



OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET
(TRADE MARKS AND DESIGNS)

Opposition Division

OPPOSITION No B 2 386 582

McDonald's International Property Company, Ltd., 2711 Centerville Road, Suite 400, Wilmington, DE 19808, United States of America (opponent), represented by **Bardehle Pagenberg Partnerschaft mbB Patentanwälte, Rechtsanwälte**, Prinzregentenplatz 7, 81675 München, Germany (professional representative)

a g a i n s t

Supermac's (Holdings) Ltd, Ballybrit Industrial Park, Ballybrit, County Galway Galway, Ireland (applicant), represented by **Cruickshank Intellectual Property Attorneys**, 8A Sandyford Business Centre Sandyford, Dublin 18, Ireland (professional representative).

On 20/01/16, the Opposition Division takes the following

DECISION:

1. Opposition No B 2 386 582 is partially upheld, namely for the following contested goods and services:

Class 29: *Meat, fish, poultry and game; sausages; chicken nuggets; hamburgers; meat extracts; potato crisps and chips; edible oils for use in cooking foodstuffs; onion rings; dips; milk; milk shakes.*

Class 30: *Coffee; tea; cocoa; sugar; artificial coffee; drinking chocolate; cocoa products; flour and preparations made from cereals; bread; sandwiches; filled buns; sandwiches containing hamburgers; pastry; confectionery; ices; ice cream desserts; treacle; salt; mustard; pepper; vinegar; sauces (condiments); crisp rolls; crisps made of cereals; chocolate chips; sauces; flavourings, other than essential oils; chocolate-based beverages; cocoa-based beverages; coffee-based beverages; tea-based beverages; chocolate; cinnamon; condiments; cookies; custard; doughnuts; fruit pies; ice cream; iced tea; ketchup; mayonnaise; meat gravies; pizzas; salad dressings; sorbets; tartar sauce; waffles; fruit sauces.*

Class 43: *Services for providing food and drink; restaurant services; fast-food restaurant services; canteens; self-service restaurant services; takeaway services; snack-bars.*

2. Community trade mark application No 12 680 591 is rejected for all the above goods and services. It may proceed for the remaining goods.
3. Each party bears its own costs.

REASONS:

The opponent filed an opposition against all the goods and services of Community trade mark application No 12 680 591. The opposition is based on the following earlier rights:

1. Community trade mark registration No 62 497 for the word mark 'McDONALD'S';
2. Community trade mark registration No 10 392 835 for the word mark 'Mc';
3. Community trade mark registration No 5 056 429 for the word mark 'MCFISH';
4. Community trade mark registration No 4 699 054 for the word mark 'MCTOAST';
5. Community trade mark registration No 4 562 419 for the word mark 'MCMUFFIN';
6. Community trade mark registration No 1 391 663 for the word mark 'McRIB';
7. Community trade mark registration No 864 694 for the word mark 'McFLURRY';
8. Community trade mark registration No 16 196 for the word mark 'CHICKEN McNUGGETS';
9. Community trade mark registration No 62 638 for the word mark 'BIG MAC';
10. Community trade mark registration No 11 596 442 for the word mark 'McCOUNTRY';
11. Community trade mark registration No 11 205 093 for the word mark 'McBites';
12. Community trade mark registration No 11 642 519 for the word mark 'McDouble';
13. Community trade mark registration No 8 664 617 for the word mark 'McWRAP';
14. German well-known trade mark for the word mark 'McDonald's'.

The opponent invoked Article 8(1)(b) CTMR in relation to earlier rights 1-13, Article 8(2)(c) in conjunction with Article 8(1)(b) CTMR in relation to earlier right 14 and Article 8(5) CTMR in relation to earlier right 1.

LIKELIHOOD OF CONFUSION – ARTICLE 8(1)(b) CTMR

A likelihood of confusion exists if there is a risk that the public might believe that the goods or services in question, under the assumption that they bear the marks in question, come from the same undertaking or, as the case may be, from economically linked undertakings. Whether a likelihood of confusion exists depends on the appreciation in a global assessment of several factors, which are interdependent. These factors include the similarity of the signs, the similarity of the goods and services, the distinctiveness of the earlier mark, the distinctive and dominant elements of the conflicting signs and the relevant public.

1. Examination of the opposition in relation to earlier Community trade mark registration No 62 638

The opposition is based on more than one earlier trade mark. The Opposition Division finds it appropriate to first examine the opposition in relation to the opponent's Community trade mark registration No 62 638 for the word mark 'BIG MAC'.

a) The goods and services

The goods and services on which the opposition is based are the following:

Class 29: *Foods prepared from meat, pork, fish and poultry products, meat sandwiches, fish sandwiches, pork sandwiches, chicken sandwiches, preserved and cooked fruits and vegetables, eggs, cheese, milk, milk preparations, pickles, desserts.*

Class 30: *Edible sandwiches, meat sandwiches, pork sandwiches, fish sandwiches, chicken sandwiches, biscuits, bread, cakes, cookies, chocolate, coffee, coffee substitutes, tea, mustard, oatmeal, pastries, sauces, seasonings, sugar.*

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

The contested goods and services are the following:

Class 29: *Meat, fish, poultry and game; sausages; chicken nuggets; hamburgers; meat extracts; potato crisps and chips; edible oils for use in cooking foodstuffs; onion rings; dips; milk; milk shakes.*

Class 30: *Coffee; tea; cocoa; sugar; artificial coffee; drinking chocolate; cocoa products; flour and preparations made from cereals; bread; sandwiches; filled buns; sandwiches containing hamburgers; pastry; confectionery; ices; ice cream desserts; treacle; yeast; baking-powder; salt; mustard; pepper; vinegar; sauces (condiments); crisp rolls; crisps made of cereals; chocolate chips; sauces; flavourings, other than essential oils; flavourings for snack foods (other than essential oils); flavourings made from vegetables (other than essential oils); chocolate-based beverages; cocoa-based beverages; coffee-based beverages; tea-based beverages; chocolate; cinnamon; condiments; cookies; custard; doughnuts; fruit pies; ice cream; iced tea; ketchup; mayonnaise; meat gravies; pizzas; salad dressings; sorbets; tartar sauce; waffles; fruit sauces.*

Class 43: *Services for providing food and drink; restaurant services; fast-food restaurant services; canteens; self-service restaurant services; takeaway services; snack-bars.*

As a preliminary remark, it is to be noted that according to Rule 2(4) CTMIR, the Nice Classification serves purely administrative purposes. Therefore, goods or services may not be regarded as being similar or dissimilar to each other simply on the grounds that they appear in the same or different classes in the Nice Classification.

The relevant factors relating to the comparison of the goods or services include, inter alia, the nature and purpose of the goods or services, the distribution channels, the

sales outlets, the producers, the method of use and whether they are in competition with each other or complementary to each other.

