

O-0686-26

TRADE MARKS ACT 1994
CONSOLIDATED PROCEEDINGS
IN THE MATTER OF
TRADE MARK APPLICATION NOS. 3626047 & 3626061
BY SUPERMAC'S (HOLDINGS) LTD
TO REGISTER

SUPERMAC'S

AND

The logo for Supermac's is written in a red, cursive script font. The word 'Supermac's' is written in a fluid, handwritten style with a red underline that extends from the end of the word.

AS TRADE MARKS
IN CLASS 43
AND OPPOSITIONS THERETO (UNDER NOS. 429397 & 429399)
BY
MCDONALD'S INTERNATIONAL PROPERTY COMPANY, LTD.

Background & Pleadings

1. Supermac's (Holdings) Ltd ("the applicant") applied to register the two trade marks set out above on the title page of this decision on 14 April 2021. The word mark ending '047 claimed a priority date of 17 May 2016 (EUIPO) and the stylised mark ending '061 claimed a priority date of 10 April 2017 (EUIPO). Both marks were published in the UK for opposition purposes on 17 September 2021 in class 43 for *Services for providing food and drink; restaurant services; fast-food restaurant services; canteens; self-service restaurant services; takeaway services; snack-bars.*

2. McDonald's International Property Company, Ltd ("the opponent") opposed both applied for marks on 17 December 2021 under sections 5(2)(b), 5(3) and 5(4)(a). The opponent relies on the following earlier rights¹ under s5(2)(b) and 5(3), namely:

Earlier TM Nos.	Goods and services relied on:
No. 1164247 BIG MAC Filing date: 6 November 1981 Registration date: 6 November 1981	29: Hamburgers and cheese and pickles for use therewith.
No.1165097 BIG MAC Filing date: 20 November 1981 Registration date: 20 November 1981	30: Sandwiches containing hamburgers; bread rolls containing hamburgers; and sauces for use with the aforesaid goods.
No.1208244 MCDONALD'S	29: Hamburgers, cheeseburgers; chicken pieces (other than for animals);

¹ Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all rights holders with an existing registered EUTM or International Registration designating the EU. As a result, the opponent's mark was converted into a comparable UK trade mark. Comparable UK marks are now recorded in the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.

Filing date: 30 November 1983 Registration date: 30 November 1983	French fried potatoes; milk shakes being milk beverages; the milk predominating; milk, eggs; hashed brown potatoes; sausages.
No. 1208245 McDONALD'S Filing date: 30 November 1983 Registration date: 30 November 1983	30: Sandwiches containing fish fillet, chicken or meat; sausage patties; fruit pies, muffins, hot cakes, Danish pastries, coffee, tea; ice cream sundaes.
No. 1208246 McDONALD'S Filing date: 30 November 1983 Registration date: 30 November 1983	32: Cola; orange squash and root beer, all being non-alcoholic beverages; fruit flavoured milk shakes, the fruit predominating; orange juice for use as beverages.
No.1285796 McDONALD'S Filing date: 1 October 1986 Registration date: 4 October 1991	43: Restaurant services; but not including any such services relating to alcoholic beverages.
No. 900058438 McCAFE Filing date: 1 April 1996 Registration date: 25 November 1998	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.
No. 906870851 McCAFE	29: Desserts.

Filing date: 18 April 2008 Registration date: 11 March 2013	30: Biscuits, cakes, cookies, chocolate, coffee, coffee substitutes, tea, pastries.
No. 916485674 ² Grand Big Mac Filing date: 16 March 2017 Registration date: 30 June 2017	30: Edible sandwiches, meat sandwiches.

3. Under section 5(4)(a) of the Act, the opponent relies on the following signs:³

- BIG MAC** used in the UK since 1974 for *Beef sandwiches; Edible sandwiches, all containing or flavoured with beef; Burgers; beef burgers; sandwiches containing beef patties and other fillings such as, cheese, lettuce, onions, pickles and sauce; burgers containing beef patties and other fillings such as, cheese, lettuce, onions, pickles and sauce.*
- McDONALD'S** used in the UK since 1974 for *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. Burgers; beef burgers; chicken burgers; fish burgers; vegetarian burgers; hamburgers; cheeseburgers; sandwiches made from wraps; salads; chicken pieces (other than for animals); French fried potatoes; French fries; potato fries; milk shakes being milk beverages, the milk predominating; milk, eggs; hashed brown potatoes; sausages. Edible sandwiches, meat sandwiches, pork sandwiches, fish sandwiches, chicken sandwiches, biscuits, bread, cakes, cookies, chocolate, coffee, coffee substitutes, tea, hot chocolate, mustard, oatmeal,*

² This earlier right is relied on under s5(2)(b) against the applied for mark ending '061 only.

³ In its notice of opposition, the opponent also relied on the signs **Macca's** and **Maccers** under s5(4)(a). At the hearing the opponent confirmed that it longer relies on these signs.

pastries, sauces, seasonings, sugar. Sandwiches containing fish fillet, chicken or meat; sausage patties; fruit pies, muffins, hot cakes, Danish pastries, coffee, tea; ice cream sundaes; doughnuts; bagels; pancakes; porridge; prepared fruits; prepared vegetables; pieces of chicken, battered and deep fried; muffins containing eggs, bacon, sausage and cheese; ice-cream based desserts; ice-cream based desserts containing chocolate; ice-cream based desserts containing biscuits; ice-cream based desserts containing sweets. Non-alcoholic beverages, syrups and other preparations for making beverages. Cola; orange squash and root beer, all being non-alcoholic beverages; fruit flavoured milk shakes, the fruit predominating; orange juice for use as beverages.

Services rendered or associated with operating and franchising restaurants and other establishment or facilities engaged in providing food and drink prepared for consumption and for drive- through facilities; preparation and provision of carry-out foods; Restaurant services; drive-through restaurant services.

