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Munich, February 4, 2015

Opposition number: B 002386582
Opposition to Community Trademark Application
012680591 - SUPERMAC'S
Applicant: Supermac's (Holdings) Ltd.
Opposition based on Community Trademark Registration
000062497 - McDONALD'S et al.
Opponent: McDonald's International Property Company, Ltd.
 Our ref: M23277EUWI39 CE/KTh/ang

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Referring to the Communication to the Opponent dated August 8, 2014 and to the Notification to the Opponent of Extension of a Time Limit dated December 10, 2014, the Opponent herewith submits further facts, evidence and arguments to substantiate the opposition.

I. Facts and background of the case

1. Facts of the case

The Opponent, McDonald's International Property Company Ltd. has opposed registration of the mark "SUPERMAC'S" owned by the company Supermac's (Holdings) Ltd., Ireland, which is the subject of CTM application 12680591 filed on March 11, 2014. The foregoing application was published in the Community Trade Marks Bulletin on April 24, 2014.

The subject opposition is directed against all of the goods and services set forth in CTM application 12680591.

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 Amtsgericht München
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The opposition is based on:

- CTM registration 62497 “**McDONALD’S**”, filed on April 1, 1996 and registered on July 16, 1999 for goods and services of classes 25, 28, 29, 30, 31, 32, 35, 41 and 42;
- CTM registration 10392835 “**Mc**”, filed on November 4, 2011 and registered on March 15, 2012 for goods and services of classes 29, 30, 32 and 43;
- CTM registration 5056429 “**MCFISH**”, filed on April 18, 2006 and registered on July 20, 2007 for goods of classes 29 and 30;
- CTM registration 4699054 “**MCTOAST**”, filed on October 24, 2005 and registered on April 20, 2007 for goods and services of classes 29, 30 and 43;
- CTM registration 4562419 “**MCMUFFIN**”, filed on July 27, 2005 and registered on August 7, 2006 for goods and services of classes 29, 30 and 43;
- CTM registration 1391663 “**McRIB**”, filed on November 19, 1999 and registered on June 11, 2001 for goods of classes 29 and 30;
- CTM registration 864694 “**McFLURRY**”, filed on June 30, 1998 and registered on September 8, 1999 for goods of class 29;
- CTM registration 16196 “**CHICKEN McNUGGETS**”, filed on April 1, 1996 and registered on August 4, 1998 for goods of class 29;

- CTM registration 62638 “**BIG MAC**”, filed on April 1, 1996 and registered on December 22, 1998 for goods and services of classes 29, 30 and 42;
- CTM registration 11596442 “**McCOUNTRY**”, filed on February 22, 2013 and registered on July 3, 2013 for goods and services of classes 29, 30 and 43;
- CTM registration 11205093 “**McBites**”, filed on September 21, 2012 and registered on January 30, 2013 for goods and services of classes 29, 30 and 43;
- CTM registration 11642519 “**McDouble**”, filed on March 11, 2013 and registered on July 23, 2013 for goods and services of class 30;
- CRM registration 8664617 “**McWRAP**”, filed on November 5, 2009 and registered on June 15, 2010 for goods and services of classes 29, 30 and 43
- Trademark “**McDonald’s**” well-known in Germany for goods and services of classes 29, 30 and 43.

The opposition is based on all the goods and services covered by the earlier marks.

The grounds of the opposition are those laid down in Articles 8 (1) (b) and 8 (5) CTMR.

2. The McDonald’s Corporation

The Opponent is owner of the trademarks used by the McDonald’s Corporation, its affiliates and franchisees. The McDonald’s Corporation

("McDonald's") is the leading global food service retailer with more than 34,000 restaurants serving 69 million people in 119 countries each day.

McDonald's has been using its "McDONALD'S" mark in the European Community in connection with the sale of food products since at least as early as 1971 when McDonald's opened its first European restaurants in the Netherlands and in Germany. Openings in further countries of the European Union followed shortly after (France in 1972, Sweden in 1973 and UK in 1974), as can be seen from the extract of the Wikipedia article "History of McDonald's", attached as

Annex 1.

Presently, McDonald's owns and/or operates at least one or more restaurants in each of the 28 Member States of the European Union. In 2013, McDonald's operated e.g. 1,468 restaurants in Germany, 1,298 restaurants in France, 480 restaurants in Italy, 461 restaurants in Spain and 1,222 restaurants in the UK, as can be seen from the extract of the "2013 Financial Highlights" published on the corporate website of McDonald's (www.aboutmcdonalds.com), attached as

Annex 2.

In 2011 in Germany alone, McDonald's achieved a net turnover of € 3.195 billion with an average of approximately 2.76 million guests frequenting the 1,415 restaurants operated by the Opponent and/or its franchisees. An extract from the official website of McDonald's Deutschland Inc. (with translation of the part "McDonald's in Zahlen und Fakten") is attached as

Annex 3.

Already in 2008, the worldwide annual revenue of McDonald's amounted to US\$ 23.52 billion and increased to US\$ 22,75 billion (2009), US\$ 24.08 billion (2010), US\$ 27,01 billion (2011), US\$ 27,57 billion (2012) and US\$ 28.11 billion (2013). The revenue in Europe alone amounted to

US\$ 7.85 billion (2011), US\$ 7.85 billion (2012) and US\$ 8.14 (2013), as can be seen from the Annual Report 2013, attached as

Annex 4.

This extract of the Annual Report also contains information about the marketing campaigns of McDonald's. Every year, McDonald's launches several advertising campaigns, for example the popular McDonald's Monopoly promotion. Attached as

Annex 5

is an article from Wikipedia about this promotion which has been offered for many years for instance in Germany, UK, France, Portugal, and the Netherlands.

