

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Hearing:
June 24, 2014

Mailed:
July 14, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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McDonald's Corporation
v.
Joel D. Joseph
—

Opposition No. 91194117
—

John A. Cullis of Neal, Gerber & Eisenberg, LLP for McDonald's Corporation.

Joel D. Joseph *pro se*.
—

Before Seeherman, Bergsman and Greenbaum, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Joel D. Joseph ("Applicant") filed an intent-to-use application to register the mark **BioMcDiesel**, in standard character form, for "biodiesel fuel," in Class 4.¹

McDonald's Corporation ("Opposer") opposed the registration of Applicant's mark on the grounds of likelihood of confusion, Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d); dilution, Section 43(c) of the Trademark Act, 15 U.S.C. §

¹ Serial No. 77697097, filed March 23, 2009.

1125(c); and Applicant's alleged lack of a *bona fide* intent to use the **BioMcDiesel** mark at the time Applicant filed his application.

I. The Pleadings

A. Likelihood of Confusion.

With respect to its likelihood of confusion claim, Opposer pled, *inter alia*, the following:

1. "McDonald's has, for decades, extensively used its 'Mc' family of marks, which includes the 'Mc' formative used with various generic or descriptive terms, as trademarks and service marks in advertising, promoting and selling various food products and restaurant services. McDonald's even maintains a registration for the 'Mc' mark alone." (Paragraph No. 4 of Opposer's Amended Notice of Opposition). Applicant admitted the allegations noted above.

2. "Over the past forty years, McDonald's has expanded its use of 'Mc' formative marks across a wide variety of non-restaurant related goods and services." (Paragraph No. 4 of Opposer's Amended Notice of Opposition). Applicant denied the above-noted allegation. However, Applicant admitted that "McDonald's has historically used numerous 'Mc' formative marks in commerce in connection with a variety of non-food related services." (Paragraph No. 6 of Opposer's Amended Notice of Opposition).

3. Opposer pleaded ownership of 21 registered "Mc" formative marks, including **Mc** for "restaurant services,"² **Egg McMuffin** for a "breakfast food

² Registration No. 1947099; renewed.

combination sandwich,”³ **Chicken McNuggets** for “chicken for consumption on or off the premises,”⁴ **Sausage McMuffin** for “breakfast food combination sandwich and restaurant services,”⁵ **McNuggets** for “restaurant services,”⁶ **McMuffin** for “restaurant services,”⁷ and **Sausage McGriddles** for “sandwiches consisting of sausage and hot cakes.”⁸ (Paragraph No. 4 of Opposer’s Amended Notice of Opposition). Applicant admitted that Opposer is the owner of the pleaded registrations and that the registrations are active.

4. “As a result of the use, over many years, of various ‘Mc’ formative marks such as those listed above, McDonald’s has developed exceedingly valuable goodwill with respect to its ‘Mc’ family of marks. Such use has caused consumers worldwide to associate composite terms incorporating ‘Mc’ with McDonald’s. As a result of its efforts, McDonald’s ‘Mc’ family of marks is famous and was famous long prior to Applicant’s filing of his application for the BioMcDiesel Mark.” (Paragraph No. 8 of Opposer’s Amended Notice of Opposition). Applicant admitted the allegations in this paragraph.

5. “Applicant’s advertising and intended use of the BioMcDiesel Mark will inevitably reach the same consumers that McDonald’s targets with its use of its

³ Registration No. 1002949; second renewal.

⁴ Registration No. 1276402; second renewal

⁵ Registration No. 1455616; renewed.

⁶ Registration No. 1450104; renewed.

⁷ Registration No. 1485633; renewed.

⁸ Registration No. 2570299; renewed.

famous ‘Mc’ family of marks.” (Paragraph No. 10 of Opposer’s Amended Notice of Opposition). Applicant admitted the allegations in this paragraph.

6. “Consumers, upon seeing the BioMcDiesel Mark used in connection with Applicant’s products are likely to mistakenly believe that such a term and the goods provided in connection with it originated with or are connected with, sponsored by, associated with, or licensed or approved by McDonald’s. Thus, the registration and use by Applicant of the BioMcDiesel Mark in connection with the recited goods is likely to cause confusion, mistake, or deception in violation of 15 U.S.C. § 1052(d).” (Paragraph No. 11 of Opposer’s Amended Notice of Opposition). Applicant denied the allegations in this paragraph.

B. Dilution.

With respect to its dilution claim, Opposer pled, *inter alia*, “the BioMcDiesel Mark would also diminish the distinctive quality of McDonald’s rights in its famous ‘Mc’ family of marks and would blur and otherwise impair the distinctiveness of this family of marks, in violation of 15 U.S.C. § 1125(c).” (Paragraph No. 12 of Opposer’s Amended Notice of Opposition). Applicant denied the allegations in this paragraph.

