



## Success for Jägermeister as General Court confirms likelihood of confusion between stag's head marks

Cristina Bercial-Chaumier and Karina Dimidjian-Lecomte

CASALONGA

20 October 2022



### EUROPEAN UNION

Legal updates: case law analysis and intelligence

- The Board of Appeal found a likelihood of confusion between a mark consisting of the term 'Les Bordes' and the image of a stag's head, and a figurative mark containing a stag's head
- The court agreed that the representations of the stags' heads clearly dominated both signs
- The Board of Appeal had rightly concluded that the marks could not be compared phonetically

On 5 October 2022 the General Court (Sixth Chamber) issued its decision in [Les Bordes Golf International v European Union Intellectual Property Office](#) (EUIPO) (Case T-696/21).

### Background

On 17 July 2019 the applicant, Les Bordes Golf International, filed an application for registration of an EUTM for the figurative sign depicted below in Classes 3, 14, 16, 18, 24, 25, 41 and 43:



On 19 September 2019 the intervener, Mast-Jägermeister SE, filed an opposition pursuant to Article 8(1)(b) of Regulation 2017/1001 based on, among other rights, International Registration No 1311081 designating the European Union covering goods and services in Classes 3, 14, 16, 18, 24, 25, 41 and 43:



The opposition was rejected in its entirety, and the intervener appealed.

The Board of Appeal of the EUIPO upheld the appeal in its entirety on the basis of the earlier international registration. It considered that there was a likelihood of confusion due to:

- the identity and similarity of the goods and services;
- the average degree of visual and conceptual similarities between the signs; and
- the fact that the inherent distinctiveness of the international registration as a whole had to be regarded as average.

The applicant filed an appeal before the General Court, relying on a single plea alleging infringement of Article 8(1)(b) of the regulation.

### General Court decision

With regard to the applicant's argument that the word element 'les bordes' was dominant because it was more distinctive, the court noted that, according to settled case law, where a mark consists of word elements and figurative elements, the former are, in principle, more distinctive than the latter, because the average consumer will more readily refer to the goods in question by quoting the name of the trademark than by describing the figurative element of that mark. The same case law nevertheless states that it does not follow that the word elements of a trademark must always be regarded as more distinctive than the figurative elements. In the case of a composite mark, the figurative element may, due in particular to its shape, size, colour or position in the sign, rank equally with the word element (see, to that effect, [Codorniu Napa v OHIM](#) (Case T-35/08), Paragraphs 37 and 39 and the case law cited). Therefore, the court held that the Board of Appeal was right to point out that "the representations of the stags' heads clearly dominate both signs on account of their size and eye-catching appearance".

In respect of the phonetic comparison, the applicant submitted that the Board of Appeal had erred in finding that a phonetic comparison of the signs was not possible. Indeed, whereas consumers would refer to the contested mark as LES BORDES, they would refer to the earlier mark by using, in their mother tongue, the word 'stag'. The court noted that the purely figurative mark, in addition to the fact that it could be uttered by the word 'stag' as well as the word 'reindeer', contained other elements - namely a cross, a double circle and black lines - so that it may be uttered in different ways. It was therefore impossible to attribute to it a specific and concrete word. The court thus found that the Board of Appeal had rightly concluded that the marks could not be compared phonetically.

Further, the court confirmed that the signs were conceptually similar to an average degree as they shared the identical concept of a stag's head, finding that the term 'Les Bordes' would not influence the conceptual similarity between the signs as it would be meaningless for the majority of the relevant consumers.

Finally, with respect to the distinctiveness of the earlier mark as a whole, the court confirmed that it had to be regarded as average.

For the above reasons, the court concluded that there was a likelihood of confusion pursuant to Article 8(1)(b) and dismissed the appeal.

### Comment

This decision is somewhat surprising in terms of the comparison of the signs, in particular the treatment of the word element in the opposed application. However, it is in line with the recent decision in [Case T-416/21](#), which held, in the context of an Article 8(5) opposition, that the following marks were conceptually identical:



Whether these decisions signal a new direction in the case law - granting broader protection to animal representations regardless of the graphic differences - remains to be seen.

---

## Cristina Bercial-Chaumier

Author | Partner

[c.bercial@casalonga.com](mailto:c.bercial@casalonga.com)

CASALONGA

---

## Karina Dimidjian-Lecomte

Author | Partner

[k.dimidjian@casalonga.com](mailto:k.dimidjian@casalonga.com)

CASALONGA

Copyright © Law Business Research Company Number: 03281866 VAT: GB 160 7529 10