

ESTTA Tracking number: **ESTTA308791**

Filing date: **09/29/2009**

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		
Entity	Corporation	Citizenship	Illinois
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 1700 Chicago, IL 60602 UNITED STATES apeterson@ngelaw.com, jcullis@ngelaw.com, mturner@ngelaw.com, rbrowne@ngelaw.com Phone:312.269.8000
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Applicant Information

Application No	77722272	Publication date	09/01/2009
Opposition Filing Date	09/29/2009	Opposition Period Ends	10/01/2009
Applicant	McSweet, LLC P.O. Box 607 Maple Valley, WA 98038 UNITED STATES		

Goods/Services Affected by Opposition

Class 029. First Use: 2008/09/04 First Use In Commerce: 2008/09/04
All goods and services in the class are opposed, namely: Pickled asparagus

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.	743572	Application Date	05/04/1961
Registration Date	01/08/1963	Foreign Priority Date	NONE
Word Mark	MCDONALD'S		
Design Mark			
Description of Mark	NONE		

Goods/Services	Class U100 (International Class 042). First use: First Use: 1948/12/00 First Use In Commerce: 1953/05/06 Drive-In Restaurant Services		
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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.	1118362	Application Date	09/23/1976
Registration Date	05/15/1979	Foreign Priority Date	NONE
Word Mark	MCPIZZA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 029. First use: First Use: 1976/08/30 First Use In Commerce: 1976/08/30 PREPARED FOOD PRODUCT CONSISTING PRINCIPALLY OF CHEESE, TOMATO, AND SEASONINGS TO BE USED ON TOAST		

U.S. Registration No.	1266500	Application Date	06/21/1982
Registration Date	02/07/1984	Foreign Priority Date	NONE
Word Mark	MC DOUBLE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use: 1977/06/30 First Use In Commerce: 1977/09/30 a Sandwich for Consumption On or Off Premises		

U.S. Registration No.	1293449	Application Date	03/21/1983
Registration Date	09/04/1984	Foreign Priority Date	NONE
Word Mark	MCSNACK		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 042. First use: First Use: 1982/12/11 First Use In Commerce: 1982/12/11 Carryout Restaurant Services

U.S. Registration No.	1315979	Application Date	06/11/1982
Registration Date	01/22/1985	Foreign Priority Date	NONE
Word Mark	MCRIB		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use: 1981/06/30 First Use In Commerce: 1981/06/30 a Sandwich for Consumption On or Off the Premises		

U.S. Registration No.	1369360	Application Date	02/13/1984
Registration Date	11/05/1985	Foreign Priority Date	NONE
Word Mark	MCMUFFIN		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use: 1983/05/00 First Use In Commerce: 1983/05/00 BREAKFAST FOOD COMBINATION SANDWICH FOR CONSUMPTION ON OR OFF THE PREMISES		

U.S. Registration No.	1450104	Application Date	09/30/1982
Registration Date	07/28/1987	Foreign Priority Date	NONE
Word Mark	MCNUGGETS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1980/04/00 First Use In Commerce: 1980/04/00 RESTAURANT SERVICES		

U.S. Registration No.	1541797	Application Date	01/19/1988
Registration Date	05/30/1989	Foreign Priority Date	NONE
Word Mark	MCCOLA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 032. First use: First Use: 1987/11/18 First Use In Commerce: 1987/11/18		

	SOFT DRINKS FOR CONSUMPTION ON OR OFF THE PREMISES		
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U.S. Registration No.	1552143	Application Date	11/23/1988
Registration Date	08/15/1989	Foreign Priority Date	NONE
Word Mark	MCCHILI		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 029. First use: First Use: 1988/05/20 First Use In Commerce: 1988/05/20 CHILI FOR CONSUMPTION ON AND OFF THE PREMISES		

U.S. Registration No.	1566184	Application Date	07/05/1988
Registration Date	11/14/1989	Foreign Priority Date	NONE
Word Mark	MCCOOKIE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use: 1988/06/17 First Use In Commerce: 1988/06/17 SOFT SERVE ICE MILK SUNDAES FOR CONSUMPTION ON OR OFF THE PREMISES		

