

ESTTA Tracking number: **ESTTA480895**

Filing date: **06/29/2012**

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

|                        |  |
|------------------------|--|
| Proceeding             | 91205193   |
| Party                  | Plaintiff<br>McDonald's Corporation  |
| Correspondence Address | John A, Cullis<br>Neal Gerber & Eisenberg LLP<br>Two North LaSalle Street, Suite 1700<br>Chicago, IL 60602-3801<br>UNITED STATES<br>rbrowne@ngelaw.com, jcullis@ngelaw.com, ljames@ngelaw.com,<br>kblouin@ngelaw.com, mbenson@ngelaw.com |
| Submission             | Opposition/Response to Motion  |
| Filer's Name           | John A. Cullis   |
| Filer's e-mail         | rbrowne@ngelaw.com, jcullis@ngelaw.com, ljames@ngelaw.com,<br>kblouin@ngelaw.com, mbenson@ngelaw.com   |
| Signature              | /John A. Cullis/   |
| Date                   | 06/29/2012   |
| Attachments            | Response_to_MAC_PATIO_Motion_to_Strike.pdf ( 8 pages )(22196 bytes )   |

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

In the Matter of:  
Application Serial No. 85/087,738  
Published in the *Official Gazette*  
January 17, 2012

|                         |   |                         |
|-------------------------|---|-------------------------|
| McDONALD’S CORPORATION, | ) |                         |
|                         | ) |                         |
| Opposer,                | ) |                         |
|                         | ) |                         |
| v.                      | ) | Opposition No. 91205193 |
|                         | ) |                         |
| MACSPORTS, INC.,        | ) |                         |
|                         | ) |                         |
| Applicant.              | ) |                         |

**RESPONSE TO APPLICANT’S MOTION TO STRIKE**

Applicant, MacSports, Inc. (“Applicant”), has moved to strike Paragraph 8 and certain portions of Paragraph 10 of Opposer McDonald’s Corporation’s (“Opposer”) Notice of Opposition on the grounds that they are insufficient. Opposer’s response to Applicant’s Motion to strike was due on June 27, 2012. However, Opposer has obtained Applicant’s consent to file its response on June 29, 2012. Opposer’s allegations are sufficiently clear and unambiguous to place Applicant on notice of Opposer’s claim and to allow Applicant to respond in good faith. Accordingly, Opposer requests that the Board deny Applicant’s Motion to Strike.<sup>1</sup>

Pursuant to 37 CFR § 2.101(b) and TBMP § 309.03, all that is required of Opposer in its Notice of Opposition is to set forth a short and plain statement showing why Opposer believes it

---

<sup>1</sup> In Opposition No. 91200513 regarding Applicant’s application for registration of the MACWAGON mark, Serial No. 85/087,577, Applicant filed a nearly identical motion to strike Paragraphs 8 and 10 of Opposer’s Notice of Opposition. Opposer filed its response to the motion to strike on May 23, 2012 and Applicant filed a reply on June 7, 2012. Similarly, in Opposition No. 91205193, regarding Applicant’s application for registration of the MACSTATION mark, Serial No. 85/385,636, Applicant also filed a motion to strike Paragraphs 8 and 10 of Opposer’s Notice of Opposition. Opposer filed its response to that motion to strike on June 27, 2012.

will be damaged by the registration of the MAC PATIO mark and state the grounds for the opposition. Further, a pleading should merely include enough detail to give Applicant fair notice of the basis for each claim. TBMP § 309.03. Opposer did just that.

