

CANCELLATION No 14 787 C (REVOCAATION)

Supermac's (Holdings) Ltd, Ballybrit Business Park, Ballybrit, Galway, Ireland (applicant), represented by **Tomkins & Co.**, 5 Dartmouth Road, 6, Dublin, Ireland (professional representative)

a g a i n s t

McDonald's International Property Company, Ltd., 110 N. Carpenter Street, 60607, Chicago, Illinois, United States of America (EUTM proprietor), represented by **Bardehle Pagenberg Partnerschaft mbB Patentanwälte, Rechtsanwälte**, Prinzregentenplatz 7, 81675 Munich, Germany (professional representative).

On 31/07/2019, the Cancellation Division takes the following

DECISION

1. The application for revocation is partially upheld.
2. The EUTM proprietor's rights in respect of European Union trade mark No 10 392 835 are revoked as from 11/04/2017 for some of the contested goods and services, namely:

Class 29: *Foods prepared from meat and poultry products (except for chicken nuggets), foods prepared from pork and fish products, preserved and cooked fruits and vegetables, eggs, cheese, milk, milk preparations, pickles.*

Class 30: *Biscuits, bread, cakes, cookies, chocolate, coffee, coffee substitutes, tea, mustard, oatmeal, pastries, sauces, seasonings, sugar; desserts.*

Class 32: *Non-alcoholic beverages, syrups and other preparations for making beverages.*

Class 43: *Restaurant services.*

3. The European Union trade mark remains registered for all the remaining goods, namely:

Class 29: *Chicken nuggets.*

Class 30: *Edible sandwiches, meat sandwiches, pork sandwiches, fish sandwiches, chicken sandwiches.*

4. Each party bears its own costs.

REASONS

On 11/04/2017, the applicant filed a request for revocation of European Union trade mark registration No 10 392 835 'Mc' (word mark) (the EUTM). The request is directed against all the goods and services covered by the EUTM, namely:

Class 29: *Foods prepared from meat, pork, fish and poultry products, preserved and cooked fruits and vegetables, eggs, cheese, milk, milk preparations, pickles.*

Class 30: *Edible sandwiches, meat sandwiches, pork sandwiches, fish sandwiches, chicken sandwiches, biscuits, bread, cakes, cookies, chocolate, coffee, coffee substitutes, tea, mustard, oatmeal, pastries, sauces, seasonings, sugar; desserts.*

Class 32: *Non-alcoholic beverages, syrups and other preparations for making beverages.*

Class 43: *Restaurant services.*

The applicant invoked Article 58(1)(a) EUTMR.

SUMMARY OF THE PARTIES' ARGUMENTS

The applicant requests to have the contested EUTM revoked with effect from five years following the date of registration, as it was not put to genuine use by or with the consent of the proprietor in relation to all of the goods and services covered by the registration.

On 28/09/2017, the EUTM proprietor filed written observations and evidence of use (twenty attachments, which will be listed and analysed further down in the following section of the decision). It provides explanations and a description of the items filed as proof of use and submits that the evidence is sufficient to demonstrate that the contested EUTM has been used genuinely in relation to all of the registered goods and services, with the exception of *oatmeal* in Class 30.

In its observations in reply of 11/06/2018, the applicant challenges the evidence filed by the EUTM proprietor (as it will be detailed further down in the following section of the decision) and states essentially that 'if the Office is minded to accept the evidence as sufficient and functioning evidence of use – the threshold for which has clearly not been met', then the evidence would only be sufficient to maintain the registration for, 'at the very most', *foods prepared from poultry products, edible sandwiches, meat sandwiches, pork sandwiches, fish sandwiches, chicken sandwiches, coffee, coffee substitutes, tea, pastries, desserts being ice cream* in Classes 29 and 30.

In its last submissions of 02/08/2018, the proprietor contests the applicant's claims in relation to the evidence of use and submits further explanations as to the documents previously filed.

GROUNDS FOR THE DECISION

According to Article 58(1)(a) EUTMR, the rights of the proprietor of the European Union trade mark will be revoked on application to the Office, if, within a continuous period of five years, the trade mark has not been put to genuine use in the Union for the goods or services for which it is registered, and there are no proper reasons for non-use.

Genuine use of a trade mark exists where the mark is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services. Genuine use requires actual use on the market of the registered goods and services and does not include token use for the sole purpose of preserving

the rights conferred by the mark, nor use which is solely internal (11/03/2003, C-40/01, Minimax, EU:C:2003:145, in particular § 35-37, 43).

When assessing whether use of the trade mark is genuine, regard must be had to all the facts and circumstances relevant to establishing whether commercial exploitation of the mark is real, particularly whether such use is viewed as warranted in the economic sector concerned to maintain or create a market share for the goods or services protected by the mark (11/03/2003, C-40/01, Minimax, EU:C:2003:145, § 38). However, the purpose of the provision requiring that the earlier mark must have been genuinely used 'is not to assess commercial success or to review the economic strategy of an undertaking, nor is it intended to restrict trade-mark protection to the case where large-scale commercial use has been made of the marks' (08/07/2004, T-203/02, Vitafruit, EU:T:2004:225, § 38).

According to Rule 40(5) Commission Regulation (EC) No 2868/95 in conjunction with Rule 22(3) Commission Regulation (EC) No 2868/95 (in the version in force at the time of filing the application for revocation), the indications and evidence of use must establish the place, time, extent and nature of use of the contested trade mark for the goods and/or services for which it is registered.

In revocation proceedings based on the grounds of non-use, the burden of proof lies with the EUTM proprietor as the applicant cannot be expected to prove a negative fact, namely that the mark has not been used during a continuous period of five years. Therefore, it is the EUTM proprietor who must prove genuine use within the European Union, or submit proper reasons for non-use.

In the present case, the EUTM was registered on 15/03/2012. The revocation request was filed on 11/04/2017. Therefore, the EUTM had been registered for more than five years at the date of the filing of the request. The EUTM proprietor had to prove genuine use of the contested EUTM during the five-year period preceding the date of the revocation request, that is, from 11/04/2012 to 10/04/2017 inclusive, for the contested goods and services listed in the section 'Reasons' above.