C. Lack of a bona fide intent to use.

Finally, Opposer alleged that Applicant did not have a bona fide intent to use the **BioMcDiesel** mark because Applicant selected the mark with the intent that consumers would associate it with McDonald’s “Mc” family of marks so that Applicant could license the use of the mark by a joint venture with Opposer.

(Paragraph Nos. 14-20 in Opposer's Amended Notice of Opposition). Applicant denied the allegations in these paragraphs.

II. The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), Applicant's application file. In addition, Opposer introduced the following testimony and evidence:⁹

A. Notice of reliance on the following items:

1. Copies of Opposer's pleaded registrations printed from the electronic database records of the USPTO showing the current status and title to the registrations;¹⁰

2. Excerpts from Applicant's discovery deposition with attached exhibits;¹¹

3. Applicant's responses to Opposer's interrogatories;¹²

4. Applicant's responses to Opposer's requests for admission;¹³

5. Applicant's responses to Opposer's request for production of documents;¹⁴

⁹ Applicant did not introduce any testimony or evidence.

¹⁰ 49 TTABVue 6 – 85.

¹¹ 49 TTABVue 86 – 283. Applicant cited to this evidence in its Appeal Brief. In its Reply Brief, Opposer argues that Applicant "cannot cite to his own deposition testimony except as a means to clarify or dispute [Opposer's] use of the testimony." (Reply Brief, p. 2). Opposer is incorrect. When a discovery deposition or a response to written discovery has been made of record by one party, it may be referred to by any party for any purpose permitted by the Federal Rules of Evidence. Trademark Rule 2.120(j)(7).

¹² 49 TTABVue 284 – 289.

¹³ 49 TTABVue 299 – 313.

6. Documents constituting official records pursuant to Trademark Rule 2.122(e);¹⁵

7. Documents obtained from the Internet pursuant to *Safer Inc. v. OMS Investments Inc.*, 94 USPQ2d 1031 (TTAB 2010);¹⁶ and

8. Documents from printed publications pursuant to Trademark Rule 2.122(e);¹⁷

B. Testimony deposition of Mindee Fernando, Opposer's Sourcing Supervisor, who is responsible for arranging for trash and recycling services for Opposer, with attached exhibits;¹⁸

C. Testimony deposition of Gail Crockett, Director of Opposer's Supply Chain, with attached exhibits;¹⁹

D. Testimony deposition of David Bruce Crown, Opposer's Central Division Development Officer, with attached exhibits;²⁰

¹⁴ 49 TTABVue 314 – 323. A party that has obtained documents through a response to a request for production of documents may not make the documents of record by a notice of reliance. Trademark Rule 2.120(j)(3)(ii). However, as in this case, when no documents exist which are responsive to a document request, a party's response that no documents exist may be made of record. *See City National Bank v. OPGI Management GP Inc./Gestion OPGI Inc.*, 106 USPQ2d 1668, 1674 n.10 (TTAB 2013) (responses to document production requests are admissible solely for purposes of showing that a party has stated that there are no responsive documents).

¹⁵ 50 TTABVue 2 – 326 and 51 TTABVue 2 – 139.

¹⁶ 51 TTABVue 140 – 212.

¹⁷ 51 TTABVue 213 – 260 and 52 TTABVue 2 – 106. We did not consider the foreign documents because there is no basis for us to assume that they would be encountered by the relevant U.S. consumers.

¹⁸ 57 TTABVue for the non-confidential testimony and 58 TTABVue for the confidential testimony.

¹⁹ 60 TTABVue for the non-confidential testimony and 61 TTABVue for the confidential testimony.

E. Testimony deposition of Brian Nicholas Kramer, Opposer's Director of Sustainable Supply Chain APMEA (Asia, Pacific, Middle East and Africa), with attached exhibits;²¹

F. Testimony deposition of Peter Sterling, Opposer's Vice President of Marketing, with attached exhibits;²² and

G. Testimony deposition of Eric Gallender, Senior Counsel for Opposer, with attached exhibits.²³

III. Standing

Because Applicant has admitted that Opposer owns its pleaded registrations and that Opposer has a family of "Mc" formative marks, Opposer has standing. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982). In addition, Opposer has made these registrations of record and, as discussed below, Opposer has established through the testimony of its witnesses and other evidence that it has a "Mc" formative family of marks.

IV. Priority

Because Applicant has admitted that Opposer's pleaded registrations for marks comprising its "Mc" formative family of marks are active and owned by

²⁰ 72 TTABVue for the non-confidential testimony and 65 TTABVue for the confidential testimony.

