

UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

FILED

FEB 25 2010

Clerk, U.S. District and
Bankruptcy Courts

BIG BOY RESTAURANTS)
INTERNATIONAL LLC,)
a Michigan limited liability company,)
One Big Boy Drive,)
Warren, MI 48091)

Plaintiff,)

v.)

EMILY SCHOENBAUM,)
an individual,)
3445 Mount Pleasant St NW,)
Washington, DC 20010)

Defendant.)

Civil Action Number: _____

Case: 1:10-cv-00303
Assigned To : Friedman, Paul L.
Assign. Date : 2/25/2010
Description: General Civil

COMPLAINT

Plaintiff Big Boy Restaurants International LLC, (“BBRI” or “Plaintiff”) for its Complaint against Defendant Emily Schoenbaum (“Schoenbaum” or “Defendant”), states as follows:

1. BBRI operates a nationally renowned family restaurant chain with locations located throughout the United States.
2. The “Big Boy” restaurant chain was initially founded in the 1930s and has grown to include 155 restaurant locations across the nation. As part of its operations, BBRI has registered and maintains a number of trademarks and copyrights related to the “Big Boy” restaurant chain.
3. BBRI recently learned that Defendant created and displayed a replica of BBRI’s Big Boy statue in Charleston, West Virginia—a practice which infringes upon BBRI’s registered copyright, and registered and common law trademark rights.

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4. Despite written demand, Defendant has refused to discontinue her infringing use, thereby necessitating the present Complaint.

JURISDICTION AND VENUE

5. BBRI is a Michigan corporation with its registered office and principal place of business located at One Big Boy Drive, Warren, Michigan 48091.

6. On information and belief, Defendant is a resident of the District of Columbia residing at 1624 Taylor Street NW, Washington, D.C. 20011.

7. This Court has subject matter jurisdiction pursuant to 15 U.S.C. § 1121 and 28 U.S.C. §§ 1331 and 1338, as Plaintiff brings claims under and pursuant to the federal Lanham Act, 15 U.S.C. §1051 *et seq.*, and under the Copyright Act, 17 U.S.C. § 101 *et seq.*

8. Venue is appropriate in this District pursuant to 28 U.S.C. §§ 1391 and 1400(a), because Defendant resides within this District upon information and belief.

GENERAL ALLEGATIONS

9. There are approximately 155 Big Boy restaurants located throughout the United States. Most of these locations are operated by independent franchisees who receive a nonexclusive license from BBRI to utilize BBRI's trademarks, copyrights, and restaurant system. In addition, BBRI directly owns and operates a number of Big Boy restaurants.

10. BBRI actively markets franchise and restaurant opportunities for the purpose of expanding its operations and adding restaurant locations.

11. BBRI's restaurant chain is nationally known throughout the country.

12. BBRI takes great care in ensuring that the goods and services provided at its restaurant locations are of a uniformly high quality. BBRI also carefully selects and approves vendors and suppliers to ensure high quality food and beverages for its customers. BBRI has in

place a rigorous system of review to ensure that its franchisees adhere to the highest standards of goods and services set by BBRI.

13. BBRI undertakes these steps in order to preserve and build upon the considerable goodwill and positive reputation it has built with the consuming public.

14. In connection with its business operations, BBRI owns United States Trademark Registration No. 0910758 for the following Big Boy service mark:



A true and accurate copy of the registration certificate is attached as Exhibit A.

15. BBRI also own common law rights in its Big Boy trademark. Collectively, BBRI federally registered trademark rights and its common law trademark rights are referred to as the "Marks."

16. BBRI markets its services through various advertising media, including on the Internet at www.bigboy.com. The Marks have also been used in print media, newspapers, trade journals, magazines, and in signs, banners, and numerous promotional materials.

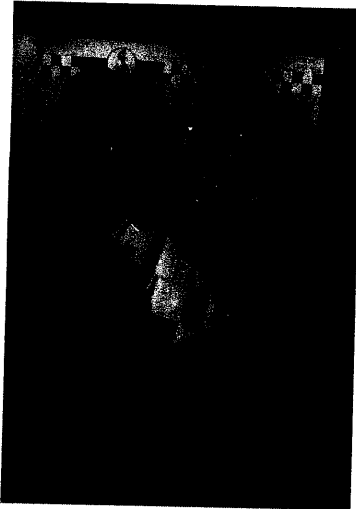
17. BBRI actively works to promote, protect and advertise its Big Boy brand and marks, and spends substantial advertising dollars marketing its goods and services under the Marks. In addition, BBRI's more than one hundred franchisees across the country also contribute significant portions of their revenues towards the promotion and advertisement of the Marks. The dilution of such Marks injures not only BBRI, but all of BBRI's franchisees.