On 28/09/2017 the EUTM proprietor submitted evidence as proof of use.

Before proceeding to listing the evidence, it is noted that there is a confidentiality request for the observations and evidence of use filed on the above mentioned date. In this regard, it is recalled that where a claim for confidentiality has been submitted by the party by use of a standard 'confidential' stamp on the cover page of the submission, or by ticking the 'confidential' tick-box when using the electronic communication platform, yet the documents enclosed contain no explanation nor indication of any special interest nor any attempt on behalf of the party to justify the confidential nature or status of the submission (as in the case at hand), the Office will remove this indication. This applies to all submissions where the party claims confidentiality 'by default', yet provides no justification in support of its claim. The party can at any time before the receipt of a request for inspection of files, invoke and sufficiently justify a special interest in keeping the document confidential. Based on the above, the Cancellation Division will remove the indication that the documents are confidential and proceed with the analysis of the evidence in this case accordingly.

The evidence to be taken into account is the following:

- **Annexes 1 to 3:** Three affidavits dated August and respectively September 2017, signed by the proprietor's Senior Department Head of Legal at McDonald's Deutschland LLC (Germany), by the proprietor's General Counsel at

McDonald's France Services (France) and respectively by the proprietor's Legal Counsel at McDonald's Restaurants Limited (UK). In respect of **Germany**, the evidence provides information on the use of the marks 'McDonald's' ('widely used since 1971' in relation to *restaurant services*), 'BIG MAC' ('widely used since 1973' in relation to *a sandwich with beef, salad and cheese*), 'McRIB' ('widely used since October 1982' in relation to *a pork sandwich*), 'McMUFFIN' ('widely used at least since June 2009' in relation to *a breakfast sandwich with egg, bacon, sausages, salad and/or cheese*), 'McTOAST' ('widely used at least since February 2009' in respect of *a toasted breakfast sandwich with ham, cheese, bacon or chocolate*), 'McFISH' ('widely used between 2012 and 2015' in relation to *fish sandwiches*) and 'McWRAP' ('widely used since at least March 2010' in relation to *a soft toasted tortilla wrap filled with chicken and salad*). The document further indicates the net turnover of 'McDonald's' in Germany and the advertising expenditure relating to 'McDonald's' goods and services for each of the years 2011 to 2016 as well as the number of products sold per year under the signs 'BIG MAC', 'McRIB', 'McMUFFIN', 'McTOAST', 'McFISH' and respectively 'McWRAP'. The affidavit given in respect of **France** provides similar information to the above (including net turnover, advertising expenditure and number of products sold) as regards the signs: 'McDonald's', 'BIG MAC', 'McMUFFIN', 'McFISH' and 'McWRAP'. Finally, the affidavit in relation to **the UK** states that the marks 'BIG MAC', 'McNUGGETS', 'McCHICKEN', 'McMUFFIN' and 'McFLURRY' have been widely used in the territory of this Member States and indicates the number of products sold under the signs and the turnover of McDonald's Restaurants Limited for each of the years 2011 to 2016. The affidavits are accompanied, in respect of each of these three Member States, by several annexes containing additional product labels, menu displays and promotional information dated in the main between 2011 to 2016 (on some the year is handwritten). In addition to the 'Mc' prefixed signs referred to in the affidavits, the evidence includes references to other such signs (for example 'McMenü', 'McSundae' in relation to *ice-cream*, 'McCafé', including depicted on *coffee/coffee based beverages* cups, 'McB' in relation a *bio beef sandwich*, 'McCroissant', 'McGriddles', 'McShaker' in relation to *fries*) as well as to the 'M' golden arch




(including depicted on *soft drinks* or *coffee paper cups*).

- **Annex 4:** Extracts from the EUTM proprietor's websites in Germany, Austria, Belgium, the Czech Republic, Denmark, Spain, Finland, France, Hungary, Ireland, Italy, the Netherlands, Poland, Portugal, Romania, Sweden, Slovenia, Slovak Republic and the United Kingdom, dated in January 2014, September 2016 and respectively October 2016. The evidence is in the official language of the respective Member State and shows, among others, several 'Mc' prefixed signs ('McWrap', 'McSundae', 'McFlurry', 'McBaguette', 'McDouble', 'McRib', 'McFish', 'McNuggets', 'McChicken', 'McToast', 'McMuffin', 'McCroissant', 'McCafé', 'McFreeze', 'McPOLLO', 'McKroket' or 'McCruncher') in relation to *foodstuffs* and *coffee/coffee-based beverages* respectively. The evidence in respect of Germany, Austria, Slovakia, Italy, France, Poland, Portugal and Romania further contains references to 'McCafé' products and/or the offer 'McCafé' and displays pictures of the goods offered (*coffee/coffee based beverages, water, soft drinks, cakes and pastries*). For France there is also a mention of 187 'McCafé' within 'McDonald's restaurants' whereas for Portugal the evidence shows the picture of a café counter displaying the sign 'McCafé'.
- **Annexes 5 and 6:** Selection of documents (copies of product labels/packaging, menu displays, vouchers and promotional information dated in 2012, 2013, 2015 and 2016) relating to Germany and respectively Luxembourg and showing the sign 'McDonald's' in relation to *restaurant services* as well as other 'Mc' prefixed

signs ('McMorning', 'McBaguette', 'McCroissant', 'McCurrywurst', 'McMenü', 'McCafé', 'McToast', 'McWrap', 'McChicken', 'McMuffin', 'McRib' and 'McFlurry') in relation to foodstuffs and coffee/coffee-based beverages.



