

ESTTA Tracking number: **ESTTA595371**

Filing date: **03/28/2014**

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		
Entity	Corporation	Citizenship	Delaware
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, DocketMail@ngelaw.com Phone:312-269-8000
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Applicant Information

Application No	79129412	Publication date	03/04/2014
Opposition Filing Date	03/28/2014	Opposition Period Ends	04/03/2014
Applicant	McFit GmbH Tannenberg 4 DEX DEX		

Goods/Services Affected by Opposition

Class 016. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Printed matter, namely, books, booklets, flyers, magazines, journals, training and nutrition plans all in the field of physical training, mental balance, wellbeing, nutrition, diet counseling and fitness
Class 032. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Mineral and aerated waters and other non-alcoholic beverages, namely, isotonic beverages, non-alcoholic malt beverages, soft drinks, sport drinks, energy drinks; fruit beverages and fruit juices; vegetable juice beverages; syrups, powders and concentrates used in the preparation of soft drinks, sport drinks, energy drinks, isotonic drinks and fruit flavored beverages
Class 035. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Advertising; business administration; business management; arranging of contracts of buying and selling of films, video and sound recordings for third parties; model agency services, namely, placement of models for advertising or sales promotion
Class 038. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Broadcasting of films, audio, sound

and video recordings; Video transmission and broadcasting services via the Internet, local area network (LAN), satellites, optical communications, or other communications networks via streaming technology and delayed playback, featuring sporting, cultural and social events

Class 041. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Providing sports facilities; sports studios, namely, providing group exercise instruction, personal training instruction, equipment and facilities, exercise classes, body sculpting classes, group fitness classes and fitness and exercise facilities; sports camps; rental of sport equipment except vehicles; organization of sporting competitions; Entertainment services in the nature of cultural, musical and sporting events, namely, music festivals, concerts, live theatrical productions, group exercise activities, group runs, bicycle competitions, outdoor gymnastic classes, soccer competitions, baseball competitions, basketball competitions; Arranging and conducting of seminars and workshops for educational purposes in the field of physical fitness, training, nutrition, health, wellness, mental wellbeing, music, languages and popular culture and distribution of training material in connection therewith; Entertainment services in the nature of development, creation, production and post-production services of multimedia entertainment content; film productions; film rental; rental of video and sound recordings; instruction in the fields of gymnastics; music composition services, namely, composition of music for others

Class 044. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Solarium services; health club services, namely, providing instruction and equipment in the field of physical exercise; health training, namely, health counseling, providing health information

Applicant Information

Application No	79129414	Publication date	03/11/2014
Opposition Filing Date	03/28/2014	Opposition Period Ends	04/10/2014
Applicant	McFit GmbH Tannenberg 4 DEX DEX		

Goods/Services Affected by Opposition

Class 016. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Printed matter, namely, books, booklets, flyers, magazines, journals, training and nutrition plans all in the field of physical training, mental balance, wellbeing, nutrition, diet counseling and fitness

Class 035. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Advertising; business administration; business management; arranging of contracts of buying and selling of films, video and sound recordings for third parties; model agency services, namely, placement of models for advertising or sales promotion

Class 038. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Broadcasting of films, audio, sound and video recordings; Video transmission and broadcasting services via the Internet, local area network (LAN), satellites, optical communications, or other communications networks via streaming technology and delayed playback, featuring sporting, cultural and social events

Class 041. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Providing sports facilities; sports studios, namely, providing group exercise instruction, personal training instruction, equipment and facilities, exercise classes, body sculpting classes, group fitness classes and fitness and exercise facilities; sports camps; rental of sport equipment except vehicles; organization of sporting competitions; Entertainment services in the nature of cultural, musical and sporting events, namely, music festivals, concerts, live theatrical productions, group exercise activities, group runs, bicycle competitions, outdoor gymnastic classes, soccer competitions, baseball competitions, basketball competitions; Arranging and conducting of seminars and workshops for educational purposes in the field of

physical fitness, training, nutrition, health, wellness, mental wellbeing, music, languages and popular culture and distribution of training material in connection therewith; Entertainment services in the nature of development, creation, production and post-production services of multimedia entertainment content; film productions; film rental; rental of video and sound recordings; instruction in the fields of gymnastics; music composition services, namely, composition of music for others

