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Big Mac: a blow for McDonald’s under trade mark law

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The Irish fast food chain Supermac’s has today scored a major success in a long-running trade mark dispute against McDonald’s. The European trade mark ‘Big Mac’ registered for McDonald’s can no longer claim protection for chicken sandwiches, food prepared from poultry products, and services provided in connection with or related to the operation of restaurants and other establishments offering food and drink prepared for consumption, drive-in facilities and the preparation of take-away meals (EGC, judgement of 05. 06.2024, T-58/23 – Supermac’s ./. EUIPO – McDonald’s International Property (BIG MAC).

Wow. What went wrong for McDonald’s?

In 2017, Supermac’s claimed that McDonald’s had not used the ‘Big Mac’ trade mark for a continuous period of more than 5 years. In 2019, the European Trade Mark Office (EUIPO) ruled that the ‘Big Mac’ trade mark should be cancelled. David against Goliath, the press reported.

However, the Appeal Division then upheld the trade mark insofar as protection is claimed for food made from meat and poultry products and for services in connection with restaurants and drive-in facilities. This means that McDonald’s could have continued to pursue the ‘Big Mac’ trade mark against the ‘Supermac’s’ fast food restaurants. Supermac’s has appealed against this to the General Court of the European Union (EGC).

Apparently, McDonald’s has now simply stumbled over the requirements that the EUIPO and the General Court impose on proof of use that will preserve the trade mark.

Among other things, McDonald’s submitted advertisements and affidavits from employees stating that McDonalds had sold a Chicken Big Mac in France in 2016. However, this was not enough for the EGC.

> ‘Genuine use of a trade mark cannot be proven by means of probabilities or presumptions, but must be demonstrated by solid and objective

> evidence of actual and sufficient use of the trade mark on the market concerned.'

The court made it unmistakably clear that proof of use can only be provided by solid and objective evidence.

The evidence must show where, when, to what extent and in which way the trade mark has been used. This usually requires evidence that the goods and services for which the trade mark claims protection have actually been offered using the trade mark and that sufficient turnover has been achieved as a result.

For example, it is not sufficient to submit screenshots of a website if no website data can be submitted to show when, to what extent and with what frequency the trade mark was used on the website.

The judgement is not yet final and an appeal to the European Court of Justice is possible.

Lessons to be learnt?

Every enterprise is well advised to carefully document the use of its trade marks, e.g. to archive screenshots and analyses of advertising measures, photos of advertising campaigns with complete EXIF data, agency invoices and briefings as well as sales statistics and purchase and sales invoices for branded products and services.

Affidavits from employees are a supporting instrument, but will generally not be able to provide evidence.