- **McCAFE** used in the UK since 2012 for *Milkshakes; milk beverages; chilled dairy desserts; coffee creamer; milk-based beverages containing coffee; milk-based beverages containing fruit juice; milk-based beverages flavored with chocolate, strawberry or vanilla; cocoa and artificial coffee; pastries and confectionery; Edible ices; biscuits, bread, cakes, cookies, chocolate, coffee, coffee substitutes, tea, oatmeal, pastries, bakery goods; chocolate-based beverages; chocolate beverages with milk; cocoa-based beverages; cocoa beverages with milk; coffee-based beverages; coffee beverages with milk; frozen yoghurt; tea-based beverages; iced coffee and other coffee drinks; iced tea; croissants; frozen ices; ice beverages with a coffee base; ice cream desserts; ice cream drinks; sorbets; aerated beverages [with coffee, cocoa or chocolate base]; mineral and aerated waters and other non-alcoholic beverages; non-alcoholic beverages, syrups and other preparations for making beverages; smoothies; non-alcoholic beverages flavored with coffee; non-alcoholic beverages flavored with tea; non-alcoholic fruit extracts; soya-based beverages, other than milk substitutes; hot chocolate; flat white coffees; lattes; cappuccinos; black coffee; white coffee; espresso; frappé coffee; frozen lemonade; doughnuts; muffins.*

Services for providing food and drink; restaurant services; food and drink preparation services; fast-food restaurant services; takeaway food and drink services; cafe services; coffee shop services; tea room services; bar services; ice cream parlors; juice bar services; snack-bar services; self-services restaurant services.

4. In addition the opponent claims use of the sign **MAC** under s5(4)(a), is as part of a “family of marks” point, utilising both **Mc** and **MAC** word elements in what it terms as a “key identifier” for its brands. I will return to the family of marks claim and the submissions made therein later in this decision.

5. The applicant filed two counterstatements in which it denied the grounds of opposition based on the similarity of the marks and the goods. It also put the opponent to proof of use of its claims. It did accept that the respective class 43 services may be considered identical or similar subject to the opponent providing proof of its earlier marks in that class.

6. Both sides have been professionally represented during these proceedings. The applicant has been represented by Carpmaels & Ransford LLP and the opponent by Bristows LLP.

7. Both sides filed submissions and evidence in these proceedings and a hearing was requested. I heard the matter on 6 June 2025, via video conference. The applicant was represented by Mr Simon Malynicz KC of Counsel, as instructed by Carpmaels & Ransford LLP. The opponent was represented by Ms Charlotte Blythe of Counsel, as instructed by Bristows LLP.

8. I make this decision based on a reading of all the material before me and the submissions made at the hearing.

9. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated

law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts that predate the UK's withdrawal from the EU.

Evidence and relevant dates

10. The opponent's registrations have filing dates that are earlier than the filing dates of the applied for marks and are therefore earlier marks, in accordance with section 6 of the Act. As the registration procedures for all earlier marks, except No. 916485674, were completed more than 5 years prior to the filing date of the contested applications, they are subject to the use conditions, as per section 6A of the Act. The opponent made a statement of use in respect of all the goods and services it relies on.

11. The opponent's earlier registration no. 916485674 is an earlier mark, in accordance with section 6 of the Act, but has not been registered for five years or more before the filing date of the applied for marks and therefore is not subject to the same proof of use requirements.

12. My first task is to establish whether, or to what extent, the opponent has shown genuine use of its earlier marks within the 'relevant period'. The relevant period is defined as being a period of five years ending with the filing or priority date of the contested application. The relevant periods in these proceedings are:⁴

- 18 May 2011 to 17 May 2016
- 11 April 2012 to 10 April 2017

13. A considerable volume of evidence was filed in these proceedings. I do not intend to summarise it in full but will refer to it as appropriate during the course of the decision.

⁴ It was confirmed in *Parabolica Ltd v Tesla Holding AS (The Comptroller General of Patents, Designs and Trade Marks, intervening)* [2026] EWHC 386 (Ch) that the EU filing date was the relevant date for assessing both absolute and relative grounds.

Opponent's evidence in chief

14. The opponent filed its first witness statement, dated 22 January 2024, in the name of Thomas O'Neill, its Head of Menu and formerly Head of Marketing. Mr O'Neill appended 29 exhibits. I set out the most pertinent points below.

15. Mr O'Neill states the opponent opened its first McDonald's branded restaurant in London in 1974. By 1997 the opponent had 800 restaurants operating in the UK and that number has subsequently increased to 1300 by 2019. These comprise restaurants operated directly by the opponent and by franchisees. Its services include sit-in restaurants, takeaways, "drive-thru" facilities and delivery services ordered either through its own app or via third party food delivery services. Its goods include a range of prepared food products and non-alcoholic beverages. Turnover in the UK has exceeded a billion pounds sterling annually from 2006 up to £1.5bn in 2017.

16. Mr O'Neill states that McDONALD'S is one of the world's most recognisable brands and sets out a number of brand league tables dated between 2014-2020 in his witness statement confirming this.⁵

17. The opponent states it has had an extensive promotional and advertising campaign since its first opening in the UK.⁶ Its advertising spend between 2015-2020 is stated to be in excess of £500m. Its first TV advertisement was broadcast in the UK in 1976. The opponent advertises on TV, online, in the mainstream press and on social media. Many of its advertising campaigns have won industry awards.⁷ The opponent has also been a sponsor of major sporting tournaments such as the FIFA Football World Cup, UEFA European football championship and the Olympic Games including the London 2012 games, which draw in a global viewing audience in millions.⁸ In addition it is an active sponsor of the UK Football Association's Better Play community football programme, which Mr O'Neill describes as raising standards and providing opportunities to play at grassroots football clubs through improved coaching, provision of kit and recognising and supporting volunteers.

⁵ Thomas O'Neill first witness statement paragraphs 62-68, also see exhibits TON26 & 27 relating to the brand awareness for the BIG MAC mark.

⁶ Exhibits TON9-17.

⁷ Exhibits TON12-17

⁸ Exhibits TON18-21.