Furthermore, McDonald's has been an Official Partner of the FIFA World Cup since 1994, and, in particular, the Official Partner for the FIFA World Cup event in 2014. Moreover, McDonald's will be the Official Partner for the FIFA World Cup events in 2018 and 2022. McDonald's is, for instance, the sole sponsor of the Player Escorts Program for the FIFA World Cup and the FIFA Confederations Cups in this period, as can be seen from the FIFA press releases and online publications attached hereto as

Annex 6.

With regard to the Olympic Games, McDonald's began its support already in 1968, and became part of The Olympic Partner Program (TOP) in 1996. McDonalds renewed its TOP sponsorship in 2006 and 2012 and announced the continuation of its TOP sponsorship for the next eight consecutive years through the 2020 Games. We refer to the McDonald's press release and an excerpt from the official IOC website attached herewith as

Annex 7.

3. Trademark registrations of McDonald's

In addition to their use and ownership, respectively, of registrations for the mark "McDonald's", which was the world's No. 1 trademark in 1996, as it can be seen from respective publications attached as

Annex 8,

McDonald's and/or the Opponent are also proprietors of 93 national trademark registrations in the Member States of the European Union consisting of the element "McDonald's" and of 20 CTM registrations consisting of or containing the element "McDonald's", also in the form "McDonald", as can be seen from the search results attached as

Annex 9.

McDonald's and the Opponent furthermore use and own registrations for various marks consisting of or incorporating the terms "Mc" or "Mac", either as a prefix or as a suffix. Inter alia, the Opponent is the owner of the following Community Trademark Registrations:

Mark	Reg. No.	Reg. Date	Class(es)
McDONALD'S	000062497	16.07.1999	25, 28, 29, 30, 31, 32, 35, 41, 42
McDONALD'S (fig.)	000062521	15.07.1999	25, 28, 29, 30, 31, 32, 35, 41, 42
McROYAL	000015818	11.03.1998	30
EGG McMUFFIN	000015966	19.12.1997	30



Mark	Reg. No.	Reg. Date	Class(es)
McCHICKEN	000016188	02.02.1998	30
McPIZZA	000016014	11.03.1998	30
McNUGGETS	000016238	16.03.1998	29, 30, 31
McBACON	000016253	16.03.1998	30
CHICKEN McNUGGETS	000016196	04.08.1998	29
McCAFE	000058438	25.11.1998	42
McDRIVE	000062612	23.12.1998	42
BIG MAC	000062638	22.12.1998	29, 30, 42
MACFISH	00553214	24.02.1999	29
McSNACK	000057869	26.01.1999	42
McEXPRESS	000057935	26.01.1999	35, 41, 42
McFLURRY	000864694	08.09.1999	29
McFEAST	000015941	27.10.1999	30
McCRISPY	001024678	18.02.2000	29, 30



Mark	Reg. No.	Reg. Date	Class(es)
McSALAD	001221704	02.05.2009	29, 30
McRIB	001391663	11.06.2001	29, 30
McPORK	002181048	10.05.2002	30
McSHAKER	002225209	19.06.2002	29, 30, 31
McCROSTY	002690873	05.12.2003	29, 30, 43
McINTERNET	002888402	24.03.2004	35, 38, 43
McCHOICE	002986875	29.04.2004	35, 42, 43
GREEK MAC	003170727	03.12.2004	29, 30
PITAMAC	004264818	11.04.2006	29, 30, 43
McMUFFIN	004562419	07.08.2006	29, 30, 43
McTOAST	004699054	20.04.2007	29, 30, 43
McFISH	005056429	20.07.2007	29, 30
McMARINS	005247903	20.07.2007	29, 30
McGRIDDLES	005506555	08.11.2007	30

Mark	Reg. No.	Reg. Date	Class(es)
McNUGGET	008540601	08.03.2010	29

The terms “Mc” and “Mac” are used to identify menu items and other food-related goods and services prepared, sold or rendered by McDonald’s. Due to McDonald’s’ long and continuous use of the “Mc” and “Mac” terms, these terms have become widely and exclusively associated with McDonald’s by consumers throughout the European Community.

Printouts from the McDonald’s websites in Austria, Belgium, Bulgaria, the Czech Republic, Germany, Denmark, Spain, Finland, France, Greece, Hungary, Ireland, Italy, Malta, the Netherlands, Poland, Portugal, Romania, Sweden, Slovenia, the Slovak Republic and the UK showing use of the “Mc” and “Mac” marks as well as promotional information are attached as

Annex 10.

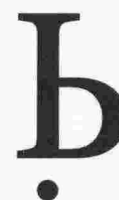
Furthermore, examples for advertising and packaging used in Germany, UK and France between 2007 and 2010 are attached as

Annex 11.

4. The mark “McDONALD’S”

a. Trademark Rankings

The sign “McDonald’s” is one of the most famous marks of the world. In 1996, the mark “McDonald’s” was the world’s No. 1 trademark (see **Annex 8**). Since many years, the mark “McDonald’s” has ranked in the Top Ten of the “Best Global Brands” evaluated by Interbrand, as can be seen from the extract of the 2014 report (including Interbrand’s method for valuing brands) and the rankings from 2001 to 2013, which are attached as



Annex 12.

The research company Millward Brown bases their brand evaluation not only on financial data, but also on research with consumers and business-to-business users. In 2014, the mark “McDonald’s” was on the fifth position of their “BrandZ Top 100 Most Valuable Global Brands” (2013: 4th position, 2012: 4th position, 2011: 4th position, 2010: 6th position, 2009: 5th position, 2008: 8th position, 2007: 11th position, 2006: 11th position). In the fast food sector, the mark “McDonald’s” has been the number one worldwide between 2006 and 2013, and the brand value has increased continuously between 2006 and 2011, as can be seen from the extracts of the reports attached as

Annex 13.

b. Consumer survey conducted in Germany in 1991

In a consumer survey conducted in Germany in 1991, 58 % of the polled persons and 67 % of the consumer circles involved spontaneously answered “McDonald’s” when they were shown a card with the designation “Mc” and asked “What comes to your mind when you hear or see this designation?”. The consumer survey was conducted by the well-known institute Infratest Burke in August/September 1991 on 2000 people aged 14 and older. An extract of the result (with translation of questions 1, 3 and 4) is attached as

Annex 14.

