

BENELUX OFFICE FOR INTELLECTUAL PROPERTY
OPPOSITION DECISION
N° 2018591
Of 28 June 2024

Opponent: **McDonald's International Property Company, Ltd. Delaware corporation**
N. Carpenter Street 110
60607 Chicago, Illinois
United States of America

Representative: **Octrooibureau Vriesendorp & Gaade B.V.**
Koninginnegracht 19
2514 AB 's-Gravenhage
Netherlands

Trademark invoked 1: **Well-known trademark pursuant to Article 6bis Paris Union Convention (UvP)**
McDonald's

Trademark invoked 2: **Well-known trademark pursuant to Article 6bis Paris Union Convention (UvP)**
Mc

Trademark invoked 3: **Benelux registration 153444**
McDonald's

Trademark invoked 4: **Benelux registration 660508**
McPlant

Trademark invoked 5: **Benelux registration 660508**
McKROKET

Trademark invoked 6: **Benelux registration 643736**
McFLURRY

- Trademark invoked 7:** **European Union registration 16188**
McCHICKEN
- Trademark invoked 8:** **European Union registration 8664617**
McWRAP
- Trademark invoked 9:** **European Union registration 16238**
McNUGGETS
- Trademark invoked 10:** **European Union registration 9062118**
McCAFE
- Trademark invoked 11:** **European Union registration 4562419**
MCMUFFIN

against

Defendant: **BIP Holland B.V.**
Princenhagelaan 13
4813 DA Breda
Netherlands

Representative: **Novagraaf Nederland B.V.**
Hoogoorddreef 5
1101 BA Amsterdam
Netherlands

Contested trademark: **Benelux application 1473777**
MACBEANS

I. FACTS AND PROCEEDINGS**A. Facts**

1. The opposition is directed against the Benelux application for the word trademark 'MACBEANS' for goods in class 30. This application was processed under the number 1473777, filed on 17 November 2022 and published on 21 November 2022.
2. On 19 January 2023, the opponent filed an opposition against this application. The opposition is based on the following earlier trademarks:
 - 'McDonald's', according to the opponent, a well-known trademark within the meaning of Article 6bis of the Paris Union Convention (UvP);
 - 'Mc', according to the opponent a well-known trademark within the meaning of Article 6bis UvP;
 - Benelux registration 153444, for the word trademark 'McDonald's' filed on 6 July 1987 and registered on 1st December 1987 for services in classes 35, 41 and 42;
 - Benelux registration 1428926, for the word trademark 'McPlant' filed on 9 November 2020 and registered on 25 February 2021 for goods in class 30;
 - Benelux registration 660508, for the word trademark 'McKROKET' filed on 2 September 1999 and registered on 1st July 2000 for goods in class 30;
 - Benelux registration 643736, for the word trademark 'McFLURRY' filed on 20 January 1999 and registered on 1st August 1999 for goods in classes 29 and 30;
 - European Union registration 16188, for the word trademark 'McCHICKEN' filed on 1st April 1996 and registered on 2 February 1998 for goods in class 30;
 - European Union registration 8664617, for the word trademark 'McWRAP' filed on 5 November 2009 and registered on 15 June 2010 for goods and services in classes 29, 30 and 43;
 - European Union registration 16238, for the word trademark 'McNUGGETS' filed on 1st April 1996 and registered on 16 March 1998 for goods in classes 29, 30 and 31;
 - European Union registration 9062118, for the word trademark 'McCAFE' filed on 28 April 2010 and registered on 1st September 2012 for goods in class 30;
 - European Union registration 4562419, for the word trademark 'MCMUFFIN' filed on 27 July 2005 and registered on 7 August 2006 for goods and services in classes 29, 30 and 43.
3. According to the registers, the opponent is the actual holder of the trademarks invoked.
4. The opposition is directed against all the goods of the contested application and is based on part of the goods and services of the trademarks invoked.
5. The language of the proceedings is English.

B. Proceedings

6. The opposition is admissible and the Benelux Office for Intellectual Property (hereinafter referred to as: "the Office") notified the parties on 23 January 2023. During the administrative phase of the proceedings both parties filed arguments and at the defendant's request, the opponent provided proof of use. Besides, the defendant limited the contested trademark by withdrawing the 'confectionery' from class 30. The course of the proceedings meets the requirements as stated in the Benelux Convention on Intellectual Property (hereinafter referred to as: "BCIP") and the Implementing Regulations (hereinafter referred to as: "IR"). The administrative phase of the procedure was completed on 20 December 2023.