²¹ 81 TTABVue for the non-confidential testimony and 66 TTABVue for the confidential testimony.

²² 84 TTABVue for the non-confidential testimony and 75 TTABVue for the confidential testimony.

²³ 80 TTABVue.

Opposer and because Applicant admitted that Opposer's "Mc" family of marks is famous and was famous long prior to Applicant's filing of his application, Section 2(d) priority is not an issue in this case as to the marks and the goods and services covered by the pleaded registrations. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).²⁴ In addition, as discussed below, Opposer has shown that it established its "Mc" formative family of marks prior to the filing date of Applicant's intent-to-use application which, in the absence of any evidence of use, is the earliest date on which Applicant can rely.

V. Likelihood of Confusion

We base our determination under Section 2(d) on an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) ("*du Pont*"). *See also, In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003).

A. Family of "Mc" marks.

As indicated above, Applicant has admitted that Opposer has extensively used a "Mc" family of marks, which includes the "Mc" formative used with various generic or descriptive terms to identify Opposer's food products and restaurant services, that Opposer has used numerous "Mc" formative marks in commerce in

²⁴ *See also* Applicant's response to Opposer's Request for Admission No. 26 (49 TTABVue 304).

connection with a variety of non-food related services, and that such use has caused consumers to associate composite terms incorporating “Mc” with Opposer.²⁵

In addition, the testimony and evidence establish that Opposer has a “Mc” formative family of marks. Opposer began using the “Mc” formative in 1968 with the introduction of the Egg McMuffin breakfast product in connection with the McDonald’s house mark.²⁶ In 1974, Opposer ran a national television commercial advertising the McDonald’s “Mc” formative family of marks by introducing the public to “McLanguage.”²⁷

Ready, gang?

Ready, Ronald.

Ah-one, ah-two.

[Singing] McDonald’s makes McBurgers,
McDonald’s makes McFries,
McDonald’s makes McWonderful shakes,
For kids of every size.
However, they do, whatever they do,
They’re different from the rest.
So, let’s go to McDonalds. It’s the place we love McBest.
[End singing].

What kind of talk is that, Ronald?

Why, that’s the Hamburgers’ McLanguage. Do you want to learn it?

Sure.

²⁵ See also Applicant’s response to Opposer’s Request for Admission No. 1 (49 TTABVue 301).

²⁶ Sterling Dep., p. 11 (84 TTABVue 12).

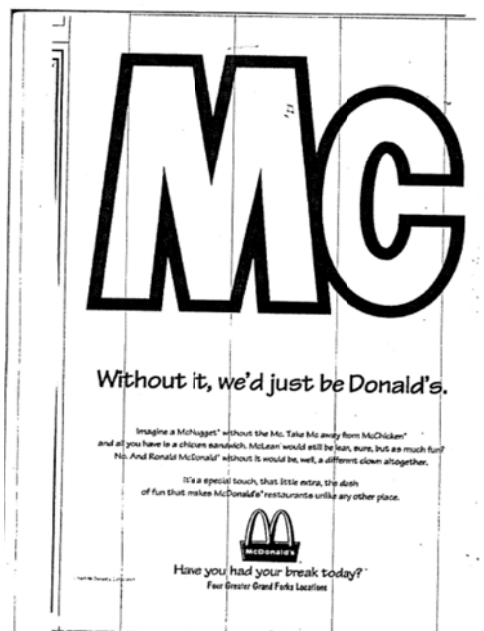
²⁷ Gallender Dep., pp. 27 – 30 (89 TTABVue 29 – 32), Exhibit 68 (89 TTABVue 184). See also Exhibit 69 entitled “Rockin’ McLanguage” commercial (89 TTABVue 185).

It's easy, just follow the bouncing hamburger.

[Repeat song].

Thus, by 1974 at the latest, Opposer had established a family of marks based on the “Mc” formative. *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889, 1891 (Fed. Cir. 1991) (“A family of marks is a group of marks having a recognizable common characteristic, wherein the marks are composed and used in such a way that the public associates not only the individual marks, but also the common characteristic of the family, with the trademark owner.”). Opposer has submitted the following to show that it has continued to use and promote the “Mc” family of marks since 1968:

1. In 1995, Opposer published the full page newspaper advertisement displayed below.²⁸ For purposes of legibility, we have reproduced the text below the copy of the advertisement.



²⁸ Gallender Dep., pp. 35 – 40 (89 TTABVue 37 – 42), Exhibit 70 (89 TTABVue 186).

Imagine a McNugget without the MC. Take Mc away from McChicken and all you have is a chicken sandwich. McLean would still be lean, sure, but as much fun? No. And Ronald McDonald without it would be, well, a different clown altogether.

