

O/0296/23

TRADE MARKS ACT 1994

TRADE MARK APPLICATION No. 3558533

BY MR AHMED BEN KHAYI AND MR ABDULWAHAB OMAR

AND

OPPOSITION No. 425170

BY MCDONALD'S INTERNATIONAL PROPERTY COMPANY, LTD

Background and pleadings

1. This is an opposition by McDonald's International Property Company, Ltd ("the opponent") to an application filed on 20th November 2020 ("the relevant date") by Mr Ahmed Ben Khayi and Mr Abdulwahab Omar ("the applicants") to register the trade mark shown below:



2. The applicants applied to register the trade mark in relation to the following services:

Class 43: Café services; Cafés; Catering of food and drink; Catering of food and drinks; Fast food restaurants; Fast-food restaurant services; Food preparation; Pizza parlors; Providing of food and drink; Restaurant services; Restaurant services for the provision of fast food; Salad bars; Take away food and drink services; Take-away food services; Take-away fast food services; Take-away food and drink services; all the aforesaid goods being prepared to Halal standards and dietary laws.

3. The opponent is the proprietor of the well-known chain of restaurants and take-aways called McDonald's. It claims to be the proprietor of two 'families' of earlier marks. The first 'family' is:

McDONALD'S (UK1208244), class 29

McDonald's (UK1208245), class 30

McDONALD'S (UK1285796), class 43

McCHICKEN (UK1144587), class 30

McNUGGETS (UK1245121), class 29

McMuffin (UK3342311), class 30

McCafe (UK3341921), classes 29, 30, 32 and 43

McDelivery (UK3232297), classes 39 and 43.

4. The second 'family' is:

BIG MAC (UK1165097), class 30

GRAND BIG MAC (UK3261876), class 30

MAC JR. (UK3261874), class 30.

5. The opponent claims that:

- (i) The earlier marks are individually and collectively similar to the contested trade mark;
- (ii) The goods and services for which the earlier marks are registered are identical or similar to the services covered by the contested mark;
- (iii) There is a likelihood of direct confusion (consumers will think they are buying from a new McDonald's restaurant), and indirect confusion (consumers will think that the contested mark is an extension of the McDonald's range of marks);
- (iv) Use of the contested mark would, without due cause, take unfair advantage and/or be detrimental to the reputation or distinctive character of the earlier mark.

6. The opponent therefore claims that registration of the contested mark would be contrary to sections 5(2) or (3) of the Trade Marks Act 1994 ("the Act").

7. The opponent also relies on unregistered passing off rights in the marks McDonald's and BIG MAC (as a result of their use in the UK since 1974), McMuffin (as a result of use in the UK since 1982), McNuggets (as a result of use in the UK since 1984), McChicken (as a result of use in the UK since 1989), McFlurry (as a result of use in the UK since 2000), McCafe (as a result of use in the UK since 2012), McDelivery (as a result of use in the UK since 2017), and GRAND BIG MAC and MAC JR. (as a result of their use in the UK since 2018).

8. According to the opponent, use of the contested mark would amount to passing off, and registration would therefore be contrary to section 5(4)(a) of the Act.

9. Finally, the opponent claims that the application to register the contested mark was filed in bad faith. In support of this allegation, the opponent relies on the following:

- (i) The applicants were well aware of the opponent's famous family of 'Mc' and 'MAC' prefixed marks;
- (ii) In 2018, Mr Ben Khayi applied to register MAC HALAL as a trade mark;
- (iii) At this time he was running a fast food restaurant under that name in the Birmingham area;
- (iv) Commercial investigations revealed that burger products called BIG MAC and MEGA MAC were on sale at the restaurant;
- (v) Following correspondence between the parties, the application to register MAC HALAL was withdrawn;
- (vi) Commercial investigations in 2021 revealed that the Birmingham restaurant had been re-branded as MakHalal and was offering burger products by the names BIG MAK and MEGA MAK;
- (vii) The applicants have sought, and continue to seek, to create a connection between themselves and the opponent.

10. The opponent therefore claims that registration of the contested mark would also be contrary to section 3(6) of the Act.

11. The applicants filed a counterstatement denying the grounds of opposition. I note the following points:

- (i) The applicants put the opponent to proof of the extent of any use made of the earlier trade marks it relied on, and of the existence of the alleged 'families' of 'Mc' and 'MAC' marks;

- (ii) It was denied that the mere fact that 'MAK' may be pronounced in a similar way to the prefix 'Mc' renders the opponent's earlier 'Mc-' marks phonetically similar to the contested mark, it being pointed out that the word element of the latter mark consists of MakHalal, not just MAK. It was denied that the earlier 'Mc-' trade marks are visually or conceptually similar to the contested mark;
- (iii) It was denied that the earlier 'MAC' marks are similar to the contested mark as a whole;
- (iv) It was denied that the respective goods/services are identical or similar;
- (v) The applicants denied taking unfair advantage of the alleged reputation of the earlier marks, and that use of the contested mark would be detrimental to the earlier marks;
- (vi) The applicants strenuously denied having applied to register MAC HALAL in bad faith;
- (vii) It was admitted that Mr Ben Khayi started a fast food restaurant in 2016 under the name MAC HALAL, and that burger products called BIG MAC and MEGA MAC were included within an extensive menu;
- (viii) The applicants claimed that the MAC element of the MAC HALAL mark was adopted to reflect the first letters of the names of three family members, the 'M' being the first letter of the name of Mr Ben Khayi's father, the 'A' being the first letter of his own given name, and the 'C' being first letter of the name of Mr Ben Khayi's eldest daughter;
- (ix) The applicants said that when the opponent's concern became apparent in 2018 the restaurant was re-branded as MAK HALAL (not MaKHalal as claimed by the opponent);
- (x) It was claimed that the replacement letter 'K' is the first letter of the name of Mr Ben Khayi's second oldest daughter;

- (xi) It was admitted that in 2021 the applicants' business was offering burger products called BIG MAK and MEGA MAK, but claimed that these have since been re-branded to BIG STAR and MEGA STAR.

Representation

12. The applicants are represented by Tomkins & Co, Chartered Trade Mark Attorneys. The opponent is represented by Bristows, Solicitors.

13. A hearing took place on 27th January 2023 at which Mr George Eustace appeared as counsel for the applicants. Mr Jonathan Moss appeared as counsel for the opponent.

The evidence

14. The opponent's evidence consists of witness statements by Mr Andrew Butcher (with 6 exhibits) and Mr Thomas O'Neill (with 36 exhibits).

15. Mr Butcher is a solicitor with Bristows. He gives an account of his firm's dealings with the applicants between 2018 and March 2022 in connection with their use of MAC HALAL, BIG MAC, MEGA MAC, MAK HALAL, BIG MAK, MEGA MAK, and later, LARGE MAK. His evidence also includes an account of the outcome of discussions conducted with the applicants' previous legal representatives that seemed to have, but ultimately did not, settle the dispute.

16. Mr O'Neill is the Head of Marketing (Food and Beverages) at McDonald's Restaurants Ltd. The company is a licensee of the opponent and appears to conduct its UK business. Mr O'Neill provides evidence about the business conducted in the UK since 1974, initially under the marks McDonald's and BIG Mac, and subsequently also under the marks McChicken, McNuggets, McMuffin, McFlurry, McCafe, McDelivery, and GRAND BIG MAC and MAC JR.

17. All the opponent's trade is conducted from its restaurants. At the date of Mr O'Neill's statement in May 2022 the opponent operated about 1300 restaurants in the UK. In 2019 the restaurants served 2.3 million customers per day. The majority of these restaurants were branded as McDonald's. About 10% were company owned,

the rest were franchises. As well as being the name of its restaurants/drive-thru takeaways, McDonald's is also used as the opponent's house brand for its products.

18. Between 2015 and 2019 the opponent's UK turnover was around £1.5 billion per annum. The BIG MAC is one of the opponent's flagship products. Between 2015 - 2020 it sold over 100 million units in the UK at an average price of around £3.

19. Mr O'Neill's evidence also includes screenshots from a YouTube reviewer who visited the applicant's MAK HALAL restaurant in Birmingham and described it as a *"McDonald's imitation"*¹.

20. The applicants' evidence consists of a witness statement (with 20 exhibits) by Mr Ben Khayi. His evidence is that MAC HALAL was first used in relation to a family run fast food restaurant in Birmingham in 2016. Mr Omar was Mr Ben Khayi's accountant until February 2020, when he became the Managing Director of Mak Halal Ltd. Since then the business has expanded on a franchise model with new Mak Halal restaurants opening in Birmingham, Walsall, Bradford, Nottingham, Cardiff, and Wolverhampton. Mr Ben Khayi exhibits various press coverage, including an article from Asian World dated 14th March 2022 describing Mak Halal as *"a great success"* and the *"UK's most vibrant Halal burger chain"*².

21. In his witness statement, Mr Ben Khayi confirmed the reasons given in the counterstatement for adopting the marks MAC HALAL and MAK HALAL.

22. He also confirmed that, as part of settlement discussions, the opponent proposed in December 2018 that the applicants' mark should be changed to M.A.K. HALAL. However, Mr Ben Khayi informed Bristows on 12th December 2018 that his business was already in the middle of changing its branding from Mac Halal to Mak Halal (emphasis added).

23. The application to register the contested mark followed the re-branding at the end of 2018 and the success of earlier UK and EU trade mark applications to register MAK

¹ See exhibit TON-33

² See exhibit ABK5

HALAL as a word mark. According to Mr Ben Khayi, the contested mark was therefore a “*simple brand extension.*”

24. Mr Ben Khayi’s written evidence is that “*While I may be aware of McDonald’s fast food chain within the UK and aware of their limited and highly particular use of ‘Mc’ and ‘Mac’ on specific products, there is no, and has been no, intention to create any confusion or connection with [the opponent].*” In this connection, he points out the applicants have quickly removed or changed branding such as MAC HALAL, BIG MAC, MEGA MAC, BIG MAK, MEGA MAK, and LARGE MAK after the opponent expressed its concerns about such use.

25. In answer to the opponent’s reliance on a YouTube reviewer allegedly describing one of the applicants’ restaurants as a “*McDonald’s imitation*”, Mr Ben Khayi provided screenshots of the full review³. He pointed out that what the reviewer actually said was “*one of those you know McDonalds imitation places, this place called MAK HALAL*”, and then adds “*looking at the menu doesn’t actually seem that McDonalds-que to me but you (lot) say it’s kind of in that vein.*” According to Mr Ben Khayi, the reviewer was referring to the food offering being like McDonald’s, not the name of the restaurant.

26. His written evidence also includes extracts from websites, social media, and publications, including the opponent’s website from July 2022 and Twitter account from September 2021, as well as the website thehalallife.co.uk (from 2022), the publication The Halal Times (from December 2017), and The Sun newspaper (from 2022), all stating that McDonald’s food is not Halal.

Cross examination

27. The opponent asked for permission to cross examine Mr Ben Khayi on his evidence. I subsequently directed the witness to attend the hearing for cross examination on the issues of:

- (i) The applicants’ knowledge of the McDonald’s marks and family of marks;

³ See exhibit ABK16

(ii) The applicants' intention to create a link or otherwise associate themselves with McDonald's.

