

ESTTA Tracking number: **ESTTA511322**

Filing date: **12/17/2012**

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	12/16/2012
Address	One McDonald's Plaza Oak Brook, IL 60523 UNITED STATES

Attorney information	John A. Cullis Neal, Gerber & Eisenberg LLP Two North LaSalle Street, Suite 1700 Chicago, IL 60602 UNITED STATES rbrowne@ngelaw.com, jcullis@ngelaw.com, ljames@ngelaw.com, jcohen@ngelaw.com, afuelleman@ngelaw.com, mbenson@ngelaw.com Phone:312-269-8000
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### Applicant Information

Application No	85595001	Publication date	06/19/2012
Opposition Filing Date	12/17/2012	Opposition Period Ends	12/16/2012
Applicant	JOHN MABEN RARE COINS, INC. 5565 BROADCAST COURT SARASOTA, FL 34240 UNITED STATES		

### Goods/Services Affected by Opposition

Class 035. First Use: 2011/09/21 First Use In Commerce: 2011/09/21 All goods and services in the class are opposed, namely: Direct response retail services by means of webcast television infomercials offering products in the field of numismatics, namely, collectible modern coins
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### Applicant Information

Application No	85531108	Publication date	07/10/2012
Opposition Filing Date	12/17/2012	Opposition Period Ends	
Applicant	JOHN MABEN RARE COINS, INC. 5565 Broadcast Court Sarasota, FL 34240 UNITED STATES		

## Goods/Services Affected by Opposition

Class 035. First Use: 2011/09/21 First Use In Commerce: 2011/09/21 All goods and services in the class are opposed, namely: Direct response retail services by means of webcast television infomercials offering products in the field of numismatics, namely, collectible modern coins
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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.	743572	Application Date	05/04/1961
Registration Date	01/08/1963	Foreign Priority Date	NONE
Word Mark	MCDONALD'S		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class U100 (International Class 042). First use: First Use: 1948/12/00 First Use In Commerce: 1953/05/06 Drive-In Restaurant Services		

U.S. Registration No.	939100	Application Date	07/22/1971
Registration Date	07/25/1972	Foreign Priority Date	NONE
Word Mark	MCDONALDLAND		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class U100 (International Class 042). First use: First Use: 1971/01/01 First Use In Commerce: 1971/01/01 RESTAURANT SERVICES		

U.S. Registration No.	1266500	Application Date	06/21/1982
Registration Date	02/07/1984	Foreign Priority Date	NONE
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
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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.	1577119	Application Date	06/22/1989
Registration Date	01/09/1990	Foreign Priority Date	NONE
Word Mark	MCFAX		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1988/12/03 First Use In Commerce: 1989/02/01 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

U.S. Registration No.	2056279	Application Date	09/28/1995
Registration Date	04/22/1997	Foreign Priority Date	NONE
Word Mark	MCDIRECT SHARES		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 1995/11/06 First Use In Commerce: 1995/11/06 financial services, namely providing a direct company stock purchase plan		

U.S. Registration No.	2678444	Application Date	12/11/1998
Registration Date	01/21/2003	Foreign Priority Date	NONE
Word Mark	MCSCHOLAR		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 1997/01/31 First Use In Commerce: 1997/01/31 Educational services namely providing educational scholarships		

U.S. Registration No.	2684782	Application Date	09/12/2001
Registration Date	02/04/2003	Foreign Priority Date	NONE
Word Mark	MCTEACHER'S NIGHT		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 2001/11/15 First Use In Commerce: 2001/11/15 CHARITABLE FUNDRAISING		

U.S. Registration No.	3151707	Application Date	05/12/2004
Registration Date	10/03/2006	Foreign Priority Date	NONE
Word Mark	MCGRIDDLES		

Design Mark	<b>MCGRIDDLES</b>
Description of Mark	NONE
Goods/Services	Class 030. First use: First Use: 2000/10/31 First Use In Commerce: 2000/10/31 HOT CAKES

U.S. Registration No.	3407069	Application Date	03/16/2006
Registration Date	04/01/2008	Foreign Priority Date	NONE
Word Mark	MCSKILLET		
Design Mark	<b>MCSKILLET</b>		
Description of Mark	NONE		
Goods/Services	Class 029. First use: First Use: 2006/04/13 First Use In Commerce: 2006/04/13 BREAKFAST ENTREES CONSISTING OF EGGS, MEAT, CHEESE AND VEGETABLES		

