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INTELLECTUAL PROPERTY

European Union: Partial Revocation for Big Mac

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A registered trade mark is vulnerable to revocation or cancellation for non-use if it has not been used for the goods and/or services for which it is registered for a certain amount of time. In most instances this time period is five years and is calculated from the date of registration, as in South Africa and the European Union.

On 5 June 2024 in proceedings brought by Supermac against the European Union Intellectual Property Office ("EUIPO") and McDonalds, the General Court held that McDonald's had in fact failed to establish *genuine* use of its **BIG MAC** European Union Trade Mark ("EUTM") in respect of "chicken sandwiches", "foods prepared from poultry products" and in the service class for "services rendered or associated with operating restaurants and other establishments or facilities engaged in providing food and drink prepared for consumption and for drive-through facilities; preparation of carry-out foods".

The General Court therefore partially annulled and altered the decision of the EUIPO and consequently those goods and services have been revoked from the EUTM for **BIG MAC** aside from "meat sandwiches." While McDonalds can still use the mark **BIG MAC** in the European Union ("EU") this ruling means that it no longer has exclusivity to **BIG MAC** for chicken sandwiches, foods prepared from poultry products and those restaurant services for which protection has been revoked.

Background

In respect of EUTMs, once non-use is raised the burden shifts to the owner of the mark to prove *genuine* use of the mark for at least five consecutive years in the Territory for the relevant goods and services. Evidence of *genuine* use in at least one member country of the EU is required.

Proceedings between Supermac and McDonalds go back to 2015 when McDonald's opposed Supermac's EUTM for **Mc**. In 2017 Supermac retaliated with an action to revoke its EUTM for **BIG MAC** on the basis of non-use. Those proceedings were upheld in January 2019 whereafter McDonald's successfully appealed in March 2019, with that successful appeal brought before the General Court by Supermac.

Evidence and *Genuine* Use

When assessing whether use of a trade mark is *genuine* regard must be had to all the facts and circumstances relevant to establishing whether the commercial use of the mark in the course of the trade is real.

The General Court considered the EU Regulations that provide that evidence of use must establish:

- the place, time, extent, and nature of use of the trade mark;
- that the type of evidence be confined to packages, labels, pricelists, catalogues, invoices, photographs, newspaper advertisements and statements in writing clearly showing the trade mark.

The evidence that McDonalds had submitted to the EUIPO Cancellation Division were printouts of advertising posters in France, screenshots of television advertisements broadcast in France in 2016 and screenshots from MacDonalds France Facebook account from 2016, see below by way of illustration:

The General Court held that this evidence did not show any regularity and recurrence that the **BIG MAC** goods were distributed and was therefore insufficient to establish that commercial use of **BIG MAC** for "chicken sandwiches" was real. Furthermore the evidence did not include prices at which those goods where marketed.

At paragraph 24 of the General Court judgment: "*genuine use of a trade mark cannot be proved by means of probabilities or presumptions, but must be demonstrated by solid and objective evidence of actual and sufficient use of the trade mark on the market concerned*".

Implications for Brand Owners

This judgment is a reminder that even well-known brands may face cancellation or partial cancellation proceedings.

In defending proceedings for revocation or cancellation the evidence adduced should clearly show the mark and that the mark is used in commerce in respect of the relevant goods and or services and during the relevant time. Token or once off use may be insufficient.

Brand owners should retain evidence of use and maintain comprehensive records. Brand portfolios should be regularly reviewed and protection obtained for all forms of the mark, for all relevant goods and/or services and in all relevant Territories.

Please contact the Werksmans Intellectual Property Team for further advice.

*A European Union trade mark ("EUTM") registration covers all 27 countries of the European Union, namely Austria, Belgium, Bulgaria, Croatia, Denmark, Finland, France, Germany, Greece, Ireland, Italy, Luxembourg, Netherlands, Portugal, Romania, Spain, Sweden, Cyprus, the Czech Republic, Estonia, Hungary, Latvia, Lithuania, Malta, Poland, Slovakia and Slovenia. An EUTM registration is effective from both a cost and time perspective in that trade mark protection is attained in all the countries concerned by means of having to file only one trade mark application.

References

Judgment of the General Court (Sixth Chamber) Case T 58/23 – Supermac (Holdings) Ltd vs McDonald's International Property Co. Limited.

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