18. Plaintiff has invested great time, effort, and resources in the development of a distinctive and well known family of trademarks and service marks, such that its products and

services have become widely recognized as emanating from Plaintiff and as maintaining uniform quality standards.

19. The Marks are distinctive, famous, nationally renowned, and have been distinctive and famous since prior to the commencement of Defendant's infringing use.

20. Plaintiff is also the owner of U.S. Copyright Registration No. VA0001697822 for the work entitled "Big Boy Statue" for a statue ("Big Boy Statue"), which is shown below:



A true and correct copy of Plaintiff's registration certificate and registered work is attached as Exhibit B.

Defendant's Infringing Activities

21. In or about 1947, Alex "Shoney" Schoenbaum was the founder of the Parkette Drive-In Restaurant in Charleston, West Virginia. Mr. Schoenbaum subsequently acquired a Big Boy franchise in or about 1951, and operated a Shoney's Big Boy Restaurant in Charleston, West Virginia.

22. In or about 1982, Shoney's licensing agreement to use the Big Boy brand was terminated. However, Mr. Schoenbaum continued to develop the Shoney's brand independent of the Big Boy brand throughout the United States.

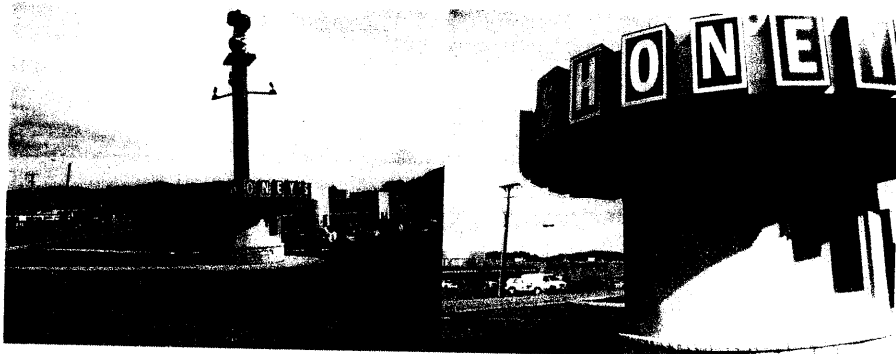
23. In or about 1996, Mr. Schoenbaum passed away and was survived by four children, including his daughter, Defendant Emily Schoenbaum.

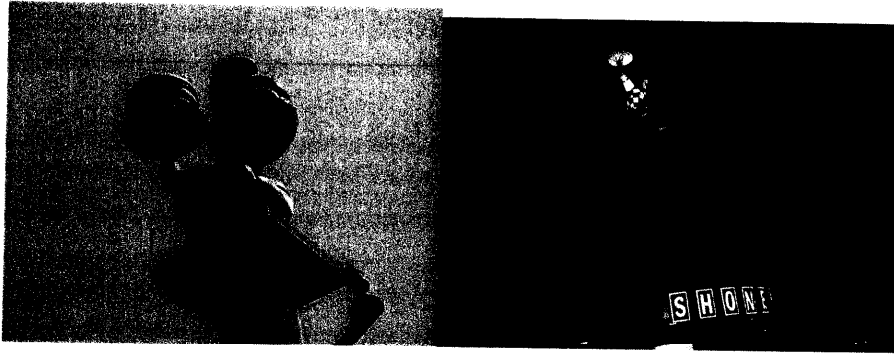
24. Shoney's currently operates hundreds of restaurants in 18 states, including 19 restaurants in West Virginia.

25. Upon information and belief, Defendant benefits directly or indirectly from the commercial success of the Shoney's brand.

26. Shoney's Restaurant continues to operate two Shoney's restaurants in Charleston, West Virginia.

27. On information and belief, Defendant commissioned, reproduced, distributed, publicly displayed, and/or created a Big Boy Statue ("Statue") at the former location of the Parkette Drive-In Restaurant in Charleston, West Virginia, depicted below:





28. On information and belief, the Statue stands on top of a pedestal that is at least 12 feet tall, which pedestal is on top of a building.