When being asked whether they have already seen or heard the designation “Mc” in relation to self-service or fast food restaurants, even 85 % of the polled persons and 94 % of the consumer circles involved answered in the affirmative. 75 % of the polled persons and 84 % of the consumer cir-

cles involved thought that the designation “Mc” belongs to a certain group of restaurants, i.e. recognized the letters “Mc” as referring to McDonald’s.

c. Consumer survey conducted in Germany in 1992

In 1992, already 77 % of German people and 85 % of the German consumer circles involved recognized the letters “Mc” as referring to a certain group of restaurants. An extract of the result of the respective consumer survey also conducted by Infratest Burke (with translation of question 1) is attached as

Annex 15.

The survey was conducted in January/February 1992 in Germany on 1000 people aged 14 and older. 83 % of the total population and 91 % of the users of fast food restaurants and consumers interested in fast food restaurants linked the sign “Mc” in combination with another word to a self-service or fast food restaurant. The card shown to the participants of the survey contained “Mc.....”, as shown on the front page of the survey.

d. Consumer surveys conducted in Hungary in 2011

In a consumer survey conducted by the renowned institute The Nielsen Company in Hungary in March 2011 on 800 people (18-59 years old), more than 4/5, namely 89% of the total population spontaneously answered “McDonald’s” when they were asked “Which company uses the prefix “Mc” in Hungary?”. An extract of the result of the consumer survey (with translation of pages 1-6 and 8) is attached herewith as

Annex 16.

A further survey was conducted by Forecast Research Piackutató, a renowned Hungarian research institute, between February 28 and March 4,

2011 among 1000 persons aged between 18 and 50. Also in this survey, the results were impressive. When being asked “Which company uses the prefix “Mc” in Hungary?”, 88% of the polled persons answered spontaneously “McDonald’s”. Attached herewith as

Annex 17

is an extract of the survey result with translation of the relevant parts.

5. Previous decisions

OHIM and national Courts and Offices previously recognized the well-known character of the mark “McDonald’s”, the family of “Mc”/“Mac” marks and/or the reputation of the marks of McDonald’s.

a. Decisions of OHIM

On April 27, 2012, the Cancellation Division issued a decision in McDonald’s International Property Company, Ltd. v Future Enterprises Pte. Ltd. on the application for declaration of invalidity No. 4711 C re: “MACCOFFEE”. In this decision, the Cancellation Division recognized that the mark “McDONALD’S” is highly reputed for restaurant services and that use of a family of “Mc” marks has been proven. The Cancellation Division stated:

“Considering the awareness of the applicant’s mark, its worldwide market share, the fact that it has been on the EU market for a long time and that it is clearly one of the top brands on a global scale, it is clear that the word “McDONALD’S” is highly reputed for restaurant services, namely fast-food restaurant services and therefore that the condition reputation under Article 8(5) CTMR has also been met [...]

In addition, the Cancellation Division also takes note of the fact that the applicant has proved that it uses a family of “Mc” marks. [...]

The Cancellation Division finds it likely that the relevant public when seeing or addressing the contested CTM in relation to the contested goods will associate it with the earlier mark and its long standing reputation as one of the world’s leading restaurant brands. Aurally, it might perceive the contested CTM as a sub-brand or a variant (as seen in the submitted national judgments) and thereby as an attempt to free ride on the reputation of the earlier mark.”

The Opposition Division recognized in *McDonald’s International Property Company Ltd. v Flour Foods Research Limited*, Decision dated 28 August 2002 on the Opposition No. B 184 970 re: “McBAGEL” that the Opponent is the owner of a family of well-known marks. Here, the Opposition Division stated:

“The beginnings of all these marks are identical and their basic structure is the same. This means that, even though an individual comparison of each earlier right with the contested CTMA might lead to the conclusion that they are not particularly similar, the overall impression is that of a family of marks with a common component. This impression is reinforced by the fact that the remaining earlier word and figurative marks all incorporate the same component, “Mc-”. [...] Considering the above and the fact that the opponent has proved that he has a family of

marks based on the common prefix “Mc”, is indeed possible that the relevant public will presume that the trade mark “McBAGEL” is another “Mc-” trade mark originating from the same undertaking as the earlier trademarks.”

In *McDonald’s International Property Company Ltd. v Eric Alain Jacques Mueller*, Decision dated 13 March 2007 on the Opposition No. B 812 232 re: “MC ARONI”, the Opposition Division stated:

“The custom on the market is such that a principal element common to trademarks, to which an additional element is added, is perceived as a family of trademarks. Indeed, in such a case, the internal signs or identifiers of the series of products are often combined with other elements. The systematic usage of a basic designation, in different combinations and contexts, can lead the public to ignore the secondary differences, thinking that they merely indicate a new item in the same commercial entity’s product line.

Given the aforementioned, and since the Opponent has proven that it is the owner of a trademark family based on the common “Mc-” prefix, it is highly probable that the public will think that the “MC ARONI” trademark is a new trademark from the same company as the prior trademarks, the latter having the same structure as the ten prior trademarks claimed by the Opponent. Indeed, the prefix “Mc-” is placed at the beginning of each trademark, it is an intrinsically stronger element than the second part of each trademark, which generally consists of the generic name of a product. Finally, the conditioned public is used

to seeing and considering the element “Mc-” as an identifier of origin, as the Opponent has shown.

In the case at bar, the comparison of the trademarks at issue shows that they are similar in their attacking element “Mc” as well as their structure, since they are built on the same model. The designations bear visual and phonetic similarities due to their identical prefix, which identifies the Opponent in the eyes of the public.”

