

O/1023/24

TRADE MARKS ACT 1994

IN THE MATTERS OF

CONSOLIDATED OPPOSITIONS: 429113, 429114 & 429115

BY MCDONALD'S INTERNATIONAL PROPERTY COMPANY, LTD. AGAINST

UK TRADE MARK APPLICATIONS 3630165, 3630194 & 3630037:

“LOVIN IT” / LOVIN IT / “LIVIN IT & LOVIN IT”

VARIOUSLY IN CLASSES 3, 9, 14, 18, 25, 35, 41 & 42

IN THE NAME OF JANA ANTONIA SPELEERS

- AND -

CONSOLIDATED APPLICATIONS BY JANA ANTONIA SPELEERS:

505099, 505100, 505101, 505102, 505103 & 505104

TO REVOKE FOR NON-USE

**UK TRADE MARK REGISTRATIONS IN THE NAME OF MCDONALD'S
INTERNATIONAL PROPERTY COMPANY, LTD.:**

2372555, 2340099, 903581089, 2341398, 903224888 AND 903196581 -

“I'M LOVIN' IT”

ACROSS CLASSES 14, 16 AND 25 29, 30, 32 35, 41, 42 & 43

BACKGROUND AND PLEADINGS

1. This decision deals with consolidated proceedings in respect of three oppositions and six revocation applications.

The Oppositions

2. The oppositions are against the three trade mark applications shown on the cover page above, each mark featuring the words “LOVIN IT”. The applications were all filed on 21 April 2021 (“**the Relevant Date**”), by Jana Antonia Speleers (“**the Applicant**”), in respect of goods and services ranging across in Classes 3, 9, 14, 18, 25, 35, 41 and 42 (as set out in full in **Annex 1** to this decision).
3. McDonald’s International Property Company, Ltd. (“**McDonald’s**”) opposes registration of the Applicant’s marks on grounds under **sections 5(3)** and **(5)(4)(a)** of the Trade Marks Act 1994 (“**the Act**”), each ground directed against all of the applied-for goods and services.
4. For its **section 5(3)** claims, McDonald’s relies on two earlier registered trade marks (“**the Earlier Marks**”): both are for the same sign - “I’M LOVIN’ IT” - and both are registered for goods and services in Classes 29, 30, 32 and 43. (The differences in the specifications of the Earlier Marks, are of little or no significance, since they both cover comparable foods, drinks and restaurant services.) McDonald’s claimed that, at the Relevant Date, its “I’M LOVIN’ IT” trade marks benefitted from a reputation in respect of the goods and services set out below, such that use of the Applicant’s marks, without due cause, would take unfair advantage of, or be detrimental to, the distinctive character or repute of McDonald’s Earlier Marks.
5. The goods and services of the Earlier Marks, for which a reputation is claimed, are these:
 - (a) UK Trade Mark No. 2372555:
 - (i) **Class 29:** *Foods prepared from meat, pork, fish and poultry products, preserved and cooked fruits and vegetables, eggs, cheese, milk, milk preparations, desserts.*

- (ii) **Class 30:** *Edible sandwiches, meat sandwiches, pork sandwiches, fish sandwiches, chicken sandwiches, biscuits, bread, cakes, cookies, chocolate, coffee, tea, oatmeal, pastries, sauces.*
- (iii) **Class 32:** *Non-alcoholic beverages, syrups and other preparations for making beverages.*
- (iv) **Class 43:** *Services rendered or associated with operating restaurants and other establishments or facilities engaged in providing food and drink prepared for consumption; including the preparation and sale of carry-out foods.*

(b) UK Trade Mark No. 2340099:

- (i) **Class 29:** *Prepared entrees consisting primarily of pork, fish or poultry; preserved fruits; jams; eggs, cheese, milk, chocolate milk, and other dairy products, dairy-based shakes; fruit preserves.*
- (ii) **Class 30:** *Edible sandwiches for consumption on or off the premises, coffee, tea, cocoa, sugar; bread, biscuits, cakes, pastries, soft-serve ice cream.*
- (iii) **Class 32:** *Soft drinks, fruit juices, fruit drinks, fruit-flavoured drinks; drinking water, mineral water, spring water; syrups and other preparations for making soft drinks, fruit juices, fruit drinks, fruit-flavoured drinks.*
- (iv) **Class 43:** *Restaurant services in Class 43.*

6. For the purposes of **section 5(4)(a)**, McDonald's claims goodwill associated with the sign "I'M LOVIN' IT" in respect of the list of goods and services set out in **Annex 2**, which covers various foods, soft drinks, restaurant services, as well as clothing, printed matter, entertainment services and golf putters.¹ The objection under this ground is that use of the Applicant's marks would be liable to be prevented on the basis of passing off.

¹ By the time of the hearing, Ms Blythe's skeleton argument presented a reduced list of goods and services for which goodwill is claimed, striking through certain terms that had featured in initial opposition claim.

The Applicant's defence

7. The Applicant filed notices of defence in respect of each of the three oppositions. It requested that the Opponent provide proof of use for all the goods and services relied on under the two Earlier Marks. In its counterstatement, the Applicant denied the grounds of opposition in their entirety.
8. In response to the section 5(3) claim, the counterstatement denied that the Earlier Marks benefited from a reputation in the UK, and that use of the Applicant's marks would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the Earlier Marks.
9. In response to the section 5(4)(a) claim, it denied that McDonald's had built a substantial reputation and goodwill in relation to "I'M LOVIN' IT" throughout the UK. It denied that the Applicant's use of its marks would give rise to misrepresentation, and that no damage would therefore follow.

The revocations

10. In addition to putting the opponent to proof of use of its two Earlier Marks for the purposes of section 5(3), the Applicant applied to revoke a total of six of McDonald's trade marks – all for "I'M LOVIN' IT" – and in respect of all of the goods and services for which they are registered. The revocation applications are made pursuant to **section 46(1)(a)** of the Act claiming that the marks had not been put to genuine use in the UK within a period of five years following their dates of registration, with no proper reasons for non-use.
11. The **contested registrations** include the two Earlier Marks (2372555 and 2340099 in Classes 29, 30, 32, 43) along with the four further "I'M LOVIN' IT" trade marks, registration numbers 903581089, 2341398, 903224888 and 903196581.
12. McDonald's filed defences in respect of each of the six contested registrations, affirming use of most of its registered goods and services.
13. When filing its Form TM8 defence, in respect of a small minority of particular goods and services under some of the contested registrations, McDonald's did not contest the claim of non-use. Moreover, by the time of the hearing, McDonald's no longer claimed use in respect of a further particular goods and services specified under some of the contested

registrations. **Annex 3** at the end of this decision sets out the detail of McDonald's specifications, including the above concessions, captured in the manner used by Ms Blythe in her skeleton argument.

14. Furthermore, at the hearing, Ms Watkinson made significant concessions, accepting that McDonald's had made use of its contested registrations in respect of the majority of its goods and services, including its core food, drink and restaurant services. The challenge on non-use therefore remained only in respect of a very small minority of the registered goods registered under No. 903581089, limited to Class 16: *Printed matters* and Class 25: *Clothing and footwear*.

Papers filed, Representation and Hearing

15. During the evidence rounds, only McDonald's filed evidence. The attorneys for McDonald's are Bristows LLP; the attorneys for the Applicant are Trade Mark Wizards Limited. An oral hearing of the matter was held by video conference on 22 November 2023. Charlotte Blythe, of counsel, attended for the Opponent; Kendal Watkinson, of counsel, attended for the Applicant. Both counsel filed skeleton arguments ahead of the hearing. I make this decision having read all the papers filed and refer to their contents where I consider it warranted to do so.

Assimilated law

16. 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 which predate the UK's withdrawal from the EU.

EVIDENCE OF USE

17. McDonald's evidence comprised a **Witness Statement of Steven John Howells**, dated 9 February 2023, accompanied by **Exhibits SJH1 to SJH28**. Mr Howells is the Director of Marketing & Media at McDonald's; his evidence seeks to demonstrate the claimed

genuine use, reputation and goodwill. Ms Blythe provided in her skeleton argument a very helpful account of the evidence, from which I draw extensively below.

18. Mr Howells' witness statement explains that the sign "I'M LOVIN' IT" has been the McDonald's brand's primary slogan since 2003 and is used prominently in relation to McDonald's full product and service offering, with the use of that slogan naturally ebbing and flowing over the last 20 years. Ms Blythe lists "a few key facts ... by way of illustration of the scale of the McDonald's brand, the product/service offering of McDonald's and the significance of the I'M LOVIN' IT slogan:

Scale of the McDonald's brand:

- (a) There are over 1,300 McDonald's restaurants in the UK and in 2019 McDonald's served over 2.3 million customers in the UK every day [Howells/§9].
- (b) UK turnover has been at least £900 million every year since 2003 [Howells/§14].
- (c) The combined advertising and promotional expenditure for the UK in the years 2012-2022 was in excess of £500 million [Howells/§45].
- (d) McDonald's has an impressive online presence with 10s of millions of hits on its website [Howells/§§63-64] and large social media followings including 26 million views on YouTube [Howells/§65].
- (e) In a survey from September 2020, McDonald's total brand awareness as a brand for informal eating out was reported at 93% [Howells/§68].

McDonald's product/service offering:

- (f) McDonald's operates restaurants where you can eat-in, take-away or drive-through, as well as providing food delivery services [Howells/§10, §15].
- (g) It offers a wide range of food as shown in the sample menu at **Exhibit SJH-2**, including: burgers, sandwiches, beef burgers, chicken burgers, fish burgers, vegetarian burgers, vegetable dippers, chicken nuggets and other chicken products, salads, wraps, potato fries, sauces and condiments, prepared fruits and vegetables, a range of breakfast items including muffins containing eggs, bacon, sausage and

cheese, porridge, pancakes, hash browns, and desserts including cookies, apple pies, doughnuts, and ice-cream-based desserts.

- (h) It also offers a wide range of drinks, including: soft drinks, bottled water, juices, milkshakes, coffee, tea and hot chocolate [**Exhibit SJH-2**]

The I'M LOVIN' IT slogan:

- (i) The slogan was introduced in 2003 as part of a high-profile global advertising campaign featuring Justin Timberlake costing over \$1 billion USD [Howells/§19-**Exhibit SJH5**]. In 2004 (the year after the launch), in excess of £25 million was spent on linear TV advertising in the UK [Howells/§46].
- (j) The slogan has been used continuously and widely since its launch and has become synonymous with the McDonald's brand. It is used interchangeably with the house brand under the famous golden arches, it features in restaurants and on the packaging of products and is used in advertising and promotional material which promote the entire McDonald's offering [Howells/§27-33, §37]. See:
- (i) Example promotional material, print, display and online advertising and outdoor advertising at **Exhibit SJH-8 & 9**.
- (ii) Television advertisements, where the mark is seen as shown below [**Exhibit SJH-10** (USB) and **Exhibit 11**]. The total reach of such advertisements between 2004 - 2015 was 99% of UK adults who own or have access to a TV [Howells/39



- (iii) Packaging including: brown paper bags at **Exhibit SJH-16**, the vessel by which customers carry their food out of McDonald's restaurants or in which food is

delivered; ice cream cups, coffee and soft drink cups, boxes for burgers, fries, desserts, chicken nuggets etc at **Exhibit SJH-17**.

