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

Proceeding	91184532
Party	Defendant MCLAB
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Date	07/18/2008
Attachments	MCLAB's Answer.pdf (8 pages)(106085 bytes)

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

McDonald's Corporation

Opposer,

v.

MCLAB

Applicant.

Opposition No. 91184532
Application Serial No. 77/253,879
Mark: MCLAB

APPLICANT MCLAB'S ANSWER

Applicant MCLAB ("Applicant") hereby answers the Notice of Opposition filed by Opposer McDonald's Corporation ("Opposer") as follows:

In response to the introductory unnumbered paragraph, Applicant denies Opposer's allegation that it will be damaged by the registration of Application Serial No. 77/253,879. Applicant also notes that the Applicant of record is MCLAB, not Changping Shi. In addition, Opposer responds that it lacks sufficient knowledge or information to form a belief as to the truth of the remaining allegations, if any, in the introductory unnumbered paragraph of the Notice of Opposition and, therefore, denies such allegations.

1. In response to paragraph 1, Applicant seeks to register MCLAB, not "McLAB." In addition, Applicant admits that it seeks to register MCLAB 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; 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

1 based on use in commerce pursuant to 15 U.S.C. § 1051(a). Except as expressly admitted, Applicant denies each and every remaining allegation in paragraph 1 of the Notice of Opposition.

2. In response to paragraph 2, Applicant denies each and every allegation in paragraph 2 of the Notice of Opposition.

3. In response to paragraph 3, Applicant responds that it lacks sufficient knowledge or information to form a belief as to the truth of the allegations in paragraph 3 and, therefore, denies such allegations.

4. In response to paragraph 4, Applicant responds that it lacks sufficient knowledge or information to form a belief as to the truth of the allegations in paragraph 4 and, therefore, denies such allegations.

5. In response to paragraph 5, Applicant responds that it lacks sufficient knowledge or information to form a belief as to the truth of the allegations in paragraph 5 and, therefore, denies such allegations.

6. In response to paragraph 6, Applicant admits that the Trademark Electronic Search System of the U.S. Patent and Trademark Office shows Opposer as the record owner of U.S. Registration No. 1,735,904 for McFree in connection with “chemical preparations to prevent and cure clogged drains.” Applicant denies that Opposer provides goods or services that are similar to the goods listed in Applicant’s U.S. Application Serial No. 77/235,879 for MCLAB. Except as expressly admitted, Applicant denies each and every remaining allegation in paragraph 6 of the Notice of Opposition.

7. In response to paragraph 7, Applicant responds that it lacks sufficient knowledge or information to form a belief as to the truth of the allegations in paragraph 7 and, therefore, denies such allegations.

8. In response to paragraph 8, Applicant responds that it lacks sufficient knowledge or information to form a belief as to the truth of the allegations in paragraph 8 and, therefore, denies such allegations.

9. In response to paragraph 9, Applicant responds that it lacks sufficient knowledge or information to form a belief as to the truth of the allegations in paragraph 9 and, therefore, denies such allegations.

10. In response to paragraph 10, Applicant admits that it seeks to register MCLAB 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; 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.” Except as expressly admitted, Applicant denies each and every remaining allegation in paragraph 10 of the Notice of Opposition.

11. In response to paragraph 11, Applicant denies each and every allegation in paragraph 11 of the Notice of Opposition.

12. In response to paragraph 12, Applicant denies each and every allegation in paragraph 12 of the Notice of Opposition.

13. In response to paragraph 13, Applicant denies each and every allegation in paragraph 13 of the Notice of Opposition.

In response to Opposer’s WHEREFORE and prayer for relief paragraph, Applicant denies that there is a basis to sustain the opposition and states that its application should be allowed to register.

AFFIRMATIVE DEFENSES

By way of further answer, Applicant alleges and asserts the following defenses in response to the allegations contained in the Notice of Opposition. In this regard, Applicant undertakes the burden of proof only as to those defenses that are deemed affirmative defenses by law, regardless of how such defenses are denominated in the instant Answer. Applicant reserves the right to assert other affirmative defenses as this opposition proceeds based on

further discovery, legal research, or analysis that may supply additional facts or lend new meaning or clarification to Opposer's claims that are not apparent on the face of the Notice of Opposition.

FIRST AFFIRMATIVE DEFENSE
FAILURE TO STATE A CLAIM

14. Opposer's claims are barred, in whole or in part, because the Notice of Opposition fails to state a claim upon which relief can be granted.

SECOND AFFIRMATIVE DEFENSE
NO INJURY OR DAMAGE

15. Opposer's claims are barred, in whole or in part, because Opposer has not and will not suffer any injury or damage from the registration of Applicant's U.S. Application Serial No. 77/253,879 for MCLAB.

THIRD AFFIRMATIVE DEFENSE
LACK OF ACTUAL CONFUSION

16. Applicant has used its MCLAB mark in the United States since at least as early as January 3, 2000, but has not experienced any confusion with Opposer or its goods and services. On information and belief, Opposer also has not experienced any actual confusion, notwithstanding Applicant's use of its mark for over eight years.

