

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: March 4, 2010

Opposition No. 91192099

McDonald's Corporation

v.

McSweet, LLC

Linda Skoro, Interlocutory Attorney

This case now comes up on opposer's motion to amend its notice of opposition to clarify opposer's grounds of opposition and delete ten of its twenty previously claimed registrations. Applicant has opposed the motion contending it is untimely and will prejudice applicant.

Motion to Amend

As grounds for its motion opposer states that it seeks to clarify that the grounds for the opposition of a likelihood of confusion are based on opposer's family of marks argument, that part of applicant's mark is descriptive and to remove reference to ten of its pleaded registrations, six of which are the subject of applicant's counterclaims. Applicant objects arguing that opposer knew of the abandonment of its marks which are the subject of the counterclaims, and subsequent voluntary surrender, at the time of filing its notice of opposition and therefore the

motion is untimely and prejudicial to applicant; and that adding a claim that applicant's mark is generic creates prejudice and is futile.¹

Opposer's motion to amend its notice of opposition is granted. Rule 15(a) of the Federal Rules of Civil Procedure encourages courts to look favorably on motions to amend when justice so requires. In deciding such a motion, the Board must consider any undue prejudice. By this motion opposer seeks to add specific information to its grounds of opposition. It is not "adding" any new claims based on descriptiveness, as its original paragraph nine in the notice was directed to a claim of descriptiveness as to part of applicant's mark. By clarifying the grounds that opposer claims against applicant's mark as to the basis for its family of marks claim and its argument that "sweet" may be descriptive is not the "addition" of claims for opposition purposes. Applicant states that the motion was filed too late to avoid prejudice to applicant. However, the amended pleading will better provide for a full adjudication on the merits. Further, applicant will not be prejudiced in that the discovery period has just opened and because the time periods will be reset to give both sides a full opportunity to address any new issues.

¹ Applicant also argues that opposer's reference to additional cases in its notice is not a substitute for evidence. Opposer and the Board agree with this statement.

Accordingly, the amended notice of opposition is accepted and applicant has **thirty** days from the date of this order to file an amended answer and to amend its counterclaim.

Motion for Judgment

On December 9, 2009 opposer filed a voluntary surrender of six of its pleaded registrations.² In response to this, applicant filed, on December 29, 2009, a motion for judgment in its favor on its counterclaim as to these six registrations. Opposer has agreed that its surrender of these registrations without applicant's consent should result in judgment being entered against it as to these six registrations for abandonment.

Trademark Rule 2.134(a) provides that if the respondent in a cancellation proceeding (herein set up as a counterclaim) applies to cancel its involved registration(s) under Section 7(e) without the written consent of every adverse party to the proceeding, judgment shall be entered against respondent.

In view thereof, and because applicant/counter-petitioner's written consent to the voluntary surrender is not of record, judgment is hereby entered against opposer/counter-respondent, the counterclaims for petitions to cancel/cpunterclaims are hereby granted, and Registration

² Reg. No. 118362 for McPIZZA; Reg. No. 1541,797 for McCOLA; Reg. No. 1552143 for McCHILI; Reg. No. 1566184 for McCOOKIE; Reg. No. 1943180 for McCOFFEE and Reg. No. 2289608 for McVEGGIE BURGER.

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No. 118362 for McPIZZA; Reg. No. 1541,797 for McCOLA; Reg. No. 1552143 for McCHILI; Reg. No. 1566184 for McCOOKIE; Reg. No. 1943180 for McCOFFEE and Reg. No. 2289608 for McVEGGIE BURGER will be cancelled in due course.

Dates

Because the motion to amend the notice of opposition has been granted, and because this matter has been suspended, dates are hereby reset. Trial dates, including the period for discovery, are rescheduled as follows:

Answer to Counterclaim Due	April 2, 2010
Deadline for Discovery Conference	May 2, 2010
Discovery Opens	May 2, 2010
Initial Disclosures Due	June 1, 2010
Expert Disclosures Due	September 29, 2010
Discovery Closes	October 29, 2010
Plaintiff's Pretrial Disclosures	December 13, 2010
30-day testimony period for plaintiff's testimony to close	January 27, 2011
Defendant/Counterclaim Plaintiff's Pretrial Disclosures	February 11, 2011
30-day testimony period for defendant and plaintiff in the counterclaim to close	March 28, 2011
Counterclaim Defendant's and Plaintiff's Rebuttal Disclosures Due	April 12, 2011
30-day testimony period for defendant in the counterclaim and rebuttal testimony for plaintiff to close	May 27, 2011
Counterclaim Plaintiff's Rebuttal Disclosures Due	June 11, 2011
15-day rebuttal period for plaintiff in the counterclaim to close	July 11, 2011
Brief for plaintiff due	September 9, 2011
Brief for defendant and plaintiff in the counterclaim due	October 9, 2011

Brief for defendant in the
counterclaim and reply brief, if any,
for plaintiff due

November 8, 2011

Reply brief, if any, for plaintiff in
the counterclaim due

November 23, 2011

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

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