

ESTTA Tracking number: **ESTTA321082**

Filing date: **12/09/2009**

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

Proceeding	91192099
Party	Plaintiff McDonald's Corporation
Correspondence Address	John A Cullis 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	Motion to Amend Pleading/Amended Pleading
Filer's Name	Lawrence E. James, Jr.
Filer's e-mail	rbrowne@ngelaw.com, jcullis@ngelaw.com, ljames@ngelaw.com, mturner@ngelaw.com, apeterson@ngelaw.com, lbailey@ngelaw.com
Signature	/Lawrence E. James, Jr./
Date	12/09/2009
Attachments	Opposer's Motion for Leave to Amend its Notice of Opposition.pdf (13 pages) (463060 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 FOR LEAVE TO AMEND ITS NOTICE OF OPPOSITION

Opposer, McDonald's Corporation ("McDonald's"), by and through its attorneys Neal, Gerber & Eisenberg, LLP, hereby moves for an Order pursuant to 37 C.F.R. § 2.107, TBMP § 507 and Fed. R. Civ. P. 15(a), granting it leave to amend its Notice of Opposition, so as to eliminate extraneous issues, streamline discovery, and focus this proceeding on the issue of whether registration of "McSweet" for pickled asparagus will damage McDonald's "Mc" family of marks. McDonald's proposed Amended Notice of Opposition is attached hereto as Exhibit A.

MEMORANDUM IN SUPPORT OF MOTION

I. STATEMENT OF FACTS

On or about April 24, 2009, McSweet, LLC ("Applicant"), filed U.S. Trademark Application Serial No. 77/722,272 for the mark "McSweet" for use in connection with Pickled Asparagus ("the Subject Mark"). After obtaining the necessary extension of time, McDonald's filed a Notice of Opposition on September 29, 2009, opposing registration of the Subject Mark. In its Notice, McDonald's alleged that Applicant's proposed use of the Subject Mark would be likely to cause confusion with McDonald's family of "Mc" formative marks, which the Court of Appeals for the Federal Circuit has recognized and defined as "marks wherein the prefix "Mc" is

used with generic food names to create fanciful words.” *J&J Snack Foods Corp. v. McDonald’s Corp.*, 932 F.2d 1460, 1463 (Fed. Cir. 1991). The “Mc” family of marks is exemplified by marks that have been in existence for over thirty-five years—such as the EGG McMUFFIN Mark, Registration No. 1,002,949—as well as marks that have been used by McDonald’s for shorter periods of time. As representative of its “Mc” family, McDonald’s asserted twenty of its numerous registrations of “Mc” marks in its Notice of Opposition in this matter.

In its responsive pleading, Applicant asserted counterclaims¹ petitioning to cancel seven of McDonald’s twenty asserted registrations. Specifically, Applicant claims that McDonald’s has abandoned the marks McPIZZA, McCOLA, McCHILI, McCOOKIE, McCOFFEE, and McVEGGIE BURGER (“the Challenged Registrations”). (See Applicant’s Answer to Notice of Opposition and Counterclaims, ¶¶29-34.)²

II. ARGUMENT

Trademark Rule 2.107 and Federal Rule of Civil Procedure 15(a) provide that “leave [to amend] shall be freely given when justice so requires.” Fed. R. Civ. P. 15(a); See *Froman v. Davis*, 371 U.S. 178, 182 (1962)(“If the underlying facts or circumstances relied upon by a plaintiff may be a proper subject of relief, he ought to be afforded an opportunity to test his claims on the merits.”). The Board has concurred that “[a]mendments to pleadings should be allowed with great liberality at any stage of the proceeding . . . unless it is shown that entry of the amendment would violate settled law or be prejudicial to the rights of any opposing parties.” *Commodore Elecs. Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1505 (TTAB 1993).

¹ Applicant refers to these as “cross claims” within its responsive pleading; however, they are properly understood to be “counterclaims.”

² Applicant also counterclaims that McDonald’s has never used or has abandoned the mark McNUGGETS in connection with restaurant services, and that the registration corresponding to that mark should also be cancelled. (Id., ¶36.) McDonald’s believes that the counterclaim against this registration will be disposed of promptly as a matter of law and, therefore, will not prolong discovery.