29. The Statue is identical or confusingly similar to the BBRI's Marks.

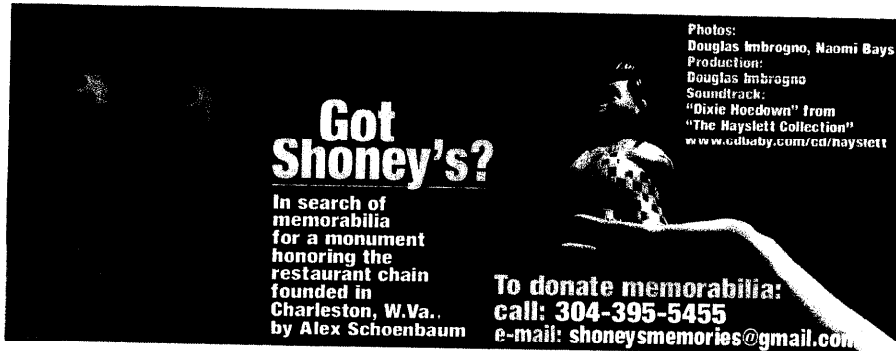
30. The Statue is substantially similar to the Big Boy Statue.

31. The Statue, on information and belief, is located less than two miles away from one of the Shoney's restaurant locations in Charleston, West Virginia. The name "Shoney's" is depicted below the Statue on the building.

32. Defendant used, commissioned, reproduced, distributed, publicly displayed, and/or created the Statue without the permission of BBRI.

33. On information and belief, Defendant also distributed hamburgers and drinks to the public at the Statue on or about October 4, 2009. Prior to the public distribution of the hamburgers, Defendant publicized that they were "Big Boy" hamburgers. See Exhibit C.

34. On information and belief, Defendant offered to purchase or has purchased Big Boy memorabilia to display in the building below the Statue. See Exhibit D. Upon information and belief, Defendant commissioned the collection of Big Boy memorabilia through the use of a website, <http://media.cnpapers.com/shoneys/>, where the following photographs are publicly displayed in a slide show:



35. On information and belief, the Statue has caused consumers to exit the highway and/or approach the Statue in the expectation of discovering a Big Boy's Restaurant that is either a franchisee of or owned by BBRI.

36. On information and belief, the Statue has deceived the public and visitors to the Statue into believing that Defendant is operating the Statue and associated building under the authority, sponsorship, or endorsement of BBRI, or with the permission or consent of BBRI, or that the building is a facility owned and operated by BBRI.

37. Defendant has conducted these commercial activities in interstate commerce.

38. Defendant's use of the Statue is an unlawful imitation of the Mark and is likely to cause confusion, mistake, or deception with regard to the Mark.

39. Defendant's use of the Statue has caused actionable confusion, mistake, or deception with regard to the Mark. One consumer stated:

"I now live in Charleston, W.V. And on Kanawha Blvd. Facing the river is the Big Boy Model holding up the cheeseburger. *At first I thought it was a Big Boy Restaurant opening up* when come to find out it's in front of some office building or something. The statue reminded me of when I was a little boy seeing that. This statue should be removed or build a Big Boy Restaurant. I just thought you might like to know what someone else is getting away with."

See Exhibit E (emphasis added).

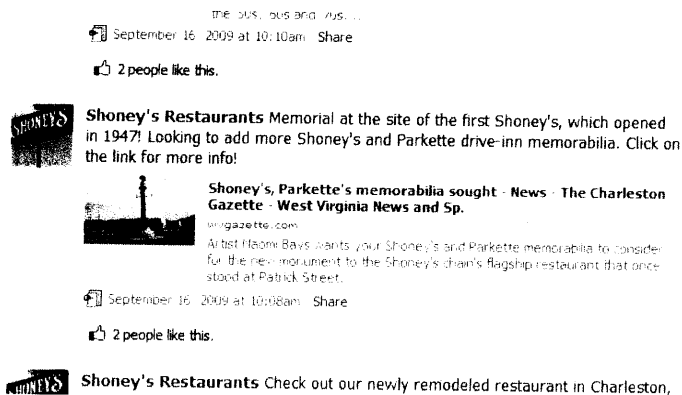
40. Defendant does not have license or permission from BBRI to use the Marks or the Big Boy Statue.

41. Ordinary consumers were likely to be confused and misled regarding the source or origin of the goods distributed by Defendant.

42. Consumers are likely to visit Defendant's Statue, believing that Shoney's goods and services originate from, or are affiliated with, endorsed, approved, or sponsored by Plaintiff.

43. BBRI's Marks are famous and Defendant's conduct adversely and irreparably harms BBRI's goodwill and business reputation, and dilutes and tarnishes the value of the Marks.

44. Upon information and belief, Defendant's conduct adversely and irreparably harmed BBRI's good business reputation by associating it with the Shoney's brand. Shoney's has even used the Statue in promoting itself by making posts on its Facebook page:



See Exhibit F at 7.

45. Defendant's conduct in infringing upon the Marks and the Big Boy Statue unjustly enriches Defendant to the detriment of BBRI.

