

ESTTA Tracking number: **ESTTA1155904**

Filing date: **08/26/2021**

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		
Entity	Corporation	Citizenship	Delaware
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, melissa.mattio@btlaw.com, btmcdonalds@btlaw.com 312-357-1313		
Docket Number	85529-332398		

Applicant Information

Application No.	90194703	Publication date	08/17/2021
Opposition Filing Date	08/26/2021	Opposition Period Ends	09/16/2021
Applicant	McFungi 21622 MARGUERITE PKWY, APT#227 MISSION VIEJO, CA 92692 UNITED STATES		

Goods/Services Affected by Opposition

Class 025. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Tee-shirts

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

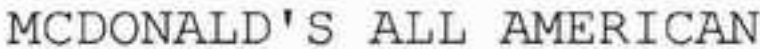
U.S. Registration No.	1426681	Application Date	09/30/1982
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Registration Date	01/27/1987	Foreign Priority Date	NONE
Word Mark	MCDONALDS		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 029. First use: First Use: 1948/00/00 First Use 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
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
Registration Date	01/08/1963	Foreign Priority Date	NONE
Word Mark	MCDONALD'S		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 042. First use: First Use: 1948/12/00 First Use In Commerce: 1953/05/06 Drive-In Restaurant Services</p>		

U.S. Registration No.	3074164	Application Date	06/13/2002
Registration Date	03/28/2006	Foreign Priority	NONE

		Date	
Word Mark	MCDONALD'S ALL AMERICAN		
Design Mark			
Description of Mark	NONE		
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		

U.S. Registration No.	1037773	Application Date	07/31/1975
Registration Date	04/13/1976	Foreign Priority Date	NONE
Word Mark	MCD		
Design Mark			
Description of Mark	NONE		
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		

U.S. Registration No.	3201441	Application Date	03/02/2006
Registration Date	01/23/2007	Foreign Priority Date	NONE
Word Mark	MCCAFE		
Design Mark			
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
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.	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.	1266500	Application Date	06/21/1982
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
Registration Date	07/11/2017	Foreign Priority Date	NONE
Word Mark	MCDELIVERY		

Design Mark	MCDELIVERY
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

Attachments	78135408#TMSN.png(bytes) 73059270#TMSN.png(bytes) 78827670#TMSN.png(bytes) 78827644#TMSN.png(bytes) 86598144#TMSN.png(bytes) McFungi and Design - Notice of Opposition.pdf(53376 bytes)
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Signature	/John A. Cullis/
Name	John A. Cullis
Date	08/26/2021

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

In the Matter of:
Application Serial No. 90194703

Published in the *Official Gazette*
on August 17, 2021

Mark: McFungi and Design

Opposition No.: _____

McDONALD'S CORPORATION,

Opposer,

v.

MCFUNGI, LLC

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 McFungi design mark in International Class 25 as shown in Application Serial No. 90/194,703, filed by Applicant, McFungi, LLC, a company having an address at 21622 Marguerite Pkwy, Apt. # 227, Mission Viejo, California 92692, 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 design mark McFungi for "Tee-shirts" in International Class 25. The application is based on applicant's 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 McFungi design 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.	McCHICKEN	1,065,885	05/17/1977	Cooked chicken for consumption on or off the premises
9.	McDOUBLE	1,266,500	02/07/1984	A sandwich for consumption on or off premises
10.	McDELIVERY	5,241,953	07/11/2017	Services for providing food and drink; restaurant services Operating restaurants and other establishments

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 goods prior to the filing date of the subject application, September 20, 2020.

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 or 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 September 20, 2020, Applicant filed its application to register the McFungi design mark for “Tee-shirts” in International Class 25. Given Opposer's widespread advertising and promotion of its “Mc” family of marks, Applicant’s selection and use of the McFungi design 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 McFungi design mark, are likely to mistakenly believe that the goods offered thereunder originated or are connected with, or are sponsored, licensed or approved by, Opposer. Thus, the registration and use by Applicant of the McFungi design mark in connection with its 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. § 1052(d).

12. Issuance of the registration to Applicant for the McFungi design 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 McFungi design mark, the confusion with Opposer's marks would result in damage and injury to Opposer and the public. Registration of the McFungi design 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 goods 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

goods 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. 90/194,703 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: August 26, 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: August 26, 2021

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