In McDonald’s International Property Company Ltd. v Comercial Losan S.L.U., Decision dated 29 September 2008 on the Opposition No. B 1 049 362 re: “Mc.Baby”, the Opposition Division stated:

“On the basis of the above, the Office concludes that the earlier trade mark “MC” combined with another word has acquired a high degree of distinctiveness through its use in the fast food market.”

In McDonald’s International Property Company Ltd. v Gian Di Sassone Pierino & C. S.A.S., Decision dated 17 November 2009 on the Opposition No. B 1 417 817 re: “McMed”, the Opposition Division stated:

“On the basis of the above, the Office concludes that the opponent’s trademarks under assessment are reputed in relation to restaurant services, at least in a part of the relevant territory, namely in Germany. [...] In the present case, the opponent has proved that it uses a family of “Mc” marks, and moreover that it uses such a family on the same fields as those covered by the CTM application. The evidence filed by the opponent, as seen above, shows

widespread use of the “Mc” prefix in combination with other elements such as “Donald’s”, “MENU”. This is particularly evident from the independent survey conducted by INFRATEST BURKE. The opponent has also filed as evidence, decisions from various National Courts showing the prefix “Mc” combined with another word has acquired decisive importance. Whilst these decisions are not binding, they do serve as an indication of reputation accrued by the opponent in the “Mc” family of marks, at least in a part of the European Union.”

b. Decisions of national Offices and Courts

In McDonald’s International Property Company Ltd. v Hans-Willi Burghartz, Decision of 7 July 2004 in Case 28 W (pat) 111/03, the Federal Patent Court of Germany overruled a decision of Trademark Division of the German Patent and Trademark Office and held that the mark “MC Döner Kebab” was not entitled to registration due to the presence of the Opponent’s prior “Mc”/“Mac” registrations. The decision and an English translation thereof are attached as

Annex 18.

In supporting its decision, the Federal Patent Court stated:

“Irrespective of the descriptive content of the additional syllables in the trademarks under comparison, the initial syllable (the Mc syllable) has prevailed to such an extent [...] that the public almost necessarily believes that it has identified a trademark held by the Opponent.”

In the decision *McDonald's Corporation v Sabbir Mehta*, which is attached as

Annex 19,

the UK Patent Office outlined:

"[...] to my mind this survey is strong support for the view that because of the opponent's reputation in their McDONALD, BIG MAC, McMUFFIN etc marks, use of "Mc" in the form indicated in relation to foodstuffs is very likely to be perceived by the purchasing public as indicating an association with the opponent company. [...] Taken at face value it appears to me that the applicants (correct: opponents) have a certain reputation in the prefixes "mc" and "MAC" in relation to fast food restaurants and they can support their ground of opposition [...] on a basis of a "series" of marks in use [...]."

On administrative appeal No. 04309/04 against registration of Spanish trademark "McWILLY EXPRESS (& Device)", the Spanish Patent and Trademark Office outlined:

"[...] MAC DONALDS is a well-known trademark in the food-sector, having attained such a degree of knowledge in the marketplace that, even aside from the fact that one of the opposing marks is MC EXPRESS, inclusion of MC and the ending EXPRESS in the trademark applied for means that even interposition of the word WILLI and the design cannot preclude the likelihood that the public will associate this mark with the earlier marks, causing consumers to take the marks to be related."

An English translation of the decision is enclosed as

Annex 20.

In the decision McDonald's International Property Company, Ltd. v Stefan Sallerfors, English translation of which is attached as

Annex 21,

the Swedish Court of Patent Appeals stated:

"It is made clear in the case that the opponent in this country – as well as elsewhere – makes use of the prefix Mc in its main trademark, included in a series of trademarks, in order to characterize, inter alia, the special dishes which are supplied in the business. The opponent is using the prefix in combination with a generic or otherwise descriptive word. [...] The market analysis invoked may, however, be regarded as convincing support for that the customers to a considerable extent would perceive a trademark McOstrich as a name on a product originating from the opponent, and would range it among the trademarks in the opponent's series."

II. Likelihood of confusion, Article 8(1)(b) CTMR

Pursuant to Article 8(1)(b) CTMR, upon opposition by the proprietor of an earlier trademark, the trademark applied for shall not be registered, if because of its identity with, or similarity to, the earlier trademark and the identity or similarity of the goods or services covered by the trademarks there exists a likelihood of confusion on the part of the public in the terri-

tory in which the earlier trademark is protected; the likelihood of confusion includes the likelihood of association with the earlier trademark.

According to Article 8(2) CTMR, “earlier trademark” means, inter alia, Community trademarks (Article 8(2)(a)(i) CTMR) or trademarks which, on the date of the application for registration of the Community trademark, 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).

The Opponent submits that the registration of the subject application would give rise to confusion amongst the public in the European Community and would result in an unwarranted association of the Applicant’s goods and services with those goods and services offered, sold and rendered by the Opponent and McDonald’s in violation of the above provisions of the Community Trademark Regulation.

The earlier marks are CTM registrations. Therefore, the relevant territory is the European Union.

1. Earlier mark: CTM registration 62497 “McDONALD’S”

a. Comparison of the goods/services

In assessing the similarity of the goods/services concerned, all relevant factors should be taken into account. These factors include, inter alia, their nature, their purpose of use and their method of use and whether they are in competition with each other or are complementary (see Judgment of the Court of Justice in Case C-39/97, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* (“Canon”), paragraph 23). Other factors may also be taken into account such as the distribution channels of the goods

concerned (see Judgment of the General Court in Case T-48/06, *Astex Therapeutics Ltd v OHIM*, paragraph 38).