II. ARGUMENTS OF THE PARTIES

7. Pursuant to Article 2.14 (2)(a) BCIP, the opponent filed an opposition with the Office, in accordance with the provisions of the following articles:

- Article 2.2ter (1)(b) BCIP: *"A trademark shall, in case an opposition is filed, not be registered or, if registered, shall be liable to be declared invalid where: [...] b. 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; the likelihood of confusion includes the likelihood of association with the earlier trademark"*.

- Article 2.2ter (3)(a) BCIP: *"Furthermore, a trademark shall, in case an opposition is filed, not be registered or, if registered, shall be liable to be declared invalid where: [...] a. it is identical with, or similar to, an earlier trademark irrespective of whether the goods or services for which it is applied or registered are identical with, similar to or not similar to those for which the earlier trademark is registered, where the earlier trademark has a reputation in the Benelux territory or, in the case of an EU trademark, has a reputation in the European Union and the use of the later trademark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trademark"*.

8. The opponent invokes several registered trademark rights (see paragraph 2) and also well-known trademarks as referred to in Article 2.2ter (2)(d) BCIP.

A. Opponent's arguments

9. The opponent indicates that he (McDonald's) is the leading global food service retailer with over 40,000 restaurants in approximately 120 countries and is one of the most famous trademarks in the world. The first restaurant was opened in 1955 in the state of Illinois in the United States. The first restaurant in the Netherlands was opened in Voorburg in 1971 and the first restaurant in Belgium, was opened in Brussels in 1978. There are now more than 250 restaurants in the Netherlands, 107 in Belgium and 12 in Luxembourg. Over 20,000 people work at McDonald's in the Netherlands and over 5,000 in Belgium. The opponent also refers to the websites www.mcdonalds.nl and www.mcdonalds.be which contain relevant data regarding the intensity, geographical scope and duration of use of McDonald's serie of trademarks, the size of the company, number of customers, employees and sales worldwide, but also for the Netherlands and Belgium alone.

10. According to the opponent, the trademark 'McDonald's' is well-known mainly for (provision of) food and related services. Besides, the trademark 'Mc' is also well-known, in particular through its frequent use in a large number of trademarks. The trademarks invoked are part of a serie, a 'family' of trademarks to which a large scope of protection accrues, according to the opponent.

11. The opponent considers the contested goods to be similar with the goods and services of the trademarks. They are food products for human consumption or services related to the provision of food and beverages. Especially, the opponent finds the confectionery related goods of the contested trademark to be highly similar to the goods 'cakes, cookies and chocolate' of the trademark invoked McCAFE as they coincide in manufacturer, distribution channels, points of sale and relevant public.

12. The opponent states that the relevant public in this matter is the general public, namely the average consumer as the goods involved are aimed to human consumption.

13. According to the opponent, an individual comparison of the trademarks invoked with the contested trademark shows that each trademark invoked is similar to the contested trademark, in the sense that all the marks in question have the similar component 'Mc' or 'MAC' in them and, in almost all cases, also in the same place, namely as a prefix. The contested trademark is also similar to the trademarks invoked since all contain the identical component 'MAC' or 'Mc' respectively, which is the dominant element since they are followed by a descriptive word, namely 'plant', 'kroket', 'beans', 'chicken', 'wrap', etc.

14. Conceptually, there is similarity as part of the relevant public will perceive the component 'Mc' as referring to a surname of Gaelic origin. The prefix 'Mc' or 'Mac' is used in both Scottish and Irish names and means 'son'. Further, the opponent affirms that the contested trademark, MACBEANS, will undoubtedly be associated with something edible, namely a legume and that it may especially be associated with the opponent's trademark McPLANT, as reference to a vegetable/plant product. The opponent finds that the trademarks contain the same concept, namely the prefix Mc/Mac followed by the name of a menu of food product.

15. Phonetically, the opponent is in the opinion of an existing similarity between the contested trademark and the trademarks invoked as they share the pronunciation of the prefix Mac or Mc respectively.