28. In accordance with my direction, Mr Ben Khayi attended the hearing for cross examination.

29. I found Mr Ben Khayi to be a guarded witness. He was evasive about when he first became aware of the McDonald's brands. He originally lived in Morocco. He was clear that he did not come across McDonald's then. He later moved to Spain. He said that in the 19 years he lived there he had not visited a McDonald's. The witness accepted he was aware of McDonald's after having moved to the UK, but he could not recall when he first became aware of McDonald's, including whether this was before he filed his trade mark applications. By contrast, when asked whether he personally used McDonald's, he immediately recalled taking his children to the opponent's restaurants on five occasions.

30. The witness accepted that BIG MAC was one of McDonald's best known product marks. When questioned about why his business had used the same name (and later BIG MAK) for one of its burger products, he said his brother had chosen the names of the menu items. He also pointed to differences in the way his business had presented the name BIG MAC and the get-up used (compared to McDonald's), and asserted that 'Big Mac' was generic for any three layer burger. However, he had to accept that the applicants had filed no evidence showing any use of Big Mac by third parties.

31. Mr Butcher's statement includes an account of telephone conversations he had on 18th and 24th September 2018 with someone called 'Abdul', who introduced himself as the business partner of Mr Ben Khayi. Mr Butcher understood this person to be Mr Abdulwahab Omar, the co-applicant in these proceedings. According to Mr Butcher, Mr Omar told him the Mac Halal name was chosen by the previous owners of the first such restaurant in Birmingham; the three current owners liked the name because the 'Mac' element was a combination of their first initials (in the case of the 'C', this being an alternative spelling of one of the names). It was put to Mr Ben Khayi this explanation was inconsistent with the explanation put forward in the applicants' counterstatement, and repeated in his written evidence.

32. Mr Ben Khayi's evidence was that the explanation for the choice of trade mark attributed to Mr Omar was wrong, either because Mr Omar was wrong, or Mr Butcher was incorrect about what Mr Omar had told him. When asked whether he had spoken to Mr Omar about his conversations with Mr Butcher, the witness said he had not. He maintained that the MAC in MAC HALAL had been chosen to reflect the first letters of the given names of three family members, the 'M' being the first letter of the given name of Mr Ben Khayi's father, the 'A' being the first letter of his own given name, and the 'C' being first letter of the given name of his eldest daughter. The MAK in MAKHALAL was chosen for similar reasons, the 'K' being the first letter of the given name of his second oldest daughter. When asked about his eldest child, Mr Ben Khayi accepted that his eldest child was in fact a son whose given name begins with the letter 'I'.

33. I do not accept Mr Ben Khayi's evidence about the reasons he adopted the names MAC HALAL or MAKHALAL. In my view, his explanation for the choice of MAC and MAK is strained and contradicted by the evidence about the applicants' obvious attempts to use branding bringing McDonald's marks to mind. The most obvious example of this being the offering of burgers called BIG MAC and (later) BIG MAK. Mr Ben Khayi's explanation is also inconsistent with Mr Butcher's hearsay account of the explanation given to him by Mr Omar in 2018. Given (1) the multiple dealings between the parties and their legal representatives about the applicants' use of the MAC and MAK elements of their trade marks, (2) Mr Butcher's evidence about his conversations with 'Abdul' was filed more than 8 months prior to the hearing, and (3) Mr Ben Khayi knew he was going to be cross examined about the applicants' reasons for adopting the contested mark, I find his evidence that he had not even spoken to Mr Omar about what he told Mr Butcher incredible. I do not believe him. This adds no weight to Mr Butcher's hearsay evidence. After all, there is no suggestion that Mr Ben Khayi was present when their conversations took place. Consequently, he is not in a position to give evidence about what his partner did or did not say. However, the fact that he claims (incredibly, in my view) not to have even spoken to Mr Omar about the matter makes me even less inclined to accept his explanation for the applicants' choice of MAC- and later MAK- trade marks. In my view, Mr Ben Khayi's explanation for the applicants' choice of marks has been made up after the event to justify the initial use of MAC, and subsequent use of MAK.

34. I find Mr Ben Khayi was well aware of McDonald's and its primary brands, including BIG MAC, when he set up a fast food restaurant in Birmingham in 2016 under the name MAC HALAL offering, inter alia, Big Mac burgers. I accept his evidence that he did not intend to cause confusion with McDonald's. However, I think it highly likely that he intended to use MAC as a way of referencing the well-known McDonald's/BIG MAC brands, and that he saw a commercial advantage in doing so. That intention was continued through the subsequent use of MAK HALAL.

The relevance of the previous unsuccessful negotiations between the parties to these proceedings

35. Both sides appear to place weight on the outcome of the negotiations which at one time appeared to have resulted in an agreement between the opponent and Mr Ben Khayi's restaurant business.

36. The opponent appeared to invite me to attach significance, and possibly to draw an adverse inference, from the fact that the applicant backtracked on a provisional agreement reached with his then-lawyers to re-brand his business, at the opponent's cost, to M.A.K. Halal. It is common ground that no agreement was ultimately concluded. Drawing any kind of adverse inference from the fact that a party walks away from a draft agreement would fetter settlement negotiations. That would be contrary to the public interest in encouraging unfettered negotiations.⁴ Consequently, I can attach no weight to this.

36. The applicants' counsel appeared to invite me to attach significance, and possibly to draw an adverse inference against the opponent, from Mr Ben Khayi's claim that it initially suggested (allegedly during 'without prejudice' negotiations) that the Birmingham restaurant be re-branded as MAK HALAL instead of MAC HALAL. There is no document in evidence from the opponent suggesting any such thing. If this was something discussed during 'without prejudice' communications, the absence of such a document is not surprising. The applicants rely on an email dated 12th December 2018 from Mr Ben Khayi to Bristows⁵ in which he takes issue with the opponent's requirement that he should add dots between the M-A-K of Mak Halal, and goes on to

⁴ See, for example, *Rush & Tomkins v GLC* [1989] AC at pages 1299 - 1300

⁵ See exhibit ABK-7

refer to what he perceived to be an earlier offer from the opponent to re-brand as Mac Halal. The opponent has not admitted making such an offer. In any event, it is well established that communications intended to settle a dispute cannot subsequently be used in evidence, except in special circumstances, such as attempted extortion or fraud, which clearly do not apply to the negotiations at issue here. Attaching any weight to an alleged communication from the opponent which, if made, was clearly intended to settle the dispute, would be to drive a coach and horses through the policy behind the 'without prejudice' rule. I have no intention of doing so.

The section 5(2)(b) ground of opposition

37. Sections 5(2)(b) and 5A of the Act are as follows:

“5(2) A trade mark shall not be registered if because-

(a) –

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

38. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*,

Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

39. The applicants deny there is a likelihood of confusion, partly because of factors specific to the parties' businesses, in particular Mr Ben Khayi's evidence that 99% of the users of the applicants' restaurants are people of the Muslim faith seeking Halal food, whereas the opponent does not offer such food. The opponent does not accept Mr Ben Khayi's characterisation of the user base of the applicants' restaurants. It was put to Mr Ben Khayi during cross examination that the applicants' own website tells a different story⁶. The section entitled 'Our Story' contains the following:

"Initially, Mak Halal was established to cater for the Muslim market, offering dine-in, takeaways, and deliveries. But its growing popularity has been fuelled by non-Muslims too.

Now the restaurant's appeal is universal, driven by word of mouth praise."

40. Mr Ben Khayi responded that the initial restaurant in Birmingham appealed almost exclusively to the Muslim market seeking Halal food. He accepted that the

⁶ See exhibit ABK1, page 1

user base of some of the restaurants opened since 2020 may be more diverse, but he maintained that the overall user base remained mainly people seeking Halal food.

41. Halal food is of particular interest to the Muslim population. However, I do not accept that the user base of the applicants' restaurants is as specific as Mr Ben Khayi suggests. Firstly, it is not clear to me how Mr Ben Khayi would know exactly what proportion of the applicants' customers are people specifically seeking Halal food: there is no evidence that the applicants undertake market research on the makeup of their customer base. Secondly, the applicants' own website says the appeal of their restaurants is now "*universal*".

42. In any event, when assessing the likelihood of confusion under Section 5(2) it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered.⁷ In doing so it is necessary to take account of future probabilities. As Arnold L.J. stated in *Liverpool Gin Distillery Ltd and others v Sazerac Brands, LLC and others*⁸:

"33. ...Halewood contend that the judge was wrong in the last sentence of [75] to have regard to what might happen in the future. There is nothing in this point. The judge correctly directed himself that the relevant date was February 2019, and plainly his findings in the first three sentences of [75] refer to the position as at that date. The judge was not precluded, in assessing the likelihood of confusion at that date, from taking into account probable future developments. On the contrary, he would have been in error had he not done so, since it is of the essence of the test of likelihood of confusion that it is forward-looking."

43. Consequently, even if the position at the relevant date was that (1) the applicants had only one restaurant in Birmingham, (2) 99% of its customers were Muslims seeking Halal foods, and (3) none of them would use a restaurant that did not offer

⁷ See *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06, CJEU, at paragraph 66 of the judgment.

⁸ [2021] EWCA Civ 1207

Halal food (i.e. McDonald's), this is irrelevant if the position would probably be different in the foreseeable future.

44. So far as the applicants' use of the contested mark is concerned, the position at the relevant date was going to be different in the future: the use of the contested mark expanded in 2020 to a number of restaurants in different locations. And even Mr Ben Khayi's perception of the users of these restaurants is that they are more diverse than the users of the original Mak Halal restaurant.

45. So far as the opponent's future use of its marks is concerned, the mere fact that it did not offer Halal food at the relevant date (and still doesn't) does not mean that it will not do so in the future. In this connection, the applicants rely on several public statements made by the opponent to the effect that they do not sell Halal food, and one statement that they have no plans do so in the future in the UK. The latter is based on a single post on twitter.com dated September 2021⁹. The post says that McDonald's conducted a Halal trial and found that Halal certified food was only popular with a very small percentage of its customers. Therefore, given the cost of introducing it, they had no plans to offer Halal food in the UK. As Mr Moss pointed out at the hearing, this does not amount to a statement that McDonald's will never offer Halal versions of its products in the UK. Indeed, Mr O'Neill's evidence is that McDonald's already have several restaurants worldwide that offer Halal food. It is therefore possible that it will do so in the UK in the future if there is sufficient demand.

46. I must therefore proceed on the basis that:

- (i) A significant proportion of the users of the applicants' restaurants may be people for whom Halal certified food is not particularly important;
- (ii) The opponent's goods/services may be used by customers (such as Mr Ben Khayi himself) who are also actual or potential users of the applicant's services.

⁹ See exhibit ABK12

The opponent's strongest section 5(2) case

47. The opponent's section 5(2) case is based on two 'families' of 'Mc' and 'MAC' marks, as well as the individual members of those 'families'.

48. The applicants accept that the earlier marks set out in Annex 1 have been put to genuine use (where required), and had acquired an enhanced level of distinctive character and reputation through use in relation to the goods/services specified in the Annex¹⁰.

49. The applicants must therefore accept the opponent has shown that it possessed a 'family' of 'Mc' prefixed marks, which were present on the UK market at the relevant date (albeit for fewer goods/services than the opponent claims).

