

ESTTA Tracking number: **ESTTA600668**

Filing date: **04/25/2014**

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

Proceeding	91212950
Party	Plaintiff McDonald's Corporation
Correspondence Address	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, Docket-Mail@ngelaw.com
Submission	Motion to Consolidate
Filer's Name	John A. Cullis
Filer's e-mail	rbrowne@ngelaw.com, jcullis@ngelaw.com, ljames@ngelaw.com, jcohen@ngelaw.com, afuelleman@ngelaw.com, mbenson@ngelaw.com, Docket-Mail@ngelaw.com
Signature	/John A. Cullis/
Date	04/25/2014
Attachments	Motion_to_Consolidate_McFIT_Opposition_Proceedings.pdf(22579 bytes )

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

In the Matter of Application Serial Nos.:

79/111,190 for McFIT  
79/111,490 for McFIT (Stylized)

McDONALD'S CORPORATION,

Opposer,

v.

McFIT GMBH,

Applicant.

**Opposition No. 91212950**

and,

In the Matter of Application Serial Nos.:

79/129,412 for McFIT and Design  
79/129,414 for McFIT and Design

McDONALD'S CORPORATION,

Opposer,

v.

McFIT GMBH,

Applicant.

**Opposition No. 91215647**

**OPPOSER'S CONSENTED MOTION  
TO CONSOLIDATE OPPOSITION PROCEEDINGS**

Opposer, McDonald's Corporation, together with the consent of Applicant, McFit GmbH, hereby moves the Trademark Trial and Appeal Board pursuant to TBMP § 511 and Fed. R. Civ. P. 42(a) for an order consolidating the above-referenced Opposition proceedings. As set forth more fully below, the Opposition proceedings in question (collectively, "the Proceedings") involve substantially identical legal and factual issues and identical parties. Accordingly, in the

interests of convenience, efficiency, and judicial economy, Opposer (with Applicant's consent) requests that the Board consolidate the Proceedings. In support of its request, Opposer states as follows:

1. As set forth in Section 511 of the Trademark Trial and Appeal Board Manual of Procedure, "[w]hen cases involving common questions of law or fact are pending before the Board, the Board may order the consolidation of the cases." *See* TBMP § 511; *see also* Fed. R. Civ. P. 42(a) ("If actions before the court involve a common question of law or fact, the court may . . . consolidate the actions . . ."); *Hilson Research, Inc. v. Soc. for Human Resource Mgmt.*, 27 USPQ2d 1423 (TTAB 1993) (opposition and cancellation consolidated).

2. In determining whether to consolidate, the Board should consider the savings in time, effort, and expense to be gained from consolidation as well as whether any actual prejudice will result from consolidation. *See* TBMP § 511; *see also World Hockey Ass'n v. Tudor Metal Prods. Corp.*, 185 USPQ 246, 248 (TTAB 1975) (ordering consolidation where issues were substantially the same and consolidation benefited both parties). While identity of the parties is not required to consolidate, where the same parties are involved in multiple actions, the case for consolidation is strengthened. *See* TBMP § 511 ("identity of the parties is another factor considered by the Board in determining whether consolidation should be ordered . . ."); *Bigfoot 4X4, Inc. v. Bear Foot, Inc.*, 4 USPQ2d 1444 (TTAB 1987).

3. The circumstances in the Proceedings strongly warrant consolidation. The four trademark applications filed by Applicant, McFit GmbH, each seek to register a mark primarily comprised of the term "McFIT" for use in connection with virtually identical goods and services as illustrated below:

