

ESTTA Tracking number: **ESTTA436794**

Filing date: **10/19/2011**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	McDonald's Corporation
Granted to Date of previous extension	10/19/2011
Address	One McDonald's Plaza Oak Brook, IL 60523 UNITED STATES

Correspondence information	John A. Cullis Neal Gerber & Eisenberg LLP Two N. LaSalle Street, Suite 1700 Chicago, IL 60602 UNITED STATES rbrowne@ngelaw.com, jcullis@ngelaw.com, ljames@ngelaw.com, kbrouin@ngelaw.com, mbenson@ngelaw.com Phone:3122698000
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Applicant Information

Application No	85242703	Publication date	06/21/2011
Opposition Filing Date	10/19/2011	Opposition Period Ends	10/19/2011
Applicant	Orca Beverage, Inc. 11903 Cyrus Way #5 Mukilteo, WA 98275 UNITED STATES		

Goods/Services Affected by Opposition

Class 032. All goods and services in the class are opposed, namely: Concentrates, syrups or powders used in the preparation of soft drinks; Soft drinks
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1126103	Application Date	
Registration Date	10/16/1979	Foreign Priority Date	NONE
Word Mark	NONE		

Design Mark	
Description of Mark	NONE
Goods/Services	

U.S. Registration No.	1331342	Application Date	09/29/1982
Registration Date	04/16/1985	Foreign Priority Date	NONE
Word Mark	BIG MAC		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1967/00/00 First Use In Commerce: 1967/00/00 Restaurant Services		

U.S. Registration No.	2035287	Application Date	12/13/1995
Registration Date	02/04/1997	Foreign Priority Date	NONE
Word Mark	BIG MAC		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use: 1967/00/00 First Use In Commerce: 1967/00/00 sandwich for consumption on or off the premises		

U.S. Registration No.	3459330	Application Date	09/30/2004
Registration Date	07/01/2008	Foreign Priority Date	NONE
Word Mark	ARE YOU MAC ENOUGH?		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 043. First use: First Use: 2005/09/30 First Use In Commerce: 2005/09/30 RESTAURANT SERVICES		

U.S. Registration No.	1307293	Application Date	08/09/1982
Registration Date	11/27/1984	Foreign Priority Date	NONE
Word Mark	MAC FRIES		
Design Mark			

Description of Mark	NONE
Goods/Services	Class 029. First use: First Use: 1972/01/03 First Use In Commerce: 1972/01/03 Frozen French Fried Potatoes

U.S. Registration No.	3775834	Application Date	12/18/2008
Registration Date	04/13/2010	Foreign Priority Date	NONE

Word Mark	MAC SNACK WRAP
Design Mark	 <p>MAC SNACK WRAP</p>

Description of Mark	NONE
Goods/Services	Class 030. First use: First Use: 2009/06/01 First Use In Commerce: 2009/06/01 SANDWICHES MADE OF MEAT, POULTRY, CHEESE, VEGETABLES AND SAUCE

U.S. Registration No.	3752293	Application Date	08/07/2009
Registration Date	02/23/2010	Foreign Priority Date	NONE

Word Mark	BIG MAC ATTACK
Design Mark	 <p>BIG MAC ATTACK</p>

Description of Mark	NONE
Goods/Services	Class 043. First use: First Use: 1976/11/14 First Use In Commerce: 1976/11/14 RESTAURANT SERVICES

U.S. Registration No.	1266500	Application Date	06/21/1982
Registration Date	02/07/1984	Foreign Priority	NONE

		Date	
Word Mark	MC DOUBLE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use: 1977/06/30 First Use In Commerce: 1977/09/30 a Sandwich for Consumption On or Off Premises		

U.S. Registration No.	1315979	Application Date	06/11/1982
Registration Date	01/22/1985	Foreign Priority Date	NONE
Word Mark	MCRIB		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use: 1981/06/30 First Use In Commerce: 1981/06/30 a Sandwich for Consumption On or Off the Premises		

U.S. Registration No.	1485633	Application Date	02/13/1984
Registration Date	04/19/1988	Foreign Priority Date	NONE
Word Mark	MCMUFFIN		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1983/05/00 First Use In Commerce: 1983/05/00 RESTAURANT SERVICES		

U.S. Registration No.	1450104	Application Date	09/30/1982
Registration Date	07/28/1987	Foreign Priority Date	NONE
Word Mark	MCNUGGETS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1980/04/00 First Use In Commerce: 1980/04/00 RESTAURANT SERVICES		

U.S. Registration No.	1947099	Application Date	08/08/1991
Registration Date	01/09/1996	Foreign Priority Date	NONE
Word Mark	MC		
Design Mark			
Description of Mark	NONE		

