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Filing date: **12/16/2010**

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

|                        |  |
|------------------------|--|
| Proceeding             | 91192099   |
| Party                  | Plaintiff<br>McDonald's Corporation  |
| Correspondence Address | LAWRENCE E. JAMES, JR.<br>NEAL, GERBER & EISENBERG LLP<br>2 NORTH LaSALLE STREET, SUITE 1700<br>CHICAGO, IL 60602<br>UNITED STATES<br>apeterson@ngelaw.com, jcullis@ngelaw.com, mturner@ngelaw.com, rbrowne@ngelaw.com |
| Submission             | Motion to Consolidate  |
| Filer's Name           | John A. Cullis   |
| Filer's e-mail         | rbrowne@ngelaw.com, jcullis@ngelaw.com, ljames@ngelaw.com, mturner@ngelaw.com, mbenson@ngelaw.com  |
| Signature              | /John A. Cullis/   |
| Date                   | 12/16/2010   |
| Attachments            | Exhibits to Motion Consolidate.pdf ( 19 pages )(539642 bytes )   |

**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.              | ) |  |

**EXHIBITS REFERENCED IN OPPOSER'S MOTION  
TO CONSOLIDATE OPPOSITION PROCEEDINGS**

Respectfully submitted,

McDONALD'S CORPORATION

Date: December 16, 2010

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

Robert E. Browne  
John A. Cullis  
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# Exhibit A

**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.              | ) |                             |

**SECOND AMENDED NOTICE OF OPPOSITION**

Opposer, McDONALD'S CORPORATION, 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. 78/947,247, filed by Applicant McSweet LLC's predecessor-in-interest, JMC Sales, which was a sole proprietorship owned by Mr. James McCaslin, located at 20322 SE 240<sup>th</sup> Street, Maple Valley, Washington, 98038 (the "Subject Application"), and hereby opposes the same and requests that registration to Applicant be refused.

As grounds for its opposition, Opposer alleges that:

1. Applicant seeks to register a mark which consists of the term "McSWEET" for use in connection with "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" in International Class 29 (hereinafter, the "McSWEET" Mark).

2. Opposer has obtained the necessary extension of time in which to file this Notice of Opposition.

3. 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.

4. 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 |

| <u>MARK NAME</u> | <u>REG. NO.</u> | <u>REG. DATE</u> | <u>GOODS/SERVICES</u>   |
|------------------|-----------------|------------------|---|
| 3. McDOUBLE      | 1,266,500       | 02/07/1984       | A sandwich for consumption on or off premises   |
| 4. McRIB         | 1,315,979       | 01/22/1985       | A sandwich for consumption on or off the premises   |
| 5. McMUFFIN      | 1,369,360       | 11/05/1985       | Breakfast food combination sandwich for consumption on or off the premises                                |
| 6. McNUGGETS     | 1,450,104       | 07/28/1987       | Restaurant services   |
| 7. McFLURRY      | 2,805,109       | 01/13/2004       | Dairy based dessert products namely ice cream and frozen confections                                      |
| 8. McGRIDDLES    | 3,151,707       | 10/03/2006       | Hot cakes   |
| 9. McCAFE        | 3,201,441       | 01/23/2007       | Beverages made of coffee beans, hot chocolate, pastries, muffins, cakes, cookies, biscuits and sandwiches |
| 10. 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.

5. 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.

6. 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.

7. 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 its application to register the "McSWEET" Mark in connection with "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", which was assigned Application Serial No. 78/947,247.

8. 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 Applicant's application for registration of its "McSWEET" Mark. Potential purchasers, upon seeing the distinctive formative "Mc" in Applicant's "McSWEET" Mark, 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).

9. In addition, Opposer's "Mc" family of marks was well established and famous long before Applicant filed its application for registration of the "McSWEET" Mark. Thus, registration by Applicant is likely to diminish and dilute the distinctive quality of Opposer'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 Opposer's famous marks.

10. 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.

11. If a registration is issued to Applicant for the "McSWEET" Mark, the confusion with Opposer's marks would result in damage and injury to Opposer and the public. Registration of this mark 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.

12. An individual, Leo McIntyre, adopted the term "McSweet" as the brand name for pickled cocktail onions that he had developed with a food manufacturer. Mr. McIntyre began selling the "McSweet" branded pickled cocktail onions through his company, Automated Sales. In 1999, Mr. McIntyre granted a non-exclusive right to James McCaslin to promote and sell his McSweet pickled cocktail onions through Mr. McCaslin's company, JMC Sales. Consequently, Mr. McCaslin began promoting and selling the McSweet pickled cocktail onions that year. From

1999 to 2003, both Automated Sales and JMC Sales were promoting and selling the McSweet pickled cocktail onions. However, JMC Sales' use of the McSweet mark and sale of products under that mark were subject to the authority and approval of Mr. McIntyre. When Mr. McIntyre fell ill in mid-late 2003, JMC Sales began servicing all of Automated Sales' customers and managing the business pursuant to the "JMC Sales Royalty Agreement," (the "License"). The License requires JMC Sales, which has since changed its name to McSweet, LLC,

**REDACTED**

Mr. McIntyre passed away in April 2009 but Applicant admits that it is still paying royalties under the License to this day. Applicant further admits that JMC Sales and Automated Sales are not related entities, and that the only document controlling the relationship between the two entities is the License.

