

ESTTA Tracking number: **ESTTA155122**

Filing date: **08/06/2007**

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	08/08/2007
Address	One McDonald's Plaza Oak Brook, IL 60523-1900 UNITED STATES

Attorney information	Robert E. Browne Neal Gerber & Eisenberg 2 North LaSalle Street Suite 2200 Chicago, IL 60605 UNITED STATES rbrowne@ngelaw.com, mkelber@ngelaw.com, jcullis@ngelaw.com, ljames@ngelaw.com, ipdocket@ngelaw.com Phone:312-269-8000
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Applicant Information

Application No	78947247	Publication date	04/10/2007
Opposition Filing Date	08/06/2007	Opposition Period Ends	08/08/2007
Applicant	JMC Sales 20322 SE 240th St. Maple Valley, WA 98038 UNITED STATES		

Goods/Services Affected by Opposition

Class 029. First Use: 1990/00/00 First Use In Commerce: 1990/00/00
All goods and services in the class are opposed, namely: processed vegetables

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 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.	1118362	Application Date	09/23/1976
Registration Date	05/15/1979	Foreign Priority Date	NONE
Word Mark	MCPIZZA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 029. First use: First Use: 1976/08/30 First Use In Commerce: 1976/08/30 PREPARED FOOD PRODUCT CONSISTING PRINCIPALLY OF CHEESE, TOMATO, AND SEASONINGS TO BE USED ON TOAST		

U.S. Registration No.	3212858	Application Date	03/02/2006
Registration Date	02/27/2007	Foreign Priority Date	NONE
Word Mark	MCCAFE		
Design Mark			
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.	1315979	Application Date	06/11/1982
Registration Date	01/22/1985	Foreign Priority Date	NONE
Word Mark	MCRIB		
Design Mark			
Description of Mark	NONE		
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.	2429881	Application Date	02/24/2000
Registration Date	02/20/2001	Foreign Priority Date	NONE
Word Mark	MCSALAD SHAKER		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 029. First use: First Use: 1999/02/15 First Use In Commerce: 1999/02/15 Specialty salads for consumption on or off the premises		

U.S. Registration No.	1369360	Application Date	02/13/1984
Registration Date	11/05/1985	Foreign Priority Date	NONE
Word Mark	MCMUFFIN		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use: 1983/05/00 First Use In Commerce: 1983/05/00 BREAKFAST FOOD COMBINATION SANDWICH FOR CONSUMPTION ON OR OFF THE PREMISES		

U.S. Registration No.	2805109	Application Date	12/19/1997
Registration Date	01/13/2004	Foreign Priority Date	NONE
Word Mark	MCFLURRY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use: 1997/10/31 First Use In Commerce: 1997/10/31 dairy based dessert products namely ice cream and frozen confections		

U.S. Registration No.	1485636	Application Date	06/11/1985
Registration Date	04/19/1988	Foreign Priority Date	NONE
Word Mark	MCD.L.T.		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1985/06/03 First Use In Commerce: 1985/06/03 RESTAURANT SERVICES FEATURING A SANDWICH		

U.S. Registration No.	1566184	Application Date	07/05/1988
Registration Date	11/14/1989	Foreign Priority Date	NONE
Word Mark	MCCOOKIE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use: 1988/06/17 First Use In Commerce: 1988/06/17 SOFT SERVE ICE MILK SUNDAES FOR CONSUMPTION ON OR OFF THE PREMISES		

U.S. Registration No.	1943180	Application Date	01/06/1994
Registration Date	12/19/1995	Foreign Priority	NONE

		Date	
Word Mark	MCCOFFEE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1976/00/00 First Use In Commerce: 1976/00/00 restaurant services		

U.S. Registration No.	1541797	Application Date	01/19/1988
Registration Date	05/30/1989	Foreign Priority Date	NONE
Word Mark	MCCOLA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 032. First use: First Use: 1987/11/18 First Use In Commerce: 1987/11/18 SOFT DRINKS FOR CONSUMPTION ON OR OFF THE PREMISES		

U.S. Registration No.	2162170	Application Date	07/03/1997
Registration Date	06/02/1998	Foreign Priority Date	NONE
Word Mark	MCBURGER SUPREME		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use: 1997/03/31 First Use In Commerce: 1997/03/31 specialty sandwich for consumption on or off the premises		