Application No.	Mark	Goods and Services
79/111,190	McFIT	<p>IC 35. Advertising; business administration; business management.</p> <p>IC 41. Providing sports facilities; sports studios, namely, providing group exercise instruction, personal training instruction, equipment and facilities, exercise classes, body sculpting classes and group fitness classes, fitness and exercise facilities; sports camps; rental of sports equipment except vehicles; organization of sports competitions; Entertainment services in the nature of cultural, musical and sporting events, namely, music festivals, concerts, live theatrical productions, group exercise activities, group runs, sporting goods product demonstrations, bicycle competitions, outdoor gymnastic classes, soccer competitions, baseball competitions, basketball competitions.</p> <p>IC 44. Solariums.</p>
79/111,490	McFIT (Stylized)	<p>IC 35. Advertising; business administration; business management.</p> <p>IC 41. Providing sports facilities; sports studios, namely, providing group exercise instruction, personal training instruction, equipment and facilities, exercise classes, body sculpting classes and group fitness classes, fitness and exercise facilities; sports camps; rental of sports equipment except vehicles; organization of sports competitions; Entertainment services in the nature of cultural, musical and sporting events, namely, music festivals, concerts, live theatrical productions, group exercise activities, group runs, sporting goods product demonstrations, bicycle competitions, outdoor gymnastic classes, soccer competitions, baseball competitions, basketball competitions.</p> <p>IC 44. Solariums.</p>
79/129,412	McFIT and Design	<p>IC 16. Printed matter, namely, books, booklets, flyers, magazines, journals, training and nutrition plans all in the field of physical training, mental</p>

		<p>balance, wellbeing, nutrition, diet counseling and fitness.</p> <p>IC 32. 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.</p> <p>IC 35. 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.</p> <p>IC 38. 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.</p> <p>IC 41. 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</p>
--	--	--

		<p>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.</p> <p>IC 44. Solarium services; health club services, namely, providing instruction and equipment in the field of physical exercise; health training, namely, health counseling, providing health information.</p>
79/129,414	McFIT and Design	<p>IC 16. 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.</p> <p>IC 35. 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.</p> <p>IC 38. 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.</p> <p>IC 41. 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;</p>

		<p>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.</p> <p>IC 44. Solarium services; health club services, namely, providing instruction and equipment in the field of physical exercise; health training, namely, health counseling, providing health information.</p>
--	--	--

Each application seeks registration within International Classes 35, 41 and 44 for virtually identical services. Consolidation is appropriate in this case because it will generate significant savings in time, effort, and expense without prejudicing either party.

4. Opposer’s allegations, as set forth in the respective Notices of Opposition for each of the Proceedings, are nearly identical. In both cases, Opposer is concerned with the likelihood of confusion between Opposer’s “Mc” family of marks and Applicant’s “McFIT” marks. In both cases, Opposer is also concerned with the dilutive effect that registration and use of the McFIT marks would have on its famous “Mc” family of marks. Moreover, discovery regarding the issues set forth above will seek to uncover the same set of facts in both of the Proceedings.

5. Discovery has not concluded in either of the Proceedings, and the issues concerning likelihood of confusion and dilution are identical. Accordingly, neither of the parties will be prejudiced by consolidation of these Proceedings, and consolidation is necessary to ensure consistent judgments. *See, e.g., Rio Energy Int’l, Inc. v. Hilton Oil Transport, 776 F.*

Supp. 120, 122 (S.D.N.Y. 1991) (ordering consolidation where common questions of law and fact existed as well as the danger of conflicting findings).

Accordingly, Opposer believes that consolidation will save time, effort, and expense for both parties. On this basis, on April 21, 2014, Opposer conferred with counsel for Applicant and received Applicant's consent to the present Motion.

WHEREFORE, for the foregoing reasons, Opposer respectfully requests, with Applicant's consent, that the Board enter an Order pursuant to TBMP § 511 and Fed. R. Civ. P. 42(a) consolidating Opposition No. 91212950 with Opposition No. 91215647, and granting such other relief as the Board deems appropriate.

Respectfully submitted,

McDONALD'S CORPORATION

Date: April 25, 2014

By: /John A. Cullis/  
One of the Attorneys for Opposer

Robert E. Browne  
John A. Cullis  
Lawrence E. James, Jr.  
Jessica Rissman Cohen  
NEAL, GERBER & EISENBERG, LLP  
2 N. LaSalle Street, Suite 2200  
Chicago, IL 60602  
(312) 269-8000

**CERTIFICATE OF SERVICE**

I, Jessica Rissman Cohen, state that I served a copy of the foregoing *Opposer's Motion to Consolidate Opposition Proceedings* via first class U.S. mail, postage pre-paid, upon:

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

on this 25th day of April, 2014.

/Jessica Rissman Cohen /  
Jessica Rissman Cohen

NGEDOCs: 2158318.2