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

McDONALD'S CORPORATION,)	
)	Opposition No. 91178758
Opposer,)	
)	
v.)	Mark: McSWEET
)	Application S/N: 78/947,247
McSWEET, LLC,)	Filed: August 8, 2006
)	Published: April 10, 2007
Applicant.)	

and,

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 CONSOLIDATE OPPOSITION PROCEEDINGS**

McDonald's Corporation ("Opposer") hereby moves the Trademark Trial and Appeal Board (the "Board") pursuant to TBMP §511 and Fed. R. Civ. P. 42(a) for an order consolidating the above-referenced Opposition proceedings (collectively, "the Proceedings"). Because the Proceedings involve the same parties, the same marks, and nearly identical legal and factual issues, consolidation will result in considerable savings of time, effort and expense. Accordingly, in the interests of convenience, efficiency, and judicial economy, Opposer requests that the Board consolidate the Proceedings.

I. Background

On August 6, 2007, Opposer filed a Notice of Opposition to oppose registration of U.S. Application Serial No. 78/947,247 by McSweet, LLC (“Applicant”) of the standard character mark McSWEET for use in connection with processed vegetables in Class 29 (“the First Application”). This opposition is referred to herein as “McSweet I”. On February 29, 2008, Applicant moved to amend the First Application to limit its identification of goods to “Pickled gourmet vegetables, namely, pickled cocktail onions, pickled garlic, ‘Gourmet Olive Bliss’ (a pickled, marinated olive medley), ‘Dilly Beans’ (pickled green beans), and ‘Giardiniera’ (a pickled celery, carrot, red pepper, garlic, green bean, and cucumber mix). On March 26, 2009, Applicant again moved to amend its identification of goods to remove dilly beans and giardiniera.

On April 10, 2009, Opposer moved for summary judgment in McSweet I. On April 26, 2009, Applicant filed a second application, U.S. Application Serial No. 77/722,272, for the same standard character McSWEET mark, but for use with pickled asparagus in Class 29 (“the Second Application”). Thus, Opposer was forced to file a second Notice of Opposition to preserve the same rights it sought to protect when it filed its initial Notice of Opposition in McSweet I. This second opposition is referred to herein as “McSweet II.”

Upon filing its Notice of Opposition in McSweet II, Opposer approached Applicant suggesting that the Proceedings be consolidated since both Proceedings sought registration of the same mark for use with substantially similar goods. When Applicant refused to grant its consent, Opposer considered filing a motion to consolidate the Proceedings over Applicant’s refusal. However, at the time, McSweet I was still suspended pending the outcome of Opposer’s motion for summary judgment, and Opposer did not want to file a pleading that was not related to the

then-pending dispositive motion.¹ On December 7, 2010, the Board issued its Order on summary judgment, thus lifting the suspension in *McSweet I*. As a result of the Order, the claims at issue in the Proceedings are now substantially identical, making consolidation highly appropriate.² Thus, Opposer now timely brings this Motion to Consolidate.

II. Argument

Where cases involve common questions of law or fact, the Board may order that the cases be consolidated. *See* TBMP § 511; Fed. R. Civ. P. 42(a); *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154, 1156 (TTAB 1991)(consolidation of opposition and cancellation *sua sponte* where parties were identical and issues were substantially identical). In considering whether to consolidate, the Board will weigh the savings in time, effort, and expense which may be gained against any prejudice or inconvenience that may be caused. *Id.*; *see S. Indus. Inc. v. Lamb-Weston Inc.*, 45 USPQ2d 1293, 1297 (TTAB 1997)(consolidation ordered where pleadings were nearly identical). Where two cases “involve [a similar] mark and contain virtually identical pleadings, consolidation will avoid duplication of effort concerning the factual issues in common and will thereby avoid unnecessary costs and delays.” *S. Indus.*, 45 USPQ2d at 1297.