- **Annex 7:** Undated printouts in German displaying the sign  in connection with a *meat sandwich*. The EUTM proprietor informs that the evidence is aimed at showing use of the contested EUTM in relation to a *sandwich including a beef patty, pickles, onions, ketchup, cheese, eggs, jalapenos and/or bacon*.
- **Annex 8:** Printouts from Wikipedia titled 'History of McDonald's'.
- **Annex 9:** Printouts from <http://corporate.mcdonalds.com> containing an extract from the '2016 Financial Information' published on the corporate website of the EUTM proprietor and showing, inter alia, the number of restaurants owned or operated by McDonald's in EU Member States at year-end 2016 and 2011.
- **Annex 10:** Copy of 'McDonald's Germany Corporate Responsibility Report 2016', showing, inter alia, that 50% of Germans over the age of 14 visit McDonald's at least once a year and that 'McDonald's' Germany is the *clear market leader in the German foodservice sector* (share around 25%).
- **Annexes 11 and 12:** Extracts from the 2016 and respectively 2014 Annual Reports of the McDonald's Corporation. The evidence mentions, among other things, the worldwide annual revenues of the company for each of the years 2009 to 2016 and the revenue in Europe for each of the years 2012 to 2014. The amounts are in USD and range between tens of billions to dozens of billions per year.
- **Annex 13:** Extracts from a publication issued by the Institute of Trade Mark Agents (with a copyright date in 1996) and mentioning, inter alia, that *according to the latest edition of The World's Greatest Brands published by Interbrand on 13 November, McDonald's has taken over from Coca-Cola as the world's top brand*.
- **Annex 14:** Printouts from www.interbrand.com, featuring the 'Best Global Brands' rankings for each of the years 2016 to 2001. The evidence shows that the sign



(from the region/countries United States), ranked 12, 9, 8, 7 or 6 place for the *Restaurants* sector.

- **Annex 15:** Printouts from <http://brandz.com>, featuring extracts from the 'BrandZ Top 100 Most valuable global brands' studies by Millward Brown for each

of the years 2016 to 2006. The evidence mentions the signs  **McDonald's**,



or 'McDonald's' (ranked within the first 10 places for the category *Fast Food* for the years 2016 to 2008 and respectively as brand no 11 for the years 2007 and 2006). In addition, the sign 'McDonald's' was ranked as brand no 1 in the 'Top 10 Fast Food' brands for each of the years 2016 to 2006. The BrandZ 2010 contains references to 'McCafé' as follows: *McDonald's benefitted from the McCafé initiative to improve its coffee. The chain bet that better coffee would help it expand the breakfast trade and compete against Starbucks and other coffee houses. McCafé provides a menu of coffee drinks and in some locations has a separate section of the restaurant.*

- **Annexes 16 and 17:** Copies of two surveys carried out by Infratest Burke in Germany in August/September 1991 and respectively in January/February 1992 (documents in German). According to the information provided by the EUTM proprietor, the documents show that in Germany already in 1991, more than 50% of the polled persons spontaneously answered 'McDonald's' when they were shown a card with the designation 'Mc' and asked *What comes to your mind*

when you hear or see *this designation* and respectively that in 1992 more than 80% of the German consumer circles involved recognised the letters 'Mc' as referring to a certain group of restaurants.

- **Annexes 18 and 19:** Copies of two surveys carried out by The Nielsen Company between 04/03/2011 and 10/03/2011 and respectively by Forecast Research Piackutató, between 28/02/2011 and 04/03/2011 (documents in Hungarian and partial English translations). The surveys were conducted on a sample of 800 persons, aged 18 to 59 (living in or around Budapest and in South-West Hungary) and respectively 1 000 persons, aged 18 to 50 (from Budapest). The participants were asked three questions ('Which company uses the prefix 'Mc' in Hungary' – multiple choice question, 'Which restaurant uses the prefix 'Mc' in Hungary' – multiple choice question and 'Which restaurant using the prefix 'Mc' is the most famous, known to you' – multiple choice in the Forecast Research survey and respectively one answer possible question in the case of the Nielsen survey). According to the documents, a very high percentage of the respondents (close to 90% and in some cases even above) mentioned 'McDonald's' spontaneously as the company and respectively restaurant associated with the prefix 'Mc', as well as a famous restaurant using said prefix.
- **Annex 20:** Printouts from curia.europa.eu containing the judgement of the General Court of 05/07/2016, T-518/13, MACCOFFEE, EU:T:2016:389.

Preliminary remarks on some of the applicant's arguments

Before proceeding to the assessment of the evidence, the Cancellation Division deems appropriate to discuss some of the applicant's arguments.

(1) Examination of individual pieces of evidence

As shown above under the 'Summary of the Parties' Arguments' section, the applicant individually assesses and challenges all of the items of evidence filed on 28/09/2017 stating on the main that these do not indicate genuine use in terms of time, place, extent, nature and use for the goods and services for which the EUTM is registered and therefore should be disregarded.

The applicant's argument is based on an individual assessment of each item of evidence regarding all the relevant factors. However, when assessing genuine use, the Cancellation Division must consider the evidence in its entirety. Even if some relevant factors are lacking in some items of evidence, the combination of all the relevant factors in all the items of evidence may still indicate genuine use.

Therefore, these arguments of the applicant have to be set aside as unfounded.

(2) Use by a third party

The applicant further contends that 'the affidavits are not made by any employee of the registrant' and since no evidence setting out the link between the proprietor and the executors of those documents has been supplied, they cannot be construed as evidence that proves use by or with the proprietor's consent.

This argument of the applicant cannot succeed either. First, it is recalled that where an EUTM proprietor submits evidence of use of its marks by a third party, this is an implicit indication that it consented to this use (08/07/2004, T-203/02, Vitafruit, EU:T:2004:225). Moreover, in the present case, each of the three affidavits mentions that the person giving the statement occupies a position with the respective McDonald's legal entity (see above under the list of evidence Annexes 1 to 3). While it

is true that the proprietor did not submit any documents regarding said companies (such as extracts from the German, French or UK company registers), the Cancellation Division finds it evident that McDonald's Deutschland LLC (Germany), McDonald's France Services (France) and McDonald's Restaurants Limited (UK) are the commercial vehicles through which the proprietor conducts its business in the respective EU Member States. Consequently, the applicant's claims are unfounded.

(3) Translation of the evidence

The applicant further contends that part of the evidence (i.e. Annex 4 and Annex 16) is not accompanied by a translation into the language of the proceedings and therefore it should be disregarded. With particular reference to the survey in Annex 16 it further argues that 'the deadline for filing the requisite translations has now passed'. Furthermore, as regards the document in Annex 18, the applicant puts forward that the proprietor submitted 'an unverified translation' only.

