

ESTTA Tracking number: **ESTTA592938**

Filing date: **03/17/2014**

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	03/16/2014
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, mbenson@ngelaw.com, DocketMail@ngelaw.com Phone:312-269-8000
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### Applicant Information

Application No	85901030	Publication date	09/17/2013
Opposition Filing Date	03/17/2014	Opposition Period Ends	03/16/2014
Applicant	MacFlowers Inc. 529 W. Wellington Ave. #45 Chicago, IL 60657 US		

### Goods/Services Affected by Opposition

Class 031. First Use: 2010/06/25 First Use In Commerce: 2011/03/22  
All goods and services in the class are opposed, namely: Granulate plant seeds

### 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.	1126102	Application Date	04/30/1973
Registration Date	10/16/1979	Foreign Priority Date	NONE
Word Mark	BIG MAC		

Design Mark	<b>BIG MAC</b>
Description of Mark	NONE
Goods/Services	Class 030. First use: First Use: 1957/00/00 First Use In Commerce: 1957/00/00 SANDWICH

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.	3775834	Application Date	12/18/2008
Registration Date	04/13/2010	Foreign Priority Date	NONE
Word Mark	MAC SNACK WRAP		

Design Mark	<b>MAC SNACK WRAP</b>		
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.	1352168	Application Date	05/23/1983
Registration Date	07/30/1985	Foreign Priority Date	NONE
Word Mark	MC DONALD'S		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1968/12/31 First Use In Commerce: 1968/12/31 RESTAURANT SERVICES		

U.S. Registration No.	1426681	Application Date	09/30/1982
Registration Date	01/27/1987	Foreign Priority Date	NONE
Word Mark	MCDONALDS		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 029. First use: First Use: 1948/00/00 First Use In Commerce: 1953/05/00 CHICKEN, HASHBROWN POTATOES, PREPARED EGGS, MILK, FRESH GARDEN SALADS AND PROCESSED INGREDIENTS THEREOF, FOR CONSUMPTION ON OR OFF THE PREMISES</p> <p>Class 030. First use: First Use: 1948/00/00 First Use In Commerce: 1953/05/00 HAMBURGER AND CHEESEBURGER SANDWICHES AND SPECIAL COMBINATION SANDWICHES FEATURING HAMBURGERS AND CHEESEBURGERS, [ ROAST BEEF SANDWICHES, HOT CHOCOLATE, PREPARED CATSUP, COOKIES, ] HOTCAKES, TABLE SYRUP, FRUIT PIES, SPECIAL COMBINATION EGGSANDWICHES, TEA, [ COFFEE, SOFT SERVE ICE CREAM OR ICE CREAM SUBSTITUTE, ICE CREAM OR ICE CREAM</p>		

	SUBSTITUTE SUNDAES, SOFT SERVE ICE MILK, SOFT SERVE ICE MILK SUNDAES, DONUTS, ] PASTRIES, CHICKEN SANDWICHES, PORK SANDWICHES, [ BISCUIT AND HAM SANDWICHES ] AND BISCUIT AND SAUSAGE SANDWICHES FOR CONSUMPTION ON OR OFF THE PREMISES Class 032. First use: First Use: 1948/00/00 First Use In Commerce: 1953/00/00 CARBONATED AND NON-CARBONATED SOFT DRINKS AND FRUIT JUICES FOR CONSUMPTION ON OR OFF THE PREMISES		
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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		

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		
U.S. Registration No.	3151707	Application Date	05/12/2004
Registration Date	10/03/2006	Foreign Priority Date	NONE
Word Mark	MCGRIDDLES		
Design Mark			
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.	2482828	Application Date	06/19/1998
Registration Date	08/28/2001	Foreign Priority Date	NONE
Word Mark	MCCAFE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 2001/05/02 First Use In Commerce: 2001/05/02 restaurant services		
U.S. Registration No.	4129420	Application Date	11/10/2010
Registration Date	04/17/2012	Foreign Priority Date	NONE
Word Mark	MCBITES		

