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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	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	Answer to Counterclaim
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 Answer to Applicant's Counterclaims and First Affirmative Defense.pdf (10 pages)(432851 bytes)

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

McDONALD'S CORPORATION,	)		
	)	Opposition No. 91/192,099	
Opposer,	)		
	)		
v.	)	Mark:	McSWEET
	)	Application S/N:	77/722,272
McSWEET, LLC,	)	Filed:	April 24, 2009
	)	Published:	September 1, 2009
Applicant.	)		

OPPOSER'S ANSWER TO APPLICANT'S COUNTERCLAIMS AND FIRST AFFIRMATIVE DEFENSE

Now comes Opposer/Counter-Respondent, McDONALD'S CORPORATION ("McDonalds"), for its Answer to the Counterclaims contained in the responsive pleading of Applicant/Counter-Petitioner, McSWEET, LLC ("Applicant"), filed November 6, 2009. As its Answer, McDonald's states as follows:

19. Applicant has continuously used the mark McSWEET since September 4, 2008, to the present, exclusively in interstate commerce and in commerce regulated by Congress in connection with Applicant's goods and services, including the sale of "pickled asparagus" in International Class 29.

ANSWER: McDonald's is without knowledge sufficient to form an opinion or belief as to the allegations set forth in Paragraph No. 19, and therefore denies the same.

20. Applicant has used its global mark continuously for the goods and services specified for a period exceeding one year and the mark has acquired distinctiveness in connection with Applicant's goods and services.

ANSWER: McDonald's is without knowledge sufficient to form an opinion or belief as to the allegations set forth in Paragraph No. 20, and therefore denies the same.

21. Applicant has previously filed for registration of the mark McSWEET for use in connection with various pickled vegetable products, and has since amended its designation to "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," also in International Class 29. Applicant and its predecessor in interest have used the mark continuously for pickled vegetables for a period exceeding 19 years and the mark has acquired distinctiveness in connection with Applicant's goods and services.

ANSWER: McDonald's admits that Applicant and Opposer are engaged in another Opposition proceeding related to a prior attempt by Applicant to register the mark McSweet, and that in the course of that Opposition, Applicant amended its designation of goods as reflected in Paragraph No. 21. McDonald's is without knowledge sufficient to form an opinion or belief as to whether Applicant and its predecessor in interest have used the mark continuously for pickled vegetables for a period exceeding 19 years, and therefore denies the same. McDonald's denies each and every remaining allegation contained in Paragraph No. 21.

22. Applicant has applied for registration of its mark in International Class 29, Serial No. 77,722,272 as follows:

IC 029. US 046. G & S: pickled asparagus.

FIRST USE: 20080904.

FIRST USE IN COMMERCE: 20080904

ANSWER: McDonald's admits that Applicant has applied for registration of the mark "McSweet" in International Class 29 for use in connection with pickled asparagus, that it claims use in commerce as of September 4, 2008, and that its application has been assigned Serial Number 77/722,272 by the United States Patent and Trademark Office.

23. Applicant has used the mark McSWEET, in connection with various pickled vegetable products, since at least as early as 1999, and in connection with pickled asparagus since 2008; and Applicant's predecessor first used his mark in commerce since at least as early as 1990, in connection with processed vegetables. Opposer cites the referenced marks in support of its opposition to registration.

ANSWER: McDonald's admits that it cites certain registrations that it owns in connection with its opposition to registration of McSWEET by Applicant. McDonald's is without knowledge sufficient to form an opinion or belief as to the remaining allegations set forth in Paragraph No. 23, and therefore denies the same.

24. Applicant has expended considerable effort and expense in promoting its mark McSWEET and the goods and services sold under such mark, with the result that the purchasing public has come to know, rely upon, and recognize the products of Applicant by such mark. Applicant has an exceedingly valuable goodwill established by its McSWEET mark.

ANSWER: McDonald's is without knowledge sufficient to form an opinion or belief as to the allegations set forth in Paragraph No. 24, and therefore denies the same.