FOURTH AFFIRMATIVE DEFENSE
LACK OF LIKELIHOOD OF CONFUSION

17. Applicant's MCLAB mark differs in terms of sight, sound, and meaning from Opposer's claimed marks and has a distinct commercial impression from Opposer's claimed marks.

18. Applicant's nucleic acid sequences, chemical reagents, and DNA related goods are different and distinct from the goods and services listed in the registrations of Opposer's claimed marks.

19. Applicant's use and registration of its MCLAB mark does not create a likelihood of confusion among consumers that its goods are offered by, are sponsored by, or are otherwise endorsed by Opposer. Nor does Applicant's use or registration of its mark create a likelihood that consumers falsely will believe that Applicant and Opposer are affiliated in any way.

FIFTH AFFIRMATIVE DEFENSE
NARROW RIGHTS

20. On information and belief, the common law adoption and use of MC as a prefix in trademarks is widespread in connection with numerous goods and services, including, but not limited to, life sciences related goods. Such common law adoption and use requires that Opposer's claimed marks be narrowly construed, such that Opposer's claimed marks cannot—as a matter of law—form the basis of a likelihood of confusion claim against Applicant's MCLAB mark.

21. The adoption and use of MC as a prefix in trademarks is part of federally registered third party marks for numerous goods and services, which are not owned by Opposer, including by way of example the following marks in International Class 1: MC (U.S. Registration No. 3,312,705) for fertilizers in ; MCBERNS AUTOWELLWASHER (U.S. Registration No. 3,076,906) for chemicals; MCS (U.S. Application No. 78/627,318) for conductive pastes; MC2 (U.S. Application No. 78/904,334) for ceramic material; MPP MCDONALD PHOTO PRODUCTS (U.S. Application Serial No. 78/932,974) for adhesives; MCLAUGHLIN GORMLEY KING (U.S. Registration No. 3,221,707) for chemicals; MCC (U.S. Registration No. 3,207,821) for chemicals; MCNETT (U.S. Registration No. 3,070,286) for adhesive sealant; MCT (U.S. Registration No. 3,147,482) for, among other things, biological reagents; MCR-SPACE (U.S. Registration No. 2,945,827) for chemical products; MCKAY (U.S. Application No. 77/200,620) for motor vehicle preparations; MCGYAN (U.S. Registration No. 3,368,447) for chemical catalysts; MC RAZOR (U.S. Registration No. 3,416,629) for surfactants and high flash point alcohols; MCPREP (U.S. Registration No. 2,699,452) for reagents; MCKRETE (U.S. Registration No.

3,071,583) for concrete additives; and so on. The existence of such registered and pending third party marks requires that Opposer's claimed marks be narrowly construed, such that Opposer's claimed marks cannot—as a matter of law—form the basis of a likelihood of confusion claim against Applicant's MCLAB mark.

SIXTH AFFIRMATIVE DEFENSE
LACK OF STANDING

22. Opposer's claims are barred, in whole or in part, because Opposer does not have standing in that Opposer does not have rights, superior or otherwise, sufficient to support the Notice of Opposition.

SEVENTH AFFIRMATIVE DEFENSE
ESTOPPEL

23. Opposer's claims are barred, in whole or in part, by the doctrine of estoppel.

EIGHTH AFFIRMATIVE DEFENSE
LACHES

24. Opposer's claims are barred, in whole or in part, by the doctrine of laches.

NINTH AFFIRMATIVE DEFENSE
ACQUIESCENCE

25. Opposer's claims are barred, in whole or in part, by the doctrine of acquiescence.

TENTH AFFIRMATIVE DEFENSE
WAIVER

26. Opposer's claims are barred, in whole or in part, by the doctrine of waiver.

ELEVENTH AFFIRMATIVE DEFENSE
INSUFFICIENT PRIOR EXCLUSIVE RIGHTS

27. Opposer's claims are barred, in whole or in part, because Opposer cannot establish prior exclusive rights in the United States sufficient to bar Applicant's registration of MCLAB.

WHEREFORE, Applicant requests judgment as follows:

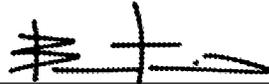
1. That the Notice of Opposition be dismissed with prejudice;
2. That Application Serial No. 77/253,879 be allowed to proceed to registration;

and

3. That Applicant be granted further reasonable and appropriate relief.

Dated: July 18, 2008

Respectfully submitted,



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MCLAB

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the following document:

APPLICANT MCLAB'S ANSWER

has been served on

John A. Cullis
Neal, Gerber, & Eisenberg LLP
2 North LaSalle Street, Suite 2200
Chicago, IL 60602

by mailing such document on July 18, 2008 by First Class Mail, postage prepaid.

I declare under penalty of perjury under the laws of the State of California and the United States of America that the foregoing is true and correct.

Dated: July 18, 2008



Bruno W. Tarabichi