

ESTTA Tracking number: **ESTTA768015**

Filing date: **08/31/2016**

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	08/31/2016
Address	One McDonald's Plaza Oak Brook, IL 60523 UNITED STATES

Attorney information	John A. Cullis Reed Smith LLP 10 South Wacker Drive Chicago, IL 60606 UNITED STATES ipdocket-chi@reedsmith.com, rbrowne@reedsmith.com, rsMcDonaldsT- MTeam@ReedSmith.com, mbenson@reedsmith.com Phone:3122071000
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**Applicant Information**

Application No	86842176	Publication date	05/03/2016
Opposition Filing Date	08/31/2016	Opposition Period Ends	08/31/2016
Applicant	DSB Enterprises, Inc. 2 Justamere Lane Hopewell Junction, NY 12533 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 025. First Use: 2011/05/00 First Use In Commerce: 2011/05/00 All goods and services in the class are opposed, namely: Leather vests
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**Grounds for Opposition**

Priority and likelihood of confusion	Trademark Act Section 2(d)
Dilution by blurring	Trademark Act Sections 2 and 43(c)

**Marks Cited by Opposer as Basis for Opposition**

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.	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 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</p> <p>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</p>
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U.S. Registration No.	1440655	Application Date	09/30/1982
Registration Date	05/26/1987	Foreign Priority Date	NONE

Word Mark	MCDONALDS
Design Mark	
Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 1973/09/00 First Use In Commerce: 1973/09/00 MEN'S CLOTHING, WOMEN'S CLOTHING AND CHILDREN'S CLOTHING, NAMELY, T-SHIRTS, [ NIGHT SHIRTS, ] HATS, [ SWEATERS ], SHORTS, ATHLETIC SHIRTS, [ VESTS, ] SWEAT SHIRTS AND JERSEYS

U.S. Registration No.	2399953	Application Date	10/26/1999
Registration Date	10/31/2000	Foreign Priority Date	NONE
Word Mark	MCDONALD'S		
Design Mark	<b>MCDONALD'S</b>		
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1968/10/00 First Use In Commerce: 1968/11/00 Men's, women's and children's clothing,namely, coats, jackets, shirts, ties, visors and scarves		

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	
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			
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.	3151707	Application Date	05/12/2004
Registration Date	10/03/2006	Foreign Priority Date	NONE
Word Mark	MCGRIDDLES		
Design Mark	 <p style="text-align: center; font-size: 2em; font-weight: bold;">MCGRIDDLES</p>		
Description of Mark	NONE		

Goods/Services	Class 030. First use: First Use: 2000/10/31 First Use In Commerce: 2000/10/31 HOT CAKES		
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U.S. Registration No.	4129420	Application Date	11/10/2010
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Registration Date	04/17/2012	Foreign Priority Date	NONE
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Word Mark	MCBITES		
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Design Mark			
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Description of Mark	NONE		
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Goods/Services	Class 029. First use: First Use: 2011/10/31 First Use In Commerce: 2011/10/31 MEAT, PORK, PROCESSED FISH AND POULTRY		
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U.S. Registration No.	2056279	Application Date	09/28/1995
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Registration Date	04/22/1997	Foreign Priority Date	NONE
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Word Mark	MCDIRECT SHARES		
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Design Mark			
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Description of Mark	NONE		
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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		
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U.S. Registration No.	2684782	Application Date	09/12/2001
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Registration Date	02/04/2003	Foreign Priority Date	NONE
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Word Mark	MCTEACHER'S NIGHT		
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Design Mark			
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Description of Mark	NONE		
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Goods/Services	Class 036. First use: First Use: 2001/11/15 First Use In Commerce: 2001/11/15 CHARITABLE FUNDRAISING		
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U.S. Registration No.	4451381	Application Date	05/06/2013
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Registration Date	12/17/2013	Foreign Priority Date	NONE
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Word Mark	MCPLAY		
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Design Mark	<h1>MCPLAY</h1>
Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 2013/05/01 First Use In Commerce: 2013/05/01 Downloadable computer games

