

ESTTA Tracking number: **ESTTA159998**

Filing date: **08/30/2007**

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	McDonald's Corporation
Granted to Date of previous extension	09/19/2007
Address	One McDonald's Plaza Oak Brook, IL 60523-1900 UNITED STATES

Attorney information	John A Cullis Neal, Gerber & Eisenberg LLP 2 North LaSalle Street Suite 2200 Chicago, IL 60602 UNITED STATES jcullis@ngelaw.com, rbrowne@ngelaw.com Phone:312-269-5988
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Applicant Information

Application No	77020407	Publication date	05/22/2007
Opposition Filing Date	08/30/2007	Opposition Period Ends	09/19/2007
Applicant	Patchell Holdings Inc. 201 King Street London, N6A1C9 CANADA		

Goods/Services Affected by Opposition

Class 041. All goods and services in the class are opposed, namely: educational services, namely, providing physical fitness programs for fitness clubs and health and exercise centers; fitness centers, namely, providing fitness and exercise facilities
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	1947099	Application Date	08/08/1991
Registration Date	01/09/1996	Foreign Priority Date	NONE
Word Mark	MC		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 042. First use: First Use: 1995/06/14 First Use In Commerce: 1995/06/14 restaurant services

Related Proceedings	McFit Serial Number 77/020,401
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Attachments	McGym Opposition.pdf (13 pages)(443658 bytes)
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Signature	/Johna A Cullis/
Name	John A Cullis
Date	08/30/2007

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

In the Matter of:
Application Serial No. 77/020,407
Published in the *Official Gazette*
May 22, 2007

McDONALD'S CORPORATION,)	
)	
Opposer,)	
)	
v.)	Opposition No. _____
)	
PATCHELL HOLDINGS INC.,)	
)	
Applicant.)	

NOTICE OF OPPOSITION

Opposer, McDONALD'S CORPORATION ("Opposer"), a corporation organized and existing under the laws of the State of Delaware, with offices at One McDonald's Plaza, Oak Brook, Illinois 60523-1900, believes that it will be damaged by registration of the mark "McGYM" in International Class 41, as shown in Application Serial No. 77/020,407 filed by Applicant, Patchell Holdings Inc. ("Applicant"), a corporation organized under the laws of Canada, located at 201 King Street, London, Ontario N6A 1C9, Canada, and hereby opposes the same and requests that registration to Applicant be refused.

As grounds for its opposition, Opposer alleges that:

1. Applicant seeks to register a mark that consists of the term "McGYM" for "educational services, namely, providing physical fitness programs for fitness clubs and health and exercise centers; fitness centers, namely, providing fitness and exercise facilities" in

International Class 41 (hereinafter, the “McGYM” mark). The application is an intent-to-use based application under 15 U.S.C. § 1051(1)(b).

2. Opposer has filed this Notice of Opposition in a timely fashion.

3. Since 1955, Opposer has been in the business of developing, operating, franchising, and servicing an extensive system of restaurants that prepare, package, and sell a wide variety of high quality, quickly-prepared, modestly-priced foods. Opposer has carried on this business throughout the United States and the world. Opposer and its subsidiaries now operate or license thousands of restaurants throughout the world, including over 13,000 restaurants in the United States.

4. In addition, Opposer has used various service marks over the last 25 years in connection with a host of educational programs and fundraising initiatives directed to the health and welfare of children and their families, which are directly related to the type of services for which Applicant seeks to register the “McGYM” mark. In particular, McDonald’s has actively been involved with hosting and promoting health and fitness programs in elementary and secondary schools throughout the United States. For example, Opposer is the owner of the mark “PASSPORT TO PLAY,” which is registered and has been used in connection with education in health, nutrition, fitness, well being and physical activity at schools across the United States. In fact, over seven million students in the United States have participated in the PASSPORT TO PLAY program. Opposer also has pending a trademark application for “R GYM,” which is used in connection with providing children’s playground facilities for recreation activities. Opposer is also the owner of the mark “GET MOVING WITH RONALD MCDONALD,” which is registered for entertainment services, namely, performances by an individual in a clown costume and has been used in connection with children’s education programs focused on nutrition and

exercise. In addition, Opposer owns the trademark “McKIDS,” which has been used for children’s clothing and accessories, roller-skates, in-line skates, skateboards, non-motorized scooters, non-motorized ride-on toy vehicles and accessories related thereto, and is currently using in the United States for role play toys.