It's a special touch, that little extra, the dash of fun that makes McDonald's restaurants unlike any other place.

2. In December 2004, Opposer promoted its "Mc" formative family of marks, shown below, in full-page print advertisements in numerous national publications (e.g., *Time*, *Sports Illustrated*, *People*, *Entertainment Weekly*, *Newsweek*, and *The Wall Street Journal*):²⁹



What does Mc mean to me? Everything that I love. It's a big part of my favorite foods like Chicken McNuggets or an Egg McMuffin sandwich. Mc is a good time because it always brings us together. It reminds me of something delicious and dependable. To me, Mc means McDonald's. So I'm cool with Mc and Mc is cool with me.³⁰

B. The fame of Opposer's marks.

This *du Pont* factor requires us to consider the fame of Opposer's marks. Fame, if it exists, plays a dominant role in the likelihood of confusion analysis

²⁹ Gallender Dep., pp. 41 – 52 (89 TTABVue 43 – 54), Exhibit 71 (89 TTABVue 187 – 208).

³⁰ For purposes of legibility, we copied the advertising copy rather than reproduce it.

because famous marks enjoy a broad scope of protection or exclusivity of use. A famous mark has extensive public recognition and renown. *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

Fame may be measured indirectly by the volume of sales of and advertising expenditures for the goods and services identified by the marks at issue, “the length of time those indicia of commercial awareness have been evident,” widespread critical assessments, and through notice by independent sources of the products identified by the marks, as well as the general reputation of the products and services. *Bose Corp. v. QSC Audio Products Inc.*, 63 USPQ2d at 1305-1306 and 1309.

As indicated above, Applicant admitted that “McDonald’s ‘Mc’ family of marks is famous and was famous long prior to Applicant’s filing of his application for the **BioMcDiesel** Mark.” Further corroborating the renown of Opposer’s marks are the following:³¹

1. According to Peter Sterling, the “Mc” formative family of marks is used and advertised throughout the United States.³² The effectiveness of Opposer’s

³¹ The third-party brand strength surveys by Interbrand, Landor, Forbes magazine and BrandZ had little probative value because they referred to the strength of the McDonald’s trademark, not the “Mc” formative family of marks. *See* Sterling Dep., Exhibits 41 – 48 (87 TTABVue 6, 15, 20, 25, 31, 37, 43, 47, 50).

³² Sterling Dep., pp. 66 – 84 (84 TTABVue 67 – 85).

advertising is demonstrated, in part, by the fact that as of June 7, 2013, Opposer was operating approximately 14,500 McDonald's restaurants in the United States.³³ In those restaurants, Opposer serves 28 million customers every day³⁴ who encounter advertising for the "Mc" formative family of marks in Opposer's restaurants;³⁵

2. Advertising expenditures by Opposer-operated restaurants (excluding privately-owned franchised units) for "Mc" branded products and services between 2008 and 2012, although they were designated as confidential, were substantial by any standard;³⁶

3. These advertising expenditures created an incredibly large number of advertising impressions on an annual basis.³⁷ Advertising impressions "are the ability for a company to deliver a message to a consumer";³⁸

4. As a result of Opposer's sales success and advertising efforts for its Mc family of marks, "[w]e have people who come into our restaurants all the time to ask for a product with a Mc prefix that doesn't exist. And we ask them why they come

³³ Sterling Dep., p. 8 (84 TTABVue 9).

³⁴ *Id* at 9 (84 TTABVue 10).

³⁵ Sterling Dep., pp. 28-29 (75 TTABVue 29-30).

³⁶ Sterling Dep., pp. 28 , 30, 32 – 37 (75 TTABVue 29, 31, 33 – 38). Because Opposer designated the advertising expenditures as confidential, we may refer to this testimony only in general terms.

³⁷ Sterling Dep. p. 61 (84 TTABVue 62 and 75 TTABVue 62). Because Opposer designated the number of advertising impressions as confidential, we refer to this testimony only in general terms.

³⁸ *Id*.

into the restaurant, where they have heard of it, and they just assume that when they heard the Mc in front of something, that it has to do with McDonald's."³⁹

5. News articles noting the "Mc" formative. For example,
 - a. *Orlando Sentinel* (October 25, 1987)⁴⁰

McMention Of The Absurd

Whether the highways and byways soon will be inundated with McStops or McSleeps or McBoth is up in the McAir. Yes, the McDonald's fast-food people do operate a McStop "travel plaza" -- McGas station, McMotel and McDonald's restaurant. It's in Minnesota, and they plan to develop more.

And yes, Quality Inns International does plan to open a McChain of about 200 economy-line McSleep Inns by 1991, but McDonald's is threatening to sue McSleep over McTrademark infringement, while McSleep is seeking legal relief from the McDonald's threat.

