

ESTTA Tracking number: **ESTTA983820**

Filing date: **06/27/2019**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Redbox Automated Retail, LLC
Granted to Date of previous extension	06/30/2019
Address	One Tower Lane, Suite 900 Oakbrook Terrace, IL 60181 UNITED STATES

Attorney information	JAMES P. MURAFF NEAL, GERBER & EISENBERG LLP TWO NORTH LASALLE STREET, SUITE 1700 CHICAGO, IL 60602 UNITED STATES trademarks@nge.com, afuelleman@nge.com, jmuraff@nge.com, marden@nge.com, docktmail@nge.com 3122698000
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Applicant Information

Application No	88057808	Publication date	01/01/2019
Opposition Filing Date	06/27/2019	Opposition Period Ends	06/30/2019
Applicant	Red Robin International Inc. Suite 200N 6312 South Fiddlers Green Circle Greenwood Village, CO 80111 UNITED STATES		

Goods/Services Affected by Opposition

Class 043. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: catering services
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Grounds for Opposition


Priority and likelihood of confusion	Trademark Act Section 2(d)
Dilution by blurring	Trademark Act Sections 2 and 43(c)
Dilution by tarnishment	Trademark Act Sections 2 and 43(c)


Marks Cited by Opposer as Basis for Opposition


U.S. Registration No.	2919854	Application Date	01/08/2003
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Registration Date	01/18/2005	Foreign Priority Date	NONE
Word Mark	REDBOX		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2003/03/31 First Use In Commerce: 2003/03/31 VENDING MACHINES		

U.S. Registration No.	2988869	Application Date	01/08/2003
Registration Date	08/30/2005	Foreign Priority Date	NONE
Word Mark	REDBOX		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 2003/03/31 First Use In Commerce: 2003/03/31 Automated DVD rental services		

U.S. Registration No.	3082012	Application Date	11/10/2004
Registration Date	04/18/2006	Foreign Priority Date	NONE
Word Mark	REDBOX		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 2003/03/31 First Use In Commerce: 2003/03/31 VENDING SERVICES, NAMELY, PROVIDING RETAIL FACILITIES FEATURING AUTOMATED DVD RENTAL		

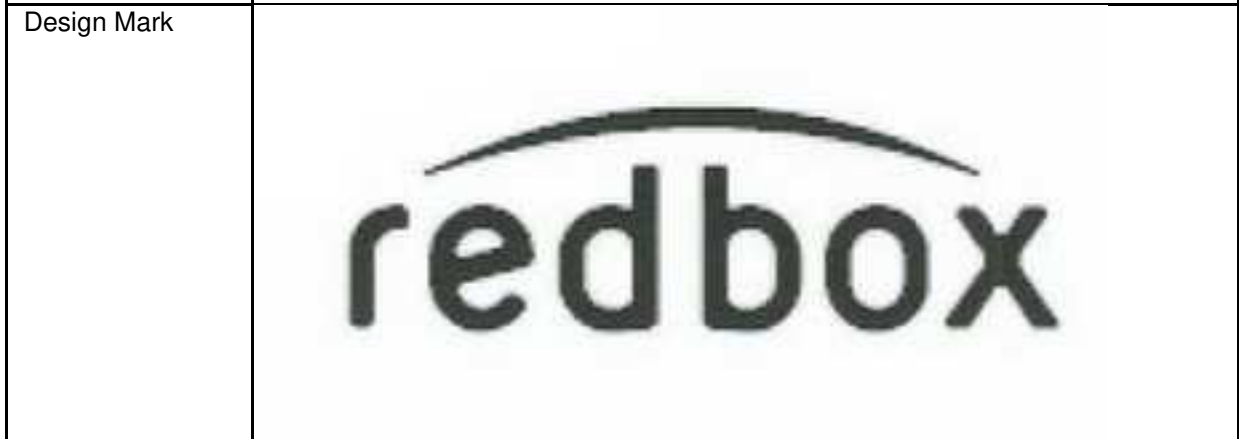
U.S. Registration No.	3229436	Application Date	04/20/2006
Registration Date	04/17/2007	Foreign Priority Date	NONE
Word Mark	REDBOX		
Design Mark			
Description of Mark	The mark consists of the word "redbox" with an arc over the word.		
Goods/Services	Class 009. First use: First Use: 2004/05/00 First Use In Commerce: 2004/05/00 Vending machines Class 041. First use: First Use: 2004/05/00 First Use In Commerce: 2004/05/00 Rental of pre-recorded DVDs on a variety of subjects through automated vending machines		