16. Visually, the opponent finds the trademarks similar to a low degree due to the difference in writing of Mc and Mac.

17. The opponent states that the first part of a trademark generally attracts the most attention, and in this respect, considers that the elements 'Mc' and 'MAC' respectively, are moreover dominant since the respective suffixes are descriptive in nature, according to the opponent. Besides, the opponent affirms that the component 'Mc' occupies a special place in the trademarks invoked and the McDonald's company and submits in this respect several court decisions in support of this assertion.

18. According to the opponent, McDonald's has acquired a very high reputation through its years of intensive advertising campaigns and uniform appearance of its eateries. This applies to the trade and brand name McDonald's, but also to the abbreviation 'Mc' and to a significant proportion of its derived brand names. According to the opponent, McDonald's is the prime example of a well-known trademark within the meaning of Article 6bis UvP. The opponent states, among others, that the brand value of the McDonald's worldwide was USD 154.9 billion in 2022 (Information published by Statista Research Department), with over 40,000 restaurants in approximately 120 countries. The opponent stresses that, already in 2010, the annual revenue of McDonald's amounted to USD 24.08 billion and increased to USD 27.01 billion in 2011. In 2019 the worldwide annual revenue of McDonald's amounted to USD 23.36 billion and increased to USD 23.22 billion in 2021 as shown in McDonald's Corporation 2021 Annual Report Several.

19. The opponent also provides with court judgments confirming that the combination of the component 'Mc' and a descriptive component referring to a food product has acquired a highly distinctive character, according to the opponent.

20. According to the opponent, the scope of protection is further broadened by the fact that it is a serial mark. In the present case, the opponent invokes, in addition to the 9 trademark registrations invoked, 11 trademark registrations forming a serie. In addition to the trademarks cited in this case, the opponent raises 5 trademarks starting with the prefix 'Mc' combined with a descriptive element.

21. The opponent also claims that the use of the contested trademark takes unfair advantage of and is detrimental to the highly distinctive character of McDonald's and the serie of 'Mc' trademarks derived therefrom (invoked).

22. In conclusion, the opponent states that there is likelihood of confusion within the meaning of articles 2.2ter (1)(b) and (d) BCIP with respect to the goods in class 30 and that the use of the contested application in relation to the goods applied for would take unfair advantage of the distinctive character and repute of the trademarks invoked within the meaning of article 2ter (3)(a) BCIP. Based on all of the foregoing, the opponent requests that the opposition filed be upheld in its entirety and that the defendant be ordered to pay the costs.

23. At the defendant's request, the opponent submitted evidence of use.

B. Defendant's arguments

24. As a first step, the defendant asked the opponent to provide evidence of use of the trademarks invoked in class 30. More precisely, the defendant requested evidence regarding:

- the use of the trademark 'McMuffin' for class 30, namely muffins and biscuits;
- the use of the trademark 'McFlurry' for desserts (as far as falling in class 30);
- the use of the trademarks 'McWrap', 'McKROKET' and 'McChicken' for class 30, namely biscuits, bread, cakes, cookies, chocolate, pastries and sugar;
- the use of the trademark 'McNUGGETS' for class 30, namely sugar;
- the use of the trademarks 'McCAFE' for biscuits, bread, cakes, cookies, chocolate, pastries, sugar and desserts (as far as falling in class 30).

25. After analyzing the evidence of use and the arguments presented by the opponent, the defendant first concludes that based on the evidence provided, the opponent has only provided evidence for desserts in class 30 for the trademark McFLURRY and for biscuits, bread, cakes, cookies, chocolate, coffee, coffee substitutes, tea, pastries in class 30 for the trademark McCAFE. As a result, the contested trademark MACBEANS should be compared with these two trademarks and the trademark McDonald's (D699834) for the horeca services in class 42, as far as the invoked prior registrations are concerned.

26. The defendant then indicates that a separate request to delete 'confectionery' from the list of the contested trademark has been sent to BOIP. As a result, the contested trademark reflects the remaining goods: 'candy, gummy, chewing gums, chewing candies, liquorice, lollipops'.