Sounds like a lot of the usual McLegal blather, but this is, after all, McAmerica, where the McCourt actions fly as fast as the McBurgers, or the good McNights.

- b. *Chicago Tribune* (August 28, 1995)⁴¹

A Big Mac To Go, And Can You Check The Oil, Please

McNames abound in the McDonald's vernacular; there aren't too many mcmonikers that consumers can't identify.

A short list would most certainly include Big Mac, Chicken McNuggets, McRib (an item that flopped in the early 1980s), McLean Deluxe (a sales problem), McJordan

³⁹ Sterling Dep., p. 18 (84 TTABVue 19). *See also*, Gallender Dep., pp. 22-23 (89 TTABVue 24-25) ("McDonald's offers a beverage that we call Sweet Tea and we have received inquiries from customers in certain parts of the country where perhaps the Sweet Tea is not offered asking us when will McDonald's be offering its McSweet Tea in my area.").

⁴⁰ 52 TTABVue 8.

⁴¹ 52 TTABVue 13.

(a sandwich once hyped by the Bulls star), Egg McMuffin and McLobster (a seasonal item back East).

But have you heard of McStop? Well, McStop is McDonald's name for a combination of a traditional McDonald's, a convenience store and a gas station, although Oak Brook-based McDonald's Corp. owns only the restaurant part. There are only a handful of McStops around the country.

c. *Detroit Free Press* (October 17, 1995)⁴²

In an article entitled “Customers Are Seeing More Marketing Efforts From Gasoline Retailers,” the author mentions a joint venture between Opposer and Amoco which she references as “McGas stations.”

d. *Advertising Age* magazine (July 25, 2005).⁴³

The renown of the “Mc” formative family of marks is shown in the *Advertising Age* magazine special issue celebrating Opposer’s fiftieth anniversary (July 25, 2005).⁴⁴ One of the stories was entitled “McDonald’s secret marketing sauce.”⁴⁵ Since the story was more than one page, at the end of page one, the editors directed readers to look for “McMarketing” on another page.⁴⁶ We find that the editors chose “McMarketing” because the “Mc” formative is well known.

Another article in the *Advertising Age* magazine is entitled “McBrand: It’s not easy being pop culture icon.”⁴⁷ The author writes that Opposer “rises to the level

⁴² 52 TTABVue 15.

⁴³ 51 TTABVue 217.

⁴⁴ 51 TTABVue 217.

⁴⁵ 51 TTABVue 218.

⁴⁶ 51 TTABVue 218 and 219.

⁴⁷ 51 TTABVue 224.

of pop culture phenomenon.” The “Mc” formative has become “the mass consumer equivalent of the New York Yankees, the supposedly domineering giant with a big bull’s-eye pinned to its chest.”

Just look to the onset of expressions like “McJob” which are rarely used in a flattering sense. “The ‘Mc’ before something is, in rare cases, a kind of ironic, loving stab at something,” says Robert Thompson, a professor and director of Syracuse University’s Center for the Study of Popular Television.” “Usually, it’s an insult. A McMansion does not refer to something of distinguished architecture, something we’ll be gazing at for years to come.”⁴⁸

Accordingly, we find that the “Mc” formative family of marks is famous.

C. The similarity or dissimilarity and nature of the goods and services.

Applicant intends to use his mark to identify biodiesel fuel. Biodiesel fuel is “a biofuel made by processing vegetable oils and other fats for use in a diesel engine, either in pure form or as an additive to conventional diesel fuel.”⁴⁹ Biodiesel fuel is an alternative to petroleum-based fuels.⁵⁰ Biodiesel fuel may be made from used fryer grease, known in the industry as yellow grease.⁵¹

“Applicant intends to offer biodiesel fuel at the retail and wholesale level on a nationwide basis.”⁵² For example, Applicant explained that he could sell his biodiesel fuel to retail gasoline service stations, school systems to operate their

⁴⁸ 51 TTABVue 224 -225.

⁴⁹ **THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE**, p. 183 (5th ed. 2011) (51 TTABVue 213-215). Biofuel is a fuel that is produced from a renewal source. *Id.*

⁵⁰ Applicant’s response to Interrogatory No. 16 (49 TTABVue 287-288).

⁵¹ Joseph Discovery Dep., p. 39 (49 TTABVue 104).

