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

Proceeding	91192099
Party	Defendant McSweet, LLC
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Date	12/29/2009
Attachments	89696.PDF (11 pages)(404876 bytes) 89697.PDF (4 pages)(118100 bytes) Exhibit B.pdf (13 pages)(480425 bytes)

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

In the Matter of:
Application Serial No. 77/722,272
Published in the *Official Gazette*
September 1, 2009

McDONALD's CORPORATION,	)	
	)	
Opposer,	)	
	)	
v.	)	Opposition No. 91192099
	)	
McSWEET, LLC,	)	
	)	
Applicant.	)	

APPLICANT'S OPPOSITION TO OPPOSER'S MOTION FOR LEAVE TO AMEND ITS NOTICE OF OPPOSITION

Applicant, McSWEET, LLC, respectfully submits this opposition to Opposer's Motion for Leave to Amend Its Notice of Opposition that was submitted after Applicant's Answer To Notice Of Opposition And Counterclaims.

I. Facts.

The following facts and chronology are pertinent:

On April 24, 2009, Applicant applied to register the mark McSWEET for pickled asparagus. Serial No. 77722272.

On September 29, 2009, Opposer filed its notice opposition alleging that there was a likelihood of confusion and dilution as a result of Opposer's ownership of numerous registrations. Opposer pled twenty marks in support of its argument, claiming that the listed "registrations are valid, subsisting, and in full force and effect. . . . Each of the aforesaid

registrations is at least prima facie evidence of: (i) the validity of each registration . . . ." Notice of Opposition, ¶¶ 5-6.

On November 6, 2009, Applicant filed its answer to Opposer's notice of opposition as well as counterclaims seeking cancellation of seven of twenty marks pled by Opposer for abandonment due to nonuse : Registration Nos. 1,118,362 for McPIZZA; 1,541,797 for McCOLA; 1,552,143 for McCHILI; 1,566,184 for McCOOKIE; 1,943,180 for McCOFFEE; and 2,289,608 for McVEGGIE BURGER, and 1,450,104 for McNUGGETS.

On December 9, 2009, Opposer filed its answer to Applicant's counterclaims and first affirmative defense. Opposer asserted an admission that it is using all seven marks in commerce and denies abandonment. Nevertheless, on December 9, 2009, Opposer filed for the voluntary surrender of registration for six out of the seven marks as to which Applicant sought cancellation.

Opposer did not seek or obtain Applicant's consent for voluntary surrender and does not suggest that it did.

On December 9, 2009, Opposer filed a motion for leave to amend its notice of opposition. In its motion, Opposer attempts to include a new claim, additional Trademark Trial and Appeal Board and Federal Circuit proceedings, and elects to remove ten of the twenty marks it originally pled.

II. Argument.

1. OPPOSER'S MOTION TO AMEND IS UNNECESSARY BECAUSE JUDGMENT ON APPLICANT'S COUNTERCLAIMS FOR CANCELLATION SHOULD BE ENTERED AGAINST OPPOSER.

Pursuant to 37 C.F.R. § 2.134(a) and TBMP § 602.02(a), after the commencement of a cancellation proceeding, if the respondent applies for voluntary cancellation of the involved

registrations without the written consent of every adverse party to the proceedings, judgment shall be entered against the respondent.

Opposer applied to voluntarily surrender Registration Nos. 1,118,362 for McPIZZA; 1,541,797 for McCOLA; 1,552,143 for McCHILI; 1,566,184 for McCOOKIE; 1,943,180 for McCOFFEE; and 2,289,608 for McVEGGIE BURGER only *after* Applicant had filed a counterclaim to cancel these specified registrations as well as Registration No. 1,450,104 for McNUGGETS. The consent of Applicant McSweet LLC was neither sought nor given, and Opposer has not offered any evidence of consent.

Because Opposer failed to seek or obtain written consent from Applicant as to its application to surrender these marks, judgment with respect to the cancellation proceeding initiated by Applicant it its counterclaims should be entered against Opposer and the specified marks should be cancelled due to abandonment.

Under Rule 15(a), Fed. R. Civ. P., leave to amend pleadings shall be freely given when justice so requires. However, because neither Rule 2.134(a) governing voluntary surrender of a registration nor Rule 15(a) governing amendment of oppositions permits Opposer to voluntarily surrender its registrations, Opposer's "elect[ion]" to reduce the number of asserted marks in its Opposition is impermissible, and its motion to amend should be denied.

2. OPPOSER SHOULD BE ORDERED TO SHOW CAUSE WHY ITS SURRENDER FOR CANCELLATION WITHOUT THE CONSENT OF APPLICANT SHOULD NOT RESULT IN THE ENTRY OF JUDGMENT AGAINST OPPOSER.

