WERKSMANS
ATTORNEYS

INTELLECTUAL PROPERTY

CANCELLED OR PARTIALLY CANCELLED TRADE MARKS – SOME TAKE AWAYS

31 October 2019 *2 min read*

By Donvay Wegierski, Director



The European Union's Trade Mark office (EUIPO) has this year cancelled McDonald's European Union Trade Mark registrations for **BIG MAC** and partially cancelled the trade mark **MC** in the EU as a consequence of non-use applications filed by Irish fast food chain Supermac.

The general principle is that if a trade mark is not used for a certain period, a trade mark can be vulnerable to cancellation for non-use. It is necessary for an interested third party to formally file cancellation proceedings on the grounds of non-use and it is then left up to the trade mark owner to shift that onus by providing evidence that the mark has in fact been used.

Brand owners are reminded of some of the implications:

- **Enforcement**: A cancelled or partially cancelled mark can still be used but enforcing it against others for unauthorised use is confined to those goods and services for which the registration remains valid in the EU;
- **Evidence of use**: Both rulings adverse to McDonalds provide some guidance to brand holders as to the evidence of use required if defending a non-use cancellation action. The standard of proof is not excessively high but the evidence provided should be strong:
    - Evidence of online use also requires visitor statistics;
    - Evidence of use must show that the mark is used within the normal course of trade and genuine, that is the mark is used in relation to the goods and services for which the mark is registered in that territory in exchange for payment;
    - Advertising material, affidavits and brochures also require proof of actual sales such as invoices; and
    - Although considered, affidavits signed by employees are less persuasive than those from an unrelated source are.
- **Distinctiveness**: It is common to use a mark in combination with a range of products, which together, comprise a family of marks. Brand owners should ensure that this mark is also used alone to retain the distinctiveness of the mark; and
- **Review and refile**: Brand owners refile trade marks that are not in use, albeit defensively, protecting those trade marks that are vulnerable to cancellation for non-use.



Donvay Wegierski

Director

View Profile