U.S. Registration No.	1878164	Application Date	03/08/1994
Registration Date	02/07/1995	Foreign Priority Date	NONE
Word Mark	MCTREATS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1994/01/23 First Use In Commerce: 1994/01/23 restaurant services		

U.S. Registration No.	1943180	Application Date	01/06/1994
Registration Date	12/19/1995	Foreign Priority Date	NONE
Word Mark	MCCOFFEE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1976/00/00 First Use In Commerce: 1976/00/00 restaurant services		

U.S. Registration No.	2289608	Application Date	04/08/1998
Registration Date	10/26/1999	Foreign Priority	NONE

		Date	
Word Mark	MCVEGGIE BURGER		
Design Mark	MCVEGGIE BURGER		
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use: 1998/04/19 First Use In Commerce: 1998/04/19 specialty sandwich for consumption on or off the premises		

U.S. Registration No.	2428690	Application Date	02/20/1998
Registration Date	02/13/2001	Foreign Priority Date	NONE
Word Mark	MCHERO		
Design Mark	MCHERO		
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use: 1997/09/00 First Use In Commerce: 1997/09/00 specialty sandwich for consumption on or off the premises		

U.S. Registration No.	2782030	Application Date	12/11/2002
Registration Date	11/11/2003	Foreign Priority Date	NONE
Word Mark	MCTERI		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use: 1994/06/17 First Use In Commerce: 1994/06/17 SPECIALTY SANDWICH FOR CONSUMPTION ON OR OFF THE PREMISES		

U.S. Registration No.	2805109	Application Date	12/19/1997
Registration Date	01/13/2004	Foreign Priority Date	NONE
Word Mark	MCFLURRY		
Design Mark			
Description of	NONE		

Mark	
Goods/Services	Class 030. First use: First Use: 1997/10/31 First Use In Commerce: 1997/10/31 dairy based dessert products namely ice cream and frozen confections

U.S. Registration No.	3151707	Application Date	05/12/2004
Registration Date	10/03/2006	Foreign Priority Date	NONE

Word Mark	MCGRIDDLES
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Design Mark	
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Description of Mark	NONE
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Goods/Services	Class 030. First use: First Use: 2000/10/31 First Use In Commerce: 2000/10/31 HOT CAKES
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U.S. Registration No.	3201441	Application Date	03/02/2006
Registration Date	01/23/2007	Foreign Priority Date	NONE

Word Mark	MCCAFE
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Design Mark	
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Description of Mark	NONE
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Goods/Services	Class 030. First use: First Use: 2001/05/02 First Use In Commerce: 2001/05/02 BEVERAGES MADE OF COFFEE BEANS, HOT CHOCOLATE, PASTRIES, MUFFINS, CAKES, COOKIES, BISCUITS AND SANDWICHES
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U.S. Registration No.	3407069	Application Date	03/16/2006
Registration Date	04/01/2008	Foreign Priority Date	NONE

Word Mark	MCSKILLET
Design Mark	
Description of Mark	NONE
Goods/Services	Class 029. First use: First Use: 2006/04/13 First Use In Commerce: 2006/04/13 BREAKFAST ENTREES CONSISTING OF EGGS, MEAT, CHEESE AND VEGETABLES

Related Proceedings	91178758
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Attachments	73100829#TMSN.gif (1 page)(bytes) 75464648#TMSN.gif (1 page)(bytes) 75449374#TMSN.gif (1 page)(bytes) 78417184#TMSN.jpeg (1 page)(bytes) 78827670#TMSN.jpeg (1 page)(bytes) 78839012#TMSN.jpeg (1 page)(bytes) Notice_of_Opposition_-_SECOND_APPLICATION.pdf (8 pages)(22052 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	09/29/2009

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

McDONALD'S CORPORATION,)	
)	Opposition No. _____
Opposer,)	
)	
v.)	Mark: McSWEET
)	Application S/N: 77/722,272
McSWEET, LLC,)	Filed: April 24, 2009
)	Published: September 1, 2009
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 "McSWEET" in International Class 29 as shown in Application Serial No. 77/722,272 filed by McSweet, LLC ("Applicant"), and hereby opposes the same and requests that registration to Applicant be refused. As grounds for its opposition, Opposer alleges as follows:

1. Applicant has filed an application to register a mark which consists of the term "McSWEET" for use in connection with "pickled asparagus" in International Class 29 ("the Second McSWEET Application").