27. According to the defendant, the goods claimed in class 30 for which the opponent has proven use, namely 'desserts' and 'biscuits, bread, cakes, cookies, chocolate, coffee, coffee substitutes, tea, pastries' are dissimilar to 'candy, gummy, chewing candies, liquorice, and lollipops'. The opponent states that they have different natures, specific intended purposes, and methods of use. The defendant also argues that the horeca services in class 42 claimed under the trademark invoked McDonald's are dissimilar to 'candy, gummy, chewing candies, liquorice, and lollipops'. The defendant is therefore of the opinion that the contested goods and the opponent's services have nothing in common: they differ in nature, purpose, and method of use, the goods and services are not complementary and do not target the same consumers.

28. The defendant underlines that the opponent states that McDonald's owns a family of trademarks with the common element 'Mc'/'Mac'. A search on Google demonstrates that MAC does not have a direct connection with McDonald's. When searching on the internet for 'Mc', most hits are related to McDonald's. However, when searching for 'Mac' there is no reference to McDonald's but mainly to M.A.C. Cosmetics and Mac laptops by Apple. The defendant provides evidence of his searches. Therefore, the defendant disputes that the element MAC has the same recognition with the public as 'Mc'.

29. According to the defendant, the opponent invokes nine trademarks with the prefix 'Mc' and mentions additional EU trademark registrations with the prefix 'Mc' and further the trademarks BIG MAC, GREEK MAC, and PITAMAC. In this context, the defendant wishes to point out that in the opponent's trademarks consisting of MAC, this element is placed at the end of the trademarks and not as a prefix like the contested trademark MACBEANS.

30. The defendant agrees that both parties are involved in consumer products for human consumption. However, the defendant disputes that his products, being 'candy, gummy, chewing gums, chewing candies, liquorice, lollipops', are intended for the general public. From the defendant's point of view, it is clear that the products are aimed at children. The defendant attaches a copy of the webpage to demonstrate this. The defendant therefore concludes that it is at least disputable whether a denomination combined with the element 'MAC' without the typical stylized yellow M used by McDonald's will be recognized by children as originating from McDonald's.

31. With regard to the opponent's assertion that all earlier marks are composed of the respective prefixes Mc and MAC followed by a descriptive word element, i.e., PLANT, KROKET, CHICKEN, WRAP, NUGGETS, CAFÉ, and MUFFIN, the applicant wishes to point out that all invoked trademarks have the prefix 'Mc' and none of the invoked trademarks have the prefix MAC. The defendant notes that the opponent admits that the similarity between the marks is low as he states that *'Visually, the trademarks to be compared are similar to a low degree due to the difference in writing of Mc and Mac'*.

32. According to the defendant, the goods in class 30 are fairly ordinary consumer products and are commonly purchased in supermarkets or establishments where goods are arranged on shelves and consumers are guided by the visual impact of the mark they are looking for. Therefore, the elements of visual similarity and dissimilarity between the signs at issue are of greater importance than the elements of aural and conceptual similarity between those signs. The defendant points out that the goods claimed by the opponent, namely 'candy, gummy, chewing gums, chewing candies, liquorice, lollipops', will be sold in supermarkets and candy stores. The candy is presented in supermarkets in a different area than bread, meat, pastry, desserts, coffee, and tea. Therefore, the public will not link a product in the sugar and candy section of a supermarket with fast-food related goods. Besides, the goods of the opponent are not offered for sale in supermarkets, but only in McDonald's restaurants.

33. The defendant argues that the relevant public will not recognize the trademarks invoked in the contested trademark. According to him, there is no conceptual link and the signs differ strongly. The aural

similarity to a below-average degree is insufficient to outweigh the lack of conceptual similarity and the low degree of visual similarity due to a coincidence in some letters. The defendant considers that the overall impression that the trademarks invoked will cause in the consumer's minds is sufficiently distanced from that of the contested trademark in order for the consumers not to confuse or associate the commercial origins of their goods. Considering all the above, even assuming that the goods are similar, there is no likelihood of confusion on the part of the public.

34. The defendant concludes that in view of all arguments above, the opposition is not well-founded. Therefore, the defendant hereby requests the Office to reject the opposition and accept the contested trademark for registration.

III. DECISION

A. Proof of use

35. In accordance with Article 2.16bis BCIP, the opponent, at the request of the defendant, shall furnish proof that the trademark invoked has been put to genuine use as provided for in Article 2.23bis BCIP or that proper reasons for non-use existed. The evidence must show genuine use in five years prior to the filing or priority date of the trademark against which the opposition is lodged.