It is clarified from the outset that the EUTM proprietor is not under any obligation to translate the proof of use, unless it is specifically requested to do so by the Office (Rule 22(6) Commission Regulation (EC) No 2868/95 (in the version in force at the time of filing the application for revocation), applicable by analogy to cancellation proceedings).

In the present case, the proprietor included in its submissions of 28/09/2017 a summary in English of the relevant parts of the document in Annex 16. Therefore, the applicant had information about the content of the evidence filed and was able to assess its content in order to be capable of exercising its right of defence. As for the document in Annex 18, it has to be pointed out that the Office accepts simple translations, drawn up by anybody and normally does not make use of its faculty to require the translation to be certified by a sworn or official translator, unless serious doubts arise regarding the accuracy or content of the translation. Against this background the Cancellation Division sets aside the applicant's claims as manifestly unfounded.

As for the extracts from the proprietor's websites (Annex 4), it is true that these were submitted in the official language of the respective Member State only. The same is valid as regards the additional product labels, menu displays and promotional information (filed in support of the affidavits in Annexes 1 and 2), which are only in German and French, respectively. However, taking into account the nature of the documents and their self-explanatory character, the Cancellation Division does not deem necessary to reopen the proceedings and explicitly ask the proprietor to provide a translation of those documents into the language of the proceedings.

Assessment of genuine use – factors

Time and Place of use

The evidence must show genuine use of the contested EUTM within the relevant period (from 11/04/2012 to 10/04/2017 inclusive) and in the European Union (see Article 18(1) EUTMR and Article 58(1)(a) EUTMR).

Part of the evidence is dated within the relevant time frame, as detailed above when listing the evidence of use. It is true that, as the applicant contends, some documents bear a handwritten indication of the year. However, there is no reason for the Cancellation Division to doubt the accuracy of that indication, since in most instances

the noting in manuscript is backed-up by time information included in the document itself, such as for example a copyright notice in the respective year.

It is further true that, as the applicant claims, some documents are either undated or bear a date outside the relevant period. However, the images of products/product packaging may serve to show how the mark was used in relation to the relevant goods and the internet printouts/screenshots to provide information regarding the type of goods the proprietor manufactures and markets, and therefore cannot be ignored in the evidence's overall evaluation (13/02/2015, T-287/13, HUSKY, EU:T:2015:99, § 67-68). In addition, the evidence dated outside the relevant time frame may serve to confirm or assess more accurately the extent to which the mark was used during the relevant period and the EUTM proprietor's real intentions at the time. The above does not however hold true as regards the surveys in Annexes 16 and 17. They were conducted in 1991 and 1992 respectively and pertain to a time frame which is too further removed from the relevant period. Furthermore, these documents have little relevance, if at all, for the purposes of the present assessment, as it will be discussed further down in the decision (under the 'Nature of use' section).

The documents submitted by the EUTM proprietor show that the place of use is the European Union. This can be inferred from the language of the documents (for example the website extracts in Annex 4) and the currency indicated.

Therefore, it is considered that the evidence of use filed by the EUTM proprietor relates to the relevant territory and contains sufficient indications concerning the time of use.

Extent of use

Concerning the extent of use, it is settled case-law that account must be taken, in particular, of the commercial volume of the overall use, as well as of the length of the period during which the mark was used and the frequency of use (e.g. 08/07/2004, T-334/01, Hipoviton, EU:T:2004:223, § 35).

Furthermore, it must be recalled that the assessment of genuine use entails a degree of interdependence between the factors taken into account. Thus, the fact that commercial volume achieved under the mark was not high may be offset by the fact that use of the mark was extensive or very regular, and vice versa. Likewise, the territorial scope of the use is only one of several factors to be taken into account, so that a limited territorial scope of use can be counteracted by a more significant volume or duration of use.

Moreover, use of the mark need not be quantitatively significant for it to be deemed genuine.

In addition, under certain circumstances, even circumstantial evidence, despite not providing direct information on the quantity of goods actually sold, can be sufficient by themselves to prove the extent of use in an overall assessment (15/07/2015, T-398/13 TVR ITALIA (fig.) /TVR et al., EU:T:2015:503, § 57-58; 08/07/2010, T-30/09, Peerstorm, EU:T:2010:298, § 42 et seq.).

The Cancellation Division notes from the outset that the proprietor did not submit any invoices, but relied instead on three affidavits that provide information on, inter alia, the net turnover of McDonald's, the advertising expenditure for McDonald's goods and services as well as the number of products sold in Germany, France and the UK respectively under the sign 'BIG MAC' and under a number of 'Mc' prefixed signs,

namely: 'McRIB', 'McMUFFIN', 'McTOAST', 'McFISH', 'McWRAP', 'McNUGGETS', 'McCHICKEN', and 'McFLURRY' (Annexes 1 to 3).

It further provided extracts from two annual reports (Annexes 11 and 12) giving the revenue in Europe, for each of the years 2012 to 2014 and mentioning, inter alia, *Germany and France as key markets* and plans to *open about 250 new restaurants and reimage approximately 350 existing restaurants in 2015*. The proprietor further filed brand studies (Annexes 14 and 15) that provide information on, among others, the

brand value in USD millions for the signs  ,  or 'McDonald's'.

As far as the affidavits are concerned, albeit admissible means of proof of use (by virtue of Article 97(1)(f) EUTMR) they are generally given less weight than independent evidence. This is because the perceptions of a party involved in a dispute may be more or less affected by its personal interests in the matter. The probative value of such statements depends first and foremost on the credibility of the account it contains. It is then necessary to take account, in particular, of the person from whom the document originates, the circumstances in which it came into being, the person to whom it was addressed and whether, on the face of it, the document appears sound and reliable (07/06/2005, T-303/03, *Salvita*, EU:T:2005:200, § 42).

Furthermore, it follows from the case-law that, where a statement has been established for the purposes of Article 97(1)(f) EUTMR by persons within the sphere of the proprietor of the mark, probative value can be attributed to that statement only if it is supported by other evidence (see, to that effect, judgments of 13/05/2009, T-183/08, *Jello Schuhpark II*, EU:T:2009:156, § 39, of 13/06/2012, T-312/11, *Ceratix*, EU:T:2012:296, § 30 and § 50 and of 12/03/2014, T-348/12, *Sport TV Internacional*, EU:T:2014:116, § 33).

