

# Big Mac trade mark action—they're not lovin' it (Supermac's (Holdings) Ltd v McDonald's International Property Company Limited)

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**IP analysis:** The EU trade mark registration 'BIG MAC' has been revoked by the EUIPO Cancellation Division on the basis of lack of genuine use. Carrollanne Lindley, partner and trade mark attorney, and Philippa Malas, consultant, at Kilburn & Strode consider the importance of this case and what practical lessons can be learned.

*Supermac's (Holdings) Ltd v McDonald's International Property Company Limited*, [CANCELLATION No. 14 788 C \(REVOCATION\)](#)v

## What is the background to this case and why is it of interest to practitioners?

McDonald's founder Ray Kroc is said to have commented that it requires a certain kind of mind to see beauty in a hamburger bun. The restaurant chain's success was allegedly built on Kroc's identification in the 1950s of the value in the 'glorious name, McDonald's'. As said by Kroc's character in a film about McDonald's origin: 'A guy named McDonald? He's never gonna get pushed around in life'. Except that is, by the Cancellation Division of the EUIPO.

McDonald's has, at first glance, lost its EU trade mark rights to 'BIG MAC'. If it can happen to McDonald's, can it happen to anyone?

There is, unsurprisingly, history between the parties in 'BIG MAC'. In 2017, McDonald's opposed two European Union trade mark (EUTM) applications for 'SUPERMAC'S' by the Irish fast food restaurant chain of the same name. McDonald's argued likelihood of confusion (art 8(1) and/or art 8(5) of Regulation (EU) 2017/1001). Supermac's is currently the proprietor of an EUTM registered in 2016 for 'SUPERMAC'S' (class 30) and an Irish trade mark registration dating back to 1989 (class 29).

Supermac's response to McDonald's was bold and in kind—it filed an application for revocation for non-use against McDonald's EUTM 'BIG MAC' in classes 29, 30 and 42.

The Cancellation Division handed down its decision in January 2019, revoking the 'BIG MAC' mark in full.

Practitioners will be interested to know the Office revoked the mark in full, even though the applicant conceded in its observations in reply that the evidence showed use on a narrow construction for 'a sandwich including a beef patty, lettuce, cheese, pickles, onions and a special sauce'.

McDonald's remained one of the world's top-ten brands in 2018. It is wholly implausible to suggest that the corporation has suffered overnight amnesia and overlooked the value of a name, but the case highlights the importance of a proprietor filing adequate evidence in defence of a revocation action—especially as the burden is theirs to prove genuine use.

The 'BIG MAC' decision can, of course, be appealed.

## What did the EUIPO Cancellation Division decide and why?

The Cancellation Division concluded that the evidence submitted by McDonald's was insufficient to prove genuine use of 'BIG MAC' for any of the goods and services for which it was registered for the five-year period between April 2012 to 2017. The mark was therefore revoked from the date of Supermac's application—not

earlier, as the applicant had preferred. The Office found that there was no evidence showing a real legal interest requiring earlier revocation. Costs were awarded in Supermac's favour.

To the lay person, the decision might seem surprising. How could the fast food giant not be able to provide evidence supporting use of 'BIG MAC'? As noted in the decision, the method and means of proving genuine use are unlimited and no artificially high burden of proof had been imposed. In the view of the Cancellation Division 'the EUTM proprietor chose to restrict the evidence submitted' with evidence falling under four categories:

- three affidavits from McDonald's Representatives in Germany, France and the UK
- advertising/packaging
- printouts from 18 EU McDonald's websites
- a Wikipedia page about the Big Mac

What it failed to submit was stand-alone commercial data in support of this material, eg sales or website activity.

### **Why was the evidence of genuine use considered to be inadequate in this case?**

It was not the quantity of the evidence which was the problem, but rather the lack of data attesting to the extent of genuine commercial use. In the Office's view, the evidence submitted did not give enough detail regarding sales figures, numbers of orders taken via a website, nor website traffic and where that traffic originated from. It held that none of the materials gave 'any data for a real commercial presence of the EUTM for any of the relevant goods or services'.

McDonald's submitted three affidavits, all of which were from McDonald's representatives who referred to sales/turnover. This was a risky strategy and meant that while the probative value of the affidavits was of some value, it was at a low level due to the potential bias of the statement makers. Third-party statements from those not under the economic control of the corporation would have been more persuasive.

The Cancellation Division also found that, in the absence of stand-alone sales data, the promotional and packaging materials submitted were not sufficient to corroborate the sales and turnover figures asserted in the affidavits.

The Wikipedia printout—a source which could be edited by anyone—was treated with withering contempt.

### **What practical lessons can be learned from this case as to the evidence that trade mark proprietors need to provide to prove genuine use of a mark?**

In practice, clients can understandably be hesitant about handing over sales data in evidence especially in proceedings against a competitor. The decision in 'BIG MAC' shows that not submitting stand-alone evidence of sales, turnover or web traffic data can put an EU registration at risk. It is still, of course, for the client to assess the commercial risk involved in revealing the data, weighed against the value of the registration. It is also worth noting that the 'BIG MAC' registration subject to these proceedings is unsurprisingly not the only BIG MAC trade mark registration owned by McDonald's. In a further interesting move, McDonald's refiled an EUTM for 'BIG MAC' in 2017.

The case provides a helpful reminder that evidence from third-parties will carry greater weight, especially in the absence of stand-alone commercial data. Finally, shred that Wikipedia printout.

*Interviewed by Andrew Muir.*

*The views expressed by our Legal Analysis interviewees are not necessarily those of the proprietor.*

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