Class 044. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Solarium services; health club services, namely, providing instruction and equipment in the field of physical exercise; health training, namely, health counseling, providing health information

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 042. First use: First Use: 1948/12/00 First Use In Commerce: 1953/05/06 Drive-In Restaurant Services		

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.	3201441	Application Date	03/02/2006
Registration Date	01/23/2007	Foreign Priority Date	NONE
Word Mark	MCCAFE		

Design Mark	<h1>MCCAFE</h1>		
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use: 2001/05/02 First Use In Commerce: 2001/05/02 BEVERAGES MADE OF COFFEE BEANS, HOT CHOCOLATE, PASTRIES, MUFFINS, CAKES, COOKIES, BISCUITS AND SANDWICHES		

U.S. Registration No.	939100	Application Date	07/22/1971
Registration Date	07/25/1972	Foreign Priority Date	NONE
Word Mark	MCDONALDLAND		
Design Mark	MCDONALDLAND		
Description of Mark	NONE		
Goods/Services	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		

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	NONE		

Mark	
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.	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.	2684782	Application Date	09/12/2001
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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			
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.	3696916	Application Date	10/14/2008
Registration Date	10/13/2009	Foreign Priority Date	NONE
Word Mark	MCWORLD		
Design Mark			
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			
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		

U.S. Registration No.	1592450	Application Date	08/21/1989
Registration Date	04/17/1990	Foreign Priority Date	NONE
Word Mark	MCPOOL		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1989/07/06 First Use In Commerce: 1989/07/06 RECREATIONAL SERVICES IN THE NATURE OF PROVIDING SWIMMING FACILITIES		

U.S. Registration No.	2999077	Application Date	11/14/2003
Registration Date	09/20/2005	Foreign Priority Date	NONE
Word Mark	GET MOVING WITH RONALD MCDONALD		
Design Mark			
Description of	NONE		

Mark	
Goods/Services	Class 041. First use: First Use: 2003/10/30 First Use In Commerce: 2003/10/30 ENTERTAINMENT SERVICES, NAMELY, PERFORMANCES BY AN INDIVIDUAL IN A CLOWN COSTUME

U.S. Registration No.	3074164	Application Date	06/13/2002
Registration Date	03/28/2006	Foreign Priority Date	NONE

Word Mark	MCDONALD'S ALL AMERICAN
Design Mark	MCDONALD'S ALL AMERICAN

Description of Mark	NONE
Goods/Services	Class 041. First use: First Use: 1978/04/30 First Use In Commerce: 1978/04/30 ENTERTAINMENT SERVICES NAMELY CONDUCTING ATHLETIC EVENTS IN THE NATURE OF BASKETBALL AND SOCCER CLINICS AND COMPETITIONS

U.S. Registration No.	1287324	Application Date	09/29/1982
Registration Date	07/24/1984	Foreign Priority Date	NONE

Word Mark	MCDONALDS ALL AMERICAN GAME
Design Mark	
Description of Mark	NONE

Goods/Services	Class 041. First use: First Use: 1978/04/00 First Use In Commerce: 1978/04/00 Entertainment Services-Namely, Basketball Exhibitions
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Attachments	78827670#TMSN.jpeg(bytes) 72398083#TMSN.gif(bytes) 78417184#TMSN.jpeg(bytes) 77592451#TMSN.jpeg(bytes) 85173863#TMSN.jpeg(bytes) 78327968#TMSN.jpeg(bytes) 78135408#TMSN.jpeg(bytes) Consol_Notice_of_Opposition_McFIT.pdf(34238 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	03/28/2014

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

In the Matter of Application Serial Nos.:

79/129,412 for McFIT and Design

79/129,414 for McFIT and Design

Published in the Official Gazette
on March 4, 2014 and March 11, 2014

McDONALD'S CORPORATION,

Opposer,

v.

