

**TRADE MARKS ACT 1938 (AS AMENDED)  
AND TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NOS  
1503078, 1503079, 1503080 & 1503081  
IN THE NAME OF FRANK YU KWAN YUEN**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NOS 42467, 42468, 42469 AND 42470 IN THE NAMES OF  
MCDONALD'S CORPORATION AND MCDONALD'S RESTAURANTS LIMITED**

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5 **IN THE MATTER OF application Nos  
1503078, 1503079, 1503080 & 1503081  
in the name of Frank Yu Kwan Yuen**

10 **AND**

15 **IN THE MATTER OF opposition thereto  
under Nos 42467, 42468, 42469 and 42470 in the names of  
McDonald's Corporation and McDonald's Restaurants Limited**

20 **Background**

On 10 June 1992, Frank Yu Kwan Yuen filed four trade mark applications to register the trade mark McCHINA in Classes 29, 30, 31 and 42 in respect of the following goods:

25 **Class 29** Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams; eggs, milk and milk products; edible oils and fats; prepared meals consisting wholly or principally of the aforesaid foodstuffs; all included in Class 29.

30 **Class 30** Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking powder; salt, mustard; vinegar, sauces, salad dressings; spices; ice; prepared meals consisting wholly or principally of the aforesaid foodstuffs; all included in Class 30.

35 **Class 31** Fresh fruits and vegetables; edible seeds; all included in Class 31.

**Class 42** Restaurant services included in Class 42.

40 The applications were numbered 1503078, 1503079, 1503080 and 1503081.

45 On 15 May 1995, McDonald's Corporation and McDonald's Restaurants Limited (as joint opponents) filed notice of opposition to these applications in which they say that the opponents have, since about 1974, carried on their restaurant business under the trade mark McDONALD'S and also use a number of other marks having the prefix Mc. The grounds of opposition are in summary:-

1. **Under Section 11** Because the opposed marks would be likely to deceive or cause confusion or is otherwise disentitled to protection in a Court of Justice.
2. **Under Section 12** Because the mark applied for would contravene Section 12.
3. **Under Section 9 & 10** The trade mark is not qualified for registration.

10 Details of the opponents' registered marks cited in the grounds of opposition are set out as an annex to this decision.

The opponents ask that the Registrar exercise her discretion and refuse to register the mark, and that an award of costs be made in their favour.

15 The applicants filed Counterstatements in which they deny the grounds of opposition. They ask that the oppositions be rejected and that they be awarded costs.

20 Both sides filed evidence in these proceedings. The matter fell to be heard on 1 December 2000, when the applicants were represented by Mr Henry Carr of Her Majesty's Counsel, instructed by Alexander Ramage Associates, their trade mark attorneys, the opponents were represented by Mr Christopher Morcom QC of Her Majesty's Counsel, instructed by Marks & Clerk, their trade mark attorneys.

25 By the time this matter came to be determined, the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. These proceedings having begun under the provisions of the 1938 Trade Marks Act must continue to be dealt with under that Act, in accordance with the transitional provisions set out in Paragraph 17 of Schedule 3 of the 1994 Act. Accordingly, all references in this decision are references to the 1938 Trade  
30 Marks Act.

### **Opponents' evidence in Chief**

35 Separate Statutory Declarations were filed for each of the proceedings, but as these are identical in all material respects I will, for convenience only summarise one set.

The opponents' evidence in chief consists of two Statutory Declarations. The first is dated 25 September 1996 and comes from John Ivor Hawkes, Vice President of McDonald's Restaurants Limited (his company), a position he has held for 2 years. Mr Hawkes says that prior to his  
40 appointment as Vice President he had been employed by his company or by an associate company, McDonald's Development Company Limited for 12 years.

Mr Hawkes says that his company is a wholly owned subsidiary of McDonald's Corporation (the corporation), and in the United Kingdom is authorised and registered by the corporation as a user  
45 of, inter alia, the trade mark McDONALD'S, and its other trade marks featuring the syllable Mc/MAC.

