

ESTTA Tracking number: **ESTTA1180214**

Filing date: **12/21/2021**

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	12/22/2021
Address	110 N. CARPENTER STREET CHICAGO, IL 60607 UNITED STATES
Attorney information	JOHN A. CULLIS BARNES & THORNBURG LLP ONE NORTH WACKER DRIVE, SUITE 4400 CHICAGO, IL 60606 UNITED STATES Primary email: trademarks-CH@btlaw.com Secondary email(s): john.cullis@btlaw.com, lee.james@btlaw.com, valerie.galassini@btlaw.com, btmcdonalds@btlaw.com 312-357-1313
Docket no.	85529-335111

Applicant information

Application no.	90457277	Publication date	08/24/2021
Opposition filing date	12/21/2021	Opposition period ends	12/22/2021
Applicant	Lewis, Jeremiah James PO BOX 854 NEW CANAAN, CT 06840 UNITED STATES		

Goods/services affected by opposition

Class 043. First Use: 0 First Use In Commerce: 0
All goods and services in the class are opposed, namely: Restaurant services, including sit-downservice of food and take-out restaurantservices

Grounds for opposition

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

Marks cited by opposer as basis for opposition

U.S. registration no.	1426681	Application date	09/30/1982
Register	Principal		
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>		

U.S. registration no.	1440655	Application date	09/30/1982
Register	Principal		
Registration date	05/26/1987	Foreign priority date	NONE
Word mark	MCDONALDS		
Design mark			
Description of mark	NONE		
Goods/services	<p>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</p>		

U.S. registration no.	743572	Application date	05/04/1961
Register	Principal		
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		
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U.S. registration no.	3074164	Application date	06/13/2002
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Register	Principal		
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Registration date	03/28/2006	Foreign priority date	NONE
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Word mark	MCDONALD'S ALL AMERICAN		
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Design mark			
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Description of mark	NONE		
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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		
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U.S. registration no.	1037773	Application date	07/31/1975
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Register	Principal		
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Registration date	04/13/1976	Foreign priority date	NONE
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Word mark	MCD		
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Design mark			
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Description of mark	NONE		
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Goods/services	Class 003. First use: First Use: 1975/01/00 First Use In Commerce: 1975/01/24 CONCENTRATED ALL PURPOSE CLEANER, SANITIZER-DETERGENT, DEEP FAT FRYER BOIL-OUT COMPOUND, STAINLESS STEEL CLEANER-DRESSING AND CHEMICAL CLEANER FOR GRILLS		
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U.S. registration no.	3201441	Application date	03/02/2006
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Register	Principal		
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Registration date	01/23/2007	Foreign priority date	NONE
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Word mark	MCCAFE		
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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.	3212858	Application date	03/02/2006
Register	Principal		
Registration date	02/27/2007	Foreign priority date	NONE

Word mark	MCCAFE		
Design mark	<h1>MCCAFE</h1>		
Description of mark	NONE		
Goods/services	Class 029. First use: First Use: 2001/05/02 First Use In Commerce: 2001/05/02 MILK-BASED BEVERAGES CONTAINING COFFEE,FRUIT AND FRUIT JUICE		

U.S. registration no.	2482828	Application date	06/19/1998
Register	Principal		
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	1485633	Application date	02/13/1984
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no.			
Register	Principal		
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.	1065885	Application date	02/05/1976
Register	Principal		
Registration date	05/17/1977	Foreign priority date	NONE
Word mark	MC CHICKEN		
Design mark			
Description of mark	NONE		
Goods/services	Class 029. First use: First Use: 1975/06/16 First Use In Commerce: 1975/06/16 COOKED CHICKEN FOR CONSUMPTION ON OR OFF THE PREMISES		

U.S. registration no.	1481974	Application date	09/29/1982
Register	Principal		
Registration date	03/22/1988	Foreign priority date	NONE
Word mark	MCCHICKEN		
Design mark			
Description of mark	NONE		
Goods/services	Class 042. First use: First Use: 1975/06/16 First Use In Commerce: 1975/06/16 RESTAURANT SERVICES		

