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

Proceeding	91192099
Party	Plaintiff McDonald's Corporation
Correspondence Address	LAWRENCE E. JAMES, JR. 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
Submission	Other Motions/Papers
Filer's Name	John A. Cullis
Filer's e-mail	rbrowne@ngelaw.com, jcullis@ngelaw.com, mturner@ngelaw.com, mbenson@ngelaw.com
Signature	/John A. Cullis/
Date	12/01/2010
Attachments	Opposer's Motion to Withdraw Response to RFA 105.pdf (13 pages)(376202 bytes)

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

McDONALD'S CORPORATION,	)		
	)	Opposition No. 91192099	
Opposer,	)		
	)		
v.	)	Mark:	McSWEET
	)	Application S/N:	77/722,272
McSWEET, LLC,	)	Filed:	April 24, 2009
	)	Published:	September 1, 2009
Applicant.	)		

OPPOSER'S MOTION TO WITHDRAW ITS RESPONSE TO
APPLICANT'S REQUEST FOR ADMISSION NO. 105

Pursuant to Fed. R. Civ. P. 36(b), McDonald's Corporation ("Opposer"), hereby moves to withdraw its response to Request for Admission No. 105 served upon Opposer by McSweet, LLC ("Applicant") in the above-captioned proceeding. Opposer is obligated to so move pursuant to its obligations to supplement discovery responses under Fed. R. Civ. P. 26(e)(2). In support of its Motion, Opposer states as follows:

1. Applicant served one hundred and five separate Requests for Admissions on Opposer in August, 2010. Request No. 105 required a response to the following:

> Admit that Opposer has not sold or distributed goods to grocery stores for the purpose of making the goods available to grocery store customers in either the meat, fresh produce, dairy, or baked goods department, or along the shelf space reserved for canned, packaged and frozen goods, or among the various non-food items such as household cleaners, alcohol, pharmacy products and pet supplies.

2. Believing the same to be accurate at the time, Opposer stated the following for its response:

> Subject to and without waiving any of its general objections, McDonald's admits that it does not presently sell or distribute goods to grocery stores for the purpose of making the goods available to grocery store customers in either the meat, fresh

produce, dairy, or baked goods department, or along the shelf space reserved for canned, packaged and frozen goods, or among the various non-food items such as household cleaners, alcohol, pharmacy products and pet supplies.

3. On November 9, 2010, Opposer's counsel identified that Opposer's "Arch Card" stored value cards bearing several of Opposer's marks and trade dress are available for retail purchase by consumers at a QFC Grocery Store located at 9999 Holman Road NW, Seattle, WA 98117. (Exhibit A, Turner Decl. ¶¶ 2-8.) These cards may be redeemed at Opposer's restaurants in exchange for various food or drink products. (*Id.*) Opposer later confirmed the availability of Arch Cards at a second QFC Grocery Store located at 2500 SW Barton St., Seattle, WA 98106. (*Id.*, ¶9.) The Arch Cards were offered through display arrangements located throughout the store, including aisle end caps, check-out displays, and intra-aisle displays. (*Id.*)

4. Based on this discovery, Opposer is conducting further investigation into the availability of its products through grocery stores. Though not complete, Opposer's investigation indicates that Arch Cards are available through many other grocery stores across the country.

5. Opposer met and conferred with Applicant regarding Opposer's obligation to withdraw its admission of Request for Admission No. 105 on November 30, 2010, however Applicant refused to consent to Opposer's motion and refused to indicate whether or not it would oppose this motion. Applicant's purported reason for refusing its consent was that Applicant did not have knowledge whether Opposer's Arch Cards are sold in grocery stores. However, when Opposer's counsel offered to provide evidence of such sales, and asked what, if any, evidence would be necessary for Applicant to consent to the motion, Applicant's counsel refused to answer stating that Applicant would not provide its consent regardless of whether Opposer could

provide evidence of sales of Arch Cards in grocery stores. Accordingly, Opposer files this motion without Applicant's consent.