In other words, the final outcome depends on the overall assessment of the evidence in the particular case. The probative value of the affidavits depends on whether or not they are supported by other types of evidence (labels, packaging etc.) or evidence originating from independent sources. In view of the foregoing, the remaining evidence must be assessed in order to see whether or not the contents of the affidavits are supported by the other items of evidence and whether the latter documents furnished provide further indications on, inter alia, the extent of use.

It must be observed from the outset that the market in question is for the production and sale of *fast food items* that are intended for normal, everyday use and for the provisions of *fast food restaurant services*. It is well known that such market is often characterised by relatively high demand and by the sale of a high number of goods to the public at large. Therefore, the provision of traditional sales evidence, such as paper invoices, is not necessarily functional when it comes to trade held in the relevant market sector.

On the other hand, it is clear from the body of evidence submitted before the Cancellation Division (in particular the documents accompanying the three affidavits, the extracts from the EUTM proprietor's websites in various Member States, the copies of product labels/packaging, the menu displays, vouchers and promotional materials or printouts detailing the number of restaurants operated by the proprietor in EU Member States) that goods under the 'Mc' prefixed signs mentioned in the affidavits as well as under the sign 'BIG MAC' have been continuously offered for sale to end consumers, the use of the signs was public and the signs were exposed to the public at large with the aim of creating a market for the fast food products on which they were applied. The

information on the number of restaurants, the brand values and the revenues (albeit the latter numbers given globally) do serve to support at least to a certain extent the information on turnover and number of products sold that was provided in the three affidavits for the signs at issue.

In an overall assessment of the evidence, the Cancellation Division deems that the documents, albeit not particularly extensive, demonstrate a certain scale of use of 'BIG MAC' and the 'Mc' prefixed signs listed in the affidavits during the relevant period which allows for the conclusion that the extent of use was not merely token. However, this applies only in relation to some of the goods and services for which the contested EUTM is registered (as will be explained in detail in the following section of the decision 'Nature of use', subsection 'Use in relation to the registered goods and services'). Furthermore, the brand studies in Annexes 14 and 15 undisputedly show that the sign 'McDonald's' enjoys a consolidated position among the top *fast food restaurant* brands and that it was ranked as brand no 1 in the 'Top 10 Fast Food brands' for several consecutive years.

However, account must be taken of the fact that the contested EUTM is the word sign 'Mc'. Consequently, whether the evidence is sufficient for demonstrating genuine use of this sign further depends on whether the documents are apt in showing use of the mark in a form that does not alter its distinctive character, which will be further assessed by the Cancellation Division in the following section of the decision.

For the sake of completeness it is noted that in addition to the signs mentioned in the three affidavits (namely, 'McDonald's', 'BIG MAC', 'McRIB', 'McMUFFIN', 'McTOAST', 'McFISH', 'McWRAP', 'McNUGGETS', 'McCHICKEN' and 'McFLURRY'), the proprietor's submissions of 28/09/2017 include references to seven other 'Mc' prefixed signs, as follows: 'McCroissant' claimed to have been used in relation to a *croissant including ham and eggs or chocolate*, as could be seen from Annexes 4 and 5, 'McMorning' claimed to have been used in relation to a range of *breakfast products, including sandwiches or croissants filled with cheese, salad, tomatoes and eggs or with chocolate, ham and eggs and coffee*, as could be seen from Annex 5, 'McBaguette' claimed to have been used in relation to a *baguette sandwich including a beef patty or a fried chicken patty, salad, cheese, tomatoes, onions and/or a special sauce*, as could be seen from Annex 5, 'McCurrywurst' claimed to have been used in relation to *sausages with a special sauce and curry*, as could be seen from Annex 5, 'McMenü' claimed to have been used in relation to a *combination meal including a main dish (sandwich, sausages or chicken nuggets), a side dish such as French fries and a beverage*, as could be seen from Annexes 4 and 5, 'McCafé' claimed to have been used in relation to *restaurant services and to a range of products usually sold by a pastry shop and/or a café such as confectionery, cakes, cookies, coffee, tea and beverages including milk*, as could be seen from Annexes 4 and 6 and 'Mc your own', claimed to have been used in relation to a *sandwich including a beef patty, pickles, onions, ketchup, cheese, eggs, jalapenos and/or bacon*, as could be seen from Annex 7. In addition, the evidence filed on the same date depicts other 'Mc' prefixed signs, such as 'McSundae' in relation to *ice-cream*, 'McB' in relation to a *bio beef sandwich* or 'McShaker' in relation to *fries*.

Having assessed the evidence produced by the EUTM proprietor in relation to these other 'Mc' prefixed signs, the Cancellation Division deems that the documents are not capable of establishing genuine use of the contested EUTM as they do not contain sufficient particulars as to the extent of use. Annexes 5 to 7 contain images of products under the signs at issue. The Internet extracts in Annex 4 show that the claimed goods are available online on the respective website. However this is not sufficient to support the proprietor's assertions of a genuine use in relation to the contested goods marketed

under these other signs or, as the case may be, the contested services offered thereunder. The affidavits or the proprietor's submissions contain no information on the number of products sold during the relevant period under any of the signs at issue. The only quantitative data the Cancellation Division was able to retrieve from the evidence concerns the sign 'McCafé' and more specifically that in France there are 187 'McCafé' within 'McDonald's' restaurants. However, in the absence of further corroborating evidence and complementary information as to the actual use of the Internet sites by potential and relevant consumers (in particular, that orders for the relevant goods have been made through the website by a certain number of customers in the relevant period) or complementary advertising and sales figures regarding the goods, the documents in Annexes 4 to 7 are not, in themselves, apt to prove that the goods were actually put on sale in the relevant territory and to what extent. The same applies as regards the claimed services offered under the sign 'McCafé'. The financial information in Annexes 11 and 12 is given globally and represents a too general reference to the entire activity of the proprietor in Europe to allow for a conclusion of genuine use other than resorting to assumptions and probabilities.