U.S. Registration No.	4418938	Application Date	01/28/2011
Registration Date	10/15/2013	Foreign Priority Date	NONE
Word Mark	REDBOX		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 2003/03/31 First Use In Commerce: 2003/03/31 Distributorship services in the field of video games, DVD's featuring movies, on-line retail store services featuring pre-recorded videos featuring entertainment in the nature of movies, motion picture films, television programs, Automated retail services, namely, providing retail facilities featuring automated retail vending machines featuring entertainment content, media, DVDs, movies and video games, for purchase and rental Class 038. First use: First Use: 2013/01/00 First Use In Commerce: 2013/01/00		

	<p>Video-on-demand transmission services, video broadcasting, transmission of voice, data, images, data signals, messages and information by electronic communications networks</p> <p>Class 041. First use: First Use: 2003/03/31 First Use In Commerce: 2003/03/31</p> <p>Rental of video recordings by means of communications networks, and providing information in the field of entertainment by means of communications networks; providing facilities for DVD, movie, and video game rental</p>
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U.S. Registration No.	4418939	Application Date	01/28/2011
Registration Date	10/15/2013	Foreign Priority Date	NONE

Word Mark	REDBOX
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Description of Mark	The mark consists of the word "redbox" with an arc over the word.
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Goods/Services	<p>Class 035. First use: First Use: 2003/03/31 First Use In Commerce: 2003/03/31</p> <p>Distributorship services in the field of video games, DVD's featuring movies, on-line retail store services featuring pre-recorded videos featuring entertainment in the nature of movies, motion picture films, television programs, Automated retail services, namely, providing retail facilities featuring automated retail vending machines featuring entertainment content, media, DVDs, movies and video games, for purchase and rental</p> <p>Class 038. First use: First Use: 2013/01/00 First Use In Commerce: 2013/01/00</p> <p>Video-on-demand transmission services, video broadcasting, transmission of voice, data, images, data signals, messages and information by electronic communications networks</p> <p>Class 041. First use: First Use: 2003/03/31 First Use In Commerce: 2003/03/31</p> <p>Rental of video recordings by means of communications networks, and providing information in the field of entertainment by means of communications networks; providing facilities for DVD, movie, and video game rental</p>
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U.S. Registration No.	4672047	Application Date	05/19/2011
Registration Date	01/13/2015	Foreign Priority Date	NONE

Word Mark	REDBOX.COM
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Design Mark	REDBOX.COM
Description of Mark	NONE
Goods/Services	<p>Class 009. First use: First Use: 2009/00/00 First Use In Commerce: 2009/00/00 Vending Machines</p> <p>Class 035. First use: First Use: 2009/00/00 First Use In Commerce: 2009/00/00 Vending machine services; automated retail vending machine kiosks featuring movies and video games; vending machine services rendered through automated kiosks featuring movies and video games; automated retail vending machine kiosk services featuring DVDs, movies, prerecorded electronic media featuring entertainment content, and video games for purchase; online retail store services featuring DVDs, movies, prerecorded electronic media featuring entertainment content, and video games for purchase; computerized online retail store services featuring pre-recorded videos; distributorship services in the field of entertainment content in the nature of DVDs, movies, video games, and digital content and pre-recorded media featuring entertainment content</p> <p>Class 041. First use: First Use: 2009/00/00 First Use In Commerce: 2009/00/00 Rental of video recordings by means of communications networks; providing information in the field of entertainment by means of communications networks; rental of DVDs, video discs, video games, movies and prerecorded electronic media featuring entertainment content</p>

U.S. Registration No.	4988910	Application Date	10/03/2012
Registration Date	06/28/2016	Foreign Priority Date	NONE
Word Mark	REDBOX		
Design Mark	REDBOX		
Description of Mark	NONE		
Goods/Services	<p>Class 041. First use: First Use: 2005/06/17 First Use In Commerce: 2005/06/17 Providing information in the field of entertainment via an interactive global computer network, networked kiosks, computers, mobile devices, game consoles, app-enabled TVs, and/or optical and magneto-optical disc players</p>		

	Class 042. First use: First Use: 2005/06/17 First Use In Commerce: 2005/06/17 Computerized online search service in the field of entertainment, namely, providing a search engine for obtaining entertainment information on a global computer network		
U.S. Application No.	87069033	Application Date	06/13/2016
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	REDBOX		
Design Mark			
Description of Mark	The mark consists of the word "REDBOX" with an arc over the word.		
Goods/Services	<p>Class 007. First use: First Use: 0 First Use In Commerce: 0 Vending machines</p> <p>Class 009. First use: First Use: 0 First Use In Commerce: 0 Computer application software for mobile phones, portable media players, and handheld computers, namely, software for viewing and renting entertainment content in the nature of movies and television programs and for reserving entertainment content in the nature of video games, movies and television programs at a vending machine</p> <p>Class 035. First use: First Use: 0 First Use In Commerce: 0 Vending machine services; automated retail vending machine kiosks featuring movies and video games; vending machine services rendered through automated kiosks featuring movies and video games; automated retail vending machine kiosk services featuring DVDs, movies, prerecorded electronic media featuring entertainment content, and video games for purchase; online retail store services featuring DVDs, movies, prerecorded electronic media featuring entertainment content, and video games for purchase; computerized online retail store services featuring pre-recorded videos; distributorship services in the field of entertainment content in the nature of DVDs, movies, video games, and digital content and pre-recorded media featuring entertainment content</p> <p>Class 038. First use: First Use: 0 First Use In Commerce: 0 Video-on-demand transmission services, video broadcasting, transmission of voice, data, images, data signals, messages and information by electronic communications networks</p> <p>Class 041. First use: First Use: 0 First Use In Commerce: 0 Rental of video recordings by means of communications networks; providing information in the field of entertainment by means of communications networks; rental of DVDs, video discs, video games, movies and prerecorded electronic media featuring entertainment content</p> <p>Class 042. First use: First Use: 0 First Use In Commerce: 0 Computerized online search service in the field of entertainment, namely, providing a search engine for obtaining entertainment information on a global computer network</p>		