5. Opposer also uses its various marks in connection with a variety of adult-focused health initiatives sponsored by Opposer. For example, Opposer sponsors the McDonald’s Cycle Center to encourage biking as a means of staying healthy and fit, and weekly yoga and Pilates classes, both at the Millennium Park in Chicago, Illinois. Opposer also promotes the “YOURSELF!FITNESS” program, which offers interactive 15-minute fitness DVDs on yoga, core, cardio and strength training as well as videogames directed to fitness for its customers. Furthermore, Opposer owns the trademark “GO ACTIVE,” which is used in connection with the development and dissemination of educational materials of others in the field of health, fitness and active lifestyles. More specifically, the “GO ACTIVE! America Challenge” offers Opposer’s consumers advice from world-class consultants on lifestyle and fitness. For example, since 2003 Opposer has offered consumers educational information on health, nutrition and fitness from the renowned personal trainer Bob Greene. Opposer further promotes and encourages fitness through its Balanced Active Lifestyles program, including promoting walking by offering Stepometers™ in Happy Meals.

6. To further encourage health and fitness amongst consumers, Opposer sponsors different athletic organizations and events, including but not limited to: “MCDONALD’S ALL AMERICAN” high school basketball and soccer exhibitions and games, the Olympics, and FIFA World Cup™. In fact, Opposer became an Official Sponsor of the Olympic Games in 1976, and

has been a committed sponsor ever since to reinforce its commitment to the importance of sports and physical activity in connection with maintaining a balanced and healthy lifestyle.

7. Opposer has used or is likely to expand the use of its “Mc” formative marks to include the same services or type of services that the “McGYM” mark is intended to be used by Applicant.

8. Opposer extensive advertising and promotion of its various goods and services under its family of “Mc” formative marks features the use of television and print advertising, radio, newspaper and magazine advertising, outdoor billboard, Internet advertising and direct mail, which are directed to and reach the public in both local and nationwide markets. In sum, Opposer uses the “Mc” family of marks on a wide variety of products and services, including services that are related to those for which the “McGYM” mark is intended to be used by Applicant.

9. In particular, Opposer owns a federal registration on the mark “Mc,” Registration No. 1,947,099, issued on January 9, 1996, for restaurant services. Opposer additionally owns numerous federal registrations for its family of “Mc” marks for various goods or services, as well as many federal registrations that are related to educational services concerning physical fitness, as illustrated by the following:

<u>EXHIBIT</u>	<u>MARK</u>	<u>REG. NO.</u>	<u>REG. DATE</u>	<u>GOODS/SERVICES</u>
1.	McKIDS	1,489,334	05/24/88	Backpacks, purses, children’s and infant’s clothing and accessories; bib pants, pajamas, jumpers, rainwear, snowsuits, shorts, underwear, belts, boots, gloves, shoes, slippers, socks, suspenders, etc.

<u>EXHIBIT</u>	<u>MARK</u>	<u>REG. NO.</u>	<u>REG. DATE</u>	<u>GOODS/SERVICES</u>
2.	McCLIP	1,579,598	01/23/90	Barbershop services
3.	McGIFT	2,435,272	03/13/01	Wrapping paper, paper gift bags, paper ribbons, bows
4.	McMERCHANDISE	1,878,115	02/07/95	Mail order services featuring novelty items
5.	McGIFT SHOP	1,566,577	11/14/89	Retail gift shop services
6.	McNATURE TRAIL	1,591,375	04/10/90	Providing recreational facilities for nature trips
7.	McPRODUCT	1,635,845	02/19/91	Mail order services in the field of promotional novelty items
8.	McSTUFF STORE	1,530,317	03/14/89	Retail gift shop services
9.	McSHIRT	1,592,145	04/17/90	Men's clothing, women's clothing and children's clothing; t-shirts and sweatshirts
10.	McDONALD'S	1,440,655	05/26/87	Men's clothing, women's clothing, and children's clothing; t-shirts, night shirts, hats, sweaters, shorts, athletic shirts, vests, sweat shirts, and jerseys
11.	McBUDDY	1,926,019	10/10/95	Non-monetary charitable services; providing foods, clothing, school supplies, and the like to underprivileged children and families
12.	McSHUTTLE	1,418,655	11/25/86	Transportation services; providing ground transportation services
13.	McJOBS	1,358,486	09/03/85	Training handicapped persons as restaurant employees
14.	McLODGE	1,562,702	10/24/89	Hotel services

