

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

BUO

Mailed: January 24, 2014

Opposition No. 91212931

McDonald's Corporation

v.

Gregg Donnenfeld

**Benjamin U. Okeke, Interlocutory Attorney:**

Pursuant to Fed. R. Civ. P. 26(f) and Trademark Rules 2.120(a)(1) and (2), the parties to this proceeding conducted a discovery conference by telephone on January 14, 2014. Opposer, by telephone call placed December 19, 2013, requested Board participation in the conference. Participating in the conference were applicant, Gregg Donnenfeld, appearing *pro se*,<sup>1</sup> opposer's counsel, Michael G. Kelber and Jessica R. Cohen, and Board interlocutory attorney, Benjamin U. Okeke.

The Board advised Mr. Donnenfeld that despite his experience, parties would be well-advised to retain a

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<sup>1</sup> Applicant is again encouraged to seek counsel. If counsel is retained by applicant an appearance should promptly be filed with the Board, indicating the new correspondence information for applicant's retained counsel.

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trademark practitioner to represent them in Board proceedings. Applicant will be expected to comply with all applicable rules and procedures, including those relating to service of papers, as set forth in Trademark Rule 2.119, regardless of whether applicant retains counsel.<sup>2</sup>

The parties indicated that there is no other pending litigation between them, or any third parties, concerning these marks in federal court or before the Board. The parties had yet to engage in substantive settlement talks.

***Standard Protective Order***

The Board reminded the parties of the automatic imposition of the Board's standard protective order in this case. Trademark Rule 2.116(g). The standard protective order is online at: <http://www.uspto.gov/trademarks/process/appeal/guidelines/stndagmnt.jsp>.

The Board also reminded the parties of the unique issue raised by confidential documents designated "for attorney's eyes only" in a proceeding involving a *pro se* defendant: if applicant represents himself, he may be precluded from receipt of discovery documents so designated. At the same time, the parties were cautioned that designation of any confidential documents should be in

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<sup>2</sup> Information for parties representing themselves is provided at the end of this order.

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good faith, and only when necessary to protect confidential matter.

If the parties wish to add or modify any provisions of the standard protective order, they may negotiate an amended protective agreement, subject to Board approval.

***Pleadings***

The Board reviewed the pleadings with the parties:

**A. Notice of Opposition**

McDonald's Corporation ("opposer"), opposes registration of the mark EGG WHITE DELIGHT, in Application Serial No. 85877499, filed by Gregg Donnenfeld ("applicant"), for use in connection with "[b]reakfast sandwiches."<sup>3</sup>

Opposer has asserted likelihood of confusion and lack of a bona fide intent to use the mark as its grounds for opposition.

• *Standing*

Opposer has sufficiently pleaded its standing to bring this action by pleading prior use of the mark EGG WHITE DELIGHT MCMUFFIN for use with goods and services that are alleged to overlap with those identified in the subject application.

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<sup>3</sup> Filed March 15, 2013, on an intent-to-use filing basis under Section 1(b) of the Trademark Act.

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Opposer may establish a reasonable belief of damage by asserting proprietary rights and current ownership of a mark that is the same or similar to the applied for mark. *See Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40 (CCPA 1981) (plaintiff may show standing based on common law rights in mark that is distinctive, inherently or otherwise); *Wet Seal Inc. v. FD Mgmt. Inc.*, 82 USPQ2d 1629, 1634 (TTAB 2007) (standing based on common law use of mark).

Through these allegations, opposer has adequately pleaded a real interest in the outcome of this proceeding and has therefore pleaded its standing to bring this opposition.

- *Priority*

In addition, the notice of opposition alleges that opposer's use of the mark EGG WHITE DELIGHT MCMUFFIN dates back to June of 2012. Notice of Opposition, ¶ 4. Opposer's allegation of use dating back to June 2012 would, if proven, give opposer priority of use with regard to applicant's constructive use date of March 15, 2013, its application filing date. This is the earliest date upon which applicant could rely without proof by "competent evidence" of an earlier date of actual use. See Trademark Rule 2.122(b)(2) (the date of use in an application is not

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evidence on behalf of the applicant; "a date of use of a mark must be established by competent evidence"); *see also* *Coach Servs. Inc. v. Triumph Learning LLC*, 96 USPQ2d 1600, 1606 n.7 (TTAB 2010).

Therefore, opposer alleges a plausible claim to priority.

- *Likelihood of Confusion*

Paragraphs 11 and 12 of the notice of opposition allege sufficient facts that if proven would entitle opposer to the relief that it seeks under Trademark Act Section 2(d), 15 U.S.C. § 1052(d). That is, opposer has alleged the similarity of the applied-for mark with its registered pleaded marks and the relatedness of the goods and services covered by those marks.