2. On or about August 8, 2006, Applicant previously filed for registration of the term "McSWEET" for use in connection with various pickled vegetable products, and has since amended its designation to "pickled gourmet vegetables, namely, pickled cocktail onions, pickled garlic, pickled, marinated olive medley, pickled green beans, and giardiniera, namely, a pickled celery, carrot, red pepper, garlic, green bean, and cucumber mix," also in International

Class 29 (“the First McSWEET Application”). The First McSWEET Application is the subject of Opposition No. 91178758, wherein Opposer has moved for summary judgment on multiple grounds.

3. Opposer is timely filing this Notice of Opposition.

4. 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 quickly-prepared, modestly-priced foods. In addition, Opposer has widely used the “Mc” formative alone and together with other words throughout the United States and the world as trademarks and service marks for, and in advertising and promotion of, a wide variety of food products and restaurant services, including, but not limited to: salads, chili, breakfast foods, specialty sandwiches, dessert products, chicken sandwiches, beverages, pizza and bagels. It has also used the “Mc” formative mark on a wide variety of goods and services that are not related to food products or restaurant services. Opposer has used its “Mc” formative marks with the same goods or type of goods for which registration of the “McSWEET” mark is sought. In addition, Opposer is likely to further expand the use of its “Mc” formative marks to include additional goods that are the same or the same type of goods as those for which registration of the “McSWEET” mark is sought.

5. Opposer owns a federal registration on “Mc,” Registration No. 1,947,099, issued on January 9, 1996 for restaurant services. Opposer also owns the following federal registrations of its “McDONALD’S” and “Mc” formative marks for goods or services, some of which are substantially similar or closely related by their nature or use to Applicant’s goods:

<u>MARK NAME</u>	<u>REG. NO.</u>	<u>REG. DATE</u>	<u>GOODS/SERVICES</u>
1. McDONALD'S	743,572	01/08/1963	Restaurant services
2. McCHICKEN	1,065,885	05/17/1977	Cooked chicken for consumption on or off the premises
3. McPIZZA	1,118,362	05/15/1979	Prepared food product consisting principally of cheese, tomato, and seasonings to be used on toast
4. McDOUBLE	1,266,500	02/07/1984	A sandwich for consumption on or off premises
5. McSNACK	1,293,449	09/04/1984	Carryout restaurant services
6. McRIB	1,315,979	01/22/1985	A sandwich for consumption on or off the premises
7. McMUFFIN	1,369,360	11/05/1985	Breakfast food combination sandwich for consumption on or off the premises
8. McNUGGETS	1,450,104	07/28/1987	Restaurant Services
9. McCOLA	1,541,797	05/30/1989	Soft drinks for consumption on or off the premises
10. McCHILI	1,552,143	08/15/1989	Chili for consumption on and off the premises
11. McCOOKIE	1,566,184	11/14/1989	Soft serve ice milk sundaes for consumption on or off the premises
12. McTREATS	1,878,164	02/07/1995	Restaurant services
13. McCOFFEE	1,943,180	12/19/1995	Restaurant services
14. McVEGGIE BURGER	2,289,608	10/26/1999	Specialty sandwich for consumption on or off the premises
15. McHERO	2,428,690	02/13/2001	Specialty sandwich for consumption on or off the premises
16. McTERI	2,782,030	11/11/2003	Specialty sandwich for consumption on or off the premises

