

Notification of a decision to the applicant

Alicante, 11/01/2019

TOMKINS & CO.
5 Dartmouth Road
Dublin 6
IRLANDA

Your reference: **MT9434**
Revocation number: **000014788 C**
Contested trade mark: **000062638**
BIG MAC

Please find attached the decision terminating the proceedings referred to above. The decision was delivered on **11/01/2019**.

Please note that the decisions of the Cancellation Division are not signed by the officials responsible but only indicate their full name and bear a printed seal of the Office in accordance with Article 94(2) EUTMR.



Irina SOTIROVA

Enclosures (excluding the cover letter): 07 pages.

CANCELLATION No 14 788 C (REVOCATION)

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., 2711 Centerville Road, Suite 400, Wilmington, DE 19808, United States of America (EUTM proprietor), represented by **Bardehle Pagenberg Partnerschaft mbB Patentanwälte, Rechtsanwälte**, Prinzregentenplatz 7, 81675 Munich, Germany (professional representative).

On 11/01/2019, the Cancellation Division takes the following

DECISION

1. The application for revocation is upheld.
2. The EUTM proprietor's rights in respect of European Union trade mark No 62 638 are revoked in their entirety as from 11/04/2017.
3. The EUTM proprietor bears the costs, fixed at EUR 1 080.

REASONS

The applicant filed a request for revocation of European Union trade mark registration No 62 638 'BIG MAC' (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, meat sandwiches, fish sandwiches, pork sandwiches, chicken sandwiches, preserved and cooked fruits and vegetables, eggs, cheese, milk, milk preparations, pickles, desserts.*

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.*

Class 42: *Services rendered or associated with operating and franchising restaurants and other establishments or facilities engaged in providing food and drink prepared for consumption and for drive-through facilities; preparation of carry-out foods; the designing of such restaurants, establishments and facilities for others; construction planning and construction consulting for restaurants for others.*

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

SUMMARY OF THE PARTIES' ARGUMENTS

The applicant argues that the EUTM was not put to genuine use during a continuous period of five years following the date of registration in relation to any of the registered goods and services. The applicant requests that the EUTM be revoked in its entirety with an earlier date, namely five years from the date of registration.

In response to the application for revocation, the EUTM proprietor filed evidence of use, which is listed below in the following section of the present decision. The EUTM proprietor claims that the EUTM is used in a number of Member States. It also states that the submitted evidence shows that the mark has been used in advertising and on the packaging of the goods that have been marketed. It is also claimed that 'as commonly known and attested to in the affidavits' millions of products were sold under the EUTM. The EUTM proprietor finally concluded that if the Office considers the evidence to be insufficient to show genuine use for all of the contested goods and services, then the application for revocation has to be rejected at least in so far as it is directed against some of the goods and services (which it listed explicitly).

The applicant argued that the evidence of use submitted by the EUTM proprietor is insufficient to prove that the EUTM was put to genuine use for anything other than sandwiches and it analyses the pieces of evidence individually. It concludes that the application must be upheld.

The EUTM proprietor in its rejoinder states that the use of the EUTM in Germany, France and the United Kingdom, which are three of the economically most important Member States is sufficient to prove that the mark is used in the European Union. It further claims that the use of the mark for a sandwich shall also be considered as use for its ingredients.

GROUNDINGS 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 Article 19(1) EUTMDR in conjunction with Article 10(3) EUTMDR, 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 22/12/1998. 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 25/09/2017 the EUTM proprietor submitted evidence as proof of use.