18. Turning to the family of marks claim, Mr O'Neill refers to using either the prefix **Mc** or the suffix **MAC** as the opponent's "collective essence". He states that the extensive and widespread use of **Mc** or **MAC** over a period of decades in relation to a product or service "creates a strong link to McDonald's".⁹

19. In relation to specific marks within the claimed family, Mr O'Neill states that the **BIG MAC** mark was first used in the UK for the opponent's signature burger product in 1974 when the first restaurant opened. It has been continuously available on menus since then.¹⁰ Between 2018 and 2020, for limited time periods, the opponent launched two differently sized variations of the **BIG MAC** burger product, namely the **GRAND BIG MAC** and **MAC JR** as part of promotions for the **BIG MAC** product's 50th anniversary.¹¹

20. With regard to the **McCAFE** mark, Mr O'Neill states this was first used in the UK in 2012 and refers to a branded range of cakes, pastries and biscuits in addition to hot and cold beverages. Mr O'Neill further states that, in 2020, the opponent was ranked in the top five biggest outlets for coffee according to the market research company Mintel.¹²

Applicant's evidence

21. The applicant filed a witness statement dated 3 July 2024 in the name of Pat McDonagh, who is the founder, owner and managing director of the applicant company. Mr McDonagh appended 23 exhibits.

22. Mr McDonagh states that the applicant firstly used the mark **SUPERMAC'S** in 1978 when it opened its first fast food restaurant in Ballinsloe, in the Republic of Ireland ("ROI"). Mr McDonagh states that the applied for marks were derived from a nickname he was given at school, in the 1960s, as a partial pun on the character Superman combined with a short form of his surname.

⁹ Thomas O'Neill first witness statement, paragraph 71.

¹⁰ Exhibit TON9.

¹¹ Exhibit TON10.

¹² Thomas O'Neill first witness statement, paragraph 20.

23. Mr McDonagh states that the applicant has 120 restaurants operating on the island of Ireland, with 119 of them being in the ROI. He also states that in some locations in the ROI, the applicant and opponent operate or have operated in very close proximity to each other's premises with no evident customer confusion.

24. In addition, Mr McDonagh gives the following turnover figures for the services provided under the applied for marks:

- 2018 €172m
- 2019 €189m
- 2020 €189m
- 2021 €195m
- 2022 €225m

25. Specifically in relation to Northern Ireland ("NI"), Mr McDonagh states that the applicant has operated up to 6 restaurants in NI between 2007 and 2019, only one of which was still operating as of 2024.¹³ Mr McDonagh exhibits an article, dated 9 August 2019, from the "i" UK news website, namely inews.co.uk, about the potential launch of the SUPERMAC'S restaurants in the UK.¹⁴ Mr McDonagh also refers to a double decker bus advertising event in London in 2014. The event featured the bus being driven around various London landmarks and was decorated with both the word and figurative applied for marks with the additional strapline "Ireland...come for the scenery stay for the food".¹⁵ Finally Mr McDonagh exhibits extensive coverage about the applicant in the Irish media.¹⁶

Opponent's evidence in reply

26. A second witness statement dated 4 September 2024 was filed in the name of Thomas O'Neill. The second statement focuses specifically on the opponent's business in NI. Mr O'Neil states that the opponent, through its franchisees, operates some 34 restaurant facilities in NI with an approximate turnover of £526,535,714 between 2019 and 2022. In addition to its restaurant provision, Mr O'Neill states that

¹³ Exhibit PM13.

¹⁴ Exhibit PM 19.

¹⁵ Exhibit PM 18.

¹⁶ Exhibits PM19-23.

the opponent also supports charitable endeavours in NI including a partnership with the Irish Football Association for their grassroots football initiative.

Relevant statutory provision: Section 6A:

27. “(1) This section applies where

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

- (a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
- (b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

- (a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade

mark in the variant form is also registered in the name of the proprietor),
and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

28. Section 100 of the Act states that:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

29. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market*

(*Trade Marks and Designs*) [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an

outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

30. I also find the following case law to be helpful where in *Awareness Limited v Plymouth City Council*,¹⁷ Mr Daniel Alexander Q.C. (as he was then) as the Appointed Person stated that:

¹⁷ Case BL O/236/13

“22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

and further at paragraph 28:

“28. I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

Sufficiency of use

31. Having considered the evidence, in particular the length of use, turnover figures, advertising revenue in addition to the advertising and promotional activity, I find that the opponent has demonstrated genuine use, reputation and goodwill in its

McDONALD'S, BIG MAC and **McCAFE** marks for the goods and services it has registered. This was also accepted by the applicant at the hearing.

Section 5(2)(b)

32. Section 5(2)(b) of the Act reads as follows:

“5 (2) A trade mark shall not be registered if because -

[...]

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

33. Section 5A is also relevant and reads:

“5A. [...] Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only”.

34. The following standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Paris Europe Inc & Anor*.¹⁸:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely

¹⁸ [2025] UKSC 25

upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; and

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

35. In *Canon*¹⁹, the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

36. Guidance on this issue has also come from Jacob J. (as he then was) in *British Sugar Plc v James Robertson & Sons Ltd* (the *Treat* case)²⁰, where he identified the factors for assessing similarity as:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

¹⁹ *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, C-39/97

²⁰ [1996] R.P.C. 281

37. In addition I find the following case law to be helpful when in *Kurt Hesse v OHIM*,²¹ the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*,²² the General Court (“GC”) stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking.”

38. In *Sanco SA v OHIM*,²³ the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different – in that case, *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public is liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amalia Mary Elliot v LRC Holdings Limited*:²⁴

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

²¹ Case C-50/15 P

²² Case T-325/06

²³ Case T-249/11

²⁴ BL-0-255-13

39. The applicant has applied for the following services in class 43:

Services for providing food and drink; restaurant services; fast-food restaurant services; canteens; self-service restaurant services; takeaway services; snack-bars.

40. The applicant accepted in its counterstatement that the respective class 43 services could be considered identical or similar if the opponent's use were proven. I have found that such use has been proven so it follows that the respective class 43 services are identical.

41. I next consider the similarity between the opponent's goods and the applicant's services. At the hearing the opponent submitted that the BIG MAC earlier registrations were its strongest case. The opponent's goods under these registrations are:

Class 29: Hamburgers and cheese and pickles for use therewith.

