

McDONALD'S CORPORATION,  
Opposer,

-versus

VULCAN CHEMICAL CORPORATION  
Respondent-Applicant.

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INTER PARTES CASE NO. 3311

OPPOSITION TO:

Application Serial No.: 44124  
Filed: February 27, 1981  
Applicant: Sze Ye se  
Trademark: BIG MAC AND LOGO  
M WITHIN A DESIGN

Used On: T-shirts, polo shirts,  
Socks, pajamas, briefs, jackets,  
Jeans, blouses, bags, shoes and  
handkerchiefs

DECISION NO. 90-4 (TM)  
February 14, 1990

### DECISION

The McDonald's Corporation on December 29, 1988 filed an unverified Notice of Opposition against the registration of the mark "BIG MAC AND LOGO M WITHIN A DESIGN" used on T-shirts, polo shirts, socks, pajamas, briefs, jackets, jeans, blouses, bags, shoes and handkerchiefs applied for by Sze Ye Se on February 27, 1981 under Application Serial No. 44142, published on Page 61, Volume I, No. 9 of the BPTTT Official Gazette dated and released for circulation on November 29, 1988.

Opposer is a foreign corporation organized and existing under the laws of the State of Delaware, United States of America, with office at McDonald's Plaza, Oak Brooks, Illinois 60521, U.S.A., while Respondent-Applicant is a Chinese citizen doing business at Room 505 Equitable Bank Building, 132 Carlos Palanca Street, Quiapo, Manila, Philippines.

The grounds alleged in the verified Notice of Opposition are:

"1. Opposer is the owner and rightful proprietor of the internationally known McDonald's Tradename, Trademarks and Service Marks, including the mark 'BIG MAC' and the corporate Logo (or 'M' design), (hereinafter collectively referred to as the 'McDonald's Marks') which are used in connection with opposer's restaurant services and food products. x x x

2. Being the owner and rightful proprietor of the McDonald's Marks, opposer effected the registration of the same in the United States of America and in many other countries as early as 23 June 1970. x x x

3. By reason of opposer's prior and continuous use of the McDonald's Marks, in particular the corporate logo (or 'M' design) and the mark 'BIG MAC', the same have acquired a meaning exclusively identified with its goods and services such as to solely indicate opposer's goods and services.

4. To promote opposer's goods and services in the Philippines and ensure the quality thereof, opposer has, since 1971, embarked on an extensive advertising campaign through all forms of media.

In its Answer, Respondent-Applicant denied the material allegations made in the opposition and alleged the following affirmative and/or special defenses:

- a) RESPONDENT was the first to adopt and use the mark 'BIG MAC and M Design' for garments and wearing apparels.
- b) RESPONDENT'S goods are very much unrelated to the goods or services of the Opposer. The goods of the Respondent are T-shirts, polo shirts, socks, pajamas, blouses, bags, shoes and handkerchiefs and fall under Classes 18, 24 and 25 while Opposer's marks are used for restaurant services and food products and are classified under Classes 42, 29, 30 and 32. Moreover, the goods of Respondent flow through outlets or channels of trade different from that Opposer's goods.
- c) The mark of the Respondent as appearing in the labels actually used in commerce is different in style, appearance and presentation from any of the marks of the Opposer. In fact, Opposer has no independent registered mark consisting of 'BIG MAC and M design'.
- d) The registrability of the mark 'BIG MAC and M Design' in favor of Respondent has been passed upon by the Bureau of Patents, Trademarks and Technology Transfer when the latter allowed the subject application for publication in the Official Gazette of the Bureau."

Thereafter, the case was set for pre-trial to April 12, 1989 but was reset to May 15, 1989 as the parties are negotiating for an amicable settlement.

After several postponements, the parties agreed in open court that the case be submitted for decision on the sole issue of confusing similarity. The parties were thus requested to simultaneously submit their respective memoranda.

On December 20, 1989, Opposer submitted its Memorandum in support of its opposition. Respondent-Applicant, on the other hand, submitted a letter dated January 31, 1990 stating therein that he "would like to withdraw (his) application of the above mentioned trademark with Application Serial No. 44124 which is under Inter Partes Case No. 3311", and that he is "no longer interested of the said application and x x x finally decided not to use the said trademark".

Based on the aforecited letter, Respondent-Applicant has finally decided to abandon subject application.

WHEREFORE, despite the aforecited letter which was filed after the case has been submitted for decision, this Notice of Opposition is nevertheless SUSTAINED. Respondent's Application Serial No. 44124 for the mark "BIG MAC AND LOGO M WITHIN A DESIGN" is REJECTED and also is declared ABANDONED.

Let the records of the case be forwarded to the Application, Issuance and Publication Division for appropriate action in accordance with this Decision.

SO ORDERED.

IGNACIO S. SAPALO  
Director