(iv) Vouchers at **Exhibit SJH-18**:



(v) The McDonald's website at **Exhibit SJH-27**.

(k) The slogan continues to be heavily promoted in the UK: it featured in an advertising campaign featuring Jessie J in 2015 [Howells/40] and in excess of £50 million was spent on linear TV advertising that year [Howells/46]; McDonald's / its advertising agencies have won numerous awards in relation to the I'M LOVIN' IT campaigns [Howells/41-44 & 60 and **Exhibits SJH-13, 14, 15 & 24**]; McDonald's hosted a live-stream concert called "I'M LOVIN' IT live" in 2020 [Howells/56-58], which was made available to 90% of the UK population; and McDonald's sponsored the Queen's Platinum Jubilee Pageant in 2022 using the tweaked tagline "One's Lovin' It" [Howells/61 and **Exhibit SJH-25**].

(l) The fame of the slogan and its importance to the McDonald's brand is reported in various articles as seen at **Exhibit SJH-28**.

THE SECTION 5(3) OPPOSITION CLAIM

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

"A trade mark which 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 the repute of the earlier trade mark.

(3A) 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.”

Proof of use

20. In the present case, both Earlier Marks on which McDonald’s relies for its section 5(3) claim had been registered for more than five years before the filing dates of the Applicant’s contested trade mark applications. Those Earlier Marks are consequently subject to the use provisions set out in section 6A of the Act. Formally, McDonald’s ability to rely on its Earlier Marks is pre-conditional on its proving that, within the five years leading up to the date on which the contested trade mark applications were filed, it had put the ‘I’M LOVIN’ IT marks to genuine use in respect of the goods and services on which it relies for its section 5(3) claims. The relevant period is therefore 22 April 2016 – 21 April 2021. I say “formally”, firstly, because McDonald’s must anyway establish the reputation it claims in respect of the slightly narrower list of goods and services in Classes 29, 30, 32 and 43, and secondly, because Ms Watkinson made substantial concessions, accepting the two Earlier Marks had been used for all of their registered goods and services. It is therefore not necessary to consider the issue of genuine use in respect of the present assessment.

Case law on section 5(3) grounds

21. The relevant case law principles can be found in the following judgments of the CJEU: Case C-375/97, *General Motors Corp v Yplon SA* [2000] RPC 572; (CJEU), Case 252/07, *Intel Corporation Inc v CPM United Kingdom Ltd* - [2009] RPC 15; Case C-408/01, *Adidas-Salomon AG v Fitnessworld Trading Ltd*. [2004] ETMR 10, Case C-487/07, *L’Oreal SA and others v Bellure NV and others* - C-487/07 and Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows:

(i) 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*.

- (ii) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26*.
- (iii) 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-Saloman, paragraph 29* and *Intel, paragraph 63*.
- (iv) 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*.
- (v) 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*.
- (vi) 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*.
- (vii) 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*.
- (viii) 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*.

(ix) 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 proprietor 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*).

22. In order to succeed with a claim under section 5(3) McDonald's must establish each of the following necessary component elements (i) similar or identical marks, (ii) a reputation, (iii) a link with the earlier mark in the mind of the relevant public, (iv) in consequence of the link, a finding that the use of the mark will take unfair advantage of the distinctive character or repute of the earlier mark or is detrimental to that distinctive character or repute, and (v) that the mark is applied for and to be used without due cause.² I consider each of those elements in turn.

Similarity of the marks

23. The marks at issue are as follows:

The Applicant's Marks	McDonald's Marks
Mark 1: LOVIN IT	I'M LOVIN' IT
Mark 2: LOVIN IT	
Mark 3: LIVIN IT & LOVIN IT	

² *Intel Corp Inc v CPM United Kingdom Ltd (C-252/07) [2009] R.P.C. 15*
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24. The Applicant denied that its marks are either identical or similar to the Earlier Marks, and relied on “the following features of the Applicant’s Marks as differentiating and distinguishing them” from the Earlier Marks:
- a. The omission of the word “I’M from each of the Applicant’s Marks”, which is at the start of the Earlier Registrations and is therefore the dominant and distinctive element;
 - b. The unique stylisation of the words “LOVIN IT” in the Applicant’s Second Mark, which does not feature in the Earlier Registrations; and
 - c. The additional “LIVIN IT &” element in the Applicant’s Third Mark, which is at the start of the mark and is therefore the dominant and distinctive element, which does not feature in the Earlier Registrations.

The Applicant submitted that if there is any similarity between the respective marks, then it is to “no more than a low degree at most”.

25. I deal with each of the Applicant’s marks in turn.
26. I bear in mind that the Earlier Mark “I’m lovin’ it”, is registered as a plain word mark and may be deployed in any conventional font. Likewise, the Applicants’ **Mark 1**, is a plain word mark that may be deployed in any conventional font. The respective marks may therefore be used in precisely the same normal font and case format.
27. It is possible that a minority of the average consumer group (the general public), encountering the mark “LOVIN IT”, would perceive it as a reference to computer services offered by someone of the surname LOVIN – comparable to, say, LEWIN PCs. This prospect may be considered more likely insofar as the applicant’s specifications in Class 9 and 35 services relate to *computer software and hardware*. No such perceived reference can arise in respect of the Earlier Mark.
28. However, notwithstanding the absence of an apostrophe to indicate the omission of a letter “g”, the far more likely prospect for the bulk of the applicant’s goods and services – and all of the goods in Classes 3, 14, 18 and 25 - is that the average consumer would perceive Mark 1 as conveying the message “loving it”, expressed in slightly abbreviated form. The absence of the apostrophe may generally be overlooked. The absence of the “I’m” component that opens the Earlier Mark is not negligible, but nor, contrary to the Applicant’s submission, is that component the dominant and distinctive element. There

is a degree to which the omitted “I’m” is almost implied. I find that the Applicant’s plain word mark “Lovin it” (Mark 1) is visually, aurally and conceptually **highly similar** to the Earlier Mark.

29. With regard to Mark 2, I find that the significant degree of stylisation present in its letters “O”, “V” and “N” contributes notably to the overall impression of the Mark 2. It is an elaborate font and, in my view, extends beyond the category of ‘ordinary’ typeface and font; certainly it provides Mark 2 with a degree of distinctive character of a nature that is not shared with the plain word Earlier Mark. The Earlier Mark is shown to have been used more or less consistently in the form exemplified below, which involves an unremarkable font, the only oddity being the lower-case usage in “i’m” (though that case usage is permissible for a plain word mark).

i’m lovin’ it™

30. I find that the Applicant’s stylised mark “Lovin it” (**Mark 2**) is aurally and conceptually highly similar to the Earlier Mark, but visually similar only to a lower degree – certainly no more than a medium degree.
31. The additional three opening components of the Applicant’s plain word mark “LIVIN IT & LOVIN IT” (**Mark 3**) do not feature in the Earlier Mark. In my view these marks are visually, aurally and conceptually similar only to a lower degree – certainly no more than a medium degree.

Reputation of the Earlier Marks

32. The second requirement is reputation – which is a knowledge threshold requirement. To establish reputation, the trade mark must be known by a significant part of the relevant section of the public as regards the goods or services for which the mark is registered. Relevant factors to take into account are market share, intensity, geographical extent and duration of use, and the size of the investment made by the opponent in promoting the mark.³
33. The Applicant admitted that the McDonald’s brand has a reputation in general, but denied that the Opponent has a reputation for the “I’M LOVIN’ IT” mark in relation to the above

3 *General Motors* at [24]-[27]

goods and services. Indeed, in her skeleton argument, Ms Watkinson had submitted that the Opponent's Evidence does not show any *genuine* use of the Earlier Marks in the UK in relation to claimed registered goods and services. No real explanation was put forward as to why the Applicant rejected McDonald's' evidence as constituting genuine use; that position might have been premised on a contention that the mark served 'merely' as a slogan, not as a trade mark per se functioning to guarantee the source of the goods or services.

34. However, as I noted earlier, at the hearing, it was accepted by the Applicant that McDonald's had made genuine use of both Earlier Marks relied on for its section 5(3) claim. Although the Applicant accepted that there had been genuine use of the Earlier Marks in respect of the registered goods and services, the Applicant made no clear admission with regard to the claimed reputation. Ms Watkinson emphasised that the Earlier Mark is "I'm lovin' it" – it is not "McDonald's" or the McDonald's "M" – the golden arches. Ms Watkinson submitted that the Earlier Mark is a slogan, which used by itself, not in association with the wider brand, does not have the same reputation as the McDonald's brand. This seems to me to imply a comment on the distinctiveness of the Earlier Mark, and I shall come back to this point later in this decision.
35. At the hearing, Ms Watkinson readily acknowledged that a slogan is capable of serving as a trade mark - capable of functioning as a badge of origin for the goods and services in question. The fact of registration is *prima facie* evidence that the Earlier Marks are valid and possess distinctive character.⁴ Moreover, by virtue of the very extensive use and promotion of the Earlier Marks, I find that have gained enhanced distinctive character and reputation in respect of the majority of the foods, drinks and restaurant services on which McDonald's relies for its section 5(3) claim in Classes 29, 30, 32 and 43 – particularly the core McDonald's offerings of Foods prepared from meat, pork, fish and poultry products, Edible sandwiches, dairy-based shakes, operating restaurants and the preparation and sale of carry-out foods. The Earlier Mark is known to a very significant part of the relevant section of the general public and the reputation is very strong in respect of the core goods and services.

4 Section 72 of the Act.

Will there be a link with the Earlier Mark in the mind of the relevant public?

