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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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**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.                                    )  
                                                  )  
McSWEET, LLC,                        )  
                                                  )  
    Applicant.                         )

Opposition No. 91192099

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

Applicant McSWEET, LLC, respectfully submits this opposition to Opposer's Motion to Withdraw its Response to Applicant's Request for Admission No. 105, which was submitted on December 1, 2010, two months after the admission was made and now, less than a month from the scheduled conclusion of discovery. As is more fully set forth below, Applicant objects to Opposer's Motion to Withdraw its Response to Applicant's Request for Admission No. 105 because (1) Opposer's proposed "supplemental" response denying the requested admission is not warranted by its proffered newly discovered evidence; (2) Opposer now seeks to make new objections which should be deemed untimely and waived; and (3) Opposer would not be prejudiced by maintaining the admission, whereas Applicant would be prejudiced by the withdrawal of Request No. 105.

**1. Opposer's Supplemental Response Does Not Fairly Respond to the Substance of Request No. 105 and Should Not Be Permitted.**

Opposer offers as the basis for withdrawing its admission the McDonald's "Arch Card" which Opposer defines as a pre-paid gift card that can be redeemed at McDonald's restaurants for McDonald's products.<sup>1</sup> A "gift card" is "a card entitling the recipient to receive goods or services of a specified value from the issuer."<sup>2</sup> Thus, a gift card is a money substitute and a means to obtaining McDonald's fast food at McDonald's restaurants. McDonald's Motion to Withdraw its Response to Applicant's Request for Admission No. 105 ("Opposer's Motion"), at 2, ¶ 3.

Consistent with Applicant's Request No. 105, McDonald's admitted 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." Nothing about the Arch Cards provides a sound basis for withdrawing its admission. Even if Opposer sells Arch Cards at grocery stores, McDonald's does not suggest that the cards are sold in the meat, fresh produce, dairy or baked goods departments.

McDonald's also admitted as part of its response to Request No. 105, that "it does not presently sell or distribute goods to grocery stores for the purpose of making the goods available to grocery store customers . . . 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." Similarly, nothing about the suggested Arch Cards demonstrates that this portion of its admission is not fairly admitted. Opposer does not purport to offer Arch cards

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<sup>1</sup> See McDonald's Motion to Withdraw its Response to Applicant's Request for Admission No. 105 ("Opposer's Motion"), at 2, ¶ 3. See also [http://www.mcdonalds.com/us/en/services/arch\\_card.html](http://www.mcdonalds.com/us/en/services/arch_card.html). ("The Arch Card is a pre-paid card that gives customers a quick and convenient way to pay at McDonald's. Arch Cards also make the perfect gift for holidays or any special occasion. Arch Cards come in denominations of \$5, \$10, \$25, and \$50.")

<sup>2</sup> <http://www.merriam-webster.com/dictionary/gift%20card>.

on *any* shelves, or, more particularly, “along the shelf space reserved for canned, packaged or frozen goods, or among the various non-food items. . . .” Rather, McDonald’s offers Arch cards “through display arrangements located throughout the store, including aisle end caps, check-out displays, and intra-aisle displays.” Opposer’s Motion at 2, ¶ 3.

Opposer now interprets Request No. 105 as one asking it to admit that it does not offer any services or goods in grocery stores generally, Opposer’s Motion at 2, ¶¶ 4-5, but that is not the substance of the Request. *See* Opposer’s Motion at ¶ 1 and Exhibit A (Request No. 105 quoted). A denial to a request for admission must fairly respond to the substance of the matter of the request. FED. R. CIV. P. 36(a)(4). Opposer has not offered any evidence that justifies or even supports its motion to withdraw what it admitted; what it admitted is fairly taken as conclusively established for purposes of this proceeding.

**2. The New Objections Opposer Offers are Lacking in Substance and Are Untimely and Should Be Deemed Waived.**

The strength of the conclusion that Opposer should not be permitted to withdraw its admission is enhanced by the belated objections that Opposer now seeks to make part of its response to Request No. 105. Initially, McDonald’s did not make any objection to Request No. 105, apparently having no difficulty comprehending the referenced grocery store locations, and the concepts of grocery store “departments” and “shelf space.” Indeed, it seems that even now, McDonald’s does not in fact have difficulty with those concepts. It has not suggested that its Arch Cards are sold in any of the referenced departments or on any shelves, but rather on “aisle end caps, check-out displays, and intra-aisle displays.” Opposer’s Motion at 2, ¶ 3. Now, however, McDonald’s takes the position that the locations specified in Request No. 105 are “vague and incomprehensible” and that there are “no clear definitions” of “departments” and “shelf space.” Opposer’s Motion, Exhibit A, last page, “Supplemental Response.” The words

should be given their ordinary meaning and Opposer's objections recognized as the sophistry that they are.