Class 30: Sandwiches containing hamburgers; bread rolls containing hamburgers; and sauces for use with the aforesaid goods.

42. The applicant specifically offers *fast-food restaurant services* and *takeaway services* and the opponent's goods comprise what I consider to be typical examples of fast food products, namely hamburgers and cheeseburgers, which are items that can be eaten in situ or taken away to be eaten elsewhere. Although there is no shared nature, there is some shared purpose between the applicant's services and the opponent's goods. Moreover there is a medium degree of complementarity, in my view, between the respective goods and services based on the *Boston Scientific* principle that there is a close connection between prepared fast food and services which provide prepared fast food, such that the consuming public would see one as being important for the other and both coming from the same economic undertaking.

43. The applicant's remaining services namely *Services for providing food and drink; restaurant services; canteens; self-service restaurant services; snack-bars*, whilst not specifying a fast food nature nonetheless all consist of services which offer food and drink in different settings. However, the provision of food and drink offered may cover

goods such as hamburgers and cheeseburgers. As such I find these services to be similar to a medium degree to the opponent's goods.

Average consumer and the purchasing process

44. I next consider who the average consumer is for the goods and services at issue and how they are purchased. In *Iconix Luxembourg Holdings SARL v Dream Paris Europe Inc & Anor*,²⁵ the Supreme Court approved the comments of Arnold LJ in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)*²⁶, in relation to the notion of an average consumer where he pointed out that:

- (a) Consumers who are ill-informed or careless, or consumers with specialised knowledge or who are excessively careful are excluded from consideration;
- (b) The average consumer provides a standard which enables the courts to strike a balance between the competing interests involved, such as trade mark owners, their competitors and consumers;
- (c) The average consumer is neither a single hypothetical person nor a mathematical average; assessment from the perspective of the average consumer does not involve a statistical test. There is no single meaning rule and if, having regard to the perceptions and expectations of the average consumer, the court considers that a significant proportion of the relevant public is likely to be confused, a finding of infringement may properly be made;
- (d) Assessment from the perspective of the average consumer is intended to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by enabling courts and tribunals to determine such issues so far as possible without the need for evidence;
- (e) The average consumer's level of attention varies according to the category of goods or services in question; and

²⁵ [2025] UKSC 25.

²⁶ [2024] EWCA Civ 262.

(f) the average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must instead rely upon the imperfect picture of the trade mark they have kept in their mind.

45. The average consumer for the contested services will be the general public. The services offer a range of eat in or take out options but primarily the price range will be at the inexpensive end of the scale and will be purchased with relative frequency. Where the provision of food products is concerned, there will be some consideration from consumers regarding allergens or calorie content but in my view the level of attention paid will be no higher than medium.

46. The services at issue will likely be selected visually from signage or menus at physical premises or via food ordering apps. There may be an additional aural element to consider, in particular where the services are accessed via telephone ordering for takeaways or “drive thru” facilities where orders are given verbally. Consequently, I find that the purchasing process for the contested services will be predominately visual but may include an aural element.

Mark comparisons

47. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo SA v OHIM*²⁷, that:

“... it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall

²⁷ Case C-591/12P

impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

48. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

49. The respective trade marks to be compared are:

Opponent's registrations	Applicant's marks
McDONALD'S McCAFE BIG MAC GRAND BIG MAC	SUPERMAC'S 

50. The opponent's **McDONALD'S** and **McCAFE** registrations are both word marks in plain typeface with no other aspect to them such as stylisation. The overall impression is derived solely from the words themselves.

51. The opponent's **BIG MAC** and **GRAND BIG MAC** registrations are also both word marks in plain typeface. However, both the **BIG** and **GRAND BIG** word elements can be considered as indicators of size, although I accept **GRAND BIG** is not a grammatically usual phrase. In relation to the Class 29 and 30 goods in terms of a size consideration, these elements may be considered as less distinctive than the **MAC** element of the marks. I consider the **MAC** element to make the greater contribution to the distinctiveness to the marks as a whole.

52. The applicant's marks consist of a single word mark and a stylised mark. The overall impression of the word mark is derived from the word itself. The stylised mark consists of a cursive typeface, rendered in red and with an underlined embellishment which does not stretch to the entirety of the mark. The overall impression is dominated by the word **SUPERMAC'S** as the stylisation is not so unusual as to prevent the word

being read and understood. The stylisation does contribute to the overall impression for that mark but the contribution is less than the word itself.

Approach

53. I will approach the visual, aural and conceptual comparison on the basis of dividing the opponent's marks into two groups, those which contain the **Mc** prefix structure and those which contain the **MAC** suffix.

Visual comparison

54. The visual comparison between the opponent's **McDONALD'S** marks and the applicant's **SUPERMAC'S** marks yield only structural similarity in terms of the possessive apostrophe. The respective marks have an **Mc** and **MAC** letter combination which the opponent submits is significant. In its skeleton argument, the opponent states that both **Mc** and **MAC** are historic surname prefixes meaning "son of", which are interchangeable. In the **McDONALD'S** marks, the **Mc** does form the prefix whereas **MAC** in the **SUPERMAC'S** marks are not prefixes but instead comprise the three letters within the mark. I note the opponent's surname submission, but I must look at the mark structures before me when considering the visual comparison and I do not consider **SUPERMAC'S** to be in the **Mc/MAC** surname bracket. Moreover it is settled case law²⁸ that consumers are more likely to pay attention to the beginnings of words rather than to the ends. Taking this into account I find that there is only a very low level of visual similarity.

55. The comparison between **McCAFE** and the applicant's marks has much the same considerations as above regarding the positioning of the **Mc** and **MAC** elements. Moreover, the opponent's mark does not have a possessive apostrophe which makes some visual difference. I find that there is only a very lowest level of visual similarity.

