

Big Mac? What's That?

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by Ron Moscona



When the European Union Intellectual Property Office (EUIPO) last week revoked the EU trade mark registration for the mark 'BIG MAC', following a challenge brought by an Irish fast-food chain, SUPERMAC'S, it was hailed by the media as a triumph for a small business in its dispute with a much stronger rival, the well-known McDonald's burger chain. But the

decision in this non-use revocation case had nothing to do with the applicant's business. It was entirely down to the evidence of use filed by McDonald's in defence of its registration. According to the EUIPO, it was simply insufficient to establish genuine use of 'BIG MAC' in the EU.

The Cancellation Division's decision suggests that a fair amount of evidence of use was in fact filed by the trade mark owner. The decision mentions three affidavits signed by McDonald's representatives in the UK, France and Germany, providing sales figures of 'Big Mac' burgers in the relevant countries over the period in question. It also mentions a range of documentary evidence including samples of packaging materials, promotional brochures and menus displaying the mark, print-outs from McDonald's national websites from across the EU, and print-outs from Wikipedia.

It is important to emphasise that the non-use challenge in this case did not focus on any of the finer aspects of the use of the BIG MAC mark. The decision did not examine the issue whether the evidence showed use of the word mark at issue as opposed to any device marks; nor did it go into much detail as to the food products (in classes 29 and 30) and restaurant franchise services (in class 42) for which the mark was registered – the registration was revoked for all goods and services, even for burger sandwiches (and

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despite the applicant's own concession that the evidence was sufficient in relation to that class of goods); nor did the decision focus on the question of the geographical extent of the use of the mark across the EU – sales figures, after all, were provided for the largest three markets in the EU, which normally ought to be sufficient.

The Cancellation Division found the evidence to be lacking essentially because it took the materials with a great pinch of salt. The evidence of the affiants which provided figures of sales was heavily discounted as evidence of company representatives who are treated by the EUIPO as not independent witnesses whose evidence is inherently unreliable.

In the documentary or physical evidence, the EUIPO found little (at least not enough) to indicate the time, place and extent of the use of the mark. Although at least some of the evidence appears to have been dated and the websites were national sites of EU member states, there was not enough according to the EUIPO to establish the scope and extent of use. The decision points out that the evidence contained *“no confirmation of any commercial transactions, either online, or via brick-and-mortar operations”*. In relation to online sources, it states that print-outs from websites showed no proof that the sites had any visitors which could establish the connection between the websites and the number of items (BIG MACs) sold. *“The mere presence of a trade mark on a website is, of itself, insufficient to prove genuine use unless the website also shows the place, time and extent of use”*. In relation to Wikipedia, the decision dismissed the site as unreliable.

The decision proclaims that the result was due *“not to an excessively high standard of proof, but to the fact that the EUTM proprietor chose to restrict the evidence submitted”*. Be that as it may, whether or not this case survives an appeal, it should serve as a warning sign. As shown repeatedly over the past few years, the EUIPO is prepared to closely scrutinise evidence of use in revocation cases as well as in cases of acquired distinctiveness. Proprietors who are required to produce evidence of genuine use have to ensure their evidence is comprehensive and persuasive and based on independent documentary materials.

There are no set rules as to the type of evidence that can be used to establish genuine use of a mark in the EU. Sales figures can be provided through a witness evidence, but it has to be supported by independent documentary evidence, such as samples of receipts or purchase orders, audited accounts, or independent third party market share reports (in each case, related to the mark in question). Evidence from online sources and social media channels can be valuable but should be supplemented by independent reports showing volumes of visits, hits and search engine searches. Website and app ranking tables can also be relevant. It is important in each case to demonstrate that the evidence relates to the relevant period and to the relevant geographical area and of course that it relates to the relevant goods and services for which the mark is registered.

Putting together this kind of comprehensive evidence requires an effort. Defending a mark against a non-use challenge can be burdensome. Losing a registration, however, can cause real damage to a business. A trade mark proprietor who is unprepared to muster up the necessary evidence to protect its registration could very well end up

finding itself penny-wise and pound-foolish.