Inasmuch as opposer has alleged that registration of applicant's mark is likely to cause confusion, opposer's claim of likelihood of confusion is sufficiently pleaded.<sup>4</sup>

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<sup>4</sup> To state a claim of likelihood of confusion under Trademark Act Section 2(d), opposer must merely allege facts from which it may be inferred that applicant's applied-for mark so resembles opposer's previously used or registered marks that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the services of the applicant and opposer. *See* 15 U.S.C. § 1052(d); *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973); *see also* TMEP § 1207.01.

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- *Lack of Bona Fide Intent to Use*

Section 1(b) of the Trademark Act, 15 U.S.C.

§ 1051(b), states that:

A person who has a bona fide intention, under circumstances showing the good faith of such person, to use a trademark in commerce may request registration of its trademark on the principal register hereby established by paying the prescribed fee and filing in the Patent and Trademark Office an application and a verified statement, in such form as may be prescribed by the Director.

Opposer's pleading, specifically, paragraphs 10 and 11 allege facts sufficient to give applicant fair notice of the underpinnings of opposer's assertion that applicant lacked a bona fide intent to use its mark in commerce under Trademark Act Section 1(b). See Fed. R. Civ. P. 8. See also Trademark Rule 2.104(a); *Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536 (TTAB 2007).<sup>5</sup>

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<sup>5</sup> "A determination of whether an applicant has a bona fide intention to use a mark in commerce is an objective determination based on all the circumstances." *Boston Red Sox v. Sherman*, 88 USPQ2d 1581, 1586 (TTAB 2008), citing *Lane Ltd. v. Jackson Intl. Trading Co.*, 33 USPQ2d 1351, 1355 (TTAB 1994). "Opposer has the initial burden of demonstrating by a preponderance of the evidence that applicant lacked a bona fide intent to use the mark on the identified goods." *Boston Red Sox*, 88 USPQ2d at 1587, citing *Commodore Elecs. Ltd. v. CBM Kabushiki Kaisha Opp.*, 26 USPQ2d 1503, 1507 (TTAB 1993). If an opposer establishes a *prima facie* case, the burden shifts to applicant to rebut that *prima facie* case by producing evidence which would establish that it had the requisite bona fide intent to use the mark when it filed its application. *Commodore Elecs.*, 26 USPQ2d at 1507.

**B. Answer**

In its answer, applicant denied the salient allegations of the notice of opposition. Additionally, applicant asserted five "affirmative defenses" to the opposition, labeled paragraphs 14-18.

Affirmative defenses, like claims in a notice of opposition, must be supported by enough factual background and detail to fairly place the opposer on notice of the basis for the defenses. See *IdeasOne Inc. v. Nationwide Better Health Inc.*, 89 USPQ2d 1952, 1953 (TTAB 2009); *Ohio State Univ. v. Ohio Univ.*, 51 USPQ2d 1289, 1292 (TTAB 1999) (primary purpose of pleadings "is to give fair notice of the claims or defenses asserted"). A party must allege sufficient facts beyond a tender of 'naked assertion[s]' devoid of 'further factual enhancement,' to support its claims. Cf. *Ashcroft v. Iqbal*, 556 U.S. 662, 663 (2009), quoting *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 570 (2007).

Applicant's first, second, and third "affirmative defenses," paragraphs 14-16, asserting that applicant has priority of rights in the disputed mark, and that opposer's status does not exempt it from the use requirement of the Trademark Act, are not actual affirmative defenses, but are merely amplifications of applicant's denials, and provide

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fuller notice of how applicant intends to defend this opposition. See *Ohio State Univ.*, 51 USPQ2d at 1292. While these are not appropriate affirmative defenses, the Board does not find it necessary to strike this language from the Answer.

Applicant's fourth "affirmative defense" asserts that "to the extent Opposer acquired any right in the EGG WHITE DELIGHT mark ... Opposer had abandoned such rights prior to the date of Applicant's intent-to-use filing." Answer, ¶ 17. To the extent this is merely an attack on opposer's likelihood of confusion claim, i.e. opposer has not maintained continuous use of its pleaded mark, this is also not an appropriate affirmative defense, but again an amplification of applicant's defense against the Section 2(d) claim. *Id.* In this event, the language will be treated as such and not stricken from the answer.

However, if applicant intended this contention to act as a separate claim of abandonment, it has failed to plead sufficient facts to support its claim. In the event applicant intended that this language be construed as a distinct affirmative defense, applicant is allowed **FIFTEEN DAYS** from the mailing date of this order to replead its answer to assert sufficient facts to support its claim of abandonment.