13. Accordingly, Applicant was at the time of filing the Subject Application, August 8, 2006, a mere licensee – and not the owner – of the McSweet Mark, and any use of the term "McSweet" by Applicant has inured to Automated Sales. Automated Sales or the estate of Mr. McIntyre remains the owner of all trademark rights in "McSweet" that may have developed as a result of Applicant's use. However, Automated Sales was not identified as the applicant on U.S. Trademark Application Serial No. 78/947,247 at the time that the application was filed, and has never been listed as the owner of the application. Rather, JMC Sales was listed as the applicant and falsely represented that it was the owner. Because JMC Sales was not the owner of the mark at the time that it was applied for (and, in fact, is still not the owner), the application is void *ab initio*.

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

WHEREFORE, Opposer requests that this Opposition be sustained and Application Serial No. 78/947,247 be refused registration.

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

Respectfully submitted,  
McDONALD'S CORPORATION  
By: s/ John A. Cullis/  
One of the Attorneys for Opposer

Date: July 26th, 2010

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NGEDOCs: 1756432.1

# Exhibit B

**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.              | ) |                              |

**AMENDED 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 Subject Application").
2. Opposer timely filed a Notice of Opposition with respect to the Subject Application.
3. 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 in connection with the same type of goods designated in the Subject Application. In addition, Opposer is likely to further expand the use of its "Mc" formative marks, and this expansion may include the goods designated in the Subject Application or other goods of the same type.

5. Opposer owns a federal registration on "Mc," Registration No. 1,947,099, issued on January 9, 1996 for restaurant services. Opposer also owns numerous federal registrations of its "McDONALD'S" and "Mc" formative marks for a wide range of goods or services, including the following:

| <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. McDOUBLE      | 1,266,500       | 02/07/1984       | A sandwich for consumption on or off premises                              |
| 4. McRIB         | 1,315,979       | 01/22/1985       | A sandwich for consumption on or off the premises                          |
| 5. McMUFFIN      | 1,369,360       | 11/05/1985       | Breakfast food combination sandwich for consumption on or off the premises |
| 6. McNUGGETS     | 1,450,104       | 07/28/1987       | Restaurant services  |

| <u>MARK NAME</u> | <u>REG. NO.</u> | <u>REG. DATE</u> | <u>GOODS/SERVICES</u>   |
|------------------|-----------------|------------------|---|
| 7. McFLURRY      | 2,805,109       | 01/13/2004       | Dairy based dessert products namely ice cream and frozen confections                                      |
| 8. McGRIDDLES    | 3,151,707       | 10/03/2006       | Hot cakes   |
| 9. McCAFE        | 3,201,441       | 01/23/2007       | Beverages made of coffee beans, hot chocolate, pastries, muffins, cakes, cookies, biscuits and sandwiches |
| 10. 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 trademark; (ii) Opposer's ownership thereof; and (iii) Opposer's exclusive right to use the registered trademark 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 generic 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. Both the Trademark Trial and Appeal Board and the Federal Circuit have long recognized the validity of McDonald's Corporation's rights to its famous "Mc" and "Mac"

family of marks. McDonald's Corp. v. McClain, 37 U.S.P.Q. 2d 1274, 1276 (TTAB 1995) (stating "The family of [McDonald's] marks has been recognized by this Board and by the courts"); McDonald's Corp. v. McKinley, 13 U.S.P.Q. 2d 1895, 1899 (TTAB 1989) (stating "In view of opposer's extensive evidence of use and promotion of marks having a "Mc" or "Mac" portion, there can be no doubt that opposer has established that its marks comprise a family"); McDonald's Corp. v. McBagel's, Inc., 649 F. Supp. 1268, 1272 (S.D.N.Y. 1986) (showing no hesitation in finding that McDonald's "owns a 'family of marks' both registered and unregistered, whose common characteristic is the use of 'Mc' or 'Mac' as a formative"); J&J Snack Foods Corp. v. McDonald's Corp., 932 F.2d 1460, 1463 (Fed. Cir. 1991)(recognizing "McDonald's specific family of marks wherein the prefix "Mc" is used with generic food names to create fanciful words.")

9. The word "sweet" is a generic or descriptive term when used alone in connection with pickled asparagus.

10. 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 Subject Application, which was assigned Application Serial No. 77/722,272.

11. 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 pickled asparagus identified in the Subject 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 product 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).

12. In addition, Opposer's "Mc" family of marks was well established and famous long before Applicant filed the Subject 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.

13. 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.

14. 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.

15. 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 Subject Application. Because Applicant is not the owner of the "McSWEET" mark, the Subject 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: December 9, 2009

By: Lawrence E. James, Jr./  
One of the Attorneys for Opposer

Robert E. Browne  
John A. Cullis  
Lawrence E. James, Jr.  
Mike R. Turner  
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**CERTIFICATE OF SERVICE**

I, Mike R. Turner, state that I served a copy of the foregoing *Exhibits Referenced in Opposer's Motion to Consolidate Opposition Proceedings* 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 16th day of December, 2010.

/Mike R. Turner /  
Mike. R. Turner