

ESTTA Tracking number: **ESTTA216928**

Filing date: **06/11/2008**

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	06/11/2008
Address	One McDonald's Plaza Oak Brook, IL 60523 UNITED STATES

Attorney information	John A Cullis Neal, Gerber & Eisenberg LLP 2 North LaSalle Street, Suite 2200 Chicago, IL 60602 UNITED STATES apeterson@ngelaw.com, jcullis@ngelaw.com, rbrowne@ngelaw.com, twilliams@ngelaw.com Phone:312.269.8000
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**Applicant Information**

Application No	77253879	Publication date	02/12/2008
Opposition Filing Date	06/11/2008	Opposition Period Ends	06/11/2008
Applicant	MCLAB 384 Oyster Point Blvd, Suite #15 South San Francisco, CA 94080 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 001. First Use: 2000/01/03 First Use In Commerce: 2000/01/03 All goods and services in the class are opposed, namely: Nucleic acid sequences and chemical reagents for other than medical and veterinary purposes; Reagent kits comprising generic DNA circle, DNA primers, polymerase and buffers for use in biotechnology fields; Test particles for biodetection systems, biological analogues and microscopic carrier beads with chemically attached DNA fragments for use in testing the operation of equipment used for analyzing air for the presence of harmful biological substances
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**Grounds for Opposition**

Priority and likelihood of confusion	Trademark Act section 2(d)
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**Marks Cited by Opposer as Basis for Opposition**

U.S. Registration No.	1735904	Application Date	07/23/1991
Registration Date	12/01/1992	Foreign Priority	NONE

		Date	
Word Mark	MCFREE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 001. First use: First Use: 1983/00/00 First Use In Commerce: 1985/00/00 chemical preparations to prevent and cure clogged drains		

U.S. Registration No.	2925207	Application Date	01/16/2004
Registration Date	02/08/2005	Foreign Priority Date	NONE
Word Mark	MCFAMILY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 1995/08/23 First Use In Commerce: 1995/08/23 COMPUTER SERVICES, NAMELY, INFORMATION STORAGE AND RETRIEVAL IN THE FIELD OF RESTAURANT OPERATION, MANAGEMENT, PRODUCTS AND SERVICES AVAILABLE TO EMPLOYEES AND NONEMPLOYEES		

U.S. Registration No.	1826212	Application Date	05/14/1993
Registration Date	03/15/1994	Foreign Priority Date	NONE
Word Mark	MCQUAD		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1992/04/01 First Use In Commerce: 1992/04/01 calibrated electronic beverage dispensing towers for use in dispensing predetermined quantities		

U.S. Registration No.	2160744	Application Date	02/21/1995
Registration Date	05/26/1998	Foreign Priority Date	NONE
Word Mark	MCDONALDS.COM		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1996/06/01 First Use In Commerce: 1996/06/01 computer services, namely providing access to computer databases in the nature of a computer bulletin board in the field of restaurant operations and management		

U.S. Registration No.	1530212	Application Date	09/14/1987
Registration Date	03/14/1989	Foreign Priority	NONE

		Date	
Word Mark	MCKIDS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1987/08/14 First Use In Commerce: 1987/08/14 RESTAURANT SERVICES		

U.S. Registration No.	1579598	Application Date	06/02/1989
Registration Date	01/23/1990	Foreign Priority Date	NONE
Word Mark	MCCLIP		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1985/10/02 First Use In Commerce: 1985/10/02 BARBER SHOP SERVICES		

U.S. Registration No.	1878115	Application Date	12/03/1993
Registration Date	02/07/1995	Foreign Priority Date	NONE
Word Mark	MCMERCHANDISE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1993/09/00 First Use In Commerce: 1993/09/00 mail order services featuring novelty items		

U.S. Registration No.	1591375	Application Date	07/07/1989
Registration Date	04/10/1990	Foreign Priority Date	NONE
Word Mark	MCNATURE TRAIL		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1989/05/19 First Use In Commerce: 1989/05/19 PROVIDING RECREATIONAL FACILITIES FOR NATURE TRIPS		

