ESTTA Tracking number: **ESTTA229760**
Filing date: **08/11/2008**

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

Proceeding	91184532
Party	Plaintiff McDonald's Corporation
Correspondence Address	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
Submission	Motion to Strike
Filer's Name	John A. Cullis
Filer's e-mail	jcullis@ngelaw.com, twilliams@ngelaw.com, rbrowne@ngelaw.com, mkelber@ngelaw.com
Signature	/John A. Cullis/
Date	08/11/2008
Attachments	Motiontostrike.pdf (23 pages)(713159 bytes)

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,	)	
v.	)	**Opposition No.: 91184532** **MARK: MCLAB**
MCLAB	)	
Applicant.	)	

OPPOSER'S MOTION TO STRIKE AFFIRMATIVE DEFENSES

Opposer McDonald's Corporation, pursuant to Federal Rule of Civil Procedure 12(f) and TBMP §506, hereby moves for an order striking all 11 Affirmative Defenses filed in this matter by Applicant MCLAB. In support of this motion, Opposer states as follows:

1. Motions to strike are useful "to simplify the pleadings and save time and expense by excising from [the pleading] any redundant, immaterial, impertinent, or scandalous matter which will not have any possible bearing on the outcome of the litigation." *Garlanger v. Verbeke*, 223 F. Supp. 2d 596, 609 (D.N.J. 2002).

2. Where, as in this case, an affirmative defense that "might confuse the issues in the case and would not, under the facts alleged, constitute a valid defense to the action can and should be deleted." *Waste Mgmt. Holdings, Inc. v. Gilmore*, 252 F.3d 316, 347 (4th Cir. 2001). Furthermore, an affirmative defense should be stricken "if it is impossible for the defendants to prove a set of facts in support of the affirmative defense that would defeat the complaint." *Openshaw v. Cohen, Klingenstein & Marks, Inc.*, 320 F. Supp. 2d 357, 364 (D. Md. 2004). Applicant's laundry list of defenses that are insufficient on their face do not constitute valid

defenses to this trademark infringement action and only serve to clutter the case and waste time and resources.

3. On June 11, 2008, Opposer initiated this proceeding against Applicant, seeking to oppose Application No. 77/253,879 for the trademark mark "MCLAB" for use 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 001 (hereinafter, the "McLAB" mark). As set forth in its Notice of Opposition, for over 50 years, Opposer has been engaged in the 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 under its world famous McDONALD'S trademark. Over these years, Opposer has built an extensive family of "Mc" formative marks formed by the distinctive "Mc" prefix with various generic and descriptive terms. In view of its longstanding use, Opposer filed its Notice of Opposition to prevent what it views as the inevitable likelihood of confusion that will result should the MCLAB mark become registered.

4. On July 18, 2008, Applicant filed its Answer and Affirmative Defenses, a copy of which is attached hereto as **Exhibit A**. As noted above, Applicant's Answer purports to set forth 11 separate Affirmative Defenses, all of which are fatally deficient in at least one substantive aspect and will serve only to clutter the case and force the parties to engage in substantial but unnecessary discovery. Further, as both parties may serve only a limited number of discovery

requests and interrogatories, the inclusion of these insufficient affirmative defenses will prejudice Opposer, who will be unduly burdened by having to devote substantial resources and a number of its limited discovery requests to these irrelevant and inapplicable issues. *See Nat'l Credit Union Admin. v. First Union Capital Mkts Corp.*, 189 F.R.D. 158, 163 (D. Md. 1999) (noting that "a motion to strike insufficient defenses does serve a useful purpose by eliminating insufficient defenses and saving time and expense which would otherwise be spent in litigating issues which would not affect the outcome of the case"). In particular, every one of the purported defenses suffers from one of the following deficiencies: (i) it is a "bare bones" conclusory statement that contains no reference to any facts; (ii) it is redundant; (iii) it is legally deficient in that it is either not a recognized affirmative defense or is otherwise legally improper; or (iv) it is an improper collateral attack on Opposer's registrations.