36. It is sufficient for such a link that the sign will call the trade mark to the mind of the average consumer.⁵ I will consider the question of link in respect of each the three applied-for marks, since they have differing degrees of similarity to the Earlier Mark.
37. The Intel factors included in the global assessment of whether such a link exists are set out at paragraph 21(d) above.
38. The factors favouring the section 5(3) claim by McDonald's are:
- the strength of the reputation attached to the Earlier Mark in respect of the foods, drinks and restaurant services that are the core business of McDonald's;
 - the similarity (in differing degrees) between the respective marks.
39. The factors less favourable to the section 5(3) claim by McDonald's are:
- that none of the goods and services for which the Applicant seeks to register its marks are at all similar to the goods and services for which the Earlier Marks have a reputation. The full list of the Applicant's goods and services set out at Annex 1 at the end of this decision is lengthy, and it is enough that I refer in due course to representative examples from the different classes;
 - the low inherent distinctiveness of the Earlier Mark, given its promotional slogan nature, involving three very ordinary English words, with an essentially banal or commonplace phrase structure – as in “I'm loving your new haircut ...”, “he's loving life/the new job/school ... etc ...”. The Earlier Mark has, through use, developed a greatly enhanced distinctiveness and a reputation, but the reputation and enhancement is in respect of goods and services that are dissimilar to the Applicant's goods and services.

Link with Mark 1

40. I have found that Mark 1 – “Lovin it” - is visually, aurally and conceptually highly similar to the reputed Earlier Mark. Mark 1 may be presented in precisely the same format as has been used by McDonald's. And if McDonald's were to change to another ordinary font

5 Floyd LJ in *Argos Ltd v Argos Systems Inc* [2018] EWCA Civ 2211; [2019] F.S.R. 3 at paragraph 82
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and typeface for its Earlier Mark, as its word-only registration permits, then Mark 1 may likewise again adopt precisely the same font and typeface. I must consider how the high degree of similarity between “I’M LOVIN’ IT” and “LOVIN IT”, coupled with the very strong reputation of the plain word mark “I’M LOVIN’ IT” (associated with McDonald’s claimed offerings), interplay with:

(a) the complete absence of any similarity between the goods and services for which the Earlier Mark has a reputation and the contested goods and services of the Applicant;

and

(b) the fact that the phrase of the Earlier Mark is not notably distinctive on an inherent basis.

41. The purpose of section 5(3) is to afford the proprietor of a mark that has acquired a reputation a form of extended protection that guards against use of a later mark that is sufficiently similar to call to mind the reputed mark in such a way that it would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier mark.
42. Similarity between goods and services is not a requirement under section 5(3), but the distance or closeness between the respective goods and services is a factor to take into account when considering if use of the later mark would bring to mind the reputed earlier mark. Nor is a likelihood of confusion a requirement under section 5(3); however, to the extent that there may be a likelihood of confusion, the elements of link and damage would be satisfied.
43. *Earlier Marks’ reputed goods and services*: The goods and services for which the Earlier Mark has a reputation may be considered to be, essentially, the food, drink and restaurant services for which McDonald’s is well known.
44. *Mark 1’s goods and services*: The Applicant’s contested goods and services under Mark 1 are set out in full at Annex 1 to this decision, but for the purposes of my considering the question of link may be characterised broadly or indicatively, as follows (any underlining is my own, for emphasis):

Class 3: *cosmetics and toiletries*

Class 9:

- (i) *Computer software downloadable digital media and recordings containing sound, images, text, information, signals or software; downloadable electronic publications of books, audio books, magazines, and journals; electronic bulletin boards; podcasts; video podcasts; webcasts; podcasts, video podcasts and webcasts in relation to fashion; hardware and programs; mobile apps*

With the disclaimer:

“none of the aforesaid goods being downloadable software in the nature of an application that provides curated and original text, audiocontent, images, photographs and video content in the field of restaurants, food, drink, recipes, current affairs, culture, the media, sports, lifestyle, weddings, property, health, dating, travel, books, and the arts to mobile and stationary consumer electronic devices.”

- (ii) *smart watches; mobile phone cases; spectacles; sunglasses; protective goggles*
- (iii) *protecting masks; protective clothing; safety clothing;*

Class 14: *Precious metals and stones; jewellery; watch straps*

Class 18: *leather; leather bags, animal harnesses; umbrellas*

Class 25: *Clothing, footwear, headgear – plus numerous examples of the same*

Class 35:

- (i) *Retail, wholesale, import and export services in relation to the sale of the goods in Classes 3, 9, 14, 18 and 25*
- (ii) *advertising, marketing and promotional services; digital marketing services;*
- (iii) *office functions; business administration;*
- (iv) *business advice in relation to franchising;*

With the disclaimers:

none of the aforesaid services relating to advertisements in connection with home interiors, wellness and cooking;

none of the aforesaid services relating to advertising, marketing and promotion of restaurants, food, drinks and recipes.

45. It is my view that despite (a) the lack of similarity with the reputed goods and services on which McDonald's relies, and despite (b) the 'ordinariness' of the English-language slogan that is the Earlier Mark – a sign far less distinctive than a trade mark slogan such as "*Vorsprung durch Technik*", for example – that use of the plain words LOVIN IT, potentially in identical presentation as used by McDonald's, will give rise to mental link and a likelihood of confusion in respect of some of the applied-for goods and services as I specify below. Likelihood of confusion is a form of consequent damage. It is also my view that use of Mark 1 in respect of the some of the goods and services below may also benefit from the promotional effort expended by McDonald's, making it easier to market the goods and services, giving rise to an unfair advantage. I also find that there is no due cause for use of Mark 1 (the plain word form) in respect of the particular goods and services I have specified.
46. I list below the applicant's specified terms under Mark 1 that I find to be objectionable in the face of McDonald's' reputed Earlier Mark. I also explain further why I consider that only those terms are defeated by the section 5(3) claim and not the other applied-for goods and services.

Class 9: *protective clothing; safety clothing; protecting masks; masks [protective -]; protection masks; protective masks*

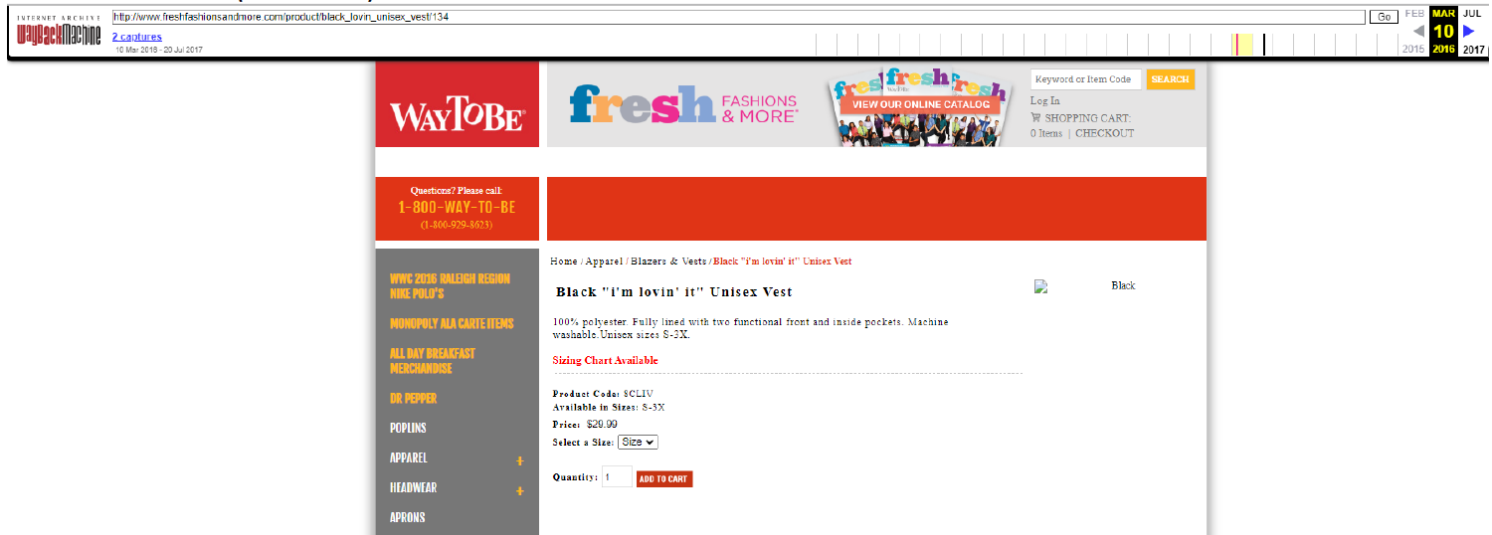
Class 25: *Clothing, footwear, headgear; cap peaks; caps; hosiery; jerseys; children costumes; casual clothing; outerclothing; overalls, smocks; paper hats, ready-made clothing; shirts; short-sleeve shirts; sports jerseys; socks; sweaters, jumpers; tee-shirts; vests*

Class 35: deletion of the above-named goods from the coverage specified by the Class 35 services.

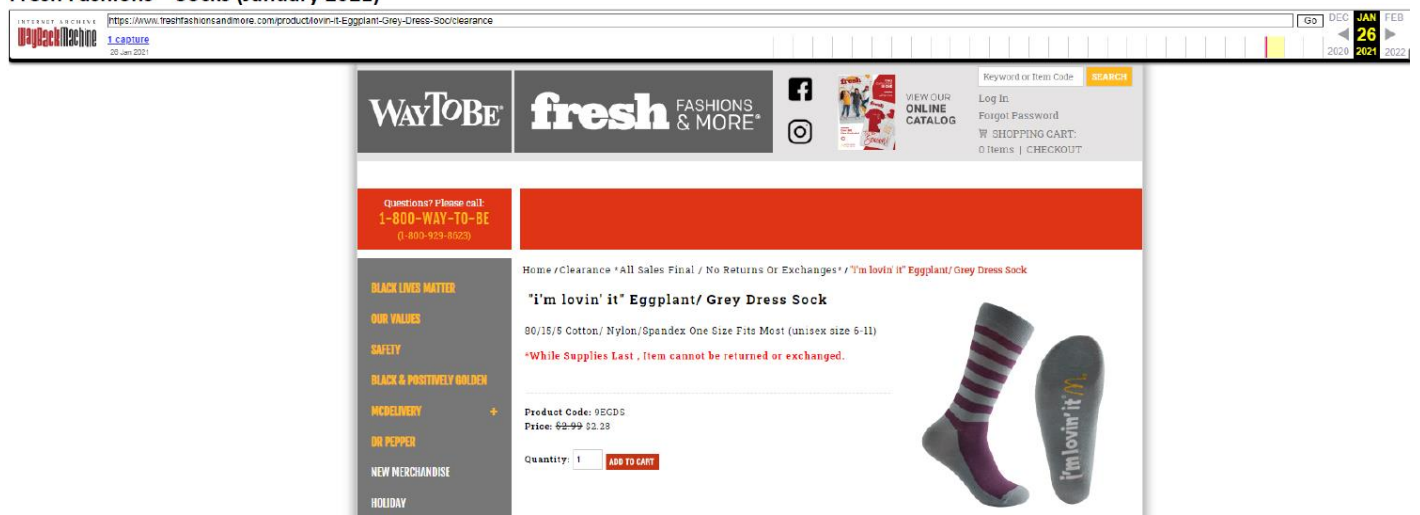
Class 35: *office functions; business administration; business advice in relation to franchising*

47. I'll explain first my view on the Class 25 goods. McDonald's' evidence at **Exhibit SH19** showed the images below in respect of goods in Class 25, offered for sale through third-party retailers (namely, freshfashionsandmore and smilemakersonline). The currency is given in dollars, so this does not appear to be use directed to the UK market.