U.S. Registration No.	1440655	Application Date	09/30/1982
Registration Date	05/26/1987	Foreign Priority Date	NONE
Word Mark	MCDONALDS		
Design Mark			
Description of Mark	NONE		

Goods/Services	Class 025. First use: First Use: 1973/09/00 First Use In Commerce: 1973/09/00 MEN'S CLOTHING, WOMEN'S CLOTHING AND CHILDREN'S CLOTHING, NAMELY, T-SHIRTS, [ NIGHT SHIRTS, ] HATS, [ SWEATERS ] , SHORTS, ATHLETIC SHIRTS, [ VESTS, ] SWEAT SHIRTS AND JERSEYS		
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U.S. Registration No.	1926019	Application Date	01/29/1993
Registration Date	10/10/1995	Foreign Priority Date	NONE
Word Mark	MCBUDDY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1989/12/00 First Use In Commerce: 1989/12/00 non-monetary charitable services; namely, providing food, clothing, school supplies and the like to underprivileged children and families		

U.S. Registration No.	1418655	Application Date	04/11/1986
Registration Date	11/25/1986	Foreign Priority Date	NONE
Word Mark	MCSHUTTLE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 039. First use: First Use: 1985/09/17 First Use In Commerce: 1985/09/17 TRANSPORTATION SERVICES, NAMELY PROVIDING GROUND TRANSPORTATION SERVICES		

U.S. Registration No.	1358486	Application Date	05/18/1984
Registration Date	09/03/1985	Foreign Priority Date	NONE
Word Mark	MCJOBS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1982/09/30 First Use In Commerce: 1982/09/30 TRAINING HANDICAPPED PERSONS AS RESTAURANT EMPLOYEES		

U.S. Registration No.	1562702	Application Date	12/09/1987
Registration Date	10/24/1989	Foreign Priority Date	NONE
Word Mark	MCLODGE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1987/11/20 First Use In Commerce: 1987/11/20 HOTEL SERVICES		

U.S. Registration No.	1538385	Application Date	09/14/1987
Registration Date	05/09/1989	Foreign Priority Date	NONE
Word Mark	MCMASTERS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 1986/02/00 First Use In Commerce: 1986/07/01 RECRUITING OF INDIVIDUALS 55 YEARS OR OLDER AS RESTAURANT EMPLOYEES Class 041. First use: First Use: 1986/02/00 First Use In Commerce: 1986/07/01 TRAINING OF INDIVIDUALS 55 YEARS OR OLDER AS RESTAURANT EMPLOYEES		

U.S. Registration No.	1636373	Application Date	05/01/1990
Registration Date	02/26/1991	Foreign Priority Date	NONE
Word Mark	MCRECYCLE USA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 040. First use: First Use: 1990/04/18 First Use In Commerce: 1990/04/18 recycling services		

U.S. Registration No.	1506327	Application Date	12/17/1987
Registration Date	09/27/1988	Foreign Priority Date	NONE
Word Mark	MC\$AVE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 1987/11/16 First Use In Commerce: 1987/11/16 ADMINISTERING AN EMPLOYEE SAVINGS PLAN		

U.S. Registration No.	1582970	Application Date	02/21/1985
Registration Date	02/13/1990	Foreign Priority Date	NONE
Word Mark	MCTRAVEL		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 039. First use: First Use: 1985/01/31 First Use In Commerce: 1985/01/31 TRAVEL AGENCY SERVICES - NAMELY, BOOKING AIRLINE RESERVATIONS, ISSUING AIRLINE TICKETS AND MAKING RENTAL CAR RESERVATIONS		

	Class 042. First use: First Use: 1985/01/31 First Use In Commerce: 1985/01/31 MAKING HOTEL RESERVATIONS		
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U.S. Registration No.	1352168	Application Date	05/23/1983
Registration Date	07/30/1985	Foreign Priority Date	NONE
Word Mark	MC DONALD'S		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1968/12/31 First Use In Commerce: 1968/12/31 RESTAURANT SERVICES		