The evidence to be taken into account is the following:

- **3 affidavits**, signed by representatives of McDonald's companies in Germany, France and the United Kingdom. They claimed significant sales figures in relation to 'Big Mac' sandwiches for the period between 2011 and 2016 and attach examples of the packaging of the sandwich (boxes), promotional brochures and what appear to be menus, further referred to below:
- **Brochures and printouts of advertising posters**, in German, French and English, showing, inter alia, 'Big Mac' meat sandwiches; and **packaging** for sandwiches (boxes); the materials appear to originate from the EUTM proprietor and are dated between 2011 and 2016. The brochures and posters show a sandwich on the menu along with other products, or on its own, and the prices are also provided on some of the materials; other documents appear to be blank menus in which the price can be filled in. The EUTM appears on the submitted material in relation to sandwiches.
- **Printouts from the websites** www.mcdonalds.de, www.mcdonalds.at, www.mcdonalds.be, www.mcdonalds.cz, www.mcdonalds.dk, www.mcdonalds.es, www.mcdonalds.fi, www.mcdonalds.fr, www.mcdonalds.hu, www.mcdonalds.ie, www.mcdonalds.it, www.mcdonalds.nl, www.mcdonalds.pl, www.mcdonalds.ro, www.mcdonalds.se, www.mcdonalds.si, www.mcdonalds.sk, www.mcdonalds.co.uk, dated between 07/01/2014 and 03/10/2016. They depict a variety of sandwiches, inter alia 'Big Mac' sandwiches, some of which state that they are sandwiches made with beef meat.
- **A printout from en.wikipedia.org**, providing information on 'Big Mac' hamburger, its history, content and nutritional values in different countries.

Having examined the material listed above in its entirety, the Cancellation Division finds that the evidence is insufficient to establish genuine use of the trade mark.

As regards the affidavits, signed by the representatives/employees of the EUTM proprietor, Article 10(6) EUTMDR (applicable to cancellation proceedings by virtue of

Article 19(2) EUTMDR) expressly mentions written statements referred to in Article 97(1)(f) EUTMR as admissible means of proof of use. Article 97(1)(f) EUTMR lists, as means of giving evidence, sworn or affirmed written statements or other statements that have a similar effect under the law of the State in which they were drawn up. As far as the probative value of this kind of evidence is concerned, statements drawn up by the interested parties themselves or their employees 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.

However, this does not mean that such statements do not have any probative value at all.

The final outcome depends on the overall assessment of the evidence in the particular case. The probative value of such statements 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 content of the affidavits is supported by the other items of evidence.

Although some of the evidence refers to the relevant time period (e. g. some of the brochures and printouts from websites) and to some of the Member States of the EU, and the EUTM is referred to in relation to at least some of the relevant goods (e.g. sandwiches), the EUTM proprietor fails to prove the extent of use of its mark.

As regards the extent of use, all the relevant facts and circumstances must be taken into account, including the nature of the relevant goods or services and the characteristics of the market concerned, the territorial extent of use, its commercial volume, duration and frequency.

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.

It is noted that all of the remaining evidence (the affidavits having been already analysed above) originates from the EUTM proprietor itself, this includes the printouts from the proprietor's own websites, promotional brochures and packaging. Part of the submitted evidence, that is, the printouts, originate from the internet. The standard applied when assessing evidence in the form of printouts from the internet is no stricter than when evaluating other forms of evidence. Consequently, the presence of the trade mark on websites can show, inter alia, the nature of its use or the fact that products or services bearing the mark have been offered to the public. However, 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 or unless this information is otherwise provided.

In particular, the value of the internet extracts in terms of evidence can be strengthened by evidence that the specific website has been visited and, in particular, that orders for the relevant goods and services have been made through the website by a certain number of customers in the relevant period and in the relevant territory. For instance, useful evidence in this regard could be records that are generally kept when operating

a business web page, for example, records relating to internet traffic and hits attained at various points in time or, in some cases, the countries from which the web page has been accessed. Neither of these, however, was provided by the EUTM proprietor.

Although some of the printouts of the proprietor's web pages exhibit sandwiches (the prices are not provided), some of which marked with the EUTM, it could not be concluded whether, or how, a purchase could be made or an order could be placed. Even if the websites provided such an option, there is no information of a single order being placed. Therefore, a connection between the EUTM proprietor's websites (irrespective of the used country code top-level domains and languages) and the eventual number of items offered (sold) could not be established.