Mr Hawkes says that McDonald's Corporation and the companies associated with it (hereinafter referred to as McDonald's) are market leaders in fast service restaurants, and have for many years operated and franchised a chain of hamburger restaurants in the United States of America under the trade mark McDONALD'S, and other marks incorporating the prefix Mc/MAC. He says that his company was incorporated in 1971, and since 1974 has operated its own chain of fast food restaurants in the United Kingdom under the same trade marks. He refers to exhibits JIH1 and JIH2 which consist of two lists detailing registrations or applications incorporating McDONALD'S or with the prefix Mc/MAC applied for or registered by McDonald's Corporation prior to 10 June 1992, the relevant date in these proceedings. Mr Hawkes asserts that these trade marks are well known and readily recognisable by the majority of the public in the United Kingdom as indicating goods and services provided by his company with the authority and under the control of McDonald's Corporation. He says that he believes there to be an inextricable connection between these marks and his company, especially in relation to restaurant services and menu items provided by its restaurants. He refers to exhibit JIH3 which consists of a list of his company's restaurants which were in operation prior to 10 June 1992, and which sets out details of 339 locations throughout the united Kingdom.

Mr Hawkes goes on to set out his company's turnover (net of VAT) for the years 1977 to 1995, which ranges from £6,610,845 in 1977 rising year on year to £480,295,000 in 1991, the last full year prior to the relevant date. The following years show a continued rise to £684,303,000 in 1995. Mr Hawke estimates that the provision of restaurant services accounts for approximately 50% of this turnover.

Mr Hawkes next refers to his company's activities to promote the trade marks, which, he says has been by means of nationwide television and radio advertisements, and refers to exhibit JIH4 which consists of two video tapes bearing examples of television advertising. He goes on to set out the approximate amounts spent annually on the promotion of the trade marks in relation to restaurant services and menu items supplied. These relate to the years 1979 to 1995 and which ranges from £1,040,367 in 1979 rising year on year to £22,881,456 in 1991, the last full year prior to the relevant date. The following years show a continued rise to £30,778,725 in 1995. Mr Hawkes reiterates that as a result of this publicity the trade marks are readily recognisable as indicating goods and services supplied by his company with the authority and under the control of McDonald's Corporation, and in support refers to exhibit JIH5 which consists of the results of a survey which he says confirms that a significant proportion of the public would associate the mark McCHINA when used in connection with restaurant services or menu items with McDonald's. The survey is dated 28 March 1996 and shows that 41% would see a restaurant under the name McCHINA as belonging to an existing chain of restaurants, of which, 70% (of the 41%) would believe this to be the McDonald's chain.

Mr Hawkes says that his company uses the trade mark McDONALD'S and its other marks featuring the syllable Mc/MAC on all of its literature, publicity material and packaging. He refers to exhibit JIH6 which consists of posters and packaging showing, inter alia, use of the words McDONALD'S, BIG MAC, BACON & EGG McMUFFIN, McRIB MEAL, FISH McNUGGETS, SAUSAGE & EGG McMUFFIN, McD.L.T., McCHICKEN SANDWICH, McFEAST, CHICKEN McNUGGETS SHANGHAI and ORIENTAL McRIB (under the heading Tastes of the Orient) and McFORTUNE COOKIE. Some of the items bear titles or have a theme of an oriental nature.

Mr Hawkes refers to the opponents' reaction at finding out about the applications which are the subject of these proceedings, and to the attempt to resolve the matter prior to the oppositions being filed. He goes on to set out what he sees as the likely consequences should the Mc prefix be used by the applicants, namely, that the use will be associated with his company's business or be seen as use authorised or approved by McDonald's, and that his company's reputation will be damaged.