U.S. Registration No.	1065885	Application Date	02/05/1976
Registration Date	05/17/1977	Foreign Priority Date	NONE
Word Mark	MC CHICKEN		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 029. First use: First Use: 1975/06/16 First Use In Commerce: 1975/06/16 COOKED CHICKEN FOR CONSUMPTION ON OR OFF THE PREMISES		

U.S. Registration No.	1037773	Application Date	07/31/1975
Registration Date	04/13/1976	Foreign Priority Date	NONE
Word Mark	MCD		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 1975/01/00 First Use In Commerce: 1975/01/24 CONCENTRATED ALL PURPOSE CLEANER, SANITIZER-DETERGENT, DEEP FAT FRYER BOIL-OUT COMPOUND, STAINLESS STEEL CLEANER- DRESSING AND CHEMICAL CLEANER FOR GRILLS		

U.S. Registration No.	2811713	Application Date	03/06/2002
Registration Date	02/03/2004	Foreign Priority Date	NONE
Word Mark	MCFAMILY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 1997/03/07 First Use In Commerce: 1997/03/07 PROMOTING THE INTERESTS OF CULTURAL ACTIVITIES IN COMMUNITIES BY PROVIDING DISCOUNT TICKETS		

Attachments	78352794#TMSN.jpeg ( 1 page )( bytes ) 73804079#TMSN.gif ( 1 page )( bytes ) 73701563#TMSN.gif ( 1 page )( bytes ) 73426936#TMSN.gif ( 1 page )( bytes ) 73059270#TMSN.gif ( 1 page )( bytes ) McLab.pdf ( 9 pages )(25344 bytes )
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### Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/John A Cullis/
Name	John A Cullis
Date	06/11/2008

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

In the Matter of:  
Application Serial No. 77/253,879  
Published in the *Official Gazette*  
February 12, 2008

McDONALD'S CORPORATION,	)	
	)	
Opposer,	)	Mark: McLAB
	)	
v.	)	Opposition No. _____
	)	
CHANGPING SHI,	)	
	)	
	)	
Applicant.	)	

NOTICE OF OPPOSITION

Opposer, McDONALD'S CORPORATION, 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 "McLAB" in International Class 001 as shown in Application Serial No. 77/253,879, filed by Applicant, Changping Shi, a U.S. citizen, located at 384 Oyster Point Blvd., Ste. 15, South San Francisco, CA 94080-1968, 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 the term "McLAB" for "nucleic acid sequences and chemical reagents for other than medical and veterinary purposes; reagent kits comprising generic DNA circle, DNA primers, polymerase and buffers for use in biotechnology fields; test particles for biodetection systems, biological analogues and microscopic carrier beads with

chemically attached DNA fragments for use in testing the operation of equipment used for analyzing air for the presence of harmful biological substances” in International Class 001 (hereinafter, the “McLAB” mark). The subject application is a use-based application under 15 U.S.C. § 1051(1)(a).

2. Opposer has obtained the necessary extension of time within which to file this Notice of Opposition.

3. Since 1955, Opposer has continuously used the name McDONALD’S as a trademark and service mark in its business of developing, operating, franchising, and servicing an extensive system of restaurants that prepare, package, and sell a limited menu 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. Beginning with its world-famous “McDONALD’S” trademark, Opposer has used or licensed the use of numerous trademarks and service marks in connection with a wide variety of goods and services over the past 50 years. In connection with this business, Opposer has built an extensive family of “Mc” formative trademarks formed by the distinctive “Mc” prefix with various generic and descriptive terms.

5. Opposer’s extensive nationwide 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 addition, Opposer uses the “Mc” formative family of marks on food product packaging and

point-of-purchase advertising, and has used the “Mc” formative family of marks for a wide variety of other goods and services, including, but not limited to: chemical preparations; computer services; men’s, women’s and children’s clothing; barbershop services; mail order services; charitable services; hotel services; recycling services; travel services; and concentrated cleaners.

