

IN THE MATTER OF AN OPPOSITION by McDonald's Corporation and McDonald's Restaurants of Canada Limited to application No. 604,731 for the trade-mark MCSAURUS filed by Mark James Rodden

On April 12, 1988, the applicant, Mark James Rodden, filed an application to register the trade-mark MCSAURUS based upon proposed use of the trade-mark in Canada in association with:

"printed matter - namely books, comic books, booklets, comic strips, calendars, posters, magazines, newsletters, newspapers, leaflets, flyers, and menus; watches, clocks, computers, radios, television sets, tape recorders, cameras, desks, tables, chairs, beds, dressers, bedspreads, curtains, rugs,. carpets, towels, dish towels, aprons, pillowcases, tote bags, headbands, wristbands, cups, mugs, saucers, plates, drinking glasses, cutlery, souvenir buttons, key chain pendants, pendants, boardgames; toys and playthings namely dinosaur dolls and models (namely dinosaur likenesses made of textile, ceramic, metal, wood, or plastic materials, and with or without moving parts or motors); printed balloons and inflatable dinosaur dolls and models (namely inflatable dinosaur-shaped balloons made of rubber, plastic, or other inflatable materials); characters (namely life-sized costume-puppets)"

and in association with the following services:

"provision, production, and management (as a service for others) of live entertainments (sports, musical, or theatrical events); production (as a service for others) of television, radio, and audio-visual productions; provision of advertising and promotional services in respect of the wares and services of others".

The opponents, McDonald's Corporation and McDonald's Restaurants of Canada Limited, filed a statement of opposition on February 17, 1989 in which they alleged that the applicant's trade-mark is not registrable and not distinctive, and that the applicant is not the person entitled to its registration, in that the trade-mark MCSAURUS as applied to the wares and services covered in the present application is confusing with the following registered trade-marks owned by the opponent, McDonald's Corporation, and in respect of which McDonald's Restaurants of Canada Limited, is a registered user:

<u>TRADE-MARK</u>	<u>REGISTRATION NO.</u>
MCDONALD'S	141,977
MCDONALD'S HAMBURGERS	141,978
MCDONALD'S & M Design	141,374
MCDONALD'S & Design	176,783
BIG MAC	182,371
MCDONALDLAND & Design	218,993
BIG MAC & Design	219,423
RONALD MCDONALD	219,896
MCDONALD'S GOOD MORNING CANADA & Design	220,219
EGG MCMUFFIN	221,457
MACSUNDAE	221,486

RONALD MCDONALD	225,901
RONALD MCDONALD & Design	225,902
LITTLE MAC	230,837
MCHAPPY DAY	223,046
MCDONALD'S CARES & Design	243,165
BIG MACK'S	243,627
DOUBLE MAC	244,774
NOBODY CAN DO IT LIKE MCDONALD'S CAN	249,611
MCBOO	253,152
MCCHICKEN	254,922
MCDONALDLAND	256,841
BIG MAC ATTACK	258,246
MCDONALDLAND	259,357
RONALD MCDONALD HOUSE	259,608
MANOIR RONALD MCDONALD	259,611
ATTACK A BIG MAC	262,644
MCDONALD'S & Design	262,687
CHICKEN MCNUGGETS	268,261
MCDOLLAR	269,956
MAYOR MCCHEESE	270,945
RONALD MCDONALD HOUSE & Design	274,108
MC CHICKEN	275,398
MACPOULET	276,932
MCDONALDLAND FASHIONS COLLECTION & Design	277,094
MCRIB	279,507
MCBUCK	283,637
MCCOTE & Design	283,789
RONALD MCDONALD HOUSE & Design	286,141
MCDONUTS	287,330
MCCONE	287,732
MCMONEY	290,131
POULET MCCROQUETTES	295,104
MCDONALD'S, RONALD AND YOU	295,143