U.S. registration no.	1266500	Application date	06/21/1982
Register	Principal		
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.	5241953	Application date	04/15/2015
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Register	Principal		
Registration date	07/11/2017	Foreign priority date	NONE
Word mark	MCDELIVERY		
Design mark			
Description of mark	NONE		
Goods/services	Class 043. First use: First Use: 2017/05/17 First Use In Commerce: 2017/05/17 SERVICES FOR PROVIDING FOOD AND DRINK; RESTAURANT SERVICES; OPERATING RESTAURANTS AND OTHER ESTABLISHMENTS OR FACILITIES ENGAGED IN PROVIDING FOOD AND DRINK PREPARED FOR CONSUMPTION AND SALE OF CARRY-OUT OR TAKE AWAY FOODS AND DRINKS		

U.S. registration no.	1947099	Application date	08/08/1991
Register	Principal		
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		

Attachments	78135408#TMSN.png(bytes) 73059270#TMSN.png(bytes) 78827670#TMSN.png(bytes) 78827644#TMSN.png(bytes) 86598144#TMSN.png(bytes) McAHH Notice of Opposition - 12.21.21.pdf(262902 bytes)
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Signature	/John A. Cullis/
Name	JOHN A. CULLIS
Date	12/21/2021

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

In the Matter of:
Application Serial No. 90/457,277

Published in the *Official Gazette*
On August 24, 2021

Mark: McAHH

Opposition No.: _____

McDONALD'S CORPORATION,

Opposer,

v.

JEREMIAH JAMES LEWIS,

Applicant.

NOTICE OF OPPOSITION

Opposer, McDonald's Corporation, a corporation organized and existing under the laws of the State of Delaware, with offices at 110 N. Carpenter Street, Chicago, Illinois 60607, believes that it will be damaged by registration of the McAHH application in International Class 43 as shown in Application Serial No. 90/457,277, filed by Applicant, Jeremiah James Lewis, an individual having an address at PO Box 854, New Canaan, Connecticut, United States 06840, and hereby opposes the same and requests that registration to Applicant be refused.

The grounds for this Notice of Opposition are as follows:

1. Applicant is seeking to register the McAHH mark for “Restaurant services, including sit-down service of food and take-out restaurant services” in International Class 43. The application is based on Applicant's alleged intent to use the mark filed under 15 U.S.C. § 1051(b).
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” family of marks, which includes “Mc” used with various generic or descriptive terms, to advertise, promote, and sell a variety of food products and restaurant services. Opposer has also used its family of “Mc” marks on a variety of goods and services that are not related to food

products or restaurant services, such as toys; charitable services; educational services; entertainment services; and men's, women's, and children's clothing, namely, t-shirts, hats, athletic shirts, sweatshirts, and jerseys.

5. Opposer's extensive advertising and promotion of its various goods and services under its family of "Mc" 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" family of marks on food product packaging and point-of-purchase advertising. In sum, Opposer uses its family of "Mc" marks in connection with products and services similar or related to those that Applicant intends to offer under the McAHH mark.

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.	McDONALD'S	1,426,681	01/27/1987	Chicken, hashbrown potatoes, prepared eggs, milk, fresh garden salads and processed ingredients thereof, for consumption on or off the premises; Hamburger and cheeseburger sandwiches and special combination sandwiches featuring hamburgers and cheeseburgers; hotcakes, table syrup, fruit pies, special combination egg sandwiches, tea, pastries, chicken sandwiches, pork sandwiches, and biscuit and sausage sandwiches for consumption on or off the premises; carbonated and non-carbonated soft drinks for