⁵² Applicant’s response to Opposer’s Interrogatory No. 5 (49 TTABVue 285).

buses, trucking companies or any company that uses bulk fuels.⁵³ “Applicant intends to promote the Mark on radio, television, cable, Internet, newspaper advertising, magazine advertising, signage and other advertising methods.”⁵⁴

Opposer is one of the largest suppliers of yellow grease.⁵⁵ Opposer promotes its sustainability programs, including its recycling efforts, on its website (McDonalds.com).⁵⁶ Also, Opposer has received publicity in the media for its recycling program. *See* the following examples:

1. A news article in the Honolulu *Star Advertiser* (March 1, 2010) entitled “McDonald’s McDiesel! Go Green Hawaii” introducing Opposer’s biodiesel program for recycling used fryer grease and referring to the biofuel as McDiesel.⁵⁷

2. A July 9, 2009 article posted on the *Automotive.com* website, entitled “McDonald’s expands menu to include Biofuel and Electric Car Outlet,” reports on Opposer’s plans to recycle its cooking oil.⁵⁸

McDonald’s, the hamburger fast food place that just about everyone knows, could be a center for bio energy in the not too distant future. Already some stores already offer their cooking oil to be converted into biofuel.

⁵³ Joseph Discovery Dep., p. 55 – 56 (49 TTABVue 118-119); Applicant’s response to Opposer’s Interrogatory Nos. 11 and 18 (49 TTABVue 286 and 288).

⁵⁴ Applicant’s response to Opposer’s Interrogatory No. 7 (49 TTABVue 285).

⁵⁵ Joseph Discovery Dep., pp. 48 and 54 (49 TTABVue 111 and 117).

⁵⁶ Crockett Dep., p. 15 (60 TTABVue 16), Exhibits 2-3 (60 TTABVue 53-55); Kramer Dep., p. 28 (81 TTABVue 29).

⁵⁷ 51 TTABVue 140. *See also* McDiesel references in *Marketplace World* (marketplace.org) (51 TTABVue 143) and the Environmental Working Group website (ewg.org) (51TTABVue 152). We did not consider the postings on websites that were unlikely to be viewed by American consumers.

⁵⁸ 51 TTABVue 187.

3. A posting on the Ecofriend website (ecofriend.com).⁵⁹

McDonald's to use its cooking oil as biofuel

McDonald's is all set to lend a helping hand in the struggle against global warming as it has announced to use its cooking oil as biodiesel for its various UK delivery vehicles.

4. *Greeley Tribune* (July 21, 2004).⁶⁰

Diesel Engines may soon be running on McDonald's French fries

Well, not the fries themselves, but from the oil used to cook them.

Rocky Mountain Biodiesel Industries opened a processing plant in Berthoud on Tuesday and will start providing 100 percent biodiesel fuel made from waste cooking and industrial oil, most of it from McDonald's restaurants, said Greg Weeks.

Weeks, the company president, said he has contracts to receive oil from McDonald's throughout northern Colorado, including those in Greeley and Evans, along with another major industrial provider.

In addition, Opposer introduced copies of seven use-based third-party registrations, owned by five entities, of marks for goods including gasoline and/or diesel fuel and restaurant and/or convenience store services, as evidence that restaurant services and diesel fuel may emanate from the same source.⁶¹ "Although third-party registrations are not evidence that the marks shown therein are in commercial use, or that the public is familiar with them, nevertheless third-party

⁵⁹ 51 TTABVue 190. Although this posting is undated, it was posted sometime prior to 2008 because the article states that by 2008, Opposer intends to run all of its vehicles in the United Kingdom on fuel made from its cooking oil.

⁶⁰ 51 TTABVue 244.

⁶¹ 51 TTABVue 129 - 138

registrations which individually cover a number of different items and which are based on use in commerce may have some probative value to the extent that they serve to suggest that the listed goods and/or services are of a type which may emanate from a single source.” *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993). *See also In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988). The registrations are listed below.⁶²

Mark	Reg. No.	Goods and Services
BP and design	2951446	Gasoline and diesel; Café and snack bar services; restaurant and carry-out services
TA	4044351	Retail store services featuring gasoline and diesel fuel and vending in the fields of food, toiletries, electronics and truck maintenance
TA and design	2498123	Gasoline service station services; Restaurant services
CHEVRON	2727275	Retail convenience store services
	0658682	Motor fuels, diesel fuel
MEIJER (stylized)	1333646	Automotive and vehicular service station services featuring gasoline and diesel fuel; Restaurant and catering services
COSTCO	2481924	Retail store services featuring gasoline; Restaurant services

⁶² We have not included the entire description of goods and services for each registration. We have listed only the goods and services relevant to this decision as arguably encompassing the goods and services at issue.