6. The Board will grant a motion to withdraw an amendment if it "facilitate[s] the development of the case in reaching the truth" and "will not prejudice the party that has obtained the admissions." *Giersch v. Scripps Networks Inc.*, 85 USPQ2d 1306, 1308 (TTAB 2007)(quoting *Farr Man & Co., Inc. v. M/V Rozita*, 903 F.2d 871, 876 (1st Cir. 1990) and *McClanahan v. Aetna Life Ins. Co.*, 144 F.R.D. 316, 320 (W.D. Va. 1992)). In determining prejudice, the Board does "not simply [ask whether] the party who initially obtained the admission will now have to convince the fact finder of its truth, but rather [it considers] the special difficulties a party may face caused by the sudden need to obtain evidence upon withdrawal or amendment of admission." *Id.* (quoting *Kerry Steel, Inc., v. Paragon Indus., Inc.*, 106 F.3d 147 (6th Cir. 1997).

7. In this case, through its investigation of unrelated claims by Applicant, Opposer recognized that the basis of its response to Request for Admission No. 105, *i.e.*, that its goods are not for sale in grocery stores, was incorrect. The availability of Opposer's goods through a grocery store—and especially a grocery store that offers Applicant's McSweet-branded products—is a fact central to the issue of confusion before the Board in this Opposition. For example, this fact shows that Opposer's and Applicant's goods are sold in the same channels of trade, which is a critical consideration in determining whether a likelihood of confusion exists. *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361 (CCPA, 1973). Thus, reaching the truth as to the likelihood of confusion is furthered by allowing Opposer to withdraw its admission of a statement that turns out to be false.

8. In addition, Applicant will not be prejudiced by Opposer's withdrawal of its admission, as the term "prejudice" is intended in this context. The test for prejudice is not simply whether removal of a withdrawal will put a party in a position where it has to prove the matter at issue, but whether proving that matter will be complicated by the timing of the withdrawal. *See, e.g., Raiser v. Utah County*, 409 F.3d 1243, 1247 (10th Cir. 2005)("The prejudice contemplated by Rule 36(b) relates to the difficulty a party may face in proving its case, *e.g.*, caused by the unavailability of key witnesses, because of the sudden need to obtain evidence with respect to the questions previously deemed admitted."). Here, the timing of Opposer's withdrawal will have no prejudicial effect whatsoever. The admission in question was propounded less than two months ago, and Applicant still has nearly a month to conduct further discovery. Moreover, further discovery on the issue in question, namely, whether Opposer's goods are sold through grocery stores, seems unnecessary in light of the attached declaration and accompanying exhibits which conclusively prove the point at issue.

9. Opposer has attached hereto as Exhibit B a copy of Opposer's Proposed Supplemental Response to Request for Admission No. 105.

WHEREFORE, Opposer respectfully requests that the Board grant its Motion to Withdraw its Response to Applicant's Request for Admission No. 105, and to allow Applicant to supplement its Proposed Supplemental Response in place of the withdrawn admission.

Respectfully submitted,

McDONALD'S CORPORATION

Date: December 1, 2010

By: s/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, an attorney, state that I served a copy of the foregoing ***Opposer's Motion to Withdraw its Response to Applicant's Request for Admission No. 105***, 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 1st day of December, 2010.

s/Mike R. Turner/

NGEDOCS: 1751500.3

Exhibit A

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

McDONALD'S CORPORATION,	)	
	)	Opposition No. 91192099
Opposer,	)	
	)	
v.	)	Mark: McSWEET
	)	Application S/N: 77/722,272
McSWEET, LLC,	)	Filed: April 24, 2009
	)	Published: September 1, 2009
Applicant.	)	

DECLARATION OF MIKE R. TURNER IN SUPPORT OF OPPOSER'S MOTION TO WITHDRAW ITS RESPONSE TO APPLICANT'S REQUEST FOR ADMISSION NO. 105

I, Mike R. Turner, an attorney, state and depose on oath that, if called to testify as a witness in this matter, I could competently testify as follows:

1. I am licensed to practice law in the State of Illinois and before the United States District Court for the Northern District of Illinois. I am an associate of the law firm Neal, Gerber & Eisenberg LLP, and serve as counsel to Defendant in the above-captioned matter.

2. On November 9, 2010, I visited several retail establishments identified by Applicant as locations where Applicant's products are sold.

3. One of the establishments I visited was a QFC Grocery Store located at 9999 Holman Road NW, Seattle, WA 98117 ("the Holman Road QFC"). I noted two separate locations within the Holman Road QFC where stored-value cards bearing Opposer's marks were offered for sale. These cards are commonly referred to as "Arch Cards," and are distributed exclusively under license by and for Opposer. Arch Cards may be redeemed at Opposer's restaurants in exchange for various food or drink products.