Fresh Fashions – Vest (March 2016)



Fresh Fashions – Socks (January 2021)



20% OFF Apparel and Sports & Outdoors Categories through 10/13! DETAILS >



Search shop

- Shop
- Promotions
- Family & Community
- Virtual Gift Card
- Catalogs & Flyers
- Custom Orders



Smilemakers Shop (March 2020)



Search shop

- Shop
- Programs
- Events
- Custom Orders
- E-mail Sign Up

Home / Shop

Categories

- Shop
- Winter 2020
- Apparel & Accessories
- Bags & Totes
- Best Sellers
- Drinkware
- Gifts & Recognition
- Lapel Pins & Patches
- Pens & Notebooks
- Promotion & Event Essentials
- Sports & Outdoors
- Technology
- Clearance

Shop

Cookies help us deliver our services. By using our services, you agree to our use of cookies.

[Learn more](#)

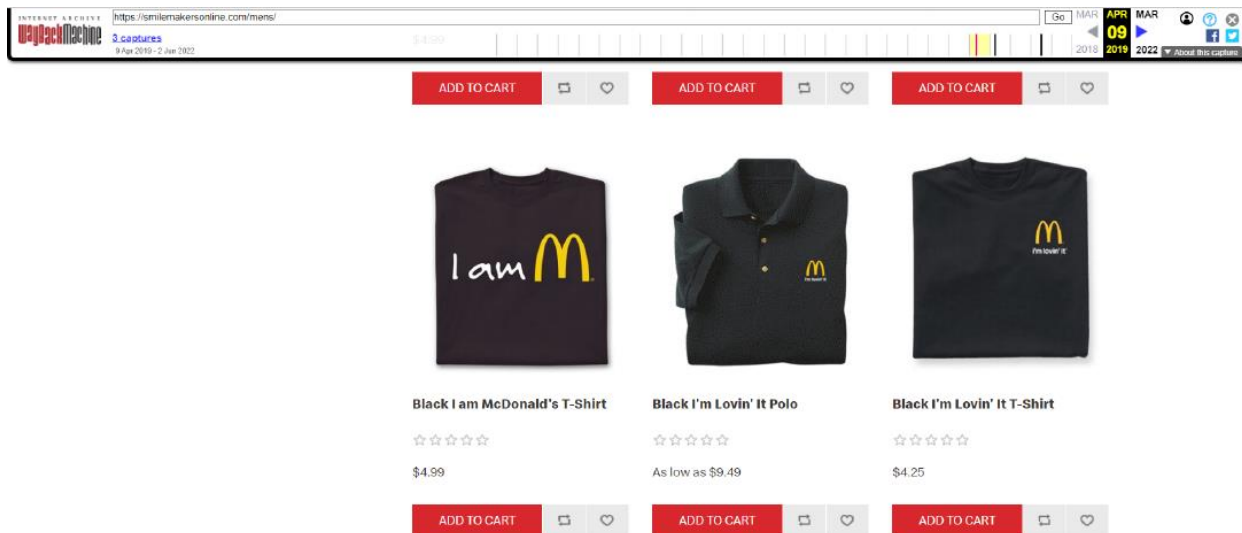
Winter Accessories

Bags & Totes

Best Sellers

Drinkware

Gifts & Recognition



48. The currency in the above images from Exhibit SH19 is given in dollars, so this does not appear to be use directed to the UK market, though Mr Howells states at paragraph 52 of his witness statement that the goods can be bought online and shipped to the UK. Nor does the exhibit show use of the mark by McDonald's itself. However, Mr Howells states that McDonald's has established a commercial relationship with the third-party websites. He states that the website of smilemakersonline.com describes itself as "a McDonald's approved supplier for apparel, accessories, incentives, and event merchandise." Several of the images feature the Earlier Mark "I'm lovin' it", albeit typically alongside other McDonald's branding.

49. I should be clear that I do not here refer to this evidence for the purpose of considering genuine use of McDonald's' earlier registrations (nor of course for the purpose of considering reputation, which is not claimed for these goods). My purpose in referring to this evidence at this stage is that I draw from it as the best available indication of in which goods in Class 25 might McDonald's reasonably be considered to have an interest for merchandising purposes. In addition to that evidence, I draw on my own knowledge and experience as a member of the general public, which is the relevant consumer group for the Class 25 goods. The terms I have identified for objection under section 5(3) are the types of clothing that may normally be merchandised – such as tee-shirts, sweatshirts, caps, clothes aimed at children, paper hats – or they are wider terms that would include the narrower individual goods within that category (e.g. *Clothing, footwear, headgear*). I include "footwear" since it may be at least arguable that this includes socks.

50. The reason I consider it reasonable to include within the penumbra of protection the goods I have listed in Class 9 is because goods such as *protective clothing* may be articles worn (and possibly purchased) by staff at McDonald's. With regard to goods such as *protective masks*, it seems to me that that specification may include the paper or fabric masks that were ubiquitous during the COVID pandemic; and such masks strike me as the sort of inexpensive merchandising items that may be offered at scale to the public.
51. I also consider it reasonable for the opposition to succeed in respect of the services in Class 35 concerned with the selling of those goods. Mr Howells states that by 2015 McDonald's franchisees employed approximately 1.9 million people worldwide,⁶ and I take judicial notice of the fact that the McDonald's business model operates on a franchise basis. It therefore seems to me that the section 5(3) objection should additionally succeed in respect of the applied-for services of *office functions; business administration; business advice in relation to franchising*. For those services I find that the relevant consumer group may make a mental link to the Earlier Mark. Moreover, the image of the McDonald's model may transfer, giving unfair advantage to the use of Mark 1. I do not overlook the disclaimer in Class 35 that none of the aforesaid services are to relate to advertising, marketing and promotion of restaurants, food or drinks, but in my view that disclaimer, framed as relating to marketing and promotion, does not cover with sufficient clarity the applied-for *office functions; business administration; business advice in relation to franchising*.
52. I turn next to give my reasons for finding that the section 5(3) claim succeeds only in respect of the above limited selection of goods and services.
53. The Earlier Mark has developed a strong reputation in respect of the goods and services that are core to the McDonald's business, as largely reflected in the claimed goods and services registered in Classes 29, 30, 32 and 43. However, since the Earlier Mark is a very simple slogan drawn from ordinary English usage, it is my view that the extended protection afforded by its reputation is to be properly considered with some stringency.
54. I have taken into account the high degree of similarity between the reputed Earlier Mark and Mark 1; I have acknowledged that success under section 5(3) requires neither similarity of goods and services, nor a likelihood of confusion. I have upheld the section

6 Paragraph 5 of his witness statement.

5(3) objection in respect of goods and services that are not similar, but where I find a likelihood of confusion may arise and/or where use of Mark 1 may benefit from an unfair advantage to the Applicant, resulting from the promotional expenditure and efforts by McDonald's in respect of its Earlier Marks. However, I have found it proper to include within the penumbra of protection only goods and services that the average consumer would consider McDonald's to have a commercial interest in or association with. In my view the nature of the other goods and services, and their lack of similarity to and distance from the reputed goods and services, is such that no mental link will be made and/or there is no form of consequent damage, such as in the form of an advantage that is unfair.

55. For instance, I am not convinced that there would be any link or damage in respect of cosmetics-type goods in **Class 3**.
56. In respect of **Class 9**, I have considered (i) the effect of the disclaimers (including in respect of restaurants, food and drink) in respect of software, hardware and digital goods and (ii) the potential perception of Mark 1 as referencing information technology (LOVIN IT).
57. I have also of course borne in mind (iii) the distance from the reputed goods and services, such that there is unlikely to be a mental link or consequent damage if Mark 1 were used in respect of smart watches; mobile phone cases; spectacles; sunglasses; protective goggles in Class 9. Likewise the goods in **Class 14** (e.g. jewellery) and **Class 18** (e.g. leatherware), and many of the individual items of clothing listed in **Class 25** – such as swimsuits; brassieres; cyclists' clothing; dresses and so on.
58. The applied-for **Class 35** services also include advertising and marketing, but the effect of the disclaimers (including in respect of restaurants, food and drink) is, in my view, enough to avoid a mental link and/or any consequent damage.
59. **OUTCOME:** The opposition based on section 5(3) succeeds to the extent set out in paragraph 46 above. In Annex 1, the terms underlined are those to be removed from the specification under Mark 1 (only).

Link with Mark 2

60. Although I have acknowledged that there is a high degree of aural and conceptual similarity between the reputed Earlier Mark and Mark 2 – **LOVIN IT** - I have found that the degree of visual similarity sits on the lower end of the scale – no more than a medium degree. I also take account of:
- (a) the low inherent distinctiveness of the reputed Earlier Mark (the ordinariness of the slogan “I’m lovin’ it”);
 - (b) the differences arising from the notable degree of stylisation in Mark 2 and the absent word element (“I’m”); and
 - (c) the lack of similarity between the goods and services in respect of which the Earlier Mark has a reputation (food, drink and restaurant services) and the applied-for goods and services under Mark 2 in Classes 3, 9, 14, 18, 25, 35, 41 (e.g. education services) and 42 (e.g. design services).

Taking those considerations together, I find that use of Mark 2 will not provoke a mental link to the reputed Earlier Mark and/or that there is no likelihood of confusion or of one or more of the types of consequent injury set out in section 5(3) of the Act, such as in the form of a or any advantage that is unfair (or detriment or dilution).

61. **OUTCOME:** The opposition based on section 5(3) fails in respect of Mark 2.

Link with Mark 3

62. Between the reputed Earlier Mark and Mark 3 – LIVIN IT & LOVIN IT - I have found that there is only a lower degree of similarity (no more than medium). Based on my same reasoning as for Mark 2, I find that use of Mark 3 will not provoke a mental link to the reputed Earlier Mark and/or there will be no form of consequent injury.
63. **OUTCOME:** The opposition based on section 5(3) fails in respect of Mark 3.