Contested goods in Class 29

The contested *sausages* are finely minced meat products. The contested *chicken nuggets* are small pieces of chicken fried in batter. The contested *hamburgers* are flat fried cakes of minced beef, often served in a bread roll. All these contested goods are included in the broad category of the opponent's *foods prepared from meat*. Therefore, they are identical.

The contested *potato crisps and chips; onion rings* are included in the broad category of the opponent's *cooked vegetables*. Therefore, they are identical.

The contested *milk* is identically contained in the opponent's list of goods.

The contested *milk shakes* are included in the broad category of the opponent's *milk preparations*. Therefore, they are identical.

Game is the meat of wild animals, used as food. Therefore, it is included in the broad category of meat. The contested *meat, fish, poultry and game* are similar to a high degree to the opponent's *foods prepared from meat, fish and poultry products*. The contested goods are or can be the main ingredients of the earlier ones. These goods have the same nature and can coincide in their producers, consumers and distribution channels.

The contested *dips* are creamy mixtures into which pieces of food are dipped before being eaten. They are similar to a high degree to the opponent's *sauces* in Class 30, as they have the same purpose and method of use. Moreover, they are distributed and marketed by the same companies and are usually found next to each other in shops, target the same end users and can be substituted for each other.

The contested *edible oils for use in cooking foodstuffs* are similar to the opponent's *milk preparations*, which include butter - mostly milk fat, produced by churning cream. The goods under comparison have the same purpose. They target the same relevant public and are in competition.

The contested *meat extracts* and the opponent's *seasonings* have the same purpose: to enhance the taste and flavour of foodstuffs. They are sold through the same distribution channels, can be found in the same areas of stores and supermarkets and usually have the same commercial origin and relevant public. Furthermore, they are in competition. Therefore, they are similar.

Contested goods in Class 30

The contested *coffee; tea; sugar; bread; pastry; mustard; sauces; chocolate; cookies* are identically contained in the opponent's list of goods (including synonyms).

The contested *sandwiches*, albeit worded slightly differently, are identical to the opponent's *edible sandwiches*.

The contested *sauces (condiments)*, albeit worded slightly differently, are identical to the opponent's *sauces*.

The contested *artificial coffee*, albeit worded slightly differently, is identical to the opponent's *coffee substitutes*.

The contested *cocoa* includes the beverage, as well as the beans. The opponent's *chocolate* includes the food preparation made from roasted ground cacao seeds, as well as the drink or sweetmeat made from this. Consequently, the contested *cocoa; drinking chocolate; cocoa products; chocolate-based beverages; cocoa-based beverages* are either included in or overlap with the opponent's *chocolate*, as these categories include the drink made from cocoa. Therefore, they are identical.

The contested *sandwiches containing hamburgers* are included in the broad category of the opponent's *edible sandwiches*. Therefore, they are identical.

The contested *preparations made from cereals* include, as a broader category, the opponent's *bread*. It is impossible for the Opposition Division to filter these goods from the abovementioned category. Since the Opposition Division cannot dissect *ex officio* the broad category of the applicant's goods, they are considered identical to the opponent's goods.

The contested *filled buns; crisp rolls; doughnuts; fruit pies; waffles* are included in the broad category of the opponent's *pastries*. Therefore, they are identical.

The contested *confectionery* overlaps with the opponent's *chocolate*, as both categories include the food preparation made from roasted ground cacao seeds, usually sweetened and flavoured. Therefore, they are identical.

The contested *pepper; cinnamon* are included in the broad category of the opponent's *seasonings*. Therefore, they are identical.

The contested *chocolate chips* are small chunks of chocolate. These goods are included in the broad category of the opponent's *chocolate*. Therefore, they are identical.

The contested *coffee-based beverages* are included in the broad category of the opponent's *coffee*. Therefore, they are identical.

The contested *tea-based beverages; iced tea* are included in the broad category of the opponent's *tea*. Therefore, they are identical.

The contested *condiments* include, as a broader category, the opponent's *sauces*. It is impossible for the Opposition Division to filter these goods from the abovementioned category. Since the Opposition Division cannot dissect *ex officio* the broad category of the applicant's goods, they are considered identical to the opponent's goods.

The contested *ketchup; mayonnaise; meat gravies; salad dressings; tartar sauce; fruit sauces* are included in the broad category of the opponent's *sauces*. Therefore, they are identical.

Ices are to be understood as 'edible ices'. The contested *ices; ice cream desserts; ice cream; sorbets* have certain connections with the opponent's *milk preparations* in Class 29, which include goods such as frozen yogurts. These goods have a similar purpose and nature as they are or include frozen desserts; they are also commonly produced by the same companies. Furthermore, these goods target the same

relevant public and are sold through the same distribution channels. Accordingly, they are in competition. Therefore, they are similar to a high degree.

The contested *salt* and the opponent's *seasonings* have the same purpose, namely flavouring food, and they target the same consumers. They coincide in producers and distribution channels. Therefore, they are similar to a high degree.

The contested *vinegar* and the opponent's *sauces* have the same purpose, namely to add flavour to food or stimulate the appetite. They coincide in producers, consumers and distribution channels. Furthermore, they are in competition. Therefore, they are highly similar.

The contested *treacle* and the opponent's *sugar* coincide in consumers and distribution channels. Furthermore, they are in competition, as they are both used as sweeteners. Therefore, they are similar.

The contested *pizzas* and the opponent's *edible sandwiches* have the same nature (being savoury snacks) and purpose. They target the same consumers, can be distributed through the same channels of trade and are in competition. Therefore, they are similar.

The contested *flour* has certain connections with the opponent's *oatmeal*, which is a substance made from ground oats, used in porridge, oatcakes, oatmeal cookies or other food, or as an accent, as in the topping on many oat bran breads. The goods under comparison have similar nature (being cereal preparations) and may coincide in their purpose, as they may be used as the main ingredients in bakery goods, such as bread and pastries. They target the same consumers and have the same channels of trade. Therefore, they are similar to a low degree.

The contested *crisps made of cereals; custard* and the opponent's *biscuits* coincide in consumers and distribution channels. Furthermore, they are in competition, as the consumers may choose between them to satisfy the same need (that of making a dessert). Therefore, they are similar to a low degree.

The contested *flavourings, other than essential oils* may include, for example, coffee flavourings. These goods and the opponent's *coffee* may have the same purpose and method of use, as both may be used to give a coffee flavour to other foodstuffs or beverages. Therefore, they are similar to a low degree.

The contested *yeast; baking-powder* are dissimilar to the opponent's goods in Classes 29 and 30. It is true that the contested goods are ingredients used in the process of preparation of some of the foodstuffs covered by the opponent's goods in Classes 29 and 30. However, this is not sufficient for a finding of similarity between the goods under comparison. They have different nature, purposes and methods of use. They come from different producers and can be found in different sections in supermarkets.