46. On or about September 22, 2009, BBRI sent a letter requesting that all use of the Statue cease, and giving Defendant actual notice of the Marks and Defendant's infringement.

47. Despite attempts to resolve the dispute without litigation, on information and belief, Defendant has not stopped using the Marks or the Statue, and BBRI was forced to file this lawsuit as a result.

**COUNT I – FEDERAL TRADEMARK INFRINGEMENT IN VIOLATION OF
SECTION 32 OF THE LANHAM ACT**

48. BBRI incorporates all foregoing paragraphs as if each were fully restated herein.

49. BBRI's federally registered Mark, United States Trademark Registration No. 0910758, and the common law Marks are valid, protectable, and enforceable.

50. BBRI's federally registered Mark, United States Trademark Registration No. 0910758, is incontestable pursuant to 15 U.S.C. §§ 1065, 1115(b).

51. BBRI has used the Marks in United States commerce in connection with restaurant services since prior to Defendant's use of the Mark and the Statue.

52. Defendant has used the Marks and the Statue in United States commerce without BBRI's license, permission, or authorization.

53. Defendant's use of the Marks and Statue is likely to cause, and has caused, confusion or mistake, or is likely to deceive and has deceived consumers, in violation of section 32 of the Lanham Act, 15 U.S.C. § 1114.

54. Defendant knew or should have known by the exercise of reasonable care that its use of the Marks and Statue in connection with the provision of restaurant-related goods and services would cause confusion, mistake, or deception among purchasers of such goods and services, as well as the general public.

55. At the time it began using the Mark and the Statue, Defendant had constructive

notice of BBRI's federally registered Mark under 15 U.S.C. § 1072.

56. Defendant's wrongful conduct has caused BBRI to suffer and, absent intervention of the Court, will cause BBRI to continue to suffer actual damages and damage to its business, reputation, and goodwill.

57. Defendant's wrongful conduct has caused BBRI to suffer and, absent intervention of the Court, will cause Plaintiff to continue to suffer irreparable harm for which there is no adequate remedy at law.

COUNT II – UNFAIR COMPETITION AND FALSE DESIGNATION OF ORIGIN IN VIOLATION OF SECTION 43(a) OF THE LANHAM ACT

58. BBRI incorporates all foregoing paragraphs as if each were fully restated herein.

59. The Marks are valid and enforceable, and the Marks are inherently distinctive and have attained secondary meaning such that consumers identify them as originating only from BBRI.

60. Defendant is attempting to trade upon BBRI's goodwill, and Defendant's use of the Marks and Statue is likely to cause confusion, mistake, or deception as to the affiliation, connection, or association of Defendant or Shoney's with BBRI, or as to the origin, sponsorship, or approval of Defendant's commercial activities by BBRI.

61. Defendant's use of the Marks and Statue constitutes a false designation of origin which is likely to divert customers away from Plaintiff.

62. On information and belief, Defendant's conduct has been deliberate, willful, intentional and in bad faith, with disregard of BBRI's rights, and with the intent to deceive or to create mistake or confusion in the minds of BBRI's customers and of the public generally.

63. Defendant's conduct violates section 43 of the Lanham Act, 15 U.S.C. §§ 1125(a).

64. Defendant's wrongful conduct has permitted or will permit Defendant or Shoney's to earn revenues and profits on the strength of BBRI's extensive advertising, consumer recognition, and goodwill.

65. Defendant's wrongful conduct has caused BBRI to suffer and, absent intervention of the Court, will cause BBRI to continue to suffer actual damages and damage to its business, reputation, and goodwill.

66. Defendant's wrongful conduct has caused BBRI to suffer and, absent intervention of the Court, will cause BBRI to continue to suffer irreparable harm for which there is no adequate remedy at law.

**COUNT III – TRADEMARK DILUTION IN VIOLATION OF
SECTION 43(c) OF THE LANHAM ACT**

67. BBRI incorporates all foregoing paragraphs as if each were fully restated herein.

68. The Marks are distinctive and famous, and have been distinctive and famous since prior to Defendant's use of the Marks and Statue.

69. Defendant's use of the Marks and Statue in commerce has been for Defendant's commercial gain.

70. Defendant's use of the Marks and Statue in connection with the goods and services distributed at the Statue dilutes the distinctive quality of, and tarnishes the public image of the Marks, harms BBRI's reputation, and lessens the capacity of the Marks to identify and distinguish BBRI's goods and services from those of Shoney's and others.

71. Defendant's use of the Marks and Statue constitutes actual dilution of, and creates a likelihood of dilution, of the Marks, in violation of section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c).

72. On information and belief, Defendant's violation of 15 U.S.C. § 1125(c) was

willful and intentional, with knowing disregard for BBRI rights.