<u>MARK NAME</u>	<u>REG. NO.</u>	<u>REG. DATE</u>	<u>GOODS/SERVICES</u>
17. McFLURRY	2,805,109	01/13/2004	Dairy based dessert products namely ice cream and frozen confections
18. McGRIDDLES	3,151,707	10/03/2006	Hot cakes
19. McCAFE	3,201,441	01/23/2007	Beverages made of coffee beans, hot chocolate, pastries, muffins, cakes, cookies, biscuits and sandwiches
20. McSKILLET	3,407,069	04/01/2008	Breakfast entrees consisting of eggs, meat, cheese and vegetables

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

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

7. Through Opposer's long, extensive and continuous use of the mark McDONALD'S and its "Mc" formative marks, the public has come to recognize marks combining the "Mc" prefix with a common or descriptive word, when applied to a wide variety of goods and services, as a family of "Mc" marks 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.

8. Despite Opposer's long-standing prior rights in the McDONALD'S mark, as well as Opposer's "Mc" family of marks for food products, restaurant services, and a wide variety of

other goods and services, Applicant filed the Second McSWEET Application, which was assigned Application Serial No. 77/722,272.

9. The mark proposed for registration by Applicant uses, as its principal distinctive element, the “Mc” prefix. The distinctive “Mc” formative is coupled with the common word “sweet,” which is a descriptive term used to describe a characteristic of the processed vegetables identified in the Second McSWEET Application. Potential purchasers, upon seeing the distinctive formative “Mc” used with the descriptive word “sweet,” are likely to mistakenly believe that such a term and the food products offered thereunder originated with or are connected or associated with, or sponsored, licensed or approved by Opposer. Thus, the registration and use by Applicant of the “McSWEET” mark in connection with its proposed goods 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. § 1114(1)(a).

10. In addition, Opposer’s “Mc” family of marks was well established and famous long before Applicant filed the Second McSWEET Application. Thus, registration by Applicant is likely to diminish and dilute the distinctive quality of McDonald’s rights in its famous “Mc” formative family of marks in violation of 15 U.S.C. § 1125(c). Moreover, registration by Applicant is likely to diminish the advertising value of the “Mc” formative marks, and such registration and use is likely to, in the event of any quality problems involving the goods offered by Applicant, tarnish the distinctiveness of McDonald’s famous marks.

11. In light of Opposer’s widespread advertising, promotion and use of its “Mc” formative marks, Applicant’s selection of a term confusingly similar to Opposer’s long 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.

12. If a registration is issued to Applicant for the “McSWEET” mark for use in connection with pickled asparagus, the confusion with Opposer’s marks would result in damage and injury to Opposer and the public. Such registration 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 goods are related in some fashion to Opposer; to 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 goods to reflect upon Opposer; and to restrict the natural growth of Opposer’s family of “Mc” formative marks.

13. On information and belief, Applicant is not the actual owner of the “McSWEET” mark. Applicant is a mere licensee of the “McSWEET” mark, and any use of the “McSWEET” mark by Applicant inures to the licensor, who is not set forth in the Second McSWEET Application. Because Applicant is not the owner of the “McSweet” mark, the Second McSWEET Application is void *ab initio*.

WHEREFORE, Opposer requests that this Opposition be sustained and Application Serial No. 77/722,272 be refused registration.

Please charge any additional fees related to this matter to Deposit Account No. 502261.

Respectfully submitted,

McDONALD'S CORPORATION

Date: September 29, 2009

By: / John A. Cullis/
One of the Attorneys for Opposer

Robert E. Browne
John A. Cullis
Lawrence E. James, Jr.
Mike R. Turner
NEAL, GERBER & EISENBERG, LLP
2 N. LaSalle Street, Suite 1700
Chicago, IL 60602
(312) 269-8000

CERTIFICATE OF SERVICE

I, Mike R. Turner, state that I served a copy of the foregoing *Notice of Opposition*, via first class U.S. mail, postage pre-paid, upon:

Katherine Hendricks
HENDRICKS & LEWIS PLLC
901 Fifth Ave., Ste 4100
Seattle, WA 98164

on this 29th day of September, 2009.

/Mike R. Turner /
Mike. R. Turner