<u>EXHIBIT</u>	<u>MARK</u>	<u>REG. NO.</u>	<u>REG. DATE</u>	<u>GOODS/SERVICES</u>
15.	McMASTERS	1,538,385	05/09/89	Recruiting of individuals 55 years or older as restaurant employees
16.	McRECYCLE	1,636,373	02/26/91	Recycling services
17.	McSAVE	1,506,327	09/27/88	Administering an employee savings plan
18.	McTRAVEL	1,582,970	02/13/90	Travel agency services; airline reservations, airline tickets, and rental car reservations
19.	McDONALD'S	1,352,168	07/30/85	Restaurant services
20.	McCHICKEN	1,065,885	05/17/77	Cooked chicken for consumption on or off the premises
21.	McRULER	1,639,570	04/02/91	Standard six-inch or twelve-inch rulers
22.	McMUG	1,604,726	07/03/90	Coffee mugs
23.	McNOTES	1,608,229	07/31/90	Note pads
24.	McBABY	2,100,005	09/23/97	Toddler and infant wear; t-shirts, hats, sweatshirts, socks, sweaters, gloves, etc.
25.	McDONALDS.COM	2,160,744	05/26/98	Computer services, namely providing access to computer databases in the nature of a computer bulletin board in the field of restaurant operations and management.
26.	GET MOVING WITH RONALD MCDONALD	2,999,077	06/20/2005	Entertainment services, namely, performances by an individual in a clown costume.
27.	GO ACTIVE	2,981,854	03/02/2005	Development and dissemination of educational materials of others in the field of

<u>EXHIBIT</u>	<u>MARK</u>	<u>REG. NO.</u>	<u>REG. DATE</u>	<u>GOODS/SERVICES</u>
				health, nutrition, Fitness and active lifestyles
28.	BIG RED SHOE	2,938,018	04/05/05	Dissemination of educational materials of others in the field of health, nutrition, social responsibility, education and other matters of general interest to children
29.	CHIEF HAPPINESS OFFICER	78/578,677	03/02/05	Educational and entertainment services, namely, providing classes and motivational speakers in the field of health, nutrition, physical fitness, safety, literacy and academic development and achievement
30.	GO ACTIVE	2,981,854	08/02/05	Development and dissemination of educational materials of others in the field of health, nutrition fitness and active lifestyles
31.	GO ACTIVE	2,963,097	06/21/05	Providing multiple-user access to a global computer information network; providing information via a global computer network featuring nutrition, fitness and active lifestyle
32.	GO ACTIVE!	3,093,899	05/16/06	Computer services, namely, providing information relating to fitness via the global computer information network; computer services, namely, providing information relating to nutrition and health care via the global

<u>EXHIBIT</u>	<u>MARK</u>	<u>REG. NO.</u>	<u>REG. DATE</u>	<u>GOODS/SERVICES</u>
				computer information network; computer services, namely, providing information relating to lifestyle via the global computer network
33.	HEALTHY GROWING UP	1,848,187	08/02/94	Printed educational materials available upon request in the nature of teachers' guides for use in teaching and planning fitness activities for children in kindergarten through third grade
34.	HEALTHY GROWING UP	1,814,536	12/28/93	Services of providing educational institutions with information and instructional materials upon request for use by teachers in teaching and planning fitness activities and lessons for children in kindergarten through third grade
35.	ITS WHAT I EAT AND WHAT I DO	3,082,112	04/18/06	Education and entertainment services, namely, providing seminars, courses and workshops in the field of health, nutrition and fitness
36.	MCCREW CARE	2,552,802	03/26/02	Administration of employee benefits plans, namely, providing health care benefit plans to employees
37.	MERC	1,703,827	07/28/92	Educational services, namely, development and dissemination of educational material in the field of health, nutrition, environment, drug awareness and other areas

<u>EXHIBIT</u>	<u>MARK</u>	<u>REG. NO.</u>	<u>REG. DATE</u>	<u>GOODS/SERVICES</u>
				of social concern
38.	PASSPORT TO PLAY	78/623,641	05/05/05	Educational services, namely, classes in the field of health, nutrition, fitness, well being and physical activity; entertainment services, namely, planning arrangement of showing movies about health, nutrition, fitness, physical activity and well being
39.	PASSPORT TO PLAY and Design	3,203,511	01/30/07	Educational services, namely, classes and seminars in the fields of health, nutrition, fitness, wellbeing and planning activity; entertainment services, namely, planning arrangement of showing movies about health, nutrition, fitness, physical activity, and well being, and planning activities to promote health, nutrition, fitness, physical activity, and well being, namely, planning games for others
40.	MCDONALD'S ALL AMERICAN	3074,164	4/28/06	Entertainment services namely conducting athletic events in the nature of basketball and soccer clinics and competitions
41.	MCDONALDS ALL AMERICAN GAME	1,287,324	5/1/84	Entertainment Services Namely, Basketball Exhibitions
42.	MCDONALD'S ALL AMERICAN HIGH SCHOOL BASKETBALL TEAM	1,101,769	9/5/78	Entertainment services in the form of a basketball team

These registrations are valid, subsisting, and in full force and effect.

10. With the exception of those marks that have been registered for a period of less than six years, each of the foregoing registrations is incontestable under § 1065 of the Lanham Act, providing conclusive evidence under § 1115(b) of the validity of the registration of the mark and Opposer's ownership and exclusive right to use the mark in commerce.

