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

Proceeding	91175984
Party	Defendant Macbar LLC Macbar LLC 19 East 80th Street, #4-B New York, NY 10021
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Date	04/09/2007
Attachments	Answer McDonalds.pdf (7 pages)(676962 bytes)

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

In the Matter of:
Application Serial No. 78/792,269
Published in Official Gazette on 9/5/06
----------X Opposition No. 91175984
McDONALD'S CORPORATION,

Opposer,

v.

MACBAR, LLC,

Applicant.
----------X

APPLICANT'S ANSWER TO NOTICE OF OPPOSITION

Applicant Macbar LLC, its attorney, hereby responds to the allegations set forth in the Notice of Opposition as follows:

1. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in the following paragraphs in Notice of Opposition: 2, 3, 4, 5, 6, 7, 8, and 9.

2. Applicant denies the allegations in the following paragraphs in the Notice of Opposition: 10, 12, 13, 14, and 15.

3. Applicant admits the allegations in the following paragraphs in the Notice of Opposition: 1.

4. With respect to paragraph 11 of the Notice of Opposition, Applicant admits that it filed an application to register the Macbar mark and denies the rest of the allegations contained therein.

AFFIRMATIVE DEFENSES

5. As a first and separate affirmative defense, Applicant's mark is suggestive of the quality and characteristic of Applicant's goods and services and is thus entitled to trademark status and registration. Applicant intends to operate restaurants which sell only macaroni and cheese dishes as entrees. "Mac and cheese" is a common, shorthand expression for a macaroni and cheese dish. Therefore, Applicant's Macbar trademark is suggestive because imagination, thought or perception is required to reach a conclusion as to the nature of Applicant's goods and services.

6. As a second and separate affirmative defense, Applicant is informed and believes that Opposer has never distributed, marketed and/or sold a macaroni and cheese dish and does not intend to distribute, market and/or sell such an item. Therefore, Opposer's alleged marks do not entitle Opposer to prevent the limited use of Applicant's mark to sell macaroni and cheese dishes.

7. As a third and separate affirmative defense, Applicant is informed and believes and on this basis asserts that Opposer's claim is barred from recovery due to the fact that the MAC portion of Applicant's mark is simply an abbreviation for "macaroni" and thus descriptive of Applicant's goods and services used in connection with the Macbar trademark. As such, Opposer may not claim exclusive ownership rights in the portion of a mark that is merely descriptive.

8. As a fourth and separate affirmative defense, Applicant is informed and believes and this basis asserts that Opposer's claim is barred to the fact that no likelihood of confusion, mistake or deception exists between Applicant's mark and Opposer's

alleged marks. Applicant intends to sell only macaroni and cheese entrée dishes. Opposer does not sell macaroni and cheese dishes.

9. As a fifth and separate affirmative defense, Applicant is informed and believes and on this basis asserts that Opposer's claim is barred from recovery due to the fact that MAC is a common word in the macaroni and cheese industry and cannot be distinctive to Opposer. Third-party registrations and uses of marks incorporating MAC now exist, and have existed, in the macaroni and cheese industry.

10. As a sixth and separate affirmative defense, Applicant is informed and believes and this basis asserts that Opposer's claim is barred to the fact that no likelihood of confusion, mistake, association or deception exists between Applicant's mark and Opposer's alleged marks. None of Opposer's marks incorporating MAC, that begin with the word MAC and are joined with a suffix, are used in class 43 (restaurant services). In comparison, Applicant's mark is comprised of MAC joined with the suffix BAR making Applicant's mark sufficiently distinct. Applicant's mark is the only mark comprised of MAC joined with the suffix in class 43 (restaurant services).

11. As a seventh and separate affirmative defense, Applicant is informed and believes and on this basis asserts that Opposer's claim is barred from recovery due to the fact that Applicant's mark is not confusingly similar in appearance, sound or meaning to Opposer's marks.