56. Turning to compare the opponent's **BIG MAC** and **GRAND BIG MAC** registrations and the applicant's marks, there clearly is a similarity in the **MAC** sequence of letters at the end of the marks. In terms of difference the opponent's marks are presented as either a two or a three word phrase separated by spaces, whereas the applicant's marks are a single word, albeit likely to be regarded as a conjoining of the words

²⁸ *El Corte Inglés, SA v OHIM*, Case T-39/10

'Super' and 'Mac's'. The opponent's marks also lack a possessive apostrophe. Overall taking the above into account, I find there is a medium level of visual similarity.

Aural Similarity

57. The **Mc** prefix element for the opponent's **McDONALD'S** and **McCAFE** marks could be pronounced as either M-A-C-K or M-U-C-K with the remaining elements being given their usual pronunciation. The applicant's marks will likely be pronounced as SUPER MACKS. Where there is a coincidence of the MACK sound, albeit that for the opponent's marks it will be at the front and for the applicant it will be at the end, I find there is a low level of aural similarity.

58. Regarding the opponent's **BIG MAC** and **GRAND BIG MAC** marks, there will be an aural overlap with the applicant's **MAC** suffix, although I also consider the additional sound of the possessive apostrophe letter S, which has no counterpart in the opponent's marks. The respective prefix elements, namely **BIG**, **GRAND BIG** and **SUPER**, will all be given their usual pronunciation. Overall I find there is a medium degree of aural similarity.

Conceptual similarity

59. In terms of the conceptual similarity comparison, it is settled case law that for a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.²⁹

60. The opponent's **McDONALD's** mark will be seen as the possessive form of the common surname. **McCAFE** is an invented mark which may give consumers some pause as to concept, but they are likely to alight on a recognisable element like the word **CAFE** and ascribe to it its usual dictionary meaning.

61. The opponent's **BIG MAC** and **GRAND BIG MAC** marks may not bring any specific concept to mind. However, given that the **BIG** and **GRAND BIG** word elements are known dictionary words relating to size, an average consumer may see them acting

²⁹ This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] E.C.R.-I-643; [2006] E.T.M.R. 29.

as an adjective to the **MAC** element so that whatever image this element brings to the consumer's mind, it will be qualified by **BIG** and **GRAND BIG**.

62. The applicant's mark, when taken as a whole, is also unlikely to bring any specific concept to mind. However, as stated above, the word **SUPER** is a known dictionary term which can relate to size which an average consumer may see acting as an adjective to the **MAC'S** element. There is an additional aspect to the applicant's marks as each also has an apostrophe element which denotes a possessive form.

63. Taking all the above into account, I find no conceptual similarity between the opponent's **McDONALD'S** and **McCAFE** marks and the applicant's marks. Whereas I find there is a low degree of conceptual similarity between the opponent's **BIG MAC** and **GRAND BIG MAC** marks and the applicant's **SUPERMAC'S** marks, based on those word elements which can refer to size.

Distinctive character of the earlier registered trade marks

64. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctive character of a mark can be enhanced by virtue of the use that has been made of it.

65. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*,³⁰ the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-

³⁰ Case C-342/97

108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR 1-2779, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

66. I will first consider the inherent distinctiveness of the earlier registrations. The opponent's **McDONALD'S** marks are the possessive form of the surname. They do not have any descriptive meaning in relation to the goods/services for which they are registered. I find these marks have a medium degree of inherent distinctiveness.

67. The **McCAFE** mark is likely to be considered as an invented word but it does contain a word element, namely CAFE, which is allusive of its goods but somewhat more descriptive of its services. Taking this into account I find it has a medium degree of inherent distinctiveness.

68. The **BIG MAC** and **GRAND BIG MAC** marks both contain elements referring to size but the **MAC** element does not describe the goods for which the marks are registered. As such I find that both marks have a medium level of inherent distinctiveness.

69. I next consider whether the opponent can claim enhanced distinctiveness of its earlier marks, because of the use made of them. The relevant market I must consider is the UK and I bear in mind the *Chiemsee* factors given above. I note that the opponent only claims enhanced distinctiveness for its **McDONALD'S**, **McCAFE** and **BIG MAC** marks. I have assessed the opponent's evidence above. The evidence demonstrated that there has been use of the **McDONALD'S** and **BIG MAC**

marks in the UK for around 50 years. In addition, there has been consistently high turnover, considerable advertising expenditure, significant market share and a geographically wide customer base in the UK. The **McCAFE** marks have been used for a considerably shorter period of time but has evidence of its own significant market impact. Taking all of the above into account I find that the earlier marks' distinctive character has been enhanced through use to a high degree.

Family of marks

70. The opponent states that the marks relied on constitute a family of marks. It states that:

“...the extensive and consistent use of the ‘Mc’ and ‘Mac’ element within those marks has cemented the public’s perception of these marks as a family of marks indicating that the origin is McDonald’s. In the alternative McDonald’s possesses 2 separate families of marks, being the “Mc family and/or the Mac family”.³¹

71. The applicant, for its part, refutes the whole family of marks claim, but stated that at best there are two groupings of the opponent’s earlier registrations, namely those which have **Mc** as a prefix and those with have **MAC** as a suffix element. However, in its submissions it claims that neither of those two groupings match the criteria set out in law for a family of marks claim.

72. The case law offering guidance on the notion of a family of marks is found in // *Ponte Finanziaria SpA v OHIM*³², in which the CJEU stated that:

“64 [...] in order for there to be a likelihood that the public may be mistaken as to whether the trade mark applied for belongs to a ‘family’ or ‘series’, the earlier trade marks which are part of that ‘family’ or ‘series’ must be present on the market.

³¹ Opponent’s skeleton arguments, paragraph 37.

³² Case C-234/06

73. In the earlier decision of the GC,³³ two conditions had been laid down for the establishment of a family of marks, neither of which were interfered with on appeal:

“126. Firstly, the proprietor of a series of earlier registrations must furnish proof of use of all the marks belonging to the series or, at the very least, of a number of marks capable of constituting a series'. For there to be a likelihood of the public's being mistaken as to whether the trade mark applied for belongs to the series, the earlier marks forming part of that series must necessarily be present on the market. [...]