McFIT GmbH,

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 McFIT and Design and McFIT and Design in International Classes 16, 32, 35, 38, 41 and 44, as shown in Application Serial Nos. 79/129,412 and 79/129,414 (collectively, the "McFIT Marks"), filed by Applicant, McFit GmbH, a company organized under the laws of the Federal Republic of Germany and having a place of business at Tannenbergr 4, 96132 Schlüßelfeld, Federal Republic of Germany and hereby opposes the same and requests that registrations to Applicant be refused.

As grounds for its consolidated opposition, Opposer alleges that:

1. Applicant seeks to register the McFIT and Design mark of Application No. 79/129,412 in connection with “mineral and aerated waters and other non-alcoholic beverages, namely, isotonic beverages, non-alcoholic malt beverages, soft drinks, sport drinks, energy drinks; fruit beverages and fruit juices; vegetable juice beverages; syrups, powders and concentrates used in the preparation of soft drinks, sport drinks, energy drinks, isotonic drinks and fruit flavored beverages” in International Class 32. In addition, Applicant seeks to register the McFIT Marks for “printed matter, namely, books, booklets, flyers, magazines, journals, training and nutrition plans all in the field of physical training, mental balance, wellbeing, nutrition, diet counseling and fitness” in International Class 16, “advertising; business administration; business management; arranging of contracts of buying and selling of films, video and sound recordings for third parties; model agency services, namely, placement of models for advertising or sales promotion” in International Class 35, “broadcasting of films, audio, sound and video recordings; video transmission and broadcasting services via the Internet, local area network (LAN), satellites, optical communications, or other communications networks via streaming technology and delayed playback, featuring sporting, cultural and social events” in International Class 38, “providing sports facilities; sports studios, namely, providing group exercise instruction, personal training instruction, equipment and facilities, exercise classes, body sculpting classes, group fitness classes and fitness and exercise facilities; sports camps; rental of sports equipment except vehicles; organization of sporting competitions; entertainment services in the nature of cultural, musical and sporting events, namely, music festivals, concerts, live theatrical productions, group exercise activities, group runs, bicycle competitions, outdoor gymnastic classes, soccer competitions, baseball competitions, basketball competitions; arranging and conducting of seminars and workshops for educational purposes in the field of

physical fitness, training, nutrition, health, wellness, mental wellbeing, music, languages and popular culture and distribution of training material in connection therewith; entertainment services in the nature of development, creation, production and post-production services of multimedia entertainment content; film productions; film rental; rental of video and sound recordings; instruction in the fields of gymnastics; music composition services, namely, composition of music for others” in International Class 41, and “solarium services; health club services, namely, providing instruction and equipment in the field of physical exercise; health training, namely, health counseling, providing health information” in International Class 44. The applications are based upon foreign trademark registrations and filed under §66(a).

2. 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.

3. 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. 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.

5. In addition, Opposer has used various service marks over the last 25 years in connection with a host of educational programs and fundraising initiatives directed to the health and welfare of children and their families, which are directly related to the type of services for which Applicant seeks to register the McFIT Marks. In particular, McDonald’s has actively been involved with hosting and promoting health and fitness programs in elementary and secondary schools throughout the United States. For example, Opposer has offered its “PASSPORT TO PLAY” program, which has educated students on the topics of health, nutrition, fitness, well being and physical activity at schools across the United States. In fact, over seven million students in the United States have participated in the PASSPORT TO PLAY program. Opposer has also offered a "CHAMPIONS OF PLAY" program to encourage a balanced approach to nutrition and activity. Opposer is also the owner of the mark “GET MOVING WITH RONALD MCDONALD,” which is registered for entertainment services, namely, performances by an individual in a clown costume and has been used in connection with children’s education programs focused on nutrition and exercise. Opposer, together with DreamWorks Studio, used

the animated character, Shrek, to promote physical activity through its “Shrek's Treketh to Adventure” games on its website that required both online and offline play to earn points and progress in the games. Opposer has further provided children’s playground facilities for recreation activities under the mark R GYM. Opposer, through the McDonald’s Foundation, has also recently entered into a partnership with KaBOOM!, a national non-profit that envisions providing playgrounds within walking distance of every child in America. Together, Opposer and KaBOOM! have built playgrounds for children in cities across the nation, including Chicago, Baltimore, San Antonio, El Paso and Joplin.