U.S. Registration No.	3696916	Application Date	10/14/2008
Registration Date	10/13/2009	Foreign Priority Date	NONE
Word Mark	MCWORLD		

Design Mark	<b>McWORLD</b>		
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 2008/07/03 First Use In Commerce: 2008/07/03 ENTERTAINMENT SERVICES, NAMELY, PROVIDING A WEBSITE FOR INTERACTIVE ONLINE GAMES FOR CHILDREN		

U.S. Registration No.	4129420	Application Date	11/10/2010
Registration Date	04/17/2012	Foreign Priority Date	NONE

Word Mark	MCBITES		
Design Mark	<b>MCBITES</b>		
Description of Mark	NONE		
Goods/Services	Class 029. First use: First Use: 2011/10/31 First Use In Commerce: 2011/10/31 MEAT, PORK, PROCESSED FISH AND POULTRY		

Attachments	72398083#TMSN.gif ( 1 page )( bytes ) 78417184#TMSN.jpeg ( 1 page )( bytes ) 78839012#TMSN.jpeg ( 1 page )( bytes ) 77592451#TMSN.jpeg ( 1 page )( bytes ) 85173863#TMSN.jpeg ( 1 page )( bytes ) Consolidated_Notice_of_Opposition_MCTV.pdf ( 8 pages )(22428 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	12/17/2012

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

In the Matter of Application Serial Nos.:  
85/595,001 for MCTV (and Design)  
85/531,108 for MCTV

Published in the Official Gazette  
on June 19, 2012 and July 10, 2012

McDONALD'S CORPORATION,

Opposer,

v.

JOHN MABEN RARE COINS, INC.,

Applicant.

**CONSOLIDATED 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 marks MCTV (and Design) and MCTV in International Class 35, as shown in Application Serial Nos. 85/595,001 and 85/531,108 (collectively the "MCTV Marks"), filed by Applicant, John Maben Rare Coins, Inc., a company organized under the laws of the State of Florida and having a place of business at 5565 Broadcast Court, Sarasota, Florida 34240, and hereby opposes the same and requests that registrations to Applicant be refused.

The grounds for this Consolidated Notice Opposition herein are as follows:

1. Applicant seeks to register the MCTV Marks for "direct response retail services by means of webcast television infomercials offering products in the field of numismatics,

namely, collectible modern coins” in International Class 35. The applications are use-based applications filed under 15 U.S.C. § 1051(a).

2. Opposer has obtained the necessary extension of time within 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 a limited menu of high quality, 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, breakfast foods, specialty sandwiches, dessert products, chicken sandwiches, poultry products and beverages. Opposer has also used its “Mc” formative marks on a wide variety of goods that are not related to food products or restaurant services, including, but not limited to: chemical preparations; computer services; men’s, women’s and children’s clothing; barbershop services; mail order services; charitable services; recycling services; travel services; and concentrated cleaners.

4. 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.

5. Beginning with its world-famous “McDONALD’S” trademark, Opposer has used or licensed the use of numerous trademarks and service marks in connection with a wide variety of goods and services over the past 50 years. In connection with this business, Opposer has built

an extensive family of “Mc” formative trademarks formed by the distinctive “Mc” prefix with various generic and descriptive terms.

6. Opposer’s extensive nationwide advertising and promotion of its various goods and services under its family of “Mc” formative marks features the use of television and print advertising, radio, newspaper and magazine advertising, outdoor billboard and signage, Internet advertising, mobile advertising and direct mail, which are directed to and reach the public in both local and nationwide markets. In addition, Opposer uses the “Mc” formative family of marks on food product packaging and point-of-purchase advertising, and has used the “Mc” formative family of marks for a wide variety of other goods and services.