36. Respect for the principle that both sides should be heard referred to in Article 2.16(1) BCIP implies in particular that the examination of the opposition is limited to the arguments, facts and evidence put forward by the parties.

37. The defendant requested evidence of use only regarding some goods designated by the trademarks invoked (see paragraph 24). The Office thus establishes that use of the trademarks for goods and services not covered by the defendant's request is not contested.

38. The opponent filed proof of use of the relevant rights invoked and argues that these invoked trademarks are duly used. The defendant finds that the opponent has proven use of the trademark McFLURRY in relation to desserts of class 30, use of the trademark McCAFE in relation to biscuits, bread, cakes, cookies, chocolate, coffee, coffee substitutes, tea, pastries of class 30, and use of the trademark McDonald's for the horeca services in class 42 (see point 26). In view of the foregoing the use of the above trademarks for the mentioned goods and services is therefore clearly *in confesso*.

B. Reputation

39. The opposition is based, among other, on the reputation of the Benelux trademark registration no. 153444 McDonald's registered for horeca services in class 42. The Office will first assess the opposition on this basis.

40. Article 2.2ter (3)(a) BCIP is only applicable when the following conditions are met:

- (i) The conflicting signs are either identical or similar;
- (ii) The earlier trademark has a reputation;
- (iii) The existence of a link between the trademarks and use of the contested trademark would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trademark;
- (iv) There is no due cause for the use of the contested trademark.

41. According to the Court, the types of injury mentioned in this article, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them.¹

42. The abovementioned requirements are cumulative and, therefore, the absence of any one of them will lead to the rejection of the opposition based on Article 2.2ter (3)(a) BCIP.

i) Similarity between the signs

43. To assess the degree of similarity between the conflicting signs, their visual, phonetic, and conceptual similarity should be determined. The comparison must be based on the overall impression given by those signs. In the assessment, the perception of the signs by the average consumer plays a decisive role. The average consumer normally perceives a mark as a whole and does not engage in an analysis of its various details.²

44. Although the comparison must be based on the overall impression made by those signs on the relevant public, account must nevertheless be taken of the intrinsic qualities of the signs at issue.³ The overall impression created in the mind of the relevant public by a complex trademark may, in certain circumstances, be dominated by one or more of its components. Regarding the assessment of whether this is the case, account must be taken, in particular, of the intrinsic qualities of each of those components by comparing them with those of other components. In addition and accessorially, account may be taken of the relative position of the various components within the arrangement of the complex mark.⁴

45. The assessment of the similarity between the signs, regarding the visual, phonetical and conceptual similarity of the signs, must be based on the overall impression created by them, taking into account, inter alia, their distinctive and dominant components.

46. The signs to be compared are the following:

Opposition based on:	Opposition directed against:
McDonald's	MACBEANS

47. The trademark invoked is a word trademark consisting of nine letters and an apostrophe before the last letter, McDonald's.

48. The contested trademark is a word trademark consisting of eight letters, MACBEANS.

49. Given that the trademarks in question are word trademarks, the fact that parts are represented in capital letters and parts are represented in lower-case letters, is irrelevant for the purposes of a visual comparison of those trademarks. The protection offered by the registration of a word trademark applies to

¹ CJEU 27 November 2008, C-252/07, ECLI:EU:C:2008:655, point 66 (Intel).

² CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 58 and the case-law mentioned there (Equivalenza).

³ CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 71 and the case-law mentioned there (Equivalenza).

⁴ General Court (EU) 23 October 2002, T-6/01, ECLI:EU:T:2002:261, points 34 en 35 (Matratzen) en 13 December 2007, T-242/06, ECLI:EU:T:2007:391, point 47 (El Charcutero Artesano).

the word stated in the application for registration and not to the individual graphic or stylistic characteristics which that trademark might possess.⁵

50. Although the average consumer usually perceives a mark as a whole and does not pay attention to its various details⁶, this does not alter the fact that a consumer who perceives a word mark will decompose that mark into word elements which have a concrete meaning for him or which are similar to words he already knows.⁷ Also, the public will not generally perceive the descriptive element of a composite trademark as the distinctive and dominant element of the overall impression created by that trademark.⁸ Moreover, it is settled case-law that consumers generally attach more importance to the first part of a trademark.⁹ It is likely that consumers will divide the marks into the initial elements 'Mc' and 'MAC' and the subsequent words, 'Donald's' and 'BEANS'.