12. As a eighth and separate affirmative defense, Applicant is informed and believes and on this basis asserts that Opposer's claim is barred from recovery due to the fact that Applicant's mark is not confusingly similar to Opposer's marks because the

respective marks used in connection with each party's respective goods are sufficiently distinct.

13. As a ninth and separate affirmative defense, Applicant is informed and believes and on this basis asserts that Opposer's claim is barred from recovery due to the fact that there is no evidence of any actual confusion as to the associations, sponsorship, authorization or approval of Applicant's goods by Opposer.

14. As a tenth and separate affirmative defense, Applicant is informed and believes and on this basis asserts that Opposer's claim is barred from recovery due to the fact that Applicant adopted and created its mark in good faith and without any intent to confuse or deceive the public.

15. As a eleventh and separate affirmative defense, Applicant is informed and believes and on this basis asserts that Opposer's claim is barred from recovery due to the doctrine of estoppel.

16. As a twelfth and separate affirmative defense, Applicant is informed and believes and on this basis asserts that Opposer's claim is barred from recovery due to the doctrine of laches.

17. As a thirteenth and separate affirmative defense, Applicant is informed and believes and on this basis asserts that Opposer's claim is barred from recovery due to the doctrine of waiver.

18. As a fourteenth and separate affirmative defense, Applicant is informed and believes and on this basis asserts that Opposer's claim is barred from recovery due to the doctrine of acquiescence.

19. As a fifteenth and separate affirmative defense, Applicant is informed and believes and on this basis asserts that Opposer's claim is barred from recovery by reason of its own unclean hands.

20. As a sixteenth and separate affirmative defense, Applicant is informed and believes and on this basis asserts that Opposer's claim is barred from recovery because Opposer is unable to identify any lost opportunities, damage, or harm to Opposer's alleged marks or other impairment of Opposer's ability to provide its services due to Applicant's Intent-To-Use Application for MACBAR. Upon information and belief, Opposer is unable to identify a specific injury suffered by Opposer due to Applicant's Intent-To-Use Application for MACBAR. Accordingly, Opposer has not suffered and will not suffer in the future any loss, injury or damage due to Applicant's mark.

21. As a seventeenth and separate affirmative defense, Applicant is informed and believes and on this basis asserts that Opposer's claim is barred from recovery because Opposer's Opposition fails to state a claim upon which relief can be granted.

22. As an eighteenth and separate affirmative defense, Applicant is informed and believes and on this basis asserts that Opposer's claim is barred from recovery because the numerous registered marks and pending applications for marks that include the term "MAC" in connection with macaroni and cheese dishes demonstrate both the inherent weakness of this term and that no single user has exclusive rights in and to the term "MAC" in connection with macaroni and cheese dishes.

23. There may be additional affirmative defenses to the claims alleged by Opposer that are currently unknown to Applicant. Therefore, Applicant reserves the right

to amend its Answer to allege additional affirmative defenses in the event discovery of additional information indicates they are appropriate.

WHEREFORE, Applicant requests that the present opposition be dismissed with prejudice and that Applicant's registration be granted.

Respectively submitted,

April 9, 2007

By: _____

Gabriel Fischbarg, Esq.
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New York, NY 10021
Tel: 917-514-6261
Attorney for Applicant

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CERTIFICATE OF MAILING

I hereby certify that a true and correct copy of Applicant's Answer was filed electronically with the TTAB via www.uspto.gov on April 9, 2007.

Respectively submitted,

April 9, 2007

By: _____
Gabriel Fischbarg, Esq.
239 East 79th Street, Suite 4-A
New York, NY 10021
Tel: 917-514-6261
Attorney for Applicant

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of Applicant's Answer was deposited with the United States Postal Service as first class mail in an envelope addressed to counsel for the Opposer: John Anthony Cullis, Esq., Neal, Gerber & Eisenberg LLP, 2 North LsSalle Street, Suite 2200, Chicago, IL 60602.

Respectively submitted,

April 9, 2007

By: _____
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