THE SECTION 5(4)(a) OPPOSITION CLAIM

64. I can deal with this ground relatively briefly, since I find that it can afford McDonald's no greater degree of success than it has achieved under the section 5(3) claim that I have considered in close detail above. Section 5(4)(a) of the Act states that:

"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 or law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade,"

65. It is settled law that for a successful finding of passing off, three factors must be present: goodwill, misrepresentation and damage. Her Honour Judge Melissa Clarke, sitting as Deputy Judge of the High Court, conveniently summarised the essential requirements of the law in *Jadebay Limited, Noa and Nani Limited (trading as The Discount Outlet) v Clarke-Coles Limited (trading as Feel Good UK)* [2017] EWHC 1400 IPEC

"55. The elements necessary to reach a finding of passing off are the 'classical trinity' of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341 HL) namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all these limbs.

56. In relation to deception, the court must assess whether 'a substantial number' of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21)."

66. Halsbury's Laws of England Vol. 97A (2012 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 309, it is noted (with footnotes omitted) that

"To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive feature used by the plaintiff 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 feature 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 successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court 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 plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;
- (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 confusion or 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."

Goodwill

67. The concept of goodwill was considered by the House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantages 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 distinguished an old-established business from a new business at its first start. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has the power of attraction sufficient to bring customers home to the source from which it emanates.”

68. For there to be goodwill, there must be customers in the UK. McDonald’s claims goodwill in respect of the goods and services set out in Annex 2 to this decision. The goods and services listed there include essentially the core McDonald’s goods and services, in line with those in Classes 29, 30, 32 and 43 in respect of which Ms Watkinson accepted that there had been genuine use, and for which I have found that the sign “I’m lovin’ it” has a reputation. It is clear from the evidence that McDonald’s has long enjoyed a protectable goodwill in relation to those core goods and services based on the claimed sign.
69. In addition to those core goods and services, Annex 2 includes a scattering of other goods and services for which McDonald’s claims protectable goodwill in the UK, as follows:
- *entertainment services; live entertainment events; live music events; music events*
 - *clothing, footwear*
 - *printed matter*
 - *golf putters*
70. The claim to goodwill in respect of *entertainment services; live entertainment events; live music events; music events* is based on McDonald’s having sponsored in recent years a music event branded as “I’m lovin’ it live”, and the sponsorship of the Queen’s pageant event. Ms Blythe submitted that although just two events over a three-year period, given the high-profile nature of both of those events, they suffice to generate goodwill.
71. Mr Howells explains that McDonald’s organised a concert with the name “I’m lovin’ it live”, which was a live-streamed concert held during the UK-wide lockdown in October - November 2020. The event featured well known artists such as Lewis Capaldi and Stormzy. McDonald’s worked on the project with M&C Saatchi Group (a “creative solutions agency” based in the UK), who reported that “through social media alone the

event had around 770,000 live views across the UK". Mr Howells refers to supporting Exhibits SJH20 – 24, and I include relevant extracts below:

McDonald's: I'm Lovin' It Live



McDonald's wanted to take the opportunity to give back to their customers, communities and the McFamily during an extremely difficult year.

In the driest spell for live music in history, M&C Saatchi Sport & Entertainment set about lifting the mood of the nation during the global pandemic.

12% INCREASE

In McDonald's social following

£11.4 MILLION

My McDonald's App sales

1 MILLION

app downloads with 6.9 million app visits

Giving back to the community

To drive app downloads and build advocacy amongst customers, communities and staff, we set about lifting the nation's spirits by creating a full weekend of live music with sets from the UK's biggest music stars including Oly Murs, Jess Glynne, Lewis Capaldi and Stormzy.

All performed live from iconic London club Printworks and only available through the McDonald's app, our exclusive performances captured the attention of the nation.



Bringing life back into music

3 days. 7 performances. 770,000 views.

Our digital first approach and 360 channel execution reached 90% of the population and delivered strong commercial results for McDonald's.

72. Mr Howells describes “I'm lovin' it live”, as a “once-in-a-decade live music event and won bronze award in the best integrated campaign category for the DMA Awards (data and marketing awards), the annual best in class awards covering all areas of direct marketing across the UK.”
73. The second basis for MacDonal'd's claim to have goodwill associated with the sign “I'm lovin' it” in respect of *entertainment services; live entertainment events; live music events; music events* is that it was one of the sponsors of the Queen's Platinum Jubilee Pageant,

which took place in June 2022. **Exhibit SJH-25** is presented in support of this point, which shows extracts from the advertising agency below:



McDonald's



'One's lovin' it'

We helped McDonald's celebrate the Queen's Platinum Jubilee by giving their iconic tagline a royal twist. Alongside OOH, McDonald's packaging has been recreated in china for 70 lucky fans to win, and the Royal Philharmonic Orchestra created a special performance of the famous jingle.

OOH, Press, PR



99P

Quarter Pounder® with Cheese



One's Lovin' It!

How are you celebrating the Jubilee, Andrew? Whether you're loving all the coverage, or just enjoying the extra long weekend, we've got a treat for you.

Tuck into a 99p Quarter Pounder® with Cheese* only on our app**. It's the first time in history we've had a 4-day weekend in June, so let's make the most of it!

74. I find that the evidence relating to the marking of the Jubilee does not establish goodwill for *entertainment services; live entertainment events; live music events; music event*. Its focus is squarely on McDonald's core food and restaurant interests. Moreover, it post-dates the Relevant Date (21 April 2021), when the Applicant filed its trade marks.
75. The evidence of the "I'm lovin' it live" is clearly evidence of a *live music / entertainment event*. However, as Mr Howells himself characterised it, the concert was a one-off event, so the sign has not served to draw repeat custom for those event services. The evidence shows that it was primarily a free of charge marketing exercise, to encourage downloads of the McDonald's app.
76. There is therefore significant doubt as to whether goodwill attached to the sign at all in respect of *entertainment services; live entertainment events; live music events; music events*. However, in case I am wrong on that point, I shall include those services in my further analysis of this ground.

77. With regard to *clothing, footwear and golf putters*, I find that the evidence falls hopelessly short of establishing goodwill associated with any of those goods. There is a single image (in **Exhibit SJH-19**) of a putter, listed with reference to the sign, offered for sale (in dollars) on an American website. There is no evidence of sales, let alone to UK customers. The evidence on *clothing* and *footwear* is limited to the content I discussed earlier in relation to Exhibit SJH-19 – which simply shows availability on a third-party website of a few items of clothing and socks. There is no evidence of sales to UK customers.
78. With regard to *printed matter*, I note that the evidence includes at **Exhibit SJH 17** samples of packaging featuring the sign “I’m lovin’ it”, in which customers at McDonald’s restaurants would receive their purchased food. I also note that the evidence includes at **Exhibit SJH 18** vouchers promoting MacDonal’d’s food offerings and that those vouchers also feature the sign.
79. However, to accept packaging and vouchers, or even menus, as evidence of goodwill in respect of printed matter is, in my view, to strain the concept. The printed matter is neither purchased, nor sought out by the consumer. Even if produced in-house by McDonald’s, it is incidental and secondary to the food and restaurant services, to which the business goodwill is actually attached. The sign does not bring in custom for printed matter.

Misrepresentation

80. Having found that McDonald’s has goodwill associated with the sign “I’m lovin’ it” in respect of its core food, drink and restaurant services, and allowing that it may additionally have goodwill in respect of *entertainment services; live entertainment events; live music events; music events*, I proceed to consider the question of whether use of the Applicant’s Marks 1, 2 and 3 for its applied-for goods and services, would amount to a misrepresentation, that those goods and services
81. The relevant test was set out by Morritt LJ in *Neutrogena Corporation and another v Golden Limited and another* [1996] RPC 473:

“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] RPC 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].’ [my underlining]

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 RPC. 147 at page 175; and *Re Smith Hayden's Application* (1945) 63 RPC 97 at page 101.”

82. Although they are different, the test for misrepresentation tends to have the same results as the test for confusion under trade mark law. In *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, Kitchin LJ considered the role of the average consumer in the assessment of a likelihood of confusion. Kitchin L.J. concluded:

“... if, having regard to the perceptions and expectations of the average consumer, the court concludes that a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of the court then it may properly find infringement.”

83. Although this was an infringement case, the principles apply equally under 5(2): see *Soulcycle Inc v Matalan Ltd*, [2017] EWHC 496 (Ch). In *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, Lewinson L.J. had previously cast doubt on whether the test for misrepresentation for passing off purposes came to the same thing as the test for a likelihood of confusion under trade mark law. He pointed out that it is sufficient for passing off purposes that “a substantial number” of the relevant public are deceived, which might not mean that the average consumer is confused. However, in the light of the Court of Appeal's later judgment in *Comic Enterprises*, it seems doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes. This is because they are both normative tests intended to exclude the particularly careless or careful, rather than quantitative assessments.

84. I will consider first the opposition under this ground as directed against the Applicant's Mark 1. I previously found that the section 5(3) claim defeated certain of the applied-for goods and services under Mark 1 - namely those in Class 9 (protective gear), Class 25 (clothing), Class 35 (retail services) and Class 35 *office functions; business administration; business advice in relation to franchising*. Although a likelihood of

confusion is not a requirement for success under section 5(3), it was in fact a likelihood of confusion that formed the main basis of the consequent injury that I found to sustain the section 5(3) objection, following on from the degree of similarity between Mark 1 (the plain-word sign “LOVIN IT”) and the reputed Earlier Mark “I’m lovin’ it”. Although there are notable formal differences between the section 5(4)(a) and the section 5(3) ground, there is also significant common interplay of factors in the assessment of misrepresentation, as set out in the case law at paragraph 66 above. In short, consideration of the factors at play in the section 5(4)(a) ground produces for McDonald’s approximately the same degree of success as achieved by the section 5(3) ground.

85. It achieves no greater success, even proceeding on the basis that McDonald’s enjoyed a measure of goodwill associated with the sign “I’m lovin’ it” in respect of *entertainment services; live entertainment events; live music events; music events*. In my view, there will be no misrepresentation, taking into account that any goodwill for those latter services is limited (based on a single event), the weakly distinctive nature of the sign, used alongside more distinctive signs of the McDonald’s brand, the lack of closeness between the parties’ respective fields of activity, and the effect of the disclaimers present in the applied-for goods and services. The disclaimer in Class 9 operates to exclude *audiocontent and video content in the field of restaurants, food, drink, culture and the arts to mobile and stationary consumer electronic devices*. The disclaimer in Class 35 operates to exclude from the applied-for services – including, for example, those relating to *downloadable prerecorded audio and audiovisual content and video podcasts* - any relating to *advertising, marketing and promotion of restaurants, food, drinks*.
86. **OUTCOME:** The section 5(4)(a) ground succeeds to the same extent as I found for section 5(3) (as set out in paragraph 46 above).
87. The opposition based on section 5(4)(a) is also directed against Marks 2 and 3. Those Marks have lower degrees of similarity to the claimed sign than does Mark 1, and I find that the section 5(4)(a) opposition fails for reasons in line with those set out at paragraphs 60 and 62 above. Marks 2 and 3 may therefore proceed to registration for all of the applied-for goods and services in Classes 3, 9, 14, 18, 25, 35, 41 and 42.