As regards the contested *flavourings for snack foods (other than essential oils); flavourings made from vegetables (other than essential oils)*, these goods are also dissimilar to the opponent's goods in Classes 29 and 30. The goods under comparison have different commercial origin and different nature, purposes and methods of use. The contested goods serve specific purposes and, in principle, target specialised public, namely companies operating in the food industry, which is different from the public of the opponent's goods.

The abovementioned *yeast; baking-powder; flavourings for snack foods (other than essential oils); flavourings made from vegetables (other than essential oils)* are even more removed from the opponent's services in Class 42. Apart from being different in nature from the contested goods, given that services are intangible whereas goods are tangible, the opponent's services serve different needs. The purpose and method of use of these goods and services are different. They do not have the same distribution channels and they are not in competition. Therefore, they are dissimilar.

Contested services in Class 43

Restaurants are eating establishments at which food and drinks are prepared and served to customers in exchange for money. Meals are generally served and eaten on premises, but many restaurants also offer take-out and food delivery services.

The contested *services for providing food and drink; restaurant services; fast-food restaurant services; canteens; self-service restaurant services; takeaway services; snack-bars* include, as broader categories, or overlap with, the opponent's *preparation of carry-out foods* (classified in Class 42 in the seventh edition of the Nice Classification in force at the time when the filing of the earlier mark was made). Since the Opposition Division cannot dissect *ex officio* the broad categories of the contested services, they are considered identical to the opponent's services.

b) The signs

BIG MAC	SUPERMAC'S
Earlier trade mark	Contested sign

The relevant territory is the European Union.

The unitary character of the Community trade mark means that an earlier Community trade mark can be relied on in opposition proceedings against any application for registration of a Community trade mark that would adversely affect the protection of the first mark, even if only in relation to the perception of consumers in part of the European Union (judgment of 08/09/2008, C514/06 P 'Armacell', paragraph 57). Therefore, a likelihood of confusion for only part of the relevant public of the European Union is sufficient to reject the contested application. In the present case, the Opposition Division finds it appropriate to focus the comparison of the signs on the English-speaking part of the relevant public.

Visually, the signs are similar to the extent that they coincide in the sequence of letters 'MAC', which constitutes the second word of the earlier mark and is included in the contested sign. On the other hand, they differ in the first word of the earlier mark, 'BIG', and the remaining letters in the beginning of the verbal element of the contested sign, 'SUPER', as well as in the apostrophe and last letter 'S' in the contested sign.

Aurally, the pronunciation of the signs coincides in the sound of the letters 'MAC' present identically in both signs, and to that extent the signs are aurally similar. The pronunciation differs in the sound of the initial letters of the marks, 'BIG' in the earlier mark and 'SUPER' in the contested sign, and in the sound of the additional letter 'S' at the end of the contested sign.

Conceptually, the word 'BIG' of the earlier mark will be perceived by the relevant English-speaking public as referring to something 'of great or considerable size, height, weight, number, power, or capacity', 'having great significance; important' or 'important through having power, influence, wealth, authority, etc.' (Collins English Dictionary online, <http://www.collinsdictionary.com/dictionary/english/big>).

The verbal element 'MAC' is usually used as a prefix in surnames of Scottish or Irish Gaelic origin to denote 'son of'. In the present case, where this element is not used as a prefix, the relevant public may perceive it as a male given name or a nickname of any longer Mac or Mc starting name such as McCoy or Macalister.

Regarding the contested sign, the Court has held that, although the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details when perceiving a word sign, they will break it down into elements that, for them, suggest a specific meaning or that resemble words known to them (judgment of 13/02/2007, T256/04, 'Respicur', paragraph 57). The conjoined expression 'SUPERMAC', as a whole, has no meaning for the relevant public and does not exist in common parlance. Therefore, it is reasonable to assume that relevant consumers will perceive this term as the mere sum of its parts, splitting it into the words 'SUPER' and 'MAC'.

The word 'MAC' has been analysed above. The word 'SUPER' will be perceived by the relevant English-speaking public as 'outstanding; exceptionally fine' or as a prefix meaning 'of greater size, extent, quality, etc. (e.g. 'supermarket') (Collins English Dictionary online, <http://www.collinsdictionary.com/dictionary/english/big>). The apostrophe and the letter 'S' which follow the element 'SUPERMAC' will be understood as the possessive ending which is used in the English language to indicate the genitive case.

To the extent that both marks contain the element 'MAC', which may be perceived as a name or a nickname, the marks are conceptually similar. Furthermore, to the extent that both marks may be perceived as containing references to great or considerable size, they are also conceptually similar in that they refer to quantitative indicators.

Taking into account the abovementioned visual, aural and conceptual coincidences, the signs under comparison are similar.

c) Distinctive and dominant elements of the signs

In determining the existence of likelihood of confusion, the comparison of the conflicting signs must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components.

The element 'BIG' of the earlier mark will be associated with the size or the significance of something. Bearing in mind that the relevant goods and services in Classes 29, 30 and 43 are related to foodstuff that could be sold in different sizes, it is considered that this element is weak for these goods and services.

The element 'SUPER' of the contested sign will be understood as something outstanding or exceptionally fine or as something of greater size, extent, quality, etc. This element is considered to be weak for all the relevant goods and services in Classes 29, 30 and 43, as it may be perceived as a mere reference to their quality or size.

The public understands the meaning of these elements and will not pay as much attention to these weak elements as to the other more distinctive elements of the marks. Consequently, the impact of these elements is limited when assessing the likelihood of confusion between the marks at issue. This finding is true regardless of the fact that the expressions 'BIG MAC' and 'SUPERMAC'S' form conceptual units.

The marks under comparison have no elements which could be considered clearly more dominant (visually eye-catching) than other elements.

d) Distinctiveness of the earlier mark

The distinctiveness of the earlier mark is one of the factors to be taken into account in the global assessment of likelihood of confusion.

The opponent did not explicitly claim that its mark is particularly distinctive by virtue of intensive use or reputation.

Consequently, the assessment of the distinctiveness of the earlier mark will rest on its distinctiveness per se. In the present case, the earlier trade mark as a whole has no meaning for any of the goods and services in question from the perspective of the public in the relevant territory. Therefore, the distinctiveness of the earlier mark must be seen as normal, despite the presence of a weak element in the mark as stated above in section c) of this decision.

e) Relevant public – degree of attention

The average consumer of the category of products concerned is deemed to be reasonably well informed and reasonably observant and circumspect. It should also be borne in mind that the average consumer's degree of attention is likely to vary according to the category of goods or services in question.

In the present case, the goods and services found to be identical or similar (to different degrees) are directed at the public at large. The degree of attention is deemed to be average.

f) Global assessment, other arguments and conclusion

The goods and services under comparison are partly identical, partly similar (to different degrees) and partly dissimilar.

The signs under comparison are similar to the extent that the second element 'MAC' of the earlier mark is identically contained at the second position in the contested sign. The signs differ as a result of their additional words/letters.