50. In my view, the opponent's strongest case under section 5(2) is based on the earlier trade mark BIG MAC, and the claim that BIG MAC, GRAND BIG MAC and MAC JR. constituted a 'family' of earlier marks of which the contested mark is likely to be mistaken as another member. This is because the 'MAC' marks are self-evidently closer to the contested mark than the opponent's 'Mc-' marks. I will therefore examine these claims first.

The MAC family

51. The applicants dispute that the opponent has shown it possessed a 'family' of MAC marks at the relevant date. There are two reasons for this. Firstly, the applicants submit that BIG MAC and GRAND BIG MAC are essentially the same mark. Secondly, they submit that there is no, or insufficient, evidence that MAC JR. was present on the market and two marks (at best) does not constitute a 'family'.

52. The basis for the applicants' second submission is the decision of the General Court (then called the Court of First Instance) in *Il Ponte Finanziaria SpA v OHIM*¹¹

¹⁰ See page 18 of the transcript of the hearing

¹¹ Case T-194/03

that use of two variant marks does not constitute a ‘family’ or ‘series’. The court found that:

“128. As was stated by the Board of Appeal and as the file shows, the only evidence produced by the applicant during the opposition proceedings refers to use of the trade mark THE BRIDGE and, to a lesser extent, of the trade mark THE BRIDGE WAYFARER. Since those two marks are the only earlier marks whose presence on the market the applicant has proved, the Board of Appeal was right to disregard the arguments by which the applicant claimed the protection due to ‘marks in a series’.”

53. The CJEU rejected a further appeal¹² stating that:

“63. 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 within the meaning of Article 8(1)(b) of Regulation No 40/94 (see Alcon v OHIM, paragraph 55, and, to that effect, Canon, paragraph 29). Where there is a ‘family’ or ‘series’ of trade marks, the likelihood of confusion results more specifically from the possibility that the consumer may be mistaken as to the provenance or origin of goods or services covered by the trade mark applied for or considers erroneously that that trade mark is part of that family or series of marks.

64 As the Advocate General stated at paragraph 101 of her Opinion, no consumer can be expected, in the absence of use of a sufficient number of trade marks capable of constituting a family or a series, to detect a common element in such a family or series and/or to associate with that family or series another trade mark containing the same common element. Accordingly, in order for there to be a likelihood that the public may be mistaken as to whether the trade mark applied for belongs to a ‘family’ or ‘series’, the earlier trade marks which are part of that ‘family’ or ‘series’ must be present on the market.”

¹² Case C-234/06

54. In *Monster Energy Company*,¹³ Mr Iain Purvis QC, as the Appointed Person, upheld a decision of the Registrar that five registered marks consisting of 'UNLEASH THE BEAST', 'REHAB THE BEAST' (both with and without the domain name www.monsterenergy.com) and 'UNLEASH THE BEAST WITHIN!', did not constitute a 'family' of the kind envisaged in *Il Ponte Finanziaria*. The relevant part of Mr Purvis' decision is shown below:

“(iv) ... more than mere use on the market must be shown. It is hard to see how the argument could possibly stand without evidence of sufficient use for the tribunal to conclude that the average consumer will have become aware of the existence of the different marks and will have understood them to form a 'family'. In the present case, the alleged 'family' is essentially two marks - 'UNLEASH THE BEAST' and 'REHAB THE BEAST'. However, whilst the evidence establishes substantial use of 'UNLEASH THE BEAST', it shows hardly any use of REHAB THE BEAST, save a couple of images of cans of drink bearing the slogan. The best Mr Cuddigan could do with the evidence was to refer me to a passage in paragraph 27 of the witness statement in support of the Opposition which stated that in a particular year more than 78 million cans were sold in the UK 'each of which bore UNLEASH THE BEAST or REHAB THE BEAST.' But of course this would be logically consistent with only a tiny number of sales of 'REHAB THE BEAST' branded cans. Mr Cuddigan fairly accepted this as a matter of logic but urged me to take a broader view of the evidence. Obviously the tribunal must read evidence sensibly and not overliterally. Had there been other material suggesting that REHAB THE BEAST branded cans were in fact sold on a substantial scale, I might perhaps have been prepared to give a generous interpretation to the statement in paragraph 27. However, if anything the other material before me suggests that there is a huge disparity between instances of use of the 'RELEASE' mark and instances of use of the 'REHAB' mark. I therefore conclude that no evidence of substantial use or reputation in the REHAB THE BEAST brand has been shown at the relevant date.

¹³ BL 0/768/18

(v) In the present case, even if one assumed that all the marks relied on had been used on a reasonable scale, it is hard to see how they really amount to a family. As I have said, there are really only two marks – RELEASE THE BEAST and REHAB THE BEAST. The rest are mere variants on the first. In Il Ponte it is notable that the Board of Appeal at OHIM and the Court of First Instance regarded two marks as insufficient in number to give rise to a ‘family’ argument. The CJEU did not suggest that this was incorrect.”

55. Mr Purvis’ comments in sub-paragraph (v) above are the basis for the applicants’ submission that BIG MAC and GRAND BIG MAC are merely variant marks, rather than a family of two MAC marks. I note that Mr Purvis had already decided that there was only evidence of use of two marks, and the evidence of use of one of those was insufficient to establish that it had any real presence on the market capable of affecting the likelihood of confusion on the part of the public. His subsequent comments about variant marks were therefore obiter. In any event, the answer to the question of whether a family of marks exists heavily depends on the specific marks at issue.

56. I note that in its judgment in *Il Ponte Finanziaria* the Court of First Instance (“CFI”) held that:

“123. when the opposition to a Community trade mark application is based on several earlier marks and those marks display characteristics which give grounds for regarding them as forming part of a single ‘series’ or ‘family’, which may be the case, inter alia, either when they reproduce in full a single distinctive element with the addition of a graphic or word element differentiating them from one another, or when they are characterised by the repetition of a single prefix or suffix taken from an original mark, such a circumstance constitutes a relevant factor for the purpose of assessing whether there is a likelihood of confusion.” (emphasis added)

57. On appeal, the CJEU did not dissent from the CFI’s characterisation of a ‘family’ of marks. It described a ‘family’ of marks as one that enabled consumers “...to detect

a common element in such a family or series and/or to associate with that family or series another trade mark containing the same common element.”

58. In *Miguel Torres v OHIM*¹⁴ the CFI repeated what it had said in *Il Ponte Finanziaria* about when marks qualify as a ‘family’, and Arnold J. (as he then was) cited this as the law in *W3 v Easygroup Ltd*¹⁵.

59. The addition of the word GRAND to BIG MAC appears to fall within qualifying criteria set out in *Miguel Torres*. In my view, consumers’ awareness of the use of GRAND BIG MAC, BIG MAC and MAC JR. would, if proven, increase the likelihood of another MAC mark (particularly if accompanied by indications of size or scale, e.g. MEGA MAC or MINI MAC), being taken as a member of the same family. Therefore, whilst I can see that the opponent’s use of GRAND BIG MAC mark adds relatively little to the use of BIG MAC, I see no reason to discount it altogether.

60. I therefore turn to the issue of whether the opponent has established that all three members of its claimed ‘family’ were present on the market at the relevant date. As I have already noted, the applicants accept that BIG MAC and GRAND BIG MAC were present on the market at the relevant date. In light of the judgment of Sir Anthony Mann in *EasyGroup v Easy Live (Services) Ltd*,¹⁶ the applicants also accept that it is not necessary for MAC JR. to have been in use at the relevant date, provided that the mark was still likely to be in the minds of relevant average consumers. The applicants dispute that it would have been.

61. Mr O’Neill’s evidence is as follows:

“37. The mark GRAND BIG MAC is used in respect of a larger version of the BIG MAC burger and the mark MAC JR. is used in respect of a smaller version of the BIG MAC burger (details of which are set out above). These burgers were launched in 2018 to celebrate the 50th anniversary of the original BIG MAC burger. They were collectively known as the “Big Mac range” in the UK. These two products are not permanent menu items and have been offered

¹⁴ Case T-287/06

¹⁵ [2018] EWHC 7 (Ch) at paragraph 234 of the judgment

¹⁶ [2022] EWHC 3327 (Ch) at paragraph 149

at different periods of time since 2018 as limited time promotions. I can confirm that an example selling price of a GRAND BIG MAC burger in January 2019 was £4.19, and that an example selling price of a MAC JR. burger in January 2019 was £2.39.”

62. According to Mr O’Neill, the records show that the combined unit sales for both the GRAND BIG MAC and MAC JR. products in the UK in the years 2018 - 2020 were in excess of 25 million units.

63. Exhibits TON-12 to TON-14 consist of examples of packaging for GRAND BIG MAC and MAC JR. products, and historical screenshots from the opponent’s website showing use of the marks in 2018 – 2020. The capture from 27th July 2018 shows the BIG MAC product being promoted on the website, with the GRAND BIG MAC and MAC JR. show below.¹⁷ The page is clearly directed at UK users of the site. A similar page from 7th February 2018 focuses on the arrival of the GRAND BIG MAC, with the MAC JR. and BIG MAC shown below. Another page from the same date shows the two new sizes were “available until 20th March 2018¹⁸.”

64. Exhibit TON-17 consists of various advertising material used by the opponent between 2015 and 2020. It is mainly for the BIG MAC product. However, it includes the following billboard advertisement from 2018 showing the BIG MAC, GRAND BIG MAC and MAC JR. products being promoted together. It also indicates that introduction of the GRAND BIG MAC and MAC JR. products was the subject of radio advertising in the UK (although, like the billboard advertising, there is no further information about where, when or for how long).



¹⁷ See TON-12 at page 180

¹⁸ See TON-14 at page 189

65. Mr O'Neill's evidence also includes the following:

“...attached as Exhibit TON-18 is a collection of stills of various other TV advertisements from the years 2015 -2020 which My Company has run in the UK to advertise McDONALD'S, as well as specific products including McMUFFIN, McNUGGETS, McFLURRY, McCAFE, BIG MAC, GRAND BIG MAC, MAC JR. and McDELIVERY. Several of these stills have been obtained from My Company's YouTube channel. We upload full versions of our TV adverts to our YouTube channel around the time the adverts are aired on TV. Accordingly, the date shown on the YouTube page is indicative of the time the advert would have aired on TV in the UK.”

66. The accompanying exhibit includes a YouTube page showing an audiovisual advertisement for the BIG MAC, GRAND BIG MAC, MAC JR. products¹⁹. It was uploaded to YouTube on 7th February 2018, which according to Mr O'Neill is around when it would have been broadcast on TV. It says that the GRAND BIG MAC and MAC JR. products would be available until 20th March 2018 at participating restaurants. No further details of where, or when, the advertisement was broadcast are provided.

67. Copies of advertisements in TON-13 and TON-17 indicate that the GRAND BIG MAC was put on sale again from around 1st February 2019 until 24th March 2019, and again in 2020. The MAC JR. did not feature on these occasions.

68. Mr O'Neill says that the combined amount spent advertising and promoting all of the opponent's brands in the UK in the years 2015 - 2020 was in excess of £500 million. This figure includes the GRAND BIG MAC and MAC JR. marks. According to Mr O'Neill (and a table included in exhibit TON-18²⁰), the campaigns to promote the GRAND BIG MAC reached an audience of around 50m UK consumers in 2018, 2019, and again in 2020. No corresponding figures are provided for the MAC JR.