MCBARBEQUE	296,686
MCQ	296,687
MCDO	301,422
I'VE GOT A TASTE FOR MCDONALD'S	305,883
MCDONALD'S PLAYLAND	310,250
MCDONALD'S PLAYLAND & Design	310,251
MCCOLA	314,361
MCMILLIONS	316,743
MCD.L.T.	316,918
MCNUT	320,301
MCMUFFIN	321,522
MCNOGG	322,335
MAPLE MCCRISP	322,792
MCMILLION	322,909
CHICKEN MCSWISS	322,791
MCJOBS & Design	330,965
MAC FRIES	332,947
MCCHEDDAR	334,618
RONALD MCDONALD CHILDREN'S CHARITIES	335,462
PARTNERS IN SUPPORTING RONALD MCDONALD HOUSE	336,058

The opponents also relied upon the following pending trade-mark applications in challenging the applicant's entitlement to registration:

<u>TRADE-MARK</u>	<u>APPLICATION NO.</u>
MCSNACK	526,017
MCPIZZA	539,009
MCBLIMP	553,091
MCPASS	562,699

The applicant served and filed a counter statement in which he denied the allegations of confusion set forth in the statement of opposition.

The opponents filed as their evidence the affidavits of Gary Reinblatt and Griffin Thompson while the applicant failed to file either evidence or a statement that he did not wish to file evidence

in this opposition. Further, both parties submitted written arguments and both were represented at an oral hearing.

The applicant submitted an amended application with his written argument in which he deleted a number of the wares and services from his application. As amended, the application covers the following wares:

"printed matter - namely books, comic books, comic strips, booklets, calendars, posters and magazines"

and the following services:

"provision, production, and management (as a service for others) of live entertainments (sports, musical, or theatrical events); provision of advertising and promotional services in respect of the wares and services of others".

As the applicant's amended application meets the requirements of Rules 35 to 37 of the Trade-marks Regulations, I advised the parties at the oral hearing that I have accepted the applicant's amended application.

The main issue in this opposition is whether the applicant's trade-mark MCSAURUS as applied to the wares and services covered in the applicant's amended application is confusing with one, or more, of the first opponent's registered trade-marks, or pending trade-mark applications, relied upon in the statement of opposition. In determining whether there would be a reasonable likelihood of confusion between the trade-marks at issue, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in Section 6(5) of the Trade-marks Act. Further, the Registrar must bear in mind that the legal burden is upon the applicant to establish that there would be no reasonable likelihood of confusion between the trade-marks of the parties as of the material dates in this opposition. In this regard, the material date with respect to the grounds of opposition based on Section 12(1)(d) of the Trade-marks Act would appear to be the date of my decision (see Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd. et al, 37 C.P.R. (3d) 413 (F.C.A.) and Conde Nast Publications, Inc. v. The Canadian Federation of Independent Grocers, 37 C.P.R. (3d) 538 (TMOB)) while the material dates with respect to the non-entitlement and non-distinctiveness grounds are respectively the applicant's filing date (April 12, 1988) and the date of opposition (February 17, 1989).

Considering the inherent distinctiveness of the trade-marks at issue (ss. 6(5)(a)), I find that the applicant's trade-mark MCSAURUS is inherently distinctive as applied to the wares and services covered in the applicant's amended application. Certain of the first opponent's trade-marks such as MCDONALD'S, RONALD MCDONALD, and the design trade-marks including these words, are weak marks which possess little inherent distinctiveness while the first opponent's trade-marks