The proprietor did not make available other information and evidence which would serve to show the extent to which the signs concerned have been commercially active for the relevant period in relation to the claimed goods and services and that use was such as to create or preserve an outlet for those goods and services. Against this background, and bearing in mind that the Cancellation Division can only base its findings on the overall assessment of the documents before it and cannot reach a finding of genuine use by resorting to probabilities and presumptions (see (15/09/2011, T-427/09, *Centrotherm*, EU:T:2011:480, § 43), it must be concluded that the signs 'McCroissant', 'McMorning', 'McBaguette', 'McCurrywurst', 'McMenü', 'McCafé', 'Mc your own' were not genuinely used during the relevant period for any of the claimed goods and services. The same applies as regards any other 'Mc' prefixed signs that are depicted by the evidence, such as 'McSundae', 'McB' or 'McShaker'. The factors of time, place, extent and nature of use are cumulative (05/10/2010, T-92/09, *STRATEGI*, EU:T:2010:424, § 43). This means that the evidence must provide sufficient indication of all of these factors in order to prove genuine use. Failure to fulfil one of the conditions will lead to the evidence of use being rejected as insufficient and, as the extent has not been established, it is not necessary to enter into the other requisites as far as these signs are concerned.

The Cancellation Division will further proceed to the assessment of the nature of use factor as regards the signs for which time, place and extent were demonstrated, namely 'McDonald's', 'BIG MAC', 'McRIB', 'McMUFFIN', 'McTOAST', 'McFISH', 'McWRAP', 'McNUGGETS', 'McCHICKEN' and 'McFLURRY'.

Nature of use

In the context of Rule 22(3) Commission Regulation (EC) No 2868/95 (in the version in force at the time of filing the application for revocation), the expression 'nature of use' includes evidence of the use of the mark as registered, or of a variation thereof according to Article 18(1)(a) EUTMR, evidence of the use of the sign as a trade mark in the course of trade and evidence of its use for the goods and/or services for which it is registered.

Use as a trade mark and use of the mark as registered

Nature of use requires, inter alia, that the contested EUTM is used as a trade mark, that is, for identifying origin, thus making it possible for the relevant public to distinguish between goods and services of different providers.

Furthermore, 'Nature of use' in the context of Rule 22(3) Commission Regulation (EC) No 2868/95 (in the version in force at the time of filing the application for revocation) requires evidence of use of the mark as registered, or of a variation thereof which, pursuant to Article 18(1)(a) EUTMR, does not alter the distinctive character of the contested EUTM.

The applicant went to great lengths to criticise the evidence on the grounds that it does not show use of the EUTM as a trade mark and that the use of the sign was in a form which alters its distinctive character. Its main arguments can be summarized as follows: (i) the contested EUTM has not, nor has it ever been used as a trade mark to designate the goods and services of the proprietor. It was filed as a defensive mark to prevent third parties from using trade marks encompassing the 'Mc' term for the goods and services of the registration or for similar goods and services; (ii) 'Mc' is a very common prefix for surnames throughout Ireland, the United Kingdom and elsewhere throughout the European Union. Use of the trade mark 'Mc'-prefix with additional words and elements which is the only evidence provided by the proprietor does not guarantee origin. There are huge number of public houses, hotels, food items, beverages and restaurants which contain the prefix 'Mc' as part of a surname; (iii) the mark as registered has a relative low degree of distinctiveness and the addition of elements has a serious effect in the distinctive character of the mark and (iv) the proprietor does not and never has used 'Mc' in and of itself. The additions of the terms included are not separate and distinct from the combination with the 'Mc' element. It is not a 'Mc' Chicken sandwich, it is a 'McChicken'® sandwich. It is not a 'Mc' Rib sandwich, it is a 'McRib'® sandwich. The 'Mc' element is never used separately. It is very clear that the proprietor has a marketing strategy of using a specific prefix juxtaposed with additional elements and is only using its marks as new, coined juxtaposed marks to create a new brand in line with the claimed 'Mc' family of trade marks.

In turn, the proprietor essentially puts forward that: (i) the mark 'Mc' has been used as a prefix of the mark 'McDonald's' and moreover, of numerous product designations consisting of the prefix 'Mc' in combination with a further element describing the nature or a characteristic of the respective product; (ii) the term 'Mc' is used to identify menu items and other goods and services prepared, sold or rendered by McDonald's; (iii) due to McDonald's long and continuous use of the 'Mc' term, this term has become widely and exclusively associated with McDonald's by consumers throughout the European Union, as demonstrated by the surveys in Annexes 16 to 19 and (iv) the findings in the said surveys proving a very high level of distinctiveness of the designation 'Mc' have already been confirmed by numerous decisions issued by courts and trade mark offices throughout Europe, in particular the General Court in case T-518/13, MACCOFFEE, EU:T:2016:389. Therefore, in the proprietor's opinion, the use of the contested mark 'Mc' as part of the mark 'McDonald's' and in particular as part of numerous 'Mc' prefixed product designations is to be considered as a proper use of the mark 'Mc' standing alone.

The Cancellation Division agrees with the applicant that there is no evidence of use of the contested EUTM alone, but only accompanied by further elements. Therefore, the question to be answered is whether the addition of these other verbal elements alters the distinctiveness of the contested EUTM or not.

	(1) McDonald's <i>Restaurant services</i>
	(2) BIG MAC <i>Sandwich with beef, salad and cheese</i>
	(3) McRIB

Mc	<i>Pork sandwich</i>
	(4) McMUFFIN <i>Breakfast sandwich with egg, bacon, sausages, salad and/or cheese</i>
	(5) McTOAST <i>Toasted breakfast sandwich with ham, cheese, bacon or chocolate</i>
	(6) McFISH <i>Fish sandwich</i>
	(7) McWRAP <i>Soft toasted tortilla wrap filled with chicken and salad</i>
	(8) McNUGGETS <i>Small pieces of fried chicken meat</i>
	(9) McCHICKEN <i>Sandwich including a breaded chicken patty, lettuce and mayonnaise</i>
	(10) McFLURRY <i>Soft-serve ice cream dessert that has pieces of candy or cookies mixed into it</i>
Registered form	Used forms