25. Applicant's McSWEET mark is not confusingly similar to Opposer's marks identified above and the goods and services sold under Opposer's marks.

ANSWER: Denied.

26. McDONALD'S CORPORATION owns, operates, and controls the World Wide Web site www.mcdonalds.com.

ANSWER: Admitted.

27. McDONALD'S CORPORATION lists trademarks owned by the McDonald's Corporation and its affiliates on the World Wide Web site www.mcdonalds.com. However, Registration No. 1,118,362 for the mark McPIZZA; Registration No. 1,541,797 for the mark McCOLA; Registration No. 1,552,143 for the mark McCHILI; Registration No. 1,566,184 for the mark McCOOKIE; Registration No. 1,943,180 for the mark McCOFFEE; and Registration No. 2,289,608 for the mark McVEGGIE BURGER, are not included within those trademarks listed.

ANSWER: McDonald's admits that it lists some of the trademarks that it owns on a webpage within the mcdonalds.com domain entitled "McDonald's Internet Site Terms and Conditions." McDonald's further admits that the registrations referenced in Paragraph No. 27 are not included on this list. McDonald's denies that the list is an exclusive listing of all of

McDonald's trademarks, and denies each and every remaining allegation contained in Paragraph No. 27.

28. McDONALD'S CORPORATION includes a downloaded menu on the World Wide Web site www.mcdonalds.com that provides a list of the national food and beverage items offered at McDonald's restaurant, but this menu does not include Registration No. 1,118, 362 for the mark McPIZZA; Registration No. 1,541,797 for the mark McCOLA; Registration No. 1,552, 143 for the mark McCHILI; Registration No. 1,566, 184 for the mark McCOOKIE; Registration No. 1,943,180 for the mark McCOFFEE; and Registration No. 2,289,608 for the mark McVEGGIE BURGER.

ANSWER McDonald's admits that it provides a document entitled "McDonald's Menu" that may be downloaded from a webpage within the mcdonalds.com domain, and that said document comprises a partial listing of items offered for sale at some McDonald's restaurants located in the United States. McDonald's further admits that this document does not include Registration No. 1,118,362 for the mark McPIZZA; Registration No. 1,541,797 for the mark McCOLA; Registration No. 1,552,143 for the mark McCHILI; Registration No. 1,566,184 for the mark McCOOKIE; Registration No. 1,943,180 for the mark McCOFFEE; and Registration No. 2,289,608 for the mark McVEGGIE BURGER, or numerous other registrations for marks owned by McDonald's. McDonald's denies each and every remaining allegation contained in Paragraph No. 28.

29. Registration No. 1,118,362 should be canceled under the Trademark Act § 14, 15 U.S.C. § 1064, as abandoned. Upon information and belief, McDONALD'S CORPORATION included in its menu and advertised and promoted the mark McPizza in the late 1980s to early and mid-1990s. However, upon information and belief, the mark is no longer in use and, since the mid-1990s, has not been in use or in existence or good standing.

ANSWER: McDonald's admits that it has used the mark "McPizza" in commerce, and furthermore that such use has resulted in McDonald's ownership of both common law and statutory rights in the mark. McDonald's denies that it has abandoned its rights in the mark and

denies the remaining allegations in Paragraph No. 29 as moot in light of its Motion to Amend which withdraws the mark from the present proceeding.

30. Registration No. 1,541,797 should be canceled under the Trademark Act § 14, 15 U.S.C. § 1064, as abandoned. Upon information and belief, McDONALD'S CORPORATION no longer advertises or includes this mark on its World Wide Web site www.mcdonalds.com or its national menu. Upon information and belief, McDONALD'S CORPORATION has discontinued the use of this mark or use of the mark in connection with the goods specified.

ANSWER: McDonald's admits that it has used the mark "McCola" in commerce, and furthermore that such use has resulted in McDonald's ownership of both common law and statutory rights in the mark. McDonald's denies that it has abandoned its rights in the mark and denies the remaining allegations in Paragraph No. 30 as moot in light of its Motion to Amend which withdraws the mark from the present proceeding.

