



Press and Information

General Court of the European Union
PRESS RELEASE No 70/16
Luxembourg, 5 July 2016

Judgment in Case T-518/13
Future Enterprises v EUIPO

According to the General Court, the repute of McDonald's trade marks makes it possible to prevent the registration, for foods or beverages, of trade marks combining the prefix 'Mac' or 'Mc' with the name of a foodstuff or beverage

In 2008, the company Future Enterprises, of Singapore, applied for registration of the EU trade mark MACCOFFEE for foodstuffs and beverages, which was granted in 2010 by EUIPO (European Union Intellectual Property Office, formerly OHIM). The American company McDonald's then applied to have the trade mark declared invalid on the basis of its earlier EU trade mark McDONALD'S as well as 12 other trade marks which it held for fast food restaurant services and which included the word elements 'Mc' or 'Mac' as prefixes¹. In 2013, EUIPO granted McDonald's application, in view of the reputation of the McDONALD'S trade mark for restaurant services and the link that the public could establish between the contested trade marks (and Future Enterprises could thereby take unfair advantage of the repute of the McDONALD'S trade mark). Future Enterprises requests the General Court to set aside the decision of EUIPO.

By today's judgment, the General Court dismisses the action brought by Future Enterprises and thus confirms the decision of EUIPO.

The General Court notes, at the outset, that the trade mark MACCOFFEE and the McDonald's protected trade marks have a certain degree of phonetic and conceptual similarity, resulting from their respective initial part, namely the 'mac' and 'mc' elements.

Moreover, the General Court validates the assessments of EUIPO according to which, **because of the combination of the element 'mac' with the name of a drink in the MACCOFFEE trade mark, in particular, the relevant public can associate that trade mark with the McDonald's 'Mc' family of trade marks and mentally establish a link between the trade marks at issue.** The element 'mac' in MACCOFFEE is perceived as identical or equivalent to the initial element 'mc' of the McDonald's trade marks. Furthermore, the structure of the MACCOFFEE trade mark is very similar to that of the Mc family of trade marks, which combines the prefix 'Mc' with the name of a foodstuff.

In addition, the General Court considers that, despite the difference of the goods and services covered by the trade marks at issue (namely the foodstuffs and beverages for MACCOFFEE and the fast food restaurant services for McDonald's), there is nevertheless a certain similarity owing to the close links existing between them: thus, the foodstuffs covered by MACCOFFEE may be used and offered in the context of the fast food restaurant services provided by McDonald's. Some of the foodstuffs designated by MACCOFFEE, such as ice cream, muffins, filled sandwiches and toasted sandwiches, are not simple ingredients serving as the basis for dishes served in fast-food restaurants, but correspond to the goods offered, as such, on the menu of those establishments.

Furthermore, the foodstuffs and restaurant services at issue are directed at the same consumers.

¹Namely, McFISH, McTOAST, McMUFFIN, McRIB, McFLURRY, CHICKEN McNUGGETS, McCHICKEN, EGG McMUFFIN, McFEAST, BIG MAC, PITAMAC and McDonald's.

Lastly, the General Court confirms EUIPO's analysis that **the use of MACCOFFEE without due cause takes unfair advantage of the repute of McDonald's trade marks**. Indeed, it is highly probable that MACCOFFEE rides on the coat-tails of McDonald's in order to benefit from its power of attraction, its reputation and its prestige, and exploits, without paying any financial compensation, the marketing effort made by McDonald's in order to create and maintain its image. Thus, upon seeing the MACCOFFEE trade mark affixed to goods closely linked to those of McDonald's, the relevant public could mentally establish a link between the trade marks at issue and could transfer the image of the McDonald's trade marks to the goods covered by MACCOFFEE.

NOTE: An appeal, limited to points of law only, may be brought before the Court of Justice against the decision of the General Court within two months of notification of the decision.

NOTE: An action for annulment seeks the annulment of acts of the institutions of the European Union that are contrary to European Union law. The Member States, the European institutions and individuals may, under certain conditions, bring an action for annulment before the Court of Justice or the General Court. If the action is well founded, the act is annulled. The institution concerned must fill any legal vacuum created by the annulment of the act.

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The [full text](#) of the judgment is published on the CURIA website on the day of delivery

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