7. Opposer also owns a federal registration for “Mc,” Registration No. 1,947,099, issued on January 9, 1996, for restaurant services. The following is a partial list of federal registrations owned by McDonald’s:

<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. McDONALDLAND	939,100	07/25/1972	Restaurant services
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 premises
5. McMUFFIN	1,485,633	04/19/1988	Restaurant Services
6. McNUGGETS	1,450,104	07/28/1987	Restaurant Services
7. McFAX	1,577,119	01/09/1990	Restaurant Services
8. Mc	1,947,099	01/09/1996	Restaurant services

<u>MARK NAME</u>	<u>REG. NO.</u>	<u>REG. DATE</u>	<u>GOODS/SERVICES</u>
9. McDIRECT SHARES	2,056,279	09/28/1995	Financial services, namely providing a direct company stock purchase plan
10. McSCHOLAR	2,678,444	01/21/2003	Educational services, namely providing educational scholarships
11. McTEACHER'S NIGHT	2,684,782	02/04/2003	Charitable fundraising
12. McGRIDDLES	3,151,707	10/03/2006	Hot cakes
13. McSKILLET	3,407,069	04/01/2008	Breakfast entrees consisting of eggs, meat, cheese and vegetables
14. McWORLD	3,696,916	10/13/2009	Entertainment services, namely providing a website for interactive online games for children.
15. McBITES	4,129,420	04/17/2012	Meat, pork, processed fish and poultry.

These registrations are valid, subsisting, and in full force and effect.

8. 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. In addition, McDonald's Corporation owns numerous other federal registrations of "Mc" formative marks for a variety of goods and services.

9. Through Opposer's extensive and continuous use of the name McDONALD'S and its "Mc" formative marks, the public has come to recognize marks combining the "Mc" prefix with a common word for a wide variety of goods and services as being 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. Opposer's "Mc" family of marks is famous and was 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 the name McDONALD'S and its "Mc" family of marks for restaurant services, food products, and a wide variety of other goods and services, Applicant filed its application to register the MCTV Marks in connection with "direct response retail services by means of webcast television infomercials offering products in the field of numismatics, namely, collectible modern coins" in International Class 35, which applications were assigned Serial Nos. 85/595,001 and 85/531,108, respectively. Moreover, in light of Opposer's widespread advertising and promotion of its "Mc" formative marks,

Applicant's selection of marks, which incorporate the "Mc" prefix suggests that Applicant intends to trade off the goodwill and recognition associated with Opposer's "Mc" family of marks.

12. The marks proposed for registration by Applicant have as their principal distinctive element the "Mc" prefix. Potential purchasers, upon seeing the dominant formative "Mc" in Applicant's MCTV Marks are likely to mistakenly believe that such terms and the services offered thereunder originated with or are connected with, sponsored or associated by, or licensed or approved by Opposer. Thus, the registration and use by Applicant of the MCTV Marks in connection with its services, 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. § 1052(d).

13. Issuance of a registration to Applicant would diminish and dilute the distinctive quality of McDonald's rights in its famous "Mc" formative family of marks and could in the event of any mishaps involving, or poor quality of, the services offered by Applicant, tarnish such distinctiveness, in violation of 15 U.S.C. § 1125(c).

14. If registrations are issued to Applicant for the MCTV Marks, the confusion with Opposer's marks would result in damage and injury to Opposer and the public. Registration of the "MCTV" 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; 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.

WHEREFORE, Opposer requests that this Consolidated Opposition be sustained and Application Serial Nos. 85/595,001 and 85/531,108 be refused registration.

Opposer requests that the requisite filing fee of \$600.00 and any additional fees related to this matter be charged to the deposit account of Neal, Gerber & Eisenberg, Account No. 502261.

Respectfully submitted,

McDONALD'S CORPORATION

Date: December 17, 2012

By:                     /John A. Cullis/                    

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John A. Cullis  
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**CERTIFICATE OF TRANSMISSION**

I hereby certify that the foregoing **NOTICE OF OPPOSITION** is being electronically transmitted via the Electronic System for Trademark Trials and Appeals (“ESTTA”) at <http://estta.uspto.gov/> on the date noted below:

Date: December 17, 2012

By: /John A. Cullis/  
One of the Attorneys for Opposer,  
McDonald’s Corporation

**CERTIFICATE OF SERVICE**

I hereby certify that I served a copy of the foregoing **NOTICE OF OPPOSITION** upon Applicant’s counsel:

Matthew R. Jenkins  
Jacox, Meckstroth & Jenkins  
1205 Manatee Avenue West  
Bradenton, Florida 34205-7517

by depositing said copy in a properly addressed envelope, First Class postage prepaid, and depositing same in the United States mail at Two North LaSalle Street, Chicago, Illinois, on the date noted below:

Date: December 17, 2012

By: /John A. Cullis/  
One of the Attorneys for Opposer,  
McDonald’s Corporation