A. The Applications at Issue are For the Same Mark.

The Board has consistently ordered consolidation when multiple proceedings between the same parties involve essentially the same mark. *See, e.g., Dating DNA LLC v. Imagini Holdings*

¹ Pursuant to 37 C.F.R. 2.127(d), ‘no party should file any paper which is not germane’ to a pending dispositive motion. The types of papers listed as “germane” would not seem to include a motion to consolidate. *See* TBMP §528.03.

² Technically, Applicant has a counterclaim to cancel one of Opposer’s ten asserted registrations in *McSweet II* that Applicant has not plead in *McSweet I*. However, this is an inconsequential difference, especially given that Opposer has asserted the registration at issue in *McSweet I* as well. Should the Board grant consolidation, Opposer will not object to Applicant’s counterclaim based on the fact that it was only plead in one of the two Proceedings.

Ltd., 94 USPQ2d 1889, 1893 (TTAB 2010)(consolidating oppositions to VISUALDNA and VISUALDNA SHOPS); *G-Mar Devel. Corp. v. Tully's Coffee Corp.*, 46 USPQ2d 1797 (TTAB 1998)(consolidating opposition to TULLY'S in Class 30 with TULLY'S in Class 42); *Plus Prods. v. Med. Modalities Assoc., Inc.*, 211 USPQ 1199, 1201 (TTAB 1981)(granting opposer's motion to consolidate oppositions to ZN-PLUS for a zinc supplement, MN-PLUS for a manganese protein complex, and CA-PLUS for a calcium protein complex). In this case, Applicant seeks registration of the same McSWEET mark in standard character form in both the Proceedings. McSweet I addresses Applicant's attempt to register the mark in Class 29 for use with three types of processed vegetables. McSweet II addresses Applicant's attempt to register the mark in Class 29 for use with a fourth type of processed vegetable. The only distinction between the First Application and the Second Application is the specific processed vegetables at issue.

B. The Proceedings Involve Common Issues of Law and Fact.

Even where marks vary more significantly, consolidation can still be proper where the questions of law and fact are the same. *See, e.g., Ritchie v. Simpson*, 41 USPQ2d 1859 (TTAB 1996)(“Inasmuch as the notices of opposition are virtually identical and present common questions of law and fact, despite the variations in the marks and goods involved, the Board has found it appropriate to consolidate the cases.”). The grounds for Opposer's claims in McSweet I and McSweet II are identical, namely (1) that Applicant's registration of the mark McSWEET for processed vegetables will cause confusion with Opposer's use of its world-renowned “Mc” family of marks; (2) that such registration will dilute Opposer's “Mc” family of marks; and (3) that Applicant is a mere licensee of the McSWEET mark rather than the owner, and, thus, both the First and Second Applications are void *ab initio*. Opposer is relying on the strength of its

“Mc” family of marks, and has asserted the same ten federal registrations in both Proceedings. For convenience, Opposer has included copies of the operative Notices of Opposition for both of the Proceedings as Exhibits A & B to this Motion.³

Because both of the Proceedings involve the same legal questions and the same mark for the same type of goods, they necessarily will turn on the same set of facts. Evidence relevant to Opposer’s §2(d) claim in McSweet I is the very same evidence that is relevant to its §2(d) claim in McSweet II. For example, if evidence proves that consumers are likely to confuse Applicant’s offering of pickled onions under the standard character mark “McSWEET” with Opposer, the same evidence would be relevant to whether those consumers are likely to be confused by Applicant’s offering of pickled asparagus under the same mark. As to dilution, it is the use of the “Mc” formative combined with a common noun or adjective that serves to dilute the goodwill that McDonald’s has cultivated in its “Mc” family of marks. Whether such use is with onions or asparagus is of little consequence in the dilution analysis. Finally, Opposer’s lack of ownership claim in both Proceedings rises from Applicant’s inability to seek trademark registrations as a mere licensee of the McSWEET mark. Thus, evidence supporting Opposer’s claim that Applicant is merely a licensee of the mark is equally relevant to both of the Proceedings.