According to the case-law of the Court of Justice, in determining the existence of likelihood of confusion, trade marks have to be compared by making an overall assessment of the visual, aural and conceptual similarities between the marks. The comparison 'must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components' (judgment of 11/11/1997, C251/95, 'Sabèl', paragraph 22 et seq.).

As seen above in sections b) and c), the relevant English-speaking public will promptly grasp the meaning of the initial word 'BIG' of the earlier mark and the initial letters 'SUPER' of the contested sign and will not pay particular attention to them because they are weak in relation to the goods and services in question and may refer to their size or quality. Therefore, consumers will focus their attention on the other, more distinctive, elements of the marks, 'MAC' in the earlier mark and 'MAC'S' in the contested sign, which are fully distinctive for all the relevant goods and services and play independent distinctive roles in the marks.

Moreover, the presence of the element 'MAC' in both marks may be perceived as a name or a nickname and may establish a conceptual link between the signs. The adjectives 'BIG' in the earlier mark and 'SUPER' in the contested sign do not suffice to differentiate the marks conceptually, since they simply qualify the object 'MAC' in a positive light, especially considering that both may be perceived as referring to the size of the object, thus also linking the marks on a conceptual level.

Therefore, considering that average consumers rarely have the chance to make a direct comparison between different marks, but must trust in their imperfect recollection of them, the Opposition Division considers that the similarities between the marks are sufficient to result in a likelihood of confusion, including a likelihood of association between the marks in the relevant territory.

Article 8(1)(b) CTMR states that, upon opposition, a CTM application shall not be registered 'if because of its identity with or similarity to the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected; the likelihood of confusion includes the likelihood of association with the earlier trade mark'. Indeed, in the present case, consumers may legitimately believe that the contested mark, 'SUPERMAC'S', is a new version or a brand variation of the earlier trade mark, 'BIG MAC', that is, that the contested mark is used by the opponent to identify a specific line of goods or services which are of a high quality, outstanding or exceptionally fine. Consequently, they would assume that the respective goods and services come from the same undertaking or from economically-linked undertakings. In other words, consumers may confuse the origins of the conflicting goods.

In its observations the applicant argues that its trade mark 'SUPERMAC'S' has been used extensively and continuously and the way in which it has been used (as a figurative mark) is an indicator of a different commercial origin from that of the opponent's goods and services. Therefore, it considers this to be sufficient to prevent the public from establishing a link between the marks. The applicant filed various pieces of evidence to prove use of its trade mark and substantiate this claim.

In this regard, it should be noted that the right to a CTM begins on the date when the CTM is filed and not before, and from that date on the CTM has to be examined with regard to opposition proceedings.

Therefore, when considering whether or not the CTM falls under any of the relative grounds for refusal, events or facts which happened before the filing date of the CTM are irrelevant because the rights of the opponent, insofar as they predate the CTM, are earlier than the applicant's CTM.

Considering all the above, the Opposition Division finds that there is a likelihood of confusion for the English-speaking part of the public in the European Union. As stated above in section b) of this decision, a likelihood of confusion for only part of

the relevant public of the European Union is sufficient to reject the contested application.

Therefore, the opposition is partially well founded on the basis of the opponent's Community trade mark registration No 62 638.

It follows from the above that the contested trade mark must be rejected for the goods and services found to be identical or similar (to different degrees) to those of the earlier trade mark.

The rest of the contested goods are dissimilar. As similarity of goods and services is a necessary condition for the application of Article 8(1) CTMR, the opposition based on this article and directed at these goods cannot be successful.

Consequently, the examination continues in relation to the remaining earlier rights invoked under Article 8(1)(b) CTMR.

2. Examination of the opposition in relation to earlier Community trade mark registrations No 62 497, No 10 392 835, No 5 056 429, No 4 699 054, No 4 562 419, No 1 391 663, No 864 694, No 16 196, No 11 596 442, No 11 205 093, No 11 642 519 and No 8 664 617.

a) The goods and services

The goods and services on which the opposition is based are the following:

Community trade mark registration No 62 497:

Class 25: *Clothing, headwear and footwear.*

Class 28: *Toys, games and playthings.*

Class 29: *Foods prepared from meat, pork, fish and poultry products, meat sandwiches, fish sandwiches, pork sandwiches, chicken sandwiches, preserved and cooked fruits and vegetables, eggs, cheese, milk, milk preparations, pickles, desserts.*

Class 30: *Edible sandwiches, meat sandwiches, pork sandwiches, fish sandwiches, chicken sandwiches, biscuits, bread, cakes, cookies, chocolate, coffee, coffee substitutes, tea, mustard, oatmeal, pastries, sauces, seasonings, sugar.*

Class 31: *Fresh fruits and vegetables.*

Class 32: *Non-alcoholic beverages, syrups and other preparations for making beverages.*

Class 35: *Publishing services for restaurants.*

Class 41: *Publishing of course material for the management of restaurants. The training of persons in the management and operation of such restaurants, establishments and facilities for others.*

Class 42: *Services rendered or associated with operating and franchising restaurants and other establishment or facilities engaged in providing food and drink*

prepared for consumption and for drive- through facilities; preparation and provision of carry-out foods; the designing of such restaurants, establishments and facilities for others; construction planning and construction consulting for restaurants for others.

Community trade mark registration No 10 392 835:

Class 29: *Foods prepared from meat, pork, fish and poultry products, preserved and cooked fruits and vegetables, eggs, cheese, milk, milk preparations, pickles.*

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; desserts.*

Class 32: *Non-alcoholic beverages, syrups and other preparations for making beverages.*

Class 43: *Restaurant services.*

Community trade mark registration No 5 056 429:

Class 29: *Foods prepared from meat, pork, fish and poultry products, preserved and cooked fruits and vegetables, eggs, cheese, milk, milk preparations, pickles.*

Class 30: *Edible sandwiches, meat sandwiches, pork sandwiches, fish sandwiches, chicken sandwiches, biscuits, breads, cakes, cookies, chocolate, coffee, coffee substitutes, tea, mustard, oatmeal, pastries, sauces, seasonings, sugar; desserts.*

Community trade mark registration No 4 699 054:

Class 29: *Foods prepared from meat, pork, fish and poultry products, preserved and cooked fruits and vegetables, eggs, cheese, milk, milk preparations, pickles.*

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; desserts.*

Class 43: *Restaurant services.*

Community trade mark registration No 4 562 419:

Class 29: *Food prepared from meat, pork, and poultry products, eggs and cheese.*

Class 30: *Edible sandwiches, meat sandwiches, pork sandwiches, egg sandwiches, muffins, biscuits and sauces.*

Class 43: *Restaurant services.*

Community trade mark registration No 1 391 663:

Class 29: *Food made from meat, pork, fish and poultry products, preserved and cooked fruits and vegetables, eggs, cheese, milk, milk products, pickles, desserts.*