U.S. Registration No.	804365	Application Date	10/14/1964
Registration Date	02/22/1966	Foreign Priority Date	NONE
Word Mark	MC DONALD'S		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class U046 (International Class 029). First use: First Use: 1948/12/00 First Use In Commerce: 1953/05/06 READY-TO-EAT HAMBURGER, CHEESEBURGER, AND FISH SANDWICHES, FRENCH FRIED POTATOES, HOT COFFEE, FRESH MILK, AND MILKSHAKES		

U.S. Registration No.	1453377	Application Date	05/16/1986
Registration Date	08/18/1987	Foreign Priority Date	NONE
Word Mark	MCBAGEL		
Design Mark			

Description of Mark	NONE
Goods/Services	Class 030. First use: First Use: 1986/03/18 First Use In Commerce: 1986/03/18 BAGELS FOR CONSUMPTION ON OR OFF THE PREMISES

U.S. Registration No.	1065885	Application Date	02/05/1976
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.	1552143	Application Date	11/23/1988
Registration Date	08/15/1989	Foreign Priority Date	NONE
Word Mark	MCCHILI		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 029. First use: First Use: 1988/05/20 First Use In Commerce: 1988/05/20 CHILI FOR CONSUMPTION ON AND OFF THE PREMISES		

Attachments	73100829#TMSN.gif (1 page)(bytes) 78827644#TMSN.jpeg (1 page)(bytes) 75926937#TMSN.gif (1 page)(bytes) 73542394#TMSN.gif (1 page)(bytes) Notice_of_opposition_for_McSweet.pdf (6 pages)(18970 bytes)
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Signature	/Robert E. Browne/
Name	Robert E. Browne
Date	08/06/2007

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

In the Matter of:
Application Serial No. 78/947,247
Published in the *Official Gazette*
April 10, 2007

McDONALD'S CORPORATION,)
)
 Opposer,)
)
 v.) Opposition No. _____
)
JMC SALES,)
)
 Applicant.)

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 "McSWEET" in International Class 29 as shown in Application Serial No. 78/947,247, filed by Applicant, JMC Sales, a sole proprietorship located at 20322 SE 240th Street, Maple Valley, Washington, 98038, and hereby opposes the same and requests that registration to Applicant be refused.

As grounds for its opposition, Opposer alleges that:

1. Applicant seeks to register a mark which consists of the term "McSWEET" for use in connection with "processed vegetables" in International Class 29 (hereinafter, the "McSWEET" Mark).
2. Opposer has obtained the necessary extension of time in which to file this Notice of Opposition.

3. Since 1955, Opposer has continuously used the name McDONALD’S as a trademark and service mark in its business of developing, operating, franchising, and servicing an extensive system of restaurants that prepare, package, and sell quickly-prepared, modestly-priced foods. In addition, Opposer has widely used the “Mc” formative alone and together with other words throughout the United States and the World as trademarks and service marks for, and in advertising and promotion of, a wide variety of food products and restaurant services, including, but not limited to: salads, chili, breakfast foods, specialty sandwiches, dessert products, chicken sandwiches, beverages, pizza and bagels. It has also used the “Mc” formative mark on a wide variety of goods and services that are not related to food products or restaurant services. Opposer has used its “Mc” formative marks with the same goods or type of goods for which registration of the “McSWEET” Mark is sought. In addition, Opposer is likely to further expand the use of its “Mc” formative marks to include additional goods that are the same or the same type of goods as those for which registration of the “McSWEET” Mark is sought.

4. Opposer owns a federal registration on “Mc,” Registration No. 1,947,099, issued on January 9, 1996 for restaurant services. Opposer also owns the following federal registrations of its “McDONALD’S” and “Mc” formative marks for goods or services, some of which are substantially similar or closely related by their nature or use to Applicant’s goods:

	<u>MARK</u>	<u>REG. NO.</u>	<u>REG. DATE</u>	<u>GOODS/SERVICES</u>
1	McPIZZA	1,118,362	05/15/79	Prepared food product consisting principally of cheese, tomato, and seasonings to be used on toast
2	McCAFE	3,212,858	02/27/07	Milk-based beverages containing coffee, fruit and fruit juice
3	McRIB	1,315,979	01/22/85	A sandwich for consumption on or off the premises