31. Registration No. 1,552,143 should be canceled under the Trademark Act § 14, 15 U.S.C. § 1064, as abandoned. Upon information and belief, McDONALD'S CORPORATION no longer advertises or includes this mark on its World Wide Web site www.mcdonalds.com or its national menu. Upon information and belief, McDONALD'S CORPORATION has discontinued the use of this mark or use of the mark in connection with the goods specified.

ANSWER: McDonald's admits that it has used the mark "McChili" in commerce, and furthermore that such use has resulted in McDonald's ownership of both common law and statutory rights in the mark. McDonald's denies that it has abandoned its rights in the mark and denies the remaining allegations in Paragraph No. 31 as moot in light of its Motion to Amend which withdraws the mark from the present proceeding.

32. Registration No. 1,566,184 should be canceled under the Trademark Act § 14, 15 U.S.C. § 1064, as abandoned. Upon information and belief, McDONALD'S CORPORATION no longer advertises or includes this mark on its World Wide Web site www.mcdonalds.com or its national menu. Upon information and belief, McDONALD'S CORPORATION has discontinued the use of this mark or use of the mark in connection with the goods specified.

ANSWER: McDonald's admits that it has used the mark "McCookie" in commerce, and furthermore that such use has resulted in McDonald's ownership of both common law and statutory rights in the mark. McDonald's denies that it has abandoned its rights in the mark and denies the remaining allegations in Paragraph No. 32 as moot in light of its Motion to Amend which withdraws the mark from the present proceeding.

33. Registration No. 1,943,180 should be canceled under the Trademark Act § 14, 15 U.S.C. § 1064, as abandoned. Upon information and belief, McDONALD'S CORPORATION no longer advertises or includes this mark on its World Wide Web site www.mcdonalds.com or its national menu. Upon information and belief, McDONALD'S CORPORATION has discontinued the use of this mark or use of the mark in connection with the goods specified.

ANSWER: McDonald's admits that it has used the mark "McCoffee" in commerce, and furthermore that such use has resulted in McDonald's ownership of both common law and statutory rights in the mark. McDonald's denies that it has abandoned its rights in the mark and denies the remaining allegations in Paragraph No. 33 as moot in light of its Motion to Amend which withdraws the mark from the present proceeding.

34. Registration No. 2,289,608 should be canceled under the Trademark Act § 14, 15 U.S.C. § 1064, as abandoned. Upon information and belief, McDONALD'S CORPORATION no longer advertises or includes this mark on its World Wide Web site www.mcdonalds.com or its national menu. Upon information and belief, McDONALD'S CORPORATION has discontinued the use of this mark or use of the mark in connection with the goods specified.

ANSWER: McDonald's admits that it has used the mark "McVeggie Burger" in commerce, and furthermore that such use has resulted in McDonald's ownership of both common law and statutory rights in the mark. McDonald's denies that it has abandoned its rights in the mark and denies the remaining allegations in Paragraph No. 34 as moot in light of its Motion to Amend which withdraws the mark from the present proceeding.

35. Registration No. 1,566,184 is registered in International Class 030 in connection with "soft serve ice milk sundaes for consumption on or off the premises." Registration No.

1,566,184 should be canceled under the Trademark Act § 14, 15 U.S.C. § 1064, as abandoned for nonuse in connection with the goods specified in the registration. Upon information and belief, McDONALD'S CORPORATION no longer advertises or includes this mark on its World Wide Web site www.mcdonalds.com or its national menu. Upon information and belief, McDONALD'S CORPORATION has discontinued the use of this mark or use of the mark in connection with the goods specified.

ANSWER: McDonald's submits that Paragraph No. 35 is duplicative of Paragraph No. 32, and herein incorporates by reference its answer to Paragraph No. 32.