127. Secondly, the trade mark applied for must not only be similar to the marks belonging to the series, but also display characteristics capable of associating it with the series. That could not be the case where, for example, the element common to the earlier serial marks is used in the trade mark applied for either in a different position from that in which it usually appears in the marks belonging to the series or with a different semantic content”.

74. As set out in *Il Ponte Finanziaria*, I accept that the **Mc** prefix marks, namely **McDONALD'S** and **McCAFE**, have been used in the marketplace, as evidenced by the opponent. There is also significant evidenced use of the **BIG MAC** mark, however there is considerably less use for the **GRAND BIG MAC** mark, which was acknowledged by the opponent as a time limited promotional product and is not a regular feature of the opponent's product menus.

75. Overall I take the view that earlier registrations do not constitute an entire family. To my mind, and as per the applicant's submissions, there are two separate groupings here based on the structure of the earlier registrations, i.e. those with **Mc** as the common feature prefix and those with **MAC** as the common feature suffix element. The positioning of the shared element, i.e. being in the same position in each of the marks, is a key factor in assessing the 'family' issue.³⁴ In this case the two groupings are

- **McDONALD'S** and **McCAFE** marks

³³ Case T-194/03, EU:T:2006:65

³⁴ *Buildxact Software Limited v Xactware Solutions Inc* BL O/0934/23, paragraph 20.

- **BIG MAC** and **GRAND BIG MAC** marks

76. The first grouping of the **Mc** prefix marks is more problematic to my mind in terms of the shared element with the applied for marks. As per the case law above the public must see that the respective marks have something in common. In this case the respective marks do not have something in common, in my view, as the opponent's marks have an **Mc** prefix and the applicant's mark have an **MAC** suffix (as well as a possessive apostrophe letter S) so the positioning and spelling do not sit right with the family criteria for confusion purposes.

77. The second grouping does sit more closely with the applicant's marks as the **MAC** letter sequence is the same and is positioned at the end of each of the respective marks. However, the applicant also raised the issue of an insufficient number of marks to qualify as a family, especially as the earlier registrations consist of the same marks. In particular the opponent is relying on four earlier **McDONALD'S** word registrations, two earlier **McCAFE** word registrations and two earlier **BIG MAC** word registrations. I agree with the applicant that the four **McDONALD'S** word registrations should not be counted four times over. It is the same sign. The same applies to the **McCAFE** and **BIG MAC** registrations. This leaves the groupings set out above each containing two signs.

78. In *Buildxact*, the Appointed Person reviewed the issue about the number of marks required for a family, in particular he referred to *Novartis v EUIPO*³⁵ wherein three was said to be the minimum viable number of marks for a family. I note this was decided post EU withdrawal. However, the AP said the decision can be regarded as "persuasive". Having considered all the family of marks criteria from the case law, I find that the marks cannot be considered as a family due to insufficient numbers, the positioning of the common feature and in the case of the **BIG MAC** and **GRAND BIG MAC** marks not being consistently present in the market at the relevant date.

Likelihood of confusion

79. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the

³⁵ T-175/22 *Novartis v EUIPO*, EU:T:2023:135.

average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The factors are interdependent, and include the principle that a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's registrations, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alert to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

80. In *L.A. Sugar Limited*,³⁶ Iain Purvis K.C. sitting as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

³⁶ *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)."

81. I bear in mind that the categories listed above in *L.A. Sugar* are not an exhaustive list of all the ways in which indirect confusion can occur. They are merely examples of the way in which it could or tends to occur.

82. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors*,³⁷ Arnold LJ approved Mr Purvis's formulation but added:

"13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16] 'a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion'. Mr Mellor went on to say that, if there is no likelihood of direct confusion, 'one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion'. I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion."

83. However it is also settled case law that it is not sufficient to find a likelihood of confusion if a mark merely calls to mind another mark.³⁸ This is considered mere association not indirect confusion.

³⁷ [2021] EWCA Civ 1207

³⁸ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

84. So far in this decision I have found:

- The respective services are identical.
- The opponent's goods and applicant's services are complementary.
- The average consumer would pay a medium degree of attention in a primarily visual purchasing process, although an aural component cannot be discounted.
- There is low degree of visual similarity between the **McDONALD'S** marks and the applicant's marks.
- There is a very low visual similarity between the **McCAFE** marks and the applicant's marks.
- There is a medium degree of visual similarity between the opponent's **BIG MAC** and **GRAND BIG MAC** marks and the applicant's marks.
- There is a low degree of aural similarity between the **McDONALD'S** and **McCAFE** marks and the applicant's marks.
- There is a medium degree of aural similarity between the opponent's **BIG MAC** and **GRAND BIG MAC** marks and the applicant's marks.
- There is no conceptual similarity between the opponent's **McDONALD'S** and **McCAFE** marks and the applicant's marks
- There is a low to medium degree of conceptual similarity between the opponent's **BIG MAC** and **GRAND BIG MAC** marks and the applicant's marks.
- The opponent's earlier registrations for its **McDONALD'S**, **McCafe** and **BIG MAC** marks have been enhanced because of the use made of them.
- The opponent's **GRAND BIG MAC** mark has a medium level of inherent distinctiveness.

Likelihood of confusion between the opponent's McDONALD'S, McCAFE marks and the applicant's marks

85. The respective marks have significant visual, aural and conceptual differences. I have found that the Mc/MAC element which the opponent claims is a key factor in confusion is presented at different places within the marks and will make an impact on how consumers will recollect the marks. In my view these differences are sufficient for a consumer not to directly confuse the marks. Moreover, I do not find it likely that consumers will indirectly confuse the marks. I remind myself of the guidance given in

L.A.Sugar that indirect confusion requires a consumer to undertake a thought process whereby they acknowledge the differences between the marks yet attribute the common element to a shared undertaking, taking one mark to be a possible brand extension or sub brand of the other mark. It seems very unlikely in this case that a plausible brand extension would move a prefix to the end of the word, add an additional letter and conjoin two words elements together. As such I find there is no likelihood of indirect confusion with any of the opponent's earlier registrations.