4	McSALAD SHAKER	2,429,881	02/20/01	Specialty salads for consumption on or off the premises
5	McMUFFIN	1,369,360	11/05/85	Breakfast food combination sandwich for consumption on or off the premises
6	McFLURRY	2,805,109	04/15/03	Dairy based dessert products namely ice cream and frozen confections
7	McD.L.T.	1,485,636	04/19/88	Restaurant services featuring a sandwich
8	McCOOKIE	1,566,184	11/14/89	Soft serve ice milk sundaes for consumption on or off the premises
9	McCOFFEE	1,943,180	02/19/95	Restaurant services
10	McCOLA	1,541,797	05/30/89	Soft drinks for consumption on or off the premises
11	McBURGER SUPREME	2,162,170	06/02/98	Specialty sandwich for consumption on or off the premises
12	McDONALD'S	804,365	02/22/66	Ready-to-eat hamburger, cheeseburger, and fish sandwiches, french fried potatoes, hot coffee, fresh milk, and milkshakes
13	McBAGEL	1,453,377	08/18/87	Bagels for consumption on or off the premises
14	McCHICKEN	1,065,885	05/17/77	Cooked chicken for consumption on or off the premises
15	McCHILI	1,552,143	08/15/89	Chili for consumption on and off the premises

These registrations are valid, subsisting, and in full force and effect.

5. Each of the aforesaid registrations is at least *prima facie* evidence of: (i) the validity of each registration; (ii) Opposer's ownership thereof; and (iii) Opposer's exclusive right to use the registered mark on the goods or services set forth in the registration. In addition, Opposer owns numerous other federal registrations of "Mc" formative marks for a variety of goods and services.

6. Through Opposer's long, extensive and continuous use of the mark McDONALD'S and its "Mc" formative marks, the public has come to recognize marks combining the "Mc" prefix with a common or descriptive word, when applied to a wide variety of goods and services, as a family of "Mc" marks 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.

7. Despite Opposer's long-standing prior rights in the McDONALD'S mark, as well as Opposer's "Mc" family of marks for food products, restaurant services, and a wide variety of other goods and services, Applicant filed its application to register the "McSWEET" Mark in connection with processed vegetables, which was assigned Application Serial No. 78/947,247.

8. The mark proposed for registration by Applicant uses, as its principal distinctive element, the "Mc" prefix. The distinctive "Mc" formative is coupled with the common word "sweet," which is a descriptive term used to describe a characteristic of the processed vegetables identified in Applicant's application for registration of its "McSWEET" Mark. Potential purchasers, upon seeing the distinctive formative "Mc" in Applicant's "McSWEET" Mark, are likely to mistakenly believe that such a term and the food product offered thereunder originated with or are connected or associated with, or sponsored, licensed or approved by Opposer. Thus, the registration and use by Applicant of the "McSWEET" Mark in connection with its proposed 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. § 1114(1)(a).

9. In addition, Opposer's "Mc" family of marks was well established and famous long before Applicant filed its application for registration of the "McSWEET" Mark. Thus, registration by Applicant is likely to diminish and dilute the distinctive quality of McDonald's

rights in its famous “Mc” formative family of marks in violation of 15 U.S.C. § 1125(c). Moreover, registration by Applicant is likely to diminish the advertising value of the “Mc” formative marks, and such registration and use is likely to, in the event of any quality problems involving the goods offered by Applicant, tarnish the distinctiveness of McDonald’s famous marks.

10. In light of Opposer’s widespread advertising, promotion and use of its “Mc” formative marks, Applicant’s selection of a term confusingly similar to Opposer’s long pre-existing family of “Mc” formative marks suggests that Applicant intends to trade off the goodwill and recognition associated with Opposer’s “Mc” family of marks.

11. If a registration is issued to Applicant for the “McSWEET” Mark, the confusion with Opposer’s marks would result in damage and injury to Opposer and the public. Registration of this mark would 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 by allowing any fault with or objection to Applicant’s goods to reflect upon Opposer; and to restrict the natural growth of Opposer’s family of “Mc” formative marks.

WHEREFORE, Opposer requests that this Opposition be sustained and Application Serial No. 78/947,247 be refused registration.

