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Mailed: April 22, 2004

Hearing:
December 12, 2003

Paper No. 33
TEH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

McDonald's Corporation
v.
2Bell B.V.

Opposition No. 91118911
to application Serial No. 75685456
filed on May 13, 1999

Robert E. Browne and Michael G. Kelber of Altheimer & Gray for McDonald's Corporation.

2Bell B.V., pro se.

Before Simms, Chapman and Holtzman, Administrative Trademark Judges.

Opinion by Holtzman, Administrative Trademark Judge:

An application has been filed by 2Bell B.V. ("2Bell") to register the mark MCDATE for "dating services."[1]

Registration has been opposed by McDonald's Corporation ("McDonald's" or "opposer"). As grounds for opposition, opposer asserts that since 1955 it has continuously used the mark

[1] Application Serial No. 75685456 filed May 13, 1999, based on Sections 1(b) and 44 of the Trademark Act.

MCDONALD'S in connection with its restaurant services; that it has used and registered the "MC" formative alone and together with other terms as marks in connection with its food products and restaurant services and in connection with a wide variety of other goods and services; that opposer owns a registration for "MC" for restaurant services and 35 registrations of its MCDONALD'S and "MC" formative marks for goods or services substantially similar or closely related by their nature or use to applicant's intended services;[2] that opposer has used or is likely to expand the use of its "MC" formative marks to include the same services or type of services on which MCDATE is intended to be used; that through opposer's extensive and continuous use of the name MCDONALD'S and its "MC" formative marks the public

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[2] The pleaded registrations include MCKIDS for children's personal care items; namely, cosmetics, shampoos, conditioners and soap (Reg. No. 1701330); MCMERCHANDISE for mail order services featuring novelty items (Reg. No. 1878115); MCGIFT SHOP ("Shop" disclaimed) for retail gift shop services (Reg. No. 1566577); MCDONALD'S for retail gift shop services (Reg. No. 1293424); MCNATURE TRAIL for providing recreational facilities for nature trips (Reg. No. 1591375); MCWIPES for pre-moistened hand cleaning towellettes for sanitizing hands (Reg. No. 1579085); MCMOMS for general interest magazines for consumers (Reg. No. 1874650); MCSHIRT for men's clothing, women's clothing and children's t-shirts and sweatshirts (Reg. No. 1592145); MCHAPPENINGS for newspaper columns on the subject of local news and community events (Reg. No. 1840527); MCBUDDY for non-monetary charitable services; namely, providing food, clothing, school supplies and the like to underprivileged children and families (Reg. No. 1926019); MCHOLIDAY for travel services; namely, providing travel and vacation information as well as reservation and planning assistance (Reg. No. 1847010); MCPREP for educational services, namely conducting classes, seminars, conferences and workshops in the fields of math, science, computers, communications, study skills and cultural enhancement, and distributing course materials in connection therewith (Reg. No. 1908924); MCSHUTTLE for transportation services, namely providing ground transportation services (Reg. No. 1418655); and MCLODGE for hotel services (Reg. No. 1562702).

has come to recognize marks containing or comprising the "MC" prefix, together with a common word, for a wide variety of goods and services as originating or being uniquely associated with opposer; that opposer has developed valuable goodwill with respect to each of its pleaded "MC" formative marks as well as for its entire "MC" family of marks; that applicant's mark consisting of "MC" coupled with the generic word "DATE" for the identified services is confusingly and deceptively similar to opposer's "MC" family of marks, particularly those used on similar services identified in its pleaded registrations, as well as its numerous other "MC" marks as used on a wide variety of other goods and services; and that applicant's selection of such a confusingly similar term suggests that applicant intends to trade off the good will and recognition associated with opposer's "MC" family of marks. In addition, opposer alleges that applicant's mark would diminish and dilute the distinctive quality of opposer's rights in its famous "MC" formative family and marks and could tarnish such distinctiveness under Section 43(c) of the Trademark Act.

Applicant, in its answer, has essentially denied the salient allegations in the notice of opposition, and has affirmatively asserted, inter alia, that there are numerous registrations for "MC" formative marks that are not owned by opposer; that applicant's mark is not similar to any of opposer's marks; and

that opposer is not rendering any services that are the same or related to dating services.

The record includes the pleadings; the file of the involved application; and opposer's two notices of reliance, one on email correspondence between applicant and opposer that was initiated by applicant and that took place between June 30, 1999 and May 15, 2000, and the other on color printouts from applicant's website and printed publications consisting of newspaper articles obtained from the Nexis database. The record also includes the testimony (with exhibits) of opposer's witnesses, Sheila Lehr, opposer's Managing Counsel and Roy T. Bergold, Jr., opposer's former Vice President – Creative. Exhibits introduced during the testimony deposition of Mr. Bergold include the declaration of Mr. Bergold that had previously been submitted in connection with a motion for summary judgment in this case and copies of the same web pages that were submitted under opposer's notice of reliance. The exhibits accompanying Ms. Lehr's deposition include the 35 registrations pleaded in the opposition and the same email correspondence submitted with opposer's notice of reliance.

