO BURGER." Opposer, on the other hand, has never provided restaurant services that feature New Mexico red-chile and green-chile fast food products, such as, but not limited to taco burgers, ranchero burgers,

namely, red-chile and/or green chile based burgers, red-chile burgers, green chile burgers, rolled taquitos, frito pie and chile cheese fries containing red or green chile.

27. Applicant affirmatively further alleges that Opposer will not be adversely affected by any loss of goodwill as a result of Applicant's use of the "BOB'S BURGERS HOME OF THE RANCHERO BURGER" mark, because Opposer has not itself developed goodwill based on the provision of restaurant services that feature New Mexico red-chile and green-chile fast food products, such as, but not limited to taco burgers, ranchero burgers, namely, red-chile and/or green chile based burgers, red-chile burgers, green chile burgers, rolled taquitos, frito pie and chile cheese fries containing red or green chile. Applicant thus affirmatively alleges that the Opposer will not and could not suffer a loss of goodwill that it has never developed or achieved in Applicant's geographical area of operation (i.e., New Mexico, Arizona, Colorado and Texas) in the first place, based on the provision of restaurant services that feature New Mexico red-chile and green-chile fast food products, such as, but not limited to taco burgers, ranchero burgers, namely, red-chile and/or green chile based burgers, red-chile burgers, green chile burgers, rolled taquitos, frito pie and chile cheese fries containing red or green chile. Therefore, the Opposer has abandoned any claim to Opposer's "BOB'S" marks due to the Opposer's lack of diligence in policing its marks.

COUNTER-CLAIMS

In further response to the Notice, the Applicant asserts the following counter-claims:

First Counter-Claim

Opposer will achieve an unfair competitive advantage by preventing Applicant from exclusively utilizing the mark "BOB'S BURGERS HOME OF THE RANCHERO BURGER" in connection with its "fast food" restaurant services that feature New Mexico red-chile and green-chile products, such as taco burgers, ranchero burgers

(i.e., New Mexico style red and/or green chile hamburgers), chile cheese fries, and so forth.

Second Counter-Claim

Applicant will be adversely affected by a loss of goodwill, which it will incur as a result of a successful opposition by Opposer because secondary meaning and distinctiveness, including many years of goodwill developed thereof, has already firmly attached to the mark, "BOB'S BURGERS HOME OF THE RANCHERO BURGER," over the last thirty years or more throughout the New Mexico geographical region and beyond because patrons of "BOB'S BURGERS HOMER OF THE RANCHERO BURGER" have come to know "BOB'S BURGERS HOME OF THE RANCHERO BURGER" as a provider of New Mexico style red-chile and green chile fast food products as described herein.

Third Counter-Claim

Registration of Opposer's "BOB'S" marks referenced herein with respect to paragraph 8 of the Notice should be cancelled or at least partially cancelled within the New Mexico geographical region defined herein (New, Mexico, Arizona, Texas and Colorado), because said "BOB'S" marks have been abandoned in this region through the failure of Opposer to properly police said marks in said New Mexico geographical region since at least 1967. Opposer is clearly relying on notices in the Official Gazette as its only means of policing its marks in the New Mexico geographical area, where Applicant has widely publicized its marks and products since the 1960's. Monitoring of the Official Gazette is not sufficient trademark "policing" when other forms of monitoring (e.g., phone books, newspapers, the Internet, etc.) for actual use of one's trademark is widely available in all markets. Applicant is aware of even more uses of "BOB'S" in association with restaurant services, providing further evidence of Opposer's clear lack of diligence in policing its mark.

RELIEF REQUESTED

1. The Applicant asks that this opposition proceeding be dismissed and that its registration issue forthwith.

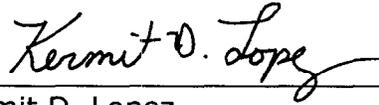
2. For counter-claim one, the Applicant asks the Board to dismiss this opposition proceeding to prevent Opposer from achieving an unfair competitive advantage.

3. For counter-claim two, the Applicant asks the Board to dismiss this opposition proceeding in order to prevent Applicant from being adversely affected by a loss of goodwill.

4. For counter-claim three, the Applicant asks the Board to cancel or partially cancel Opposer's said "BOB'S" marks with respect to the New Mexico geographical region defined herein in order to prevent Opposer from appropriating the goodwill established by Applicant's use of "BOB'S BURGERS HOME OF THE RANCHERO BURGER" and Applicant's common law trademark rights thereof since at least 1967.

WHEREFORE, since the likelihood of confusion claimed by Opposer amounts to only a speculative, theoretical possibility, Applicant prays that Application No. 78/077,636 for the mark BOB'S BURGERS HOME OF THE RANCHERO BURGER be allowed and that the Notice of Opposition be dismissed.

Respectfully submitted this 18th day of February 2003.

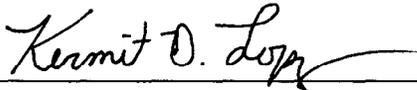
A handwritten signature in cursive script that reads "Kermit D. Lopez". The signature is written in black ink and is positioned above a horizontal line.

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ATTORNEY FOR APPLICANT

CERTIFICATE OF MAILING BY 1st CLASS MAIL

I certify that this document and fee is being deposited on February 18, 2003 with the U.S. Postal Services as 1st Class Mail under 37 C.F.R. 1.8 and is addressed to BOX TTAB-NO FEE, Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513.



Signature of Person Mailing Correspondence

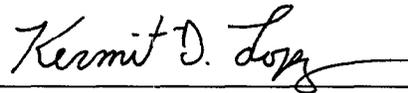
Kermit D. Lopez

Typed or Printed Name of Person Mailing Correspondence

CERTIFICATE OF SERVICE

I hereby certify that on this 18th day of February, 2003, I mailed, via first class mail, postage prepaid, a true and correct copy of the foregoing APPLICANT'S ANSWER, AFFIRMATIVE DEFENSES AND COUNTER-CLAIMS to:

Michael H. Gibbs
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February 18, 2003

02-20-2003

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #01

BOX TTAB – NO FEE
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Re: Opposition No. 91154340, Serial No. 78/077,636
Trademark Application: BOB'S BURGERS HOME OF THE RANCHERO BURGER
Applicant's Answer to the Notice of Opposition and Affirmative Defenses and Counter-Claims

Dear Sir or Madam:

Please find enclosed *Applicant's Answer to the Notice of Opposition and Affirmative Defenses and Counter-Claims* ("Answer") with respect to the above-referenced trademark application and opposition matter. Included with Applicant's Answer are a signed "Certificate of Mailing by 1st Class Mail" and a signed "Certificate of Service". A copy of the Answer has also been sent to the Opposer.

If you have any questions or concerns, please e-mail me at klopez@olpatentlaw.com. You may also call me at (214) 219-0502.

Sincerely,

Kermit D. Lopez
ORTIZ & LOPEZ, PLLC

Enc. Answer