6. Opposer also uses its various marks in connection with a variety of adult-focused health initiatives sponsored by Opposer. For example, Opposer sponsors the McDonald’s Cycle Center to encourage biking as a means of staying healthy and fit, and weekly yoga and Pilates classes, both at the Millennium Park in Chicago, Illinois. Opposer also has promoted the “YOURSELF!FITNESS” program, which offered interactive 15-minute fitness DVDs on yoga, core, cardio and strength training as well as videogames directed to fitness for its customers. Furthermore, Opposer provided its “GO ACTIVE” program, which focused on the development and dissemination of educational materials of others in the field of health, fitness and active lifestyles. More specifically, the “GO ACTIVE! America Challenge” offered Opposer’s consumers advice from world-class consultants on lifestyle and fitness. For example, for several years, beginning in 2003, Opposer offered consumers educational information on health, nutrition and fitness from the renowned personal trainer Bob Greene. Opposer has further promoted and encouraged fitness through its Balanced Active Lifestyles program, including promoting walking by offering Stepometers™ in Happy Meals.

7. To further encourage health and fitness amongst consumers, Opposer sponsors different athletic organizations and events, including, but not limited to: “MCDONALD'S ALL AMERICAN” high school basketball and soccer exhibitions and games, the Olympics, and FIFA World Cup™. In fact, Opposer became an Official Sponsor of the Olympic Games in 1976, and has been a committed sponsor ever since to reinforce its commitment to the importance of sports and physical activity in connection with maintaining a balanced and healthy lifestyle. In connection with its sponsorship of the London 2012 Olympic Games, for example, and as part of its “CHAMPIONS OF PLAY” program, Opposer provided children from around the world the opportunity to attend the Games and play with athletes at the venues where the Olympians competed.

8. Opposer has used or is likely to expand the use of its “Mc” formative marks to include the same services or type of goods and services for which the McFIT Marks are intended to be used by Applicant.

9. 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.

10. 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. McCAFE	2,482,828	08/28/2001	Restaurant services.
3. McCAFE	3,201,441	01/23/2007	Beverages made of coffee beans, hot chocolate, pastries, muffins, cakes, cookies, biscuits and sandwiches.
4. McDONALDLAND	939,100	07/25/1972	Restaurant services.
5. Mc DOUBLE	1,266,500	02/07/1984	A sandwich for consumption on or off premises.
6. McRIB	1,315,979	01/22/1985	A sandwich for consumption on or off premises.
7. McMUFFIN	1,485,633	04/19/1988	Restaurant services.
8. McNUGGETS	1,450,104	07/28/1987	Restaurant services.
9. Mc	1,947,099	01/09/1996	Restaurant services.
10. McDIRECT SHARES	2,056,279	09/28/1995	Financial services, namely providing a direct company stock purchase plan.
11. McTEACHER’S NIGHT	2,684,782	02/04/2003	Charitable fundraising.
12. McGRIDDLES	3,151,707	10/03/2006	Hot cakes.
13. McWORLD	3,696,916	10/13/2009	Entertainment services, namely providing a website for interactive online games for children.
14. McBITES	4,129,420	04/17/2012	Meat, pork, processed fish and poultry.