Pursuant to 37 C.F.R. § 2.134(b), during the course of a cancellation proceeding, if the respondent has permitted its involved registration to be cancelled under Section 8 of the Trademark Act or has failed to renew its involved registration under Section 9 of the Act, then the Board may issue an order allowing respondent time to show cause why the cancellation, or

the failure to renew, should not be deemed the equivalent of a cancellation by request of respondent without the request of petitioner and should not result in entry of judgment against respondent. The purpose of this rule is "to prevent a cancellation proceeding respondent . . . from being able to moot the proceeding, and avoid judgment, by deliberately failing to file the required affidavits or renewal applications." 37 C.F.R. § 2.134(b), TBMP § 602.02(b), *See Marshall Field & Co. v. Mrs. Fields Cookies*, 11 U.S.P.Q.2d 1154, 1989 WL 297864 at *1 (TTAB 1989).

Although the Board has not determined whether the surrender of a registration during a cancellation proceeding invokes Rule 2.134(b), it has made comparable interpretations. *See* Jeffery A. Handelman, Guide to TTAB Practice Volume 1, § 3.20 (2008) (Copy appended, Exh. A) regarding the discussion of *Sara Lee Corp. v. Kayser-Roth Corp.*, Cancellation No. 21,981 (TTAB Dec. 6, 1994) (respondent's decision not to resume use of the mark during the pendency of a cancellation proceeding "can only be viewed as the equivalent of a voluntary cancellation of the registration and an attempt to moot the proceeding and thereby avoid judgment on the merits of petitioner's claims.") While *Sara Lee Corp. v. Kayser-Roth Corp.* is unpublished and designated as non-precedential, it may be cited for its persuasive value. *See* TMEP § 705.05.

Here, even though Opposer did not permit cancellation of the six contested marks by failing to file a Section 8 or 9, it did apply to voluntarily surrender the marks for cancellation *after* the cancellation proceeding was commenced to the same effect—mooting the cancellation proceeding and avoiding judgment. Opposer voluntarily surrendered six marks that it claims it "has used" and "denies that it has abandoned . . ." Opposer's Answer to Applicant's Counterclaims and First Affirmative Defense, ¶¶ 29-34. Originally, Opposer pled these marks to

bolster its argument and maintained that each pleaded mark was valid.[1] However, whether the marks are actually valid or not is a question left unanswered because Opposer deliberately surrendered the marks to avoid proving such use. Opposer should not be permitted to claim use then sidestep the cancellation proceeding altogether. If judgment is not entered forthwith under 37 C.F.R. § 2.134(a), Opposer should be ordered to show cause why its surrender for cancellation without the consent of Applicant should not result in the entry of judgment against it. Applicant has filed a corresponding Motion for Order for Opposer to Show Cause Why its Surrender for Cancellation Without the Consent of Applicant Should Not result in the Entry of Judgment Against Opposer concurrently herewith.

3. OPPOSER'S MOTION TO AMEND IS UNTIMELY AND PREJUDICIAL TO APPLICANT AND SHOULD BE DENIED.

Leave to amend pleadings will not be granted if the entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party or parties. *See generally*, *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 U.S.P.Q.2d 1503 (TTAB 1993) and *U.S. Olympic Comm. v. O-M Bread Inc.*, 26 U.S.P.Q.2d 1221 (TTAB 1993).

Timing of a motion for leave to amend is an important factor in determining whether a respondent would be prejudiced by the proposed amendment. *See* TBMP § 507.02; *Trek Bicycle Corp. v. StyleTrek Ltd.*, 64 U.S.P.Q.2d 1540 at *2 (TTAB 2001) (motion to amend opposition is denied where it was filed eight months after notice of opposition, with no explanation for the delay, and was based on facts within opposer's knowledge at the time opposition was filed). A motion for leave to amend should be filed as soon as any ground for such amendment becomes

[1] Opposer claims that the listed "registrations are valid, subsisting, and in full force and effect . . . Each of the aforesaid registrations is at least prima facie evidence of: (i) the validity of each registration . . . ." Notice of Opposition, ¶¶ 5-6.

apparent and lengthy delay may render the amendment untimely. *See Int'l Finance Corp. v. Bravo Co.*, 64 U.S.P.Q.2d 1597, 1604 (TTAB 2002).

Opposer unduly delayed in filing its motion to amend its notice of opposition. The newly added cases as well as the reduction of pleaded marks appear to be based on facts that were within Opposer's knowledge at the time the notice of opposition was filed. Specifically, in support of its "Mc" and "Mac" as a "family of marks" claim, Opposer included prior Trademark Trial and Appeal Board and Federal Circuit proceedings in which Opposer was a party. Because each cited proceeding occurred more than twenty years ago, Opposer could and should have included the citations prior to filing of the notice of opposition, or by prompt investigation conducted immediately thereafter.