36. Registration No. 1,450,104 is registered in International Class 042 in connection with "restaurant services." Registration No. 1,450,104 should be canceled under the Trademark Act § 14, 15 U.S.C. § 1064, as abandoned for nonuse in connection with the services specified in the registration. Upon information and belief McDONALD'S CORPORATION has a product on its menu and not a restaurant service that relates to this mark. Upon information and belief, McDONALD'S CORPORATION never used or has discontinued the use of this mark in connection with restaurant services and it is no longer in existence or good standing.

ANSWER: McDonald's admits that Registration No. 1,405,104 is registered in International Class 042 for restaurant services for the mark "McNuggets" and that it has used the mark as both a trademark and a service mark to identify a product and its services respectively. McDonald's further admits that it has products on its menus that relate to the mark "McNuggets," and that those products are offered in association with McDonald's restaurant services. McDonald's submits that Registration No. 1,450,104 speaks for itself. McDonald's denies each and every remaining allegation contained in Paragraph No. 36.

Wherefore, Applicant deems that it is or will be damaged by Registration No. 1,118,362 for the mark McPIZZA; Registration No. 1,450,104 for the mark McNUGGETS; Registration No. 1,541,797 for the mark McCOLA; Registration No. 1,552,143 for the mark McCHILI; Registration No. 1,566, 184 for the mark McCOOKIE; Registration No. 1,943,180 for the mark McCOFFEE; and Registration No. 2,289,608 for the mark McVEGGIE BURGER, and petitions for cancellation thereof in their entireties. Applicant prays that this Petition for Cancellation be granted, that judgment be entered against Opposer, and that United States Registration Nos. 1,118,362, 1,450,104, 1,541,797, 1,552,143, 1,566,184, 1,943,180, and 2,289,608 be canceled.

ANSWER: Denied.

OPPOSER'S FIRST AFFIRMATIVE DEFENSE TO APPLICANT'S COUNTERCLAIMS

Estoppel by Incontestability Pursuant to 15 U.S.C. §1064 and 15 U.S.C. §1065

1. Registration No. 1,450,104 for the mark McNUGGETS, for use in connection with restaurant services, was issued following the decision of the Court of Appeals for the Federal Circuit, *In re McDonald's,* 818 F.2d 875 (Fed. Cir. 1987)(unpublished). The mark was in continuous use by McDonald's for five consecutive years subsequent to the date of registration, namely, July 28, 1987. That mark is still used in commerce by McDonald's in connection with restaurant services. On September 22, 1992, McDonald's filed a Combined Section 8 and 15 Declaration for Registration No. 1,450,104.

2. Pursuant to 15 U.S.C. §1065, Registration No. 1,450,104 is incontestable, and under 15 U.S.C. §1115(b) constitutes conclusive evidence of the validity of the registered mark of the registration of the mark, of McDonald's ownership of the mark and of McDonald's exclusive right to the registered mark in commerce in connection with restaurant services.

3. Pursuant to 15 U.S.C. §§1064 and 1065 and 15 U.S.C. §1115(b), Applicant is prohibited from attacking the validity of Registration No. 1,450,104 on the ground that McDonald's allegedly "never used . . . this mark in connection with restaurant services" because that registration is incontestable.

WHEREFORE, McDonald's hereby requests that judgment be entered in its favor and against Applicant, that Opposer's First Affirmative Defense be sustained, and that the Trademark Trial and Appeal Board grant Opposer any further relief that it deems just and equitable.

Respectfully submitted,

McDONALD'S CORPORATION

Date: December 9, 2009

By: /Lawrence E. James, Jr./

One of the Attorneys for Opposer

John A. Cullis
Lawrence E. James, Jr.
NEAL, GERBER & EISENBERG, LLP
2 N. LaSalle Street, Suite 2200
Chicago, IL 60602
(312)269-8000

CERTIFICATE OF SERVICE

I, Lawrence E. James, Jr., state that I served a copy of the foregoing ***Opposer's Answer to Applicant's Counterclaims and First Affirmative Defense*** 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 9th day of December, 2009.

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

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