Class 30: *Sandwiches, meat sandwiches, pork sandwiches, fish sandwiches, chicken sandwiches, biscuits, bread, cakes, chocolate, coffee, artificial coffee, tea, mustard, oatmeal, pastry, sauces, spices, sugar.*

Community trade mark registration No 864 694:

Class 29: *Dairy based dessert products.*

Community trade mark registration No 16 196:

Class 29: *Foods prepared from meat, pork, fish and poultry products, meat sandwiches, fish sandwiches, pork sandwiches, chicken sandwiches, preserved and cooked fruits and vegetables, eggs, cheese, milk, milk preparations, pickles, desserts.*

Community trade mark registrations No 11 596 442 and No 11 205 093:

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 43: *Restaurant Services.*

Community trade mark registration No 11 642 519:

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.*

Community trade mark registration No 8 664 617:

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 43: *Restaurant services for the provision of carry-out food.*

The remaining contested goods, for which the opposition is not successful on the basis of Community trade mark registration No 62 638 examined above, are the following:

Class 30: *Yeast; baking-powder; flavourings for snack foods (other than essential oils); flavourings made from vegetables (other than essential oils).*

The relevant factors relating to the comparison of the goods or services include, inter alia, the nature and purpose of the goods or services, the distribution channels, the

sales outlets, the producers, the method of use and whether they are in competition with each other or complementary to each other.

Contested goods in Class 30

The goods of the abovementioned earlier marks generally cover various foodstuffs in Classes 29 and 30 and services of provision of food and drinks and other services in Class 42/43 (which have already been compared above in section 1, in relation to the comparison of the contested mark with earlier Community trade mark registration No 62 638), fresh fruits and vegetables in Class 31, non-alcoholic beverages and preparations for such in Class 32, as well as clothing in Class 25, toys and games in Class 28 and publishing and training services in Classes 41 and 42.

The contested *yeast; baking-powder; flavourings for snack foods (other than essential oils); flavourings made from vegetables (other than essential oils)* are specific products which do not have points of contact with the goods and services of the opponent. Although some of them are foodstuffs or ingredients for foodstuffs, this is not sufficient for a finding of similarity between them. They have different nature, purposes and methods of use. They come from different producers and some of them target different relevant public. They are not strictly complementary and are not in competition. Therefore, they are dissimilar.

b) Conclusion

According to Article 8(1)(b) CTMR, the similarity of the goods or services is a condition for a finding of likelihood of confusion. Since the goods and services are clearly dissimilar, one of the necessary conditions of Article 8(1)(b) CTMR is not fulfilled, and the opposition must be rejected insofar as it is based on earlier Community trade mark registrations No 62 497, No 10 392 835, No 5 056 429, No 4 699 054, No 4 562 419, No 1 391 663, No 864 694, No 16 196, No 11 596 442, No 11 205 093, No 11 642 519 and No 8 664 617.

EARLIER WELL-KNOWN MARK – ARTICLE 8(2)(C) CTMR IN CONJUNCTION WITH ARTICLE 8(1)(b) CTMR

In its notice of opposition, the opponent claims to have a well-known mark in the sense of Article 6bis of the Paris Convention for the word mark 'McDonald's' in Germany in relation to the following goods and services:

Class 29: *Foods prepared from meat, pork, fish and poultry products, meat sandwiches, fish sandwiches, pork sandwiches, chicken sandwiches, preserved and cooked fruits and vegetables, eggs, cheese, milk, milk preparations, pickles, desserts.*

Class 30: *Edible sandwiches, meat sandwiches, pork sandwiches, fish sandwiches, chicken sandwiches, biscuits, bread, cakes, cookies, chocolate, coffee, coffee substitutes, tea, mustard, oatmeal, pastries, sauces, seasonings, spices, sugar.*

Class 42: *Restaurant services.*

According to Article 8(2)(c) CTMR, for the purposes of Article 8(1) CTMR 'earlier trade marks' means:

trade marks which, on the date of application for registration of the Community trade mark, or, where appropriate, of the priority claimed in respect of the application for registration of the Community trade mark, are well known in a Member State in the sense in which the words 'well known' are used in Article 6bis of the Paris Convention.

Article 8(2)(c) CTMR, in general, defines the earlier trade mark only 'for the purposes of paragraph 1' and, therefore, does not provide an independent relative ground for refusal. Thus, the grounds for refusal and opposition are those provided by Article 8(1)(b) CTMR.

In order for Article 8(2)(c) CTMR in conjunction with Article 8(1)(b) CTMR to be applicable, the following has to be established:

- a) the earlier mark was well-known in the relevant territory on the date when the contested CTM application was filed and
- b) because of identity with or similarity of the contested mark to the earlier well known mark and the identity or similarity of the goods or services covered by the trade marks, there exists a likelihood of confusion on the part of the public in the relevant territory.

With regard to the second requirement, these are all the conditions that have to be fulfilled to render Article 8(1)(b) CTMR applicable, namely identity or similarity between the conflicting signs and identity or similarity between the goods or services covered by the signs, and a consequent likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected.

As stated above, no likelihood of confusion exists for the contested *yeast; baking-powder; flavourings for snack foods (other than essential oils); flavourings made from vegetables (other than essential oils)* in Class 30 with respect to Community trade mark registrations No 62 638, No 62 497, No 10 392 835, No 5 056 429, No 4 699 054, No 4 562 419, No 1 391 663, No 864 694, No 16 196, No 11 596 442, No 11 205 093, No 11 642 519 and No 8 664 617 as examined under Article 8(1)(b) CTMR above, due to dissimilarity between the goods and services. Since those marks cover the same or a broader scope of goods and services as the well-known right under examination, one of the necessary conditions for Article 8(2)(c) CTMR in conjunction with Article 8(1)(b) CTMR to be applicable is not fulfilled, that is identity or similarity between the goods and services.

The opposition must, therefore, be rejected also insofar as it is based on Article 8(2)(c) in conjunction with Article 8(1)(b) CTMR for the unregistered word mark 'McDonald's' well-known in Germany.

REPUTATION – ARTICLE 8(5) CTMR

The opponent invoked Article 8(5) CTMR in relation to earlier Community trade mark No 62 497 for the word mark 'McDONALD'S', for which the opponent claimed reputation in the European Union.

According to Article 8(5) CTMR, upon opposition by the proprietor of an earlier trade mark within the meaning of Article 8(2) CTMR, the contested trade mark shall not be registered where it is identical with, or similar to, the earlier trade mark and is to be

registered for goods or services which are not similar to those for which the earlier trade mark is registered, where, in the case of an earlier Community trade mark, the trade mark has a reputation in the Community and, in the case of an earlier national trade mark, the trade mark has a reputation in the Member State concerned and where the use without due cause of the contested trade mark would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

Therefore, the grounds of refusal of Article 8(5) CTMR are only applicable when the following conditions are met.

