

ESTTA Tracking number: **ESTTA564518**

Filing date: **10/11/2013**

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		
Entity	Corporation	Citizenship	Delaware
Address	One McDonald's Plaza Oak Brook, IL 60523 UNITED STATES		

Attorney information	Michael G. Kelber & Jessica E. Cohen Neal, Gerber & Eisenberg LLP Two North LaSalle Street Suite 1700 Chicago, IL 60602 UNITED STATES rbrowne@ngelaw.com, mkelber@ngelaw.com, jcohen@ngelaw.com, mbenson@ngelaw.com, DocketMail@ngelaw.com Phone:312-269-8000
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Applicant Information

Application No	85877499	Publication date	10/01/2013
Opposition Filing Date	10/11/2013	Opposition Period Ends	10/31/2013
Applicant	Donnenfeld, Gregg 6 Wren Drive Roslyn, NY 11576 UNITED STATES		

Goods/Services Affected by Opposition

Class 030. All goods and services in the class are opposed, namely: Breakfast sandwiches

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Other	Applicant, at the time of filing the application, lacked a bona fide intent to use the mark with the claimed goods.

Mark Cited by Opposer as Basis for Opposition

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	EGG WHITE DELIGHT McMUFFIN		
Goods/Services	breakfast sandwich		

Attachments	Notice_of_Opposition_EGG_WHITE_DELIGHT.pdf(18312 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	/Jessica E. Cohen/
Name	Jessica E. Cohen
Date	10/11/2013

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

In the Matter of:
Application Serial No. 85/877,499
Published in the *Official Gazette*
October 1, 2013

McDONALD’S CORPORATION,)	
)	Mark: EGG WHITE DELIGHT
Opposer,)	
)	
v.)	Opposition No. _____
)	
GREGG DONNENFELD,)	
)	
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 “EGG WHITE DELIGHT” in International Class 30, as shown in Application Serial No. 85/877,499 filed by Applicant, Gregg Donnenfeld (“Applicant”), having an address of 6 Wren Drive, Roslyn, New York 11576 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 “EGG WHITE DELIGHT” for use in connection with “breakfast sandwiches” in International Class 30. The application is an intent-to-use based application filed under 15 U.S.C. § 1051(b).

2. 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.

3. In connection with this business, Opposer has, for decades, extensively promoted and sold a wide variety of food products and restaurant services. For instance, Opposer has used its world famous “EGG McMUFFIN” trademark in connection with breakfast sandwiches continuously for over forty years. During that time, Opposer has expanded to include a wide variety of goods and services, including food products such as chicken, specialty sandwiches, breakfast items, pancakes, baked pastries, and restaurant services, all of which are advertised and promoted throughout the United States.

4. Among its various products is the EGG WHITE DELIGHT McMUFFIN breakfast sandwich, which Opposer began selling in select locations around the country in June 2012. Since that time, Opposer has invested significant time, effort and resources in developing, promoting and providing its EGG WHITE DELIGHT McMUFFIN breakfast sandwich. As a result, the public has come to associate the phrase “EGG WHITE DELIGHT” with Opposer’s EGG WHITE DELIGHT McMUFFIN breakfast sandwich.

5. In building momentum for the national expansion of its EGG WHITE DELIGHT McMUFFIN breakfast sandwich, on March 13, 2013, Opposer attended the 2013 Let’s Eat Speed Media Event at the New York Hilton Hotel in New York City. The Let’s Eat Speed Media Event, hosted by New Product Events, provided a platform for companies to introduce new products to the media. There, McDonald’s announced the impending national expansion of its EGG WHITE DELIGHT McMUFFIN breakfast sandwich to representatives from People

Magazine, Cosmopolitan Magazine, Good Housekeeping Magazine, Scholastic Parent & Child, Food Network, Food Network Magazine, Every Day with Rachel Ray, Beauty and the Feast, The Daily Meal, Access Hollywood, Working Mother, Men's Health, Bon Appetit, Katie, iVillage, Sirius XM radio, Energy Times, Family Circle, Epicurious.com, The Nibble, Essence, Gifts.com, and Real Simple Magazine. At 11:59 AM on March 13, 2013, while the Let's Eat Speed Media Event was still underway, The Daily Meal posted an article entitled "McDonald's Rolling Out Egg White Delight McMuffin Nationwide April 22" covering Opposer's announcement. Within mere hours, CBS News, the Chicago Tribune, Fox News, The Huffington Post, Bloomberg, Consumerist, Zagat, Today Food, Newser and Topix picked up and posted stories reporting on McDonald's national expansion of its EGG WHITE DELIGHT McMUFFIN breakfast sandwich.

