

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

coggins

Mailed: August 11, 2009

Concurrent Use No. 94002189

Frisch's Restaurants, Inc.

v.

Big Boy Restaurants
International, LLC

Before Hairston, Rogers, and Taylor,
Administrative Trademark Judges.

By the Board:

This case now comes up on applicant's two motions to extend the suspension period and its motion to accept the concurrent use agreement between the parties.

By way of background, the Board previously denied applicant's earlier motion to accept a concurrent use agreement between the parties because that agreement failed to allege or establish facts to show that concurrent use of the parties' marks was not likely to cause confusion. The Board suspended proceedings and allowed the parties time in which to submit a new agreement that would include the necessary allegations and facts. The new agreement, accompanied by applicant's consented motion to accept the new agreement, is now before the Board.

Motions to Extend

The motions to extend the suspension are granted.

Trademark Rule 2.127(a).

Motion to Accept Agreement

In this proceeding, concurrent use applicant Frisch's Restaurants, Inc. seeks to register the mark BIG BOY, in typed form, for "tartar sauce and pies" in Class 30 and "restaurant, drive through and carryout services" in Class 43.¹ Applicant claims as its territory the states of Indiana; Kentucky; Ohio, except for the counties of Cuyahoga, Lorain, Medina, Summit, Portage, Geauga and Lake; and Tennessee, except for the counties of Anderson, Blount, Campbell, Claiborne, Cocke², Cumberland, Fentress, Grainger, Hamblen, Hancock, Jefferson, Knox, Loudon, Monroe, Morgan, Roane, Scott, Sevier and Union. Applicant recites as an exception to its exclusive right to use, use by registrant Big Boy Restaurants International, LLC of the following sixteen registered marks:

Registration No. 910758
Mark: BIG BOY (stylized with design)
Issued: March 30, 1971
Goods/Services: "restaurant services"

¹ Application Serial No. 76391539, filed April 4, 2002. Frisch's asserts January 1946 as its date of first use anywhere and date of first use in commerce.

² The parties recited "Cooke" instead of "Cocke" in the new agreement. This appears to be a typographical error inasmuch as there is no Cooke county of Tennessee, there is a Cocke county of Tennessee, and Cocke county is excluded from Frisch's territory in the underlying January 12, 2001 "Intellectual Property Use and Non-Compete Agreement" and "Transfer Agreement" between the parties.

Disclaimer: No claim is made to the exclusive right to use a pictorial representation of a hamburger apart from the mark as show.

Registration No. 913601

Mark: BIG BOY (in typed form)

Issued: June 8, 1971

Goods/Services: "publications-namely, menus, gift certificate booklets, comic books, house organs, printed labels, season's greeting cards, printed business cards, and company history pamphlets"; "foods and ingredients of foods, partly prepared, prepared, ready-to-eat and frozen-namely, seasoning salt, ham, hamburger and steak relish, onion ring dip mix, canned and frozen soups (bean soup, clam chowder and chili), tomato and spice cream french dressing, [garlic'n-oil italian dressing, thousand island dressing,] bleu cheese dressing, tartare sauce, shrimp and cocktail sauce, mayonnaise, strawberry glaze, breaded chicken, fountain syrups for use as food and in making food beverages, crackers, sugar, and beef strip loin steak"; "serving of foods and beverages in restaurants"; and "rendering technical assistance in the establishment and operation of restaurants."

Registration No. 944155

Mark: BIG BOY (in typed form)

Issued: October 3, 1972

Goods/Services: "flavored carbonated and non-carbonated non-alcoholic, maltless soft drinks and fountain syrups for making same, both for use in restaurants."

Registration No. 1166686

Mark: BIG BOY (stylized with design)

Issued: August 25, 1981

Goods/Services: "salad dressings."

Registration No. 1230170

Mark: BOB'S BIG BOY (in typed form)

Issued: March 8, 1983

Goods/Services: "hamburger sandwiches, for consumption on or off the premises" and "restaurant services."

Registration No. 1230569

Mark: BOB'S BIG BOY FAMILY RESTAURANTS (stylized with design)

Issued: March 8, 1983

Goods/Services: "restaurant services."

Disclaimer: No claim is made to the exclusive right to use the words "Family" and "Restaurants", apart from the mark as shown.

Registration No. 1230570

Mark: BOB'S BIG BOY RESTAURANTS (stylized with design)

Issued: March 8, 1983

Goods/Services: "restaurant services."

Disclaimer: No claim is made to the exclusive right to use the word "restaurants" apart from the mark as shown.

Registration No. 1806061

Mark: BIG BOY RESTAURANT AND BAKERY (stylized with design)

Issued: November 23, 1993

Goods/Services: "menus, cardboard placards, order forms, stationary, printed business application forms, printed office forms, imprinted paper labels, and instructional material; namely, job description packages" and "restaurant, concession and catering services, preparing and serving food for others."

Disclaimer: No claim is made to the exclusive right to use "restaurant and bakery" apart from the mark as shown.