Moreover, Applicant's counterclaims seek cancellation of Opposer's marks because of abandonment, not removal of those marks from Board consideration. Any removal stemming from the granting of McDonald's motion to amend would severely prejudice Applicant because the fact of McDonald's abandonment of those marks is an important defense in this proceeding.

In addition, Opposer originally pled twenty federally registered marks to illustrate its alleged "Mc" family of marks. Opposer explains that it "elected" to reduce the number of asserted marks from twenty to ten to "streamline" the proceedings. However, Applicant is pursuing the cancellation of only six of the ten marks that Opposer removed. Amending its opposition to remove most of the marks contested by Applicant does not avoid the cancellation proceeding nor dismiss the proceeding. Opposer should not be permitted, now, in the face of Applicant's counterclaims, to remove the contested marks in order to subvert the cancellation proceeding or the requirement to submit evidence of use. Contrary to Opposer's contention, it

cannot lever Applicant's counterclaims into an excuse to remove ten weak marks for consideration in this proceeding via amendment of its notice of opposition.

Furthermore, Opposer asserts that the ten remaining pleaded marks are "sufficient" to represent its "Mc" family of marks. Opposer's Motion For Leave To Amend Its Notice of Opposition, at 4. If Opposer believes that ten marks are sufficient to support its opposition, it is unclear, at best, why it elected to complicate and encumber this proceeding by initially pleading twenty. While Opposer now claims it seeks to "streamline" and "eliminate extraneous issues," it offers no explanation why it waited over two months and until after Applicant's counterclaims for cancellation before filing the motion for leave to amend.

Because Opposer fails to offer any explanation for its delay in including the new cases and reducing the number of pleaded marks, and could have, without difficulty, incorporated the sought after amendments in its original opposition (and certainly within twenty days thereafter), the motion to amend should be viewed as untimely and prejudicial, and should be denied.

4. OPPOSER'S MOTION TO AMEND TO ADD A NEW CLAIM IS PREJUDICIAL TO APPLICANT AND SHOULD BE DENIED.

Applicant would suffer prejudice if Opposer is permitted to add the generic claim at this juncture. Opposer's Proposed Amended Notice of Opposition, ¶ 9. Opposer did not assert that it was unable to learn about this new claim prior to or shortly after filing its first opposition. Opposer, therefore, had ample time to file a motion for leave to amend its pleading at an earlier stage in the proceeding. It is incumbent upon Opposer to identify all claims promptly in order to provide Applicant with proper notice. *Media Online Inc. v. El Clasificado*, Inc., Cancellation No. 92047294 at 7 (TTAB September 29, 2008). Allowing piecemeal prosecution of this case would unfairly prejudice Applicant by increasing the time, effort, and money that Applicant

would be and has been required to expend to defend against Opposer's challenge to its registration. *Id.*

5. OPPOSER'S MOTION TO AMEND TO ADD A PROPOSED GENERIC CLAIM IS FUTILE AND SHOULD BE DENIED.

Opposer's proposed generic claim is futile. A generic name of a product can never function as a trademark to indicate origin. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 15, comment a (1995) ("Generic designations are not subject to appropriation as trademarks at common law and are not eligible for registration under state and federal trademark statutes."). To properly be deemed an unprotectable "generic name" in trademark law, the designation must be the name of the same product or service of which it is alleged to identify the source. *See Liquid Controls Corp. v. Liquid Control Corp.*, 802 F.2d 934, 936, 231 U.S.P.Q. 579 ("A generic term is one that is commonly used as the name of a kind of goods. . . . Unlike a trademark, which identifies the source of a product, a generic term merely specifies the genus of which the particular product is a species.").

Opposer has failed to state a generic claim because it has failed to plead particular facts sufficient to show that Applicant's mark McSWEET is the name of the products Applicant sells under this mark. On the contrary, the name of Applicant's company is McSweet, LLC, and the product involved in this opposition that Applicant sells under that name is pickled asparagus. Thus the trademark McSWEET identifies the source of the product and not the particular product itself. Accordingly, Opposer's motion to amend to add a generic claim should be denied.

6. OPPOSER'S MOTION TO AMEND TO INCLUDE PREVIOUS TRADEMARK TRIAL AND APPEAL BOARD DECISIONS IN WHICH OPPOSER WAS A PARTY CANNOT ACT AS A SUBSTITUE FOR EVIDENCE AND SHOULD BE DENIED.

