

Macca's: I'm kinda loving it!

By [Gaelyn Scott](#)

24 Jan 2013

McDonald's recently announced that it would be rebranding a number of its Australian outlets as Macca's. Why? Well, because that's apparently how many Australians refer to the fast food chain - a survey shows that some 55% of Australians use the name Macca's instead of McDonald's.

Australians are, of course, particularly fond of nicknames and a company spokesman had this to say: "We've been a part of Australia for over 40 years now and we're incredibly proud to embrace our 'Australian only' nickname. What better way to show Aussies how proud we are to be a part of the Australian community than by changing our store signs to the name the community has given us?"

This is, it must be said, highly unusual stuff! Although we're sometimes told that it's the customer who owns the brand, this basically refers to the fact that a brand is little more than the opinion that the customer has of it. Letting the customer decide on the brand name is, well, another thing altogether! But are there any legal risks?

Legal issues to consider

There are certainly legal issues to consider in a case like this. As a brand owner, the one thing you don't want is any dilution of your brand, or any confusion about what exactly the brand name is. The reason for this is that you may find it difficult to enforce your rights if there is dilution, even if you do have a trade mark registration. You could, in fact, even lose your trade mark registration altogether if the trade mark is no longer able to perform its primary function, which is to differentiate your product from the products of your competitors. But none of that is going to happen in the case of McDonald's. That's because the renaming is seemingly being managed very carefully.

Although we don't yet know exactly how the Macca's branding will be done - for example, whether it will totally replace the McDonald's branding, or whether it will be used together with the McDonald's branding in the form of a sub-brand - what is clear is that this is simply a temporary arrangement. In fact, the renaming is intended to coincide with Australia Day, which takes place on 26 January, and it seems that it will last for just a few weeks. On top of that, there's a lot of publicity surrounding this temporary renaming, so the public's very clear that what's going on here is just this: the fast food giant is, in recognition of the fact that Australians refer to it as Macca's, allowing its Australian outlets to use that name for a few weeks.

There is, of course, no way that the owner of a truly global brand like McDonald's would allow a name change to take place in one country - the most that multinationals will allow is for translations or transliterations to be used in the Far East. And, even if Macca's does totally replace McDonald's for the few weeks, there's no chance of the Australian trade mark

registrations for McDonald's becoming vulnerable to attack for non-use - in Australia a trade mark registration can be cancelled if it is not used for a continuous period of three years or more (in South Africa the period is five years).

McDonald's may well decide to get Australian trade mark registrations for Macca's, although there is a suggestion in one news report that it may seek to have the name listed in the Macquarie Dictionary, which is the dictionary of Australian English - this would, in my view, be a strange thing to do, because brand names generally do not appear in dictionaries. In order to get a valid trade mark registration you must have a genuine intention to use the mark, and it seems to me that if you intend to use a mark for a few weeks you do have a genuine intention.

Open to attack after three years

Even if McDonald's can't get the mark registered before the name change actually happens, registration will, in my view, still be worthwhile because it's quite conceivable that someone may want to copy the name after the event, and thereby try to create some form of association with McDonald's. One problem that the company may have with trade mark registrations is that if the usage of Macca's is really just a one-off, the registrations for Macca's will be open to attack for non-use in just over three years.

Having a nickname foisted on you is unusual, but it's not unprecedented. Remember the Bafana Bafana trade mark fiasco! What happened there was that the nickname Bafana Bafana was coined by certain sports journalists who worked for *The Sowetan* newspaper. SAFA, however, disliked the name because it felt that it was derogatory, as it means "The Boys, The Boys". So SAFA ignored the name and hoped that it would just go away. But the name stuck and after a number of years SAFA simply had to acknowledge the fact. SAFA did this by applying to register Bafana Bafana as a trade mark in every conceivable product category. All of SAFA's trade mark applications were successful. All but the one that really mattered, that is - the one that covered those goods that lie at the very heart of sports merchandising: clothing. SAFA's clothing trade mark application failed for the simple reason that a clothing manufacturer called Stanton Woodrush had already registered the nickname for those goods. So SAFA sued the clothing company, but it lost: the Supreme Court of Appeal said that it was a case of "first come, first served", and it made the point that as SAFA had never used the trade mark for clothing, and as it hadn't even devised the name, SAFA had no greater claim to the name than Stanton Woodrush had. SAFA was eventually forced to do a deal with Stanton Woodrush.

The Macca's renaming will, I'm quite sure, go much more smoothly.

ABOUT THE AUTHOR

Gaelyn Scott is director in and head of ENS' IP Department.

For more, visit: <https://www.bizcommunity.com>