U.S. Registration No.	1007919	Application Date	09/27/1973
Registration Date	04/01/1975	Foreign Priority Date	NONE
Word Mark	RONALD MCDONALD		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1970/09/00 First Use In Commerce: 1970/09/00 MEN'S, WOMEN'S AND CHILDREN'S CLOTHING-NAMELY, KNIT SHIRTS, BLOUSES, AND SHIRTS		

Attachments	73426936#TMSN.png( bytes ) 75832321#TMSN.png( bytes ) 78827670#TMSN.png( bytes ) 72398083#TMSN.png( bytes ) 78417184#TMSN.png( bytes ) 85173863#TMSN.png( bytes ) 85924012#TMSN.png( bytes ) NOO_MCVESTS.pdf(30884 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	08/31/2016

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

In the Matter of:  
Application Serial No. 86/842,176

Published in the *Official Gazette*  
on May 3, 2016

McDONALD'S CORPORATION,

Opposer,

v.

DSB Enterprises, Inc.,

Applicant.

Mark: The logo for the mark 'McVESTS' is displayed in a stylized, serif font. The 'M' and 'C' are joined together, and the 'V' is significantly larger and more prominent than the other letters.

Opposition No.: \_\_\_\_\_

**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 mark McVESTS in International Class 25, as shown above in Application Serial No. 86/842,176 filed by Applicant, DSB Enterprises, Inc., a corporation organized and existing under the laws of the State of New York, with a mailing address of 2 Justamere Lane, Hopewell Junction, New York 12533 and hereby opposes same and requests that registration to Applicant be refused.

The grounds for this Notice of Opposition are as follows:

1. Applicant seeks to register the mark McVESTS for "leather vests" in International Class 25. The application is a use-based application filed under 15 U.S.C. § 1051(a), and claims a date of first use on May 31, 2011.

2. 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 in the United States and throughout 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 its “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. Opposer has also used its family of “Mc” and “Mac” formative marks on a wide variety of goods that are not related to food products or restaurant services, including, without limitation: chemical preparations; concentrated cleaners; computer services; men’s, women’s and children’s clothing; barbershop services; mail order services; educational services; and charitable services.

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 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 its “Mc” and “Mac” formative family of marks on food product packaging and point-of-purchase advertising. In sum, Opposer uses its family of “Mc” and “Mac” marks in connection with a wide variety of products and services, or is likely to expand the use of its family of “Mc” and “Mac” marks to

products identical, similar or related to those for which Applicant’s McVESTS mark is used.

6. Opposer owns numerous federal registrations for its family of “Mc” 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.	Mc	1,947,099	01/09/1996	Restaurant services
2.	McDONALD’S	1,352,168	07/30/1985	Restaurant services
3.	McDONALD’S	1,426,681	01/27/1987	Hamburger and cheeseburger sandwiches and special combination sandwiches featuring hamburgers and cheeseburgers
4.	McDONALD’S	1,440,655	05/26/1987	Men’s clothing, women’s clothing, and children’s clothing, namely, t-shirts, hats, shorts, athletic shirts, sweat shirts and jerseys.
5.	McDONALD’S	2,399,953	10/31/2000	Men’s, women’s and children’s clothing, namely, coats, jackets, shirts, ties, visors, and scarves
6.	McCAFE	2,482,828	8/28/2001	Restaurant services
7.	McCAFE	3,201,441	01/23/2007	Beverages made of coffee, pastries, muffins, cakes, cookies, biscuits, and sandwiches
8.	McDONALDLAND	0,939,100	07/25/1972	Restaurant services
9.	McDOUBLE	1,266,500	02/07/1984	A sandwich for consumption on or off premises
10.	McRIB	1,315,979	01/22/1985	A sandwich for consumption on or off premises
11.	McMUFFIN	1,485,633	04/19/1988	Restaurant services