comprising or including the word MCDONALDLAND do possess some inherent distinctiveness. Further, a number of the first opponent's marks including the MC or MAC prefix in combination with a food identifier possess some measure of inherent distinctiveness, as do the trade-marks which include the prefix MAC or MC in combination with a word or words which are descriptive of food products. The former group of trade-marks include such marks as MACSUNDAE, EGG MCMUFFIN, MCCHICKEN, MACPOULET, MAYOR MCCHEESE, MCRIB, MCCOTE & Design, MCCONE, MCCOLA, MCNUT, MCMUFFIN, MCNOGG, MCDONUTS, MAC FRIES and MCPIZZA while the latter group is represented by the trade-marks MCSNACK, MCBARBEQUE, POULET MCCROQUETTES, MAPLE MCCRISP, CHICKEN MCSWISS, MCCHEDDAR and CHICKEN MCNUGGETS. Other of the first opponent's trade-marks are inherently distinctive in relation to the food products or restaurant services covered in the respective registrations, including the trade-marks BIG MAC, BIG MAC ATTACK, MCHAPPY DAY, BIG MACK'S, MCBOO, ATTACK A BIG MAC, MCQ, MCDO, MCD.L.T., MCMILLION and MCMILLIONS. Finally, the first opponent has a group of marks possessing some inherent distinctiveness but covering wares and services unrelated to either food products or restaurant services, including the trade-marks: LITTLE MAC and DOUBLE MAC covering electric food cookers; MCBUCK, MCDOLLAR and MCMONEY as applied to imitation money; and MCJOBS covering the training of handicapped persons as restaurant employees.

With respect to the extent to which the trade-marks at issue have become known (ss. 6(5)(a)), the applicant's trade-mark MCSAURUS had not become known in Canada as of the filing date of his proposed use trade-mark application. Further, as no evidence has been furnished by the applicant, I must conclude that he has not yet commenced use of his trade-mark MCSAURUS in Canada in association with any of the wares or services covered in his amended application. On the other hand, a number of the first opponent's trade-marks are very well known in Canada either in association with the operation of fast-food restaurants or in association with the food products sold in those restaurants. In particular, the opponents' evidence establishes that the trade-marks MCDONALD'S, BIG MAC, EGG MCMUFFIN, SAUSAGE MCMUFFIN, MCCHICKEN, CHICKEN MCNUGGETS and MCD.L.T. are very well known in Canada. However, the Reinblatt affidavit does not establish that such trade-marks as MACSUNDAE, LITTLE MAC, DOUBLE MAC, MCCONE, MCCOLA, MCNUT, MCDONUTS, MCPIZZA or MCNOGG have become known to any extent in Canada. Likewise, the length of time that the trade-marks at issue have been in use (ss. 6(5)(b)) clearly favours the opponents in view of the use in Canada by the second opponent and licensees of the first opponent of the trade-marks MCDONALD'S since at least 1960, BIG MAC since 1968, EGG MCMUFFIN since at least 1976, SAUSAGE MCMUFFIN since 1984,

MCCHICKEN since 1981, CHICKEN MCNUGGETS since 1983 and MCD.L.T. since 1985.

As for the respective wares and services of the parties (ss. 6(5)(c)), the applicant's printed matter and his live entertainment and advertising and promotional services differ from the food products, imitation money, electric food cookers, clothing, towels and computer software, as well as the restaurant and charitable services, covered in the first opponent's registrations and pending applications. Likewise, the channels of trade (ss.6(5)(d)) associated with the wares and services covered in the respective registrations and pending applications of the first opponent and the channels of trade associated with the applicant's wares and services covered in his amended application differ.

As to the degree of resemblance between the trade-marks of the parties (ss. 6(5)(e)), the applicant's trade-mark MCSAURUS does bear at least some degree of similarity both in appearance and in sounding to a number of the first opponent's "Mc" formative trade-marks in that the trade-marks commence with the element MC. On the other hand, the trade-marks at issue do not suggest the same ideas. While a number of the first opponent's marks suggest a name, a surname, or a food product, other of its trade-marks such as MCBOO, MCQ, MCBUCK, MCMONEY, MCJOBS, McD.L.T. and MCMILLION either suggest no idea or suggest ideas completely unrelated to the idea of some association with dinosaurs suggested by the applicant's trade-mark MCSAURUS.

