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

Proceeding	91205193
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Atty. Ref.: 121.0904

MCDONALD'S CORP.,

Opposer,

v.

MACSPORTS, INC.,

Applicant.

Opposition No. 91205193

**APPLICANT'S REPLY TO OPPOSER'S
RESPONSE TO APPLICANT'S MOTION TO STRIKE**

Applicant, MACSPORTS, INC., by and through its undersigned counsel, submits this Reply Brief in response to OPPOSER'S RESPONSE TO APPLICANT'S MOTION TO STRIKE.

In response to Applicant's motion, Opposer argues Paragraphs 8 and 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."

With regard to Paragraph 8, a laundry list of 21 terms without reference to the goods or services on which they are (or were) allegedly used or the dates during which they are used does not give fair notice.

Even in its response, Opposer, at best, can state that it "from time to time adopted and used the marks listed in Paragraph 8." Opposer suggests that "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."

In order to properly plead a likelihood of confusion claim, Opposer must plead that it possesses earlier rights in its pleaded marks, the marks are similar, and the goods are similar. Similarly, in order to properly plead a dilution claim, it must plead that its mark (or marks) became famous prior to the date of first use or filing date of Applicant's mark.

Opposer's claims fail to meet this threshold standard. Its allegation that it used its 21 terms "from time to time" establishes nothing.

It is certainly true, as Opposer suggests, that Applicant may simply deny the allegation(s) of Paragraph 8. However, the availability of a denial is not a remedy for Opposer's deficient pleading.

Opposer further argues that the marks listed in Paragraph 8 "simply show the breadth of Opposer's 'Mac' family of marks." However, that is the very point: A laundry list of terms does *not* show the breadth of Opposer's alleged family of marks. If they are not in use, they are not trademarks. If they are not trademarks, they cannot comprise part of Opposer's alleged family of marks.

The allegation of Paragraph 8 is insufficient to establish that the terms identified therein are even marks. Opposer's failure to allege that any of these 21 marks were in use at the time Applicant filed its application or on the date of first use of Applicant's mark renders this allegation irrelevant and immaterial.

As the Board is well aware, a trademark is (1) a tangible symbol (a word, name, symbol or device or any combination of these); (2) that is actually adopted and used by a manufacturer or seller of goods or services in commerce that Congress may regulate; and (3) that identifies and distinguishes the seller's goods or services from those made or sold by others. MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 3:1 (4th ed.).

While Opposer asserts in its Response that “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.” The problem with this argument is that Opposer has not alleged sufficient factual arguments to conclude that the list of terms in Paragraph are being used – or have ever been used – *as trademarks*. Paragraph 8 states: “Opposer has also, from time to time used or is using other ‘Mc’ and ‘Mac’ formative trademarks, such as the following:....” Although Opposer styles the list of terms as “trademarks,” this allegation is a legal conclusion, not a factual allegation. Specifically, in order to establish that the terms listed in Paragraph 8 are in fact trademarks, Opposer must do more than simply list them and label them “trademarks”.

In order to plead these are trademarks, Opposer must plead: some goods or services on which it uses the marks, the date or dates on which Opposer began using such terms, and that Opposer was – or is – using the marks in commerce that Congress may regulate.

Having failed to plead facts sufficient to determine whether the terms listed in Paragraph 8 are trademarks, Paragraph 8 is irrelevant or immaterial and fails to provide notice of Opposer’s claims. By failing to establish the terms listed in Paragraph 8 are trademarks, Opposer cannot base a likelihood of confusion claim on them. Likewise, having failed to allege that these are indeed trademarks, they cannot comprise Opposer’s alleged family of marks.

Paragraph 8 does not provide fair notice. Rather, it is a self-serving conclusory legal assertion by which Opposer seeks to bootstrap marks that are likely not in use without any factual allegation to support Opposer’s claims.