69. Counsel for the applicants attacked Mr O'Neill's evidence on the grounds that it is mere assertion, insufficiently supported by the documents he exhibits. He came close

¹⁹ See page 257

²⁰ At page 273

at times to asking me to disbelieve him. A party is not entitled to ask a Hearing Officer to disbelieve a witness unless (a) the witness has been given sufficient notice that the truth of his or her statement is being challenged so as to permit the witness to answer that challenge in further written evidence, or (b) the party has asked to cross examine the witness, or (c) the party has filed evidence which contradicts the truth of what the witness said, or (d) the statement under challenge is self-evidently incredible²¹.

70. Conditions (b) to (d) do not apply. The applicants' written submissions in response to the opponent's evidence included an extensive critique of the exhibits to Mr O'Neill's evidence and some of things said in his statement. However, the closest the applicants came to calling him a liar was in relation to the public reach figures provided in the table in exhibit TON-18 in relation to the opponent's advertising campaigns. The applicants' representatives submitted that these were:

“wholly derived from the Opponent and as such its probative value is greatly diminished in the first instance.”

71. That criticism appears to me to be directed at the accuracy of the information in the table rather than Mr O'Neill's truthfulness. Consequently, as the truthfulness of Mr O'Neill's evidence had not previously been called into question, I must proceed on the basis that what Mr O'Neill said in his statement is true. That does not mean that I must uncritically accept his assertions about what his evidence shows. Rather, I must decide whether his narrative evidence and the supporting documents are sufficient to establish the facts on which the opponent relies²². The relevant fact for present purposes is whether the opponent had established a 'family' of three -MAC- marks at the relevant date in the perception of average UK consumers of fast food. When making that assessment it is necessary to consider the opponent's evidence as a whole. This means that deficiencies or omissions in Mr O'Neill's narrative statement, and/or the individual exhibits, can be overlooked if the evidence as a whole is sufficient to establish the fact(s) at issue. In civil proceedings the facts can be established on

²¹ *Pan World Brands v. Tripp* (EXTREME) [2008] RPC 2

²² *Robot Energy Limited v Monster Energy Company* BL O/308/20, Ms Emma Himsworth, as the Appointed Person

the balance of probabilities. However, it is not appropriate to resort to speculation or guesswork in order to fill in significant gaps in the evidence.

72. I agree with the applicants that there are significant gaps in Mr O'Neill's evidence about the opponent's use of MAC JR. The main ones are:

- (i) The sales figures provided do not distinguish between sales of GRAND BIG MAC products and MAC JR. products, and no explanation has been provided as to why (in contrast to sales of all the opponent's other products) sales figures for these products were combined;
- (ii) The GRAND BIG MAC sales appear to include sales from repeat promotions in 2019 and 2020, whereas the MAC JR. product appears to have been marketed in only one short period between early February 2018 and 20th March 2018;
- (iii) The fact that further promotions of the GRAND BIG MAC product occurred in 2019 and 2020, whereas no further marketing of the MAC JR. appear to have happened, suggests that the 2018 sales of MAC JR. were less than the sales of the GRAND BIG MAC;
- (iv) Although the MAC JR. appears to have been subject to promotion on the opponent's website, as well as billboard, TV and radio advertising, no information about the locations, duration, frequency, channels, or audience numbers has been provided;
- (v) The public reach figures provided for the opponent's marketing campaigns between 2018 and 2020 do not cover the MAC JR. mark.

73. The deficiencies and omissions in Mr McNeill's evidence were covered (admittedly amongst numerous criticisms of just about every aspect of his evidence) in lengthy written submissions filed on behalf of the applicants filed at the same time as Mr Ben Khayi's evidence in response. The opponent subsequently indicated that it intended to file evidence in reply, but ultimately decided not to do so. It therefore chose not to fill in the gaps in Mr O'Neill's evidence. In these circumstances I am particularly wary of drawing inferences in the opponent's favour as to the extent of its use and promotion

of the MAC JR. mark (e.g. that the public reach figure provided for the marketing of GRAND BIG MAC in 2018 is accurate and also covered the co-marketing of the MAC JR. product).

74. As counsel for the applicants pointed out in the hearing, the incomplete picture of the opponent's use of MAC JR. is further complicated by the fact that sales under that mark appear to have only lasted about 7 weeks in a period more than 2.5 years before the relevant date. Taking all of this into account I find that the evidence is insufficient to establish that, at the relevant date, the MAC JR. mark was likely to have been known to a significant proportion of UK consumers of fast food products.

75. As this leaves the opponent without an effective 'family' of MAC marks, the section 5(2)(b) ground of opposition based on a 'family' of MAC marks is rejected.

BIG MAC

76. At the hearing, Mr Eustace suggested that the opponent was not pursuing a case based on the individual marks, but only in the claimed 'Mc' and 'MAC' 'families'. Mr Moss clarified that the opponent had not abandoned any part of its case. Having examined the opponent's pleadings, I am satisfied that the pleadings cover the individual marks as well as the 'families'. In particular, paragraph 23 of the opponent's statement of case relies on the similarity between *"the Application mark and each of the opponent's registrations and between the Application mark and the 'Mc' Registered Family and the 'MAC' Registered family."* It also relies on the enhanced distinctiveness claimed for each of the earlier registered marks, as well as that of the 'families' of marks, in claiming there is a significant risk of confusion between *"the Application mark and each of the opponent's registrations"* (emphasis added). At no point has the opponent abandoned this part of its case.

Similarity of goods/services

77. The respective goods/services are shown below:

<i>Applicants' services</i>	<i>The goods the applicants accept that BIG MAC has been used for and acquired an enhanced degree of distinctive character</i>
Class 43: Café services; Cafés; Catering of food and drink; Catering of food and drinks; Fast food restaurants; Fast-food restaurant services; Food preparation; Pizza parlors; Providing of food and drink; Restaurant services; Restaurant services for the provision of fast food; Salad bars; Take away food and drink services; Take-away food services; Take-away fast food services; Take-away food and drink services; all the aforesaid goods being prepared to Halal standards and dietary laws.	Class 30: Sandwiches containing hamburgers; bread rolls containing hamburgers.

78. In assessing the similarity of the goods or services concerned, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary²³. 'Complementary' means that:

"...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that

²³ CJEU, *Canon*, Case C-39/97

customers may think that the responsibility for those goods lies with the same undertaking²⁴.”

79. Café, catering of food, restaurant, and takeaway services all cover the service of providing fast food, such as hamburgers. There is an obvious similarity of purpose between such services and the food they provide. Indeed, unless the food carries a different brand, a fast food takeaway is probably providing goods and services under the mark used for the business. Goods and services are nevertheless different in nature, and the method of use is different. The goods/services may be competitive. For example, one may decide to visit a burger restaurant or simply buy a burger and eat it at home or in the car. The respective goods/services are also highly complementary in the sense indicated in the case law (above). In my view, these are highly similar goods/services.

80. The applicants’ specification includes a few services which require further analysis. *Food preparation* does not obviously cover services similar to hamburgers. However, in my view, this term covers the service of preparing food on demand. This includes preparing hamburgers in response to orders. I therefore find that these services are also highly similar to hamburgers.

81. *Catering of drinks, Pizza parlors, and Salad bars* do not cover the provision of burger-type foods. In *Tony Van Gulck v Wasabi Frog Ltd*²⁵, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning the complementarity between retail services and goods. On the basis of the European courts’ judgments in *Sanco SA v OHIM*,²⁶ and *Assembled Investments (Proprietary) Ltd v. OHIM*²⁷, upheld on appeal in *Waterford Wedgwood Plc v. Assembled Investments (Proprietary) Ltd*²⁸, Mr Hobbs concluded that:

i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently

²⁴ See, for example, *Boston Scientific Ltd v OHIM*, Case T-325/06

²⁵ Case BL O/391/14

²⁶ Case C-411/13P

²⁷ Case T-105/05, at paragraphs [30] to [35] of the judgment

²⁸ Case C-398/07P

pronounced that, from the consumer's point of view, they are unlikely to be offered by one and the same undertaking;

ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;

iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;

iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered);

(v) It was necessary to consider the greater or lesser likelihood that a single economic undertaking would naturally be regarded as responsible for providing not only goods of the kind in question, but also retail services of the kind specified.

82. In my view, similar principles can be applied to the relationship between hamburgers one hand, and on the other hand, services for the *catering of drinks, pizza parlors, and salad bars*. The sort of service provider selling hamburgers (such as burger van) is also likely to provide drinks. Further, as burgers and pizzas are prime examples of fast food, it is more likely than not that an undertaking selling hamburgers would also be assumed to be responsible for pizza parlour services offered under the same or similar mark. I therefore find these goods/services are similar to a medium degree.

83. The position is different for *salad bars* services. There is no evidence that the public would naturally expect such services to be provided by an undertaking that markets hamburgers. These services/goods are not similar. Consequently, the

opposition under section 5(2) based on the earlier BIG MAC mark cannot succeed in relation to *salad bars* services. This is because showing some degree of similarity between the respective goods/services is an essential requirement of the section²⁹.

Average consumer

84. According to the opponent, average consumers of the services covered by the applicants' application pay a low-to-medium degree of attention when choosing a service provider.

85. The applicants say that consumers concerned about, or just interested in, Halal food requirements (which they say is virtually all the likely users of the services) will pay a high degree of attention when choosing a service provider. When pressed, Mr Eustace submitted that other users would pay a medium degree of attention³⁰.

86. In my view, average consumers of the services specified in class 43 will be members of the general public interested in (at least) the price and quality of the food and drink provided through the service, the hygiene standards of the provider, and the level of customer service. Therefore, I find that such consumers will pay a medium or 'average' degree of attention when seeking a service provider. I accept that those with an interest in acquiring Halal food will pay a higher (but not the highest) level of attention, i.e. medium-to-high.

87. The services are likely to be selected primarily by eye, from printed or online advertisements, or from just looking at the signage on the restaurant etc. However, word-of-mouth recommendations (or the opposite) are also likely to play an important part in the selection process. Indeed, the applicants' own website says that their success is "*driven by word of mouth praise.*" Additionally, telephone orders are likely to play a significant role in the selection of the applicants' takeaway services.

²⁹ *Waterford Wedgwood plc v OHIM* – C-398/07 P (CJEU)

³⁰ I note this is inconsistent with paragraph 28 of Mr Eustace's skeleton argument in which he stated that users of fast food goods and services normally buy quickly without paying much attention.

Distinctive character of the earlier mark

88. In *Lloyd Schuhfabrik Meyer & Co* the CJEU stated that:


*“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).*

*23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”*

89. BIG is obviously descriptive of the size of a burger. MAC is not descriptive of hamburgers. Therefore, BIG MAC as a whole is inherently distinctive to a medium or ‘normal’ degree with the distinctive character of the mark backloaded on MAC. As already noted, the applicants accept that BIG MAC has an enhanced degree of distinctive character through use in relation to hamburgers. Consequently, there is no need to go any deeper into the opponent’s evidence of use of this mark. It is sufficient to record that having been through the evidence, I am satisfied that BIG MAC is a very distinctive mark for hamburgers.

