



MACDIMSUM TRADE-MARK FOUND NOT REGISTRABLE FURTHER TO RESTAURANT GIANT McDONALD'S OPPOSITION

BARRY GAMACHE^{*}
ROBIC, LLP
LAWYERS, PATENT & TRADEMARK AGENTS

A recent decision by the Opposition Board of Canada's Trade-marks Office has dismissed an application filed by Mr. Tong G. Cheah for the trade-mark MACDIMSUM further to the opposition brought by McDonald's Corporation and McDonald's Restaurants of Canada Limited on the basis of alleged confusion with various registered trade-marks owned by McDonald's Corporation that have a MC or MAC prefix. In his decision, Hearing Officer Herzig examined Mr. Cheah's choice of associating the prefix MAC with the expression DIMSUM and its likely affect on consumers who had an imperfect recollection of McDonald's Corporation's trade-marks (*McDonald's Corporation and McDonald's Restaurants of Canada Limited v. Cheah*, 2012 TMOB 138 (T.M.O.B.), Myer Herzig, July 26, 2012; decision released August 1, 2012).

On February 12, 2007, in accordance with Canada's *Trade-marks Act*, R.S.C. 1985, c. T-13 (hereafter the "Act"), Tong G. Cheah (hereafter "Mr. Cheah") filed an application to register in Canada the trade-mark MACDIMSUM in association with a long list of food products (for example, [f]ood and drinks namely Steamed Chicken Buns with Mushrooms, Steamed BBQ Pork Buns, Steamed Custard Duck Egg Buns, Pork Dumplings (Shiu Mai), Minced Pork in Bean-Stick Rolls with Oyster Sauce, Meat and Shrimp Dumpling "Chiu Chow Style", Filet with King Oyster Mushrooms, Bamboo Fungus with Mixed Mushrooms Dumplings, Shrimp Dumplings (Har Gow), Seafood Dumplings, Sticky Rice in Lotus Leaves, Steamed Mixed Beef Balls with Bean Sticks, Spareribs in Black Bean Sauce, Chickens' Feet in Chef's Sauce and other similar products) on the basis of proposed use of the trade-mark with those wares in Canada.

Mr. Cheah's MACDIMSUM trade-mark appears to suggest traditional Chinese cuisine known as dim sum in which small portions of a variety of foods are served in succession (according to the definition of "dim sum" found in the Free Online Dictionary at www.thefreedictionary.com, consulted on September 25, 2012). Mr. Cheah's MACDIMSUM application was published for opposition purposes on March 5, 2008 and on May 5, 2008, McDonald's Corporation (hereafter "McDonald's") and McDonald's Restaurants of Canada Limited (hereafter "McDonald's Canada") filed a statement of opposition raising various grounds of opposition having in common the

© CIPS, 2012.

^{*}Barry Gamache is a member of ROBIC, LLP, a firm of lawyers, patent and trademark agents. Published in the November 2012 issue of *World Intellectual Property Law Report*. Publication 142.269.

ROBIC, LLP
www.robic.ca
info@robic.com

MONTREAL
1001 Square-Victoria - Bloc E - 8th Floor
Montreal, Quebec, Canada H2Z 2B7
Tel.: +1 514 987-6242 Fax: +1 514 845-7874

QUEBEC
2828 Laurier Boulevard, Tower 1, Suite 925
Quebec, Quebec, Canada G1V 0B9
Tel.: +1 418 653-1888 Fax.: +1 418 653-0006

issue of alleged confusion between Mr. Cheah's trade-mark and various trade-marks owned by McDonald's.

