

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB

NOV. 24, 98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

McDonald's Corporation

v.

Maureen Kelly

Opposition No. 100,619
to application Serial No. 74/624,036
filed on January 23, 1995

Carol Anne Been of Sonnenschein Nath & Rosenthal for
McDonald's Corporation

James M. Wagstaffe of Cooper, White & Cooper for Maureen
Kelly

Before Quinn, Hohein and Chapman, Administrative Trademark
Judges.

Opinion by Chapman, Administrative Trademark Judge:

An application has been filed by Maureen Kelly to
register the mark "McGREET."¹ on the Principal Register for
"greeting cards, note pads, stationery, self-stick removable

¹ The mark includes a period.

note pads".² The application is based on a bona fide intention to use the mark in commerce.

McDonald's Corporation has opposed the application, alleging that since 1955 opposer has used the name McDONALD'S as a trademark and service mark for an extensive system of restaurants which prepare and sell a limited menu of moderately-priced, quickly-prepared foods; that opposer has widely used the "Mc" prefix combined with generic terms as trademarks and service marks in connection with its restaurants, food products, and a wide variety of other goods and services including greeting cards, note pads, printed matter, stationery, gift and novelty items, and services related thereto; and that opposer owns registrations for both RONALD McDONALD³ and the design of the Ronald McDonald character⁴ for greeting cards, THE HOUSE THAT LOVE BUILT and design⁵ for greeting cards and envelopes, McNOTES and design⁶ for note pads,

² Application Serial No. 74/624,036, filed January 23, 1995.

³ Reg. No. 1,499,525, issued August 9, 1988, Section 8 affidavit accepted, Section 15 affidavit acknowledged. The claimed dates of first use and first use in commerce are March 1985.

⁴ Reg. No. 1,500,487, issued August 16, 1988, Section 8 affidavit accepted, Section 15 affidavit acknowledged. The claimed dates of first use and first use in commerce are March 1985.

⁵ Reg. No. 1,505,874, issued September 27, 1988, Section 8 affidavit accepted, Section 15 affidavit acknowledged. The claimed dates of first use and first use in commerce are November 1985.

⁶ Reg. No. 1,608,229, issued July 31, 1990, Section 8 affidavit accepted, Section 15 affidavit acknowledged. The word 'notes' is disclaimed. The claimed dates of first use and first use in commerce are October 25, 1989.

Opposition No. 100619

McQUESTION⁷ for preprinted paper note pads, and McCALENDAR⁸ for calendars; that opposer owns numerous registrations for other "Mc" formative marks for, inter alia, stationery, gift and novelty items and printed matter, and related services and for food products and restaurant services; and that through extensive and continuous use of the marks McDONALD'S and the "Mc" formative marks, opposer has developed a family of marks, such that the public recognizes opposer's marks utilizing the "Mc" prefix for diverse products outside the food service industry. Opposer further alleges that applicant's mark is formed by the "Mc" prefix together with the generic word "greet"; that applicant's selection of her mark suggests that applicant intends to trade off the good will and recognition associated with opposer's family of marks; and that applicant's mark, if used on her goods, would so resemble opposer's previously used and registered marks, such as McCALENDAR, McNOTES, McQUESTION, and McPRINT, as well as opposer's family of "Mc" formative marks, as to be likely to cause confusion, mistake, or deception.

Applicant denied the salient allegations of the notice of opposition.

⁷ Reg. No. 1,809,178, issued December 7, 1993. The claimed dates of first use and first use in commerce are March 1993.

⁸ Reg. No. 1,550,136, issued August 1, 1989, Section 8 affidavit accepted, Section 15 affidavit acknowledged. The claimed dates of first use and first use in commerce are August 22, 1988 and November 2, 1988, respectively.

The record consists of the pleadings; status and title copies of thirty-five of opposer's pleaded registrations submitted under a notice of reliance; the affidavit testimony of Roy T. Bergold, Jr., opposer's vice president-creative⁹; opposer's notice of reliance on portions of applicant's discovery deposition; and opposer's notice of reliance on certain of applicant's answers to opposer's interrogatories. Applicant submitted no evidence or testimony. Both parties filed briefs on the case.¹⁰ No oral hearing was requested.

⁹ The parties stipulated to the submission of testimony by way of affidavit. See Trademark Rule 2.123(b).

¹⁰ In opposer's reply brief, opposer objected to attachments to applicant's brief, specifically arguing that "the discovery deposition transcript and samples of greeting cards" attached to applicant's trial brief were untimely. Opposer also objected to an argument contained within applicant's brief, specifically that applicant made a reference for the first time to some "alleged channels of distribution that were not in the record". Opposer contended this was untimely. Opposer requested that these matters not be considered.