Comparison of marks

90. The respective trade marks are shown below:

Contested trade mark	Earlier trade mark
	BIG MAC

91. From a visual perspective, the contrasting colours and the use of a capital 'H' give the impression that the contested mark is formed of the element 'Mak' and the word 'Halal' conjoined. The earlier mark is plainly two separate words. The contested mark is longer than the earlier mark, even allowing for the space between BIG and MAC (8 letters v 6 & space). The words 'Halal' and 'BIG' have no counterpart in the other mark. The contrasting colour scheme featured in the contested mark is not present in the earlier mark either. The first word in the contested mark (MAK) shares the first 2 of the 3 letters of the second word in the earlier mark (MAC). This is the extent of the visual similarity between the marks. It is sufficient, in my view, for the average consumer to see a low degree of visual similarity between the marks.

92. From an aural perspective, the 'Mak-' and 'MAC' elements sound the same. There is no aural similarity between the other verbal elements of the marks - 'Halal' and 'Big'. Further, the elements with the same sound will be verbalised in a different order because 'Mak-' is the first element of the contested mark, whereas MAC is the second element of the earlier mark. Nevertheless, the fact that one of the two verbal elements in the marks has the same sound is sufficient to create a medium degree of aural similarity between the marks.

93. The applicants submit that in so far as the average consumer denotes any conceptual meaning to 'MAC', it would be seen to denote a personal computer or a rain coat.

94. The opponent submits that in the context of its claimed family of MAC marks, the concept of 'MAC' is the use of 'Mac' in association with another word related to food (e.g. BIG).

95. The applicant's tentative suggestion that 'MAC' would be seen by average consumers as denoting a personal computer may be based on Apple's use of that word as a trade mark. The conceptual meaning referred to in the case law is the natural meaning of the sign at issue, not its status as a trade mark for a product. The applicants' submission is therefore misconceived. The applicants' alternative (but equally tentative) submission is that MAC in BIG MAC would be understood as meaning the type of raincoat for which MAC is one of two possible spellings (the other being Mack). I do not accept that any significant proportion of average consumers would attribute this meaning to the word MAC in the context of the mark BIG MAC. As to the opponent's submission, the use of MAC in association with BIG is not a 'concept' at all. In my view, average consumers would not attribute any clear meaning to MAC when used in the trade mark BIG MAC in relation to hamburgers.

96. At the hearing, counsel for the applicants (correctly) accepted that 'BIG' in BIG MAC was likely to be taken by average consumers as a reference to size. This is the only readily discernible meaning that can be attached to (a part of) BIG MAC.

97. The applicants submit that the MAK- element in the contested mark may have different meanings, such as "*the Scot word for make*", or "*bearing in mind its meaning in Slavic languages*" may be considered as meaning 'poppy'. I agree with the opponent that neither of these meanings is sufficiently well-known to average UK consumers for them to attach any clear meaning to 'Mak-' in the contested mark. The meaning of 'Halal' is clear; it refers to food prepared in accordance with Islamic law. This is the only readily discernible meaning that can be attached to (a part of) MakHalal.

98. Considered as wholes, neither mark has any clear conceptual meaning. The most that can be said is the meanings of 'BIG' and 'Halal' are not shared so there is no conceptual similarity between the marks.

Likelihood of confusion

99. The applicants' case is that '-Halal' helps to distinguish their mark from the opponent's marks because it designates Halal food. In light of the accepted descriptiveness of 'Halal', I asked Mr Eustace at the hearing whether 'Mak-' should be considered as the dominant and distinctive element of the applicants' mark. He replied that *"Mak was the dominant element, yes, which is not to say you can ignore the 'Halal'."*

100. As part of an earlier discussion about whether GRAND BIG MAC and BIG MAC were members of a 'family' of marks, or just variants of the same mark, Mr Eustace submitted that GRAND and BIG were simply descriptions of size. I therefore asked him whether he therefore accepted that MAC must be the dominant and distinctive element of BIG MAC. He replied that *"MAC is going to be more distinctive [than BIG] but to a far lesser degree than in the case of the other mark."*

101. BIG is clearly descriptive of size. Therefore, MAC is the most distinctive element of BIG MAC when used in relation to hamburgers. I hesitate to find that MAC is also the dominant element of the mark. After all, it is the same length as BIG and that word comes before MAC. Accordingly, MAC does not visually or aurally dominate the earlier mark.

102. I find there is no likelihood of average consumers directly mistaking the contested mark for BIG MAC or vice versa. The visual and aural differences between the marks as wholes are too great for that, even after allowing for imperfect recollection.

103. In *L.A. Sugar Limited v By Back Beat Inc*³¹, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

"16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it

³¹ Case BL O/375/10

is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: 'The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark'.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).*
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).*
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)."*

104. In my view, the MAC element in the earlier mark was 'strikingly' distinctive of the opponent's hamburgers at the relevant date. Further, the second verbal element in the applicants' mark – Halal – was of a kind that consumers might expect to see in a sub-brand or brand extension, i.e. a service providing Halal versions of products. However, I still see no likelihood of any material level of indirect visual confusion arising from average consumers mistakenly believing that the contested mark is a brand extension of BIG MAC. The reasons for this are that (1) the 'Mak-' element of the contested mark is visually different to MAC and those consumers who have

recognised the marks as wholes are different are unlikely to believe that the opponent has not only dropped the 'BIG' element, but also changed the spelling of the MAC element, and (2) the contrasting colour scheme used for the contested mark does nothing to indicate a familial relationship to BIG MAC, and mildly points away from one.

105. The visual differences between the marks will not be apparent to consumers who only hear the contested mark, e.g. through verbal recommendation or criticism. In my view, a significant proportion of average consumers in this position are likely to believe that Mak Halal is a sub-brand of the BIG MAC used in relation to services providing Halal food, including Halal burgers. It is not necessary for the opponent to establish that all average consumers, or even a majority of them, would be confused in this way. It is sufficient that a significant proportion of average consumers are likely to suffer confusion³².

106. It is true that such confusion may not persist if the consumer subsequently sees the contested mark at the point of selecting the applicants' services, e.g. ordering a takeaway meal and/or visiting the applicants' restaurants. However, although the level of attention paid by consumers at the time when the goods/services are selected is an important aspect of the global assessment of the likelihood of confusion, confusion that occurs at other points in time can also be taken into account³³. Further, significant confusion amongst consumers of the goods covered by the earlier mark also counts³⁴. This is particularly so if such confusion has real potential to affect the functions of the senior trade mark. If a significant proportion of average consumers of the opponent's goods, paying a normal degree of attention, mistake verbal criticism of the quality of the applicants' services for criticism of the quality of the opponent's goods and, as a result, reduce or avoid selecting the

³² See *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, Kitchin LJ (as he then was) at paragraph 34 of the judgment. Although this was an infringement case, the principles apply equally under 5(2): see *Soulcycle Inc v Matalan Ltd*, [2017] EWHC 496 (Ch).

³³ See *OHIM v DaimlerChrysler AG*, CJEU (at paragraph 48 of the judgment) and, by analogy, *Arsenal Football Club*, CJEU, Case C-206/01.

³⁴ So-called 'wrong-way-round' confusion: see *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation*, [2016] EWCA Civ 41, at paragraphs 41 to 67 of the judgment

opponent's goods in future, the quality function of the senior mark is liable to be damaged with adverse economic consequences³⁵.

107. The applicants point out that there is no evidence of confusion, despite the applicants having used the contested mark (or variations of it) since 2016. This is true. The opponent has filed some hearsay evidence from a YouTube reviewer suggesting that the public thought that one of the applicants' restaurants was an imitation of a McDonald's restaurant. However, apart from consisting of unattributed hearsay evidence of doubtful probative value, evidence of imitation is not evidence of confusion. This is because one has to know that the applicants' restaurant is not connected to the opponent in order to view it as an imitation.

108. In *Roger Maier and Another v ASOS*,³⁶ Kitchen L.J. (as he then was) stated that:

“80.the likelihood of confusion must be assessed globally taking into account all relevant factors and having regard to the matters set out in Specsavers at paragraph [52] and repeated above. If the mark and the sign have both been used and there has been actual confusion between them, this may be powerful evidence that their similarity is such that there exists a likelihood of confusion. But conversely, the absence of actual confusion despite side by side use may be powerful evidence that they are not sufficiently similar to give rise to a likelihood of confusion. This may not always be so, however. The reason for the absence of confusion may be that the mark has only been used to a limited extent or in relation to only some of the goods or services for which it is registered, or in such a way that there has been no possibility of the one being taken for the other. So there may, in truth, have been limited opportunity for real confusion to occur.”

109. In this case, the applicants operated only one restaurant in Birmingham up until 2020. Several more MakHalal restaurants have opened since then, but there are still

³⁵ See *L'Oreal SA v Bellure NV*, CJEU, Case C-487/07, at paragraph 58

³⁶ [2015] EWCA Civ 220

large parts of the UK where there are no such restaurants. Further, evidence of the opponent's customers being put off from selecting their goods because of criticisms they have heard about the applicants' services may be hard to come by if those consumers simply vote with their feet. Moreover, the evidence indicates that the applicants' services have been successful to date and are seemingly well regarded. That could change in the future as the number of franchises continues to grow. The opponent's mark is entitled to protection against such a risk.

110. I therefore find that there is a likelihood of indirect aural confusion, if the contested mark is used in relation to services which are similar to the goods for which the BIG MAC is registered and entitled to protection. Further, although it is necessary to evaluate the likelihood of confusion in the round, which means factoring in the absence of any likelihood of visual confusion, I find the likely degree and effect of indirect aural confusion is sufficient on the facts of this case to justify an overall finding of a likelihood of confusion.

111. My attention has been drawn to a decision of the Board of Appeal at the EUIPO which held there was no likelihood of confusion (or even a mental link) between a number of the opponent's marks, including BIG MAC, and the mark shown below.



112. Every case turns on its own facts. The mark shown above is clearly quite different to the contested mark. It contains verbal and figurative elements which make it unlikely to be confused with, or call to mind, BIG MAC. I therefore find the Board of Appeal's decision irrelevant.

113. The opposition under section 5(2)(b) based on the earlier BIG MAC mark succeeds, except in relation to salad bar services.

McDonald's

114. As the opposition based on the earlier BIG MAC mark failed in relation to salad bar services, it is necessary to consider whether the opponent can improve upon its case by relying on any of the other earlier marks cited in the Notice of Opposition. McDonald's is registered under UK1208245 in relation to *restaurant services* in class 43.

Comparison of services

115. Restaurants may have a salad bar, but a salad bar on its own would not be perceived as a restaurant service, which usually involves, at least, a place to eat and a choice of food. However, the services are clearly similar in nature and purpose, and there is likely to be a degree of competition between them, e.g. consumers may opt to obtain a light salad-based meal or snack from a salad bar as an alternative to visiting a restaurant. The respective services are highly similar.

Average consumer and the selection process


116. I have already considered the average consumer for the services covered by the contested mark and the selection process. I found that average consumers interested in obtaining Halal food will pay an above average degree of attention and those without such an interest would pay an average degree of attention. The selection process will be primarily visual, but with oral orders, recommendations etc. playing a significant role.