73. Defendant's wrongful conduct has permitted or will permit Defendant to earn substantial revenues and profits on the strength of BBRI's extensive advertising, consumer recognition, and goodwill.

74. Defendant's wrongful conduct has caused BBRI to suffer and, absent intervention of the Court, will cause BBRI to continue to suffer actual damages and damage to its business, reputation, and goodwill.

75. Defendant's wrongful conduct has caused BBRI to suffer and, absent intervention of the Court, will cause BBRI to continue to suffer irreparable harm for which there is no adequate remedy at law.

COUNT IV – COPYRIGHT INFRINGEMENT

76. BBRI incorporates all foregoing paragraphs as if each were fully restated herein.

77. Without the permission or consent of BBRI, Defendant has used and continues to use the Statue and displays it publicly.

78. Upon information and belief, without the permission or consent of BBRI, Defendant reproduced, prepared derivative works, and/or publicly displayed the Statue which are substantially similar, if not strikingly similar, to BBRI's copyrighted Big Boy Statue.

79. Defendant's actions constitute copyright infringement of BBRI's copyrights and exclusive rights in the Big Boy Statue under copyright, under 17 U.S.C. § 101, *et seq.*

80. Upon information and belief, Defendant's acts of infringement have been willful and intentional, in disregard and with indifference with the rights of BBRI.

81. BBRI has no adequate remedy at law.

COUNT V – CONTRIBUTORY COPYRIGHT INFRINGEMENT

82. BBRI incorporates all foregoing paragraphs as if each were fully restated herein.

83. Defendant's conduct, as alleged in this Complaint, constitutes contributory infringement of Plaintiff's copyright in violation of Sections 106 and 501 of the Copyright Act.

84. Defendant directly encouraged, facilitated, and/or induced the unauthorized reproduction, adaptation, and public display of Plaintiff's copyrighted work by others; thus, Defendant is contributory liable for Plaintiff's damages resulting from the same.

85. Plaintiff is entitled to recover from Defendant the damages he has sustained and will sustain, and any gains, profits and advantages obtained by Defendant as a result of Defendant's contributory infringement, or in the alternative statutory damages, as well as attorneys' fees, and including but not limited to such damages and awards as are available under 17 U.S.C. §§ 504-505.

86. Plaintiff has no adequate remedy at law.

PRAYER FOR RELIEF

WHEREFORE, BBRI prays that this Court issue judgment:

A. In the form of permanent injunctive relief that enjoins Defendant from: 1) using any advertising or promotional material referencing BBRI; 2) using any of the Marks, or the Statue, or any confusingly similar words, phrases, symbols, or combinations thereof in connection with the operation of the Statue; 3) using any of the Marks, including without limitation the phrases "Big Boy," "Big Boy's," or any other similar variations of such phrases invoking the name "Big Boy" in any way in connection with the operation of food services; 4) using any other designation which is confusingly similar to any of the Marks, or that is likely to create the impression that Shoney's is associated with BBRI or is endorsed, authorized, or sponsored by

BBRI; 5) engaging in unfair competition by infringing, misappropriating, or diluting any of the Marks; 6) advertising or representing, directly or indirectly, that Defendant or Shoney's is in any way affiliated with BBRI; 7) engaging in any actions in which Defendant holds out itself or Shoney's as having any association with BBRI; 8) destroying any evidence of Defendant's infringement or Defendant's profits, or other benefits resulting from Defendant's operations including without limitation its infringing conduct alleged above;

B. That BBRI be afforded such other relief to which it is entitled pursuant to 15 U.S.C. § 1116;

C. That BBRI recover damages arising out of Defendant's infringement and unfair competition;

D. That BBRI be awarded its reasonable attorneys' fees and expenses pursuant to 15 U.S.C. § 1117;

E. That BBRI be awarded its taxable costs and disbursements in this action pursuant to 15 U.S.C. § 1117;

F. That this Court order the destruction or impounding of all infringing articles following final judgment in this action pursuant to 15 U.S.C. § 1118;

G. That Plaintiff be awarded: 1) Defendant's profits realized as a result of the copyright infringement, or in the Court's discretion, such sum as the Court find to be just; 2) damages sustained by Plaintiff; 3) reasonable attorneys fees; and 4) the costs of the action;

H. That BBRI be awarded prejudgment and post-judgment interest on any monetary award in this action; and

I. That BBRI be awarded such other relief as this Court deems just and equitable.

JURY DEMAND

Plaintiff hereby demands a trial by jury on all claims for which there is a right to jury trial.

Dated: Feb. 24, 2010

By: 

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