5. In Applicant's First Affirmative Defense (¶14), Applicant alleges that Opposer's Notice of Opposition "fails to state a claim upon which relief can be granted." Answer at ¶14. The Board has repeatedly stricken such a "defense" where, as here, Opposer has alleged facts that, if proved, would establish that: "(1) the opposer has standing to maintain the proceeding, and (2) a valid ground exists for opposing registration." *See Order of Sons of Italy in Am. v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1222 (TTAB 1995); *see also S.C. Johnson & Son, Inc. v. GAF Corp.*, 177 USPQ 720, 721 (TTAB 1973) (striking defense of failure to state a claim upon which relief could be granted where Opposer alleged likelihood of confusion with its prior registered mark). Opposer certainly has standing, as evidenced by its use and registrations of its "Mc" formative marks, as pled in the Notice of Opposition. *See* Notice of Opp. at ¶7. Opposer has also alleged under 15 U.S.C. §1063 that it will be harmed by the issuance of a registration for the subject mark to Applicant. *Id.* at ¶13. Opposer's pleading, therefore is legally

sufficient in stating a claim. Thus, the Board should strike Applicant's First Affirmative Defense (¶14) as improper.

6. In Applicant's Second Affirmative Defense (¶15), Applicant alleges that:

> 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.

Id. Applicant's assertion is wrong both factually and legally. From a factual standpoint, Opposer has alleged harm to its reputation and goodwill associated with it mark. Notice of Opp. at ¶13. More importantly, though, Applicant's assertion is legally incorrect. It is well-settled that "the owner of a mark is damaged by a later use of a similar mark which places the owner's reputation beyond its control, though no loss in business is shown." *Int'l Kennel Club of Chicago, Inc. v. Mighty Star, Inc.*, 846 F.2d 1079, 1091 (7th Cir. 1988), *citing James Burrough Ltd. v. Sign of the Beefeater, Inc.*, 540 F.2d 266, 276 (7th Cir. 1976); *Harjo v. Pro Football Inc.,* 30 USPQ2d 1828, 1832 (TTAB 1994). The term "damage" as used in Sections 13 and 14 of the Trademark Act concerns only a party's standing to file an opposition or petition to cancel, respectively. As previously established, a party may establish its standing to oppose or to petition to cancel by showing that it has a real interest in the case, that is, a personal interest beyond that of the general public. Thus, the Board should also strike Applicant's Second Affirmative Defense (¶15) as improper.

7. In addition, Applicant's Second Affirmative Defense (¶15) is duplicative of Applicant's denial of ¶13 of the Notice of Opposition. Notice of Opp. at ¶13. This allegation should therefore be stricken in the interest of removing unnecessary clutter from the pleadings and facilitating efficient discovery. *See Heller Fin., Inc. v. Midwhey Powder Co.*, 883 F.2d

1286, 1294 (7th Cir. 1989) ("where…motions to strike remove unnecessary clutter from the case, they serve to expedite, not delay").

8. Applicant's Third, Fourth and Fifth Affirmative Defenses (¶¶16-21) are not actually defenses at all. Answer at ¶16-21. An affirmative defense "directly or implicitly concedes the basic position of the opposing party but which asserts that notwithstanding that concession the opponent is not entitled to prevail because he is precluded for some other reason." *Choice Hotels Int'l, Inc. v. Madison Three, Inc.*, 83 F. Supp. 2d 602, 602 (D. Md. 2000); *Sanchez v. LaRosa Del Monte Express, Inc.*, No. 94C3602, 1994 WL 603901 (N.D. Ill. Nov. 1, 1994) ('[a]n affirmative defense …adds 'new matter which, assuming the complaint to be true, states a defense to it') (quoting Black's Law Dictionary, at 55 (5th Ed. 1979)). Instead, Applicant includes three defenses that are simply arguments under a likelihood of confusion analysis, and do not provide some other reason why Applicant should prevail in this matter. As none of the Third, Fourth, and Fifth Affirmative Defenses are "defenses" on which Applicant can prevail, the Board should strike the Third, Fourth, and Fifth Affirmative Defenses (¶¶16-21) from the pleadings.

9. Applicant's Sixth Affirmative Defense asserting that Opposer lacks standing is also unsupported by the facts. Answer at ¶22. As stated above, Opposer certainly has standing, as evidenced by its use and registrations of its "Mc" formative marks, as pled in the Notice of Opposition. *See* Notice of Opp. at ¶7. Opposer has also alleged under 15 U.S.C. § 1063 that it will be harmed by the issuance of a registration for the subject mark to Applicant. *Id.* at ¶11. Opposer's pleading, therefore is legally sufficient in stating a claim. Thus, the Board should strike Applicant's Sixth Affirmative Defense (¶22) as improper.

