

**IN THE MATTER OF AN OPPOSITION  
by McDonald's Corporation and McDonald's  
Restaurants of Canada Limited to application  
No. 1,166,252 for the trade-mark MCNOODLE  
filed by Chung-Kee Noodle Shop Ltd.**

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**On January 29, 2003, the applicant, Chung-Kee Noodle Shop Ltd., trading as McNoodle Restaurant, filed an application to register the trade-mark MCNOODLE for the following wares:**

noodles, dumplings, stewed meats and sauces accompanying noodles and dumplings, and without restricting the generality of the foregoing, including wunton, meat and non-meat dumplings, sauces, braised meat and non-meat, and consomme

**and for the following services:**

restaurant services and wholesale or retail of packages of noodles, dumplings, stewed meats and sauces accompanying noodles and dumplings, and without restricting the generality of the foregoing, including wunton, meat and non-meat dumplings, sauces, braised meat and non-meat, and consomme.

**The application is based on proposed use of the mark in Canada for wares and services and was advertised for opposition purposes on December 24, 2003.**

**The opponents, McDonald's Corporation and McDonald's Restaurants of Canada Limited ("McDonald's Canada"), filed a statement of opposition on May 25, 2004, a copy of which was forwarded to the applicant on June 8, 2004. The first ground of opposition is that the applicant's application does not conform to the requirements of Section 30(e) of the Trade-marks Act because neither the applicant nor a licensee of the applicant intended to use the applied for trade-mark in Canada. The second ground is that the applied for trade-mark is not registrable pursuant to Section 12(1)(d) of the Act because it is confusing with over fifty**

registered trade-marks owned by the first opponent that commence with the prefix MC or its equivalent MAC. Among those registered marks are MCDONALD'S, BIG MAC, EGG MCMUFFIN, MCCHICKEN, CHICKEN MCNUGGETS, MCRIB, MACSUNDAE and MCHAPPY DAY.

The third ground of opposition is that the applicant is not the person entitled to registration pursuant to Section 16(3) of the Act because, as of the applicant's filing date, the applied for trade-mark was confusing with one or more of the first opponent's registered trade-marks previously used in Canada. The fourth ground is that the applicant's trade-mark is not distinctive because it is confusing with the opponents' trade-marks used in Canada.

The applicant filed and served a counter statement on July 8, 2004. As their evidence, the opponents submitted the affidavits of Redmond Langan and Eileen Castellano. The applicant did not submit evidence. Only the opponents filed a written argument and an oral hearing was conducted at which both parties were represented.

#### THE OPPONENTS' EVIDENCE

The Castellano affidavit serves simply to introduce into evidence the particulars of a number of the first opponent's trade-mark applications and registrations.

In his affidavit, Mr. Langan identifies himself as a Vice-President of McDonald's Canada which he states is an indirectly, wholly-owned subsidiary of McDonald's Corporation. McDonald's Canada uses McDonald's Corporation's various trade-marks in Canada under

license.

**Mr. Langan states that the opponents operate restaurants under the trade-mark MCDONALD'S and that the Canadian outlets are either owned by McDonald's Canada or by independent franchisees. As of the end of 2004, there were more than 30,000 such restaurants worldwide with 1,362 of them being in Canada. Mr. Langan states that the sales in Canada by MCDONALD'S outlets have been in excess of \$2 billion per year for each of the five years preceding the date of his affidavit which is February 3, 2005. Sales of BIG MAC sandwiches since the year 2000 have been more than \$100 million per year. The same applies to the products sold under the trade-marks MCNUGGETS and MCCHICKEN. Sales of products under the mark MCMUFFIN have been in excess of \$75 million per year since 2000.**

**Mr. Langan further states that tens of millions of dollars per year have been spent in Canada on advertising and promotion by the opponents. According to him, major marketing campaigns are undertaken at least six times a year that are designed to reach at least 75% of Canadian households and sometimes at least 90%. Appended as exhibits to Mr. Langan's affidavit are numerous advertising and promotional materials which illustrate the use of a plethora of MC-prefixed marks including MCCAFFE, MCGRIDDLES, MCMUFFIN, MCFLURRY, MCVEGGIE BURGER, MCHAPPY DAY, MCHOMARD, MCLOBSTER, MCCHICKEN, CHICKEN MCNUGGETS, MCXTRA, MCCLASSIQUES, MCFAVOURITES, MCWRAP, CHICKEN MCGRILL, MCVALUE, POULET MCGRILLE and MCCREPES. Mr. Langan provides additional materials to evidence the widespread advertising and promotion of such marks via such media as radio, television and billboards.**

## **THE GROUNDS OF OPPOSITION**

**The first ground does not raise a proper ground of opposition. The opponents failed to include any allegations of fact to support their contention that the applicant did not intend to use its applied for trade-mark. Thus, the first ground is unsuccessful.**

**As for the second ground of opposition, the material time for considering the circumstances respecting the issue of confusion with a registered trade-mark is the date of my decision: see the decision in Conde Nast Publications Inc. v. Canadian Federation of Independent Grocers (1991), 37 C.P.R.(3d) 538 at 541-542 (T.M.O.B.). Furthermore, the onus or legal burden is on the applicant to show no reasonable likelihood of confusion between the marks at issue. Finally, in applying the test for confusion set forth in Section 6(2) of the Act, consideration is to be given to all of the surrounding circumstances including those specifically set forth in Section 6(5) of the Act.**