Again, while Applicant has the ability to deny the allegation, the lack of relevant information provided by Paragraph 8 prejudices Applicant because Applicant is left to spend its

time and money – not to mention the limited number of interrogatories available to Applicant during discovery – to establish facts that that should have been pleaded in the Notice of Opposition.

Not knowing which of the 21 marks Opposer claims are currently in use, which were used for any period of time and which were intermittently used means Applicant must waste time and money. Given the level of discovery that would be required to probe Opposer’s claims, it is clear that Paragraph 8 fails to give fair notice of Opposer’s claims. For any mark not currently in use by Opposer, such mark supports neither Opposer’s likelihood of confusion claim nor its dilution claims. To the extent that Opposer has simply alleged a list of marks in a vacuum without reference to dates of use or goods or services on which they may have been used, this allegation provides no notice whatsoever.

To the extent that any of the marks identified in Paragraph 8 are not being used, they are not marks and cannot be relied on by Opposer to establish they are marks, a likelihood of confusion exists, Applicant’s mark dilutes Opposer’s mark(s) or that Opposer possesses a family of marks. As pleaded, they are “immaterial”.

In Opposition No. 91202725, the Board concluded: “such details are the central object of discovery and need not be pleaded.” However, this conclusion places the burden of Opposer’s pleading on Applicant. Indeed, any allegation in any Notice of Opposition may be probed during discovery. However, the very purpose of fair notice in a pleading is to provide sufficient notice to the other party about the type and scope of information to be sought during discovery. The purpose of discovery is to probe Opposer’s *properly pleaded* claims. Discovery is not a substitute for proper pleading. The fact that the information is discoverable during discovery does not remedy a deficient pleading. Further, the Board’s conclusion in Opposition No.

91202725 obviates the requirement of fair notice in pleadings and shifts the burden to Applicant to establish facts that should have been properly pleaded in the Notice of Opposition.

Hypothetically, if Opposer had pleaded only Paragraph 8 as its basis for a claim, it would assuredly be dismissed. If such claim – standing alone – would be insufficient to support a claim, the fact that Opposer has pleaded other, different facts cannot save Paragraph 8. In other words, the fact that the Notice of Opposition includes other claims that meet the relatively low pleading standard does save this deficient allegation.

Opposer’s allegation(s) in Paragraph 8, on their face, concedes that at least some of the 21 alleged marks identified in Paragraph 8 are not currently being used by Opposer (*i.e.*, “has... from time to time *used*”). “Used” is the past tense. Thus, Opposer does not allege current, valid use of all of the 21 terms identified in Paragraph 8 *as trademarks*. It is Opposer’s obligation to assert “enough detail to give the defendant fair notice of the basis for each claim”. TBMP § 309.03(a)(2). Moreover, Opposer must allege – and ultimately prove – that such use has continued to the present. *D. & M. Antique Import Corp. v. Royal Saxe Corp.*, 311 F. Supp. 1261, 166 U.S.P.Q. 302 (S.D.N.Y. 1969). The failure of Opposer to identify which, if any, of the 21 marks pleaded in Paragraph 8 are in fact in use and those which have been “used” – in the past – does not give Applicant sufficient notice of Opposer’s claims and renders it impossible for Applicant to consider, evaluate and respond to these claims.

A list of terms that may have been used – as trademarks or not – in the past do not establish anything “regarding the existence *at the present time* of a ‘famous family of marks containing the prefix ‘MC’””. *In re Jamil, et al.*, Opp. No. 76032587 (TTAB Feb. 17, 2005). Insofar as Opposer has stated the purpose of Paragraph 8 is to establish that “consumers worldwide associate trademarks distinguished by the ‘Mac’ formative with Opposer,” more than

naked allegations are required to support this theory. Again, however, if these marks are not in use *here and now*, they cannot comprise part of Opposer's alleged family of marks and they cannot contribute to the public's recognition of Opposer's family or marks *at the present time*.