10. Applicant's Seventh, Eighth, Ninth, and Tenth Affirmative Defenses relating to estoppel, laches, acquiescence, and waiver, respectfully, also cannot stand. Answer at ¶23-26. Estoppel, for example, prevents a litigant from asserting a claim against another party that has changed its position, to its detriment, in reliance upon the litigant's misrepresentation or failure to disclose a material fact. *See Westfield Ins. Co. v. Paugh*, 390 F. Supp. 2d 511, 529 (N.D.W.V. 2005); *see also Leading Edge Tech. Corp. v. Sun Automation, Inc.*, No. H-90-2316, 1991 U.S. Dist. Lexis 20766, at *26-27 (D. Md. Sept. 24, 1991) (citing elements of equitable estoppel in patent context). In this case, Opposer has made no representations to Applicant other than putting Applicant on notice that they are violating Opposer's intellectual property rights. Thus, the Board should strike the Seventh Affirmative Defense (¶23) as improper.

Similarly, it is well established that, in an opposition proceeding, the defenses of laches and acquiescence (the Eighth and Ninth Affirmative Defenses (¶¶24-25), respectfully) run from the time the mark is published for opposition, not from the time of knowledge of use. *National Cable Television Association v. American Cinema Editors Inc.*, 937 F.2d 1572, 1581, 19 USPQ2d 1424, 1432 (Fed. Cir. 1991); *Coach House Restaurant Inc. v. Coach and Six Restaurants Inc.*, 934 F.2d 1551, 1558; 19 USPQ2d 1401, 1404-05 (11th Cir. 1991); and *Turner v. Hops Grill & Bar Inc.*, 52 USPQ2d 1310, 1312 (TTAB 1999). The Court of Appeals for the Federal Circuit has explicitly held that laches, which is also characterized as "acquiescence," cannot apply where, as here, Opposer acts at its first opportunity to protest the issuance of a registration – namely, when the mark is published for opposition. *National Cable Television Ass'n Inc.*, 19 USPQ2d at 1431-32 (re-affirming precedent that laches is measured "from the time the action could be taken against the acquisition by another of a set of rights…"). *See also*

James Burrough Ltd. v. Lajoie, 174 USPQ 329, 331 (CCPA 1972) (holding that where Opposer timely filed opposition proceeding the defense of acquiescence was inapplicable).

Here, the underlying application was published in the Official Gazette on February 12, 2008. Opposer timely filed its First 90 Day Request for Extension of Time to Oppose for Good Cause on February 14, 2008. The Board granted Opposer's Motion and in so doing, reset the deadline to oppose for June 11, 2008. Opposer timely filed its Notice of Opposition on June 11, 2008, which the Board instituted on June 11, 2008. *See* copy of TARR record, attached hereto as **Exhibit B**. On these facts, Applicant cannot fairly maintain that there has been any undue delay in Opposer acting to assert its rights. Thus, the Board should strike the Eighth and Ninth Affirmative Defenses (¶¶24-25) from the pleadings.

The defense of waiver (the Tenth Affirmative Defense (¶26)), on the other hand, requires "the intentional relinquishment or abandonment of a known right." *Kontrick v. Ryan,* 540 U.S. 443, 458 n.13 (2004) (internal quotation omitted) (overruled in part on other grounds). Opposer has certainly not relinquished or abandoned any rights in relation to this matter. In fact, just the opposite is true – Opposer has bought this action to protect its rights and valuable assets. The Tenth Affirmative Defense (¶26), therefore, should be stricken as well.

11. Lastly, in Applicant's Eleventh Affirmative Defense (¶27), Applicant alleges that Opposer's claims are barred because Opposer cannot establish prior exclusive rights sufficient to bar Applicant's registration of the mark MCLAB. Answer at ¶27. However, this "defense" is an improper collateral attack on Opposer's federally registered mark, "Mc." It is well-settled that such a collateral attack on the validity of a registration is not properly asserted as an affirmative defense. *Contour Chair-Lounge Co. v. Englander Co.*, 324 F.2d 186, 188 (CCPA 1964). Thus, Applicant's Eleventh Affirmative Defense (¶27) should be stricken in its entirety as well.

12. In sum, each of Applicant's Affirmative Defenses should be stricken from this case as they are fatally flawed in at least one aspect. To do so will best serve the interests of the parties and the Board by removing irrelevant and unnecessary issues from the proceeding and allow this case to move forward in an efficient and focused manner.

WHEREFORE, Opposer respectfully requests that the Board:

(1) enter an Order granting Opposer's Motion and striking each of Applicant's Affirmative Defenses; and

(2) grant Opposer any such additional and further relief that the Board deems proper.