51. The element 'BEANS' in the contested trademark will be perceived as referring to the shape of the goods applied for in class 30. Indeed, the consumer is used to bean-shaped candy, like "jellybean"¹⁰. This verbal element is therefore considered non-dominant in the contested trademark.

52. The trademark invoked and the contested trademark are both composed of the respective prefixes 'Mc' and 'MAC'. This initial element is also the dominant element in the contested sign.

53. Visually and phonetically, both marks begin with the corresponding dominant element 'Mc' and 'MAC' respectively. Their pronunciation is the same. Visually they coincide in the letters M and C. The subsequent elements 'Donald's' and 'BEANS' differ visually and phonetically. The similarity lies in the dominant initial element.

54. The word 'MAC' is the Gaelic word for son. In many Irish and Scottish names, it is used as a prefix followed by (the genitive of) the name of a (legendary) ancestor. Traditionally, people did not pay precise attention to the correct spelling. In the unified names, some families write 'Mac' and others 'Mc'. The two words therefore have the same origin and meaning. The signs are thus conceptually similar to some extent.

55. The Office establishes that the signs are therefore similar to a certain degree.

ii) Reputation of the trademark invoked

56. In the case the invoked earlier trademark is a Benelux trademark, the condition of reputation is fulfilled, as far as the territorial aspect is concerned, when the trademark has a reputation in a substantial part of the Benelux territory, which part may consist of a part of one of the Benelux countries.¹¹

57. This assessment concerns the average consumer who is deemed to be reasonably well informed and reasonably observant and circumspect.¹² The public amongst which the earlier trademark must have acquired a reputation is that concerned with that trademark, that is to say, depending on the good or service marketed, either the public at large or a more specialist public, for example traders in a specific sector.¹³

⁵ General Court (EU) 31 January 2013, T-66/11, ECLI:EU:T:2013:48, point 57 (Babilu).

⁶ CJEU 22 June 1999, C-342/97, ECLI:EU:C:1999:323 (Lloyd Schuhfabrik Meyer).

⁷ General Court (EU) 13 February 2007, T-256/04, ECLI: EU:T:2007:46 (Respicur).

⁸ General Court 3 July 2003, T-129/01, ECLI:EU:T:2003:184, point 53 (Budmen).

⁹ General Court (EU) 17 March 2004, T-183/02 and T-184/02, ECLI:EU:T:2004:79, point 81 (Mundicor).

¹⁰ https://dictionary.cambridge.org/dictionary/english/jellybean#google_vignette.

¹¹ CJEU 14 September 1999, C-375/97, ECLI:EU:C:1999:408, point 29 (Chevy).

¹² CJEU 27 November 2008, C-252/07, ECLI:EU:C:2008:655, point 36 (Intel).

¹³ CJEU 14 September 1999, C-375/97, ECLI:EU:C:1999:408, point 24 (General Motors).

58. In examining the degree of knowledge amongst the relevant public all the relevant facts of the case, in particular the market share held by the trademark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it, must be taken into consideration.¹⁴

59. The relevant point in time to establish that the earlier trademark has acquired a reputation is the filing date or, where appropriate, the priority date of the contested trademark.¹⁵ The relevant point in time in this case is 17 November 2022, namely the date of the filing of the contested trademark.