U.S. Application No.	87546664	Application Date	07/28/2017
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	REDBOX.		
Design Mark			
Description of Mark	The mark consists of the word "redbox" in red with a purple period.		
Goods/Services	<p>Class 007. First use: First Use: 0 First Use In Commerce: 0 Vending machines</p> <p>Class 009. First use: First Use: 0 First Use In Commerce: 0 Computer application software for mobile phones, portable media players, and handheld computers, namely, software for viewing and renting entertainment content in the nature of movies and television programs and for reserving entertainment content in the nature of video games, movies and television programs at a vending machine</p> <p>Class 035. First use: First Use: 0 First Use In Commerce: 0 Vending machine services; automated retail vending machine kiosks featuring movies and video games; vending machine services rendered through automated kiosks featuring movies and video games; automated retail vending machine kiosk services featuring DVDs, movies, prerecorded electronic media featuring entertainment content, and video games for purchase; online retail store services featuring DVDs, movies, prerecorded electronic media featuring entertainment content, and video games for purchase; computerized online retail store services featuring pre-recorded videos; distributorship services in the field of entertainment content in the nature of DVDs, movies, video games, and digital content and pre-recorded media featuring entertainment content</p> <p>Class 038. First use: First Use: 0 First Use In Commerce: 0 Video-on-demand transmission services, video broadcasting, transmission of voice, data, images, data signals, messages and information by electronic communications networks</p> <p>Class 041. First use: First Use: 0 First Use In Commerce: 0 Rental of video recordings by means of communications networks; providing information in the field of entertainment by means of communications networks; rental of DVDs, video discs, video games, movies and prerecorded electronic media featuring entertainment content</p> <p>Class 042. First use: First Use: 0 First Use In Commerce: 0 Computerized online search service in the field of entertainment, namely, providing a search engine for obtaining entertainment information on a global computer network</p>		

Attachments	<p>78514282#TMSN.png(bytes)</p> <p>78866011#TMSN.png(bytes)</p> <p>85229209#TMSN.png(bytes)</p> <p>85229213#TMSN.png(bytes)</p>
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	85325085#TMSN.png(bytes) 85744345#TMSN.png(bytes) 87069033#TMSN.png(bytes) 87546664#TMSN.png(bytes) Notice of Opposition - THE BIG RED BOX.pdf(125414 bytes)
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Signature	/James P. Muraff/
Name	JAMES P. MURAFF
Date	06/27/2019

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

In the Matter of Application No. 88057808)	
)	
Mark: THE BIG RED BOX)	
)	
REDBOX AUTOMATED RETAIL, LLC)	
)	
Opposer,)	OPPOSITION NO. _____
v.)	
)	
RED ROBIN INTERNATIONAL INC.)	
)	
Applicant.)	

NOTICE OF OPPOSITION

This Notice of Opposition is submitted in the matter of Application Serial No. 88057808, by which Red Robin International Inc. (“Applicant”), seeks to register the trademark THE BIG RED BOX based on an intent to use the mark in connection with “catering services” in International Class 43. Redbox Automated Retail, LLC, a Delaware Limited Liability Company having a place of business at One Tower Lane, Oakbrook Terrace, Illinois 60181, believes that it would be damaged by the registration and therefore opposes the same.




The grounds for Opposition herein are as follows:


1. Redbox Automated Retail, LLC, is one of the top entertainment content distribution companies in the United States, and the premier provider of kiosk-based DVD and video game rentals and sales. Redbox has distributed more than 5 billion movies and games online and through over 41,000 locations nationwide.