Reliance on previous decisions cannot act as a substitute for evidence. *Chicken Delight, Inc. v. Delight Wholesale Co.*, 193 U.S.P.Q. 175, 177 (TTAB 1976) ("[I]t is well settled that a decision in a prior case is incompetent as proof of any fact recited therein as against one who was not a party thereto."); *Standard Knitting Ltd. v. Toyota Jidosha Kabushiki Kaisha*, 77 U.S.P.Q.2d 1917, 1931 n.24 (TTAB 2006) (rejecting an opposer's reliance on case law to establish that automobiles are related to clothing because such cases "cannot be relied on by opposer as proof of the facts found therein."); *In re Jamil*, Serial No. 76032587 (TTAB February 17, 2005) (determining that two precedential decisions made by the Board that McDonald's had a famous family of marks with the prefix "Mc" could not be used against the applicant because not only were such cases over "nine and [fourteen] years old, but even if they issued on the same date as this opinion, the findings of fact and conclusions of law stated therein do not constitute *evidence* which is binding on either applicant or the Board in *this* proceeding.") (non-precedential case which may be cited for its persuasive value under TMEP § 705.05). Copy appended, Exh. B.

Here, Opposer attempts to amend its notice of opposition to include four decisions from both the Trademark Trial and Appeal Board and the Federal Circuit as evidence to support its claim that "Mc" and "Mac" are recognized as a family of marks. Opposer's Proposed Amended Notice of Opposition, ¶ 8. Not only are the cases nine to twenty-three years old, but Applicant was not a party in the cases, thus the Board must only look to the evidence in *this* case to determine if "Mc" and "Mac" are recognized as a family of marks. Therefore, because the four cases Opposer includes are not binding on this proceeding, the amendment should be denied.

WHEREFORE, Applicant respectfully requests that the Board enter an Order denying Opposer's Motion For Leave To Amend Its Notice Of Opposition.

Respectfully submitted,

HENDRICKS & LEWIS, PLLC

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Dated: December 29, 2009

CERTIFICATE OF SERVICE

I hereby certify that on December 29, 2009 I served a true and complete copy of the foregoing APPLICANT'S OPPOSITION TO OPPOSER'S MOTION FOR LEAVE TO AMEND ITS NOTICE OF OPPOSITION via email and First Class U.S. Mail, postage pre-paid, upon:

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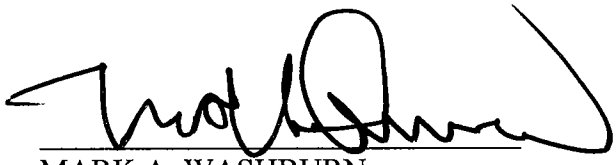

MARK A. WASHBURN

EXHIBIT A

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GUIDE TO TTAB PRACTICE

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2008 SUPPLEMENT

With regard to the likelihood of confusion ground, the Board observed that "respondent's failure to file a Section 8 affidavit was the result of a deliberate business decision made well prior to the commencement of this proceeding and not for the purpose of avoiding this proceeding."[167] Thus, the Board did *not* enter judgment against Mrs. Fields on the ground of likelihood of confusion. The Board noted that one of the four challenged registrations was over five years old when the cancellation petition was filed and therefore was not subject to cancellation on the basis of likelihood of confusion, while the other three registrations were less than five years old and hence could be canceled based on the likelihood of confusion ground. Accordingly, the Board gave petitioner Marshall Field an opportunity to elect whether it wished (1) to have the petition dismissed without prejudice with respect to the ground of likelihood of confusion for the remaining three registrations, or (2) to go forward for a decision on that issue.[168]

[C] Deliberate Cancellation or Expiration of Registration

If respondent deliberately permits its challenged registration to be canceled under Section 8 or not renewed under Section 9 in an effort to moot the case and avoid having judgment entered against it in the cancellation proceeding, the Board will enter judgment against respondent and in favor of petitioner on petitioner's pleaded claims. Such judgment would have res judicata effect against respondent.

In an unpublished case, *Sara Lee Corp. v. Kayser-Roth Corp.*,[169] Sara Lee petitioned to cancel Kayser-Roth's registration based on both likelihood of confusion and abandonment claims. The cancellation proceeding was suspended pending the outcome of a civil action between the parties. While the proceeding was suspended, Kayser-Roth's challenged registration was cancelled under Section 8. Kaiser-Roth argued that judgment should not be entered against it because its failure to file the Section 8 affidavit "reflects only its present decision not to resume use of the mark, and does not at all reflect upon the mark's alleged similarity to any trademark of petitioner nor upon registrant's alleged prior abandonment of the mark." The Board rejected this purported showing of good and

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[167] *Marshall Field & Co. v. Mrs. Fields Cookies*, 11 USPQ2d 1154, 1156 (TTAB 1989).

[168] *Marshall Field & Co. v. Mrs. Fields Cookies*, 11 USPQ2d 1154, 1156–57 (TTAB 1989).