Analysis of the evidence

60. The opponent submitted the following documents in order to demonstrate reputation of the trademarks invoked:

- History of McDonald's (Wikipedia).
- Information from website McDonald's Nederland.
- Information from website McDonald's Belgium.
- List of McDonald's restaurants by country (2022).
- McDonald's annual report 2015.
- McDonald's annual report 2021.
- Excerpt Statista – McDonald's Statistics and Facts.
- Extracts from 'BrandZ Top 100 Most Valuable Global Brands' (Kantar) 2018 – 2022.
- Excerpt from "The World's Greatest Brands" showing No. 1 ranking McDonald's.
- Extract of a Consumer Survey August/September 1991 by Infratest Burke "Mc..."
- Extract of a Consumer Survey January/February 1992 by Infratest Burke "Mc..."
- Extract of Consumer Survey in Hungary conducted in March 2011 on 800 people by The Nielsen Company.
- Extract of Consumer Survey in Hungary conducted between February 28 and March 4, 2011, on 1000 people by The Nielsen Company.
- Decision General Court, dated 5 July 2016, case T-518/13, MACCOFFEE.
- Decision General Court, dated 10 October 2019, case T-428/18, McDreams.
- Decision Gerechtshof Den Bosch, 23 May 1989, McMussel.
- Decision Gerechtshof Amsterdam, 19 January 2006, McSmart.
- Prints website McDonald's Belgium, Germany, Finland, Italy, Netherlands, Poland, Hungary, Spain, Sweden.

¹⁴ CJEU 14 September 1999, C-375/97, ECLI:EU:C:1999:408, point 27 (General Motors).

¹⁵ See Article 2.2ter (2) and, by analogy, Article 2.30sexies BCIP).

61. According to the opponent's arguments and evidence, McDonald's annual revenue has exceeded 22 billion every year since at least 2010 and still does today, and there are more than 250 restaurants bearing the McDonald's brand in the Benelux countries.

62. It is clear from the documents produced by the opponent that the McDonald's trademark is indeed well-known in the Benelux for fast-food services, which is not disputed by the defendant.

iii) Risk of injury and link

63. The opponent alleges that the use of the contested trademark takes unfair advantage of and is detrimental to the highly distinctive character of McDonald's and the serie of 'Mc' trademarks derived therefrom (invoked) (see point 22).

64. When assessing this section, the following goods of the signs must be taken into consideration:

Opposition based on:	Opposition directed against:
CI 42 Horecadiensten en diensten verleend in, of betrekking hebbende op, restaurants en andere gelegenheden en voorzieningen zich bezighoudende met het verschaffen van voor de consumptie bereide dranken en voedsel, bereiding van meeneemmaaltijden. <i>Catering services and services provided in, or relating to, restaurants and other establishments and facilities engaged in the provision of beverages and food prepared for consumption, preparation of take-out meals.</i>	CI 30 Candy, gummy, chewing gums, chewing candies, liquorice, lollipops.

65. Article 2.2ter(3)(a) BCIP requires a certain degree of similarity between the earlier and the contested trademark, by virtue of which the relevant section of the public makes a connection between those two trademarks, that is to say, establishes a link between them even though it does not confuse them.¹⁶ This concerns an additional requirement arising from case-law of the CJEU for the application of Article 2.2ter(3)(a) BCIP.

66. The existence of such a link must be assessed globally, taking into account all factors relevant to the circumstances of the case. Those factors include: (i) the degree of similarity between the conflicting marks; (ii) the nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public; (iii) the strength of the earlier mark's reputation; (iv) the degree of the earlier mark's distinctive character, whether inherent or acquired through use; (v) the existence of the likelihood of confusion on the part of the public.¹⁷ The fact that, for the average consumer, who is reasonably well informed and reasonably observant and circumspect, the contested trademark would call the earlier trademark to mind is tantamount to the existence of such a link.¹⁸

¹⁶ CJEU 27 November 2008, C-252/07, ECLI:EU:C:2008:655, point 30 (Intel Corporation).

¹⁷ CJEU 27 November 2008, C-252/07, ECLI:EU:C:2008:655, points 41-42 (Intel Corporation).

¹⁸ CJEU 27 November 2008, C-252/07, ECLI:EU:C:2008:655, point 60 (Intel Corporation).

67. The opponent claims general reputation for its serie of trademarks which have, as common elements, the prefix 'Mc', followed by a noun, descriptive or otherwise (see paragraph 19). This is not disputed by the defendant (see point 28-29). The defendant only states that the reputation does not apply to the word MAC. However, this observation does not affect the determination of the reputation of the serie of trademarks invoked. The Office finds that 7 of the 11 trademarks invoked actually consist of the element 'Mc' followed by a descriptive element or otherwise, namely 'McPlant', 'McKROKET', 'McCHICKEN', 'McWRAP', 'McNUGGETS', 'McCAFE' and 'McMUFFIN', all related to food products or services. Additionally, the Office notes that the opponent refers to 5 other similar trademarks it owns, namely 'McBACON', 'McCRISPY', 'McSALAD' and 'McDrive'.