Design Mark	<h1>MCBITES</h1>
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	72456124#TMSN.gif( bytes ) 77636011#TMSN.jpeg( bytes ) 73426936#TMSN.gif( bytes ) 78417184#TMSN.jpeg( bytes ) 85173863#TMSN.jpeg( bytes ) Notice_of_Opposition_MACFLOWERS.pdf(22287 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	03/17/2014

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

In the Matter of:  
Application Serial No. 85/901,030  
Published in the *Official Gazette*  
September 17, 2013

McDONALD’S CORPORATION,	)	
	)	<b>Mark: MACFLOWERS</b>
Opposer,	)	
	)	
v.	)	<b>Opposition No. _____</b>
	)	
MACFLOWERS, 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 “MACFLOWERS” in International Class 31, as shown in Application Serial No. 85/901,030 filed by Applicant, MacFlowers, Inc. (“Applicant”), an Illinois corporation, with offices at 529 W. Wellington Ave., Unit 45, Chicago, Illinois 60657, 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 term “MACFLOWERS” for use in connection with “granulate plant seeds” in International Class 31. The application is a use-based application filed under 15 U.S.C. § 1051(a).

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 and sandwiches, namely hamburgers, continuously for 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, pancakes, baked pastries, and restaurant services, 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, similar or related to those for which Applicant’s “MACFLOWERS” 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.	MAC SNACK WRAP	3,775,834	4/13/2010	Sandwiches made of meat poultry, cheese, vegetables and sauce
5.	McDONALD’S	1,352,168	07/30/1985	Restaurant services
6.	McDONALD’S	1,426,681	01/27/1987	Hamburger and cheeseburger sandwiches and special combination sandwiches featuring hamburgers and cheeseburgers
7.	McDOUBLE	1,266,500	02/07/1984	A sandwich for consumption on or off premises
8.	McRIB	1,315,979	01/22/1985	A sandwich for consumption on or off premises
9.	McMUFFIN	1,485,633	04/19/1988	Restaurant services
10.	McNUGGETS	1,450,104	07/28/1987	Restaurant services
11.	Mc	1,947,099	01/09/1996	Restaurant services
12.	McGRIDDLES	3,151,707	10/03/2006	Hot cakes
13.	McCAFE	2,482,828	08/28/2001	Restaurant services

<u>MARK NAME</u>	<u>REG. NO.</u>	<u>REG. DATE</u>	<u>GOODS/SERVICES</u>
14. McBITES	4,129,420	04/17/2012	Meat, pork, processed fish and poultry

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 filing date of April 11, 2013 for Applicant's "MACFLOWERS" 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	MACSIMIMIZE YOUR MAC
MAC JR.	BLAST BACK YOUR MAC
MINI MAC	MORNING MAC
MEGA MAC	MACMAN
DOUBLE MAC	MAC FAMILY
SUPER MAC	MAC TO GO
XTREME MAC	MAC PAC
MONSTER MAC	HAVE YOU HAD YOUR MAC TODAY?
LITE MAC	MAC TONIGHT
6 PAC 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 application on or about April 11, 2013 to register “MACFLOWERS” as a trademark for granulate plant seeds.

12. Applicant’s use of the “MACFLOWERS” mark in the United States is or will 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 or hearing Applicant's "MACFLOWERS" mark used in connection with Applicant's products, are likely 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 Applicant's "MACFLOWERS" 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 "MACFLOWERS" 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 "MACFLOWERS" 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 goods 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. 85/901,030 be refused registration.



**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: March 17, 2014

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

Robert E. Browne  
John A. Cullis  
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**CERTIFICATE OF SERVICE**

I, John A. Cullis, state that I served a copy of the foregoing *Notice of Opposition*, via first class U.S. mail, postage pre-paid, upon Applicant’s counsel of record:

Patrick Richards  
Richards Patent Law P.C.  
233 S. Wacker Dr., Floor 84  
Chicago, Illinois 60606-6338  
patrick@richardspatentlaw.com

via First Class Mail in accordance with Trademark Rule §§ 2.201 and 2.119 and a courtesy copy via e-mail on March 17, 2014.

          /John A. Cullis/            
John A. Cullis