[169] *Sara Lee Corp. v. Kayser-Roth Corp.*, Cancellation No. 21,981 (TTAB Dec. 6, 1994).

sufficient cause. In entering judgment against respondent and in favor of petitioner on petitioner's pleaded claims, the Board explained:

> Respondent's failure to file the Section 8 affidavit was not the result of inadvertence or mistake, but was deliberate. Respondent's failure to file the Section 8 affidavit was not the result of a business decision, made prior to commencement of this proceeding, to abandon the registered mark; in fact, respondent denies that such prior abandonment occurred.
>
> Indeed, respondent's 'present decision not to resume use of the mark,' a decision made during the pendency of this cancellation proceeding, can only be viewed as the equivalent of a voluntary cancellation of the registration and an attempt to moot the proceeding and thereby avoid judgment on the merits of petitioner's claims. This is precisely the result Trademark Rule 2.134 is designed to avoid.

If, during the course of a cancellation proceeding, the respondent is planning *not* to make a Section 8 or Section 9 filing for a challenged registration, it should contact petitioner and request written consent to have the registration cancelled under Trademark Rule 2.134(a). If petitioner is willing to give such consent, the registration can be surrendered for cancellation without any judgment entered against respondent.

§ 3.21 CANCELLATION OF REGISTRATIONS ON THE SUPPLEMENTAL REGISTER

[A] The Difference Between the Supplemental Register and the Principal Register

The Lanham Act provides for two trademark registers: the Principal Register, which covers full-fledged trademarks that are distinctive at the time of registration, and the Supplemental Register, a second-class register that is reserved for terms that while not yet distinctive, are "capable" of becoming so in the future through use and promotion. Thus, a mark that does not meet all the requirements for registration on the Principal Register, but that is "capable of distinguishing the applicant's goods or services," may be registered on the Supplemental Register.[170] Most commonly, a mark ends up on the Supplemental Register after the Examining Attorney has refused registration on the Principal Register on descriptiveness grounds.

[170] *In re Bush Bros. & Co.*, 884 F.2d 569, 570, 12 USPQ2d 1058, 1059 (Fed. Cir. 1989); Lanham Act § 23(a), 15 U.S.C. § 1091(a).

EXHIBIT B

Mailed:

THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE TTAB

February 17, 2005
GDH/gdh

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Jamil, *et al*

Serial No. 76032587

Dr. Basharat A. Jamil, *pro se*, for Jamil, *et al*.

Amy L. Alfieri, Trademark Examining Attorney, Law Office 109 (Howell, Managing Attorney).

Before Seeherman, Quinn and Hohein, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

Basharat A. Jamil, Irfan Jamil, Furhan A. Jamil and Usman A. Jamil, all of whom are United States citizens and who will hereinafter be collectively referred to in the singular as "applicant," have filed an application to register on the Principal Register the mark "MCHEALTH CLINIC" and design, as reproduced below,

for "healthcare services, namely, preventative, alternative, and

conventional healthcare."[1]

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to the services recited in the application, so resembles the following marks, which are registered by the same registrant for the various services indicated, as to be likely to cause confusion, mistake or deception:[2]

> (i) the mark "RONALD MCDONALD HOUSE," which is registered for a "newsletter dealing with a housing program for families with hospitalized children" and for "providing temporary lodging and emotional support for families with hospitalized children";[3]
>
> (ii) the mark "RONALD MCDONALD HOUSE" and design, as reproduced below,

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[1] Ser. No. 76032587, filed on April 24, 2000, which is based on an allegation of a bona fide intention to use the mark in commerce. The word "CLINIC" is disclaimed and, as further stated in the application:

> The mark consists of the wording, "MCHEALTH CLINIC" with a stylized representation of a stethoscope forming the letter M. The letter M and the term CLINIC will appear in red and the lowercase letter "C," the term "HEALTH," and the stethoscope design will appear in blue.

[2] While the final refusal was also based on Reg. No. 1,794,979, which issued on September 28, 1993 for the mark "MCFIT" for "newsletters related to health and fitness programs," such registration has now expired. Accordingly, no further consideration will be given thereto.

[3] Reg. No. 1,201,031, issued on July 13, 1982, which sets forth a date of first use of the mark anywhere and in commerce of, respectively, March 1979 for the goods and October 15, 1974 for the services; renewed. The word "HOUSE" is disclaimed.

which is registered for "providing temporary lodging and emotional support for families with hospitalized children";[4]

(iii) the mark "RONALD MCDONALD HOUSE" and design, as illustrated below,

which is registered for "providing temporary lodging and emotional support for families with hospitalized children";[5]

(iv) the mark "RONALD MCDONALD HOUSE FAMILY ROOM" and design, as depicted below,

which is registered for "providing hospitality rooms within hospitals for families with hospitalized children";[6] and

(v) the mark "RONALD MCDONALD HOUSE FAMILY ROOM," which is registered for "providing hospitality rooms within

---

[4] Reg. No. 1,337,332, issued on May 21, 1985, which sets forth a date of first use of the mark anywhere of January 1981 and a date of first use of the mark in commerce of February 1981; combined affidavit §§8 and 15. The word "HOUSE" is disclaimed.