It cannot be deemed that the use of the sign under (1) constitutes use of the contested EUTM 'Mc' in a form which does not alter the distinctive character of the mark as registered, since the two signs appear essentially different. The additional element 'Donald's' is not descriptive, devoid of distinctive character or weak for the services at issue. Moreover, it is not visually less standing than the element 'Mc' so that it can be construed that the difference between the registered and used form is in a negligible element. It is true that there is no legal precept in the European Union trade mark system that obliges the proprietor to provide evidence of the earlier mark alone when genuine use is required and that two or more trade marks may be used together in an autonomous way, or with the company name, without altering the distinctive character of the earlier registered trade mark (T-463/12, MB, EU:T:2014:935, §43). However, this is not the case for the present proceedings. It is clear from the evidence that 'Donald's' is not an independent mark or sign, which would refer for instance to the company mark, the manufacturer, etc. Furthermore, it is recalled that it is upon the proprietor of the mark to provide evidence that the additional sign is in fact an independent mark or sign, which the latter failed to do. In the light of the foregoing, the use of the sign 'McDonald's' cannot be regarded as an acceptable variation of the contested EUTM.

These findings are not called into question by the proprietor's reference to the surveys in Annexes 16 to 19 or to the judgement of the General Court in case T-518/13, MACCOFFEE, EU:T:2016:389 (Annex 20).

The probative value of the surveys in Annexes 18 and 19 has been significantly lowered by the fact that, as evidenced by the documents themselves, the respondents were confronted with leading questions. As regards the surveys in Annexes 16 and 17, it has already been pointed out when assessing the time of use, that this part of the evidence is essentially flawed since it pertains to a time frame too far removed from the relevant period. Be that as it may, the fact remains that the surveys in question are concerned with the ability of the sign 'Mc' to function as a badge of origin. However, the mere fact that the public associates the prefix 'Mc' with a certain company (i.e.

McDonald's) and with *restaurant services* does not automatically mean that use of the sign 'McDonald's' is equivalent to the use of the registered mark 'Mc'. What needs to be shown for the purposes of the present assessment is that the contested mark was used in a form which does not alter the distinctive character of the EUTM as registered, not that the element 'Mc' can function as a trade mark or that it has a certain degree of recognition on the market, even if such degree is, as shown by the documents in question, rather high.

The judgment relied upon by the proprietor is also not relevant for the present proceedings.

Paragraph 64 quoted by the proprietor, reads as follows: *Finally, it should be noted that the marks McMUFFIN, McRIB, McFLURRY, CHICKEN McNUGGETS, McCHICKEN and EGG McMUFFIN, derived from the McDONALD'S trade mark, fulfil all the conditions to form a 'family' of trade marks, within the meaning of the case-law cited [...] above, in so far as they are sufficient in number and reproduce in full the same distinctive element, namely the element 'mc', with the addition of a word element that differentiates them from each other and that they are characterised by the repetition of the same prefix, 'mc', taken from the McDONALD'S trade mark. [...] As the Board of Appeal correctly observed in [...] the contested decision, the McDONALD'S trade mark, with a reputation for fast-food restaurant services, is the original trade mark of the family, to which all the derived marks are connected by a common feature, namely the prefix 'mc', and from which they are all separated by the same type of final element, which refers to one of the foodstuffs on the menu of the intervener's fast-food restaurants, as is pointed out in [...] the contested decision.*

The existence of a family of marks and the use of the registered mark in a form which does not alter its distinctive character are however two different issues. A family of marks is an additional factor relating to the assessment of the likelihood of confusion under Article 8(1)(b) EUTMR or, as the case may be, the existence of a link under Article 8(5) EUTMR. Nature of use in the context of revocation proceedings under Article 58(1)(a) EUTMR is one of the requirements to be proved by the EUTM proprietor and relates to, inter alia, evidence of the use of the mark as registered, or of a variation thereof according to Article 18(1)(a) EUTMR.

What the Court confirmed in the MACCOFFEE case was the existence of a family of marks, all characterised by the same prefix 'Mc', taken from the 'McDonald's' trade mark but not that 'McDonald's' and 'Mc' are broadly equivalent or that the differences between them are negligible.

Therefore, the proprietor's arguments have to be set aside.

Regarding the use of the sign under (2), despite the proprietor's claims that 'MAC' is the phonetically identical spelling of 'Mc', the additional letter 'A' placed between 'M' and 'c' substantially alters the visual appearance of the registered trade mark. Consequently, this difference constitutes an alteration of the distinctive character of the registered sign.

As regards the use of the signs under (3) to (9) inclusive, the elements added (*rib, muffin, toast, fish, wrap* and *nuggets*) are indented to describe the characteristics of the goods and/or their main ingredient. The Cancellation Division does not share the opinion of the applicant in that these signs are 'new, coined, juxtaposed marks'. Admittedly the EUTM 'Mc' and the descriptive term that follows after it are conjoined. Be that as it may, the fact remains that each of the additional words *rib, muffin, toast, fish, wrap* and *nuggets* has a clear and particular meaning with regard to the goods at

issue, which will be perceived by the relevant consumers irrespective of the particular way these signs are depicted. Against this background, it is concluded that the additional elements *rib*, *muffin*, *toast*, *fish*, *wrap* and *nuggets* do not alter the distinctive character of the EUTM.

The above does not hold true however as regards the sign under (10). The word *flurry* refers in English to *a small swirling mass of something, especially snow or leaves, moved by sudden gusts of wind, a sudden short period of activity or excitement or a number of things arriving or happening suddenly and during the same period* (meaning extracted from the Oxford Dictionary at https://www.lexico.com/en/definition/flurry_on_23/07/2019). This element is not in itself descriptive or non-distinctive in relation to the goods concerned and therefore this addition alters the distinctive character of the contested mark.

Against this background, it is considered that in the context of the evidence as a whole, the documents submitted show that the contested EUTM was used in such a way as to establish a clear link between some of the registered goods in Classes 29 and 30 and the EUTM proprietor and in a form which does not alter its distinctive character.

Use in relation to the registered goods and services

Article 58(1)(a) EUTMR and Rule 22(3) Commission Regulation (EC) No 2868/95 (in the version in force at the time of filing the application for revocation) require that the EUTM proprietor proves genuine use for the contested goods for which the EUTM is registered.

The contested EUTM is registered for goods and services in Classes 29, 30, 32 and 43 (see list in the 'Reasons' section above).