Likelihood of confusion between the opponent's BIG MAC and GRAND BIG MAC marks and the applicant's marks

86. The respective marks share the same **MAC** ending, albeit that the applicant's marks have a possessive apostrophe S element. However I find this similarity is outweighed by the differences at the beginnings of the marks, namely the additional words **BIG**, **GRAND BIG** and **SUPER**. These words are sufficient in my view for the average consumer not to directly confuse the marks, that is to mistake one mark for the others.

87. Regarding indirect confusion, I again remind myself of the guidance given in *L.A.Sugar*. However, I am also alert to the guidance in *Duebros* that a finding of indirect confusion should not be made simply because the respective marks share a common element.

88. I note that the additional words **BIG**, **GRAND BIG** and **SUPER** all have size connotations. However, I also note that the applicant's marks are conjoined, there is stylisation in the '061 mark and both applied for marks have a possessive apostrophe at their ends, which is a point of difference for the conceptual aspect of the respective marks. With regard to the respective goods and services I previously found that there was only a low degree of complementarity between them. Taking in to account the interdependency principle and the case law guidance given above, I find that use of the opponent's marks in relation to goods and the applicant's marks in relation to services do not amount to indirect confusion. As such I do not find the average consumer is likely to be confused. If one mark is brought to mind by the others on the basis of the letters **MAC** then I put this down to mere association not indirect

confusion, as per *Duebros*. I find there is no likelihood of indirect confusion with any of the earlier relied on registrations.

89. The opposition brought under section 5(2)(b) is unsuccessful.

Section 5(3)

90. I next turn to consider the claim made under section 5(3). The opponent opposed the applied for marks under this ground based on its earlier **McDONALD'S**, **McCAFE** and **BIG MAC** marks and the goods and services for which these marks are registered as set out in paragraph 2 of this decision. The opponent claims that the applicant would take unfair advantage due to the “free riding” off the opponent’s registrations. In addition, the opponent claims that the applied for marks would be detrimental to the repute and distinctive character of opponent’s brand.

91. Section 5(3) of the Act states:

“5(3) A trade mark which -

(a) is identical with or similar to an earlier trade mark, [...] shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.”

92. Section 5(3A) of the Act states:

“Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.”

93. The relevant case law can be found in the following judgments of the CJEU: Case C375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oréal v Bellure*, Case C-323/09, *Marks and Spencer v Interflora*, Case

C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows:

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24*.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26*.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Salomon, paragraph 29* and *Intel, paragraph 63*.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV*, paragraph 40.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the holder of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

94. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that its registrations and the application are similar. Secondly, the opponent must show that its registrations have achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must be established that the level of reputation and the similarities between the parties' marks will cause the public to make a link between them, in the sense of the earlier registrations being brought to mind by the contested mark. Finally, assuming the first three conditions have been met, section 5(3) requires that one or more of the types of damage will occur. It is unnecessary for the purposes of section 5(3) that the goods and services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

Reputation

95. I must consider whether the opponent's registrations have met the test for reputation. In *General Motors*, Case C-375/97, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation ‘in the Member State’. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation ‘throughout’ the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

96. Having considered the factors set out above and weighing in the evidence that I assessed earlier in this decision relating to longevity of use, turnover and brand awareness, I find that the opponent has established a strong reputation for its **McDONALD’S** and **McCAFE** marks and the goods and services in classes 29, 30, 32 and 43 for which these are registered as well as for its **BIG MAC** registrations and the class 29 and 30 goods for which these marks are registered.

Link

97. As noted above, the assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* underlined below are:

The degree of similarity between the conflicting marks

98. For the reasons given above I found there is a low degree of visual similarity between the opponent's **McDONALD'S** and **McCAFE** registrations and the applicant's marks but a medium degree of similarity between the opponent's **BIG MAC** marks and the **SUPERMAC'S** marks. In addition, I found there was low degree of aural similarity between **McDONALD'S** and **McCAFE** and **SUPERMAC'S** but a medium degree of aural similarity between **BIG MAC** and **SUPERMAC'S**. Where there was any conceptuality similarity it resides only in both **BIG** and **SUPER** relating to sizes as there was no concept in the **MAC** element.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

99. I have already found that the respective class 43 services are identical and the opponent's class 29 and 30 goods were complementary and therefore similar to a medium degree to the applicant's services. In addition, I found that the respective goods and services will all be purchased by the general public.

The strength of the earlier mark's reputation

100. The earlier marks have established a strong reputation for their goods and services.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

101. For the reasons given above, the earlier registrations are inherently distinctive to a medium degree. Given the use which has been made of the earlier marks, I find that the distinctiveness has been enhanced to a high degree.

Whether there is a likelihood of confusion

102. For the reasons given above, I do not find that there was either a direct or indirect likelihood of confusion between the respective marks.

103. There is no doubt that the opponent has reputation in its **McDONALDS** and **McCAFE** marks for its class 29, 30 and 32 goods and class 43 services. However, the differences between these marks and the applied for marks are such that no link will be made by the average consumer. The opponent also has a reputation in **BIG MAC** for its class 29 and 30 goods. However I find that the differences here between these goods and the applicant's services and the differences between the respective marks are sufficiently distant such that there will be no link. In the event that the relevant consumers encountering the letters **MAC** within a trade mark were to bring the other mark to mind, it would be so fleeting as to be ineffective with regard to the requirements of section (5)(3).

104. Therefore, the opposition brought under Section 5(3) is unsuccessful.

Section 5(4)(a)

105. Under section 5(4)(a), the opponent relies on the following signs:

- **McDONALD'S** for which it claims use in the UK since 1974
- **McCAFE** for which it claims use in the UK since 2012
- **BIG MAC** for which it claims use in the UK since 1974

106. I have set out in paragraph 3 the goods and services for which the opponent claims use of the above mentioned signs.

107. Section 5(4)(a) states:

“(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa) [...]