6. Between March 13, 2013 and March 15, 2013 alone, more than 50 media sources publicized Opposer's announcement of the national launch of its EGG WHITE DELIGHT McMUFFIN breakfast sandwich. Popular New York media outlets featured prominently among these, including headlines in the New York Post, the Gothamist and the Today Show. Opposer's EGG WHITE DELIGHT McMUFFIN breakfast sandwiches have since garnered tremendous media attention and acclaim. Accordingly, Opposer has developed considerable consumer recognition and goodwill in its EGG WHITE DELIGHT McMUFFIN mark, and the EGG WHITE DELIGHT McMUFFIN mark is now among Opposer's most valuable assets.

7. Applicant is a New York resident, who serves as general counsel for Marc Ecko Enterprises, a position he has held continuously since August 2004. Upon information and belief, Marc Ecko Enterprises is a billion-dollar global fashion company, which is one of the largest brands in urban streetwear. The headquarters of Mark Ecko Enterprises are located at 40 West 23rd Street in New York City, approximately two miles from the New York Hilton.

8. Applicant is also an experienced trademark attorney, who is listed as the attorney of record for more than 150 trademark registrations and pending applications filed by Marc Ecko Enterprises, or its affiliates, in the U.S. Patent & Trademark Office.

9. Despite Opposer's use of and prior rights in its EGG WHITE DELIGHT McMUFFIN mark, Applicant filed its application on or about Friday, March 15, 2013 — just two days after Opposer nationally announced the official expansion to all McDonald's restaurants of its EGG WHITE DELIGHT McMUFFIN breakfast sandwich — to register "EGG WHITE DELIGHT" as a trademark based on his alleged intent to use the mark in connection with breakfast sandwiches.

10. Upon information and belief, Applicant has no connection with the restaurant or food industries. Nor has Applicant, upon information and belief, taken any public steps to manifest an intent to use the mark in connection with breakfast sandwiches. Accordingly, upon information and belief, Applicant, at the time of filing the subject application, lacked a *bona fide* intent to use "EGG WHITE DELIGHT" in connection with breakfast sandwiches.

11. In light of Opposer's widespread advertising, promotion and resulting recognition in its EGG WHITE DELIGHT McMUFFIN mark, Applicant's selection of a phrase nearly identical to and confusingly similar to Opposer's pre-existing EGG WHITE DELIGHT McMUFFIN mark — for the goods that Opposer is renowned for, namely, breakfast sandwiches — suggests that Applicant intends to trade off the goodwill and recognition associated with Opposer's EGG WHITE DELIGHT McMUFFIN mark. Indeed, the timing of Applicant's filing further suggests that the subject application was not filed in good faith.

12. But even if Applicant actually had a *bona fide* intent to use the "EGG WHITE DELIGHT" mark at the time he filed his application, his use of "EGG WHITE DELIGHT" in

connection with breakfast sandwiches would likely cause potential purchasers to mistakenly believe that such a term and the goods 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 “EGG WHITE DELIGHT” in connection with its recited goods is likely to cause confusion, mistake, or deception in violation of 15 U.S.C. § 1052(d).

13. If a registration is issued to Applicant for Applicant’s “EGG WHITE DELIGHT” 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; and to benefit from the likely confusion among purchasers led to believe that Applicant’s breakfast sandwiches are related in some fashion to Opposer.

WHEREFORE, Opposer requests that this Opposition be sustained and Application Serial No. 85/877,499 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 11, 2013

By: /s/Michael G. Kelber/

Michael G. Kelber
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CERTIFICATE OF SERVICE

I, Jessica E. Cohen, state that I served a copy of the foregoing, **NOTICE OF OPPOSITION**, upon Correspondent for Application Serial No. 85/877,499 as listed with the USPTO:

Gregg Donnenfeld
6 Wren Drive
Roslyn, New York 11576-2722

via First Class Mail in accordance with Trademark Rule §§ 2.201 and 2.119 and via e-mail on October 11, 2013.

s/Jessica E. Cohen/
Jessica E. Cohen