68. Based on the evidence provided by the opponent, the Office establishes that the opponent does enjoy a family of trademarks consisting of the element 'Mc' followed by a non-distinctive element, in the fast-food sector.

69. Considering that the dominant elements 'MAC' and 'Mc' in the signs are strongly similar (see paragraphs 53 and 54) and that the opponent has a serie of 'Mc' trademarks with a strong reputation for food-related services and goods, while the contested sign is applied for food products, the Office establishes that the relevant public, namely the general public, will establish a link between the signs.

70. The condition 'taking unfair advantage of, or be detrimental to the distinctive character or the repute of the earlier trademark' includes according to the CJEU three types of injury:

- Detriment to the distinctive character of the earlier trademark (dilution, whittling away or blurring);
- Detriment to the repute of the earlier trademark (tarnishment or degradation);
- Taking unfair advantage of the distinctive character or the repute of the trademark (parasitism or free riding).¹⁹

71. According to the CJEU one of these three types of injury suffices.²⁰

72. It is not required to provide evidence of actual detriment. Demonstrating a serious risk of such detriment is sufficient.

73. The existence of one of the mentioned types of injury, or a serious risk that such an injury will occur in the future, must - just as the existence of a link between the conflicting marks - be assessed globally, taking into account all factors relevant to the circumstances of the case.²¹

74. According to the Office, the contested sign would take unfair advantage of the distinctive character or the reputation of the earlier trademark. Considering the similarities between the signs, the established reputation of the McDonald's trademark, and the link the public will establish between opponent's well-known serie of Mc trademarks for food related goods and services and the contested sign containing a MAC prefix which is applied for food products, the relevant public might be influenced to purchase the goods of defendant, thereby granting the defendant an unfair advantage by benefiting from the opponent's marketing efforts without financial compensation (free riding), which is also not contested by the defendant.

¹⁹ CJEU 18 June 2009, C-487/07, ECLI:EU:C:2009:378, points 38-41 (L'Oréal/Bellure).

²⁰ CJEU 18 June 2009, C-487/07, ECLI:EU:C:2009:378, point 42 (L'Oréal/Bellure).

²¹ CJEU 3 September 2015, C-125/14, ECLI:EU:C:2015:539, point 32 (Iron & Smith/Unilever).

75. It is evident that the use of the contested trademark, without due cause, would unfairly benefit from the repute of the 'McDONALD'S trademark, leveraging its attraction and reputation.

76. Therefore, the opposition under Article 2.2ter (3)(a) BCIP is well-founded, and the contested trademark should be rejected for all the goods concerned.

IV. Use without due cause

77. An opposition cannot succeed under Article 2.2ter (3)(a) BCIP if the defendant demonstrates that it has a due cause for using the contested trademark. The CJEU has held that the concept of 'due cause' may not only include objectively overriding reasons but may also relate to the subjective interests of a third party using a sign which is identical or similar to the trademark with a reputation.²²

78. In this case, the defendant did not invoke any due cause regarding the use of the contested trademark.

Conclusion

79. For these reasons, the Office concludes that the use of the contested trademark does take unfair advantage of, or is detrimental to, the distinctive character or repute of the trademarks invoked. Consequently, one of the (necessary) conditions laid down in Article 2.2ter (3)(a) BCIP has been fulfilled and the opposition must be justified on this ground.

80. As the opposition is fully upheld on the basis of the third trademark invoked, it is not necessary to examine the other trademarks invoked and the related evidence of use in accordance with Article 1.14 (1)(i) IR.

²² CJEU 6 February 2014, C-65/12, ECLI:EU:C:2014:49, point 45 (Leidseplein Beheer/Red Bull).

IV. CONSEQUENCE

81. The opposition with number 2018591 is justified.

82. Benelux application 1473777 is not registered.

83. Since the opposition is justified, the defendant shall pay the opponent 1,045 euros in accordance with article 2.16 (5) BCIP in conjunction with rule 1.28 (3) IR. This decision constitutes an enforceable order pursuant to article 2.16 (5) BCIP.

The Hague, ...2024



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