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Finally, applicant's fifth "affirmative defense" asserts that "to the extent Opposer acquired rights in the EGG WHITE DELIGHT mark in one or more limited geographic parts of the United States ... then Applicant's application should proceed to registration with respect to all other parts." Answer, ¶ 18. However, geographic limitations will be considered and determined by the Board only in the context of a concurrent use proceeding. See Trademark Rule 2.133(c); *Jansen Enter. Inc. v. Rind*, 85 USPQ2d 1104, 1106 n.3 (TTAB 2007) (counterclaim for partial cancellation by limiting geographic area denied); *Snuffer & Watkins Mgmt. Inc. v. Snuffy's Inc.*, 17 USPQ2d 1815, 1815 (TTAB 1990) (allegations of abandonment in a particular geographic location constitute an insufficient pleading).

Accordingly, applicant's fifth "affirmative defense" is **STRICKEN** and will be given no further consideration.<sup>6</sup>

***Stipulations/Filings***

The parties agreed only to service of courtesy copies of submissions by email at this point. The following email addresses are of record:

Courtesy copies should be served on opposer at the following email addresses:

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<sup>6</sup> These findings and determinations render opposer's motion, filed November 27, 2013, to strike applicant's affirmative defenses **MOOT**.

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rbrowne@ngelaw.com, mkelber@ngelaw.com,  
jcohen@ngelaw.com, mbenson@ngelaw.com,  
DocketMail@ngelaw.com.

Courtesy copies should be served on applicant at the following email address:

greggdonnenfeld@gmail.com.

The parties are urged to file all submissions through the Board's Electronic System for Trademark Trials and Appeals (ESTTA), available online at:  
<http://estta.uspto.gov>.

Throughout this proceeding, the parties should review the Trademark Rules of Practice and the Trademark Board Manual of Procedure ("TBMP"), online at:  
<http://www.uspto.gov/trademarks/process/appeal/index.jsp>.

The Board expects all parties appearing before it to comply with the Trademark Rules of Practice and where applicable, the Federal Rules of Civil Procedure, online at: <http://www.law.cornell.edu/rules/frcp/>.

***Accelerated Case Resolution (ACR)***

In view of the issues presented in this opposition, the Board believes this case is well-suited for resolution by accelerated case resolution (ACR). The parties indicated some interest in pursuing ACR. The Board encourages the parties to discuss a modified proceeding and schedule that may be more time and cost efficient for the

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parties. In modifying the proceeding the parties may seek to: 1) stipulate to facts, e.g. the relatedness of the goods; 2) limit the number of interrogatories, document requests, and depositions allowed during the proceeding; 3) stipulate that discovery depositions may be taken by telephone or video conference; 4) stipulate that the parties may submit declarations or affidavits in lieu of oral testimony at trial; or 5) stipulate that the parties forego trial and oral hearing and submit summary judgment briefs accompanied by any evidence, which may be submitted in the form of declarations or affidavits and stipulate that the Board may resolve any genuine disputes of material fact and issue a final ruling based on the parties' ACR submissions.

The parties are directed to review the Board's website regarding ACR at:  
[http://www.uspto.gov/trademarks/process/appeal/TTAB\\_ACR\\_Options.jsp](http://www.uspto.gov/trademarks/process/appeal/TTAB_ACR_Options.jsp); and [http://www.uspto.gov/trademarks/process/appeal/Accelerated\\_Case\\_Resolution\\_\\_ACR\\_\\_notice\\_from\\_TTAB\\_webpage\\_12\\_22\\_11.pdf](http://www.uspto.gov/trademarks/process/appeal/Accelerated_Case_Resolution__ACR__notice_from_TTAB_webpage_12_22_11.pdf).

If the parties agree to pursue ACR after exchange of disclosures or discovery (or wish to further discuss their options), they should notify the interlocutory attorney,

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preferably within **SIXTY DAYS** from the opening of the discovery period.

***Contested Motions***

The parties are reminded that uncooperative behavior during the discovery process will not be well-taken. See *HighBeam Mktg. LLC v. Highbeam Research LLC*, 85 USPQ2d 1902 (TTAB 2008); *Sunrider Corp. v. Raats*, 83 USPQ2d 1648, 1654 (TTAB 2007) (parties have a duty to cooperate in resolving discovery issues). The Board requires the parties to make a good-faith effort to resolve all discovery issues prior to filing a motion to compel seeking relief from the Board. See TBMP § 408.01(c).

Similarly, the parties should confer before filing any motion to extend or suspend these proceedings. If either party files an unconsented motion to extend or suspend in this case, **the moving party must contact the Board interlocutory attorney assigned to the case by telephone** upon filing so that such motion can be resolved promptly by telephone conference.