Distinctive character of the earlier mark

117. There can be no doubt that McDonald's is 100% factually distinctive for restaurant services.

Comparison of the marks

118. The respective marks are shown below:

Contested trade mark	Earlier trade mark
 The logo for 'MakHalal' features the word 'Mak' in white and 'Halal' in orange, both in a bold, sans-serif font. A registered trademark symbol (®) is located at the top right of the 'al' in 'Halal'.	McDonald's

119. There is a very low degree of visual similarity between these marks. They both begin with a letter 'M', have a capital letter as the third or fourth letter of the marks. They are roughly the same length, and have an '-al-' letter combination towards the end of the marks. The opponent submits that, like the 'Mc' in McDonald's, the 'Mak-' in the contested mark will be seen as a prefix. The applicants dispute this. I consider that a significant proportion of average consumers will probably see MakHalal as simply two words conjoined. However, given the use of a capital letter 'H', I find that another (also) significant proportion of average consumers will see Mak- as a prefix for the word Halal. This will add another point of similarity so far as consumers in this group are concerned. Even so, the overall visual differences between the marks shown above is plain to see.

120. The contested mark has three syllables: MAK-HA-LAL. The earlier mark also has three syllables. The pronunciation of the last two are uncontroversial: DON-ALDS. There is a dispute about how the Mc- in McDonald's will be pronounced. The applicants say that it will be pronounced MUHK. They point out that this is how the opponent itself pronounces Mc- in its advertising. The opponent says that Mc- can be pronounced as Muhk or Mac. In support of this submission, Mr Moss cited various famous people with names beginning Mc- who are sometimes referred to as Mac-. The clearest example being John McEnroe.

121. In my view, there is likely to be mixed pronunciation of the Mc- in McDonald's amongst members of the public. I take Mr Eustace's point that McDonald's themselves pronounce it Muhk, and this might be thought to influence the way the

public will pronounce it. On the other hand, if one takes the opponent's actual usage into account then it is necessary to consider all such use. The fact that one of McDonald's signature products is the BIG MAC is relevant. This is because the public might reasonably assume this mark is derived from the Mc- in McDonald's. The opponent might therefore be regarded as having sent mixed messages as to how the Mc- in McDonald's should be pronounced. In any event, the aural difference between Mac and Muhk is slight and could easily be lost in ordinary verbal communications. I therefore conclude that the Mc- and MAK syllables of the respective marks are aurally identical to some, and highly similar to others. However, taking into account that there is no aural similarity at all between DON-ALDS and HA-LAL, the identical or highly similar first syllable results in only a low degree of overall aural similarity between the marks.

122. Conceptually, McDonald's is obviously a surname whereas as MakHalal (as a whole) has no clear meaning. Therefore, the marks are conceptually dissimilar.

Likelihood of confusion

123. I find there is no likelihood of confusion between the contested mark and McDonald's (considered as just one mark). Notwithstanding the highly similar services, the extremely distinctive character of the earlier mark, and the need to account for imperfect recollection, the marks are simply not similar enough for average consumers paying a normal degree of attention (or even a low-to-medium degree, as Mr Moss would have it) to confuse them.

124. Taking McDonald's on its own (i.e. without the BIG MAC factor), I see no likelihood of indirect confusion either. The similar sounding first syllables and the very low level of visual similarity described above is likely to be sufficient to bring McDonald's to mind. However, this is 'mere association', which is not sufficient for the purposes of section 5(2) of the Act because it does not constitute a likelihood of confusion. The opponent's section 5(2) case based on its other Mc- marks (individually) is no stronger and fails for essentially the same reasons.

The ‘family’ of Mc- marks

125. There is no dispute that the six Mc- marks set out in Annex A had been used to the extent that they had acquired an enhanced degree of distinctive character by the relevant date. Therefore, they were clearly ‘on the market’. The Mc- prefix to the marks is plainly a common element which appears in the same position in each of the marks. In my view, the marks constitute a ‘family’ of Mc- trade marks for the goods/services listed against them. In *Il Ponte Finanziaria* the CFI set out two conditions for establishing a likelihood of confusion with a ‘family’ of marks. The second was expressed like this:

“127. Secondly, the trade mark applied for must not only be similar to the marks belonging to the series, but also display characteristics capable of associating it with the series. That could not be the case where, for example, the element common to the earlier serial marks is used in the trade mark applied for either in a different position from that in which it usually appears in the marks belonging to the series or with a different semantic content.”

126. On appeal, the CJEU described the likelihood of confusion between a ‘family’ of earlier marks and a third party mark as existing when the public is able:

“...to detect a common element in such a family or series and/or to associate with that family or series another trade mark containing the same common element.”

127. The difficulty with the opponent’s section 5(2) case based on its ‘family’ of Mc- marks is, as counsel for the applicants pointed out, the Mc- element that identifies the opponent’s ‘family’ of marks is not present in the contested mark. It is true that MAK- has the same first letter as Mc-, and may sound the same or similar. However, the sort of confusion arising from the existence of a family of marks specifically depends on consumers noticing something in common between marks that would otherwise be regarded as insufficiently similar to create a likelihood of confusion. The contested mark does not share the distinctive feature of the opponent’s Mc- ‘family’ of marks. Similarity that merely brings the Mc- family of marks does not constitute a

likelihood of confusion. The opposition under section 5(2) of the Act based on the Mc- 'family' fails for this reason.

The section 5(3) ground of opposition

128. At the relevant date, section 5(3) was as follows:

“(3) A trade mark which-
(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark”.

129. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case C-252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C-383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows:

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*.

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) the more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that use of the latter will take unfair advantage of, or will be detrimental to, the distinctive character or the repute of the earlier mark; *L'Oreal v Bellure NV, paragraph 44*.

(g) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34*.

(h) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(i) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the

earlier mark; *L'Oreal v Bellure NV, paragraph 40*. The stronger the reputation of the earlier mark, the easier it will be to prove that detriment has been caused to it; *L'Oreal v Bellure NV, paragraph 44*.

(j) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and 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 the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure*).

130. It is convenient to start by considering the opponent's section 5(3) case based on the reputation of the BIG MAC trade mark.

BIG MAC

Reputation

131. The applicants accept that BIG MAC has a reputation in relation to (essentially) hamburgers.

Link

132. As I noted above, my assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

The degree of similarity between the conflicting marks

133. For the reasons given above, there is a low degree of visual similarity between the contested mark and BIG MAC, a medium degree of aural similarity, but no conceptual similarity.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

134. For the reasons given above, hamburgers are similar to the services covered by the contested mark, except for salad bar services. The users of the goods/services are the general public, so there is a clear overlap between the respective users notwithstanding the limitation in the applicants' specification to food and drink prepared in accordance with Halal requirements.

The strength of the earlier mark's reputation

135. In cross examination, Mr Ben Khayi accepted that BIG MAC was one of McDonald's best known products. This is plainly correct. The product has been on the UK market since 1974 and 100s of millions have been sold. The mark has a strong reputation for hamburgers.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

136. BIG MAC is a very distinctive mark for hamburgers.

Whether there is a likelihood of confusion

137. For the reasons given above, there is a likelihood of confusion amongst a significant proportion of the public if the contested mark is used in relation to the services covered by the application, except for salad bar services.

Finding on link

138. In my view, the contested mark is liable to cause the public to bring the BIG MAC mark to mind, if it used in relation to services similar to hamburgers. Even consumers who are not confused into thinking that the contested mark is economically connected to McDonald's are likely to make this association.

Due cause

139. It was confirmed at the hearing that the applicants' pleadings advance no positive case that they have 'due cause' to use the contested mark.

Unfair advantage

140. In *Aktieselskabet af 21. november 2001 v OHIM*³⁷, the CJEU stated that:

“22. With regard to the appellant’s argument concerning the standard of proof required of the existence of unfair advantage taken of the repute of the earlier mark, it must be noted that it is not necessary to demonstrate actual and present injury to an earlier mark; it is sufficient that evidence be produced enabling it to be concluded prima facie that there is a risk, which is not hypothetical, of unfair advantage or detriment in the future.”

In my view, the evidence indicates there is a risk, which is more than merely hypothetical, that use of the contested mark would take advantage of the reputation of BIG MAC as one of the best known burger products in the UK and EU. The MAK-element of the contested mark brings the BIG MAC mark to mind. The contested mark thereby benefits from the power of attraction of that mark. It therefore exploits, without paying any financial compensation, the marketing effort expended by the opponent in order to create and maintain the earlier mark's image as a popular multi-layer burger. It then adds the word -Halal to that image so as to appeal particularly (but not exclusively) to consumers who want a product with the characteristics of a BIG MAC, but prepared according to Halal food standards.

³⁷ Case C-197/07P

141. During cross examination, Mr Ben Khayi said that the Mac Halal business had a slow start in 2016 and only took off a year or so later once the food offering was certified as Halal. He therefore considered that this, rather than any link to the opponent, was responsible for the success of the business. There are no sales or marketing figures in his evidence. Therefore, I have only Mr Ben Khayi's recollection of the timeline related to the success of his business. It is not unusual for a new business with just one outlet to struggle to establish itself in the first year or so. However, even if Mr Ben Khayi is correct that obtaining Halal certification was a turning point, this does not undermine my conclusion about how the contested mark would take advantage of the reputation of BIG MAC (as set out in the final two sentences of the previous paragraph).

142. In *Argos Limited v Argos Systems Inc.*³⁸ L.J. Floyd noted what the CJEU had said about unfair advantage in paragraph 50 of the judgment in *L'Oreal v Bellure*³⁹, and observed that:

"103. On a literal reading of that paragraph, any advantage taken by a third party of a mark with a reputation will be unfair if the third party seeks by its use of the similar sign (a) to ride on the coat-tails of the mark in order to benefit from its attraction, reputation and prestige, and (b) to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. Such a general statement is comprehensible in the context of a case where there is, or is likely to be, a transfer of the image of the proprietor's reputation to the defendant's goods or services. However the present case does not involve any such transfer of image and it is in the highest degree improbable that the court had in mind a case on these highly unusual facts.

104. Subsequent to L'Oreal , this court decided in Whirlpool Corp v Kenwood Ltd [2009] EWCA Civ 753; [2010] RPC 2 that mere commercial advantage was not sufficient to render the taking of advantage unfair. Lloyd LJ (with whom Wilson and Rix LJJ agreed) stated at [136]:

³⁸ [2018] EWCA Civ 2211

³⁹ Summarised at paragraph 129(i) above

‘There must be an added factor of some kind for that advantage to be categorised as unfair.’”

143. The subjective intention of the applicants is relevant to the issue of whether any advantage gained is unfair⁴⁰. The opponent’s case is that the contested mark was adopted as part of an on-going pattern of behaviour by the applicants through which they have sought, and continue to seek, to create a connection between themselves and the opponent.

144. All relevant evidence must be taken into account in the assessment of the applicants’ intentions in choosing the contested mark. And as the EU’s General Court stated in *The Coca Cola Company v OHIM and Another*⁴¹:

88. Th[e] case-law.... in no way limits to the mark applied for the relevant evidence to be taken into consideration for the purposes of establishing a risk of free-riding (the risk that unfair advantage will be taken of the distinctive character or the repute of the earlier trade marks), but allows account also to be taken of any evidence intended to facilitate that analysis of the probabilities as regards the intentions of the proprietor of the trade mark applied for, and — a fortiori — any evidence relating to the actual commercial use of the mark applied for.”