- The signs must be either identical or similar.
- The opponent's trade mark must have a reputation. The reputation must also be prior to the filing of the contested trade mark; it must exist in the territory concerned and for the goods and/or services on which the opposition is based.
- Risk of injury: the use of the contested trade mark would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.

The abovementioned requirements are cumulative and, therefore, the absence of any one of them will lead to the rejection of the opposition under Article 8(5) CTMR (judgment of 16/12/2010, joined cases T345/08 and T357/08, 'BOTOCYL', paragraph 41). However, the fulfilment of all the abovementioned conditions may not be sufficient. The opposition may still fail if the applicant establishes due cause for the use of the contested trade mark.

In the present case, the applicant claims to have due cause for using the contested mark. The applicant's claim will need to be examined only if the three abovementioned conditions are met (judgment of 22/03/2007, T-215/03, 'VIPS', paragraph 60). Therefore, the Opposition Division will only deal with this issue, if still necessary, at the end of the decision.

a) **The signs**

McDONALD'S	SUPERMAC'S
Earlier trade mark	Contested sign

The relevant territory is the European Union.

Visually, the signs are similar to the extent that they coincide in the letters 'M' and 'C', located at the beginning of the earlier mark and at the sixth and eighth position in the contested sign, as well as in the apostrophe and the letter 'S' at the end of both marks. However, the marks differ in the additional letters, 'DONALD' in the earlier mark and 'SUPER' and 'A' in the contested sign, and in the location of these letters and overall structure of the marks.

Aurally, irrespective of the different pronunciation rules in different parts of the relevant territory the pronunciation of the marks coincides in the sound of the letters 'MC' / 'MAC' and the last letter 'S', present in both signs, as the letters 'MC' at the beginning of the earlier mark will be recognised by the majority of the public as a prefix of Scottish and Irish surnames and will be pronounced the same way as the letters 'MAC' in the contested sign. To that extent the marks are aurally similar.

The pronunciation differs in the sound of the letters 'DONALD' in the earlier mark and 'SUPER' in the contested sign and in the fact that the coinciding letters of the signs have different positioning within the marks.

Conceptually, the verbal element 'Mc' in the earlier mark stands for the frequent patronymic prefix of traditional Scottish and Irish surnames, which is considered to be known by the majority of the relevant public, including the non-English speaking part of the public, given the great amount of famous persons or firms having a (sur)name starting with that prefix such as Shirley McLane, Elle McPherson, Paul McCartney, Andie MacDowell, John McEnroe, Baker & McKenzie, McLaren Automotive, McKinsey & Company Inc.

The prefix in the opponent's sign is followed by the common name 'Donald', which together with the prefix 'Mc' will be perceived as a surname of Scottish or Irish Gaelic origin.

The conjoined expression 'SUPERMAC', as a whole, has no meaning for the relevant public and does not exist in common parlance. Therefore, it is reasonable to assume that relevant consumers will perceive this term as the mere sum of its parts, splitting it into the words 'SUPER' and 'MAC'.

The verbal element 'MAC' is usually used as a prefix in surnames of Scottish or Irish Gaelic origin to denote 'son of'. In the present case, where this element is not used as a prefix, part of the relevant public may perceive it as a male given name or a nickname of any longer Mac or Mc starting name such as McCoy or Macalister. Moreover, the Irish-speaking public will understand that element as 'son of'. For the rest of the public, the verbal element 'MAC' will not be associated with any meaning.

The word 'SUPER' will be perceived by the relevant public as 'outstanding; exceptionally fine' or as a prefix meaning 'of greater size, extent, quality, etc.', because it is a somewhat basic English word which is commonly used throughout the European Union.

The apostrophe and the letter 'S' which follow the verbal elements of the signs under comparison will be understood at least by the English-speaking public as the possessive ending which is used in the English language to indicate the genitive case.

Since the signs will be associated with different meanings, the signs are not conceptually similar.

Taking into account the abovementioned visual and aural coincidences, the signs under comparison are similar only to a certain degree.

b) Reputation of the earlier trade mark

According to the opponent, the earlier Community trade mark No 62 497 has a reputation in the European Union for all the goods and services for which it is registered.

Reputation implies a knowledge threshold which is reached only when the earlier mark is known by a significant part of the relevant public for the goods or services it covers. The relevant public is, depending on the goods or services marketed, either the public at large or a more specialised public.

In the present case the contested trade mark was filed on 11/03/2014. Therefore, the opponent was required to prove that the trade mark on which the opposition is based had acquired a reputation in the European Union prior to that date. The evidence must also show that the reputation was acquired for the goods and services for which the opponent has claimed reputation, namely:

Class 25: *Clothing, headwear and footwear.*

Class 28: *Toys, games and playthings.*

Class 29: *Foods prepared from meat, pork, fish and poultry products, meat sandwiches, fish sandwiches, pork sandwiches, chicken sandwiches, preserved and cooked fruits and vegetables, eggs, cheese, milk, milk preparations, pickles, desserts.*

Class 30: *Edible sandwiches, meat sandwiches, pork sandwiches, fish sandwiches, chicken sandwiches, biscuits, bread, cakes, cookies, chocolate, coffee, coffee substitutes, tea, mustard, oatmeal, pastries, sauces, seasonings, sugar.*

Class 31: *Fresh fruits and vegetables.*

Class 32: *Non-alcoholic beverages, syrups and other preparations for making beverages.*

Class 35: *Publishing services for restaurants.*

Class 41: *Publishing of course material for the management of restaurants. The training of persons in the management and operation of such restaurants, establishments and facilities for others.*

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

In order to determine the mark's level of reputation, all the relevant facts of the case must be taken into consideration, including, in particular, the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

On 06/02/2015 the opponent submitted the following evidence:

- Annex 1: An extract from a Wikipedia article 'History of McDonald's' printed on 21/01/2015, according to which McDonald's has been using its mark in connection with the sale of food products since at least 1971, when the first restaurants were opened in Germany and the Netherlands. Furthermore, other restaurants followed shortly in France (1972), Sweden (1973) and the UK (1974).
- Annex 2: Financial highlights from one of the opponent's web pages (www.aboutmcdonalds.com) printed on 21/01/2015. It is mentioned that there are at least one or more restaurants in each of the Member States of the European Union at the end of 2008 and 2013. In 2013, the restaurants numbered 1 468 in Germany, 1 298 in France and 1 222 in the UK.
- Annex 3: An extract from the website www.mcdonalds.de, 'Stand 31/12/2011', with translation in English. The document states that the net turnover of McDonald's Deutschland Inc. for 2011 was EUR 3.195 billion and that 2.76 million customers frequented its restaurants.
- Annex 4: Extracts from the opponent's annual report of 2013. According to this document, McDonald's serves around 70 million customers daily in more than 100 countries across more than 35,000 restaurants around the world. It states that the amount of annual revenue in Europe from 2011 to 2013 has increased from 7 852 million dollars in 2011 to 8 138 million dollars in 2013.
- Annex 5: A Wikipedia extract printed on 21/01/2015 referring to the McDonald's Monopoly game which is a sweepstakes sales promotion of McDonald's and Hasbro, using the theme of the latter's board game Monopoly. The promotion has been offered for the first time in 1987 and has been offered under several variations in, among others, Austria, France, Germany, the Netherlands, Poland, Portugal, Romania, Spain and the United Kingdom.
- Annex 6: An extract from the FIFA website (www.fifa.com) printed on 21/01/2015. It contains articles dated 24/10/2014 and 08/07/2006 indicating that the opponent has been the Official Partner of the FIFA World Cup since 1994 and will be Official Partner for the FIFA World Cup events in 2014, 2018 and 2022.
- Annex 7: A press release from 2012 and a website extract from www.olympics.org showing that McDonald's has been supporting the Olympic Games since 1968.
- Annex 8: An article from ITMA news, dated December 1996, indicating that according to the latest edition of 'The World Greatest Brands' published by Interbrand on 13/11/1996, McDonald's has taken over from Coca Cola as the world's top brand.
- Annex 9: A list of national and Community trade marks in the opponent's name all containing the verbal element 'McDonald's' or 'McDonald'.
- Annex 10: Printouts from various McDonald's websites in the member states of the European Union printed on 21/01/2015. The documents show different products named, inter alia, 'Big Mac', 'McDouble', 'McMorning', 'McFreeze',

'McMenu', 'McSundae', 'McToast', 'McBacon', 'McMuffin', 'McChicken', 'McNuggets', 'McRoyal', 'McFish', 'McBites', 'McWrap', 'McCafé', 'McKroket', 'McRib', 'McFlurry', 'McPioner', 'McFarm', 'McFarmer', 'McDo', 'McPuişor'.

- Annex 11: Samples of advertising, menus with products and packaging dated between 2007 and 2010 used in various member states of the European Union (Germany, the United Kingdom and France), in which some of the goods are identified by the prefix 'Mc' followed by a name or a word characterising the product in question, for example: McDonald's, Chicken McNuggets, McChicken, McRib, McFlurry, McMuffin and McMenu.
- Annex 12: Publications by Interbrand and extracts from the webpage of Interbrand (www.interbrand.com), titled 'Best Global Brands', showing that 'McDonald's' has been ranked on the ninth position in 2014 of the 'Best Global Brand' and has been ranked in the Top Ten of the 'Best Global Brand' each year between 2001 and 2011.
- Annex 13: Extracts from the Millward Brown's rankings 'BrandZ Top 100 Most Valuable Global Brands' showing that 'McDonald's' was in the fifth position in 2014, fourth position in 2013, 2012 and 2011, sixth in 2010, fifth in 2009, eighth in 2008, eleventh in 2007 and eleventh in 2006 and it was first in the fast food sector from 2006 to 2014. The research was carried out by Millward Brown, and the evaluation took into account not only financial data but also research with consumers and business-to-business users.
- Annex 14: A survey conducted in 1991 in Western Germany by Infratest Burke among 2 000 respondents aged 14 and older. According to this survey 58% of all persons polled, when shown a card with 'Mc' and asked 'what comes to your mind when you hear this designation?', answered McDonald's. Eighty-five per cent of the persons polled linked the sign 'Mc' in combination with another word to a self-service or fast food restaurant. Seventy-five per cent of the persons polled replied positively that this designation belongs to a certain group of restaurants.
- Annex 15: A survey conducted in 1992 in Western Germany by Infratest Burke on 1 000 respondents aged 14 and older. Eighty-three per cent of the people polled linked the sign 'Mc' in combination with another word to a self-service or fast food restaurant. Seventy-seven per cent of the persons polled replied positively that this designation belongs to a certain group of restaurants.
- Annex 16: A survey carried out in 2011 in Hungary by the Nielsen Company among 800 respondents aged between 18 and 59 years. Of those surveyed, 89% spontaneously answered McDonald's when asked, 'Which company uses the prefix 'Mc' in Hungary?'.
- Annex 17: A survey carried out in 2011 in Hungary by Forecast research Piackutató, among 1 000 respondents aged between 18 and 50 years. In this case, the answer to the question asked in Annex 16 was also given by 88% of those surveyed.
- Annex 18: A decision issued on 07/07/2004 in case 28W(pat) 111/03 of the Federal Patent Court of Germany with a translation in English where the

prefix 'Mc' was recognised as being able to identify McDonald's. The contested mark in that case was McDöner Kebab.

- Annex 19: A decision of the UK Patent Office issued on 16/08/1996 in which the use of the prefix 'Mc' in the field of foodstuffs is recognised as likely to be perceived as indicating the opponent.
- Annex 20: A translation in English of a decision (administrative Appeal No 04390/04 before the Spanish trade mark Office with date of the appeal 17/08/2004) where the mark McDonald's is recognised as having a reputation.
- Annex 21: A translation in English of a decision of 08/10/1999 in case No 97-707 of the Swedish Court of Patent Appeals where the family of 'Mc' marks in the field of food and beverages and restaurant services is recognised as indicating the opponent.
- Annexes 22 and 23: Opposition decisions of the OHIM, No B 2 017 146 and No B 1 934 416 in which the reputation of the mark 'McDonald's' and the family of marks 'Mc' is recognised.

The opponent also highlights that the opponent's company is the leading global food service retailer, serving around 69 million customers daily in 119 countries across 34 000 restaurants. It claims that the earlier mark 'McDONALD'S' has been extensively used since at least 1971 and that it has grown to be one of the most recognizable brands for the sale of fast food products.

On the basis of the above, the Opposition Division concludes that the earlier trade mark 'McDONALD'S' has acquired reputation in the European Union for part of the goods and services for which the opponent has claimed reputation. Although the evidence does not refer to all the countries of the European Union, the European Court of Justice has clarified that for an earlier Community trade mark, reputation throughout the territory of a single Member State may suffice (see judgment of 06/10/2009, C-301/07 'PAGO'). Therefore, the Opposition Division acknowledges that reputation proven in several countries of the EU (in particular, Germany, the United Kingdom, France) is sufficient for concluding that the earlier trade mark has a reputation in the European Union.

The documents show that the mark 'McDONALD'S' has been subject to a very long standing and intensive use and that it is generally known in the relevant market, as has been attested by diverse sources. In particular, the surveys, rankings and statements from various independent market research agencies are considered strong indications to show that the mark 'McDonald's' has earned a significant and widespread recognition among the relevant public. The amounts of restaurants and annual revenue figures in Europe are references to the steady and long standing market presence of the opponent's mark 'McDONALD'S' on the market. The participation in international events (e.g., the FIFA World Cup events) gives information of the opponent's investments and its promotional, communication and marketing strategies. All these documents show that the opponent has undertaken serious steps to build-up a brand image and enhance trade mark awareness among the relevant public.