[5] Reg. No. 1,927,933, issued on October 17, 1995, which sets forth a date of first of the mark anywhere and in commerce of February 1994; combined affidavit §§8 and 15. The word "HOUSE" is disclaimed.

[6] Reg. No. 2,381,540, issued on August 29, 2000, which sets forth a date of first of the mark anywhere and in commerce of March 11, 1992. The word "HOUSE" is disclaimed.

hospitals for families with hospitalized children."[7]

Applicant has appealed. Briefs have been filed, but an oral hearing was not held. We reverse the refusal to register.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence which are relevant to the factors bearing on the issue of whether there is a likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973). However, as indicated in Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), in any likelihood of confusion analysis, two key considerations are the similarity or dissimilarity in the goods and/or services at issue and the similarity or dissimilarity of the respective marks in their entireties.[8]

Turning first to the similarity or dissimilarity in the goods and services at issue, Examining Attorney properly notes in her brief that it is well established that an applicant's services and those goods and/or services of the registrant need not be identical or even competitive in nature in order to support a finding of likelihood of confusion. Instead, it is sufficient that the respective goods and/or services are related in some manner and/or that the circumstances surrounding their

---

[7] Reg. No. 2,377,753, issued on October 26, 1999, which sets forth a date of first of the mark anywhere and in commerce of March 11, 1992. The word "HOUSE" is disclaimed.

[8] The court, in particular, pointed out that: "The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks."

marketing are such that they would be likely to be encountered by the same persons under situations that would give rise, because of the marks employed in connection therewith, to the mistaken belief that they originate from or are in some way associated with the same producer or provider. See, e.g., Monsanto Co. v. Enviro-Chem Corp., 199 USPQ 590, 595-96 (TTAB 1978) and In re International Telephone & Telegraph Corp., 197 USPQ 910, 911 (TTAB 1978). The Examining Attorney, while making no mention of registrant's newsletter, maintains in view of the above that "applicant provides services that are related to the registrant's provision of healthcare services" because registrant "has created a physical presence within hospitals by providing hospitality rooms" and has furnished "assistance to the families of hospitalized children by providing temporary lodging and emotional support." Registrant's services, the Examining Attorney insists, are "sufficiently related to the health care field so that confusion between the applicant's mark and the registered marks would be likely."

Applicant, on the other hand, contends that healthcare consumers would not regard the provision by applicant of the services of "preventative, alternative, and conventional healthcare" as being commercially or otherwise "sufficiently related to" the provision by registrant of either such services as "temporary lodging and emotional support for families with hospitalized children" or "hospitality rooms within hospitals for families with hospitalized children." In particular, applicant argues in its reply brief that because "the scope of the

registered marks is 'housing' and '[hospitality rooms]'" while "the scope of the Applicants [sic] mark ... is medical care [offered] through health clinics, ... they are diametrically opposite" services which the general public is simply not likely, at least on this limited record, to consider as being related.

It is nonetheless obvious that, as identified, each of the respective services is directed in a broad sense to some aspect of the field of healthcare, with applicant providing "preventative, alternative, and conventional healthcare" through venues that could include medical clinics or even hospitals and registrant providing, for families of hospitalized children, temporary lodging and emotional support as well as hospitality rooms within hospitals. More importantly, however, the respective services would appear on their face to be complementary in that the families of children in need of clinical or hospital care not infrequently require temporary lodging and emotional support, as well as hospitality rooms within a hospital, in order to be able to stay with their children during the provision of medical treatment. Furthermore, such families would consequently find a newsletter dealing with a housing program for families with hospitalized children to be of interest concerning details of and developments in temporary lodging which is conveniently located to a hospital or medical clinic needed by their children. Accordingly, we agree with the Examining Attorney that the healthcare services which applicant intends to provide through its medical clinic or could provide in a hospital are "sufficiently related to" registrant's newsletter

dealing with a housing program for families with hospitalized children and its services of providing temporary lodging and emotional support, as well as in-hospital hospitality rooms, for families of child patients that, if offered under the same or substantially similar marks, confusion as to the origin or affiliation thereof would be likely to occur.