The second Statutory Declaration is dated 26 September 1996 and comes from David Greene, an Associate Director of Taylor Nelson AGB plc, a company specialising in consumer surveys. Mr Greene says that he has been with this company for 3 years and that he has 13 years experience in the conduct of consumer surveys.

Mr Greene gives details of a method of conducting consumer surveys designed by his company, and which is described as Omnibus Sampling. He refers to exhibit DG1 which consists of details of the sampling and methodology of the survey used, which he says involves interviewing a representative number of adults, (in this case approximately 1,200) across the United Kingdom, the sample being structured to be representative of the population in terms of sex, age, social class and region.

Mr Greene says that in March 1996 his company was requested to undertake such a survey on behalf of McDonald's restaurants Limited to ascertain the public reaction to the name McCHINA, the results of the survey being shown as exhibit DG2. Mr Greene summarises the answers to the question "What would be your immediate reaction or first thoughts, on hearing that a restaurant had recently opened in your area called McCHINA?", which are as follows:

- 3% said it sounded like a McDonald's restaurant
- 5% thought it was connected to McDonald's restaurants
- 1% thought it was part of the McDonald's chain
- 1% thought it was a Chinese/McDonald's

He next summarises the answers to a question asking whether they believed McCHINA to be part of an existing chain of restaurants. Of the 41% that said yes, 70% thought that the restaurant chain was McDonald's, which he extrapolates to mean that 29% of those questioned believed McCHINA to be part of McDonald's.

### **Applicants' evidence**

This consists of two Statutory Declarations. The first is dated 28 January 1998, and comes from Frank Yu Kwan Yuen, the applicant.

Mr Yuen says that he came to England in 1967. He recounts his business activities in the years to 1989, at which time and influenced by the return of Hong Kong to China, he realised that the traditional Chinese food market would need to change and he decided to sell a new generation of Chinese food under the name McCHINA Wok Away. He says that in 1991 he opened the first of these restaurants in Wimbledon and began to register the names McCHINA and Wok Away. He says that this was to be the first open plan kitchen takeaway, cooking freshly prepared ingredients in front of the customer. He refers to exhibit YKY1 which consists of a leaflet and

various photographs depicting, inter alia, the exterior and interior of restaurant premises. The leaflet shows the frontage of the restaurant with the name “McCHINA stir fried”, the photographs show the name “McCHINA Wok Away”, the letter M and W made up of what looks like crossed chopsticks. Mr Yuen says that these show that these show that fears that the public will associate the McCHINA restaurant with McDonald’s are unfounded.

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Mr Yuen goes on to outline his plans to develop McCHINA Wok Away, and refers to exhibit YKY2 which consists of a business plan, marked “Copyright 1995 McCHINA Limited”. The plan is headed, and throughout refers to McCHINA, describing it as an “alternative to hamburgers, pizza and chicken”. The plan makes reference to “large, national fast food chains” and goes on to say that “To compete on equal terms the Chinese must follow the trend of reliable and consistent quality, yet provide something different to stem the onslaught of less expensive and more varied fast food options.”. The plan makes several references to the handover of Hong Kong to China in 1997 as an opportunity to gain and exploit the interest in China. There is a reference to “The new generation of Chinese food” but not, as Mr Yuen infers, to the marketing of the business as the “son of” the traditional Chinese takeaway.

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Mr Yuen refers to exhibit YKY3 which he says demonstrates that the advertising of McCHINA has never misled or attempted to prove any association with McDonald’s. The exhibit consists of various advertisements and features for McCHINA Wok Away takeaway restaurants, some referring to their “new generation of Chinese foods”. Those that are dated originate from July to October 1995. Mr Yuen next refers to exhibit YKY4 which consists of undated examples of the McCHINA Wok Away menu which Mr Yuen says illustrate that his company is selling a product in a completely different style and form to that of McDonald’s, and that the public cannot be confused or conclude that there is an association.