The relevant goods and services which have to be compared are the following:

Earlier trademark CTM registration 62497	Contested trademark CTM application
<p>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.</p> <p>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.</p>	<p>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.</p> <p>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</p>

<p>Class 31: Fresh fruits and vegetables.</p> <p>Class 32: Non-alcoholic beverages, syrups and other preparations for making beverages.</p> <p>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.</p>	<p>tea; ketchup; mayonnaise; meat gravies; pizzas; salad dressings; sorbets; tartar sauce; waffles; fruit sauces.</p> <p>Class 43: Services for providing food and drink; restaurant services; fast-food restaurant services; canteens; self-service restaurant services; takeaway services; snack-bars.</p>
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aa. Similar goods/services

The goods “meat, fish, poultry and game; sausages; chicken nuggets; hamburgers; meat extracts” of class 29 covered by the contested mark are identical or, at least highly similar to “foods prepared from meat, pork, fish and poultry products, meat sandwiches, fish sandwiches, pork sandwiches, chicken sandwiches” covered by the prior mark in class 29.

The same applies to “potato crisps and chips; onion rings” covered by the contested mark and “preserved and cooked fruits and vegetables” covered

by the prior mark and to “milk; milk shakes” and “milk, milk preparations” covered by the marks at issue in class 29.

The further goods “edible oils for use in cooking foodstuffs; dips” covered by the contested mark in class 29 are at least similar to the Opponent’s goods of class to a medium degree.

The goods “coffee; tea; artificial coffee; coffee-based beverages; tea-based beverages; iced tea; sugar; bread; sandwiches; filled buns; sandwiches containing hamburgers; pastry; confectionery; mustard; sauces (condiments), sauces; cookies; chocolate” of class 30 covered by the contested mark are identical or, at least highly similar to “coffee, coffee substitutes, tea; sugar; bread; edible sandwiches, meat sandwiches, pork sandwiches, fish sandwiches, chicken sandwiches; pastries; mustard; sauces; cookies; chocolate;” covered by the prior mark in class 30.

The latter equally applies to “cocoa; drinking chocolate; cocoa products; chocolate chips; chocolate-based beverages; cocoa-based beverages;” covered by the contested mark and “chocolate” covered by the prior mark, to “flour and preparations made from cereals; crisps made of cereals” and “oatmeal”, to “ices; ice cream desserts; crisp rolls; custard; doughnuts; fruit pies; ice cream; sorbets; waffles; fruit sauces” and “biscuits, cakes, cookies, chocolate; fresh fruits”, to “yeast; baking-powder ; salt; pepper; vinegar; flavourings, other than essential oils; flavourings for snack foods (other than essential oils); flavourings made from vegetables (other than essential oils); meat gravies; cinnamon; condiments; ketchup; mayonnaise; salad dressings, tartar sauce” and “mustard, sauces, seasonings”, to “pizzas” and “edible sandwiches” and to “treacle” and “sugar” covered by the marks at issue in classes 30 and 31.

Moreover, the services “Services for providing food and drink; restaurant services; fast-food restaurant services; can-teens; self-service restaurant services; takeaway services; snack-bars” of class 43 covered by the contested CTM application are identical or, at least, highly similar to “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” covered by the prior mark in class 42 (now: 43) both being “restaurant services”.

Moreover, the afore-mentioned services “Services for providing food and drink; restaurant services; fast-food restaurant services; canteens; self-service restaurant services; takeaway services; snack-bars.” covered by the contested CTM application in class 43 are similar to the Opponent’s goods of classes 29, 30, 31 and 32 being food products and beverages, given that the latter goods are regularly subject to “restaurant services”.

b. Comparison of the signs

The signs to be compared are the following:

McDONALD’S	SUPERMAC’S
earlier trademark	contested trademark

Visually, both marks have the prefix/suffix “Mc”/”Mac” and, moreover, the genitive “’s” in common. Hence, there is a visual similarity.

Aurally, the prefix “Mc”/”Mac” of both marks is pronounced identically, namely “mac”. Therefore, the signs are also similar in aural respect.

Conceptually, noteworthy is that the element “SUPER” will be perceived as an indication of a very high quality product. Hence, consumers will easily perceive the element “SUPER” as a mere descriptive indication lacking any distinctive character. In particular, consumers being confronted with goods of classes 29 and/or 30 and/or services of class 43 under the designation “SUPERMAC’S” will assume that goods and services are of a very high quality. On the other hand, the identical element “Mc”/”Mac” is a commonly known prefix of Scottish and Irish surnames. The signs are hence conceptually similar.

Summarizing, the signs are similar at least to a medium degree.

2. Earlier marks: Several Community trademark registrations composed of the element “Mc”/”Mac” and a further descriptive element

a. Comparison of the goods

Given that all prior trademark registrations which are composed of the element “Mc”/”Mac” and a further descriptive element cover goods of classes 29, 30 and/or 31 and “restaurant services” of class 43, the above comments apply equally.

b. Comparison of the signs

The signs to be compared are the following:

MCFISH MCTOAST MCMUFFIN McRIB McFLURRY CHICKEN McNUGGETS BIG MAC McCOUNTRY McBites McDouble McWRAP	SUPERMAC'S
earlier trademarks	contested trademark

Visually, all marks have the prefix/suffix “Mc”/”Mac” in common. Hence, there is a visual similarity, irrespective of the additional genitive “s” with- in the contested mark which does not render the mark distinct from its overall impression.

Aurally, the element “Mc”/”Mac” of the marks is pronounced identically, namely “mac”. Therefore, the signs are also similar in aural respect.

Conceptually, the identical element “Mc”/”Mac” is commonly known as a prefix of Scottish and Irish surnames. The signs are hence also conceptually similar.

Summarizing, the signs are similar at least to a medium degree.