Moreover, a pleading may only be stricken if it is insufficient or contains any redundant, immaterial, impertinent or scandalous matter. Fed. R. Civ. P. 12(f); TBMP § 506. Unlike a motion to dismiss a claim, a motion to strike particular paragraphs does not address whether the paragraphs at issue are sufficient, by themselves, to state a claim. Rather, it merely addresses whether the paragraphs are relevant. In fact, the Board has mandated that “motions to strike are not favored, and matter will not be stricken unless it clearly has no bearing upon the issues of the case. The primary purpose of pleadings, under the Federal Rules of Civil Procedure, is to give fair notice of the claims or defenses asserted. Thus, the Board, in its discretion, may decline to strike even objectionable pleadings where their inclusion will not prejudice the adverse party, but rather will provide fuller notice of the basis for a claim or defense.” TBMP § 506.01 (internal citations omitted). Opposer’s Paragraph 8 and Paragraph 10 of its Notice of Opposition clearly bear upon the issues of this case and are more than sufficient to provide Applicant with fair notice of the claims.

First, with respect to Paragraph 8, Applicant argues that “Paragraph 8 fails to give fair notice of Opposer’s claims and is so vague so as to prejudice Applicant.” *Applicant’s Motion to Strike*, P. 2. Opposer, however, merely provided a non-exhaustive list of “Mac” formative marks and alleged that, in addition to its federally registered trademarks identified in detail in Paragraph 7, Opposer has also, from time to time adopted and used the marks listed in Paragraph 8. Opposer further alleged that as a result of such use, consumers worldwide associate trademarks distinguished by the “Mac” formative with Opposer. There is nothing so vague or ambiguous

about Opposer's list of marks or its allegations in Paragraph 8 that Applicant is not on notice or unable to respond or otherwise prejudiced by this allegation. While Applicant asserts that in order to respond, it requires an identification of the specific goods or services the marks are used in connection with as well as facts that indicate when the marks were used or whether they are currently being used, such fact details go to the merits, and are the proper subject of discovery, not pleading. Accordingly, they need not be pleaded as they are unnecessary under the Federal Rules or the Trademark Rules at this stage.

Applicant, in its Answer, is permitted to either admit or deny the allegations, or state that it lacks knowledge or information sufficient to form a belief as to the truth of the allegation, and effectively deny the allegation. 37 CFR § 2.106(b)(1); TBMP § 311.02. Thus, if Applicant believes that it requires additional information, such as the identification of goods and services the listed marks are used in connection with as well as dates of use, to respond, it may simply effectively deny the allegations by stating that it lacks sufficient knowledge or information to respond.

Applicant further claims in its Motion that without dates of use and an identification of goods and services, Applicant is not able to make a likelihood of confusion analysis and therefore, is unable to respond. However, in order to respond to Paragraph 8, Applicant is not asked to or required to make a likelihood of confusion analysis. It merely must admit, deny or state it is without sufficient knowledge to respond to the allegations that Opposer has, from time to time, used the listed marks and that as a result, consumers worldwide associate trademarks distinguished by the "Mac" formative with Opposer. Moreover, Applicant argues that because it is unable to make a likelihood of confusion analysis, Opposer's Paragraph 8 fails to state a claim for which relief may be granted. However, Applicant's Motion to Strike is not the proper

remedy for an allegation that Opposer has failed to state a claim upon which relief may be granted and should be denied for this reason as well. Again, to survive a motion to strike, the paragraph at issue must merely be relevant to the claim. Certainly, Opposer's historical use of a variety of "Mc" and "Mac" family of marks is relevant to establish that Opposer acquired fame in its family of "Mc" and "Mac" marks prior to Applicant adopting the MAC PATIO mark and that Opposer presently owns a famous family of marks.

Finally, Applicant argues that it is unable to respond to Paragraph 8 because a number of the marks listed in Paragraph 8 are no longer in use, and they therefore, are not relevant. Again, the Trademark Rules provide Applicant with options to respond, if this is the case. The list of marks in Paragraph 8 simply shows the breadth of Opposer's "Mac" family of marks, which it began using long before Applicant first used its MAC PATIO mark. Accordingly, regardless of whether particular marks are no longer used by Opposer, Applicant may, without prejudice, merely admit, deny or effectively deny the allegations that Opposer has, *from time to time*, used the listed marks and that as a result, consumers worldwide associate trademarks distinguished by the "Mac" formative with Opposer.

