

DECISION
of the Fourth Board of Appeal
of 1 September 2021

In case R 67/2021-4

Mast-Jägermeister SE

Jägermeisterstraße 7-15

38296 Wolfenbüttel

Germany

Opponent / Appellant

represented by Gramm, Lins & Partner Patent- und Rechtsanwälte PartGmbH,
Theodor-Heuss-Straße 1, 38122 Braunschweig, Germany

v

Les Bordes Golf International

Les Bordes

41220 Saint Laurent Nouan

France

Applicant / Defendant

represented by Casadei-Jung, 10 boulevard Alexandre Martin, 45000 Orleans, France

APPEAL relating to Opposition Proceedings No B 3 094 876 (European Union trade
mark application No 18 082 876)

THE FOURTH BOARD OF APPEAL

composed of D. Schennen (Chairman), C. Bartos (Rapporteur) and E. Fink (Member)

Registrar: H. Dijkema

gives the following

Decision

Summary of the facts

- 1 By an application filed on 17 June 2019, Les Bordes Golf International ('the defendant') sought to register the sign



for the following list of goods and services:

Class 3 - Perfumery and fragrances; Cleaning and fragrancing preparations; Toiletries;

Class 14 - Key rings and key chains, and charms therefor;

Class 16 - Printed matter; Paper and cardboard; Stationery and educational supplies; Bags and articles for packaging, wrapping and storage of paper, cardboard or plastics;

Class 18 - Luggage, bags, wallets and other carriers; Walking sticks; Umbrellas and parasols; Card holders made of leather; Card holders made of imitation leather; Document cases of leather; Golf umbrellas; Umbrellas; Parasols;

Class 24 - Textile goods, and substitutes for textile goods; Linens; Household textile articles; Plastic banners; Streamers of textile; Banners of textile or plastic; Banners of textile; Flags and pennants of textile; Nylon flags; Flags of textile or plastic; Plastic flags; Handkerchiefs of textile; Textile tissues; Wash cloths;

Class 25 - Headgear; Footwear; Clothing; Hosiery; Gloves [clothing]; Sports jerseys; Golf pants, shirts and skirts; Golf trousers; Dressing gowns; Golf shorts; Tee-shirts; Golf clothing, other than gloves;

Class 41 - Organisation of conferences, exhibitions and competitions; Rental services relating to equipment and facilities for education, entertainment, sports and culture; Education and instruction services; Hosting [organising] awards; Entertainment, sporting and cultural activities; Administration [organisation] of entertainment services; Entertainment in the nature of golf tournaments;

Class 43 - Rental of furniture, linens, table settings, and equipment for the provision of food and drink; Temporary accommodation; Providing temporary accommodation; Restaurant services; Provision of food and drink.

- 2 On 19 September 2019, Mast-Jägermeister SE ('the appellant') filed an opposition against the application for all the above goods and services based on Article 8(1)(b) EUTMR and the following earlier trade marks:

- a) European Union trade mark ('EUTM') No 15 185 424



registered on 28 June 2016 for, amongst others, goods in Class 25.

b) International registration ('IR') No 1 311 081 designating the European Union



registered on 17 November 2015 for, amongst others, the following goods and services:

Class 3 - Toiletries; animal grooming preparations; essential oils and aromatic extracts; abraders; cleaning and fragrancng preparations; tailors' and cobblers' wax;

Class 14 - Gemstones, pearls and precious metals, and imitations thereof; jewellery; time instruments; other articles of precious metals and precious stones, and imitations thereof namely statues and figurines, made of or coated with precious or semi-precious metals or stones, or imitations thereof, ornaments, made of or coated with precious or semi-precious metals or stones, or imitations thereof, coins and tokens, works of art of precious metal, key rings (trinkets or fobs); jewellery boxes and watch boxes; parts and fittings of all the aforesaid goods, included in this class;

Class 16 - Works of art and figurines of paper and cardboard, and architects' models; decoration and art materials and media; filtering materials of paper; bags and articles for packaging, wrapping and storage of paper, cardboard or plastics; stationery and educational supplies; adhesives for stationery or household purposes; money holders; disposable paper products; printed matter; paper and cardboard; parts and fittings of all the aforesaid goods, included in this class;

Class 18 - Sausage skins and imitations thereof; umbrellas and parasols; walking sticks; luggage, bags, wallets and other carriers; leather and imitation leather, pelts and hides; saddlery, whips and animal apparel; parts and fittings of all the aforesaid goods, included in this class;

Class 24 - Fabrics; textile goods, and substitutes for textile goods; filtering materials of textiles;

Class 25 - Headgear; clothing; footwear; parts and fittings of all the aforesaid goods, included in this class;

Class 41 - Publishing and reporting; education, entertainment and sports; translation and interpretation; rental, hire and leasing in connection with the aforesaid, included in this class; advice, consultancy and information for the aforesaid, included in this class;

Class 43 - Temporary accommodation; animal boarding; rental of furniture, linens and table settings; provision of food and drink; rental, hire and leasing in connection with the aforesaid, included in this class; advice, consultancy and information for the aforesaid, included in this class.

c) German trade mark No 302 015 043 892



registered on 30 July 2015 for, amongst others, goods and services in Classes 3, 14, 16, 18, 24, 25, 41 and 43.