3. **Earlier mark: Community trademark registration 10392835**
“Mc”
- a. **Comparison of the goods/services**

The following relevant goods and services have to be compared:

Earlier trademark CTM registration 10392835	Contested trademark CTM application
<p>Class 29: Foods prepared from meat, pork, fish and poultry products, preserved and cooked fruits and vegetables, eggs, cheese, milk, milk preparations, pickles.</p> <p>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.</p>	<p>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.</p> <p>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; dough-</p>

<p>Class 32: Non-alcoholic beverages, syrups and other preparations for making beverages.</p> <p>Class 43: Restaurant services.</p>	<p>nuts; fruit pies; ice cream; iced tea; ketchup; mayonnaise; meat gravies; pizzas; salad dressings; sorbets; tartar sauce; waffles; fruit sauces.</p> <p>Class 43: Services for providing food and drink; restaurant services; fast-food restaurant services; canteens; self-service restaurant services; takeaway services; snack-bars.</p>
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Given that the prior trademark registration for “Mc” covers goods and services of classes 29, 30, 32 and 43, the above comments apply equally.

b. Comparison of the signs

The signs to be compared are the following:

Mc	SUPERMAC’S
earlier trademark	contested trademark

As regards the similarity of the marks, it is to be noted that the contested mark is dominated by the element “Mac” given the clearly descriptive connotation of the further element “SUPER”. Hence, the marks are similar in aural and visual respect.

4. Earlier mark: Well-known mark “McDONALD’S” in Germany

a. Well-known character of the mark “McDONALD’S”

In determining whether a mark is a well-known mark within the meaning of Article 6bis of the Paris Convention, any circumstances from which it may be inferred that the mark is well-known should be taken into account, including:

- the degree of knowledge or recognition of the mark in the relevant sector of the public;
- the duration, extent and geographical area of any use of the mark;
- the duration, extent and geographical area of any promotion of the mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods and/or services to which the mark applies;
- the duration and geographical area of any registrations, and/or any applications for registration, of the mark, to the extent to which they reflect use or recognition of the mark;
- the record of successful enforcement of rights in the mark, in particular, the extent to which the mark has been recognised as well known by competent authorities; and
- the value associated with the mark.

(see Judgment of the General Court in Case T-420/03, *El Corte Inglés, SA v OHIM*, paragraph 80).

Regarding the duration, extent and geographical area of use of the mark “McDONALD’S”, 1971 the first McDonald’s restaurants were opened in the European Union, namely in the Netherlands and in Germany. The number of McDonald’s restaurants in the European Union has continuously

increased. In 2013, McDonald's operated 1,415 restaurants in Germany, 1,226 restaurants in France, 431 restaurants in Italy, 424 restaurants in Spain and 1,198 restaurants in the UK (see **Annexes 1 and 2**). The revenue in Europe also continuously increased, e.g. from € 5.7 billion in 2006 to € 8.2 billion in 2012, as can be seen from the extracts of the Annual Reports (attached as **Annex 4**).

Concerning the degree of knowledge or recognition of the mark in the relevant sector of the public as well as the value associated with the mark, the surveys conducted in Germany in 1991 and 1992 (**Annexes 14 and 15**) show that the element "Mc" is well-known and recognized in Germany as referring to McDonald's by the public. The questions in both surveys were not leading, but open questions and revealed an unaided brand awareness of more than 80%. It can be assumed that today, even more people know the mark "McDonald's", given that McDonald's opened further restaurants every year and the number of consumers visiting the McDonald's restaurants continuously increased.

Furthermore, the rankings provided as **Annexes 11 and 12** show the extraordinary value of the mark "McDonald's", which is not only evaluated on the basis of financial data, but also on consumer research.

As regards the promotion of the mark "McDONALD'S" and its registration in the EU, McDonald's and/or the Opponent are also proprietors of 93 national trademark registrations in the Member States of the European Union consisting of the element "McDonald's" and of 20 CTM registrations consisting of or containing the element "McDonald's" (see **Annex 9**). The mark "McDONALD'S" is widely used in advertising, on the packaging of the goods and on every McDonald's restaurant building (see **Annexes 4, 10 and 11**). Hence, the mark is used 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, sugar.

Class 32:

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

Class 43:

Restaurant services.

Finally, the Opponent has shown that not only OHIM, but also national Courts and Offices have ruled that the element “Mc”/“Mac” combined with another word has acquired decisive importance and is particularly distinctive in the food sector.

Summarizing, the Opponent has shown that the mark “McDONALD’S” is and has been well-known at least in Germany also at the date of application of the contested mark “SUPERMAC’S” in relation to the above-cited goods and services.

b. Comparison of the goods/services

The contested goods and services of the CTM application are the following:

Class 29:

Meat, fish, poultry and game; sausages; chicken nuggets; ham-burgers; meat extracts; potato crisps and chips; edible oils for use in cooking food-stuffs; 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; dough-nuts; 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; cafeterias; self-service restaurant services; takeaway services; snack-bars.

As shown above, the afore-mentioned goods and services of classes 29, 30 and 43 covered by the contested application are partly identical and partly highly similar to goods and services of classes 29, 30, 32 and 43 of the prior mark.

c. Comparison of the signs

The signs to be compared are the following:

McDonald's	SUPERMAC'S
earlier trademark	contested trademark

The earlier mark is well-known in Germany. Therefore, the relevant territory is Germany.

As regards a similarity between the marks, we refer to our comments above regarding the opposing CTM registration 62497 "McDONALD'S" which apply equally.

Summarizing, the signs are similar to a medium degree.

3. Global assessment of the likelihood of confusion

a. Applicable case law of the Court of Justice

According to the settled case law of the Court of Justice, the risk that the public might believe that the goods or services in question come from the

same undertaking or, as the case may be, from economically linked undertakings, constitutes a likelihood of confusion (see Canon, paragraph 29).

Furthermore, a global assessment of the likelihood of confusion implies some interdependence between the relevant factors and in particular a similarity between the marks and between the goods or services, and a lesser degree of similarity between the goods may be offset by a greater degree of similarity between the marks and vice versa (see Canon, paragraph 17).