<u>MARK NAME</u>	<u>REG. NO.</u>	<u>REG. DATE</u>	<u>GOODS/SERVICES</u>
15. McPOOL	1,592,450	04/17/1990	Recreational services in the nature of providing swimming facilities.
16. GET MOVING WITH RONALD MCDONALD	2,999,077	06/20/2005	Entertainment services, namely, performances by an individual in a clown costume.
17. MCDONALD'S ALL AMERICAN	3,074,164	04/28/2006	Entertainment services namely conducting athletic events in the nature of basketball and soccer clinics and competitions.
18. MCDONALD'S ALL AMERICAN GAME	1,287,324	05/01/1984	Entertainment Services Namely, Basketball Exhibitions.

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

11. 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.

12. 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.

13. 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.")

14. 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, on March 15, 2013, Applicant filed its applications to register the McFIT Marks in connection with "printed matter, namely, books, booklets, flyers, magazines, journals, training and nutrition plans all in the field of physical training, mental balance, wellbeing, nutrition, diet counseling and fitness" in International Class 16, "mineral and aerated waters and other non-alcoholic beverages, namely, isotonic beverages, non-alcoholic malt beverages, soft drinks, sport drinks, energy drinks; fruit beverages and fruit juices; vegetable juice beverages; syrups, powders and concentrates used in the preparation of soft drinks, sport drinks, energy drinks, isotonic drinks and fruit flavored beverages" in International Class 32 (for App. Serial No.

79/129,412 only), “advertising; business administration; business management; arranging of contracts of buying and selling of films, video and sound recordings for third parties; model agency services, namely, placement of models for advertising or sales promotion” in International Class 35, “broadcasting of films, audio, sound and video recordings; video transmission and broadcasting services via the Internet, local area network (LAN), satellites, optical communications, or other communications networks via streaming technology and delayed playback, featuring sporting, cultural and social events” in International Class 38, “providing sports facilities; sports studios, namely, providing group exercise instruction, personal training instruction, equipment and facilities, exercise classes, body sculpting classes, group fitness classes and fitness and exercise facilities; sports camps; rental of sports equipment except vehicles; organization of sporting competitions; entertainment services in the nature of cultural, musical and sporting events, namely, music festivals, concerts, live theatrical productions, group exercise activities, group runs, bicycle competitions, outdoor gymnastic classes, soccer competitions, baseball competitions, basketball competitions; arranging and conducting of seminars and workshops for educational purposes in the field of physical fitness, training, nutrition, health, wellness, mental wellbeing, music, languages and popular culture and distribution of training material in connection therewith; entertainment services in the nature of development, creation, production and post-production services of multimedia entertainment content; film productions; film rental; rental of video and sound recordings; instruction in the fields of gymnastics; music composition services, namely, composition of music for others” in International Class 41, and “solarium services; health club services, namely, providing instruction and equipment in the field of physical exercise; health training, namely, health counseling, providing health information” in International Class 44, which applications were

assigned Serial Nos. 79/129,412 and 79/129,414. 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.

15. 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 McFIT Marks are likely to mistakenly believe that such terms and the goods and 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 McFIT Marks in connection with its goods and services, for all channels of trade and all types of prospective purchasers, are likely to cause confusion, mistake, or deception in violation of 15 U.S.C. § 1052(d).

16. Issuance of registrations 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 McFIT Marks, the confusion with Opposer's marks would result in damage and injury to Opposer and the public. Registration of these marks 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 and services 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 or services to reflect upon Opposer; and to restrict the natural growth of Opposer's family of "Mc" formative marks.

WHEREFORE, Opposer requests that this Opposition be sustained and Application Serial Nos. 79/129,412 and 79/129,414 be refused registration.

Opposer requests that the requisite filing fee of \$3,300.00 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: March 28, 2014

By: /John A. Cullis/

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CERTIFICATE OF TRANSMISSION

I hereby certify that the foregoing **CONSOLIDATED 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 28, 2014

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 **CONSOLIDATED NOTICE OF OPPOSITION** upon Applicant’s counsel:

Stacey C. Friends, Esq.
Ruberto, Israel & Weiner, PC
255 State St., 7th Floor
Boston, Massachusetts 02109

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: March 28, 2014

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

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