Goods/Services	Class 042. First use: First Use: 1995/06/14 First Use In Commerce: 1995/06/14 restaurant services		
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U.S. Registration No.	3151707	Application Date	05/12/2004
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Registration Date	10/03/2006	Foreign Priority Date	NONE
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Word Mark	MCGRIDDLES		
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Design Mark			
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Description of Mark	NONE		
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Goods/Services	Class 030. First use: First Use: 2000/10/31 First Use In Commerce: 2000/10/31 HOT CAKES		
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U.S. Registration No.	1352168	Application Date	05/23/1983
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Registration Date	07/30/1985	Foreign Priority Date	NONE
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Word Mark	MC DONALD'S		
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Design Mark			
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Description of Mark	NONE		
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Goods/Services	Class 042. First use: First Use: 1968/12/31 First Use In Commerce: 1968/12/31 RESTAURANT SERVICES		
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Attachments	78491934#TMSN.jpeg (1 page)(bytes) 77636011#TMSN.jpeg (1 page)(bytes) 77799534#TMSN.jpeg (1 page)(bytes) 78417184#TMSN.jpeg (1 page)(bytes) 73426936#TMSN.gif (1 page)(bytes) Notice of Opposition.pdf (8 pages)(98508 bytes)		
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/John A. Cullis/
Name	John A. Cullis
Date	10/19/2011

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

In the Matter of:
Application Serial No. 85/242,703
Published in the *Official Gazette*
June 21, 2011

McDONALD’S CORPORATION,)	
)	
Opposer,)	
)	
v.)	Opposition No. _____
)	
ORCA BEVERAGE, INC.)	
)	
Applicant.)	

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 “MACFUDDY” in International Class 32, as shown in Application Serial No. 85/242,703 filed by Applicant, Orca Beverage, Inc. (“Applicant”), 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 that consists of the phrase “MACFUDDY” for “concentrates, syrups or powders used in the preparation of soft drinks” and “soft drinks” (“Applicant’s Goods”) in International Class 32 (hereinafter, the Applicant’s “MACFUDDY” mark). The application is an intent-to-use application filed under 15 U.S.C. § 1051(1)(b).

2. Opposer has obtained the necessary extensions of time in which to file this Notice of Opposition. Accordingly, this Notice of Opposition is being timely submitted.

3. Since 1955, Opposer has been in the business of developing, operating, franchising, and servicing an extensive system of restaurants that prepare, package, and sell a wide variety of high quality, quickly-prepared, modestly-priced foods. Opposer has carried on this business throughout the United States and the world. Opposer and its subsidiaries now operate or license thousands of restaurants throughout the world, including over 14,000 restaurants in the United States.

4. In connection with this business, Opposer has, for decades, extensively used the “Mc” and “Mac” family of marks, which includes the “Mc” and “Mac” formatives used with various generic or descriptive terms, as trademarks and service marks in advertising, promoting and selling a wide variety of food products and restaurant services. For instance, Opposer has used its world famous “BIG MAC” trademark in connection with restaurant services continuously over forty years. During that time, Opposer has expanded the use of its “Mc” and “Mac” family of trademarks to include a wide variety of goods and services including food products such as chicken, specialty sandwiches, breakfast items, restaurant services and non-food products, all of which are advertised and promoted throughout the United States.

5. Opposer’s extensive advertising and promotion of its various goods and services under its family of “Mc” and “Mac” formative marks features the use of television and print advertising, radio, newspaper and magazine advertising, outdoor billboard, Internet advertising and direct mail, all of which are directed to and reach the public in both local and nationwide markets. In addition, Opposer uses the “Mc” and “Mac” formative family of marks on food product packaging and point of purchase advertising. In sum, Opposer uses the “Mc” and “Mac”

family of marks on a wide variety of products, or is likely to expand the use of its family of “Mc” and “Mac” marks to products and/or services, identical, similar or related to those on which Applicant’s “MACFUDDY” mark is intended to be used by Applicant.

6. Opposer owns numerous federal registrations for its family of “Mc” and “Mac” marks. These registrations include, but are not limited to, the following:

<u>MARK NAME</u>	<u>REG. NO.</u>	<u>REG. DATE</u>	<u>GOODS/SERVICES</u>
1. BIG MAC	1,126,102	10/16/1979	Sandwich
2. BIG MAC	1,331,342	04/16/1985	Restaurant services
3. BIG MAC	2,035,287	02/04/1997	Sandwich for consumption on or off the premises
4. ARE YOU MAC ENOUGH?	3,459,330	07/01/2008	Restaurant services
5. MAC FRIES	1,307,293	11/27/1984	Frozen French Fried Potatoes
6. MAC SNACK WRAP	3,775,834	4/13/2010	Sandwiches made of meat poultry, cheese, vegetables and sauce
7. BIG MAC ATTACK	3,752,293	2/23/2010	Restaurant services
8. McDONALD’S	1,352,168	07/30/1985	Restaurant services
9. McDOUBLE	1,266,500	02/07/1984	A sandwich for consumption on or off premises
10. McRIB	1,315,979	01/22/1985	A sandwich for consumption on or off premises
11. McMUFFIN	1,485,633	04/19/1988	Restaurant Services
12. McNUGGETS	1,450,104	07/28/1987	Restaurant Services
13. Mc	1,947,099	01/09/1996	Restaurant services
14. McGRIDDLES	3,151,707	10/03/2006	Hot cakes

All of these registrations are valid, subsisting, and in full force and effect. Furthermore, Opposer used these marks in association with their respective designated goods and services prior to Applicant's intent-to-use filing date of February 15, 2011 for Applicant's "MACFUDDY" mark.

7. Each of the aforesaid registrations is at least *prima facie* evidence of the validity of each registration, of Opposer's ownership thereof, and of Opposer's exclusive right to use such registered marks on the goods or services set forth in the registration.

8. In addition to those federally registered trademarks listed above, Opposer has also, from time to time used or is using other "Mc" and "Mac" formative trademarks, such as the following:

MAC	MAC JR.
MINI MAC	MACMAN
LITE MAC	MAC FAMILY
MEGA MAC	MAC TO GO
DOUBLE MAC	MAC PAC
SUPER MAC	MONSTER MAC
6 PAC MAC	XTREME MAC
MACSIMIMIZE YOUR MAC	HAVE YOU HAD YOUR MAC TODAY?
BLAST BACK WITH MAC	OFFICER MAC
MAC ATTACK	MAC TONIGHT
MORNING MAC	

Such use, over many years, has caused consumers worldwide to associate trademarks distinguished by the "Mac" formative with Opposer.

9. Opposer has developed, at great effort and expense, exceedingly valuable goodwill with respect to its “Mc” and “Mac” family of marks. As a result of its efforts, Opposer’s “Mc” and “Mac” family of marks are famous and were famous long prior to the date of filing of Applicant’s subject application.

10. 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.”)

11. Despite Opposer’s long-standing prior rights in its “Mc” and “Mac” family of marks, Applicant filed its intent-to-use application on or about February 15, 2011 to register “MACFUDDY” as a trademark for Applicant’s Goods.

12. Applicant’s intended use of the “MACFUDDY” mark will inevitably be directed at the same consumers that Opposer targets with its use of its famous “Mc” and “Mac” family of marks.

13. Potential purchasers, upon seeing Applicant's "MACFUDDY" mark used in connection with Applicant's Goods, are likely to mistakenly believe that such a term and the services offered thereunder originate with or are connected with, sponsored by, associated with, or licensed or approved by Opposer. Thus, the registration and use by Applicant of Applicant's "MACFUDDY" mark in connection with its recited goods is likely to cause confusion, mistake, or deception in violation of 15 U.S.C. § 1052(d).

14. Issuance of a registration to Applicant for its "MACFUDDY" mark would also diminish the distinctive quality of Opposer's rights in its famous "McDONALD'S," "BIG MAC," and "Mc" and "Mac" family of marks and would blur and otherwise impair the distinctiveness of this family of marks, in violation of 15 U.S.C. § 1125(c).

15. If a registration is issued to Applicant for Applicant's "MACFUDDY" mark, the confusion with Opposer's marks would result in damage and injury to Opposer and the public. Registration of this term 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; to tarnish McDonald's good name by offering products not subject to McDonald's quality controls; and to restrict the natural growth of McDonald's "Mc" and "Mac" family of marks.

WHEREFORE, Opposer requests that this Opposition be sustained and Application Serial No. 85/242,703 be refused registration.

Please charge the fee of \$300 and any additional fees related to this matter to Deposit Account No. 502261.

Respectfully submitted,

McDONALD'S CORPORATION

Date: October 19, 2011

By: /s/John A. Cullis/

Robert E. Browne
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CERTIFICATE OF SERVICE

I, John A. Cullis, state that I served a copy of the foregoing, **NOTICE OF OPPOSITION**, upon Correspondent for Application Serial No. 85/242,703 as listed with the USPTO:

Orca Beverage, Inc.
11903 Cyrus Way, Suite 5
Mukilteo, Washington 98275

via First Class Mail in accordance with Trademark Rule §§ 2.201 and 2.119 and via e-mail on this 19th day of October, 2011.

s/John A. Cullis/
John A. Cullis

NGEDOCS: 1847247.2