Moreover, marks with a highly distinctive character, either per se or because of the reputation they possess on the market, enjoy broader protection than marks with a less distinctive character (see Canon, paragraph 18). The distinctive character of the earlier mark must be taken into account when determining whether the similarity between the goods and services is enough to give rise to a likelihood of confusion (see Canon, paragraph 24).

b. Higher distinctiveness of the mark “McDONALD’S”

The Opponent has shown under II.2.a. above that the mark “McDONALD’S” is well-known in the European Union and, in particular, in Germany. Hence, the prior marks “McDONALD’S” are highly distinctive and, therefore, enjoy a broader scope of protection. Furthermore, the Opponent has shown that the element “Mc”/“Mac” also enjoys a higher distinctiveness. When comparing the Opponent’s marks to the Applicant’s mark “SUPERMAC’S”, one can see that the marks themselves are identical in structure, and that the overall impression of each mark is similar due to the inclusion of the Opponent’s distinctive term “Mc”/“Mac”. Each mark of the Opponent contains the term “Mc” or “Mac” and a secondary, often descriptive term such as “BIG”, “NUGGETS”, “CHICKEN”, “TOAST”,

“COUNTRY” or “DOUBLE”. As such, a consumer will take notice of the “Mc”/“Mac” term as it is more distinctive and memorable than the following geographical or services identification term.

c. Family of “Mc” marks

The Opponent furthermore submits that he owns a family of marks with the common element “Mc”/“Mac”. According to the decision of the General Court of 26 February 2006 in Case T-194/03 – *Il Ponte Finanziaria SpA v OHIM*, a likelihood of confusion may be created by the possibility of association between the trademark applied for and the earlier marks forming part of the series of marks, where the trademark applied for displays such similarities to those marks as might lead the consumer to believe that it forms part of the same series and therefore that the goods covered by it have the same commercial origin as those covered by the earlier trademarks, or a related origin (paragraph 124).

The General Court furthermore held that such a likelihood of association may be invoked only if two conditions are cumulatively satisfied: 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” (*Il Ponte Finanziaria SpA v OHIM*, paragraph 126). Secondly, the trademark 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 (*Il Ponte Finanziaria SpA v OHIM*, paragraph 127).

Here, the Opponent has provided evidence of use in relation to a number of marks of his “Mc”/“Mac” family of marks (see, in particular, **Annexes 10 and 11**). In particular, the printouts from the national McDonald’s websites in the European Union show use of the marks McDonald’s,

McChicken, Chicken McNuggets, McCafé, Big Mac, McToast, McFlurry, McRib, Egg McMuffin, McMuffin, McFeast, McBacon, McNuggets, McWrap and McFish. Moreover, the surveys (see **Annexes 14 to 17**) have shown that the element “Mc”/”Mac” alone is well-known and recognized as referring to McDonald’s by the public. Furthermore, OHIM and national Courts and Offices acknowledged that the Opponent can rely on a “Mc”/”Mac” family of marks (see OHIM decisions cited above and **Annexes 18 to 21**). Hence, the first condition established by the General Court in *Il Ponte Finanziaria SpA v OHIM* is fulfilled.

As regards the second condition, as shown above, the earlier marks “McDonald’s” and the application “SUPERMAC’S” contain the phonetically, visually and conceptually identical element “Mc”/”Mac”, which is the common element of the Opponent’s “Mc”/”Mac” family of marks. A further characteristic of the Opponent’s “Mc”/”Mac” family of marks is that the element “Mc”/”Mac” is combined with descriptive elements, such as “BIG”, “CHICKEN”, “TOAST”, “FISH”, “COUNTRY” or “DOUBLE”. Hence, the mark “SUPERMAC’S” clearly fits into the Opponent’s family of “Mc”/”Mac” marks. Therefore, the second requirement established by the General Court in *Il Ponte Finanziaria SpA v OHIM* is also fulfilled.

As the public is well aware of the Opponent’s use of the “Mc”/”Mac” term in combination with a descriptive element, it is quite likely that consumers will associate the mark “SUPERMAC’S” with the product and service line of McDonald’s. This possibility of the public believing that the Applicant’s “SUPERMAC’S” mark is a member of Opponent’s family of marks is even more likely since the goods and services of the respective parties are identical or at least highly similar.

Accordingly, the Opponent submits that as a result of its well-known use of the “Mc”/”Mac” component in various combinations of trademarks and

its ownership of a family of “Mc”/”Mac” marks, it is likely that the public would believe that the Applicant’s use of the mark “SUPERMAC’S” simply identifies a new service in the long and successful “Mc”/”Mac” product line of McDonald’s.

d. Conclusion

Since the respective goods and services are identical or highly similar, the marks “McDONALD’S” and “SUPERMAC’S” are similar, the distinctiveness of the earlier marks is very high and the Opponent can rely on a “Mc”/”Mac” family of marks, the public could believe that the goods or services come from the same undertaking or from economically linked undertakings which constitutes a likelihood of confusion.

III. Unfair advantage taken of the distinctiveness or repute of the earlier marks, Article 8(5) CTMR

The registration of the Applicant’s “SUPERMAC’S” mark will also take unfair advantage of the distinctive character and the reputation associated with the Opponent’s trademarks, which is contrary to the provisions of Article 8 (5) CTMR. Even if the public were able to distinguish between the marks themselves, it is likely that the public would believe that the “SUPERMAC’S” mark is used to identify a new service from McDonald’s offering of “Mc”/”Mac” products.

According to Article 8(5) CTMR, upon opposition by the proprietor of an earlier trademark, the trademark applied for shall not be registered where it is identical with, or similar to, the earlier trademark and is to be registered for goods which are not similar to those for which the earlier trademark is registered, where, in the case of an earlier Community trademark, the trademark has a reputation in the Community and, in the case of an

earlier national trademark, the trademark has a reputation in the Member State concerned and where the use without due cause of the trademark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trademark.

In accordance with the case law of the Court of Justice, one of the three types of injury, which are (i) detriment to the distinctive character of the mark, (ii) detriment to the repute of the mark, and (iii) taking unfair advantage of the distinctive character or the repute of the mark, is sufficient for Article 8(5) CTMR to apply (see Judgment of the Court of Justice in Case C-252/07, Intel Corporation Inc. v CPM United Kingdom Ltd, paragraph 28).