11. In addition, Opposer owns numerous other federal registrations of its "Mc" formative marks for a variety of goods and services.

12. Both the Trademark Trial and Appeal Board and the Federal Circuit have long recognized Opposer's rights in its famous "Mc" family of marks. McDonald's Corp. v. McKinley, 13 U.S.P.Q.2d 1895, 1899 (TTAB 1989)(In finding that the mark "McTEDDY" was likely to cause confusion with McDonald's "Mc" and "Mac" family of marks, the Board stated, "In view of opposer's extensive evidence of use and promotion of marks having a "Mc" or "Mac" portion, there can be no doubt that opposer has established that its marks comprise a family"); McDonald's Corp. v. McBagle's, Inc., 649 F.Supp. 1268, 1272 (S.D.N.Y. 1986) (In finding that the mark "McBAGEL" was confusingly similar to McDonald's family of "Mc" and "Mac" marks, the court showed no hesitation in finding that McDonald's "owns a 'family of marks' both registered and unregistered, whose common characteristic is the use of 'Mc' or 'Mac' as a formative"); McDonald's Corp. v. McClain, 37 U.S.P.Q.2d 1274, 1276 (TTAB 1995)(In holding that the mark "McCLAIM" was confusingly similar to McDonald's "Mc" formative marks, the Board stated, "The family of [McDonald's] marks has been recognized by this Board and by the courts"); J&J Snack Foods Corp. v. McDonald's Corp., 932 F.2d 1460 (Fed. Cir. 1991)(the court found that the marks, "McPRETZEL" and "McDUGAL McPRETZEL" were confusingly similar to McDonald's "Mc" and "Mac" family of marks). Moreover, the court in McDonald's Corp. v. Druck and Gerner, DDS., P.C., 814 F. Supp. 1127,

1134 (N.D.N.Y. 1993), found that the use of the term “McDENTAL,” in connection with dental services, infringed Opposer’s family of marks, and issued an injunction against the defendants.

13. Through Opposer’s extensive and continuous use of the name “McDONALD’S” and its family of “Mc” marks, the public has come to recognize marks combining the “Mc” prefix with a common word for a variety of goods and services as being uniquely associated with Opposer. Opposer has developed, at great effort and expense, exceedingly valuable goodwill with respect to its family of “Mc” marks. Opposer’s “Mc” family of marks is famous and was famous long prior to the date of filing of Applicant’s subject application.

14. Despite Opposer’s long-standing prior rights in the name “McDONALD’S” and its family of “Mc” marks, Applicant filed its application to register the “McGYM” mark, Serial No. 77/020,407.

15. The mark Applicant seeks to register has as its only distinctive element the “Mc” prefix, which is coupled with the generic term “GYM”. Potential purchasers, upon seeing the dominant formative “Mc” in Applicant’s “McGYM” mark used in connection with “educational services, namely, providing physical Fitness programs for Fitness clubs and health and exercise centers; Fitness centers, namely, providing Fitness and exercise facilities,” are likely to mistakenly believe that such term and the services offered thereunder originated with or are connected with, sponsored or associated by, or licensed or endorsed by Opposer. Thus, the registration and use by Applicant of the “McGYM” mark in connection with its proposed services is likely to cause confusion, mistake, or deception in violation of 15 U.S.C. § 1114(1)(a).

16. In addition, Opposer’s rights in its “Mc” family of marks based on its use, registration and recognition by the public were established, and Opposer’s “Mc” family was

famous, long before Applicant filed the subject Application. Thus, registration to Applicant would diminish and dilute the distinctive quality of McDonald's rights in its family of famous "Mc" marks, in violation of 15 U.S.C. § 1125(c), and could also, in the event of any mishaps involving, or poor quality of, the services offered by Applicant, tarnish such distinctiveness.

17. If a registration is issued to Applicant for the "McGYM" mark, the resulting confusion with Opposer's marks would cause damage and injury to Opposer and the public. Registration of this term would give Applicant an unqualified right to wrongfully appropriate Opposer's valuable goodwill and reputation associated with Opposer's marks and to benefit from such confusion among purchasers led to believe that Applicant's services are related in some fashion to Opposer. Registration of this term to Applicant would also dilute the distinctiveness of Opposer's marks and harm its goodwill and reputation associated with its marks by allowing any fault with or objection to Applicant's services to reflect upon Opposer, and would restrict the natural growth and expansion of Opposer's entire family of "Mc" marks.

WHEREFORE, Opposer requests that this Opposition be sustained and Application Serial No. 77/020,407 be refused registration.

Please charge the fee of \$300 and any additional fees related to this matter to Deposit
Account No. 502261.

Respectfully submitted,

McDONALD'S CORPORATION

Date: August 30, 2007

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