The Board's copy of applicant's trial brief is a facsimile copy submitted on September 4, 1998. The facsimile copy includes no exhibits or attachments. However, opposer's objection is well taken. The portions of applicant's discovery deposition which were properly and timely made of record by opposer under a notice of reliance form part of the record of this case, but applicant's submission of the entire discovery transcript is inappropriate, and would not be considered if it were attached to a copy of applicant's brief. We also do not have any samples of applicant's greeting cards submitted with applicant's brief. To the extent such cards were not made of record, they could not be considered even if they had been submitted with applicant's brief. However, we note that there are samples of applicant's greeting cards which were made of record as opposer's exhibit 30 to the Roy T. Bergold, Jr. affidavit testimony. As for applicant's reference within her brief regarding applicant's additional channels of trade (i.e., through publications such as Village Voice), because applicant did not properly submit any evidentiary support, this reference has not been further considered.

As a preliminary matter, applicant contends (in footnote 6 of her brief) that "preemption of an entire mode of commercial expression would pose substantial consequences under the First Amendment". This opposition proceeding involves the question of likelihood of confusion under the Trademark Act of 1946. The Board, being an administrative tribunal, determines only the question of the registrability of marks; the Board has no authority to determine the constitutionality of any portion of the law. See *Harjo v. Pro Football, Inc.*, 30 USPQ2d 1828, 1833 (TTAB 1994). See also, TBMP §102.01.

In this case opposer has filed status and title copies of several (35) of its pleaded registrations¹¹. Because opposer owns valid and subsisting registrations of its pleaded marks, the issue of priority does not arise. See *King Candy Company v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974); and *Humana Inc. v. Humanomics Inc.*, 3 USPQ2d 1696 (TTAB 1987).

¹¹ The status and title copies submitted by opposer include those listed in footnote 3 through 8, *supra*; as well as registrations for the mark McDONALD'S for drive-in restaurant services, and McDONALD'S and McDONALD'S and design for retail gift shop services and for a variety of goods including, "comic books, coloring books, paper party hats, and calendars"; McGIFT SHOP and McSTUFF STORE, both for retail gift shop services; McMAGAZINE and McMOMS, both for a general interest magazine for consumers; McMARKER for marker pens; McBUCKS and McDOLLAR for printed redeemable certificates; and RONALD McDONALD for restaurant services and a variety of goods.

Opposition No. 100619

Thus, the sole issue before the Board is likelihood of confusion. Based on the record before us in this case, we find that confusion is likely.

The affidavit testimony of Roy T. Bergold, Jr., opposer's vice president-creative, establishes that opposer began its restaurant business in 1955 under the mark McDONALD'S; and that the business has grown to be the world's largest food service company with over 12,000 restaurants worldwide. Annual sales in the United States grew from \$14.9 billion in 1994 to \$16.3 billion in 1996; and annual advertising expenditures went from over \$385 million in 1994 to over \$503 million in 1996. Opposer sells its goods and offers its services nationwide and worldwide through all available advertising media, including television, radio, newspapers, magazines, and point of purchase advertising. Opposer has developed and used a number of marks using the "Mc" formative, often combined with a generic term, including such marks as EGG McMUFFIN, McBAGEL, McDELIVERY, and McDONUTS. These marks have been used to identify opposer's goods and services.

Opposer has distributed greeting cards since 1985, and since 1990 opposer has sold holiday greeting cards with the proceeds benefiting the Ronald McDonald House Charities and Ronald McDonald Houses (one such card is imprinted with "Happy McHolidays!"). Opposer also distributes greeting

Opposition No. 100619

cards through its individual Ronald McDonald Houses around the country to support that particular Ronald McDonald House; and opposer has licensed its McDONALD'S marks for use in greeting cards, including cards by Hallmark. Opposer has distributed note pads under "Mc" formative marks such as McNOTES (since 1989) and McQUESTION (since 1993); and self-stick removable note pads under the mark McMOMS (since 1993). In addition, opposer distributes preprinted birthday party invitations and thank you cards for use by families who host parties at McDONALD'S restaurants, as well as trading cards featuring McDONALD'S characters and the McDONALDLAND racing team. Opposer also distributes a variety of stationery items and calendars, newsletters, and catalogs under various "Mc" formative marks such as McMARKER, McCALENDAR, McFIT, McHAPPENINGS, and McMAGAZINE. Opposer's McMARKER washable markers are sold in mass merchandisers such as Wal-Mart, and Kmart; and opposer sells gift and novelty items in its four retail gift shops using the marks McGIFT STORE, McGIFT SHOP and McSTUFF STORE. Opposer plans to continue to expand the products and services it offers and to continue coining and adopting new "Mc" formative marks.

Opposition No. 100619

The record shows that applicant, Maureen Kelly, has commenced use of her mark on greeting cards,¹² presenting them at the California Gift Show in Los Angeles in January 1995. Ms. Kelly, has offered her greeting cards for sale by personal solicitation, by direct mail, and to a variety of retail outlets, including card and gift shops, and she continues to attend the California Gift Show. She targets the general public ages 15-65 for sales of her cards. Ms. Kelly stated at her discovery deposition that one of her objectives is "to secure a licensing agreement with one of the major card manufacturers" (page 79), including Hallmark or Gibson. Her sales revenue in 1995 was \$400 and in 1996 was \$1100, with expenses totaling significantly over the sales income figures. Applicant adopted the mark "MCGREET." based on her national heritage and her mother's maiden name, McCurdy, and she ultimately liked "the sound of 'MCGREET'" (applicant's answer to opposer's interrogatory No. 4).