Turning, then, to consideration of the marks at issue herein, the Examining Attorney asserts in her brief that:

> The applicant's mark is ... likely to be confused with the [registrant's] marks[,] ... all of which contain the wording, RONALD MCDONALD. The owner of these marks, McDonald's Corporation, has established a famous family of marks containing the prefix "MC." The Trademark Trial and Appeal Board has recognized the fame of these marks as well as the establishment of a family of marks by McDonald's Corporation. In the case of *McDonald's Corp. v. McClain*, 37 USPQ2d 1274 (TTAB 1995), the ... Board held that the applicant's MCCLAIM mark for "legal services" so resembled the McDonald's family of marks that confusion was likely, as many of the latter marks combine the distinctive MC prefix with suggestive or descriptive terms, and the term CLAIM is descriptive or suggestive when used in connection with legal services. Additionally, in the case of *McDonald's Corp. v. McKinley*, 13 USPQ2d 1895 (TTAB 1989), the ... Board held that the applicant's MCTEDDY mark, when used in connection with teddy bears, was likely to cause confusion as to source in light of the well-known MC and MAC family of marks owned by McDonald's Corporation.
>
> As evidenced by the decisions of the ... Board, the McDonald's Corporation is widely known by consumers for its use of the prefix "MC" in conjunction with a wide variety of goods and services. Thus, the examining attorney maintains that consumers are likely to believe that MCHEALTH CLINIC is associated with the cited marks containing the wording ... RONALD MCDONALD HOUSE, and originates

> from the same source, namely, McDonald's Corporation.

Applicant, observing in its initial brief that the "driving force and controlling factor" behind the refusal to register "seem to be the 'fame'" of the cited marks "and the size of" the registrant, insists that "[t]he fame and the size of a corporation should have no role in the USPTO decision" concerning whether confusion is likely. However, as set forth in *du Pont*, supra, "[t]he fame of the prior mark (sales, advertising, length of use)" is a factor to be considered "[i]n testing for likelihood of confusion ... when [evidence thereof is] of record." In particular, the Examining Attorney correctly points out in her brief that:

> Famous marks enjoy a wide latitude of legal protection because they are more likely to be remembered and associated in the public mind then [sic] a weaker mark. *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1327, 54 USPQ2d 1894, 1987 [sic] (Fed. Cir. 2000) (Trademark Trial and Appeal Board erred in limiting the weight accorded to the fame of opposer's FRITO-LAY mark); *Kenner Parker Toys Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 352, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992) (Board erred in discounting the fame of opposer's mark PLAY-DOH). When present, the fame of the mark is "a dominant factor in the likelihood of confusion analysis for a famous mark, independent of the consideration of the relatedness of the goods [or services]." *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1327, 54 USPQ2d 1894, 1898.

Nevertheless, the rights conferred by a famous mark, in legal contemplation, are not the same as a right in gross, which would preclude the registration to another of the same or similar mark(s) for any goods and services. For instance, even though famous marks, as noted above, are entitled to a wide latitude of

legal protection, our principal reviewing court in Electronic Design & Sales Inc. v. Electronic Data Systems Corp., 954 F.2d 713, 21 USPQ2d 1388, 1392 (Fed. Cir. 1992), underscored in its reversal of the Board's finding of a likelihood of confusion that "the Board gave too much weight to certain *DuPont* factors, such as the strength of opposer's mark, and failed to give due weight to countervailing *DuPont* factors, such as the sophistication of purchasers." As set forth in *du Pont*, supra, "[t]he evidentiary elements are not listed ... in order of merit" inasmuch as "[e]ach may from case to case play a dominant role."

In this case, however, there simply is no evidence which is properly of record which currently establishes the fame of any marks owned by registrant, including an asserted family of "MC"-prefixed marks, much less any evidence showing that marks which include the name "RONALD MCDONALD" or the phrase "RONALD MCDONALD HOUSE" presently are famous. The Examining Attorney's reliance on certain factual finding by the Board in McDonald's Corp. v. McClain, supra, and McDonald's Corp. v. McKinley, supra, to support her contention regarding the existence at the present time of a "famous family of marks containing the prefix 'MC'" is misplaced for several reasons. Not only are such cases, which were respectively decided on May 23, 1995 and September 25, 1989, now over nine and 14 years old, but even if they issued on the same date as this opinion, the findings of fact and conclusions of law stated therein do not constitute *evidence* which is binding on either applicant or the Board in *this* proceeding. See, e.g., Faultless Starch Co. v. Sales Producers Associates, Inc., 530

F.2d 1400, 189 USPQ 141, 142-43 (CCPA 1976) [because ultimate conclusion regarding likelihood of confusion is necessarily drawn from all probative facts in evidence in each individual case, such conclusion, as distinguished from general rules of law or interpretation, cannot be controlled by earlier conclusions reached in another case]; and National Dairy Products Corp. v. Parman-Kendall Corp., 122 USPQ 332, 333 (TTAB 1959) ["facts found by a court and the conclusions drawn therefrom in a case involving another party are not binding on this applicant or controlling on this tribunal"].[9]

