WERKSMANS
ATTORNEYS

INTELLECTUAL PROPERTY

SUPERMAC VS MCDONALDS – THE TRADE MARK BATTLE CONTINUES

4 September 2019 *3 min read*

By Donvay Wegierski, Director

The European Union Intellectual Property Office (EUIPO) has partially cancelled McDonald's EU trade mark registration for **MC**. Favouring the non-use application brought by Irish fast food chain Supermac that McDonalds has since appealed comes just a few months after the EUIPO cancelled McDonald's **BIG MAC** EU registration.

In terms of the EUIPO's partial revocation of the trade mark **MC**, this registration remains valid in respect of certain goods including chicken nuggets and sandwiches while other goods and services have been removed from the registration, including restaurant services.

supermac-mcdonalds

As we know a trade mark adds significant value to a business and as a result can be desired by others. Without a doubt, **MC** is fundamental to McDonalds though understandably sought after by others particularly those with the same namesake, in this case 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.

Here, the EUIPO found that there was no evidence of use of the mark **MC** within the EU alone but instead that the mark **MC** serves as a prefix as it is combined with other elements including McFlurry and McNuggets and McChicken. These combination marks further confirm that **MC** pertains to a group or family of marks eminating from the McDonald's name and that **MC** is not a distinctive mark on its own.

McDonalds may choose to appeal this ruling too but will need to demonstrate that the EUIPO's findings were flawed.

IMPLICATIONS

- **Enforcement**: McDonalds can still use the mark **MC** 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