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Mr Yuen comments on the survey carried out on behalf of McDonald’s, noting that only 12% of the people questioned in the survey were from the stated customer base of McDonald’s (children and young people). He further notes that 3% said McCHINA sounded like McDonald’s whereas 31% said that they thought it was a Chinese restaurant. Mr Yuen gives his view on the recognition that he believes should have been achieved from an advertising expenditure of £31,000,000. He says that his target customers are at the opposite end of the market to McDonald’s.

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Mr Yuen refers to exhibit JIH1 to Mr Hawkes’ Declaration, which includes publicity for products from the McDonald’s “Tastes of the Orient” range, commenting that this is the motivation behind the opposition by McDonald’s who wish to use something similar to diversify their business. He denies that the applicants have any intention to sell the concept of McCHINA as an association with McDonald’s. Mr Yuen refers to exhibit YKY5 which consists of copies of letters from two companies interested in operation McCHINA businesses, Mr Yuen noting that neither express any concern about possible confusion with McDonald’s.

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Mr Yuen concludes his Declaration by giving his views on the motives and actions of McDonald’s, and refutes the suggestion that there is likely to be confusion.

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**Applicants' evidence (Rule 13(8))**

This consists of a Statutory Declaration dated 1 December 1998 and is a second Declaration by Frank Yu Kwan Yuen.

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In this Declaration Mr Yuen responds to the Declaration of 29 October 1998 made by John Ivor Hawkes on behalf of the opponents, and inter alia, makes the following points:

- 10 S the prefix Mc was adopted to signify "son of" because the public would not recognise the Chine equivalent.
- S there are two McDonald's restaurants within 1 mile of the McCHINA restaurant which is close enough for there to be confusion.
- 15 S Mc is well known and used as a title, although as a prefix it has no meaning.
- S McDonald's do not own the trade mark McCHINA and would not be affected by a Chinese takeaway business trading under that name.

20 Mr Yuen goes on to refer to the Declaration of 26 October 1998 made by David Green on behalf of the opponents. He comments that Mr Green does not give the dates on which the survey was conducted or where it was undertaken. He requests that the survey should not be relied upon until he has had the opportunity to file rebuttal evidence. None was filed.

25 **Opponents' evidence in reply**

This consists of three Statutory Declarations. The first is dated 8 March 2000 and is a second Declaration of John Ivor Hawkes.

30 Mr Hawkes comments on the Declaration by Mr Yuen on behalf of the applicants, and in particular, on the reason given by Mr Yuen for adopting the prefix Mc rather than the Chinese equivalent and to his claim that there has not been any confusion. Mr Hawkes goes on to refute the assertion that his company or McDonald's Corporation is seeking to monopolise the prefix Mc, per se. He says that they do not claim to have invented it, but for the reasons he gives, he believes that they have a justifiable claim to the prefix when used in conjunction with restaurant services and menu items, and that use of the prefix by another in respect of the same goods or services would mislead the public as to their origin. He continues saying that his company and the McDonald's corporation are not trying to demonstrate a connection between their businesses and the trade mark McCHINA, rather, and as evidenced by the surveys, that the use of the Mc prefix is likely to be associated with them. Mr Hawkes asserts that the applicants are trying to present a modernised and westernised concept of Chinese food by trading off the McDonald's name and reputation.

45 Mr Hawkes goes on to refer to the Chinese foods sold as menu items in McDonald's restaurants, and that he believes that a significant proportion of customers will be aware of this and are more likely to assume a connection exists between McDonald's and the applicants' restaurant trading under the name McCHINA. He concludes this Declaration by commenting on the conclusions

of the surveys conducted by David Greene, noting that the largest percentage of those questioned identified McDonald's with the Mc prefix.

5 Next is a Statutory Declaration dated 29 February 2000, and is a second Declaration by David Greene, who now describes himself as a Director of Taylor Nelson Sofres Plc.