THE REVOCATIONS

88. I can deal relatively briefly with the applications to revoke, on the grounds of non-use, McDonald's six trade mark registrations, namely Nos. 2372555 and 2340099 (the Earlier Marks) and the four further "I'M LOVIN' IT" trade marks, Nos. 903581089, 2341398, 903224888 and 903196581.
89. My consideration of the revocation applications is simplified by various factors:
- (i) McDonald's did not defend, when filing its Forms TM8(N). Annex 3 shows those undefended terms as struck-through in black. For instance, McDonald's did not claim to have made genuine use of "I'M LOVIN' IT" in respect ~~Services rendered or associated with franchising restaurants~~ registered in Class 35 under Trade Mark No. 2341398.
 - (ii) By the date of the hearing, having taken stock of its available evidence, McDonald's no longer claimed use in respect of various specific terms, such as ~~honey, rice, tapioca~~ registered in Class 30 under Earlier Mark 2340099 and ~~Jewellery~~ in Class 14 registered under trade mark No. 903581089. Ms Blythe helpfully marked the specified terms no longer defended by way of red strike-through in an annex to her skeleton argument, as shown in Annex 3 to this decision.
 - (iii) The significant concession on the part of the Applicant, at the hearing itself, diverging from the position put forward in skeleton argument, that McDonald's had made genuine use of its earlier registrations in respect of its core business offerings in the form of food, drink and restaurant services in Classes 29, 30, 32 and 43.
 - (iv) My already having considered the evidence relating to printed matters, clothing and footwear.
90. The revocation application is made under section 46(1)(a) of the Act. The relevant legislative provisions are as follows:
- "46 Revocation of registration.
- (1) The registration of a trade mark may be revoked on any of the following grounds—

- (a) that within the period of five years following the date of completion of the registration procedure it has not 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, and there are no proper reasons for non-use;

...

- (2) For the purposes of subsection (1) 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 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.
- (3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made:

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.”

Genuine use case law principles

91. The law relating to genuine use of a registered trade mark is well established. It was summarised by Arnold LJ in *easyGroup Ltd v Nuclei Ltd & Ors*,⁷ 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*

⁷ [2023] EWCA Civ 1247, paragraph 106.

(*Trade Marks and Designs*) [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung 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. [...] 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 [...].

(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 [...].

(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 [...].

(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 [...]. Internal use by the proprietor does not suffice [...]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter [...]. But use by a non-profit making association can constitute genuine use [...].

(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 [...].

(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 [...].

(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 [...].

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

92. The relevant 5-year periods are set out in each of the filed Forms TM26(N) and cover 2005-2010. However, pursuant to section 46(3) use after the 5-year periods up until the date of the cancellation applications, being 16 August 2022, will be relevant and may establish genuine use.
93. At the hearing, the challenge on non-use remained only in respect of a very small minority of the registered goods registered under No. 903581089, limited to Class 16: *Printed matters* and Class 25: *Clothing and footwear*. I earlier rejected the claim that the sign had generated goodwill in respect of those goods. I also find that the evidence is inadequate to establish genuine use.
94. I have set out the evidence in relation to clothing and footwear. It is clearly not sufficient to establish the genuine use of the mark in the UK for those goods.

95. The evidence in relation to printed matters is richer. I fully accept that the sign will have appeared on “printed matter”, in as much as the trade mark appears (at scale and with great frequency) on goods such as packaging and vouchers, but the factors to be considered in establishing genuine use are concerned with use to create or preserve an outlet for the goods or services that bear the mark. Internal use by the proprietor does not suffice, nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter. It seems to me use of the mark on the vouchers and wrappings is to create or preserve an outlet for McDonald’s food, drinks and restaurant services – not for the boxes or paper bags containing those goods, even though those cardboard and paper goods may bear the mark.

96. OUTCOME: McDonald’s six contested trade mark registrations survive the revocation attack to the extents indicated below.

(a) UK Trade Mark No. 2372555

Intact – all goods and services in Classes 29, 30, 32 and 43 unchanged;

(b) UK Trade Mark No. 2340099

The goods in red are revoked as from five years after registration – namely 20 August 2010

Class 29: *Prepared entrees consisting primarily of pork, fish, ~~game~~ or poultry; ~~meat extracts~~; preserved, ~~dried and cooked~~ fruits ~~and vegetables~~; ~~jellies~~, jams; eggs, cheese, milk, chocolate milk, and other dairy products, dairy-based shakes; fruit preserves, pickles; ~~edible oils and fats in Class 29.~~*

Class 30: *Edible sandwiches for consumption on or off the premises, coffee, coffee substitutes, tea, cocoa, sugar, ~~honey, rice, tapioca, flour, breakfast cereals, processed cereals, cereal-based snack foods and ready to eat cereal-derived food bars~~; bread, biscuits, cakes, pastries, soft-serve ice cream ~~and frozen yogurt~~; ~~yeast, baking powder~~, salt, mustard, pepper, sauces, spices, seasonings & ice in Class 30.*

Class 32: *Soft drinks, fruit juices, fruit drinks, fruit-flavoured drinks, ~~sports drinks in the form of isotonic drinks~~; drinking water, mineral water, spring water; syrups and other preparations for making soft drinks, fruit juices, fruit drinks, fruit-flavoured drinks, ~~and sports drinks in Class 32.~~*

Class 43: *Restaurant services in Class 43.*

(c) UK Trade Mark No. 903581089

All goods – those in Classes 14, 16 and 25 - are revoked as from five years after registration – namely 31 August 2010

(d) UK Trade Mark No. 2341398

Class 29: Intact and unchanged

Class 30: Intact and unchanged

All services in Classes 35, 41, 42 are revoked as from five years after registration – namely 6 August 2010

Class 43: Intact and unchanged

(e) UK Trade Mark No. 903224888

Class 29: Intact and unchanged

Class 30: Intact and unchanged

All services in Class 42 are revoked as from five years after registration – namely 1 February 2010

(f) UK Trade Mark No. 903196581

All services in Classes 35 and 41 are revoked as from five years after registration – namely 18 March 2010

Class 43: Intact and unchanged

COSTS

97. Both parties have achieved a measure of success in these proceedings. The Applicant has succeeded in revoking only some of the contested registrations; McDonald's has succeeded in defence of a substantial part of its contested registrations. McDonald's has successfully opposed some of the goods and services applied for under Mark 1. The Applicant has succeeded in defence of the majority of its goods and services under Mark 1 and of all of the goods and services under Marks 2 and 3.
98. The Applicant has, on balance, enjoyed the greater degree of success and remains entitled to a contribution towards its costs in line with the scale set out in Tribunal Practice Notice No. 2/2016. The costs reflect the very brief nature of the Forms TM26(N) and the partial nature of the Applicant's successes. I assess these costs as follows:
- £400 for considering the Notices of Opposition and preparing a counterstatement and considering the opponent's evidence;
 - £400 contribution to the official fees the Forms TM26(N)
 - £600 for hearing preparation and attendance.
99. I therefore order McDonald's International Property Company, Ltd to pay Jana Antonia Speleers the sum of £1400. The sum should be paid within twenty-one days of the expiry of the appeal period, or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful or withdrawn.

Dated this 25th day of October 2024

Matthew Williams
For the Registrar

ANNEX 1

The goods and services under the Applicant's three contested trade marks

UK Trade Mark No. 3630165 - "LOVIN IT"

NOTE – the underlined terms are removed from Trade Mark No. 3630165, in view of the successful section 5(3) objection. The terms remain intact where they appear under the Applicant's trade mark numbers 3630194 and 3630037

Class 3

Non-medicated cosmetics and toiletry preparations; cosmetics; skincare cosmetics; body care cosmetics; cleansers; exfoliators; beauty masks; cosmetic tonics; lotions and creams; moisturising creams; sunscreen creams; hand creams; body creams; night creams; day creams; eye creams; eye washes - not for medical purposes; soaps and gels; bath and shower gels; bath preparations; bath soaps; baths salts; bath bombs; bubble baths; beauty serums; anti-ageing serums; perfumery; fragrances; incense; essential oils; hair oils; bath oils; body oils; face oils; massage oils; facial massage oils; body massage oils; essences; cleansing milk; body milk; moisturising milk; bath milk; beauty milk; makeup; makeup setting sprays; makeup foundations; concealer; lipsticks; lip gloss; lip liners; blushers; mascara; lash extensions; eye shadows; eye liner; bronzers; skin toners; highlighters (make-up); makeup primers; make-up powder; eye make-up; make-up removing preparations; make-up removers; nail cosmetics; nail care products [cosmetics]; cosmetic nail preparations; nail polish; nail varnish; nail enamels; nail gels; nail glitters; nail decolorants; nail cream; lotions for strengthening the nails; nail strengtheners; nail hardeners; nail tips; nail whiteners; nail conditioners; false nails; artificial nails; nail care preparations; nail buffing preparations; nail polish pens; nail repair preparations; gel nail removers; nail polish remover pens; nail enamel removers; nail-polish removers; nail varnish removing preparations [cosmetics]; nail primer; nail art stickers; nail polishing powder; nail polish top coat; nail polish base coat; adhesives for artificial nails; glue for strengthening nails; adhesives for fixing false nails; preparations for removing gel nails; glaze activator for strengthening nails; nail manicure products [preparations]; nail revitalising lotions [cosmetics]; nail treatment gels [cosmetics]; hair products; haircare preparations; hair cleaning preparations; hair shampoos; hair

conditioners; hair colourings; hair dyes; non-medicated dentifrices; bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; baby wipes; wipes incorporating cleaning preparations; moist wipes for sanitary and cosmetic purposes; facial wipes impregnated with cosmetics; bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations.