145. I take this to mean that I can take into account the way in which the contested mark has come about (as a fall-back choice from Mac Halal) and the applicants use of other marks (such as BIG MAC/BIG MAK) in determining whether the applicants intend to take advantage of the reputation of the earlier mark. However, what ultimately counts is whether the contested mark, by itself, would take unfair advantage of the earlier marks.

146. I earlier found that Mr Ben Khayi intended to use MAC as a way of referencing the well-known McDonald’s/BIG MAC brands, saw a commercial advantage in doing so, and that this intention was continued through the subsequent use of MAK HALAL. I accept that the applicants do not intend to cause confusion, and that they have

⁴⁰ See *Whirlpool v Kenwood* [2009] EWCA Civ 753 at paragraph 136

⁴¹ Case T-480/12

changed their branding (albeit only after the opponent complained) to try to avoid doing so. However, I have no doubt that the applicants sought, and still seek, to gain an economic advantage from the reputation of the BIG MAC. They seek to draw on the reputation of, and characteristics associated with, that mark so as to make it easier to market their MakHalal/Mak Halal restaurants. This constitutes an unfair advantage within the meaning of section 5(3) of the Act.

147. Further, even if there is no subjective intention to take advantage of the reputation or distinctive character of the earlier mark, any advantage gained will be unfair if the contested mark was chosen with a view to it having brand significance, and with a view to it having an economic impact on the applicants' consumers⁴². I am satisfied that the applicants' behaviour at least falls within this description.

148. I therefore find that use of the contested mark in relation to the services applied for (except salad bars) would, without due cause, take unfair advantage of the reputation and distinctive character of the BIG MAC mark.

Detriment to reputation or distinctive character

149. I am satisfied that if there is indirect aural confusion with BIG MAC of the kind described in paragraph 106 above, there is a serious risk that the reputation of the senior mark will be tarnished.

150. In order to establish that use of the contested mark would be detrimental to the distinctive character of the earlier mark it is not necessary to provide evidence of actual detriment. A serious risk of such detriment is sufficient. This can be established by the use of logical deductions taking account of the normal practice in the relevant commercial sector as well as all the other circumstances of the case⁴³.

151. If MAC comes to be perceived by consumers as generic for a multi-layer burger, or services providing such products, then the distinctive power of BIG MAC to exclusively denote the opponent's products will be seriously eroded. This would be

⁴² See *Monster Energy Company v Red Bull GmbH* [2022] EWHC 2155 (Ch) at paragraph 26 of the judgment

⁴³ See paragraphs 42 and 43 of the judgment of the CJEU in *Environmental Manufacturing LLP v OHIM*, Case C-383/12P

bound to result in consumers placing less trust in the mark to guarantee the goods of a particular undertaking. And that would be liable to affect their economic behaviour, i.e. they would no longer look to the opponent as the sole provider of the BIG MAC. Mr Ben Khayi implicitly recognised this risk when he said during cross examination that one of the reasons he thought it was OK for his business to use BIG MAC (and by extension BIG MAK), was because he thought that BIG MAC is commonly used for multi-layer burgers. There is no evidence of that. However, the applicants' use of marks such as BIG MAC and Mac Halal represents a serious risk of such dilution in the future. Watering the link down by using the phonetic equivalents - MakHalal and BIG MAK - reduces but does not eliminate the risk. Therefore, I find that use of the contested mark (which I recognise also has visual elements) would also be detrimental to the distinctive character of the BIG MAC mark.

152. The section 5(3) ground of opposition based on the BIG MAC mark therefore succeeds in respect of the services in class 43 which are similar to hamburgers. This is all the services except for salad bar services.

McDonald's 'family' of Mc- marks

Reputation

153. I have already found that the six marks shown in Annex 1 constitute a 'family' of Mc- marks. The applicants accept that each of these earlier marks had acquired a reputation through use prior to the relevant date in relation to the goods/services specified in the Annex.

Link

The degree of similarity between the conflicting marks

154. I have already analysed the overall degree of similarity between the contested mark and McDonald's. I found it was limited to a very low degree of visual similarity and a low degree of aural similarity. The McCHICKEN, McNUGGETS and McMuffin marks are individually no more similar. Arguably they are even less visually and aurally similar because the -AL- letter sequence common to McDonald's and MakHalal is absent. However, they are not as conceptually dissimilar to the contested mark as

McDonalds. This is because they are not surnames, and the second element – like Halal – is related to food. McCafe and McDelivery are even less similar to the contested mark. However, when comparing a ‘family’ of earlier marks to a contested mark it is important to consider the common element of the earlier marks, and the extent to which the contested mark is likely to call the ‘family’ to mind.

155. The common element of the earlier ‘family’ of marks is the Mc- prefix. As already noted, that common element is not present in the contested mark. Instead, the verbal element of the contested mark starts with Mak-. I have already found that this element will appear to a significant proportion of average consumers to be a prefix, like Mc- . Mc- and Mak- both begin with ‘M’ and they sound the same or similar. I have also noted the diversity of the second elements making up the Mc- ‘family’, and that half of the ‘family’ are comprised of Mc- as a prefix to a word relating to food. In my view, average consumers who see Mak- as a prefix to Halal (another word relating to food) are likely to perceive some similarity between the contested mark and the opponent’s Mc- ‘family’ of marks.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

156. All the services covered by the contested mark are the same or similar to *restaurant services* for which the applicants accept that McDonald’s mark has a reputation. This includes *pizza parlour* and *salad bar* services. The former appears to be a type of restaurant. The latter is an alternative to restaurant services and highly similar.

157. Additionally, at least the following descriptions of services are similar in purpose and complementary to the goods for which the McCHICKEN, McNUGGETS, McMuffin and McCafe marks are accepted as having a reputation:

Catering of food and drink; Catering of food and drinks; Fast food restaurants; Food preparation; Providing of food and drink; Restaurant services for the provision of fast food; Take away food and drink services.

158. The users of the goods/services are the general public, so there is a clear overlap between the respective users notwithstanding the limitation in the applicants' specification to food and drink prepared in accordance with Halal requirements.

The strength of the earlier marks reputation

159. McDonald's clearly has a massive reputation for fast food restaurant services. Further, according to Mr O'Neill, sales under each of the other earlier marks mentioned in the previous paragraph exceeded 100 million units in the five years 2015 – 2020. There is substantial evidence of promotion of all these marks. I therefore find that the opponent's Mc- 'family' of marks had a substantial reputation in the UK (and EU) at the relevant date.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

160. The earlier Mc- marks are highly distinctive of the opponent's goods and services.

Whether there is a likelihood of confusion

161. For the same reasons given in relation to McDonald's solus, there is no likelihood of confusion between the contested mark and the Mc- 'family' of marks.

Conclusion on link

162. I earlier cited case law indicating that a likelihood of confusion between a 'family' of earlier marks and a later mark is only liable to arise where the later mark shares the element which makes the earlier marks a 'family'. This case law does not rule out the possibility that an element of the later mark which resembles the common element in the established 'family' of marks may be sufficient to cause a significant proportion of the public to call the marks in the 'family' to mind. In *Adidas-Salomon* the CJEU held that:

"29. The infringements referred to in Article 5(2) of the Directive [section 5(3) of the Act], 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.”

163. In my view, the reputation of the earlier ‘family’ of Mc- marks combined with the identity or similarity between the respective goods/services, and the overlap between the users of such goods/services, is sufficient for even the relatively low degree of similarity between the marks at issue to cause a substantial proportion of the relevant public to make a link between the marks.

Unfair advantage

164. By bringing the Mc- ‘family’ of marks to mind, the contested mark exploits, without paying any financial compensation, the marketing effort expended by the opponent in order to create and maintain the earlier marks’ image for popular fast food goods and services. It adds the word -Halal to that image so as to appeal particularly (but not exclusively) to consumers who want products and services with the characteristics associated with marks in the Mc- ‘family’, but prepared according to Halal food standards. Use of the contested mark in relation to all the services covered by the application would therefore benefit from the power of attraction of the Mc- marks.

165. This is unfair for the reasons given in paragraphs 142 to 151 above.

Detriment to reputation and/or distinctive character

166. My finding that use of the contested mark would, without due cause, take unfair advantage of the Mc- ‘family’ of marks, is sufficient to uphold the opponent’s opposition under section 5(3) based on the Mc- ‘family’ of marks. In these circumstances, I see no need to unnecessarily lengthen this already long decision further by examining the opponent’s further claims of detriment to the reputation and/or distinctive character of the Mc- ‘family’ of marks.

The section 5(4)(a) ground of opposition

167. At the hearing, Mr Moss accepted that the opponent’s case under section 5(4)(a) based on its unregistered rights in MC- and MAC marks stood or fell with the section

5(2) and 5(3) grounds. As those grounds have succeeded, there is no need to separately examine the opponent's section 5(4)(a) case.

The bad faith case

168. In contrast to the opponent's position on its section 5(4)(a) case, Mr Moss asked me to make a determination on the opponent's allegation of bad faith, even if the application was going to be refused anyway under section 5(2) and/or 5(3) of the Act (which it is). An allegation of bad faith is a serious allegation. I therefore consider that both parties are entitled to a determination of the matter, even if it has no bearing on the outcome of the application.

169. Section 3(6) of the Act states:

“(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

170. In *Sky Limited & Ors v Skykick, UK Ltd & Ors*⁴⁴, the Court of Appeal considered the case law from, inter alia, *Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH*, Case C-529/07, *Koton Mağazacılık Tekstil Sanayi ve Ticaret AŞ*, Case C-104/18 P, *Hasbro, Inc. v EUIPO, Kreativni Dogaaji d.o.o. intervening*, Case T-663/19, and *pelicantravel.com s.r.o. v OHIM, Pelikan Vertriebsgesellschaft GmbH & Co KG (intervening)*, Case T-136/11. The relevant parts of the court's summary are as follows:

“1. -

2. -

3. The concept of bad faith presupposes the existence of a dishonest state of mind or intention, but dishonesty is to be understood in the context of trade mark law, i.e. the course of trade and having regard to the objectives of the law namely the establishment and functioning of the internal market, contributing to the system of undistorted competition in the Union, in which each undertaking must, in order to attract and retain customers by the quality of its goods or

⁴⁴ [2021] EWCA Civ 1121

services, be able to have registered as trade marks signs which enable the consumer, without any possibility of confusion, to distinguish those goods or services from others which have a different origin: Lindt at [45]; Koton Mağazacilik at [45].

4. The concept of bad faith, so understood, relates to a subjective motivation on the part of the trade mark applicant, namely a dishonest intention or other sinister motive. It involves conduct which departs from accepted standards of ethical behaviour or honest commercial and business practices: Hasbro at [41].

5. The date for assessment of bad faith is the time of filing the application: Lindt at [35].

6. It is for the party alleging bad faith to prove it: good faith is presumed until the contrary is proved: Pelikan at [21] and [40].

7. Where the court or tribunal finds that the objective circumstances of a particular case raise a rebuttable presumption of lack of good faith, it is for the applicant to provide a plausible explanation of the objectives and commercial logic pursued by the application: Hasbro at [42].

8. Whether the applicant was acting in bad faith must be the subject of an overall assessment, taking into account all the factors relevant to the particular case: Lindt at [37].

9. For that purpose it is necessary to examine the applicant's intention at the time the mark was filed, which is a subjective factor which must be determined by reference to the objective circumstances of the particular case: Lindt at [41] – [42].