Mr Greene refers to the Declaration made by Alan Wicken on behalf of the applicants, inter alia, making the following comments on Mr Wicken's observations regarding the conduct and results of the survey he conducted on behalf of McDonald's:

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S the survey is carried out using hand-held capri machines with the data automatically downloaded to a mainframe computer. The machines have the capacity to record verbatim answers which would have been coded by an experienced coder.

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S the questions asked were balanced, not leading and pitched so that respondents could understand them.

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S that his summary of the survey should have said that (of the respondents) "41% said that they saw McCHINA as being part of an existing chain", and that the change of terminology would make no appreciable difference to the results.

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S whilst seeming to agree that 7% (the respondents to question 3 of the survey who made a connection with McDonald's), is not impressively large, 41% thought that McCHINA was part of an existing chain, and 70% (of the 41%) thought that this was McDonald's, which is a high positive result.

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S The results of the second survey showed that 18% of respondents would connect a sign saying McCHINA with McDonald's, that changing "China" for another word may have achieved the same results, and that the suffix is of lesser importance.

The final Statutory Declaration is dated 18 March 1999, and comes from Shez Mockford, the Manager of the McDonald's restaurant in Camberley, a position he has held for 18 months.

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Mr Mockford says that he is aware of the applicants' McCHINA restaurant in Camberley, saying that in the past six months he has received two telephone calls from members of the public asking if the applicants' restaurant is part of or accessible from the McDonald's restaurant. From this Mr Mockford draws the conclusion that the public will believe that any fast food restaurant trading under a name beginning with Mc (other than a recognisable family name) is operated or connected with McDonald's.

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That concludes my review of the evidence insofar as it is relevant to these proceedings.

### **Decision**

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At the hearing Mr Morcom stated that the opponents would not be pursuing the grounds under Section 9 and 10, which leaves the opposition as founded on the grounds under Section 11 and 12 of the Act. Those sections read as follows:-



11 It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design.

5  
12.-(1) Subject to the provisions of subsection (2) of this section, no trade mark shall be registered in respect of any goods or description of goods that is identical with or nearly resembles a mark belonging to a different proprietor and already on the register in respect of:

10 (i) the same goods

(ii) the same description of goods, or

15 (iii) services or a description of services which are associated with those goods or goods of that description.

20 The reference in Section 12(1) to a near resemblance is clarified by Section 68(2)(b) of the Act which states that references in the Act to a near resemblance of marks are references to a resemblance so near as to be likely to deceive or cause confusion.

25 The established tests for objections under these provisions are set down in Smith Hayden and Company Ltd's application (Volume 1946 63 RPC 101) later adapted, in the case of Section 11, by Lord Upjohn in the BALI trade mark case 1969 RPC 496. Adapted to the matter in hand, these tests may be expressed as follows:-

30 **Under Section 11** Having regard to the opponents' user of the mark McDONALD'S and other Mc or MAC prefixed marks, is the tribunal satisfied that the mark applied for, McCHINA, if used in a normal and fair manner in connection with any goods or services covered by the registration proposed will not be reasonably likely to cause deception and confusion amongst a substantial number of persons?

35 **Under Section 12** Assuming user by the opponents of their marks in a normal and fair manner for any of the goods or services covered by the registrations of that mark, is the tribunal satisfied that there will be no reasonable likelihood of deception amongst a substantial number of persons if the applicants use their mark McCHINA, normally and fairly in respect of any goods or services covered by their proposed registration?