Essentially, McDonald's argued that it owns in Canada a family of trade-marks that begin with the prefix MC or the prefix MAC combined or associated with a word that usually indicates a food product. This family of trade-marks includes MCDONALD'S for various food products and restaurant services; MACSUNDAE for sundaes; MCCHICKEN for cooked and uncooked fresh chicken; MCMUFFIN for a breakfast food combination sandwich; MCNUT for nuts and MAC FRIES for French fried potatoes. This family also includes the trade-mark BIG MAC for a ready-to-eat hamburger sandwich (although in the case of BIG MAC, the MAC component is not used as a prefix) and others such as MCNUGGETS and MCFLURRY.

In support of their grounds of opposition alleging confusion, McDonald's and McDonald's Canada (the "Opponents") filed evidence establishing, for example, that annual sales in Canada of MCNUGGETS products exceeded, on average, 120,000,000\$ CDN for the period 2003-2008; annual sales in Canada of MCMUFFIN products exceeded, on average, \$100,000,000 for the same period while annual sales in Canada of MCCHICKEN sandwiches exceeded, on average, \$75,000,000 CDN, also for the same period. The evidence also established extensive advertising of McDonald's wares and services in various media. McDonald's advertising made reference to its various marks including MCCHICKEN, CHICKEN MCGRILL, CHICKEN MCNUGGETS, MCVEGGIE BURGER, MCCAFFEE, EGG MCMUFFIN, MCGRIDDLES and MCFLURRY. Among their various products and services, the Opponents also sold Asian-themed food products in Canada such as Szechwan dipping sauce that accompanies CHICKEN MCNUGGETS products. These last sales were made as early as 1987.

The Opponents also filed a survey that was conducted in a shopping mall environment "intended to determine whether consumers would identify a particular individual, business or company as the source of products listed" in the application filed by Mr. Cheah. According to the survey results, 29% of respondents (out of 101) replied that they believed "McDonald's manufactures or sells MACDIMSUM food products". That group of 29% pointed to the MAC prefix in the MACDIMSUM trade-mark as the main reason for their answer.

For his part, Mr. Cheah explained that the MAC component of his trade-mark alluded to "Malaysian/Asian/Chinese Dim Sum". However, Hearing Officer Herzig noted that no evidence was provided in support of Mr. Cheah's assertion that this meaning was somehow clear for consumers.

In his decision, Hearing Officer Herzig noted that the confusion that is the Act's main concern is not confusion of the marks themselves but rather the mistaken inference that would occur if goods or services from one source are considered as being goods and services from another source.

Under the circumstances, did Mr. Cheah satisfy his onus of establishing the absence of likelihood of confusion between his trade-mark MACDIMSUM and the Opponents' various trade-marks? Hearing Officer Herzig concentrated on the Opponents' MCDONALD'S trade-mark. He wrote that it is well-known, if not famous, in Canada in association with restaurant food and services; on the other hand, no reputation was associated with the MACDIMSUM trade-mark. Additionally, all parties' marks have prefixes that are either MC or MAC (both considered phonetic equivalents by Hearing Officer Herzig). Moreover, the Opponents have used in Canada, as they alleged, members of their family of trade-marks that have a MC or MAC component for food products.

After review of the evidence, Hearing Officer Herzig concluded that Mr. Cheah did not satisfy his onus of establishing the absence of likelihood of confusion and his applied for trade-mark MACDIMSUM was found to be unregistrable.

This case is a reminder that care should be taken when choosing a trade-mark that could suggest a link to a well-known trade-mark because of a common component. For the owner of a famous trade-mark, the presence of a family of trade-marks, all having a same common element, is certainly an important asset when it comes to challenging a newcomer's adoption of a trade-mark having a similar component in the same area of trade.



ROBIC, LLP
www.robic.ca
info@robic.com

MONTREAL
1001 Square-Victoria - Bloc E - 8th Floor
Montreal, Quebec, Canada H2Z 2B7
Tel.: +1 514 987-6242 Fax: +1 514 845-7874

QUEBEC
2828 Laurier Boulevard, Tower 1, Suite 925
Quebec, Quebec, Canada G1V 0B9
Tel.: +1 418 653-1888 Fax.: +1 418 653-0006