As a surrounding circumstance with respect to the issue of confusion, the opponents have relied upon the adoption and use of an alleged family of MC and MAC formative trade-marks. In view of the decision in McDonald's Corp. v. Yogi Yogurt Ltd., 66 C.P.R. (2d) 101, an opponent relying upon a family or series of trade-marks must evidence use of those marks in the marketplace. In the present case, and apart from the evidence of adoption by the first opponent of a number of MC formative trade-marks, the opponents have submitted evidence of significant use by the second opponent and licensees of the first opponent of the trade-marks MCDONALD'S in association with fast-food restaurant services and EGG MCMUFFIN, SAUSAGE MCMUFFIN, MCCHICKEN, CHICKEN MCNUGGETS, MCD.L.T., and to a lesser extent MCRIB, all as applied to food products. I am satisfied, therefore, that the opponents have established the existence of a family or series of trade-marks including the component MC followed by the name of a food product. However, the existence of such a family of marks does not mean that the opponents' protection for their MC formative marks necessarily extends beyond the area of food products and restaurant services. Indeed, in McDonald's Corp. v. Silcorp Ltd./ Silcorp Ltée, 24 C.P.R. (3d) 207, at pages 212-13, Mr. Justice Strayer commented as follows on the limitations which he perceived as being

associated with the opponents' family of marks:

As well, at page 217, the learned trial judge commented on the opponents' submission relating to their alleged family of trade-marks:

I agree, however, with the opponents' submission that the Silcorp decision is distinguishable from the present case in that the learned trial judge was, in fact, considering trade-marks comprising the element MAC in combination with other words. Nevertheless, the decision demonstrates that the existence of the opponents' family or series of marks may not be relevant factor with respect to the issue of confusion unless the trade-mark at issue comprises the prefix MC, or MAC, in combination with the name of an edible as applied to food products. I am therefore not convinced that the existence of the opponents' family of marks is a particularly relevant factor with respect to the issue of confusion in this opposition where the applicant's mark does not include the name of an edible and the applicant's wares and services are unrelated to food products and restaurant services.

As a further surrounding circumstance with respect to the issue of confusion, the opponents

sought to rely upon their evidence relating to the existence of an employee incentive program whereby more than 60,000 employees in Canada of the second opponent and licensees of the first opponent can purchase a range of goods which display one, or more, of the first opponent's trade-marks. However, almost all of the wares are associated with the first opponent's McDONALD'S, RONALD McDONALD or RONALD McDONALD HOUSE trade-marks and not with the "Mc" formative marks. As well, the goods are only available to employees of either the second opponent or licensees of the first opponent and not to the average consumer of the opponents' wares and services. As a result, this evidence is of little relevance to the issues in this opposition and, in particular, does not assist the opponents in establishing a reputation for the alleged family of "Mc" formative trade-marks extending beyond their food products and restaurant services.

As yet a further surrounding circumstance with respect to the issue of confusion, the opponents submitted evidence relating to the free distribution by the second opponent and the licensees of McDonald's Corporation of hand puppets, get well cards, greeting cards and stencils, as well as the "treat-of-the-week" distributed to children, including McSAFETY punch out cards, McRULER rulers and McPUPPETS punch out cards. Further, promotional booklets to raise the safety consciousness of children have been distributed in Canada by the second opponent. In paragraph 35 of his affidavit, Mr. Reinblatt also notes the following:

35. From time to time, various "McDonald's" restaurants will conduct local programs or projects with a view to promoting the company and local "McDonald's" restaurants. "Mc" formative words are often featured in such promotions. Now produced, shown to me and marked Exhibit "CC" to this my affidavit is a photocopy of an entry form promoting, among other things, THE GREAT RACE. Now produced, shown to me and marked Exhibit "DD" to this my affidavit is a photocopy of a flyer entitled "McNEWS". Now produced, shown to me and marked collectively Exhibit "EE" to this my affidavit are photocopies of a McCALENDAR desk calendar and an advertisement therefor."