40 Turning first to the ground under Section 12 of the Act. The opponents rely on a large number of registrations for, or incorporating the trade marks McDONALD'S or MAC, or that have the prefix Mc. Most of these are for groups of the same mark but registered in respect of several classes. At the hearing Mr Morcom indicated that he considered his best case to be based upon the opponents' registrations in Class 42, which cover identical services, and that if he failed in this respect he would be in no better position for any of the other classes in which the opponents have registrations. I therefore need only consider the respective marks, and in this I adopt the well known test propounded by Parker J in Pianotist Co's application (1906) 23 RPC 774. The relevant passage reads:

5 "You must take the two words. You must judge of them both by their look and by their  
sound. You must consider the goods to which they are to be applied. You must consider  
the nature and kind of customer who would be likely to buy those goods. In fact, you  
must consider all the surrounding circumstances; and you must further consider what is  
likely to happen if each of these trade marks is used in a normal way as a trade mark for  
the goods of the respective owners of the marks. If, considering all those circumstances,  
you come to the conclusion that there will be a confusion - that is to say - not necessarily  
that one will be injured and the other will gain illicit benefit, but that there will be a  
confusion in the mind of the public, which will lead to confusion in the goods - then you  
10 may refuse the registration, or rather you must refuse the registration in that case."

15 The applicants' mark consists of the word McCHINA, which, self evidently, is neither visually or  
phonetically identical to any of the marks set out in the annex to this decision . The most that can  
be said is that some elements of the opponents' registrations share the same "Mc" or MAC prefix,  
but as said by the Hearing Officer in the McINDIANS case (SRIS 0/121/96) to which I was  
referred, "the presence of the common feature "Mc" is totally insufficient to reach a conclusion  
that the marks are confusingly similar. I find in fact that they are not similar". I see no reason to  
take a contrary view, or why the feature MAC should be any different.

20 Although the applicants' services are limited to the provision of foodstuffs prepared to a Chinese  
recipe or in such a style, the opponents' registrations have no such restriction, and notionally, the  
respective marks are to be used in relation to the same services, that is, take-away restaurant  
services. Prepared meals from restaurants are self-selected from a menu, and whilst a certain  
degree of care will be taken, this in my view is likely to be in the choice of foodstuff, for example,  
25 whether to have a "burger" or a Chinese meal, rather than the purveyor. The applicants contend  
that they cater for a different market, and this may well be the case in reality, but as I have already  
said, the services are, at least notionally, to be provided to the same customer base.

30 Taking all of the above into account, I find that there while there is a possibility of consumers  
being given cause to wonder whether there is an association between the applicants and the  
opponents, I do not believe that there is a real tangible risk of confusion or deception amongst a  
substantial number of persons, and consequently, the opposition fails under Section 12.

35 Turning to the grounds under Section 11 of the Act. The test set out earlier requires me to  
consider the user established by the respective parties at the relevant date, that is the date of the  
application for registration of the trade mark under opposition, which in this case is 10 June 1992.

40 The opponents say that they have used the trade mark McDONALD'S in the United Kingdom  
since 1974 in relation to fast food restaurants, and although there is no evidence to establish this,  
turnover figures have been provided from that date, and as the name under which the business  
trades I have no difficulty in accepting that they have used the name since that date. They also  
say that they have used a range of Mc and MAC prefixed trade marks and that this use has  
established a connection between Mc/ MAC and themselves. Although the evidence submitted  
to establish this use is very thin and cannot be said to originate from before the relevant date, it  
45 does show that the opponents use trade marks with the prefix Mc or MAC in respect of menu  
items, and I consider it reasonable to infer that this use is indicative of their trading style prior to  
the relevant date.

At the date of application to register McCHINA, the opponents already had over 50 registrations (not including McDONALD'S) for trade marks with Mc and MAC as a prefix or feature, mostly used in conjunction with a descriptive, food related term, such as McBurger, McSalad or McFeast. I accept that registration is not evidence that the marks have been used, but given that the trade marks are used in respect of menu items, that the opponents have been trading for many years prior to the relevant date and the sheer scale of the turnover (which by any measure is massive), I find it most unlikely that they have not used at least a number of the marks they have registered.