On the basis of the above, the Opposition Division concludes that the opponent has demonstrated that the earlier mark 'McDONALD'S' has a reputation in the European

Union. However, the evidence does not succeed in establishing that the trade mark has a reputation for all the goods and services on which the opposition is based and for which reputation has been claimed. The evidence mainly relates to *services rendered or associated with facilities engaged in providing food and drink prepared for consumption and for drive-through facilities; preparation and provision of carry-out foods* in Class 42, whereas there is no or little reference to the remaining goods and services. Although it is clear from the evidence that the opponent also sells various foodstuffs and drinks in its restaurants, the evidence shows that these products bear their own brands, most of which starting with the prefix 'Mc'.

c) The 'link' between the signs

As seen above, the earlier mark is reputed and the signs are similar to some extent. In order to establish the existence of a risk of injury, it is necessary to demonstrate that, given all the relevant factors, the relevant public will establish a link (or association) between the signs. The necessity of such a 'link' between the conflicting marks in consumers' minds is not explicitly mentioned in Article 8(5) CTMR but has been confirmed in the judgments of 23/10/2003, C408/01, 'Adidas', paragraphs 29 and 31, and of 27/11/2008, C252/07, 'Intel Corporation', paragraph 66. It is not an additional requirement but merely reflects the need to determine whether the association that the public might establish between the signs is such that either detriment or unfair advantage is likely to occur after all of the factors that are relevant to the particular case have been assessed.

Possible relevant factors for the examination of a 'link' include (judgment of 27/11/2008, C252/07, 'Intel Corporation', paragraph 42):

- the degree of similarity between the signs;
- the nature of the goods and services, including the degree of similarity or dissimilarity between those goods or services, and the relevant public;
- the strength of the earlier mark's reputation;
- the degree of the earlier mark's distinctive character, whether inherent or acquired through use;
- the existence of likelihood of confusion on the part of the public.

This list is not exhaustive and other criteria may be relevant depending on the particular circumstances. Moreover, the existence of a 'link' may be established on the basis of only some of these criteria.

In the present case, the signs are similar to the extent that the initial two letters 'Mc' of the earlier mark 'McDONALD'S' are present in the element 'MAC' at the end of the contested sign, 'SUPERMAC'S', and these elements will be pronounced identically by the majority of the relevant public. Furthermore, both marks end with an apostrophe and the letter 'S'. However, this does not mean that the relevant public is likely to establish a link between them. It is clear that the similarities between the signs relate mainly to the elements 'MC' / 'MAC', which are not decisive in distinguishing the goods on the market, since these letters are relatively commonplace and are used in different positions in the marks under comparison. The similarity based merely on the similar elements 'MC' / 'MAC' and the additional

apostrophe and the letter 'S' should not be overestimated. The beginnings of the marks, which are the parts that consumers generally tend to focus on, as they first catch the attention of the reader, are different. Furthermore, the marks at issue contain relevant differing elements, which introduce different concepts and create different overall impressions of the signs. When encountering the signs 'McDONALD'S' and 'SUPERMAC'S', the relevant public will be aware that the goods originate from different, unconnected undertakings. The reputation of the earlier mark is not sufficient for a finding that the relevant public will establish a link between the signs. The contested mark as a whole bears very little resemblance to the earlier trade mark, and it does not contain any element that could on its own, or in combination with other elements of the contested sign, bring to mind the earlier trade mark. It follows from all the foregoing that the insignificant similarities are unlikely to bring the earlier trade mark to the mind of the average consumer when they encounter the contested sign.

It should be noted that the opponent also claims to have a family of marks with the common element 'Mc' which would result in a transfer of the goodwill of the earlier reputed mark in favour of the applicant's mark.

A family of marks implies that firstly, the proprietor of a series of earlier registrations must furnish proof of use of all the marks belonging to the series or, at the very least, of a number of marks capable of constituting a 'series'. Secondly, the trade mark applied for must not only be similar to the marks belonging to the series, but also display characteristics capable of associating it with the series. This could not be the case where, for example, the element common to the earlier series of marks is used in the contested trade mark, either in a different position from that in which it usually appears in the marks belonging to the series, or with a different semantic content.

In the present case, the opponent has proven that it uses a family of marks. The evidence filed by the opponent, as seen above, shows use of the prefix 'Mc' in combination with descriptive or allusive terms relating to the ingredients of the food products designated by the sign in the relevant language (such as 'McFish', 'McToast', 'McMuffin' and 'McRib', all of which are earlier marks on which the opposition is based). This is evident from the printouts of the McDonald's websites in the member states of the European Union, the samples of advertisements and packaging and the independent surveys conducted by Infratest Burke in Germany. The opponent has also filed decisions from various national courts showing that the prefix 'Mc', combined with another word in the field of foodstuffs is recognized and has acquired decisive importance.

However, as regards the second condition, the Opposition Division is of the opinion that the trade mark applied for, 'SUPERMAC'S', is not sufficiently similar to the marks belonging to the series in the sense that it does not display characteristics capable of associating it with the series. The appearing in different positions in the signs of the similar elements 'MC', in the case of the earlier marks, and 'MAC', in the case of the contested sign, weighs heavily against such an association being established in the consumers' minds. The earlier family of marks consists of the distinctive prefix 'Mc' followed by a generic term for a particular foodstuff. However, the latter mark does not display any of these characteristics. The word 'SUPER' is not a generic term describing a particular type of foodstuffs. Moreover, the similar element 'MAC' is displayed as the second part of the verbal element 'SUPERMAC' and is followed by an apostrophe and the letter 'S'. Consumers, therefore, will not make the necessary mental association between the contested sign and the earlier series of marks.

Therefore, taking into account and weighing up all the relevant factors of the present case, the Opposition Division concludes that it is unlikely that the relevant public will make a mental connection between the signs in dispute, that is to say, establish a 'link' between them. Therefore, the opposition is not well founded under Article 8(5) CTMR and must be rejected on the basis of this ground.

COSTS

According to Article 85(1) CTMR, the losing party in opposition proceedings must bear the fees and costs incurred by the other party. According to Article 85(2) CTMR, where each party succeeds on some heads and fails on others, or if reasons of equity so dictate, the Opposition Division shall decide a different apportionment of costs.

Since the opposition is successful only for part of the contested goods and services, both parties have succeeded on some heads and failed on others. Consequently, each party has to bear its own costs.



The Opposition Division

Begoña URIARTE
VALIENTE

Alexandra APOSTOLAKIS

Martina GALLE

According to Article 59 CTMR, any party adversely affected by this decision has a right to appeal against this decision. According to Article 60 CTMR, notice of appeal must be filed in writing at the Office within two months of the date of notification of this decision. Furthermore, a written statement of the grounds of appeal must be filed within four months of the same date. The notice of appeal will be deemed to be filed only when the appeal fee of EUR 800 has been paid.