Even though the opponents have not provided any evidence as to the volume or dollar value of such premium distributions, their evidence does establish some measure of a reputation for the "Mc" formative trade-marks in association with booklets, flyers, calendars, and other printed materials, wares which are overlapping with certain of the wares covered in the applicant's amended application.

In paragraphs 26 to 31 of the Reinblatt affidavit and the accompanying exhibits referred to in these paragraphs, the opponents have also submitted evidence of publicity, advertising, and articles appearing in publications featuring the use of so-called "McLanguage". Included in this evidence are reference to such terms as: "McAUTO", "McWidens", "McShortage", "McProblems", "McSneeze", "McFortune", "McBarge", "McBlimp", "mcunion", "McMuseum" and "McHistory". While this evidence does not establish that the opponents have any proprietary rights in any of these



terms as trade-marks or otherwise, it does increase the likelihood that the average person encountering a trade-mark including the formative "MC" in combination with another word or element and applied to wares similar to the second opponent's premiums might assume some connection with the opponents.

Having regard to the above and, in particular, to the differences between the applicant's live entertainment, advertising and promotional services and the opponents' restaurant services and food products, as well as the other wares and services covered in the first opponent's registrations and pending applications, and considering further the differences in the potential channels of trade associated with the respective wares and services of the parties, I have concluded that there would be no reasonable likelihood of confusion between the applicant's trade-mark MCSAURUS as applied to the services covered in his amended application and the trade-marks of the first opponent.

With respect to the applicant's printed matter, the opponents' evidence establishes that the second opponent and licensees of the first opponent distribute booklets, flyers, calendars, book marks and greeting and get well cards in Canada as part of their normal course of trade in their fast-food restaurants and that such wares are associated with trade-marks such as McRULER and McCALENDAR. Further, the Reinblatt affidavit also establishes that "Mc" formative words, described by Mr. Reinblatt as "McLanguage", appear relatively frequently in advertising, promotional materials and newspaper articles in which reference is made to the opponents or their restaurants.

In McDonald's Corp. v. Clem Saila Inc., 24 C.P.R. (3d) 400 (TMOB), an opposition by the first opponent to registration of the trade-mark MCPUPPETS for "paper sculptures", the hearing officer concluded as follows:

The opponents' evidence in the present opposition is even stronger than in the MCPUPPETS opposition as the opponents have established that there has been relatively extensive use of the so-called "McLanguage" in advertising and other literature. Likewise, as in the MCPUPPETS case, the opponents have furnished evidence of the distribution of calendars, booklets, flyers and other printed materials not dissimilar to the wares of the applicant. While the element SAURUS of the applicant's mark is not, by itself, a word in the English or French languages, I would note that "-saurus" as a suffix is defined in Webster's Third New International Dictionary as "lizard - in generic names in zoology <Brontosaurus> <Ichthyosaurus>" and in Funk & Wagnalls Standard College Dictionary as "combining form Zool. Lizard: used to form genus names: Brontosaurus, Pleseosaurus". I have therefore concluded, as did the hearing officer in the MCPUPPETS opposition, that consumers might well assume some type of sponsorship or approval of the applicant's wares by the opponents. As a result, the applicant has failed to meet the legal burden upon him in respect of at least the non-distinctiveness ground of opposition.

In view of the above, I have rejected the opponents' grounds of opposition in relation to the applicant's services but refuse the applicant's application as applied to "printed matter - namely books, comic books, comic strips, booklets, calendars, posters and magazines" pursuant to Section 38(8) of the Trade-marks Act. In this regard, I would note the finding of the Federal Court, Trial Division in Produits Ménagers Coronet Inc. v. Coronet-Werke Heinrich Schlerf GmbH, 10 C.P.R. (3d) 492 in respect of there being authority to render a split decision.

DATED AT HULL, QUEBEC THIS 30<sup>th</sup> DAY OF SEPTEMBER 1993.

G.W.Partington,  
Chairman,  
Trade Marks Opposition Board.