FED. R. CIV. P. 36(a)(3) and (5) require that objections to requests for admission be made within thirty days after being served (or upon such additional time as was allowed for the responses). Opposer requested and was granted additional time to make its objections and responses. Nevertheless, it did not object to Request No. 105. Opposer did not make *any* specific objections to the "identified locations within grocery stores" or the terms "departments" and "shelf space." Affidavit of Caitlin A. Bellum in Support of Applicant's Opposition to Opposer's Motion to Withdraw its Response to Applicant's Request for Admission No. 105 ("Bellum Aff.") ¶ 3, Exh. 2.

Moreover, Opposer does not argue within its motion that it should be able to assert new objections in its supplemental response. Rather, it attempts to slide them in, failing even to mention, let alone justify, them in its motion. Because the time for filing objections has long expired, the objections made by Opposer for the first time in its supplemental response should not be granted. *See Avante Intern. Tech., Inc. v. Hart Intercivic, Inc.*, 2008 WL 2074093, 1 (S.D. Ill.) (S.D. Ill. 2008); *Cf. Essex Builders Group, Inc. v. Amerisure Ins. Co.*, 230 F.R.D. 682, 685-686 (M.D. Fla. 2005).

**3. Opposer's Motion to Withdraw its Response to Applicant's Request for Admission No. 105 is Prejudicial to Applicant and Should Be Denied.**

Under FED. R. CIV. P. 36(b), two factors are considered in determining whether to allow a party's withdrawal of an admission: the withdrawal must further the presentation of the merits, and the party who obtained the admission cannot be prejudiced by the withdrawal. *Hadley v. U.S.*, 45 F.3d 1345, 1348 (9th Cir. 1995). The test to determine whether prejudice exists is if the non-moving party is now any less able to obtain the evidence required to prove the matter which

was admitted than it would have been at the time the admission was made. *Rabil v. Swafford*, 128 F.R.D. 1, 2 (D.D.C. 1989); *Giersch v. Scripps Networks, Inc.*, 85 USPQ2d 1306, \*3 (TTAB 2007); *Brook Village N. Assocs. v. General Elec. Co.*, 686 F.2d 66, 70 (1st Cir.1982). Filing a Rule 36(b) motion prior to the close of discovery *per se* does not necessarily imply that the moving party has satisfied the second prong. “Timing is merely *one* factor to consider in analyzing prejudice to the non-moving party.” *Giersch v. Scripps Networks, Inc.*, 85 USPQ2d 1306, \*4 (TTAB 2007) (emphasis included).

Opposer’s withdrawal of its admission to Request for Admission No. 105 is clearly prejudicial to Applicant for two reasons. First, Opposer has not offered *any* evidence to suggest that what it admitted is not true, and Applicant would be put to substantial additional effort and expense to prove what McDonald’s has already admitted. By contrast, Opposer will not be prejudiced. Its admission does not preclude it from offering evidence that it sells its Arch Card in grocery stores “through display arrangements, . . . including aisle end caps, check-out displays, and intra-aisle displays.”

Applicant is also prejudiced by the timing of Opposer’s motion. Opposer served its Responses to Applicant’s First Set of Requests for Admission on October 8, 2010. Bellum Aff. ¶ 2, Exh. 1. It was not until December 1, 2010, only 18 days before the conclusion of discovery, DN 31, that Opposer moved to withdraw its admission. Although Opposer and Applicant have recently stipulated to a thirty-day extension of discovery, it would be unrealistic for Applicant to now conduct adequate discovery regarding Opposer’s proposed denial. Moreover, Applicant would likely have to take one or more depositions of Opposer’s personnel, the necessity of which the admission substantially avoids.

Opposer suggests that there is something improper in Applicant’s refusal to consent to its

withdrawal of its admission. Opposer's Motion at 2, ¶ 5. But the withdrawal of the admission clearly is not in Applicant's interest and, as set forth above, is not warranted. Moreover, Opposer refused to provide a copy of its motion to Applicant prior to submittal so that Applicant would be advised of the basis for the motion. *Bellum Aff.* ¶ 7. Under the circumstances, not consenting to Opposer's motion was both prudent and justifiable.

