

Supermac Takes a Bite out of Mcdonald's as it Loses the Big Mac Trade Mark in the European Union

Article By:

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Although it may be one of the most famous burgers in the world, on 15 January 2019, Supermac's (Holdings) Ltd was successful in seeking the cancellation of McDonald's International Property Company Ltd (**McDonald's**) EU trade mark registration for BIG MAC for burgers or restaurants.

Cancellation actions

Under Article 58(1)(a) of the EU Trade Mark Regulation (EU) 2017/1001 (**EUTMR**), an EU trade mark can be cancelled where:

- within a continuous period of five years the mark has not been put to genuine use within the EU for the relevant goods and services for which it is registered; and
- there are no proper reasons for non-use.

McDonald's evidence

McDonald's filed purported evidence of use of the BIG MAC Trade Mark in EU member states in response to the application for cancellation. The evidence included:

- affidavits signed by McDonalds' representatives in relation to sales figures for Big Mac sandwiches
- brochures and printouts of advertising posters and packaging relating to Big Mac sandwiches
- printouts from McDonalds' European websites, and
- a printout from Wikipedia relating to the "Big Mac Hamburger".

However the EUIPO concluded that on reviewing the evidence there had been not been genuine use, leading to the cancellation of the BIG MAC Trade Mark.

In reaching its decision the EUIPO made findings that:

- the evidence filed did not have significant probative value of the evidence as:
 - all the evidence submitted by McDonald's was from McDonalds' employees or representatives. Whilst the EUIPO emphasised that this type of evidence does carry

- some value, it is given comparatively less value than third party evidence; and
- Wikipedia entries cannot be considered a reliable source of information as they can be amended by Wikipedia's users; and
- a holistic assessment of McDonald's evidence did not prove the extent of use of its mark. The EUIPO clarified that extent of use is assessed holistically, considering the nature of the goods and services, the characteristics of the market concerned, the territory, commercial volume, duration and frequency of use. McDonald's only used evidence of use in the UK, Germany and France in an attempt to demonstrate extent of use for the whole of the EU, with the reasoning that these three member states are the most economically significant member states. The evidence also only referred to some of the relevant goods and services such as sandwiches.

Lessons to be learned

This decision demonstrates the significance of being strategic in filing evidence of use in proceedings before the EUIPO. Simply relying on the commercial success of a trade mark is insufficient to counteract poorly formulated evidence. The decision also confirms the trend established in the controversial Kit Kat case that EU trade mark law is moving in the direction of requiring use in most (if not all) EU Member States, a worrying trend for brand owners who have relied solely on EU trade mark rights.

It is likely McDonald's will appeal this decision and, if so, it will be worth seeing what evidence McDonald's will rely upon.

Star Tong is a trainee solicitor who contributed to this post.

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