(b) [...]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

108. Subsection (4A) of Section 5 states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

109. Section 5A of the Act is as follows:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

110. In *Reckitt & Colman Products Limited v Borden Inc. & Ors*,³⁹ Lord Oliver of Aylmerton described the ‘classical trinity’ that must be proved in order to reach a finding of passing off:

“First, [the plaintiff] must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying ‘get-up’ (whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the

³⁹ [1990] RPC 341, HL, page 406.

public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by him are the goods or services of the plaintiff. Thirdly, he must demonstrate that he suffers or, in a quia timet action, that he is likely to suffer damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff."

111. Halsbury's Laws of England Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

"Establishing a likelihood of deception generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other indicium which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;

- (c) the similarity of the mark, name etc used by the defendant to that of the claimant;
- (d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action”.

Relevant date

112. In terms of the relevant date for assessment of section 5(4)(a), in *Advanced Perimeter Systems Limited v Multisys Computers Limited*,⁴⁰ Mr Daniel Alexander QC (as he was then), sitting as the Appointed Person, quoted with approval the summary made by Mr Allan James, acting for the Registrar, in SWORDERS Trade Mark:⁴¹

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’”

113. The applicant’s word mark ending ‘047 has a priority date of 17 May 2016 and its stylised mark ending ‘061 has a priority date of 10 April 2017. As such, all factors will be considered as at these priority dates.

⁴⁰ BL O-410-11

⁴¹ BL O-212-06

Goodwill

114. The first hurdle for the opponents is to show that they had the required goodwill at the relevant date. The issue of what constitutes goodwill was discussed in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd*⁴² viz,

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

115. In *Smart Planet Technologies, Inc. v Rajinda Sharm*⁴³, Mr Thomas Mitcheson QC (as he was then), sitting as the Appointed Person, reviewed the following authorities about the establishment of goodwill for the purposes of passing-off: *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2015] UKSC 31, paragraph 52, *Reckitt & Colman Product v Borden* [1990] RPC 341, HL and *Erven Warnink B.V. v. J. Townend & Sons (Hull) Ltd* [1980] R.P.C. 31. After reviewing these authorities Mr Mitcheson concluded that:

“.. a successful claimant in a passing off claim needs to demonstrate more than nominal goodwill. It needs to demonstrate significant or substantial goodwill and at the very least sufficient goodwill to be able to conclude that there would be substantial damage on the basis of the misrepresentation relied upon.”

116. Goodwill arises as a result of trading activities and accrues to the business that the public thinks is responsible for the goods and services. The relevant market for assessing goodwill is the UK. I reviewed the opponent's evidence earlier in the decision and I found that at the relevant dates it was clear that the opponenent had

⁴² [1901] AC 217 (HOL)

⁴³ BL O/304/20

goodwill in the **McDONALD'S McCAFE** and **BIG MAC** signs for the respective goods and services I set out in paragraph 3.

Misrepresentation

117. Having cleared the first hurdle of goodwill, I now go on to consider the second hurdle, that of misrepresentation. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]”

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148 . The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175 ; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

And later in the same judgment:

“.... for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993) . It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

118. On the subject of how many of the relevant public must be deceived or confused for the opponent to be successful in a claim under this ground, I bear in mind the decision in *Lumos Skincare Limited v Sweet Squared Limited and others*⁴⁴, where Lord Justice Lloyd commented on the paragraph above as follows:

“64. One point which emerges clearly from what was said in that case, both by Jacob J and by the Court of Appeal, is that the “substantial number” of people who have been or would be misled by the Defendant's use of the mark, if the Claimant is to succeed, is not to be assessed in absolute numbers, nor is it applied to the public in general. It is a substantial number of the Claimant's actual or potential customers. If those customers, actual or potential, are small in number, because of the nature or extent of the Claimant's business, then the substantial number will also be proportionately small.”

119. Accordingly, once it has been established that the party relying on the existence of earlier rights under section 5(4)(a) had sufficient goodwill at the relevant date to find a passing-off claim, the likelihood that only a relatively small number of persons would be likely to be deceived does not mean that the case must fail. There will be a misrepresentation if a substantial number of customers, or potential customers, of the claimant's actual business would be likely to be deceived.

120. I have found that the opponent has established goodwill in the signs **McDONALD'S**, **McCAFE** and **BIG MAC**. I found a low degree of visual and aural similarity between the opponent's **McDONALD'S** and **McCAFE** registrations and the applicant's marks and a medium degree of visual and aural similarity between the opponent's **BIG MAC** marks and the applicant's marks. The conceptuality similarity resided only in **BIG** and **SUPER** where they relate to sizes as there was no concept in the **MAC** element.

121. I acknowledge that the test for misrepresentation is different to that for likelihood of confusion, namely, that misrepresentation requires “a substantial number of members of the public are deceived” rather than whether the “average consumers are confused”. However, as recognised by Lewison L.J. in *Marks and Spencer PLC v*

⁴⁴ [2013] EWCA Civ 590.

*Interflora*⁴⁵, it is doubtful whether the difference between the legal tests will produce different outcomes. In my view, this is the case here. I do not find that the relevant public faced with the contested marks, used in respect of the goods/services for which they have goodwill, will believe that there is a connection between the opponent's registrations and the applicant's marks. The visual, aural and conceptual differences between the marks are significant and there is not, in my view, a logical progression from the opponent's registrations and the applicant's marks such as to give rise to misrepresentation. As such the opposition based on section 5(4)(a) fails.

Overall conclusion

122. The opposition has failed in its entirety. Subject to any appeal of this decision the applied for marks will proceed to registration.

Costs

123. The applicant has been successful in these proceedings. As such it is entitled to a contribution towards the costs incurred. Awards of costs for proceedings commenced before 1 February 2023 are governed by Annex A of Tribunal Practice Notice (TPN) 2/2016. Bearing in mind the guidance given in TPN 2/2016, I award costs as follows:

£500 Considering Notice of Opposition & preparing counterstatement

£900 Considering other side's evidence & preparing own evidence

£1300 Preparation for & attending the hearing

£2700 Total

124. I order McDonald's International Property Company, Ltd. to pay Supermac's (Holdings) Ltd the sum of £2700. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

⁴⁵ [2012] EWCA (Civ) 1501

Dated this 31st day of July 2026

June Ralph

For the Registrar

The Comptroller-General