Applicant neither attended the depositions of opposer's witnesses nor took any testimony in its own behalf. However, applicant filed a notice of reliance on Internet articles from third-party websites.[3]

[3] Applicant's notice of reliance was initially filed prematurely but was timely resubmitted during applicant's testimony period.

Only opposer filed a brief[4] and attended the oral hearing.

As a preliminary matter, we note that applicant and opposer each filed a motion to strike the other party's notice of reliance which the Board deferred until the time of final decision. We turn now to a consideration of those motions.

Opposer's motion to strike is well taken. Articles obtained from the Internet, such as those submitted by applicant, may be introduced into evidence through the testimony of a person who can properly authenticate and identify the materials. However, they do not constitute printed publications within the meaning of Trademark Rule 2.122(e) and may not be made of record by a notice of reliance. See TBMP § 704.08 (2nd ed. June 2003). Opposer's motion to strike is accordingly granted.[5]

Applicant has moved to strike opposer's notice of reliance on copies of newspaper articles and printouts from applicant's website on the grounds that "[o]pposer does not indicate the general relevance" of the evidence and because the evidence is "incompetent and relevant."[6] Opposer's notice sufficiently

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[4] Opposer's uncontested motion for an extension of time to file its main brief is granted, and its brief is accepted as timely.

[5] Moreover, it is clear from applicant's statement in its notice of reliance that it seeks to rely on the information contained in these articles for the truth of what those articles say. As such, the evidence would, in any event, be considered inadmissible hearsay.

[6] Although email correspondence would not ordinarily be admissible by notice of reliance, applicant not only submitted these documents itself in connection with a motion to extend its time to answer but continued to refer to the email exchange in its answer to the opposition. Therefore, this evidence is considered to have been stipulated into the

indicates the relevance of the evidence, and although website materials are not admissible by notice of reliance as explained above, these materials are of record because they have been introduced into evidence through the testimony of Mr. Bergold.[7] On the other hand, newspaper articles (and their electronic equivalents) constitute printed publications that may be properly submitted by a notice of reliance. See TBMP § 704.08 (2nd ed. June 2003). To the extent that opposer is relying on this evidence for the non-hearsay purpose of showing, for example, perception and extent of recognition of McDonald's marks, the evidence will be considered. Thus, applicant's motion to strike is denied.

We turn then to the merits of this case.

McDonald's began its restaurant operations in 1955, and since that time has become the world's largest food service company, with sales in the United States exceeding $19.5 billion in the year 2000, and worldwide sales of $33 billion in 1997 and over $40 billion in 2000. In 1998 alone, McDonald's served more than 40 million customers each day in over 24,000 restaurants worldwide. Since the 1970's, McDonald's has extensively used and promoted the "MC" formative in combination with generic words to identify a wide variety of products and services as part of the McDonald's family of marks.

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record. In any event, the documents have been properly introduced as exhibits to the testimony of Ms. Lehr.

Advertising expenditures for MCDONALD'S and the "MC" formative marks for McDonald's products and services in the United States approached $500 million in 1998 and exceeded that amount in 1999 and 2000. Opposer has advertised its "MC" formative marks in all available media including television, radio, newspapers, national magazines, telephone directories, outdoor signage, and point of purchase advertising. Long prior to the filing date of 2Bell's application, the "MC" formative itself was registered as a mark for restaurant services and opposer obtained numerous other registrations for "MC" formative marks, including its pleaded marks, covering a wide range of products and services. Prior to the filing date of the application, the MCDONALD'S mark appeared in a number of print advertisements for a diverse range of goods and services in association with other "MC" formative marks such as, MCKIDS, RONALD MCDONALD, and MAYOR MCCHEESE for children's clothing; MCJOBS, and MAC TONIGHT for educational programs; MCRECYCLE USA and MCDONALD'S PLAYLAND for recycling programs; and HALLOWEEN MCNUGGET BUDDIES and MCDONALD HAPPY MEALS for food products.[8] In addition, for more than 40 years, McDonald's has extensively used and promoted its red, yellow and white trade dress, including the yellow or "golden" arches to designate the "M" in the McDonald's name.

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[7] Applicant has not suggested that applicant is not the owner of that website or that the materials were not obtained from its website.