10. Even where there exist objective indicia pointing towards bad faith, however, it cannot be excluded that the applicant's objective was in pursuit of a legitimate objective, such as excluding copyists: Lindt at [49].

11. -

12. *It is relevant to consider the extent of the reputation enjoyed by the sign at the time when the application was filed: the extent of that reputation may justify the applicant's interest in seeking wider legal protection for its sign: Lindt at [51] to [52].*

13.- ”

171. The opponents' case is, essentially, that the applicants have for their own commercial advantage, sought and continue to seek, to create a connection between themselves and the opponent. According to the opponent, the application to register the contested mark was filed to support this pattern of behaviour.

172. The first question is whether, in these circumstances, the application to register the contested mark should be regarded, at least *prima facie*, as an act of bad faith. This depends on whether the applicants' motivation amounts to a “*dishonest intention or other sinister motive*” which can be judged by assessing whether it “*involves conduct which departs from accepted standards of ethical behaviour or honest commercial and business practices.*”

173. In *Hotel Cipriani v Cipriani (Grosvenor Street)*⁴⁵, Arnold J. identified the following principles which were to be considered in assessing whether use was in accordance with honest practices:

(1) The requirement to act in accordance with honest practices in industrial or commercial matters constitutes in substance the expression of a duty to act fairly in relation to the legitimate interests of the trade mark proprietor.

(2) The court should carry out an overall assessment of all the relevant circumstances, and in particular should assess whether the defendant can be regarded as unfairly competing with the proprietor of the trade mark.

(3) An important factor is whether the use of the sign complained of either gives rise to consumer deception or takes unfair advantage of, or is detrimental to,

⁴⁵ [2009] RPC 9

the distinctive character or repute of the trade mark. If it does, it is unlikely to qualify as being in accordance with honest practices.

(4) In assessing whether the condition of honest practice is satisfied, account must be taken first of the extent to which the use of the third party's name is understood by the relevant public, or at least a significant section of that public, as indicating a link between the third party's goods or services and the trade mark proprietor or a person authorised to use the trade mark, and secondly of the extent to which the third party ought to have been aware of that.

(5) Another factor to be taken into account when making the assessment is whether the trade mark concerned enjoys a certain reputation in the Member State in which it is registered and its protection is sought, from which the third party might profit in marketing their goods or services.

(6) On the other hand, a mere likelihood of confusion will not disqualify the use from being in accordance with honest practices if there is a good reason why such a likelihood of confusion should be tolerated.

(7) Whether the defendant ought to have been aware of the existence of deception is a relevant factor. Once the defendant knows that their use is causing substantial deception or confusion, there can be no doubt that they must stop. (emphasis added)

The Court of Appeal considered the law in *Maier v ASOS*⁴⁶ and again in *Okotoks Ltd v Fine & Country*⁴⁷ but did not differ from Arnold J.'s analysis of the law.

174. I have already found that:

(i) Use of the contested mark would cause a significant section of the public to make a link with the BIG MAC and/or Mc- 'family' of marks;

⁴⁶ [2010] RPC 16

⁴⁷ [2013] EWCA Civ 672

(ii) The applicants did not intend to cause confusion by using the contested mark to create a link with the opponent's marks:

(iii) The effect of such a link would be that, without due cause, the contested mark draws on the reputation of, and characteristics associated with, BIG MAC and the marks in the opponent's Mc- 'family', so as to help market the applicants' MakHalal restaurants;

(iv) The applicants intended to obtain this benefit;

(v) This constitutes taking unfair advantage of the opponent's marks.

175. Accordingly, my findings of fact are sufficient to conclude that:

(i) use of the contested mark is likely to be contrary to honest commercial practices;

(ii) the applicants ought to have been aware, and I think were aware, that at least a significant section of that public would see their mark as indicating a link between their services and the opponent.

176. Whether they recognised it or not, judged objectively, this behaviour departs from accepted standards of honest commercial practices and therefore amounts to a form of commercial dishonesty. Consequently, the bad faith case must succeed unless the applicants have shown they nevertheless had a legitimate objective in filing the application.

177. Counsel for the applicants asked me to take into account that they have been using MAK HALAL as the name of their restaurants since 2018. In my view, this does not establish the application had a legitimate objective, such as preventing copying of their branding, in circumstances where:

(i) The opponent had made its concern about the use of MAC HALAL clear in 2018 and did not consent to the subsequent use of MAK HALAL or MakHalal;

(ii) At the relevant date, the applicants continued to use marks which manifestly sought to cement an association the opponent's marks, i.e. BIG MAK;

(iii) The applicants continued to use the contested mark alongside marks like BIG MAK to feed off the reputation of the opponent's marks (albeit without trying to cause actual confusion).

178. Further, I do not consider that the applicants have shown that the reputation enjoyed by the contested mark at the time when the application was filed was sufficient to justify their attempt to protect the trade mark, notwithstanding the effect such use might have on the opponent's marks. The evidence shows that the applicants operated just a single restaurant in Birmingham up until 2020. The use of the mark has expanded since then following the adoption of a franchise model. However, the MAK HALAL/MakHalal marks did not have a substantial or longstanding reputation at the relevant date.

179. According to the applicants, the opponent's behaviour justified their belief that it did not object to their use and registration of MAK HALAL marks. There are two elements to this. Firstly, that the opponent took no further action between December 2018 (when negotiations broke down) and November 2020 (when the application was filed) to prevent the use of MAK HALAL/MakHalal. Secondly, the opponent did not oppose the applicants' UK and EU trade mark applications filed in 2018 and 2019 to register MAK HALAL. This appears to amount to a claim that the opponent acquiesced to the applicants' use and registration of MAK HALAL marks, and thereby gave the applicants reasonable grounds to believe the opponent did not object to such use or further such registrations.

180. As explained above, there is no evidence that the opponent led the applicants to believe that they would not object to the use of MAK HALAL or MakHalal. The most that can be said is that the opponent may have been aware of the applicants' use of these names between December 2018 and the relevant date in 2020, and/or the applicants' applications to register these marks, and took no action to oppose such use/registration.

181. It is true that mere knowledge of the use of a later mark, combined with inactivity on the part of the proprietor of an earlier conflicting trade mark, may constitute acquiescence under trade mark law⁴⁸. The relevant section of the Act states:

“48(1) Where the proprietor of an earlier trade mark or other earlier right has acquiesced for continuous period of five years in the use of a registered trade mark in the United Kingdom, being aware of that use, there shall cease to be any entitlement on the basis of that earlier trade mark or other right— (a) to apply for a declaration that the registration of the later trade mark is invalid, or (b) to oppose the use of the later trademark in relation to the goods or services in relation to which it has been so used,

unless the registration of the later trade mark was applied for in bad faith.”

182. Section 48(1) applies to registered marks, not pending applications as in the case of the current proceedings. Even in relation to registered marks, acquiescence only becomes a bar to action after a period of 5 years has elapsed, and even then the bar does not apply where the later trade mark was applied for in bad faith (as in this case).

183. In my view, the applicants had no reasonable grounds for believing that the opponent’s lack of action against their use of MAK HALAL/MakHalal, and applications to register the same, meant they accepted such use. Nor do I consider that the applicants’ use of the contested mark legitimised it and meant they were acting in good faith when they applied to register it.

184. It is possible for an application to register a trade mark to be filed in bad faith as regards some of the goods/services in the application, but in good faith for others. However, in this case I consider that the applicants’ motives were the same for all the services covered by the application, including *salad bar* services. This is because all the services specified in the application were intended to cover the fast food business the applicants conduct, or plan to conduct, under the contested mark.

⁴⁸ See *Budějovický Budvar, národní podnik v Anheuser-Busch Inc* CJEU, Case C-482/09

185. The opposition under section 3(6) therefore succeeds for all the services covered by the application.

Overall result

186. The opposition has succeeded. The application will be refused in full.

Costs

187. The opposition having succeeded the opponent is entitled to a contribution towards its costs. Counsel for the applicants submitted that costs should take account of the fact that the opponent unnecessarily complicated its case through over pleading and compounded this by filing an excessive volume of evidence, some of which was of dubious worth. The opponent's case was partly based on two 'families' of marks. This necessarily resulted in a longer-than-usual notice of opposition. The opponent originally sought to rely on 14 earlier marks to support its section 5(2) and (3) grounds, and 10 earlier rights to support its section 5(4)(a) case. Prior to serving the notice of opposition the registrar directed the opponent to focus its case. The number of earlier marks relied on was reduced to 11. Ten of these justified serious consideration. Consequently, the initial over pleading was addressed before the applicants were required to respond to the opponent's case. The opponent was given leave to file up to 450 pages of evidence to support its case. Consequently, it cannot be criticised for doing so. It is true that some of the pages filed as evidence added very little to the opponent's case, but there was not an excessive amount of irrelevant evidence. I therefore reject the applicants' criticisms of the manner in which the opponent brought and supported its case.

188. I assess the on-scale costs due as follows:

£500 for filing the notice of opposition and considering the applicants' counterstatement;

£200 for the official fee for filing the form TM7;

£2000 for filing evidence and considering the applicants' evidence;

£1900 for preparing and attending the hearing;

£200 for preparing bundles for cross examination.

189. I therefore order Mr Ahmed Ben Khayi and Mr Abdulwahab Omar to pay McDonald's International Property Company, Ltd the sum of £4800 as a contribution towards the cost of these proceedings. The applicants are jointly and severally liable for these costs. They are to be paid within 21 days of the end of the period for appeal or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings (subject to any order of the appellate tribunal).

Dated this 22nd day of March 2023

Allan James

For the Registrar

Annex 1

Mark	Goods/services
McDONALD'S (UK1208244 & UK1285796) and McDonald's (UK1208245)	<p>Class 29: Hamburgers, cheeseburgers; chicken pieces (other than for animals); French fried potatoes; milk shakes being milk beverages; the milk predominating; milk, eggs; hashed brown potatoes; sausages</p> <p>Class 30: Sandwiches containing fish fillet, chicken or meat; sausage patties; fruit pies, muffins, hot cakes, Danish pastries, coffee, tea; ice cream sundaes</p> <p>Class 43: Restaurant services; but not including any such services relating to alcoholic beverages</p>
McCHICKEN (1144587)	Class 30: Edible sandwiches, all containing or flavoured with chicken
McNUGGETS (UK1245121)	Class 29: Pieces of poultry; all for food for human consumption
McMuffin (UK3342311)	Class 30: Edible sandwiches, meat sandwiches, pork sandwiches
McCafe	<p>Class 29: Milk-based beverages containing coffee; milk-based beverages flavored with chocolate, strawberry or vanilla.</p> <p>Class 30: Cocoa and artificial coffee; coffee; tea; chocolate-based beverages; chocolate beverages with milk; cocoa-based beverages; cocoa beverages with milk; coffee-based beverages; coffee beverages with milk; teabased beverages;</p>

	<p>iced coffee and other coffee drinks; iced tea; ice beverages with a coffee base.</p> <p>Class 32: Fruit beverages and fruit juices; smoothies.</p>
McDelivery (UK3232297)	Class 39: Food delivery services
BIG MAC (UK1165097)	Class 30: Sandwiches containing hamburgers; bread rolls containing hamburgers.
GRAND BIG MAC (UK3261876)	Class 30: Edible sandwiches, meat sandwiches, pork sandwiches