Registration No. 1818909

Mark: Running big boy (design only)

Issued: February 1, 1994

Goods/Services:

"paper and paper articles; namely, placemats; cardboard and cardboard articles; namely, placards, menus; printed matter; namely, imprinted paper labels, printed application forms, printed office forms; newspaper, containing company and employee information; magazines, containing employee information, employee guidelines, franchise information brochure; books; namely,

food and franchise manual; bookbinding material; namely, folders; photographs; stationery; namely, envelopes, letterhead, notepads; adhesive materials; namely, address labels and stickers; artists, materials; namely, paint brushes; instructional and teaching material; namely, management training sheets, employee training sheets, manuals; namely, food, franchise and service instructional seminars; playing cards; printers' type and cliches (stereotype), all distributed to franchisees"; "meats, fish, poultry, seafood and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, preserves, eggs, milk and other dairy products (excluding ice milk, ice cream, and frozen yogurt); edible oils and fats; pickles; non-dairy whipped toppings, fruit toppings, and nut toppings; salads and salad dressings; soups; potatoes; namely, French fries, instant mash potatoes"; "coffee, tea, cocoa, sugar, rice, tapioca, sago, coffee substitutes; flour, and preparations made from cereals; namely, oatmeal; bread, biscuits, cakes, pastries and confectionery; namely, sticky buns, cinnamon rolls, sugar cookies, chocolate chip cookies, oatmeal raisin cookies; fruit ices; honey, treacle; yeast, baking powder; salt, mustard, pepper, vinegar; maple syrup; syrup toppings; namely, strawberry, chocolate; sauces; namely, spaghetti, tartar, tomato, chili; spices; pies; namely, fruit filled; frozen yogurt; mixes for baking products; namely, pancake mix, corn bread, hush puppies; milkshakes; chocolate based fillings"; "nonalcoholic drinks; namely, lemonade, orange juice; syrups for making soft drinks; beer, wine"; and "restaurant; food concession stands and catering services; preparing and serving food for others."

Registration No. 1823393

Mark: BIG BOY (in typed form)

Issued: February 22, 1994

Goods/Services: "restaurants; catering; concession stands featuring food and souvenirs."

Registration No. 2059156

Mark: BIG BOY DINER (stylized with design)

Issued: May 6, 1997

Goods/Services: "restaurant services including carry-out, concession and catering services, preparing and serving food others."

Disclaimer: No claim is made to the exclusive right to use "diner" apart from the mark as shown.

Registration No. 2090105

Mark: Running big boy with burger (design only)

Issued: August 19, 1997

Goods/Services: "restaurant services including carry-out, concession and catering services, preparing and serving food for others."

Registration No. 2145671

Mark: Original big boy (design only)

Issued: March 24, 1998

Goods/Services: "clothing for men, women, children and infants, namely, aprons, athletic jerseys, bandannas, bathing suits, bathrobes, beachwear, berets, Bermuda shorts, textile bibs, bow ties, boxer shorts, cardigans, cloth diapers, infant's and children's shirts, shorts, pants, overalls, jackets, textile baby bibs, sweatshirts, tee shirts, hats, belts, blouses and pullovers, caps, coats, Halloween costumes, gloves, jackets, raincoats, scarfs, shoes, slippers, socks and stockings, sweaters, ties, waistcoats, ear muffs, shoes, sandals, sneakers, galoshes, jackets, handkerchiefs, headbands, head wear and painter's caps, hosiery, infant footwear, jerseys, jogging and warm-up suits, knee highs, knitted coats, knitted headwear, long-sleeve shirts, mittens, mock T-shirts, money belts, overalls, overcoats, polo shirts, raincoats, rain shoes, robes, rompers, rubber shoes, shorts, shower caps, ski boots, ski glove, sleeved vests, sleeveless vests, sleepwear, namely, nightshirts, pajamas, baby bunting, slippers, snow suits, sport shirts, sports uniforms, suspenders, tank tops, tennis shoes, thongs (footwear), turtlenecks, vests, visors, waterproof sports jackets, windproof trousers, wraps, and wrist bands"; "toys and sporting goods - athletic equipment and sporting goods, namely, elbow pads, footballs, golf bags, golf club covers, golf putters, hockey sticks, knee pads, leg guards, golf tees and markers, tennis racket covers; basketball backboards and baskets, sporting articles, namely, golf caddie

