

McCurry – Fighting That Spice, Come What McMAY

By Lim Eng Leong

From Malaysia to the rest of the world, McDonald's has long and zealously guarded its famous "Mc-" trademarks, and few countries have seen as many colourful battles as Malaysia. Nearly every foodie or restauranteur here remembers "*that McCurry case*". Although more than 24 years have passed since McDonald's sued McCurry Restaurant (KL) in 2001 under the tort of passing off, and 16 years since Malaysia's appellate courts delivered the landmark 2009 decision, the saga continues to spice up Malaysian trademark law.

Little did most know that around the same period, McDonald's was facing another curry-themed challenger.

In 2003, B. Awtar Singh s/o Balwant Singh, trading as *Mc Spicy Curry House*, applied to register "**MC CURRY**" (Application No. 03005153) in Class 29 for food-related products. The Registrar of Trademarks initially allowed the registration in 2007 with an interesting disclaimer on the letters "MC". Despite this limitation, McDonald's filed a trademark opposition, arguing that the prefix "MC" was part of its globally recognised **Mc Family of Marks**, used across 100+ countries. Allowing "MC CURRY", it said, would dilute the distinctiveness and potentially mislead consumers.

The applicant countered that its goods like anchovy, butter, jam, oils, canned foods and other retail groceries targeted a different segment than fast food restaurants, and therefore were unlikely to cause confusion.

What followed was one of Malaysia's longest-pending IP matters. After nearly 20 years, the Registrar finally issued a decision in February 2025 rejecting the opposition and allowing Mc Spicy Curry House's registration. McDonald's, unsurprisingly, appealed to the High Court.

The High Court's 2025 Decision: A Surprising Turn in Favour of McDonald's

In October 2025, the High Court delivered a judgment that tipped the scales back towards the Golden Arches.

Judicial Commissioner Dato' Edwin Paramjothy Michael Muniandy held that the Registrar had applied the wrong legal test by focusing narrowly on whether the goods were generally similar. Instead, under **Sections 14 and 19 of the Trademarks Act 1976**, the correct question was whether the mark was **likely to cause confusion or deception** among the Malaysian public.

The court ruled that "MC CURRY" could mislead consumers into assuming an association with McDonald's and ordered the registration revoked.

McDonald's had sought RM30,000 in legal costs but was awarded RM10,000 (approximately USD 2,500).

Why Did McCurry Win in 2009, but McDonald's Win in 2025?

Many have asked: *If McCurry Restaurant survived against McDonald's in 2009, why didn't Mc Spicy Curry House succeed too?*

The answer lies in two key differences:

1. Passing Off (2009) vs. Trademark Registration (2025)

- **2009:** The dispute involved *passing off*, where McDonald's had to prove actual misrepresentation by McCurry Restaurant. The court found no such misrepresentation.
- **2025:** This case involved **trademark registration**, governed by statutory law. The test focuses on **likelihood of confusion**, a broader and more protective threshold.

2. Scope of Use

McCurry Restaurant's use in 2009 was tied to a restaurant name. Mc Spicy Curry House's attempted registration in 2025 covered a **wide range of retail groceries** expanding its potential reach and raising the risk of consumer confusion.

Importantly, the 2009 decision never guaranteed that future "Mc-something" marks would automatically be accepted for registration. The 2025 ruling reinforces that **well-known marks still enjoy stronger statutory protection**, especially when registration rather than mere use is concerned.

Implications for Brand Owners in Malaysia

For Global Brands (like McDonald's)

The ruling strengthens the protection of well-known prefixes and families of marks in Malaysia. Long-standing global reputation can justify broader safeguards, even against businesses in different product classes.

For Local Businesses and SMEs

The case serves as a cautionary tale. Using a familiar prefix, even innocently or descriptively, may still attract refusal if it resembles a well-known global brand. Malaysia's trademark law continues to take consumer perception seriously.

For Trademark Practitioners

This decision highlights the importance of:

- Distinguishing between passing off and statutory trademark tests
- Understanding how disclaimers affect (or do not affect) the assessment
- Carefully evaluating prefixes and brand families when advising clients

A Pivotal Moment in Malaysia's Trademark Jurisprudence

After years of mixed signals and casual mimicry of famous prefixes, the High Court's decision to overturn "MC CURRY" marks a meaningful shift. It reaffirms the importance of **trademark distinctiveness**, consumer clarity, and the statutory protection afforded to well-known marks.

For McDonald's, it restores a degree of control over its "Mc" identity within Malaysia. For Malaysian entrepreneurs, it is a reminder that branding strategies in a globalised marketplace must be crafted with legal awareness because sometimes, even a single prefix can be the difference between spicy success and a legal headache.