6. Opposer owns federal registration number 1,735,904 for the mark McFREE for use in connection with chemical preparations to prevent and cure clogged drains in International Class 001, which goods are classified in the same international class as those of Applicant’s. Moreover, Opposer has used its “Mc” formative marks, and in particular its McFREE mark, with the same goods or type of goods for which registration of the “McLAB” Mark is sought.

7. Opposer also owns a federal registration on “Mc,” Registration No. 1,947,099, issued on January 9, 1996 for restaurant services. Opposer additionally owns the following federal registrations of its “McDONALD’S” and “Mc” formative marks for goods or services:

<u>EXHIBIT</u>	<u>MARK</u>	<u>REG. NO.</u>	<u>REG. DATE</u>	<u>GOODS/SERVICES</u>
1	McFREE	1,735,904	12/01/92	Chemical preparations to prevent and cure clogged drains
2	McFAMILY	2,925,207	02/08/05	Computer services; information storage and retrieval in the field of restaurant operation
3	McQUAD	1,826,212	03/15/94	Calibrated electronic beverage dispensing towers for use in dispensing predetermined quantities.

<u>EXHIBIT</u>	<u>MARK</u>	<u>REG. NO.</u>	<u>REG. DATE</u>	<u>GOODS/SERVICES</u>
4	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.
5	McKIDS	1,530,212	03/14/89	Restaurant services
6	McCLIP	1,579,598	01/23/90	Barbershop services
7	McMERCHANDISE	1,878,115	02/07/95	Mail order services featuring novelty items
8	McNATURE TRAIL	1,591,375	04/10/90	Providing recreational facilities for nature trips
9	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
10	McBUDDY	1,926,019	10/10/95	Non-monetary charitable services; providing foods, clothing, school supplies, and the like to underprivileged children and families
11	McSHUTTLE	1,418,655	11/25/86	Transportation services; providing ground transportation services
12	McJOBS	1,358,486	09/03/85	Training handicapped persons as restaurant employees
13	McLODGE	1,562,702	10/24/89	Hotel services
14	McMASTERS	1,538,385	05/09/89	Recruiting of individuals 55 years or older as restaurant employees
15	McRECYCLE	1,636,373	02/26/91	Recycling services

<u>EXHIBIT</u>	<u>MARK</u>	<u>REG. NO.</u>	<u>REG. DATE</u>	<u>GOODS/SERVICES</u>
16	McSAVE	1,506,327	09/27/88	Administering an employee savings plan
17	McTRAVEL	1,582,970	02/13/90	Travel agency services; airline reservations, airline tickets, and rental car reservations
18	McDONALD'S	1,352,168	07/30/85	Restaurant services
19	McCHICKEN	1,065,885	05/17/77	Cooked chicken for consumption on or off the premises
20	McD	1,037,773	04/13/76	Concentrated all purpose cleaner, sanitizer-detergent, deep fat fryer boil-out compound, stainless steel cleaner-dressing and chemical cleaner for grills
21	McFAMILY	2,811,713	02/03/04	Promoting the interests of cultural activities in communities by providing discount tickets

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

8. Each of the aforesaid registrations is at least *prima facie* evidence of the validity of each registration, of Opposer's ownership thereof, and of Opposer's exclusive right to use such registered mark on the goods or services set forth in the registration. In addition, McDonald's Corporation owns numerous other federal registrations of "Mc" formative marks for a variety of goods and services.

9. Through Opposer's extensive and continuous use of the name McDONALD'S and its "Mc" formative marks, the public has come to recognize marks combining the "Mc" prefix with a common word for a wide 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 the specific marks listed above, as well as for its entire “Mc” family of marks. Opposer’s “Mc” family of marks is famous and was famous long prior to the date of filing of Applicant’s subject application.