Class 9

Computer software, hardware and programs; mobile apps; computer software, hardware, programs and mobile apps in relation to jewellery and fashion; e-books; e-books in relation to fashion; encoded gift cards; encoded loyalty cards; computer programs; computer hardware; apparatus and instruments for recording, transmitting, reproducing or processing sound, images or data; recorded and downloadable media; downloadable and electronic publications; printed publications in electronically readable form; downloadable prerecorded audio and audiovisual content, information, and commentary; downloadable electronic books, magazines, newsletters, newspapers, journals, and other publications; downloadable digital media and recordings containing sound, images, text, information, signals or software; downloadable electronic publications of books, audio books, magazines, and journals; electronic bulletin boards; podcasts; video podcasts; webcasts; podcasts, video podcasts and webcasts in relation to fashion; electronic files; data recordings including audio, video, still and moving images and text; DVDs and other digital recording media; computer software and programmes for document creation, production, conversion, recording, indexing, archiving, printing, displaying, viewing, publishing (including electronic publishing), transmission, encryption, management, typography and distribution; sound and video recordings; sound carriers; records, discs, tapes, cassettes, cartridges, cards and other carriers, all bearing or for use in bearing sound recordings, video recordings, data, images, graphics, text, programs or information; CD-ROMs, DVDs; media content; downloadable educational media; webcasts for teaching, instruction, entertainment or educational purposes; smart watches; mobile phone cases; protective covers for smartphones; leather cases for mobile phones; leather cases for smartphones; leather cases for tablet computers; protective flip covers for mobile phones; protective flip covers for tablet computers; eyeglasses; spectacle lenses; spectacle frames; spectacle

cases; spectacles; sunglasses; protective clothing; safety clothing; masks [protective -]; anti-pollution masks for respiratory protection; dust masks; dust protective masks; filters for respiratory masks; protecting masks; protection masks; protective masks; respiratory mask filters [non-medical]; respiratory masks, other than for artificial respiration; goggles; protective goggles; dust goggles; safety goggles; none of the aforesaid goods being downloadable software in the nature of an application that provides curated and original text, audiocontent, images, photographs and video content in the field of restaurants, food, drink, recipes, current affairs, culture, the media, sports, lifestyle, weddings, property, health, dating, travel, books, and the arts to mobile and stationary consumer electronic devices.

Class 14

Precious metals and their alloys; jewellery, precious and semi-precious stones; horological and chronometric instruments; rings (jewellery); engraved and custom made jewellery, including signet rings; gold, silver, platinum signet rings; pendants; medallions; cuff links; rings with gemstones; ornaments (jewellery); necklaces; earrings; bracelets; brooches; bangles; charms (jewellery); pendants; chains of precious metals; lockets; key chains of precious metal; jewellery stones of faceted glass; jewellery travel rolls; genuine and costume jewellery; watches; watch bands, straps for wristwatches, watch straps; watch chains; watch springs; watch glasses, watch crystals; watch cases; watches; wristwatches; jewellery articles of precious metals and precious stones, and imitations thereof.

Class 18

Leather and imitations of leather; leather pouches; leather straps; leather boxes; leather shoulder belts; bags; luggage and carrying bags; cosmetic bags; handbags; shoulder bags; leather bags; travel bags; work bags; clutch bags; sports bags; gym bags; camping bags; animal carrier bags; feed bags for animals; credit card cases; pocket wallets; purses; collars, leashes and clothing for animals; clothing and costumes for animals; animal apparel; covers and wraps for animals; animal leads; animal harnesses; bits for animals; umbrellas and parasols.

Class 25

Clothing, footwear, headgear; bathing caps; berets; cap peaks; caps; hat frames; hats; headbands; headgear for wear; hoods; mantillas; shower caps, Swim Bonnet Cap; skull caps; top hats; turbans; veils; visors; wimples; aprons; ascots; babies' pants; bandanas; bath robes; bathing trunks, bathing drawers; bathing suits, swimsuits; beach clothes; belts; bibs, not of paper; boas; bodices; boxer shorts; brassieres; breeches for wear; camisoles; chasubles; clothing; clothing for gymnastics; clothing of imitations of leather; clothing of leather; coats; collars; corselets; corsets; cuffs, wristbands; cyclists' clothing; detachable collars; dress shields; dresses; dressing gowns; ear muffs; fur stoles; furs; gabardines; garters; girdles; gloves; heelpieces for stockings; hosiery; jackets; jerseys; jumper dresses, pinafore dresses; knickers, panties; knitwear; layettes; leggings; leg warmers; liveries; maniples; masquerade costumes, children costumes; mittens; money belts; motorists' clothing; muffs; neck scarves mufflers, neck scarfs; neckties; casual clothing; outerclothing; overalls, smocks; overcoats, topcoats; paper clothing; paper hats; parkas; pelerines; pelisses; petticoats; pocket squares; pockets for clothing; ponchos; pyjamas; ready-made clothing; ready-made linings [parts of clothing]; saris; sarongs; sashes for wear; scarves, scarfs; shawls; shirt fronts; shirt yokes; shirts; short-sleeve shirts; ski gloves; skirts; skorts; sleep masks; slippers; sock suspenders; socks; spats, gaiters; sports jerseys; sports singlets; stocking suspenders; stockings; stuff jackets; suits; suspenders, braces for clothing; sweat-absorbent stockings; sweat-absorbent underclothing, sweat absorbent underwear; sweaters, jumpers, teddies; tee-shirts; tights; togas; trouser straps, pants; underpants; underwear, underclothing; uniforms; waistcoats, vests; waterproof clothing; wet suits for water-skiing; footwear; bath sandals; bath slippers; beach shoes; boot uppers; boots; boots for sports; esparto shoes or sandals; fittings of metal for footwear; football shoes, football boots; footwear; footwear uppers; galoshes; gymnastic shoes; half-boots; heelpieces for footwear; heels; lace boots; non-slipping devices for footwear; sandals; shoes; ski boots; slippers; inner soles; soles for footwear; sports shoes; studs for football boots; tips for footwear; welts for footwear; wooden shoes.

Class 35

Retail, online retail, wholesale, import and export services in relation to the sale of non-medicated cosmetics and toiletry preparations, cosmetics, skincare cosmetics, body care cosmetics, cleansers, exfoliators, beauty masks, cosmetic tonics, lotions and creams, moisturising creams, sunscreen creams, hand creams, body creams, night creams, day creams, eye creams, eye washes - not for medical purposes, soaps and gels, bath and shower gels, bath preparations, bath soaps, baths salts, bath bombs, bubble baths, beauty serums, anti-ageing serums, perfumery, fragrances, incense, essential oils, hair oils, bath oils, body oils, face oils, massage oils, facial massage oils, body massage oils, essences, cleansing milk, body milk, moisturising milk, bath milk, beauty milk, makeup, makeup setting sprays, makeup foundations, concealer, lipsticks, lip gloss, lip liners, blushers, mascara, lash extensions, eye shadows, eye liner, bronzers, skin toners, highlighters (make-up), makeup primers, make-up powder, eye make-up, make-up removing preparations, make-up removers, nail cosmetics, nail care products [cosmetics], cosmetic nail preparations, nail polish, nail varnish, nail enamels, nail gels, nail glitters, nail decolorants, nail cream, lotions for strengthening the nails, nail strengtheners, nail hardeners, nail tips, nail whiteners, nail conditioners, false nails, artificial nails, nail care preparations, nail buffing preparations, nail polish pens, nail repair preparations, gel nail removers, nail polish remover pens, nail enamel removers, nail-polish removers, nail varnish removing preparations [cosmetics], nail primer, nail art stickers, nail polishing powder, nail polish top coat, nail polish base coat, adhesives for artificial nails, glue for strengthening nails, adhesives for fixing false nails, preparations for removing gel nails, glaze activator for strengthening nails, nail manicure products [preparations], nail revitalising lotions [cosmetics], nail treatment gels [cosmetics], hair products, haircare preparations, hair cleaning preparations, hair shampoos, hair conditioners, hair colourings, hair dyes, non-medicated dentifrices, bleaching preparations and other substances for laundry use, cleaning, polishing, scouring and abrasive preparations, baby wipes, wipes incorporating cleaning preparations, moist wipes for sanitary and cosmetic purposes, facial wipes impregnated with cosmetics, bleaching preparations and other substances for laundry use, cleaning, polishing, scouring and abrasive preparations, computer software, hardware and programs, mobile apps, computer software, hardware, programs and mobile apps in relation to jewellery and fashion, e-books, e-books in relation to fashion, encoded gift cards,

encoded loyalty cards, computer programs, computer hardware, apparatus and instruments for recording, transmitting, reproducing or processing sound, images or data, recorded and downloadable media, downloadable and electronic publications, printed publications in electronically readable form, downloadable prerecorded audio and audiovisual content, information, and commentary, downloadable electronic books, magazines, newsletters, newspapers, journals, and other publications, downloadable digital media and recordings containing sound, images, text, information, signals or software, downloadable electronic publications of books, audio books, magazines, and journals, electronic bulletin boards, podcasts, video podcasts, webcasts, podcasts, video podcasts and webcasts in relation to fashion, electronic files, data recordings including audio, video, still and moving images and text, DVDs and other digital recording media, computer software and programmes for document creation, production, conversion, recording, indexing, archiving, printing, displaying, viewing, publishing (including electronic publishing), transmission, encryption, management, typography and distribution, sound and video recordings, sound carriers, records, discs, tapes, cassettes, cartridges, cards and other carriers, all bearing or for use in bearing sound recordings, video recordings, data, images, graphics, text, programs or information, CD-ROMs, DVDs, media content, downloadable educational media, webcasts for teaching, instruction, entertainment or educational purposes, smart watches, mobile phone cases, protective covers for smartphones, leather cases for mobile phones, leather cases for smartphones, leather cases for tablet computers, protective flip covers for mobile phones, protective flip covers for tablet computers, eyeglasses, spectacle lenses, spectacle frames, spectacle cases, spectacles, sunglasses, protective clothing, safety clothing, masks [protective -], anti-pollution masks for respiratory protection, dust masks, dust protective masks, filters for respiratory masks, protecting masks, protection masks, protective masks, respiratory mask filters [non-medical], respiratory masks, other than for artificial respiration, goggles, protective goggles, dust goggles, safety goggles, precious metals and their alloys, jewellery, precious and semi-precious stones, horological and chronometric instruments, rings (jewellery), engraved and custom made jewellery, including signet rings, gold, silver, platinum signet rings, pendants, medallions, cuff links, rings with gemstones, ornaments (jewellery), necklaces, earrings, bracelets, brooches, bangles, charms (jewellery), pendants, chains of precious metals, lockets, key chains of precious metal, jewellery stones of faceted glass, jewellery travel rolls, genuine and costume

