BL O/0678/25

IN THE MATTER OF THE TRADE MARKS ACT 1994 AND:

IN THE MATTER OF:
UK TRADE MARK APPLICATIONS NOS 3630165, 3630194 & 3630037
In the name of Jana Speleers
AND OPPOSITION NOS 429113, 429114 & 429115 THERETO
In the name of McDonald's International Property Company, Ltd.
-
- and -

UK TRADE MARK NOS 2372555, 2340099, 903581089,
2341398, 903224888 & 903196581
In the name of McDonald's International Property Company, Ltd.
AND CANCELLATION NOS 505099, 505100, 505101,
505102, 505103 & 505104 THERETO
In the name of Jana Speleers

DECISION OF THE APPOINTED PERSON

1. This is an Appeal from a decision of the Hearing Officer Matthew Williams dated 25 October 2024 dealing with a number of consolidated Oppositions and Cancellation applications arising out of the application by Jana Speleers (referred to by the Hearing Officer as Party B) to register the mark LOVIN IT for a wide range of goods and services. In particular we are concerned with UK trade mark 3630165 (referred to as Mark 1) which was applied for inter alia for types of clothing and related goods in class 25. The mark was opposed by McDonald's International Property Company Limited (referred to by the Hearing Officer as Party A) based on its own registrations and goodwill in the phrase I'M LOVIN IT.

McDonald's is of course the well-known fast-food restaurant chain. Ms Speleers sought to cancel the marks relied on by McDonald's on the grounds of non-use.

2. It is not necessary to go into the details of the findings of the Hearing Officer save to note that he held that McDonald's had used its marks and indeed had obtained a very strong reputation and enhanced distinctiveness in them in relation to its core food, drink and restaurant services. However, the extent of any link and unfair advantage was limited by the fact that the phrases I'M LOVIN IT and LOVIN IT represent simple English words which have a readily understood meaning and are used every day by people without referring to McDonalds.

3. Balancing these two factors, the Hearing Officer held (in summary) that use by Ms Speleers of Mark 1 would create a link in the mind of the average consumer with McDonald's I'M LOVIN' IT trade marks and would give rise to an unfair advantage so as to give rise to an objection under s5(3) of the 1994 Trade Marks Act only when used in relation to goods and services in which the average consumer would consider McDonalds to have some commercial interest or association. The more distance between the goods and the core business of McDonalds, the less likely there was to be the necessary mental link or consequential damage.

4. To give effect to this decision he examined all the goods and services which Mark 1 was applied for and excluded from registration those which he thought the average consumer would think were commercially associated with McDonalds. This Appeal concerns the scope of those exclusions. McDonald's allege that the list of goods in class 25 which were excluded from registration should be expanded to cover other goods. Essentially the same arguments are also made in respect of the services in class 35 (this is for retail and other services in relation to the sale of the goods listed in class 25).

5. The Hearing Officer recorded that he had taken two things into account in particular when coming to his conclusion:

(i) Some evidence filed by McDonalds showing some US online retailers offering various goods in class 25 for sale, apparently with McDonald's branding. This was said to be the 'best available' evidence of the types of class 25 goods in which McDonalds might reasonably be expected to have an interest for merchandising purposes. I would add that he did not say that the evidence was particularly convincing.

(ii) His own knowledge and experience as a member of the public.

6. The Hearing Officer concluded that he should exclude from registration the types of clothing in class 25 which may normally be merchandised, giving the examples of tee-shirts, sweatshirts, caps, clothes aimed at children, paper hats. He explained that this also meant the exclusion of wider terms which would include any of these narrower individual types of product. He further excluded *'footwear'* because it arguably included socks, an item which he plainly considered was sufficiently merchandisable to give rise to the requisite link in the public mind.

7. I should add that he also excluded various items in class 9 including *'protective clothing'* (on the basis that it may be worn or possibly purchased by staff at McDonalds) and *'protective masks'* (on the basis that they were ubiquitous during the COVID pandemic and could be the sort of inexpensive merchandising item which might be offered at scale to the public by a company such as McDonald's).

8. In the end the following goods in class 25 were excluded from registration (and by extension the services of selling them in class 35):

Clothing, footwear, headgear; cap peaks; caps; hosiery; jerseys; children costumes; casual clothing; outer clothing; overalls, smocks; paper hats readymade clothing; shirts; short-sleeve shirts; sports jerseys; socks; sweaters,

jumpers; tee-shirts; vests

Ground 1 of the Appeal

9. In this appeal, Ms Blyth for McDonalds says in the light of those findings that it was irrational of the Hearing Officer not to include other items in class 25 of the same kind as those I have listed in paragraph 8 above.

10. I will rule on each of these items in turn.

(i) Berets.