4. Attached as Exhibit A is a true and accurate copy of a first photo taken by me of Arch Cards as displayed at the Holman Road QFC.

5. Attached as Exhibit B is a true and accurate copy of a second photo taken by me of Arch Cards as displayed at the Holman Road QFC.

6. The Holman Road QFC also sold McSweet Pickled Garlic, McSweet Pickled Cocktail Onions, and McSweet Gourmet Olive Bliss.

7. Attached as Exhibit C is a true and accurate copy of a third photo taken by me of a display of McSweet-branded products as they were found at the Holman Road QFC.

8. Attached as Exhibit D is a true and accurate copy of a receipt from the Holman Road QFC showing the purchase of one container of McSweet Pickled Garlic and one of Opposer's Arch Cards valued at $15.

9. I later confirmed the availability of Opposer's Arch Cards at a second QFC Grocery Store located at 2500 SW Barton St., Seattle, WA 98106 ("the Barton Street QFC"). The Arch Cards were offered for sale at the Barton Street QFC through display arrangements and in store locations completely different than at the Holman Road QFC, such as on aisle end caps and within aisles instead of on rotating displays.

I declare under penalty of perjury that the foregoing is true and correct.

Executed this 1st day of December, 2010

By:_____
MIKE R. TURNER
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

Exhibit B

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

McDONALD'S CORPORATION,	)		
	)	Opposition No. 91192099	
Opposer,	)		
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OPPOSER'S FIRST SUPPLEMENTAL OBJECTIONS AND RESPONSES TO APPLICANT'S FIRST SET OF REQUESTS FOR ADMISSION TO OPPOSER

McDonald's Corporation ("Opposer"), by and through its attorneys, and pursuant to Rule 2.120 of the Trademark Rules of Practice and Rules 26 and 36 of the Federal Rules of Civil Procedure, hereby provides its First Supplemental Responses to Applicant's First Set of Requests for Admission.

BASES UPON WHICH OBJECTIONS AND RESPONSES ARE MADE

Opposer's ongoing investigation of the underlying facts relating to this case, discovery, and preparation for trial is underway. Therefore, the responses contained herein are based only upon such information and documents that are presently available and specifically known to Opposer. Further discovery, independent investigation, legal research and analysis may supply additional facts, add meaning to known facts, and establish entirely new factual conclusions and legal contentions, which may require additions to, changes in, and variations from these responses. Opposer reserves the right to withdraw or amend its responses to reflect discovered information or documents which it may later recall, locate, or discover, or as additional facts are ascertained, analyses are completed and contentions are made.

Opposer expressly incorporates each and every one of its General Objections set forth in its Objections and Responses to Applicant's First Set of Requests for Admission to Opposer.

SUPPLEMENTAL RESPONSES

REQUEST FOR ADMISSION NO. 105. Admit that Opposer has not sold or distributed goods to grocery stores for the purpose of making the goods available to grocery store customers in either the meat, fresh produce, dairy, or baked goods department, or along the shelf space reserved for canned, packaged and frozen goods, or among the various non-food items such as household cleaners, alcohol, pharmacy products and pet supplies.

RESPONSE: Subject to and without waiving any of its general objections, McDonald's admits that it does not presently sell or distribute goods to grocery stores for the purpose of making the goods available to grocery store customers in either the meat, fresh produce, dairy, or baked goods department, or along the shelf space reserved for canned, packaged and frozen goods, or among the various non-food items such as household cleaners, alcohol, pharmacy products and pet supplies.

SUPPLEMENTAL RESPONSE: In addition to its general objections, which are incorporated herein by reference, Opposer specifically objects to this Request on the ground that the identified locations within grocery stores are vague and incomprehensible, grocery store arrangements vary, and there are no clear definitions of where certain "departments" or "shelf space" begin or end. Subject to its specific and general objections, and as Opposer understands this Request, the Request is denied.

Respectfully submitted,

McDONALD'S CORPORATION

Date: December 1, 2010

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

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

CERTIFICATE OF SERVICE

I, Mike R. Turner, an attorney, state that I served a copy of the foregoing ***Opposer's First Supplemental Objections and Responses to Applicant's First Set of Requests for Admission to Opposer,*** 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 1st day of December, 2010.

s/Mike R. Turner/

NGEDOCS: 1751503.1