				consumption on or off the premises; Carbonated and non-carbonated soft drinks for consumption on or off the premises
2.	MCDONALDS	1,440,655	05/26/1987	Men's clothing, women's clothing and children's clothing, namely, t-shirts, hats, athletic shirts, sweat shirts and jerseys.
3.	McDONALD'S	743,572	01/08/1963	Drive-in restaurant services
4.	McDONALD'S ALL AMERICAN	3,074,164	03/28/2006	Entertainment services, namely, conducting athletic events in the nature of basketball and soccer clinics and competitions
5.	McD (Stylized)	1,037,773	04/13/1976	Concentrated all purpose cleaner, sanitizer-detergent, deep fat fryer boil- out compound, stainless steel cleaner- dressing and chemical cleaner for grills
6.	McCAFE	3,201,441	01/23/2007	Beverages made of coffee beans, hot chocolate, pastries, muffins, cakes, cookies, biscuits, and sandwiches
7.	McCAFE	3,212,858	02/27/2007	Milk-based beverages containing coffee, fruit and fruit juice
8.	McCAFE	2,482,828	08/28/2001	Restaurant services
9.	McMUFFIN	1,485,633	04/19/1998	Restaurant services
10.	McCHICKEN	1,065,885	05/17/1977	Cooked chicken for consumption on or off the premises
11.	McCHICKEN	1,481,974	03/22/1988	Restaurant services
12.	McDOUBLE	1,266,500	02/07/1984	A sandwich for consumption on or off premises
13.	McDOUBLE	3,635,809	06/09/2009	Restaurant services
14.	McDELIVERY	5,241,953	07/11/2017	Services for providing food and drink; restaurant services Operating restaurants and other establishments
15.	MC	1,947,099	01/09/1996	Restaurant services

Each of the aforesaid registrations is valid, subsisting, and in full force and effect.

Furthermore, Opposer applied to register and commenced use of the above-listed marks in

association with its respective designated services prior to the filing date of the subject application, January 10, 2021.

7. Each of the above-identified 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 and services set forth in the registrations.

8. Through Opposer's extensive and continuous use of the trademark McDONALD'S, and its "Mc" marks, the public has come to recognize marks combining "Mc" 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 filing dates of the subject application filed by Applicant.

9. Both the Trademark Trial and Appeal Board and the Federal Circuit have long recognized the validity of Opposer's rights to its famous "Mc" 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 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) (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.”).

10. Despite Opposer’s long-standing prior rights in its “Mc” family of marks for restaurant services, food products, clothing, and a wide variety of other goods and services, on January 10, 2021, Applicant filed its application to register the McAHH mark for “Restaurant services, including sit-down service of food and take-out restaurant services” in Class 43. Given Opposer’s widespread advertising and promotion of its “Mc” family of marks, Applicant’s selection and use of the McAHH mark, which incorporates the “Mc” prefix, suggests an intent by Applicant to trade off the goodwill and recognition associated with Opposer’s trademarks.

11. Potential purchasers, upon seeing the dominant “Mc” in the McAHH mark, are likely to mistakenly believe that the services offered thereunder originated or are connected with, or are sponsored, licensed or approved by, Opposer. Thus, the registration and proposed use by Applicant of the McAHH mark in connection with its services, 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).

12. Issuance of the registration to Applicant for the McAHH mark will also diminish and dilute the distinctive quality of Opposer’s rights in its famous “Mc” marks, and will blur and otherwise impair the distinctiveness of this family of marks in violation of 11 U.S.C. § 1125(c).

13. If a registration is issued to Applicant for the McAHH mark, the confusion with Opposer’s marks would result in damage and injury to Opposer and the public. Registration of the McAHH 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 services of Applicant 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 services not subject to Opposer's quality controls; and to restrict the natural growth of Opposer's "Mc" family of marks.

WHEREFORE, Opposer requests that this Opposition be sustained and Application Serial No. 90/457,277 be refused registration.

The requisite filing fee of \$600.00 and any additional fees related to this matter are being charged to a credit card concurrently with this filing.

Respectfully submitted,

McDONALD'S CORPORATION

Date: December 21, 2021

By: /John A. Cullis/
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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: December 21, 2021

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