It was said that having excluded *'caps'*, the Hearing Officer ought rationally have excluded *'berets'* as well. This does not follow. As the Hearing Officer explained, where a wide class (say *'headgear'*) includes within it an objectionable sub-class (here, *'caps'*), the wide class must be refused. However, it does not follow that every other sub-class within the wide class (eg *'berets'*) would also have to be refused. The finding on *'caps'* is explicable on the basis that it would cover traditional merchandising items such as baseball caps. I can see no reason why that finding also required the refusal of *'berets'*. Ms Blyth accepted this in the course of the hearing, and suggested that this objection should be moved into the Second Ground of Appeal – I will therefore deal with it below.

(ii) Hats.

This is said to be a synonym for *'headgear'* which was refused as explained above because it was wide enough to cover *'caps'*. Since *'hats'* is in my view also wide enough to include *'caps'* it ought also to have been refused as a matter of consistency. I will allow the appeal on *'hats'* accordingly.

(iii) Headgear for wear.

This comes to the same thing as *'headgear'* itself which was refused as explained above. So I agree it was inconsistent not to exclude this from registration. I will allow the appeal on *'headgear for wear'*.

(iv) Skull caps.

The argument here was the same as regards *'berets'* (see above). For the same reasons it is not a good point, and Ms Blyth asked me to consider it as part of the Second Ground of Appeal.

(v) Visors.

This is said to be a synonym of *'cap peaks'* which were excluded from registration. I understand that whilst the ordinary meaning of visors suggests a protective item covering the face, the term also covers headgear of the tyle consisting of something like a cap peak attached to the head by a band (worn in order to provide shade from the sun). These can certainly be promotional items like cap peaks, and ought to have been excluded for the same reason. I will allow the appeal on *'visors'*.

(vi) Aprons.

These were argued to be synonyms of *'overalls'* and *'smocks'* which were excluded. I do not agree with this. However, they do plainly fall into the HO's definition in paragraph 50 of his Decision of what should be refused in class 9 (protective clothing of the kind one would expect to be worn by McDonald's workers), so in my view they ought also to have been excluded for consistency. I will allow the appeal for *'aprons'*.

(vii) Clothing.

This was excluded where it appeared at the beginning of the list of goods but was not excluded when it appeared later on. This was a simple mistake by the Hearing Officer which I will correct by allowing the appeal in relation to *'clothing'*.

(viii) Masquerade costumes.

This was said to be a synonym or broader class for *'children's costumes'* which was refused. I do not accept this. It is a very specific item relating to costumes worn at masked balls or other events featuring masked participants. I will not allow the appeal.

(ix) Sports singlets.

This was said to be a synonym for *'vests'* which was excluded. I do not accept this. It is a more specific item and does not need to be excluded for consistency. I will not allow the appeal.

(x) Tights.

These were said in the skeleton argument to be a synonym for *'hosiery'* which was excluded from registration. This is plainly not the case, as Ms Blyth fairly accepted in the course of argument. *'Hosiery'* would include socks which the Hearing Officer clearly thought were sufficiently merchandisable to be refused. I therefore see no irrationality or inconsistency in allowing tights. I will not allow the appeal.

(xi) Footwear.

This is the same point as in relation to *'clothing*. The first appearance of *'footwear'* in the list of goods was refused on the basis that it included socks which were objectionable. However, there are two other references to

'footwear' in the specification which were not deleted. I agree these should also be refused and I will allow the appeal on *'footwear'* (twice).

11. I turn to the points on class 35. There are two of these. First, the Hearing Officer plainly intended to make the list of goods in class 35 consistent with the list in class 25. However, when executing this plan, there seems to have been an error in that he failed to exclude from registration *'jerseys, children's costumes, outer clothing, overalls, smocks, sweaters'* when he had excluded them from class 25. I agree that this was a clear inconsistency and I will therefore allow the appeal in relation to these goods from the list in class 35.

12. Second, the list in class 35 needs to reflect my findings in relation to the list in class 25 as set out above.

Ground 2 of the Appeal

13. This Ground is not based on inconsistency. Rather it seeks to re-open the debate before the Hearing Officer in respect of a wide range of goods in class 25. McDonald's argued that these other goods are ones in which McDonald's would also reasonably be considered by the average consumer to have an interest for merchandising purposes.

14. There is a large number of the class 25 goods in this class including *bathing suits, mittens, money belts, ponchos, scarves, slippers* etc. I will not list them all.

15. This Ground of Appeal is a direct challenge to a difficult and multifactorial decision of the Hearing Officer and is inherently ill-suited to an Appeal. Some real error of principle would have to be shown which undermined the decision on these goods in order to persuade me to reconsider the matters.

16. Obviously almost anything could be merchandised. However, some things are much more readily associated in the mind of the public with merchandising

activities than others. One thinks immediately of t-shirts and baseball caps. The more strongly the goods are considered to be merchandising items, the more likely a link is to be made with McDonald's in the mind of the average consumer when they see the term 'LOVIN IT'. Furthermore, as the Hearing Officer said, the conceptual distance between the goods in question and the goods and services for which McDonald's has a reputation is also highly relevant in the production of the link or subsequent damage to the brand.