¹² In applicant's brief on the case she contended that with regard to her intent-to-use application, she had an intention to use the mark only on greeting cards; but she included other items in her application because she was advised in a communication with the Patent and Trademark Office that the description of goods should "be inclusive" (brief, p. 3). In fact, she states that "She has no intention to use the mark "MCGREET." on "note pads, stationery, markers or calendars" (brief, footnote 3). There is no proposed amendment to the identification of goods in her application. Therefore, the identification of goods remains "greeting cards, note pads, stationery, self-stick removable note pads". If applicant ultimately prevails in this case, the application will be remanded to the Examining Attorney for further examination of the question of applicant's bona fide intent to use her mark as to all originally listed items.

Opposition No. 100619

This record clearly establishes that, given opposer's advertising and sales figures, opposer is a major restaurant business, and that its McDONALD'S and RONALD McDONALD marks for restaurant services are famous. See *Kenner Parker Toys Inc. v. Rose Art Industries Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992).

In addition, opposer has shown that it has used other marks consisting of the "Mc" prefix followed by a generic or descriptive term, prior to applicant's filing date of January 23, 1995. The Court of Appeals for the Federal Circuit has explained that recognition of a family of marks is "achieved when the pattern of usage of the common element is sufficient to be indicative of the origin of the family." *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889, 1891 (Fed. Cir. 1991). We find that opposer's prior use and promotion of its McDONALD'S marks, and its various "Mc" formative marks, have been such that opposer has created a family of marks with the "Mc" prefix in combination with generic or descriptive words to form coined terms. See *McDonald's Corp. v. McBagel's, inc.*, 649 F. Supp. 1268, 1 USPQ2d 1761 (SDNY 1986); *McDonald's Corp. v. McKinley*, 13 USPQ2d 1895 (TTAB 1989); and *McDonald's Corp. v. McClain*, 37 USPQ2d 1274 (TTAB 1995).

Opposer has established that, as part of its family of marks, it uses the marks RONALD McDONALD and the design of

Opposition No. 100619

the character Ronald McDonald, as well as several "Mc" prefix marks in connection with stationery items. In particular, the marks McDONALD'S, RONALD McDONALD and the design of the character Ronald McDonald are used by opposer for greeting cards, as well as McNOTES (and design) for note pads, McMOMS for self-stick removable note pads, McQUESTION for preprinted paper note pads, McMARKER for marker pens, and McDONALD'S and McCALENDAR for calendars.

Applicant's mark, "MCGREET." is similar in format to opposer's various "Mc" formative marks and the purchasing public upon seeing her mark would believe applicant's goods are sponsored by or are associated with opposer.

Moreover, applicant uses her mark on greeting cards, goods which are identical to goods on which opposer's uses some of its marks. In addition, there is no evidence of third-party uses of any "Mc" prefix marks in the stationery or other fields.

We simply have no doubt that applicant's use of her mark, "MCGREET." for greeting cards, note pads, stationery and self-stick removable note pads would be likely to cause confusion, mistake, or deception with opposer's marks, including its family of marks consisting of the "Mc" prefix combined with various generic or descriptive terms used on stationery items, including greeting cards, and note pads.

Applicant argues that she adopted her mark because of her national heritage, and her mother's maiden name, McCurdy. (She further explained that she did not like "MCCARD" because of the alliteration of the two "c" letters together, and she selected "MCGREET." instead.) Even assuming, and the record does not suggest otherwise, that she is an innocent adopter and she did not intend to trade on opposer's marks or fame, that does not mean that the mark "MCGREET." is not likely to cause confusion.

Applicant's argument that there is no evidence of actual confusion is also not persuasive. In this case applicant commenced use of her mark in a de minimis manner only a few years ago. We simply cannot conclude that there has been an opportunity for confusion to occur. Moreover, the test is not actual confusion, but likelihood of confusion. See *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992).

Finally, applicant's argument that opposer submitted no consumer survey is likewise unpersuasive. The Board has stated that a survey is not required to establish a showing of likelihood of confusion. See *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423, 1435 (TTAB 1993).

Applicant, as the newcomer, had the obligation to select a mark which would avoid confusion. See *In re Hyper*

Opposition No. 100619

Shoppes (Ohio) Inc., 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); Hilson Research Inc., supra, at 1440; and Gillette Canada, supra, at 1774.

Opposition No. 100619

Decision: The opposition is sustained, and
registration to applicant is refused.

T. J. Quinn

G. D. Hohein

B. A. Chapman
Administrative Trademark Judges,
Trademark Trial and Appeal Board