

THE BIG MAC CASE
PROOF OF GENUINE USE
Nicholas Caddick Q.C.

H|C

Big Mac

- EU000062638
- Revoked for non-use (despite evidence of 215,000,000 Big Macs being sold in UK, Germany and France in 2016)
- Cancellation No.14 788C - 11/1/19
- Subject to appeal
- “Use it or lose it”



When is proof of use required?

- Revocation of existing mark
 - Art.58(1)(a) EUTMR
 - s.46(1)(a) TMA 1994
 - Existing trade mark may be revoked if it has not been put to genuine use in the 5 years before the application for revocation (unless there are proper reasons for non-use)
- Opposition to registration of a new mark
 - Art.47(2) EUTMR (EU 2017/1001)
 - s.6A(2) and (3) TMA 1994
 - Proprietor of earlier mark must show genuine use of earlier mark during the 5 years before filing of new mark (or proper reasons for non-use)

Country of use

- For UKTMs – genuine use is use “in the UK”
- For EUTMs – genuine use is use “in the Union”
 - Does not mean needs to have been used across all of EU. Disregard territorial borders
 - What is genuine use depends on nature of goods/services and of the relevant market (contrast e.g. *La Mer* (C-259/02), *Sofa Workshop* [2015] EWHC 1773 and *NOW* (T-278-13))



What is genuine use?

- Actual use by proprietor or authorised person
- Not merely token use
- Use as a trade mark (badge of origin)
- Use on the market – can include preparation to enter the market but not internal use nor use to promote other goods/services.
- Take into account nature of goods/services and of the market (even de minimis use can be enough)
- Need not be for profit
- Must be use of the trade mark



See e.g. *London Taxi Corporation Limited*
[2016] EWHC 52

Proving genuine use (1)

- Burden is on the registered proprietor (“R”)
- R should have evidence of use and must produce it
- R must put forward its “best case” - properly backed up with credible exhibits, invoices, adverts etc.)
- Tribunal will be sceptical in the absence of “solid” evidence
- “The rule is not just ‘use it or lose it’ but (the less catchy, if more reliable) ‘use it – and file the best evidence first time round – or lose it’”

See *Awareness Limited v Plymouth City Council* (Case BL O/236/13) and *Guccio Gucci SpA v Gerry Weber International AG* (O/424/14)

Proving genuine use (2)

Art.10 EUTMDR (EU 2018/626)

- Proof of use must consist of indications concerning “the place, time, extent and nature of use” – Art.10(3)
- Evidence must consist of written documents and, in principle be confined to submission of supporting documents and items such as packages, labels, price lists, catalogues, invoices, photographs, newspaper advertisements and statements in writing – Art.10(4)

Proving genuine use (3)

EUIPO Guidelines for Examination – Part C Opposition – Section 6 “Proof of Use”

- Requires “proof”
- Solid and objective evidence
- “Even proprietors of purportedly well-known marks must submit evidence to prove genuine use”
- Does material show use in the relevant 5 year period?

Some recent UKIPO cases

- *Securicor* 0/322/19 (6 June 2019)
 - *Only one credible document showing use (photo showing TM on side of van)*
 - *Other documents undated or in wrong period*
 - *Not for relevant goods/services*
- *Chevron Cars* 0/211/19 (18 April 2019)
 - “Sheer paucity of evidence ..is most striking”
 - “Invoices” produced were for internal use (and minimal)
 - No evidence of offers for sale on internet or in public
 - No promotional or sales literature
 - No sales or marketing figures



Big Mac – the evidence of use

McD's evidence of use:

- 3 affidavits by McD reps in Germany, France and UK:
 - Claiming significant sales figures for BigMac sandwiches – e.g. 215,000,000 Big Mac burgers sold in 2016
 - Attaching examples of packaging, brochures and menus
- Brochures and posters showing BigMac sandwiches and packaging
- Printouts from websites from 18 Member States depicting BigMac sandwiches
- Wikipedia printout giving information on Big Mac burger

Big Mac – evidence insufficient (1)

Affidavits:

- Admissible, but...
- Probative value less as from employees (not independent)
- Needed to be supported by documents (e.g. labels, packaging) or evidence from independent sources.

Big Mac – evidence insufficient (2)

Supporting evidence

- None was independent
- Packaging and brochures depicted TM but there was no evidence as to their circulation, to whom they were offered, or whether they led to purchases
- Wikipedia entries can be amended by users and therefore “... *cannot be considered as a reliable source of information*”. They need to be supported



Big Mac – evidence insufficient (3)

Website

- The mere presence of a TM on a website insufficient. Need to show the place, time and extent of use.
- Strengthen probative value with evidence of visits to the website and orders placed in the relevant period and territory. Can use records of internet traffic and hits on site and evidence of country from which it was accessed.
- Here some printouts from website showed a BigMac (but not prices) but no evidence of any order being placed. No connection between the website and the number of items offered (and sold).

Big Mac - conclusions

EUIPO conclusions

- No conclusive evidence that products marked with the TM were being offered for sale.
- Even if goods were being offered for sale, no data about how long they were offered, where, or of actual sales
- No evidence of engagement with potential or actual consumers
- No evidence of any services being offered under the TM.
- EUIPO could not conclude (without resorting to probabilities and presumptions) that the mark was genuinely used.
- It is up to the proprietor to show “that the use is not merely token”.
- Methods and means of proving use re unlimited. The finding that use has not been proven was not due to an excessively high standard of proof, but to the fact that the proprietor chose to restrict the evidence submitted.