jewellery, watches, watch bands, straps for wristwatches, watch straps, watch chains, watch springs, watch glasses, watch crystals, watch cases, watches, wristwatches, jewellery articles of precious metals and precious stones, and imitations thereof, leather and imitations of leather, leather pouches, leather straps, leather boxes, leather shoulder belts, bags, luggage and carrying bags, cosmetic bags, handbags, shoulder bags, leather bags, travel bags, work bags, clutch bags, sports bags, gym bags, camping bags, animal carrier bags, feed bags for animals, credit card cases, pocket wallets, purses, collars, leashes and clothing for animals, clothing and costumes for animals, animal apparel, covers and wraps for animals, animal leads, animal harnesses, bits for animals, umbrellas and parasols, clothing, footwear, headgear, bathing caps, berets, cap peaks, caps, hat frames, hats, headbands, headgear for wear, hoods, mantillas, shower caps, Swim Bonnet Cap, skull caps, top hats, turbans, veils, visors, wimples, aprons, ascots, babies' pants, bandanas, bath robes, bathing trunks, bathing drawers, bathing suits, swimsuits, beach clothes, belts, bibs, not of paper, boas, bodices, boxer shorts, brassieres, breeches for wear, camisoles, chasubles, clothing, clothing for gymnastics, clothing of imitations of leather, clothing of leather, coats, collars, combinations, corselets, corsets, cuffs, wristbands, cyclists' clothing, detachable collars, dress shields, dresses, dressing gowns, ear muffs, fur stoles, furs, gabardines, garters, girdles, gloves, heelpieces for stockings, hosiery, jackets, jerseys, jumper dresses, pinafore dresses, knickers, panties, knitwear, layettes, leggings . leg warmers, liveries, maniples, masquerade costumes, children costumes, mittens, money belts, motorists' clothing, muffs, neck scarves mufflers, neck scarfs, neckties, outerclothing, overalls, smocks, overcoats, topcoats, paper clothing, paper hats, parkas, pelerines, pelisses, petticoats, pocket squares, pockets for clothing, ponchos, pyjamas, ready-made clothing, ready-made linings [parts of clothing], saris, sarongs, sashes for wear, scarves, scarfs, shawls, shirt fronts, shirt yokes, shirts, short-sleeve shirts, ski gloves, skirts, skorts, sleep masks, slippers, sock suspenders, socks, spats, gaiters, sports jerseys, sports singlets, stocking suspenders, stockings, stuff jackets, suits, suspenders, braces for clothing, sweat-absorbent stockings, sweat-absorbent underclothing, sweat absorbent underwear, sweaters, jumpers, teddies, tee-shirts, tights, togas, trouser straps, pants , underpants, underwear, underclothing, uniforms, waistcoats, vests, waterproof clothing, wet suits for water-skiing, footwear, bath sandals, bath slippers, beach shoes, boot uppers, boots, boots for sports, esparto shoes or sandals, fittings of metal for footwear, football shoes, football boots, footwear, footwear uppers, galoshes,

gymnastic shoes, half-boots, heelpieces for footwear, heels, lace boots, non-slipping devices for footwear, sandals, shoes, ski boots, slippers, inner soles, soles for footwear, sports shoes, studs for football boots, tips for footwear, welts for footwear, wooden shoes, casual clothing; advertising, marketing and promotional services; digital marketing services; office functions; business administration; business advice in relation to franchising; none of the aforesaid services relating to advertisements in connection with home interiors, wellness and cooking; none of the aforesaid services relating to advertising, marketing and promotion of restaurants, food, drinks and recipes.

UK Trade Mark No. 3630194 - LOVIN IT

The goods and services covered by 3630165 above, plus the following:

Class 41

Education; provision of training; entertainment; sporting and cultural activities; arranging and conducting of events; conferences; workshops and seminars; organisation of fashion shows for entertainment and commercial purposes; online publication of electronic books and journals; arranging and conducting of in-person educational forums in relation to fashion and jewellery; None of the aforesaid services being online information services, namely, providing information containing curated and original text, audio content, images, photographs and video content in the field of restaurants, food, drink, recipes, current affairs, culture, the media, sports, lifestyle, weddings, property, health, dating, travel, books, and the arts via a web site.

Class 42

Design services; design and quality control services; jewellery design services; clothing design services; design of clothing; design of clothing accessories; design of clothing, footwear and headgear; fashion design services; design and development of computer software; design and development of mobile application software; website design services; advisory and consultancy services relating to all the aforesaid; none of the aforesaid services being website design services, website maintenance, website creation and website hosting services.

UK Trade Mark No. 3630037 - - "LIVIN IT & LOVIN IT"

The goods and services covered by 3630194, above.

ANNEX 2

Goods and services in respect of which goodwill is claimed for section 5(4)(a)

By the hearing, McDonald's no longer relied on the terms struck-through in red

Prepared entrees consisting primarily of pork, fish, ~~game~~ or poultry; ~~meat extracts~~; preserved, ~~dried and cooked~~ fruits ~~and vegetables~~; ~~jellies~~, jams; eggs, cheese, milk, chocolate milk, and other dairy products, dairy-based shakes; fruit preserves, ~~pickles~~; ~~edible oils and fats~~.

Foods prepared from meat, pork, fish and poultry products, preserved and cooked fruits and vegetables, eggs, cheese, milk, milk preparations, ~~pickles~~, desserts.

Edible sandwiches for consumption on or off the premises, coffee, ~~coffee substitutes~~, tea, cocoa, sugar, ~~honey, rice, tapioca, flour, breakfast cereals, processed cereals, cereal-based snack foods and ready to eat cereal-derived food bars~~; bread, biscuits, cakes, pastries, soft-serve ice cream ~~and frozen yogurt~~; ~~yeast, baking powder, salt, mustard, pepper~~, sauces, spices, seasonings and ice.

Edible sandwiches, meat sandwiches, pork sandwiches, fish sandwiches, chicken sandwiches, biscuits, bread, cakes, cookies, chocolate, coffee, ~~coffee substitutes~~, tea, ~~mustard~~, oatmeal, pastries, sauces, seasonings, sugar.

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, 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.

Soft drinks, fruit juices, fruit drinks, fruit-flavoured drinks, ~~sports drinks in the form of isotonic drinks~~; drinking water, mineral water, spring water; syrups and other preparations for making soft drinks, fruit juices, fruit drinks, fruit-flavoured drinks, ~~and sports drinks~~.

~~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.

Restaurant services.

Services rendered or associated with operating restaurants and other establishments or facilities engaged in providing food and drink prepared for consumption; including the preparation and sale of carry-out foods.

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 carryout foods; Restaurant services; drive-through restaurant services.

Entertainment services; live entertainment events; live music events; ~~family fun, football and~~ music events.

Clothing, footwear ~~and headgear~~; printed matter; ~~stationery; Pins; badges; keyrings; pens; paperclips; hoodies; onesies; T-shirts; tote bags; bags; sweatshirts; jumpers; shorts; trousers; caps; hats; toys, games and playthings; trays; Headbands; vests; waistcoats~~; golf putters.

ANNEX 3

Goods and services specified under McDonald's "I'M LOVIN' IT" registrations

Terms struck-through in black: no use was claimed in the Form TM8

Terms struck-through in red: Party A no longer claimed use by the hearing

UK Trade Mark No. 2372555

Class 29

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

Class 30

Edible sandwiches, meat sandwiches, pork sandwiches, fish sandwiches, chicken sandwiches, biscuits, bread, cakes, cookies, chocolate, coffee, coffee substitutes, tea, mustard, oatmeal, pastries, sauces, seasonings, sugar.

Class 32

Non-alcoholic beverages, syrups and other preparations for making beverages.

Class 43

Services rendered or associated with operating restaurants and other establishments or facilities engaged in providing food and drink prepared for consumption; including the preparation and sale of carry-out foods.

UK Trade Mark No. 2340099

Class 29

Prepared entrees consisting primarily of pork, fish, ~~game~~ or poultry; ~~meat-extracts~~; preserved, ~~dried and cooked~~ fruits ~~and vegetables~~; ~~jellies~~, jams; eggs, cheese, milk, chocolate milk, and other dairy products, dairy-based shakes; fruit preserves, pickles; ~~edible oils and fats in Class 29.~~

Class 30

Edible sandwiches for consumption on or off the premises, coffee, coffee substitutes, tea, cocoa, sugar, ~~honey, rice, tapioca, flour, breakfast cereals, processed cereals, cereal-based snack foods and ready to eat cereal-derived food bars~~; bread, biscuits, cakes, pastries, soft-serve ice cream ~~and frozen yogurt~~; ~~yeast, baking powder~~, salt, mustard, pepper, sauces, spices, seasonings & ice in Class 30.

Class 32

Soft drinks, fruit juices, fruit drinks, fruit-flavoured drinks, ~~sports drinks in the form of isotonic drinks~~; drinking water, mineral water, spring water; syrups and other preparations for making soft drinks, fruit juices, fruit drinks, fruit-flavoured drinks, ~~and sports drinks in Class 32~~.

Class 43

Restaurant services in Class 43.

UK Trade Mark No. 903581089

Class 14

~~Jewellery, horological and chronometric instruments.~~

Class 16

Printed matters.

Class 25

Clothing, ~~headgear~~, footwear.

UK Trade Mark No. 2341398

Class 29

Food prepared from meat, pork, fish and poultry products, preserved and cooked fruits and vegetables, potatoes, eggs, cheese, milk, milk preparations, pickles and desserts.

Class 30

Sandwiches, meat sandwiches, pork sandwiches, fish sandwiches, chicken sandwiches, biscuits, bread, cakes, cookies, chocolate, coffee, coffee substitutes, tea, mustard, oatmeal, pastries, sauces, seasonings, sugar.

Class 35

~~*Services rendered or associated with franchising restaurants and other establishments or facilities engaged in providing food and drink prepared for consumption including the preparation and sale of carry-out foods.*~~

Class 41

~~*Training of persons in the management and operation of restaurants, establishments and facilities engaged in providing food and drink for consumption including the preparation and sale of carry-out foods.*~~

Class 42

~~*Designing of restaurants and other establishments or facilities engaged in providing food and drink for consumption including the preparation and sale of carry-out foods.*~~

Class 43

Services rendered or associated with operating restaurants and other establishments or facilities engaged in providing food and drink prepared for consumption including the preparation and sale of carry-out foods.

UK Trade Mark No. 903224888**Class 29**

Food prepared from meat, pork, fish and poultry products, preserved and cooked fruits and vegetables, potatoes, eggs, cheese, milk, milk preparations, pickles, desserts.

Class 30

Sandwiches, meat sandwiches, pork sandwiches, fish sandwiches, chicken sandwiches, biscuits, bread, cakes, cookies, chocolate, coffee, coffee substitutes, tea, mustard, oatmeal, pastries, sauces, seasonings, sugar.

Class 42

~~*Designing of restaurants and other establishments or facilities engaged in providing food and drink for consumption including the preparation and sale of carry-out foods.*~~

UK Trade Mark No. 903196581**Class 35**

~~*Services in the field of or relating to the franchising of restaurants and other establishments or facilities providing prepared food and drink for consumption, including the preparation and sale of takeaway food.*~~

Class 41

~~*Training of managers of restaurants or other establishments or facilities providing prepared food and drink for consumption, including preparation and sale of takeaway food.*~~

Class 43

Services in the field of or relating to the management of restaurants and other establishments or facilities providing prepared food and drink for consumption, including preparation and sale of takeaway food.