Likewise, Opposer's allegations in Paragraph 10 are sufficiently clear and unambiguous to allow Applicant to respond in good faith and without prejudicing itself and are in no way redundant, immaterial, impertinent or scandalous. In Paragraph 10, Opposer simply alleges that both the Trademark Trial and Appeal Board and the Court of Appeals for the Federal Circuit have long recognized the validity of McDonald's Corporation's rights to its famous "Mc" and "Mac" family of marks and in support thereof, lists Board and Federal Circuit decisions recognizing Opposer's rights in its family of "Mc" and "Mac" marks. Applicant, however, argues in its Motion that it cannot respond to Paragraph 10 because the case citations themselves

are not factual allegations, are immaterial because they are from 16 to 25 years ago, and Applicant does not agree that the cited decisions support the allegation that Opposer owns a famous family of “Mc” or “Mac” marks. First, if Applicant believes it can, in good faith, subject to Rule 11 of the Federal Rules of Civil Procedure, dispute the allegation that 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” Applicant should simply deny this allegation. Applicant’s disagreement with Opposer’s allegation or the accuracy of its summaries of the cited decisions does not make the allegation of Paragraph 10 immaterial or irrelevant.

In addition, Applicant argues that the case citations in Paragraph 10 are irrelevant due to the dates of the decisions. However, to sufficiently plead its dilution claim, Opposer must allege that it had rights in its famous family of “Mc” or “Mac” marks prior to Applicant’s first use in commerce of its mark. Thus, the cases cited by Opposer are certainly relevant to show that the Trademark Trial and Appeal Board and Federal Circuit have recognized Opposer’s rights in its family of marks, and in particular, that they recognized Opposer’s rights in its famous family of marks long before Applicant began using its MAC PATIO mark. In addition, such decisions show the strength of Opposer’s rights for purposes of its likelihood of confusion and dilution analysis.

Moreover, Applicant argues that the case citations should be stricken because they are not factual allegations. However, the allegation that Applicant is asked to respond to is simply that 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.” Accordingly, Opposer’s inclusion of the case citations in support of its allegation does not

prejudice Applicant; rather, it provides fuller notice of Opposer's claim that it had rights in its famous family of "Mc" and "Mac" marks prior to Applicant's first use of the MAC PATIO mark. *See* TBMP § 506.01.

Finally, in a recent proceeding in which Opposer opposed the application of the trademark MACMASHIE, Opposition No. 91202725, the applicant filed a motion for a more definite statement with respect to Paragraphs 8 and 10 of Opposer's Notice of Opposition, which are nearly identical to Paragraphs 8 and 10 of Opposer's Notice of Opposition in the instant proceeding. The applicant of the MACMASHIE mark similarly argued that without the identification of goods and services and dates of first use of the marks alleged in Paragraph 8, it was unable to respond to Paragraph 8. In addition, the applicant argued that it disagreed with the case summaries alleged in Paragraph 10, and it therefore, could not respond to the allegations. The Board denied Applicant's motion for a more definite statement in its entirety, finding that the allegations at issue were neither vague nor ambiguous and provided the applicant with fuller notice of the claims. Accordingly, here too, Applicant's motion to strike should be denied.

WHEREFORE, for at least the foregoing reasons, Opposer respectfully requests that Applicant's Motion to Strike and request that the Board suspend further action in this proceeding be denied.

Respectfully submitted,

McDONALD'S CORPORATION

Date: June 29, 2012

By: /John A. Cullis/

Robert E. Browne  
John A. Cullis  
Lawrence E. James, Jr.  
Kathleen E. Blouin

NEAL, GERBER & EISENBERG LLP  
2 N. LaSalle Street, Suite 1700  
Chicago, IL 60602  
(312) 269-8000 Telephone  
(312) 269-1747 Facsimile