***Schedule***

The parties are reminded that the next significant due date is **February 14, 2014**, when the parties' initial disclosures are due. See Fed. R. Civ. P. 26(a)(1)(A)(i) and (ii) regarding required initial disclosures. Neither

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the service of discovery requests nor the filing of a motion for summary judgment (except on the basis of *res judicata* or lack of Board jurisdiction) should occur until the parties have exchanged their initial disclosures as required by Fed. R. Civ. P. 26(f). See Trademark Rules 2.120(a)(3) and 2.127(e)(1).

The Board again thanks the parties for their participation in the conference. As a final matter, the Board reminds the parties of their duty to conduct themselves with decorum and courtesy and encourages open communication between the parties during this proceeding. Trademark Rule 2.192; *MySpace Inc. v. Mitchell*, 91 USPQ2d 1060, 1062 n.4 (TTAB 2009).

The proceeding is resumed and disclosure, discovery, and trial dates are reset as follows:

Initial Disclosures Due	2/14/2014
Expert Disclosures Due	6/14/2014
Discovery Closes	7/14/2014
Plaintiff's Pretrial Disclosures	8/28/2014
Plaintiff's 30-day Trial Period Ends	10/12/2014
Defendant's Pretrial Disclosures	10/27/2014
Defendant's 30-day Trial Period Ends	12/11/2014
Plaintiff's Rebuttal Disclosures	12/26/2014
Plaintiff's 15-day Rebuttal Period Ends	1/25/2015

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days

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after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

***PRO SE INFORMATION***

A. Representation

The Board notes that applicant currently represents himself *pro se*, i.e. without assistance from a licensed attorney. It should be noted that, while Patent and Trademark Rule 11.14 permits any party to represent itself, it is advisable for a person who is not acquainted with the technicalities of the procedural and substantive law involved in an opposition proceeding to secure the services of an attorney who is familiar with such matters. The Patent and Trademark Office **cannot aid in the selection of an attorney**. In addition, as the impartial decision maker, the Board may not provide legal advice, though it may provide general procedural information.

B. Nature of Board Proceedings

An opposition proceeding before the Board is similar in many ways to a civil action in a Federal district court. There are pleadings (notice of opposition, answers, and, sometimes, a counterclaim), a wide range of possible

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motions; discovery (a party's use of discovery depositions, interrogatories, requests for production of documents and things, and requests for admission to ascertain the facts underlying its adversary's case), a trial, and briefs, followed by a decision on the case. Unlike the case in a civil proceeding, the Board does not preside at the taking of testimony. Rather, all testimony is taken by deposition during the assigned testimony, or trial periods, and the written transcripts, together with any exhibits, are then filed with the Board. No paper, document, or exhibit will be considered as evidence in the case unless it has been introduced in evidence in accordance with the applicable rules.

C. Electronic Resources

All parties may refer to the Trademark Trial and Appeal Board Manual of Procedure ("TBMP"), the Trademark Act, and the Trademark Rules of Practice, all available on the USPTO website, [www.uspto.gov](http://www.uspto.gov). The TTAB homepage provides electronic access to the Board's standard protective order, and answers to frequently asked questions. Other useful resources include the ESTTA filing

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system<sup>7</sup> for Board filings and TTABVUE for status and prosecution history.

Compliance with the Trademark Rules of Practice, and where applicable the Federal Rules of Civil Procedure, is expected of all parties before the Board, whether or not they are represented by counsel.

D. Service of Papers

Trademark Rule 2.119(a) and (b) require that every paper filed in the Patent and Trademark Office in a proceeding before the Board must be served upon the attorney for the other party, or the other party itself, if unrepresented, and proof of such service must be made before the paper will be considered by the Board. Consequently, copies of all papers which applicant may file in this proceeding must be accompanied by a signed statement indicating the date and manner in which such

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<sup>7</sup> Use of electronic filing with ESTTA—as the parties have done so far—is strongly encouraged. This electronic file system operates in real time and provides filers with confirmation that the filing has been received. When papers are filed through ESTTA the papers must still be served on the other party to the proceeding.

If the parties have questions about or need assistance with ESTTA, they may call the Board at (571) 272-8500 or (800) 786-9199 (toll free) from 8:30 a.m. until 5:00 p.m. (EST).

While electronic filing is preferred, papers may also be filed by mail. The parties should refer to TBMP §§ 107-111 for information on filing by mail. If ESTTA filing is not possible for any reason, the filer should submit its papers by mail, with a certificate of mailing. See TBMP § 110 et. seq.

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service was made. The statement, whether attached to or appearing on the paper when filed, will be accepted as *prima facie* proof of service.

The following is an example of an acceptable Certificate of Service:

**Certificate of Service**

The undersigned certifies that a copy of the attached <describe filing> was served, by first class mail, upon opposer at the following address:

Michael G Kelber  
Neal Gerber Eisenberg LLP  
Two North Lasalle Street, STE 1700  
Chicago, IL 60602,

on <insert date>.

/Gregg Donnenfeld/