Accordingly, when deciding to grant an opposer's motion for leave to amend, the Board considers whether there is any undue prejudice to the applicant and whether the amendment is legally sufficient. *Id.* To be legally sufficient, the amendment need only allege facts that, if true, would establish an opposer's standing. *Id.* at 1506 (citing *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024 (C.C.P.A. 1982)).

The basis of McDonald's opposition to registration of the Subject Mark is that it is likely to cause confusion with and to dilute McDonald's "Mc" family of marks. "A family of marks is a group of marks having a recognizable common characteristic, wherein the marks are composed and used in such a way that the public associates not only the individual marks, but the common characteristic of the family, with the trademark owner." *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 1463 (Fed. Cir. 1991). As pleaded in both the original Notice of Opposition and the proposed Amended Notice of Opposition, McDonald's "Mc" family of marks is based upon its long use of numerous marks that combine the "Mc" formative with various descriptive or generic terms. McDonald's alleges in the proposed Amended Notice of Opposition that the "Mc" family of marks is famous and recognized throughout the world as being associated with McDonald's. McDonald's further alleges therein that registration of the Subject Mark poses a threat of confusion and dilution, and, as a result, damage to McDonald's "Mc" family of marks. The proposed Amended Notice of Opposition is legally sufficient because it establishes McDonald's standing to oppose.

To represent its "Mc" family of marks, McDonald's initially asserted twenty of its federal registrations of "Mc" marks. However, as McDonald's is asserting the "Mc" family of marks in this Opposition, as opposed to any particular member of that family, McDonald's has elected to reduce the number of asserted marks from twenty to ten, and thereby avoid the time and expense

of litigating Applicant's Counterclaims. The ten marks asserted in the proposed Amended Notice of Opposition are more than sufficient to represent and illustrate the nature of McDonald's "Mc" family of marks. McDonald's reduction of the number of asserted marks will help streamline discovery and move this matter toward resolution. The proposed amendment removes all six of the Challenged Registrations from the Notice of Opposition.³ Thus, Applicant's counterclaims as to those marks are moot.

Granting this Motion at this stage of the proceeding will not cause Applicant any undue prejudice. Discovery has not opened in this matter, and granting of this Motion now will significantly reduce the issues before the Board as well as the amount of discovery.

III. CONCLUSION

WHEREFORE, Opposer's Amendment is timely filed, legally sufficient and will not prejudice Applicant, and Opposer respectfully requests that the Board enter an Order pursuant to TBMP § 507 and Fed. R. Civ. P. 15(a) granting its Motion for Leave to Amend its Notice of Opposition attached hereto, and adjusting the trial dates as the Board deems appropriate.

Respectfully submitted,

McDONALD'S CORPORATION

Date: December 9, 2009

By: /Lawrence E. James, Jr./
John A. Cullis
Lawrence E. James, Jr.
NEAL, GERBER & EISENBERG LLP
2 N. LaSalle Street, Suite 1700
Chicago, IL 60602
(312)269-8000 Telephone
(312)269-1747 Facsimile

³ In a separate motion filed concurrently herewith, Opposer has requested voluntary surrender of the Challenged Registrations. However, McDonald's efforts to streamline this proceeding should in no way be taken as an admission that it has abandoned any common law, state law based or international rights in the marks that are the subject of the Registrations it is seeking to remove from this proceeding.

EXHIBIT A

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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McDONALD'S CORPORATION,)	
)	Opposition No. 91192099
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v.)	Mark: McSWEET
)	Application S/N: 77/722,272
McSWEET, LLC,)	Filed: April 24, 2009
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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
NEAL, GERBER & EISENBERG, LLP
2 N. LaSalle Street, Suite 1700
Chicago, IL 60602
(312) 269-8000

CERTIFICATE OF SERVICE

I, Lawrence E. James, Jr., state that I served a copy of the foregoing *Amended Notice of Opposition*, via first class U.S. mail, postage pre-paid, upon Applicant's counsel of record:

Katherine Hendricks
HENDRICKS & LEWIS PLLC
901 Fifth Ave., Ste 4100
Seattle, WA 98164

on this 9th day of December, 2009.

/Lawrence E. James, Jr./
Lawrence E. James, Jr.

NGEDOCs: 1671918.1