17. Given those factors, which were not contended on Appeal to be wrong, drawing the line for the purposes of a s5(3) objection is a question of 'feel' or individual judgment, and one on which reasonable people could be expected to disagree. I am thus very unwilling to overturn the Hearing Officer on where he drew the line unless the case was very clear indeed.

18. I should also note that at the outset of the Appeal I dealt with an application by McDonald's to admit fresh evidence which was said to support this Ground. It was a witness statement by a solicitor which exhibited further extracts from some online retailers' websites said to show a wider range of goods being sold with McDonald's branding. I rejected this application on the basis (i) that this was plainly evidence which could have been advanced before the Hearing Officer, (ii) the evidence was not particularly probative, since these were US websites and there was no evidence of actual sales, (iii) if I had admitted the evidence I would have had to remit the matter to the Hearing Officer for further consideration, which was plainly undesirable.

19. Ms Blyth divided the goods under this Ground into three categories for the purposes of argument.

20. First, she identified certain goods which were said to be so similar to those which had been excluded from registration that it was irrational not to include them. Examples included *'babies' pants and bibs'*. It is said that the HO excluded children's costumes and considered that clothes aimed at children may

normally be merchandised. I do not see that it follows that he was therefore also obliged to exclude babies' pants and bibs. Children's costumes are quite different things. They might include eg a clown outfit which would be natural associated with McDonalds. Babies are also not typical McDonald's customers whereas children certainly are.

21. Another instance was *'uniform'* and *'gloves'*. It was said to be irrational not to exclude these, having excluded *'protective clothing'*. Again I reject this. I think the Hearing Officer's reasoning was that Covid masks were known to be used as merchandising items, which is why he excluded the general class of protective clothing. I do not see that the same reasoning must apply to uniform and gloves.

22. It was also said that *'clothing of leather or imitations of leather'* were typical merchandisable items. I have no idea whether that is the case, but the Hearing Officer plainly did not consider that this was close enough to give rise to a link and I have no reason to second-guess this decision. The 'berets' and 'skull caps' arguments transferred from Ground 1 fall into the same category.

23. Second, she pointed to the possibility that McDonald's might sponsor a sporting event. This was said to be a reason to exclude *'cyclists clothing'*. Whilst this might have been an argument which could have been made before the Hearing Officer, it does not seem to have been made, and I do not think it can be raised now. It certainly does not follow from the Hearing Officer's findings that this class should be have been excluded. Putting advertising slogans on items including clothing at a sporting event is a quite distinct form of merchandising. It is not irrational to treat cyclists' and motoring clothing differently from (for example) t-shirts which are well known merchanised items.

24. Third, she asserted that any everyday item of clothing should be considered a merchandisable item. In this category were things like dresses, wellington boots and jackets. The Hearing Officer obviously did not view every item of clothing as one which the public would be likely to understand to be a merchandised item,

in the same way as they might a t-shirt or a baseball cap, and this does not seem to me to be an irrational position to take.

25. All in all, it is not normally within the proper scope of the Appellate process for the Appointed Person to impose his own view of the place to draw the line on difficult and nuanced questions of evaluation. An issue such as the precise types of goods which would be likely to be understood by the public as being likely to be merchandised by the Opponent, thus creating a link in their mind which was strong enough to create an unfair advantage, is a paradigm instance of such a question. Unless what the Hearing Officer has done is clearly irrational, then there will be no basis for the Appointed Person to intervene. I do not think that it was irrational to fail to exclude any of the categories identified in Ground 2. I therefore reject Ground 2 of the Appeal.

26. I would finally say that the few points on which I have upheld the Appeal under Ground 1 were all matters of clear inconsistency or simple mistakes which could have been corrected by the Hearing Officer himself if he had been given the opportunity. There is plainly scope for the Hearing Officer to issue a corrective Decision where obvious mistakes are pointed out. It would be absurd to require an Appeal to the Appointed Person to deal with such matters.

27. In cases where (as here) it is obvious that a simple mistake has been made or there is an obvious and clear inconsistency of the kind I have identified in this case, I would therefore strongly urge parties to notify the Hearing Officer in the first instance and invite him or her to correct the mistake or rectify the inconsistency. This applies even where there are other elements of the Decision which will be being appealed in any event.

28. Ms Blyth suggested that adopting this approach might result in delay beyond the period in which an Appeal needs to be brought. I appreciate this concern, but I would not expect there to be a difficulty provided the Hearing Officer was approached promptly. In any event, the Hearing Officer should be given the

opportunity to make the correction. If no response is received by the end of the Appeal period, obviously the matter will have to be raised on Appeal.

29. I am grateful to Ms Blyth for providing a draft Minute of Order giving effect to this Decision, which I will issue at the same time.

IAIN PURVIS KC

THE APPOINTED PERSON

21 JULY 2025 (original decision handed down orally on 16 July 2025)