Further, Opposer has been sharing locations with gas service stations since at least as early 1993.⁶³ Biodiesel fuel is sold at some of the restaurant and gas station combinations.⁶⁴ The news media has reported the opening of restaurant/gas station combinations featuring Opposer's restaurant services. For example,

1. In a *Detroit Free Press* article dated October 17, 1995, "Customers Are Seeing More Marketing Efforts From The Gasoline Retailers," the paper reported that Opposer was teaming-up with Amoco "for a new co-branded gas station that will let drivers fill up stomachs and tanks in one stop. At least 50 so-called McGas stations will open next year east of the Rockies, including stations in Michigan."⁶⁵

2. *Chicago Tribune* (August 28, 1995)⁶⁶

A Big Mac To Go, And Can You Check The Oil, Please

But have you heard of McStop? Well, McStop is McDonald's name for a combination of a traditional McDonald's, a convenience store and a gas station, although Oak Brook-based McDonald's Corp. owns only the restaurant part. There are only a handful of McStops around the country.

3. An October 9, 2000 article in the *Albuquerque Journal* reported the opening of a "McD's/Chevron combo": "McGas Opens On Osuna."⁶⁷

⁶³ Crown Dep., pp. 7-8 (81 TTABVue 8-9).

⁶⁴ Crown Dep., pp. 30-31, 34 (81 TTABVue 31-32, 35).

⁶⁵ 52 TTABVue 15-16.

⁶⁶ 52 TTABVue 13.

⁶⁷ 52 TTABVue 21-22.

4. The *Tulare Advance-Register*, in Tulare, California (December 20, 2002), reported the opening of a “McChevron,” “the first such combination restaurant-gas station McDonald’s will have in Tulare.”⁶⁸

5. On August 29, 2008, *The Belleville News-Democrat* reported that Opposer and MotoMart will be opening a combination restaurant and gas station dubbed “McMoto.”⁶⁹ It is the fifth such combination restaurant and gas station partnership between Opposer and MotoMart.

The goods and services of Applicant and Opposer need not be identical to find a likelihood of confusion under Section 2(d). They need only be related in such a way that the circumstances surrounding their marketing would result in relevant purchasers mistakenly believing that the goods and services originate from or are associated with the same source. *On-Line Careline Inc. v. America Online Inc.*, 229 F.3d 10809, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000).

The foregoing evidence shows the following:

1. Opposer is the largest supplier of yellow grease in the United States;
2. Yellow grease is recycled into biodiesel fuel;
3. In Hawaii, Opposer is using biodiesel fuel recycled from its yellow grease to fuel Opposer’s delivery trucks;
4. Five third parties have registered a single mark for restaurant and gasoline service stations; and

⁶⁸ 52 TTABVue 25.

⁶⁹ 52 TTABVue 27-28.

5. Opposer has partnered with third parties to operate combination restaurant and gasoline service stations.

Although we cannot conclude from this evidence that biodiesel fuel and restaurant services in general are related, it is sufficient to show that there is a relationship between gas stations and food service/restaurants, and particularly between Opposer's restaurants, the food items served in those restaurants, and its yellow grease, and fuel, such that relevant consumers, when confronted with the use of Applicant's **BioMcDiesel** mark for biodiesel fuel, would be likely to believe that there is an association as to source between that biodiesel fuel and Opposer's restaurant services and related food products.

D. Established, likely-to-continue channels of trade and classes of consumers.

As indicated above, "Applicant intends to offer biodiesel fuel at the retail and wholesale level on a nationwide basis."⁷⁰

Q. So BioMcDiesel branded biodiesel fuel was planned to be sold via the EcoFuels owned franchised service stations; is that correct?

A. Not exclusively. It could be sold at other stations as well.⁷¹

Accordingly, ordinary consumers who purchase Applicant's biodiesel fuel may also patronize Opposer's restaurant services and be exposed to and/or purchase the food items sold under the "Mc" formative marks. In this regard, we note that retail

⁷⁰ Applicant's response to Opposer's Interrogatory No. 5 (49 TTABVue 285).

⁷¹ Joseph Dep., p. 55 (49 TTABVue 118). EcoFuel is the service mark for the service stations Applicant intends to open to distribute its biodiesel fuel. (Joseph Dep., pp. 46-47; 49 TTABVue 108-109).

gasoline service stations and restaurant services are offered at the same locations and Opposer has partnered with third-party gasoline service station companies to offer both restaurant services and gasoline service station services at the same location. In fact, biodiesel fuel is sold at some of Opposer's co-branded restaurant and gas locations.⁷²

“Applicant intends to promote the Mark on radio, television, cable, Internet, newspaper advertising, magazine advertising, signage and other advertising methods.”⁷³ The record shows that Opposer advertises in the same media. Applicant has admitted that “Applicant's advertising and intended use of the BioMcDiesel Mark will inevitably reach the same consumers that McDonald's targets with its use of its famous ‘Mc’ family of marks.” (Paragraph No. 10 of Opposer's Amended Notice of Opposition).