Applicant, 2Bell B.V., is a Dutch corporation with its office in The Netherlands. Applicant filed its application for the mark MCDATE on May 13, 1999 based on an intent to use the mark in commerce (and under Section 44 of the Trademark Act), but at some point began using the mark on the Internet. The record shows that applicant was operating a website (in a language which is presumably Dutch) for its MCDATE services at least as of August 3, 2001, the date on which Mr. Bergold viewed the website. Opposer has introduced color copies of selected pages from that site. The record also shows that on June 30, 1999, applicant sent an email communication to a representative of McDonald's Corporation proposing a joint project involving the mark MCDATE. A series of email exchanges between applicant and McDonald's followed. In an email dated February 28, 2000, applicant described its proposal as one which would "...combine a concept of 'serious dating with restaurant dining.'"

Through the testimony of Sheila Lehr, opposer introduced copies of 35 registrations for its pleaded marks testifying that each of the registrations is subsisting and owned by opposer. Thus, there is no issue with respect to opposer's priority. King Candy Co. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to

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[8] The run dates for these advertisements have been determined, for the

the factors bearing on the likelihood of confusion issue, including the similarity of the marks and the similarity of the goods and services. In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). The factors deemed pertinent in this proceeding are discussed below.

The record as a whole sufficiently establishes that McDonald's is the owner of a family of marks consisting of the prefix "MC" and a generic term. The evidence shows that the "MC" family feature is distinctive (i.e., not descriptive or highly suggestive or commonly used in the trade), and that long before 2Bell filed its application, opposer extensively used and registered numerous marks containing the "MC" family feature and advertised the MCDONALD'S mark in association with other marks in the family. There is no question that this record establishes that the public recognizes this family name and associates it with McDonald's.[9]

The evidence also shows that opposer's "MC" family of marks is strong and famous and entitled to a broad scope of protection. In 2000 alone, McDonald's expended more than $500 million in advertising for its various products and services and, in that

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most part, from the face of the advertisements.

[9] Moreover, the "MC" formative family has been recognized in a number of published decisions by this Board and by the courts. See, e.g., J & J Snack Foods Corp. v. McDonald's Corp., 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991); McDonald's Corp. v. Druck and Gerner, 814 F.Supp. 1127, 26 USPQ2d 1492 (DC NNY 1993); Quality Inns International v. McDonald's Corp., 695 F.Supp. 198, 8 USPQ2d 1633 (DC MD 1988); McDonald's Corp. v. McBagel's Inc., 649 F. Supp. 1268, 1 USPQ2d 1761 (DC SNY 1986); and McDonald's Corp. v. McClain, 37 USPQ2d 1274 (TTAB 1995).

same year, sales exceeded $19.5 billion in the United States and $40 billion worldwide for those products and services. There is no evidence in the record of third-party use or registration of "MC" formative marks in any field.[10]

Turning to the marks, we find that MCDATE is substantially similar to opposer's strong and famous "MC" family of marks. The marks have the same prefix and the same structure and format. Applicant's mark MCDATE, as with many of opposer's marks, is composed of the "MC" family feature followed by a descriptive or generic word. Applicant, in its answer, argues that none of the 35 marks pleaded by opposer in the opposition is similar to MCDATE. However, where a family of marks has been established, the determination of whether marks are similar is based on a comparison of the challenged mark with the family of marks as a whole, not necessarily any individual mark in the family. In this case, there is no question that MCDATE would simply be perceived by consumers as another member of McDonald's "MC" family of marks. We also note that applicant has prominently depicted MCDATE on its website in a red and gold color scheme and style of lettering that is remarkably similar to certain elements

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[10] Applicant submitted copies and a list of registrations with its answer arguing that there are numerous third-party registrations containing the "MC" formative in their marks that are not owned by McDonald's. However, applicant failed to make any third-party registrations of record during its testimony period. Moreover, such evidence, even if it were of record, would not necessarily diminish the value of opposer's "MC" family of marks. See J & J Snack Foods Corp. v. McDonald's Corp., supra.

of opposer's distinctive trade dress, further reinforcing a connection with McDonald's and the perception of MCDATE as part of McDonald's family marks.[11]

We turn then to the goods and services. Opposer does not provide dating services. Nor does opposer appear to have any intention of expanding into this field. When asked what struck him about applicant's website, Mr. Bergold responded,

> Well, when I first saw it, I immediately assumed that it was McDonald's Corporation that was getting involved in a license for dating services, and frankly, I would have been very much against that and would not have allowed that in my past tenure."
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> ...
>
> Because I don't think a dating service is commensurate with the image and the values and the principles that McDonald's stands for. ...
>
> Bergold Dep., p. 52.