2. For many years, and before the acts of Applicant alleged herein, Redbox has provided automated DVD and video game rental services, video-on-demand transmission services, streaming of audio, visual, and audiovisual material via the internet, and internet-based

entertainment content streaming services, among other services (“Services”), under and in connection with its REDBOX trademark and trade name, establishing both common law rights as well as rights under the Lanham Act. Redbox has devoted significant resources, time and effort to marketing and promoting its Services under the REDBOX trademark and trade name. Redbox maintains a website under the domain name www.redbox.com, which is available to all members of the trade and public, and which promotes its Service.

3. To further protect its REDBOX name and mark, Redbox has obtained numerous trademark registrations for its REDBOX mark including the following:

Mark	Reg. No.	Class(es)	Priority Date
REDBOX	2,919,854	Class 9	January 8, 2003
REDBOX	2,988,869	Class 41	January 8, 2003
REDBOX	3,082,012	Class 35	November 10, 2004
	3,229,436	Class 9	April 20, 2006
REDBOX	4,418,938	Classes 35, 38 and 41	January 28, 2011
	4,418,939	Classes 35, 38 and 41	January 28, 2011
REDBOX.COM	4,672,047	Classes 35, 38 and 41	May 19, 2011
REDBOX	4,988,910	Classes 41 and 42	October 3, 2012
	87069033	Classes 7, 9, 35, 38, 41 and 42	June 13, 2016

	87546664	Classes 7, 9, 35, 38, 41 and 42	July 28, 2017
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4. On information and belief, Applicant is a Nevada corporation, having a place of business at 6312 South Fiddlers Green Circle, Suite 200N, Greenwood Village, Colorado 80111.

5. On July 30, 2018, notwithstanding Redbox’s prior rights in and to its REDBOX marks, Applicant filed an application to register the mark THE BIG RED BOX in International 43, Application No. 88057808 (the “Subject Application”). The Subject Application was filed under Lanham Act §1(b) based on a intent to use.

6. The Subject Application was published in the Official Gazette of the USPTO on January 1, 2019. This Opposition is timely pursuant to the U.S. Trademark Trial & Appeal Board’s April 30, 2019 Order allowing Redbox until June 30, 2019 to institute an opposition against the Subject Application.

7. Redbox’ rights are prior to Applicant’s. Each of Redbox’ REDBOX registrations have been in actual use prior to the application filing date. Additionally, Redbox has established common law rights in its REDBOX mark (in both standard character form and in all lowercase letters) prior to Applicant’s conduct alleged herein.

8. Applicant’s THE BIG RED BOX mark is confusingly similar to Redbox’ REDBOX mark in that it is comprised entirely of the word RED BOX, together with the descriptive term BIG. Accordingly, Applicant’s THE BIG RED BOX marks create a confusingly similar commercial impression to Redbox’s REDBOX mark.

9. Furthermore, the goods and services covered by Applicant’s THE BIG RED BOX marks and Redbox’s REDBOX prior applications and registrations are closely related and

complementary, at least because food and drink products are regularly sold in vending machines, which are covered by Redbox's REDBOX marks, and as such, are the type of products and services likely to be seen as emanating from the same source under a single mark.

10. Based on information and belief, Applicant's and Redbox's respective goods and services are / will be offered to and/or seen by actual or potential customers in or around the same locations, such as in strip malls where the goods and services of Redbox are provided while at the same time the goods and services of Applicant will also be provided, in or around such same locations.

11. Applicant's THE BIG RED BOX mark is therefore likely to confuse, cause mistake among, or deceive the relevant public into believing that Applicant and Applicant's goods and services offered in connection with THE BIG RED BOX mark are sponsored by, endorsed by, or in some manner related to Redbox in violation of 15 U.S.C. §§ 1052(d), 1114(1) and 1125(a).

12. Given Redbox's considerable reputation and the renown of its REDBOX mark, registration of Applicant's THE BIG RED BOX mark is likely to cause dilution of the distinctiveness of Redbox's REDBOX mark in violation of 15 U.S.C. § 1125(c). In addition, if Applicant's services lack quality, Applicant's use of Applicant's THE BIG RED BOX mark may also tarnish Redbox's REDBOX mark, resulting in harm to Redbox's reputation in violation of 15 U.S.C. §1125(c).

13. Redbox will continue to be irreparably damaged by registration of Applicant's confusingly similar mark. Deficiencies or faults in the quality of Applicant's products and services are likely to reflect negatively upon, tarnish and seriously injure the reputation which Redbox has established for its products and services marketed under its REDBOX mark. This

likelihood of confusion and dilution is likely to result in loss of revenues to Redbox and damage to its reputation.

WHEREFORE, Redbox requests that the Subject Application be refused and that this Notice of Opposition be sustained.

Redbox authorizes the TTAB to charge the fees for opposition in one class and any additional fees related to this matter to the deposit account of Neal, Gerber & Eisenberg LLP.

Respectfully submitted,

Date: June 27, 2019

By: /James P. Muraff /
James P. Muraff, One of the Attorneys for
Redbox Automated Retail, LLC

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