In view of the foregoing, we find that Applicant's biodiesel fuel and Opposer's restaurant services and food products move in the same channels of trade and are purchased by the same classes of consumers.

E. The similarity or dissimilarity of the marks in their entirety in terms of appearance, sound, connotation and commercial impression.

In comparing Opposer's family of marks with Applicant's mark, the question is not whether Applicant's mark is similar to Opposer's individual marks, but whether Applicant's mark would be likely to be viewed as a member of Opposer's “Mc” formative family of marks. *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1720

⁷² Crown Dep., pp. 30-34 (72 TTABVue 31-35); Exhibits 9-10 (72 TTABVue 81 – 82).

⁷³ Applicant's response to Opposer's Interrogatory No. 7 (49 TTABVue 285).

(TTAB 2007); *The Black & Decker Corporation v. Emerson Electric Co.*, 84 USPQ2d 1482, 1491 (TTAB 2007); *Plus Products v. Medical Modalities Associates, Inc.*, 217 USPQ 464, 465 n.8 (TTAB 1983) (“purchasers familiar with plaintiff's family of marks would believe the defendant's mark is but another member of that family.”). As discussed above, Opposer’s family of marks consists of the “Mc” formative followed by a descriptive or generic term for a food product identifying Opposer’s restaurant services or products.

Applicant’s mark, **BioMcDiesel**, has the “Mc” formative followed by a generic term, albeit not a food item. Applicant’s placement of the “Mc” formative in the middle of Applicant’s mark does not distinguish Applicant’s mark from Opposer’s family because Opposer’s family is not limited to marks in which the “Mc” formative is the first part of the mark. This is illustrated by several members of Opposer’s family which have a structure similar to that of Applicant’s mark (*e.g.*, Chicken McNuggets, Egg McMuffin, and Sausage McMuffin).

Also, the fact that “Diesel” is not a food product is not fatal to Opposer’s claim. First, the use of the generic term “Diesel” as the suffix word after the “Mc” formative in the mark **BioMcDiesel** follows the structure of Opposer’s family of marks. Second, because of the fame of Opposer’s “Mc” formative family of marks, when third parties use the “Mc” formative, it engenders a similar commercial impression as Opposer’s “Mc” formative family of marks. *See the Advertising Age* article, noted above, where the author wrote that the “Mc” formative has become “the mass consumer equivalent of the New York Yankees, the supposedly

domineering giant with a big bull's-eye pinned to its chest," leading to expressions such as McJobs, McMansions and McGas. In this regard, we note the March 1, 2010 article posted on the Honolulu *Star Advertiser* website (staradvertiserblogs.com) entitled "McDonald's McDiesel! Go Green Hawaii."⁷⁴ The article refers to Opposer's biodiesel program for recycling used fryer grease, as McDiesel.⁷⁵

We find that Applicant's mark **BioMcDiesel** and Opposer's "Mc" family of marks are sufficiently similar that if used on related goods, consumers would think **BioMcDiesel** is part of Opposer's "Mc" family of marks.

F. Analysis.

In determining likelihood of confusion, preference is accorded the prior user of a mark or family of marks, as against a newcomer. The newcomer has the clear opportunity, if not the obligation, to avoid confusion with well-known marks of others. *J & J Snack Foods Corp. v. McDonald's Corp.*, 18 USPQ2d at 1892; *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 676, 223 USPQ 1281, 1285 (Fed. Cir. 1984); *Planters Nuts & Chocolate Co. v. Crown Nut Co.*, 305 F.2d 916, 924-25, 134 USPQ 504, 511 (CCPA 1962).

In view of the facts that (i) Opposer is the owner of a famous "Mc" formative family of marks for restaurant services and food products, (ii) Applicant's mark

⁷⁴ 51 TTABVue 140.

⁷⁵ See also McDiesel references in *Marketplace World* (marketplace.org) (51 TTABVue 143) and the Environmental Working Group website (ewg.org) (51TTABVue 152). We did not consider the postings on foreign websites that were unlikely to be viewed by American consumers.

BioMcDiesel and Opposer's "Mc" family of marks are similar, (iii) Applicant's biodiesel fuel and Opposer's restaurant services and food products are related, (iv) move in the same channels of trade and (v) are sold to the same classes of consumers, we find that Applicant's mark **BioMcDiesel** for biodiesel fuel is likely to cause confusion with Opposer's "Mc" formative family of marks.

Because we have found that there is a likelihood of confusion, we do not decide Opposer's dilution claim or claim that Applicant lacked a *bona fide* intent to use his mark at the time he filed the application.

Decision: The opposition is sustained and registration to Applicant is refused.