Because there is no proof that the cited marks are part of a famous family of registrant's marks, we must decide the issue of likelihood of confusion on the basis of each of the cited marks individually. When such marks and applicant's mark are considered in their entireties, we find that applicant's "MCHEALTH CLINIC" and design mark is substantially different in sound, appearance, connotation and commercial impression from registrant's "RONALD MCDONALD HOUSE" and "RONALD MCDONALD HOUSE

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[9] This is not to say, of course, that the Board is totally unaware of registrant and its fast-food products and restaurant services. Rather, like applicant, this panel is certainly familiar with such. Applicant, we note, has essentially admitted that registrant is very well known if not famous for its fast-food operations inasmuch as applicant, in its reply brief, makes the statement that "McDonald's Corporation should rest assured that nobody will show up in a McHealth Clinic to buy a bigmac and[,] vice versa, nobody will go to McDonald's Restaurant to have a blood test!" In the context of this appeal, however, one of the issues before us is whether there is evidence which proves that marks which contain the "MC"-prefix, or which consist of or include the name "RONALD MCDONALD" or the phrase "RONALD MCDONALD HOUSE," form a famous family of marks for such services as providing temporary lodging and emotional support, as well as hospitality rooms within hospitals, for families with hospitalized children and such ancillary goods as newsletters dealing with a housing program for families with hospitalized children.

FAMILY ROOM" marks. Applicant, in this regard, reiterates in its reply brief the argument which it made in its initial brief, emphasizing in particular that:[10]

> A comparison of the designs of [registrant's] ... marks with the Applicants [sic] mark indicates that there is no similarity between the designs due to the fact that the heart-shaped stethoscope M in the design of the Applicants [sic] mark is clearly distinct from the M used in the registered designs. The color scheme of the Applicant['s] design, [with] M and Clinic [in] red and rest [in] blue on white base (red, white and blue), will most likely leave the impression and image of M-Clinic in the eyes of the viewers, thus leaving no confusion between the sound, connotation and commercial impression of the Applicants [sic] design and the registered designs.

On the other hand, the Examining Attorney in her brief "maintains that it is the prefix, "MC," not the design element, which will be remembered most by consumers," noting that:

> When a mark consists of a word portion and a design portion, the word portion is more likely to be impressed upon a purchaser's memory and to be used in calling for the goods or services. Therefore, the word portion is controlling in determining likelihood of confusion. In re Dakin's Miniatures Inc., 59 USPQ2d 1593, 1596 (TTAB

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[10] Applicant also repeats in its reply brief a contention which it raised throughout the prosecution of its application. Specifically, referring to an article which reports that, on or about November 27, 2001, "Judge David Neuberger" of "London's High Court ... ruled that a Chinese restaurant owner can use the name McChina for his chain of fast-food outlets despite protests from hamburger giant McDonald's," applicant urges that, in light of such ruling, it is clearly entitled to a finding of no likelihood of confusion because not only is its mark different from registrant's marks, but its services are even more different from registrant's goods and services than the fast-food restaurant services at issue in the English court's ruling. The fact that the Examining Attorney, as applicant further points out, "has failed to address or refute the latest Court decision by Judge Neuberger" is of no moment, however, inasmuch as such a decision from a foreign court, interpreting a different statutory framework, is irrelevant in this appeal.

> 1999); In re Appetito Provisions Co. [Inc.], 3 USPQ2d 1553 (TTAB 1987); Amoco Oil Co. v. Amerco, Inc., 192 USPQ 729 (TTAB 1976); TMEP §1207.01(c)(ii).

It is plain, however, that the word portions of the respective marks are comprised of, and distinguished by, more than just the prefix "MC." Clearly, in terms of overall sound, appearance, connotation and commercial impression, the word portion of applicant's "MCHEALTH CLINIC" and design mark is substantially different from the word portions of registrant's "RONALD MCDONALD HOUSE" marks and its "RONALD MCDONALD HOUSE FAMILY ROOM" marks. Even allowing for the descriptiveness, as evidenced by the disclaimers thereof, of the words "CLINIC" and "HOUSE," it obviously remains the case that the suggestive term "MCHEALTH" in applicant's mark bears essentially no resemblance to the name "RONALD MCDONALD" in registrant's marks.[11] We therefore agree with applicant that, on this record, contemporaneous use of the marks at issue is not likely to cause confusion as to source or sponsorship, notwithstanding the complementary nature of the respective goods and services.[12]

Decision: The refusal under Section 2(d) is reversed.

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[11] It is pointed out that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, our principal reviewing court has indicated that "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided [that] the ultimate conclusion rests on consideration of the marks in their entireties." In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). For instance, according to the court, "that a particular feature is descriptive ... with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark ...." Id.

[12] We hasten to add, however, that a different result might pertain in a proceeding (such as an opposition) in which evidence that registrant possesses a famous family of "MC"-prefixed marks is made of record.