C. Consolidation Will Prevent Duplication of Efforts and Benefit All Involved.

The purpose behind consolidation is to avoid the needless waste of time, effort and expense. *See* TBMP §511. Because nearly all of the discovery relevant to McSweet I is also relevant to McSweet II, and vice versa, considerable time, effort and expense could be saved

³ For clarity, Opposer has taken the liberty of redacting the paragraphs of the operative Notice for Opposition No. 91/178,758 that have been stricken by the Board pursuant to the summary judgment ruling in McSweet I.

through consolidation by avoiding the need to produce documents and materials in both Proceedings. Similarly, the vast majority of written discovery responses and deposition transcripts could be equally applied by both Applicant and Opposer to both Proceedings. Avoiding the need to duplicate production and discovery efforts will result in considerable savings for both sides. Furthermore, the single protective agreement already in place for McSweet I could apply to the consolidated proceeding, thus ending the parties' ongoing dispute over a protective order in McSweet II. Finally, consolidation will prevent the scheduling complications and overlap likely to result as the two Proceedings enter the trial phase. Notably, all of these identified efficiencies will equally benefit both Opposer and Applicant.

Consolidation is particularly appropriate at this point, while discovery is still ongoing in both of the Proceedings, and now that the trial schedules are only separated by a few months. Indeed, ordering consolidation now, just after the Board has eliminated the only claim that was unique between the Proceedings, seems like a most appropriate option.⁴ The Board recently ordered consolidation in a similar scenario wherein an applicant filed a second application for essentially the same mark already being opposed in a first opposition. *See Dating DNA*, 94 USPQ2d at 1893 (TTAB 2010)(consolidating newly filed opposition with one in which discovery had already closed). In *Dating DNA*, the second application sought broadened rights across four additional classes. (*Compare* TARR Report for U.S. App. 77/258,529 with TARR

⁴ Opposer recognizes that Applicant must still answer Opposer's Second Amended Notice of Opposition in McSweet I, and that the Board generally does not consider a motion to consolidate "until an answer has been filed (i.e., until issue has been joined)." TBMP §511. However, the "issue" of Applicant's right to the registrations it seeks was "joined" when Applicant filed its first answer in McSweet I over three years ago. Applicant's answer (which is unlikely to shed any additional light on the Proceedings) is not due to be filed until after fact discovery closes in McSweet II. By waiting until Applicant's answer is filed to move to consolidate, Opposer will only draw an accusation from Applicant that Opposer is attempting to impermissibly extend discovery when that is simply not the case. Under the specific circumstances of these Proceedings, Opposer's Motion to Consolidate is ripe.

Report for U.S. App. 77/715,869.) Nevertheless, the Board granted the opposer's motion for consolidation because "each proceeding involve[d] identical parties, similar marks and related or identical issues." *Dating DNA*, 94 USPQ2d at 1893. If anything, the conditions in the present case more favorably support consolidation than in *Dating DNA*. Accordingly, the Board should grant Opposer's Motion to Consolidate.

III. Conclusion

WHEREFORE, for the foregoing reasons, Opposer respectfully requests that the Board enter an Order pursuant to TBMP §511 and Fed. R. Civ. P. 42(a) consolidating Opposition No. 91/178,758 with Opposition No. 91/192,099, establish a trial schedule for the consolidated Proceedings as the Board sees fit, and granting such other relief as the Board deems appropriate.

Respectfully submitted,

McDONALD'S CORPORATION

Date: December 15, 2010

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CERTIFICATE OF SERVICE

I, Mike R. Turner, state that I served a copy of the foregoing *Opposer's Motion to Consolidate Opposition Proceedings* via first class U.S. mail, postage pre-paid, upon:

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on this 15th day of December, 2010.

/Mike R. Turner /
Mike. R. Turner

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