bags, golf clubs, hockey skates, ice skates, portable ski carriers, roller skates, skateboards, ski goggles, snowboards, snow saucers, snow sleds and snow sleighs for recreational use; sporting goods, namely, golf balls, sports balls, in-line roller skates, kickboard flotation devices, swim fins, swim goggles, swim masks, toys, namely, bath toys, battery operated action toys, beanbags, board games, card games, cases for action figures, chess games, children's hobby craft kit, Christmas tree ornaments (except confectionery and illuminated articles) clothing for action figures or play figures, action skill games, costume masks, dice, dolls, doll accessories, dominoes; educational games, namely, art, history, balloons, learning resource games, mathematics, motor skills, non-fiction games; children's games, namely, historical board games; puzzle games, role-playing games; flotation device for recreational use, flying discs; games and playthings, namely, action skill games, inflatable toys, sand toys, squeezable squeaking toys; games and toys, namely, board games and card games to be used by adults and children when traveling; hand puppets, inflatable swimming pools and rafts, jack-in-the-boxes, jigsaw puzzles, kites, latex squeeze toy figures, manipulative puzzles, musical toys, paper dolls, party favors in the nature of small toys, plastic dolls of people and animals, playground balls, playsets for doll and doll houses, plush toys, pool floats, baby rattles, children's stuffed toy characters and hobby craft kits, promotional games materials, puppets, rag dolls, ride-on toys; talking dolls; toy action figures and accessories therefore; polyvinyl chloride toy figurines produced by injection molding process, toy bakeware and cookware, toy banks, toy building blocks, toy craft kits comprised of molds and molding compound for making toy figures, toy action figures, toy houses and tents, toy mobiles, toy pail and shovel sets, toy sand boxes and sand toys, toy telephones, toy 3D viewers and reels, toy watches; water squirting toys, wind-up toys, and yo-yo's"; and "restaurant services."

Registration No. 2442108

Mark: BIG BOY RESTAURANT AND MARKET (stylized with design)

Issued: April 10, 2001

Goods/Services: "menus, cardboard placards, order forms, stationery, printed business application forms, printed office forms, imprinted paper labels, and instructional material, namely job description packages" and "restaurants, concession and catering services, preparing and serving food for others."

Disclaimer: No claim is made to the exclusive right to use "restaurant and market" apart from the mark as shown.

Registration No. 2634415

Mark: BIG BOY (stylized with design)

Issued: October 15, 2002

Goods/Services: "restaurant and catering services."

Registration No. 2734047

Mark: BIG BOY ORIGINAL AT THE MOVIES (stylized with design)

Issued: July 8, 2003

Goods/Services: "restaurant and catering services."

Disclaimer: No claim is made to the exclusive right to use "original" and "at the movies" apart from the mark as shown.

By the consented motion and agreement, the parties inform the Board that registrant expressly consented to applicant's concurrent use application; that neither party will use or advertise its marks in the other party's territory; that applicant will always display the name "Frisch's" in close proximity to each display of its mark on packaging, in marketing materials and displays, and in signage in applicant's territory; that the parties do not believe that there is a likelihood of confusion caused by the parties' respective uses of their marks; that the

parties do not know of any instances of actual confusion caused by the parties' respective uses of their marks to date; and that the parties' entry into various agreements, including the earlier agreements executed in 2001, will minimize or eliminate the possibility of any confusion that might otherwise be caused by the parties' respective uses of their marks.

Upon careful consideration of the consented motion and agreement, the Board is persuaded that under the terms of the agreement, concurrent use by the parties of their involved marks will not, in fact, be likely to cause confusion. Moreover, while stipulated agreements are not binding on the Board, there can be no better assurance of the absence of a likelihood of confusion, mistake, or deception than the parties' careful consideration of their commercial interests. See *In re Four Seasons Hotels Ltd.*, 987 F.2d 1565, 26 USPQ2d 1071 (Fed. Cir. 1993), and *Amalgamated Bank of New York v. Amalgamated Trust & Savings Bank*, 842 F.2d 1270, 1275, 6 USPQ2d 1305, 1308 (Fed. Cir. 1988).

Accordingly, applicant Frisch's Restaurants, Inc. is entitled to registration of its mark BIG BOY for "tartar sauce and pies" in Class 30 and "restaurant, drive through and carryout services" in Class 43 for the geographic territory consisting of the states of Indiana; Kentucky;

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Ohio, except for the counties of Cuyahoga, Lorain, Medina, Summit, Portage, Geauga and Lake; and Tennessee, except for the counties of Anderson, Blount, Campbell, Claiborne, Cocke, Cumberland, Fentress, Grainger, Hamblen, Hancock, Jefferson, Knox, Loudon, Monroe, Morgan, Roane, Scott, Sevier and Union. (Application Serial No. 76391539.)

Registrant Big Boy Restaurants International, LLC's Registration Nos. 910758, 913601, 944155, 1166686, 1230170, 1230569, 1230570, 1806061, 1818909, 1823393, 2059156, 2090105, 2145671, 2442108, 2634415, and 2734047 will be restricted to the counties of Cuyahoga, Lorain, Medina, Summit, Portage, Geauga and Lake in the State of Ohio; the counties of Anderson, Blount, Campbell, Claiborne, Cocke, Cumberland, Fentress, Grainger, Hamblen, Hancock, Jefferson, Knox, Loudon, Monroe, Morgan, Roane, Scott, Sevier and Union in the State of Tennessee; and the remaining United States except for Indiana and Kentucky.