Nevertheless, the question is not whether opposer does, or even would, provide dating services, but rather whether the purchasing public would believe, in view of the fame of opposer's family of marks and the similarity of MCDATE to that family, and in light of the numerous and diverse nature of the goods and services on which opposer already uses its marks, that McDonald's either provides a dating service, or that it is a service that is

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[11] It is not improper to consider these materials as evidence of the meaning or commercial impression the mark projects. See, e.g., Specialty Brands v. Coffee Bean Distributors, Inc., 748 F.2d 669, 223 USPQ 1281 (Fed. Cir. 1984); and In re Nationwide Industries, Inc., 6 USPQ2d 1882 (TTAB 1988). We nevertheless have based our finding that the marks are similar on applicant's mark in typed form as it appears in the drawing.

endorsed by, or in some way associated with, McDonald's. We have no doubt that they would.

In addition, the record shows that McDonald's is involved in numerous community service activities offered under its family of "MC" marks ranging from recycling programs (MCRECYCLE USA) to job training programs (MCJOBS). Opposer also promotes its restaurants as a place for social functions and interaction by sponsoring such activities as movie nights, jazz nights, candlelight dinners, "cruise" nights, and music concerts and festivals. Mr. Bergold referred to a series of television commercials (one featuring Michael J. Fox) that conveyed an image of McDonald's restaurants as a place "you'd be very comfortable bringing a date." Bergold Dep., pp. 19-20.

The record also includes newspaper articles describing current trends in dating and dating services in terms of the quality and speed of a McDonald's operation. For example,

> 'It's almost McDonald's approach to dating - slap them together and move them out...' *The Washington Times* (July 20, 1998).
>
> 'Americans are uptight about sex and rejection,' she says, 'so we believe in ideas like love at first sight. It's a McDonald's approach to love. ...' *Daily News* (New York) (February 10, 1998).
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> [regarding video dating services] Californian Jeffrey Ullman,... ...who may turn out to be the Ray Kroc of McDates, has sold his service around the concept of "quality singles." *The Washington Post* (February 14, 1988).

The use of MCDATE to identify dating services would clearly evoke an association with McDonald's and, further, a belief by

purchasers that those dating services originate with, or are sponsored by or are in some way connected with McDonald's.

Moreover, McDonald's numerous consumer goods and services and applicant's dating services would all be offered to ordinary consumers who would not necessarily be likely to exercise the degree of care necessary to prevent confusion. See Kimberly-Clark Corp. v. H. Douglas Enter., Ltd., 774 F.2d 1144, 1146, 227 USPQ 541 (Fed. Cir. 1985).

Opposer has also alleged that applicant intended to trade off the good will and recognition associated with opposer's "MC" family of marks. Applicant in its answer denied that allegation and affirmatively asserted that MCDATE was in existence as a mark before applicant contacted McDonald's with applicant's proposal; that the selection of "MC" was "merely a coincidence" and that applicant's proposal to McDonald's regarding the "mcdate-project" had nothing to do "in itself" with the creation of the mark (Applicant's Answer, p. 8); that the mark was created in The Netherlands with the idea that the mark "should be short, concise, strong, self-explanatory, friendly, ... [and] fit within family values" (Applicant's Answer, p. 10); and that applicant took the name from "the original Dutch project name, the abbreviation for 'menugestuurde computer date' by taking the 'm' and 'c' from the first letters in the first two words and adding 'date' on to it" (Applicant's Answer p. 10). In an email to a McDonald's representative on February 28, 2000, applicant

described its business proposal as a project designed to "combine a concept of 'serious dating with restaurant dining'."

Applicant's selection of MCDATE based on the same image and values associated with McDonald's,[12] applicant's attempt, by its business proposal, to tap into McDonald's restaurant market, and, out of a world of trade dress options, applicant's decision to depict MCDATE on its website in a color scheme and style that is remarkably similar to McDonald's well-known and distinctive trade dress, all lead us to conclude that applicant, by its selection and use of the mark MCDATE, fully intended to promote an association of the mark with McDonald's.

At a minimum, applicant was clearly aware of opposer's marks and, as the newcomer, had the obligation to avoid confusion by adopting a mark which is not similar to those marks. In re Shell Oil Co., 992 F.2d 91204, 26 USPQ2d 1687 (Fed. Cir. 1993); and Nina Ricci S.A.R.L. v. E.T.F. Enterprises Inc., 889 F.2d 1070, 12 USPQ2d 1901 (Fed. Cir. 1989).

Decision: The opposition is sustained on the ground of likelihood of confusion.[13]

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[12] "...the brand McDonald's...stands for...such things as quality, service, cleanliness, value, consistency, good for kids, good for the whole family." Bergold Dep., p. 23.

[13] Having determined that opposer is entitled to prevail on the ground of likelihood of confusion, we need not reach the issue of dilution.