**I will first consider the issue of confusion as between the applicant's mark and the opponents' registered mark MCDONALD'S for restaurant wares and services since it is their most widely used trade-mark. As for Section 6(5)(a) of the Act, the applicant's mark MCNOODLE is inherently distinctive since it is a coined word. However, since it is dominated by the non-distinctive element NOODLE, it cannot be said to be an inherently strong mark. Since there is no evidence from the applicant, I must conclude that its proposed mark has not become known at all in Canada.**

The opponents' mark MCDONALD'S is the possessive form of a surname and is therefore an inherently weak mark. However, given the level of sales associated with that mark, the number of outlets in Canada and the penetration of the opponents' advertising efforts, it is safe to assume that the opponents' mark is known by almost every Canadian and is therefore entitled to the status of a famous mark in association with restaurant wares and services. Such a finding is of great importance in assessing the issue of confusion: see Veuve Cliquot Ponsardin v. Boutiques Cliquot Ltée (2006), 49 C.P.R.(4th) 401 at 417-418 (S.C.C.).

As for Section 6(5)(b) of the Act, the length of time the marks have been in use favors the opponents. As for Sections 6(5)(c) and 6(5)(d) of the Act, it is the applicant's statements of wares and services and the statements of wares and services in the first opponent's registrations that govern: see Mr. Submarine Ltd. v. Amandista Investments Ltd. (1987), 19 C.P.R.(3d) 3 at 10-11 (F.C.A.), Henkel Kommanditgesellschaft v. Super Dragon (1986), 12 C.P.R.(3d) 110 at 112 (F.C.A.) and Miss Universe, Inc. v. Dale Bohna (1994), 58 C.P.R.(3d) 381 at 390-392 (F.C.A.). However, those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. In this regard, evidence of the actual trades of the parties is useful: see the decision in McDonald's Corporation v. Coffee Hut Stores Ltd. (1996), 68 C.P.R.(3d) 168 at 169 (F.C.A.).

A review of the wares and services in the first opponent's several registrations that comprise or include the mark MCDONALD'S reveals that they are similar to the wares and services listed in the applicant's application. In the absence of evidence from the applicant,

**it is fair to conclude that the trades of the parties would be the same or similar.**

**As for Section 6(5)(e) of the Act, there is some resemblance between the marks at issue since both commence with the prefix MC and both comprise three syllables. More noteworthy, however, is the existence of the opponents' other MC-prefixed marks.**

**As an additional surrounding circumstance, I have considered the opponents' family or series of marks. The opponents submitted that their family of trade-marks which include the prefixes MC and MAC for food products and restaurant services increases the likelihood of confusion occurring in the present case in accordance with the decision in McDonald's Corp. v. Yogi Yogurt Ltd. (1982), 66 C.P.R.(2d) 101 (F.C.T.D.). I agree.**

**The opponents have evidenced the existence of a large family of MC-prefixed marks or similarly constructed marks with some having achieved considerable fame in their own right such as MCNUGGETS, MCCHICKEN, MCMUFFIN and BIG MAC. As noted, evidence of use has been provided of a number of other similarly constructed trade-marks of the opponents in Canada. Furthermore, evidence has been provided to show that the opponents have engaged in an ongoing campaign of creating, using, advertising and promoting marks comprising the prefix MC followed by the name of a food product.**

**In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. In view of my conclusions above and particularly in view of the fame associated with the registered trade-mark MCDONALD'S and a number of**

**other MC-prefixed marks of the opponents, the similarities between the marks and the similarities between the wares, services and trades of the parties, I find that it is reasonable to assume that consumers familiar with the opponents' trade-mark MCDONALD'S would assume that the use of the trade-mark MCNOODLE has been, at the very least, approved, licensed or sponsored by the opponents. Thus, I find that the applicant has failed to satisfy the onus on it to show no reasonable likelihood between its mark and the opponents' registered marks. Thus, the second ground based on the first opponent's registered mark MCDONALD'S is successful and the remaining registered marks need not be considered.**

**As for the third ground of opposition, the opponents have satisfied their initial burden of evidencing prior use of the mark MCDONALD'S and non-abandonment of that mark as of the applicant's advertisement date. The ground therefore remains to be decided on the issue of confusion as of the applicant's filing date. For the most part, my conclusions respecting the second ground are also applicable here. Thus, I find that the applicant has failed to satisfy the onus on it to show no reasonable likelihood of confusion between its proposed mark MCNOODLE and the opponent's registered trade-mark MCDONALD'S and its family of MC-prefixed marks. The third ground based on the opponents' previously used mark MCDONALD'S is successful and the remaining aspects of this ground need not be considered.**

**As for the fourth ground of opposition, the material time for considering the circumstances respecting the issue of distinctiveness is as of the filing of the opposition. The onus or legal burden is on the applicant to show that its applied for trade-mark actually distinguishes or is adapted to distinguish its wares and services from those of others**

throughout Canada. There is, however, an evidential burden on the opponents to prove their supporting allegations of fact.

The fourth ground essentially turns on the issue of confusion between the applicant's proposed mark and the trade-marks used and relied on by the opponents including the registered mark MCDONALD'S. My conclusions respecting the second ground are, for the most part, applicable here as well. Thus, I find that the applicant has failed to satisfy the onus on it to show that its proposed mark MCNOODLE is not confusing with the opponents' extensively used trade-mark MCDONALD'S and their related family of MC-prefixed marks. To that extent, the fourth ground is also successful.

In view of the above, and pursuant to the authority delegated to me under Section 63(3) of the Act, I refuse the applicant's application.

**DATED AT GATINEAU, QUEBEC, THIS 23<sup>rd</sup> DAY OF DECEMBER, 2008.**

**David J. Martin,  
Member,  
Trade Marks Opposition Board.**