

Judgment of the General Court in Case T-58/23 Concerning Trademark Revocation Proceedings

- A. Background
- B. General Court's Examination
- C. Genuine Use of a Trademark in Greek Practice
- D. Conclusion

A. Background

1. The EU word trademark 'BIG MAC'¹ (the **Trademark**) is the subject of a dispute between the Irish fast-food chain 'Supermac's (Holdings) Ltd' (**Supermac's**) and the US fast-food chain 'McDonald's International Property Co. Ltd' (**McDonald's**).
2. In 2017, Supermac's filed an application with the European Union Intellectual Property Office (EUIPO) for the revocation of the Trademark, claiming that it had not been put to genuine use in the EU for a continuous five-year period, in connection with goods and services for which it was registered, specifically in classes 29, 30 and 42:
 - a. Class 29: Foods prepared from meat, pork, fish and poultry products, meat sandwiches, fish sandwiches, pork sandwiches, chicken sandwiches, preserved and cooked fruits and vegetables, eggs, cheese, milk, milk preparations, pickles, desserts;
 - b. Class 30: Edible sandwiches, meat sandwiches, pork sandwiches, fish sandwiches, chicken sandwiches, biscuits, bread, cakes, cookies, chocolate, coffee, coffee substitutes, tea, mustard, oatmeal, pastries, sauces, seasonings, sugar; and
 - c. Class 42: Services rendered or associated with operating and franchising restaurants and other establishments or facilities engaged in providing food and drink prepared for consumption and for drive-through facilities; preparation of carry-out foods; the designing of such restaurants, establishments and facilities for others; construction

¹ Reg. No.: 62638/ Reg. Date: 22.12.1998

planning and construction consulting for restaurants for others.

3. In 2019, the application was upheld by the Cancellation Division of EUIPO with regard to all the goods and services mentioned above, as the evidence provided by McDonald's did not prove the extent of use of the Trademark. The same year McDonald's filed a notice of appeal before EUIPO against its decision.
4. In 2022, by its decision (the **Contested Decision**), the Board of Appeal annulled the Cancellation Division's decision in so far as it had revoked McDonald's rights over the Trademark only in respect of the following subcategories of the goods and services in classes 29, 30 and 42:
 - a. Class 29: Foods prepared from meat and poultry products, meat sandwiches, chicken sandwiches;
 - b. Class 30: Edible sandwiches, meat sandwiches, chicken sandwiches; and
 - c. Class 42: Services rendered or associated with operating restaurants and other establishments or facilities engaged in providing food and drink prepared for consumption and for drive-through facilities; preparation of carry-out foods.
5. The Board of Appeal dismissed the appeal regarding the remaining goods and services of Classes 29, 30 and 42.
6. Subsequently, Supermac's filed an action before the General Court of the European Union (GCEU), by which it seeks the partial annulment and the alteration of the Contested Decision.

B. General Court's Examination

1. In reviewing the Contested Decision, the GCEU pointed out that the evidence submitted by McDonald's² does not provide any indication of the extent of use of the Trademark in connection with the goods at issue. In particular, it lacks indication as regards the volume of sales, the length of the period during which the Trademark was used and the frequency of its use and does not make it possible to ascertain in what quantities, or with what frequency and recurrence, the goods ('chicken sandwiches' and 'foods prepared from poultry products', as a broader category) were distributed.
2. Moreover, the GCEU pointed out that none of the evidence submitted by McDonald's³ was adequate to prove that the Trademark has been used in connection with '*services rendered or associated with operating restaurants and other establishments or facilities engaged in*

²Such as printouts of advertising posters, on which, inter alia, the handwritten words 'September – November 2016' appear, and menu boards relating to the 'Grand Big Mac Chicken', screenshots of a television commercial relating to 'BIG MAC & Grand BIG MAC Chicken', broadcasted in France in 2016 and screenshots from the Facebook account of McDonald's France, relating to the offer of "Grand Big Mac Chicken" in 2016.

³Such as photographs of the packaging used in relation to the 'meat sandwich', photographs of promotional brochures, printouts from McDonald's websites and Facebook account, surveys, newspapers, articles and a letter from the Director-General of a German employers' and trade association in the restaurant chains sector.

providing food and drink prepared for consumption and for drive-through facilities; preparation of carry-out foods'.

3. On 5 June 2024, GCEU ruled that McDonald's has not proven that the Trademark has been put to genuine use as regards the goods 'chicken sandwiches' (Class 29 and 30), 'foods prepared from poultry products' (Class 29) and the 'services rendered or associated with operating restaurants and other establishments or facilities engaged in providing food and drink prepared for consumption and for drive-through facilities; preparation of carry-out foods' (Class 42). Consequently, GCEU partially annulled and altered the Contested Decision, limiting the protection conferred on McDonald's by the Trademark.

C. Genuine Use of a Trademark in Greek Practice

1. According to Article 50 par. 2a (Revocation of trademark rights) of Law 4679/2020⁴ (the **Trademark Law**), if, within a period of five years following registration, the owner does not put the trademark to 'genuine use' in connection with the goods or services for which it is registered, or if such use has been suspended during an uninterrupted period of five years, the owner's rights over the trademark may be, partially or entirely revoked.
2. The Trademark Law requires the fundamental obligation of actual use of a registered trademark⁵ to ensure that legal protection is not granted to unused trademarks. The concept of genuine use of a trademark aligns with the trademark's essential function namely to guarantee the identity of the origin of the goods or services, allowing consumers and end users to distinguish them from others, without confusion.
3. Greek case law, following the guidelines and precedents of EU case law, considers that genuine use exists when a trademark is actually used in the market for the designated goods or services, and not merely for internal use by the undertaking concerned.
4. In this respect, when assessing whether there has been 'genuine use' of a trademark, the facts and circumstances, relevant to establishing whether the commercial use of the trademark could be considered as "actual", may include the characteristics of the relevant market and the scale and frequency of use. The use of the trademark does not need to be quantitatively significant to be deemed genuine, as it depends, inter alia, on the characteristics of the goods or services in the corresponding market. Thus, a low volume of goods or services marketed under the trademark at issue may be compensated for by a high intensity of use and/or a long period of regular use of that trademark or vice versa.

⁴ On the protection of trademarks and the incorporation of the Directive (EU) 2015/2436 and the Directive 2004/48/EC on the enforcement of Intellectual Property Rights and other provisions.

⁵ References are also made in Articles 28 (Non-use as defense in opposition proceedings), 40 (Non-use as defense in infringement proceedings), and 54 (Non-use as a defense in proceedings seeking a declaration of invalidity) of Trademark Law.

D. Conclusion

1. The dispute described above, and the relating decisions are important as they focus on the nature of the evidence required to substantiate genuine use. This evidence should exclude probabilities or presumptions and must be demonstrated by solid and objective evidence of actual and sufficient use of a trademark in the relevant market. Additionally, these decisions serve as a valuable reminder that even well-known trademark owners should not overlook these requirements.



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