With regard to Paragraph 10, in *In re Jamil, et al.* the Examining Attorney refused registration of **MCHEALTH CLINIC & Design** for *healthcare services, namely, preventative, alternative, and conventional healthcare* in Class 42, relying on *McDonald's Corp. v. McKinley*, 13 USPQ2d 1895 (TTAB 1989) and *McDonald's Corp. v. McClain*, 37 USPQ2d 1274 (TTAB 1995).

On appeal of that decision, the Examining Attorney argued:

As evidenced by the decisions of the ... Board, the McDonald's Corporation is widely known by consumers for its use of the prefix "MC" in conjunction with a wide variety of goods and services. Thus, the examining attorney maintains that consumers are likely to believe that **MCHEALTH CLINIC** is associated with the cited marks containing the wording ... **RONALD MCDONALD HOUSE**, and originates from the same source, namely, McDonald's Corporation.

The Board rejected this argument as follows:

The Examining Attorney's reliance on certain factual findings by the Board in *McDonald's Corp. v. McClain, supra*, and *McDonald's Corp. v. McKinley, supra*, to support her contention regarding the existence *at the present time* of a "famous family of marks containing the prefix 'MC'" is misplaced for several reasons. Not only are such cases, which were respectively decided on May 23, 1995 and September 25, 1989, *now over nine and 14 years old*, but even if they issued on the same date as this opinion, the findings of fact and conclusions of law stated therein do not constitute evidence which is binding on either applicant or the Board in this proceeding. *See, e.g., Faultless Starch Co. v. Sales Producers Associates, Inc.*, 530 F.2d 1400, 189 USPQ 141, 142-43 (CCPA 1976) [because ultimate conclusion regarding likelihood of confusion is necessarily drawn from all probative facts in evidence in each individual case, such conclusion, as distinguished from general rules of law or interpretation, cannot be controlled by earlier conclusions reached in another case]; and *National Dairy Products Corp. v. Parman-Kendall Corp.*, 122 USPQ 332, 333 (TTAB 1959) ["facts found by a court and the conclusions drawn therefrom in a case involving another party are not binding on this applicant or controlling on this tribunal"].

See In re Jamil.

While Applicant appreciates the procedural posture of *In re Jamil* and the instant case are different, the Board's conclusion applies equally to both *ex parte* appeals and *inter partes* proceedings.

Here, the cases identified by Opposer in Paragraph 10 are between 16 and 25 years old. Having determined that decisions that were 9 and 14 years old failed to support the contention regarding the existence *at the present time* of a "famous family of marks containing the prefix 'MC,'" it follows that decisions that are between 16 and 25 years old must also fail support Opposer's contention that, *at the present time*, a famous family of "MC" marks exists.

If, as in *In re Jamil*, reliance on cases that were 9 and 14 years old *as evidence* was irrelevant and immaterial, then cases that are between 16 and 25 years old are immaterial *as allegations* because, even if established through the introduction of evidence, as the Board stated, as evidence such decisions are immaterial to establish that Opposer possesses a "famous family of marks" *at the present time*.

Additionally, as the Board made clear, the findings of fact and conclusions of law stated in those remote decisions *do not constitute evidence* which is binding on either applicant or the Board. *See, e.g., Faultless Starch Co. v. Sales Producers Associates, Inc.*, 530 F.2d 1400, 189 USPQ 141, 142-43 (CCPA 1976).

Therefore, since the case citations and case summaries are irrelevant and immaterial, they must be stricken.

For the foregoing reasons, Applicant requests that the Board **STRIKE** Paragraph 8 from the Notice of Opposition and the portions of Paragraph 10 comprising case citations and Opposer's summaries of the same.

Date: July 10, 2012

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the REPLY TO OPPOSER'S RESPONSE TO APPLICANT'S MOTION TO STRIKE was served on counsel for Opposer at the following address of record, by email as agreed between the parties on May 23, 2012, this 10th day of July 2012:

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