According to Article 58(2) EUTMR, where there are grounds for revocation for only some of the goods or services for which the contested mark is registered, the proprietor's rights will be revoked for those goods and services only.

According to case-law, when applying the abovementioned provision the following should be considered:

... if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of subcategories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the subcategory or subcategories to which the goods or services for which the trade mark has actually been used belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group

which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or subcategories.

[Furthermore,] allowing an earlier trade mark to be deemed to be registered only in relation to the part of the goods or services in respect of which genuine use has been established ... must be reconciled with the legitimate interest of the proprietor in being able in the future to extend his range of goods or services, within the confines of the terms describing the goods or services for which the trade mark was registered, by using the protection which registration of the trade mark confers on him.

(14/07/2005, T-126/03, Aladin, EU:T:2005:288)

Registered goods in Class 29

The EUTM covers in this class the broad categories of *foods prepared from meat and poultry products*, which refer to a variety of food items. On the other hand, the evidence shows use only for very specific goods *chicken nuggets*. This raises the question of whether the submitted evidence is to be regarded strictly as proof of use only for the particular goods, which are not mentioned as such in the list of goods, or for the broad categories of *foods prepared from meat and poultry products* as specified in the registration. In the present case, the Cancellation Division does not deem that use for, essentially, one type of goods is sufficient to secure use for the broad categories of the registered *foods prepared from meat and poultry products*, even when taking into account the principles arising from the above quoted 'Aladin' judgment. Therefore, it is concluded that genuine use was shown only for *chicken nuggets* in Class 29.

For the remaining registered goods in this class there is no evidence in terms of nature and/or extent and therefore the mark has to be revoked. It is true that some of the registered goods (such as for example *cheese* or *pickles*) are ingredients of the *sandwiches* marketed by the proprietor. This is not in itself sufficient to allow a conclusion of genuine use, since there is no evidence on file that such goods are also available separately under the contested EUTM.

For the sake of completeness, it is further noted that the presence of *fish*, *pork* or *chicken* as (main) ingredient in the sandwiches or wraps marketed by the proprietor under the signs 'McFISH', 'McRIB', 'McCHICKEN' or 'McWRAP' is not of such a nature as to lead to a conclusion of genuine use for other goods falling under the broad categories of *foods prepared from meat, pork, fish and poultry products*, since *sandwiches* and *wraps* (irrespective of the type of meat they contain) are properly classified in Class 30 and not in Class 29.

Registered goods in Class 30

Taking into account the evidence of use filed by the EUTM proprietor and bearing in mind that the EUTM proprietor is not required to prove use of all the conceivable variations of the category of goods and also the principles set out in the above mentioned Aladin judgement and in particular the legitimate interest of the proprietor in

being able in the future to extend his range of goods, within the confines of the terms describing the goods for which the trade mark was registered, the Cancellation Division deems that genuine use of the trade mark must be established for the following registered goods in Class 30: *edible sandwiches, meat sandwiches, pork sandwiches, fish sandwiches, chicken sandwiches*.

For the remaining registered goods in this class, the proprietor either did not submit any evidence of use or the evidence produced is insufficient in terms of extent and/or nature. Therefore, the EUTM must be revoked. The considerations stated above as regards goods used as ingredients of the final products sold by the proprietor are equally valid and apply *mutatis mutandis*.

Registered goods in Class 32

The proprietor did not submit evidence that the registered goods in this class have actually been put on the market or advertised under the contested EUTM. Therefore, the mark must be revoked.

Registered services in Class 43

Reference is made to the considerations set by the Cancellation Division in the 'Extent of use' and 'Nature of use: Use of the mark as registered' as to why the evidence is insufficient in terms of extent and/or nature to demonstrate genuine use of signs 'McDonald's', 'McCafé' or 'McMenü' in connection with *restaurant services* or *services* that could fall under this broad category. It follows that the proprietor failed to prove use for the registered services in this class and therefore the mark has to be revoked.

Conclusion

It follows from the above that the EUTM proprietor has not proven genuine use of the EUTM for some of the registered goods in Classes 29 and 30 and for all the registered goods and services in Classes 32 and 43, for which it must, therefore, be revoked.

The EUTM proprietor has proven genuine use for the remaining contested goods in Classes 29 and 30; therefore, the application is not successful in this respect.

According to Article 62(1) EUTMR, the revocation will take effect from the date of the application for revocation, that is, as of 11/04/2017. An earlier date, on which one of the grounds for revocation occurred, may be fixed at the request of one of the parties. In the present case, the applicant has requested an earlier date, namely five years following the date of registration of the contested EUTM, stating as justification that the proprietor has not used the mark for a continuous period of five years following the date of registration or, in the alternative, for a continuous period of five years prior to the date of filing of the application for revocation. However, such statement cannot qualify as a specific legal interest for such an earlier date. Article 62(1) EUTMR puts the cancellation applicant to a strict onus to set out facts which would support as legitimate interest to consider an earlier date as the relevant date and to prove it, which the applicant failed to do. Therefore and, in exercising its discretion in this regard, the Cancellation Division considers that it is not expedient in this case to grant this request, since the applicant has not shown sufficient legal interest to justify it.

COSTS

According to Article 109(1) EUTMR, the losing party in cancellation proceedings must bear the fees and costs incurred by the other party. According to Article 109(2)

EUTMR, where each party succeeds on some heads and fails on others, or if reasons of equity so dictate, the Cancellation Division will decide a different apportionment of costs.

Since the cancellation is successful only for part of the contested goods and services, both parties have succeeded on some heads and failed on others. Consequently, each party has to bear its own costs.



The Cancellation Division

Ioana MOISESCU

Oana-Alina STURZA

Richard BIANCHI

According to Article 67 EUTMR, any party adversely affected by this decision has a right to appeal against this decision. According to Article 68 EUTMR, notice of appeal must be filed in writing at the Office within two months of the date of notification of this decision. It must be filed in the language of the proceedings in which the decision subject to appeal was taken. Furthermore, a written statement of the grounds of appeal must be filed within four months of the same date. The notice of appeal will be deemed to be filed only when the appeal fee of EUR 720 has been paid.