Indeed, although the submitted packaging materials and brochures depict the EUTM, there is no information provided about how these brochures were circulated, who they were offered to, and whether they have led to any potential or actual purchases. Moreover, there is no independent evidence submitted that could show how many of the products for which the packaging was used (if that is the case) were actually offered for sale or sold.

It is concluded that, the evidence analysed above does not provide sufficient details concerning the extent of use; other than exhibiting the sign in relation to goods which could be considered to be part of the relevant goods, these materials do not give any data for the real commercial presence of the EUTM for any of the relevant goods or services.

It follows that the submitted brochures, packaging and printouts do not give sufficient information to support the sales and turnover figures claimed in the affidavits.

As far as the printout from en.wikipedia.org is concerned, it is noted that Wikipedia entries cannot be considered as a reliable source of information, as they can be amended by Wikipedia's users and therefore these could only be considered relevant as far as they are supported by other pieces of independent concrete evidence. In the case at issue, however, the remaining pieces of evidence which were submitted do not provide information about the extent of use, as already mentioned above, and therefore, the excerpt from Wikipedia does not change the conclusions reached in that respect.

As far as the applicant's statement regarding the use of the sign for sandwiches is concerned, it is noted that the Office must conclude its own evaluation of the evidence of use submitted. This means that the probative value of the evidence is evaluated independently of the observations submitted by the applicant in this respect.

Assessment of the relevance, pertinence, conclusiveness and efficacy of evidence lies within the discretion and power of judgment of the Office, not the parties, and falls outside the adversarial principle which governs inter parties proceedings (decisions of 01/08/2007, R 201/2006-4, OCB, § 19; 14/11/2000, R 823/1999-3, SIDOL).

A declaration by the applicant concluding that evidence of use submitted is sufficient to prove use in relation to the contested goods does not, therefore, have any effect on the Office's findings.

Taking into account the submitted evidence as a whole, it is concluded that the documents do not provide conclusive information that the products marked with the EUTM are offered for actual sale, as there is no confirmation of any commercial transactions, either online, or via brick-and-mortar operations. Even if the goods were

offered for sale, there is no data about how long the products were offered on the given web page or in other ways, and there is no information of any actual sales taking place or any potential and relevant consumers being engaged, either through an offer, or through a sale. Finally, as far as the relevant services are considered, there is no single piece of evidence that refers to any of the registered services being offered under the EUTM.

It follows, that an overall assessment of the evidence does not allow the conclusion, without resorting to probabilities and presumptions, that the mark was genuinely used during the relevant period for the relevant goods or services (15/09/2011, T-427/09, Centrotherm, EU:T:2011:480, § 43). It is up to the EUTM proprietor to show such use in a manner which allows a reasoned conclusion to be made that the use is not merely token.

The methods and means of proving genuine use of a mark are unlimited. The finding that genuine use has not been proven in the present case is due not to an excessively high standard of proof, but to the fact that the EUTM proprietor chose to restrict the evidence submitted (15/09/2011, T-427/09, Centrotherm, EU:T:2011:480, § 46).

Considering the above, the Cancellation Division concludes that the evidence furnished by the EUTM proprietor is insufficient to prove that the EUTM was genuinely used in the relevant territory during the relevant period of time.

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 at least the extent of use has not been established, it is not necessary to enter into the other requisites.

Conclusion

It follows from the above that the EUTM proprietor has not proven genuine use of the contested EUTM for any of the goods and services for which it is registered. As a result, the application for revocation is wholly successful and the contested EUTM must be revoked in its entirety.

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. However, 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 any 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.

Since the EUTM proprietor is the losing party, it must bear the cancellation fee as well as the costs incurred by the applicant in the course of these proceedings.

According to Article 109(1) and (7) EUTMR and Article 18(1)(c)(ii) EUTMIR, the costs to be paid to the applicant are the cancellation fee and the representation costs, which are to be fixed on the basis of the maximum rate set therein.



The Cancellation Division

Nicole CLARKE

Irina SOTIROVA

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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.