Respectfully submitted,

Date: August 11, 2008

By: /John A. Cullis/
One of the Attorneys for Opposer,
McDonald's Corporation

Robert E. Browne
John A. Cullis
Thomas E. Williams
Neal, Gerber & Eisenberg
Two North LaSalle Street
Chicago, Illinois 60602-3801
(312) 269-8000 (phone)
(312) 269-1747 (fax)

CERTIFICATE OF TRANSMISSION

I hereby certify that the foregoing **OPPOSER'S MOTION TO STRIKE AFFIRMATIVE DEFENSES** 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: August 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 **OPPOSER'S MOTION TO STRIKE AFFIRMATIVE DEFENSES** upon:

Bruno W. Tarabichi
OWENS TARABICHI LLP
111 W. Saint John St., Suite 588
San Jose, California 95113
(408) 298-8204 (phone)
(408) 521-2203 (fax)
btarabichi@owenstarabichi.com
Attorneys for Applicant,
MCLAB

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: August 11, 2008 By: /Thomas E. Williams/
One of the Attorneys for Opposer,
McDonald's Corporation

NGEDOCS: 1552145.3

Exhibit A

Trademark Trial and Appeal Board Electronic Filing System. http://estta.uspto.gov

ESTTA Tracking number: **ESTTA225175**

Filing date: **07/18/2008**

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

Proceeding	91184532
Party	Defendant MCLAB
Correspondence Address	CHANGPING SHI MCLAB 384 OYSTER POINT BLVD STE 15 SOUTH SAN FRANCISCO, CA 94080-1968 ginageshi@gmail.com
Submission	Answer
Filer's Name	Bruno Tarabichi
Filer's e-mail	btarabichi@owenstarabichi.com
Signature	/bruno tarabichi/
Date	07/18/2008
Attachments	MCLAB's Answer.pdf (8 pages)(106085 bytes)

Owens Tarabichi Docket No. 142-2001

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,

Bruno W. Tarabichi
OWENS TARABICHI LLP
111 W. Saint John St., Suite 588
San Jose, California 95113
Tel. (408) 298-8204
Fax (408) 521-2203
btarabichi@owenstarabichi.com
Attorneys for Applicant
MCLAB

CERTIFICATE OF SERVICE

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

APPLICANT MCLAB'S ANSWER

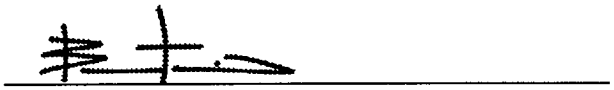
has been served on

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

Exhibit B

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2008-08-11 10:53:04 ET

Serial Number: 77253879 Assignment Information Trademark Document Retrieval

Registration Number: (NOT AVAILABLE)

Mark

MCLAB

(words only): MCLAB

Standard Character claim: Yes

Current Status: An opposition is now pending at the Trademark Trial and Appeal Board.

Date of Status: 2008-06-11

Filing Date: 2007-08-13

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 111

Attorney Assigned:
BELLO ZACHARY R

Current Location: 650 -Publication And Issue Section

Date In Location: 2008-01-09

LAST APPLICANT(S)/OWNER(S) OF RECORD

---

1. MCLAB

Composed Of:
Changping Shi, USA Citizen
Address:

MCLAB
384 Oyster Point Blvd, Suite #15
South San Francisco, CA 94080
United States
Legal Entity Type: Sole Proprietorship
State or Country Where Organized: California
Phone Number: 650-872-0245
Fax Number: 650-872-0253

GOODS AND/OR SERVICES

International Class: 001
Class Status: Active
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
Basis: 1(a)
First Use Date: 2000-01-03
First Use in Commerce Date: 2000-01-03

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2008-06-11 - Opposition instituted for Proceeding

2008-02-14 - Extension Of Time To Oppose Received

2008-02-12 - Published for opposition

2008-01-23 - Notice of publication

2008-01-09 - Law Office Publication Review Completed

2008-01-08 - Assigned To LIE

2007-11-21 - Approved for Pub - Principal Register (Initial exam)

2007-11-19 - Assigned To Examiner

2007-08-16 - New Application Entered In Tram

ATTORNEY/CORRESPONDENT INFORMATION

Correspondent
BRUNO TARABICHI
OWENS TARABICHI LLP
111 W. SAINT JOHN ST., SUITE 588
SAN JOSE, CA 95113
Phone Number: 650-872-0245
Fax Number: 650-872-0253