**4. Opposer's Lack of Diligence Concerning the Arch Cards Should Bar its Withdrawal of its Admission to Request No. 105.**

Even if the Board determines that the two-factor test under Rule 36(b) has been satisfied by Opposer, the Board still has discretion to deny a request to withdraw an admission. *A per se* rule that the Board must permit withdrawal of an admission simply because it relates to an important matter in the litigation is inappropriate in light of the discretionary language of the Rule. *See Asea, Inc. v. Southern Pac. Transp. Co.*, 669 F.2d 1242, 1248 (9th Cir. 1981). *See also In re Carney*, 258 F.3d 415, 419 (5th Cir. 2001); *U.S. v. Kasuboski*, 834 F.2d 1345, 1350 n. 7 (7th Cir. 1987) (“[R]ule 36(b) allows withdrawal of admissions if certain conditions are met and the district court, in its discretion, permits the withdrawal.”); *Donovan v. Carls Drug Co., Inc.*, 703 F.2d 650, 652 (2d Cir.1983). When an admission is made inadvertently, or new evidence is discovered after the admission, Rule 36(b) withdrawal should be allowed. *Branch Banking and Trust Co. v. Deutz-Allis Corp.*, 120 F.R.D. 655, 660 (E.D.N.C. 1988). However, the presence of improper conduct by the party moving to withdraw an admission may be considered by the Board in determining whether to grant a motion to withdraw an admission. *See Carlson v. Freightliner LLC*, 226 F.R.D. 343, 361 (D. Neb. 2004).

At the time Opposer's responses to Applicant's requests for admission were due, McDonald's Arch Cards were available for sale in grocery stores—McDonald's registration of its “ARCH CARD” mark suggests that the cards have been available for sale in grocery stores

since at least 2006.<sup>3</sup> Under FED. R. CIV. P. 36(a)(4), Opposer was obligated to make a reasonable inquiry on the issue of whether Opposer sold or distributed products to grocery stores, and determine whether the information readily obtainable was sufficient to allow Opposer to admit this particular request. Opposer suggests that Opposer only discovered that its Arch Cards were sold in grocery stores on November 19, 2010. Opposer's Motion ¶ 3. However, it is scarcely plausible that Opposer does not know where and how its cards are sold. Moreover, the investigation and efforts in drafting Opposer's responses were overseen by at least five attorneys—Robert E. Browne, Michael G. Kelber, John A. Cullis, Lawrence E. James Jr., and Mike R. Turner—as well as Opposer itself. Opposer even requested and received an extension of time to serve its responses because it had not had the chance to properly review them. DN 23. With the magnitude of information and assistance at Opposer's disposal, it is difficult to fathom how the sale of Opposer's Arch Cards at grocery stores could not have been discovered by Opposer until November 9, 2010. Consequently, it would be grossly unfair to now permit Opposer to withdraw its admission, because the cards are not new, Opposer has had knowledge of these sales for over four years, and Opposer's did not inadvertently admit the request.

WHEREFORE, Applicant respectfully requests that the Board enter an Order denying Opposer's Motion to Withdraw its Response to Applicant's Request for Admission No. 105.

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<sup>3</sup> Bellum Aff. ¶9, Exh. 4. Noticeably absent from Opposer's motion is the date that Arch Cards were first available for sale at grocery stores and an explanation as to why Opposer is just now discovering such evidence. DN 31; Bellum Aff. ¶ 8.

DATED this 21st day of December, 2010.

Respectfully submitted,  
HENDRICKS & LEWIS, PLLC

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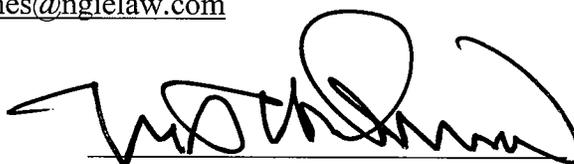
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Dated: December 21, 2010

**CERTIFICATE OF SERVICE**

I hereby certify that on December 21, 2010, I served a true and complete copy of the foregoing APPLICANT'S OPPOSITION TO OPPOSER'S MOTION TO WITHDRAW ITS RESPONSE TO APPLICANT'S REQUEST FOR ADMISSION NO. 105 via email and First Class U.S. Mail, postage pre-paid, upon:

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