10. Despite Opposer’s long-standing prior rights in the name McDONALD’S and its “Mc” family of marks for restaurant services, food products, and a wide variety of other goods and services, Applicant filed its application to register the “McLAB” mark in connection with nucleic acid sequences and chemical reagents for other than medical and veterinary purposes; reagent kits comprising generic DNA circle, DNA primers, polymerase and buffers for use in biotechnology fields; and test particles for biodetection systems, biological analogues and microscopic carrier beads with chemically attached DNA fragments for use in testing the operation of equipment used for analyzing air for the presence of harmful biological substances in International Class 001, which application was assigned Serial No. 77/253,879. Moreover, in light of Opposer’s widespread advertising and promotion of its “Mc” formative marks, Applicant’s selection of a term that is identical to Opposer’s pre-existing family of “Mc” formative marks suggests that Applicant intends to trade off the goodwill and recognition associated with Opposer’s “Mc” family of marks.

11. The mark proposed for registration by Applicant has as its principal distinctive element the “Mc” prefix that is coupled with the common word “lab,” which is a generic term. Potential purchasers, upon seeing the dominant formative “Mc” in Applicant’s “McLAB” mark used in connection with logistics nucleic acid sequences and chemical reagents for other than medical and veterinary purposes; reagent kits comprising generic DNA circle, DNA primers, polymerase and buffers for use in biotechnology fields; and test particles for biodetection systems, biological analogues and microscopic carrier beads with chemically attached DNA

fragments for use in testing the operation of equipment used for analyzing air for the presence of harmful biological substances are likely to mistakenly believe that such a term and the services offered thereunder originated with or are connected with, sponsored or associated by, or licensed or approved by Opposer. Thus, the registration and use by Applicant of the “McLAB” mark in connection with its services for all channels of trade and all types of prospective purchasers is likely to cause confusion, mistake, or deception in violation of 15 U.S.C. § 1063.

12. Issuance of a registration to Applicant would diminish and dilute the distinctive quality of McDonald’s rights in its famous “Mc” formative family of marks and could in the event of any mishaps involving, or poor quality of, the services offered by Applicant, tarnish such distinctiveness, in violation of 15 U.S.C. § 1125(c).

13. If a registration is issued to Applicant for the “McLAB” mark, the confusion with Opposer’s marks would result in 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; to benefit from the likely confusion among purchasers led to believe that Applicant’s services are related in some fashion to Opposer; 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 to restrict the natural growth of Opposer’s family of “Mc” formative marks.

WHEREFORE, Opposer requests that this Opposition be sustained and Application Serial No. 77/253,879 be refused registration.

Opposer requests that the requisite filing fee of \$300.00 and any additional fees related to this matter be charged to the deposit account of Neal, Gerber & Eisenberg, Account No. 502261.

Respectfully submitted,

McDONALD'S CORPORATION

Date: June 11, 2008

By: \_\_\_\_\_/john a. cullis/

Robert E. Browne  
John A. Cullis  
Thomas E. Williams  
Neal, Gerber & Eisenberg, LLP  
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CERTIFICATE OF TRANSMISSION

I hereby certify that the foregoing NOTICE OF OPPOSITION is being electronically transmitted via the Electronic System for Trademark Trials and Appeals (“ESTTA”) at <http://estta.uspto.gov/> on the date noted below:

Date: June 11, 2008

By: /Thomas E. Williams/  
One of the Attorneys for Opposer,  
McDonald’s Corporation

CERTIFICATE OF SERVICE

I hereby certify that I served a copy of the foregoing NOTICE OF OPPOSITION upon:

Changping Shi  
McLab  
384 Oyster Point Blvd Ste 15  
South San Francisco, CA 94080-1968

by depositing said copy in a properly addressed envelope, First Class postage prepaid, and depositing same in the United States mail at Two North LaSalle Street, Chicago, Illinois, on the date noted below:

Date: Date: June 11, 2008

By: /Thomas E. Williams/  
One of the Attorneys for Opposer,  
McDonald’s Corporation

NGEDOCS: 1537394.2