	<u>MARK NAME</u>	<u>REG. NO.</u>	<u>REG. DATE</u>	<u>GOODS/SERVICES</u>
12.	McNUGGETS	1,450,104	07/28/1987	Restaurant services
13.	McGRIDDLES	3,151,707	10/03/2006	Hot cakes
14.	McBITES	4,129,420	04/17/2012	Meat, pork, processed fish and poultry
15.	McDIRECT SHARES	2,056,279	04/22/1997	Financial services, namely, providing a direct company stock purchase plan
16.	McTEACHER'S NIGHT	2,684,782	02/04/2003	Charitable fundraising
17.	McPLAY	4,451,381	12/17/2013	Downloadable computer games
18.	RONALD MCDONALD	1,007,919	04/01/1975	Men's, women's and children's clothing, namely, knit shirts, blouses, and shirts

7. All of these registrations are valid, subsisting, and in full force and effect. Furthermore, Opposer has used these marks in association with their respective designated goods and services prior to May 31, 2011, the date of first use claimed by Applicant.

8. 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 registrations.

9. Through Opposer's extensive and continuous use of the name McDONALD'S and its "Mc" and "Mac" formative marks, the public has come to recognize marks combining the "Mc" and "Mac" prefixes 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" and "Mac" family of marks. Opposer's "Mc" and "Mac" family of

marks is famous and was 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 Opposer'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) ("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) ("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. McSweet, LLC*, 112 U.S.P.Q. 2d 1268, 2014 WL 5282256 at \*7 (TTAB 2014) ("Based on the record before us, . . . Opposer has established that, based on its use and promotion of its family of marks, Opposer continues to own a family of marks consisting of the prefix 'MC' combined either with a generic term or a descriptive term."); *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 the name McDONALD'S and its "Mc" and "Mac" family of marks for restaurant services, food products, and a wide variety of other goods and services, on December 8, 2015, Applicant filed its application to register the McVESTS mark for "leather vests" in International Class 25. Moreover, in light of Opposer's widespread advertising and promotion of its "Mc" and "Mac" formative marks, Applicant's

selection and use of the McVESTS mark, which incorporates the “Mc” prefix, suggests that Applicant intends to trade off the goodwill and recognition associated with Opposer’s family of “Mc” formative marks.

12. The mark proposed for registration by Applicant has as its principal distinctive element the “Mc” prefix. Potential purchasers, upon seeing the dominant formative “Mc” in Applicant’s McVESTS mark are likely to mistakenly believe that the goods offered thereunder originated or are connected with, or are sponsored, licensed or approved by, Opposer. Thus, the registration and use by Applicant of the McVESTS mark in connection with its goods, for all channels of trade and all types of prospective purchasers, is likely to cause confusion, mistake, or deception in violation of 15 U.S.C. § 1052(d).

13. Issuance of a registration to Applicant will also diminish and dilute the distinctive quality of Opposer’s rights in the name McDONALD’S and its famous family of “Mc” marks, and will blur and otherwise impair the distinctiveness of this family of marks in violation of 15 U.S.C. § 1125(c).

14. If a registration is issued to Applicant for Applicant’s McVESTS mark, the confusion with Opposer’s marks would result in damage and injury to Opposer and the public. Registration of the McVESTS mark would also 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 Opposer’s good name by offering goods not subject to Opposer’s quality controls; and to restrict the natural growth of Opposer’s “Mc” family of marks.



**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: August 31, 2016

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 NOTICE OF OPPOSITION upon Applicant’s counsel of record for Application Serial No. 86/836,509 as listed with the USPTO:

Matthew H. Swyers  
The Trademark Company PLLC  
344 Maple Ave. W., Suite 151  
Vienna, Virginia 22180

via First Class Mail, postage prepaid, in accordance with Trademark Rule § 2.119 on the date noted below:

Date: August 31, 2016

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