1. Earlier marks with reputation

The Opponent has shown that the earlier marks' reputation does not only satisfy the requirements of Article 8 (5) CTMR, but goes far beyond given that the mark "McDONALD'S" is well-known at least in Germany within the meaning of Article 6bis of the Paris Convention. Hence, there can be no doubt that the mark "McDONALD'S" has acquired a reputation with respect 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, sugar.

Class 32:

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

Class 43:

Restaurant services.

2. Comparison of the signs

The examination of the likelihood of confusion showed that the marks “McDONALD’S” and “SUPERMAC’S” are similar, in particular in view of the high distinctiveness of the mark “McDONALD’S” and the fact that the Opponent can rely on a family of “Mc”/“Mac” marks.

Furthermore, according to the case law of the Court of Justice, it is sufficient for the degree of similarity between the mark with a reputation and the later mark to have the effect that the relevant section of the public establishes a link between the marks (see Judgment of the Court of Justice in Case C-408/01 *Adidas-Salomon and Adidas Benelux*, paragraph 31).

While the protection provided by Article 8 (5) CTMR does not require the existence of a likelihood of confusion, such a link between the conflicting marks is necessarily established when there is a likelihood of confusion (see *Intel Corporation Inc. v CPM United Kingdom Ltd*, paragraph 57).

Given that the Opponent has shown that there exists a likelihood of confusion between the marks “McDONALD’S” and “SUPERMAC’S” with regard to goods and services applied for in classes 29, 30 and 43, the conditions of similarity in Article 8 (5) CTMR are fulfilled even if the similarity of the marks “McDONALD’S” and “SUPERMAC’S” would be considered as low.

3. **Unfair advantage taken of the distinctive character/the repute of the earlier marks**

According to the case law of the Court of Justice, the concept of taking unfair advantage of the distinctive character or the repute of the trademark (also referred to as “free-riding”) relates not to the detriment caused to the mark but to the advantage taken by the third party as a result of the use of the similar sign (see Judgment of the Court of Justice in Case C- 487/07 *L’Oréal SA et al. v Bellure NV et al.*, paragraph 41).

The Court has furthermore held that the advantage is taken unfairly by the third party where that party seeks by that use to ride on the coat-tails of the mark with a reputation in order to benefit from the power of attraction, the reputation and/or 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 mark’s image (*L’Oréal SA et al. v Bellure NV et al.*, paragraph 50).

In *L’Oréal SA et al. v Bellure N.V. et al.*, the Court furthermore stressed that the specific condition of the protection of mark with a reputation consists of a use without due cause of a sign identical with or similar to an earlier mark which takes or would take unfair advantage of, or is or would be detrimental to, the distinctive character or the repute of the earlier mark (paragraph 34). That means that actual detriment or actual unfair advantage need not to be shown.

Moreover, the Court has held that the stronger the distinctive character of the earlier mark, the more likely it is that, confronted with a later identical or similar mark, the relevant public will call that earlier mark to mind (see *Intel Corporation Inc. v CPM United Kingdom Ltd*, paragraph 54).

Here, the evidence provided by the Opponent as to the reputation of the mark “McDONALD’S” and the element “Mc”/”Mac” has shown that they carry the Opponent’s goodwill, which was obtained by the longstanding and extensive use and promotion of the sign “McDONALD’S” and the “Mc”/”Mac” family of marks. As it has been shown, the recognition of the mark “McDONALD’S” and the element “Mc”/”Mac” among the relevant public is and has been very high. The mark “McDONALD’S” does not only enjoy reputation within the meaning of Article 8 (5) CTMR, but is even well-known within the meaning of Article 6bis of the Paris Convention.

Moreover, as mentioned above, the mark “SUPERMAC’S” clearly fits into the Opponent’s “Mc”/”Mac” family of marks. When being confronted with the mark “SUPERMAC’S” in relation to the contested goods and services, the public will inevitably believe that the so-designated goods and services come from the Opponent.

The long established use of the Opponent’s mark “McDONALD’S” and the “Mc”/”Mac” family of marks would result in a transfer of the goodwill of the earlier reputed marks in favour of the Applicant’s trademark. The Applicant would benefit from the Opponent’s investments in the mark “McDONALD’S” and the “Mc”/”Mac” family of marks if the contested application would be registered.

Summarizing, use of the Applicant’s mark would take unfair advantage of the distinctiveness and the repute of the earlier trademarks within the meaning of Article 8 (5) CTMR.

4. Without due cause

Article 8 (5) CTMR requires that any such possible use of the later mark must be “without due cause” to be sanctioned. There is no indication of

any due cause for using the mark “SUPERMAC’S” for the goods and services applied for in the Opponent’s core classes 29, 30 and 43. The existence of a cause justifying the use of the trade mark applied for is a defence which the Applicant may raise, in which case it must prove it.


5. Conclusion

In view of the above, the opposition is well-founded on the grounds of Art. 8 (5) CTMR. Hence, the Opposition Division of OHIM recently – correctly – upheld oppositions filed by the Opponent against comparable CTM applications for “McParking” and “McGym” on basis of Art. 8 (5) CTMR. The decisions are attached as

Annexes 22 and 23.

V. Conclusion

As the Opponent has shown that there is a likelihood of confusion within the meaning of Article 8 (1) (b) CTMR with respect to goods and services of classes 29, 30 and 43, and that use of the contested application in respect of any of the goods and services applied for in classes 29, 30 and 43 would take unfair advantage of the distinctive character and the repute of the earlier marks within the meaning of Article 8 (5) CTMR, it is requested to uphold opposition no. B 002386582 for all the contested goods and services and to reject application no. 012680591 in its entirety.


Claus M. Eckhardt
Rechtsanwalt

Encl.:
Schedule of Annexes
Annexes 1 – 23
1 Duplicate