The survey commissioned by the opponents is said to establish that a significant proportion of the public would associate the mark McCHINA when used in connection with restaurant services or menu items with McDonald's. The survey is dated 28 March 1996, which is getting on for four years after the relevant date and it is not possible to say whether the results would have been any different had it been conducted at the relevant date. It is possible that increasing use of Mc and MAC prefixed trade marks by the opponents has heightened the public's awareness. Whether or not this is the case, given the scale of the opponent's business at the relevant date; over £500,000,000 and £22,000,000 in turnover and advertising spend, and 339 restaurants throughout the country, it is difficult to believe that there can be many who, if they have not eaten at, will not have heard of or seen one of the opponents' restaurants and some of their menu items.

The applicants are critical of the surveys conducted by the opponents, both in the construction of the questions and the recording of the results, but in any case, they do not consider the results to be of much assistance to the opponents. The results of the survey do not appear to be particularly impressive, although as Mr Yuen highlights only 12% of those questioned were from the stated customer base of McDonald's. When asked what their immediate reaction or first thoughts would be on hearing that a restaurant had recently opened in your area called McCHINA?, at best only 10% of those asked made an association with the opponents. In answer to a question asking whether they believed McCHINA was part of an existing chain of restaurants, 41% said that they did, and of these, 70% thought that the restaurant chain was McDonald's which extrapolates to mean that 29% of those questioned believed McCHINA to be part of McDonald's.

The survey in the McINDIANS case achieved a 76% association with the opponents. The question in that survey was somewhat different, asking whether the respondent recognised words such as McBACON, McBEANS, McTOAST, McPORK, and McSAUSAGE. Despite accepting some criticisms of the survey, the hearing officer took it to provide strong support to the view that the opponents' reputation derived from their use of their marks such as McDONALD'S, BIG MAC, McMUFFIN, etc, in relation to foodstuffs, is very likely to be perceived by the purchasing public as indicating an association between such marks and the opponents' business. The hearing officer went on to say "Indeed, such is the power of advertising that it is an association that I would make myself, even though I am only a very infrequent user of the opponents' restaurants.", a statement which is equally applicable to my experience of the opponents' business.

The letters Mc have no reference to foodstuffs or restaurants that I am aware of, and are not, therefore, an obvious or natural choice to use as prefix to such descriptive words. Whilst I do not question the veracity of the reason given by the applicants for having chosen the prefix as part of their trading style, I am not convinced that many would distill the meaning that the applicants

intend. I am supported in this view by the second of the surveys conducted by the opponents in which only 2% of respondents on seeing Mc used in McCHINA thought of its meaning as “son of”, compared to the 18% who draw an association with the opponents.

5 When all relevant factors are considered, and I do not consider it unreasonable to have regard to  
the survey in the McINDIANS case, I am lead to the belief that Mc used as a prefix to a word  
descriptive of a type of foodstuff, (eg Burger), or with connotations of food or restaurants, such  
as the constituents, (eg Pork), form, (eg Nugget), method of preparation (eg Fried), or style of  
10 cuisine (eg Indian) is likely to be regarded by a significant proportion of the public as signifying  
an association with the opponents’ business. I consider that the word CHINA would be taken as  
an indication of a style of cuisine from that country, and that should the applicants use their mark  
in relation to restaurant services (and by extension foodstuffs), there would be a strong likelihood  
of deception and confusion amongst a substantial number of persons. I find the opposition to be  
15 successful under Section 11 of the Act in respect of the services specified in their application in  
Class 42, and also in respect of the goods covered by the applications in Classes 29, 30 and 31.

The opponents have been successful in these proceedings and I do not, therefore, need to consider  
the exercise of my discretion, they are entitled to a contribution towards their costs, and I order  
20 the applicants to pay to the opponents the sum of £2,440, these costs to cover all three  
proceedings. The costs are to be paid within seven days of the expiry of the appeal period or  
within seven days of the final determination of this case if any appeal against this decision is  
unsuccessful.

25 **Dated this 1 day of February 2001**

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**Mike Foley  
for the Registrar  
The Comptroller General**