- 3 By decision of 17 November 2020 ('the contested decision'), the Opposition Division rejected the opposition in its entirety and ordered the appellant to bear the costs.
- 4 The Opposition Division proceeded as if all the contested goods and services were identical to those of the earlier marks which, for the appellant, was the best light in which the opposition could be examined. The goods and services assumed to be identical were directed at the public at large and at business customers with specific professional knowledge or expertise displaying an average to high level of attention.
- 5 The relevant territory was Germany (for earlier German trade mark No 302 015 043 892) and the European Union (for earlier EUTM No 15 185 424 and IR No 1 311 081). The relevant public would not recognise the words 'LES BORDES' as indicating a geographical origin since 'LES BORDES' was the name of a small community of less than 1 900 inhabitants in north central France but it was not the municipality where the defendant was located and it was not known for the manufacturing or providing of any of the contested goods or services. Although a very small part of the relevant public might perceive those words as referring to the name of the site where the defendant was located, this was a negligible part of the public. The verbal elements 'LES BORDES' were meaningless and distinctive to an average degree.
- 6 The silhouette of a stag's head in the contested sign was not related to the relevant goods and services and was distinctive to an average degree. The image of the stag's head, depicted almost identically in all the earlier marks, was also distinctive to an average degree. The additional figurative elements in earlier IR No 1 311 081 and German trade mark No 302 015 043 892, namely the circles with black lines emanating from a cross depicted in the middle of the stag's antlers, were not related to the relevant goods or services and were distinctive to an average degree.
- 7 Both signs contained the image of a stag's head but differed in the way these images were depicted; in the earlier marks, the stag was represented in a realistic way and all the details of its face, such as eyes, nose and mouth were clearly visible, while the contested sign was a black sketch of a stag's head silhouette where no such details could be perceived. The signs further differed in the verbal elements 'LES BORDES' of the contested sign and in the additional figurative elements of earlier IR No 1 311 081 and German trade mark No 302 015 043 892. The signs were visually similar to a low degree. As the earlier marks were purely figurative, the signs could not be compared aurally. Conceptually, both signs represented the image of a stag's head. Earlier IR No 1 311 081 and German trade mark No 302 015 043 892 also consisted of additional figurative elements, adding some concepts to them and the contested sign also consisted of the distinctive

verbal elements 'LES BORDES'. They were at best conceptually similar to an average degree.

- 8 The evidence of enhanced distinctiveness of the earlier trade marks was related to the field of spirits and alcoholic beverages, on which the opposition was not based. The appellant did not expressly claim enhanced distinctiveness for any of the goods and services on which the opposition was based and no evidence related to these goods and services was submitted. The inherent distinctiveness of the earlier marks was normal.
- 9 The signs at issue were similar only insofar as their figurative elements depicted an animal of the same species. They differed in all other aspects, including the additional verbal elements 'LES BORDES' of the contested sign. The differences between the representations of the figurative elements of the signs together with the additional verbal elements of the contested sign sufficed for consumers, even those displaying an average degree of attention, to safely distinguish between the signs and to exclude a likelihood of confusion.

Submissions and arguments of the parties

- 10 The appellant filed a notice of appeal against the contested decision, duly followed by a statement of grounds. It requests that the Board uphold the appeal and annul the contested decision.
- 11 Based on earlier EUTM No 15 185 424, it argues that all the contested goods in Classes 3, 14 and 18, e.g. perfumeries, key rings and key chains and charms therefor as well as bags and wallets, are often branded with the same trade mark as clothing and they have the same distribution channels, producers and relevant public, namely any people interested in fashion and a well-groomed appearance. The goods in Classes 3, 14, 16, 18, 24 and 25 are everyday goods that are often bought in passing. Consumers only pay an average level of attention to them.
- 12 Both the sign applied for as well as the signs for which the earlier trade marks enjoy protection, contain the image of a stag's head in black and white, shown directly from the front, with antlers and neck, both heads being fully symmetrical and having identical proportions. The verbal elements of the contested sign do not alter the similarity between the marks as a whole. They do not play a dominant role and the representation of a stag in the contested sign cannot be considered to be negligible in the overall impression created by that mark. The French public is probably familiar with the municipality Les Bordes in France in the Centre-Val of the Loire region. They will understand the verbal elements as an appellation of geographical origin and a non-distinctive element of the contested sign. The signs are visually similar at least to an average degree.
- 13 Based on the identity or similarity between the goods and services and the visual and conceptual similarity between the signs, there exists a likelihood of confusion under Article 8(1)(b) EUTMR.

- 14 Based on earlier IR No 1 311 081 and German trade mark No 302 015 043 892, the contested goods and services are identical. The relevant public has an average level of attention. The circle and the cross between the stag's antlers are of little importance since these are details which will not play a decisive role in the recollection of the earlier trade marks by consumers. Moreover, German consumers who buy or use alcoholic beverages are familiar with the image of the stag's head, even when presented with the circle and the cross. The signs are visually and conceptually similar.
- 15 The German surveys, partially submitted on appeal, confirm that the German public is familiar with the stag's head, which proves that the distinctive character of the earlier trade marks is far above average. Considering the identity between the goods and services, the earlier trade marks' high degree of distinctiveness, the relevant public's average level of attention and the similarity in the representations of the stags' heads, there is a likelihood of confusion under Article 8(1)(b) EUTMR.
- 16 The defendant did not submit any observations in reply.

Reasons

- 17 The appeal is admissible and well founded.
- 18 There is a likelihood of confusion. The opposition succeeds in its entirety based on Article 8(1)(b) EUTMR and earlier IR No 1 311 081 designating the European Union.
- 19 Pursuant to Article 8(1)(b) EUTMR, upon opposition of the proprietor of an earlier trade mark, the trade mark applied for shall not be registered if, because of its identity with, or similarity to, the earlier trade mark and the identity or similarity between the goods or services covered by the trade marks, there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected.
- 20 Unlike the Opposition Division, the Board will first examine the opposition based on earlier IR No 1 311 081 designating the European Union, see paragraph 2 under b) above, which enjoys the broadest protection compared to the other earlier trade marks.
 - a) *Relevant public and level of attention*
- 21 The relevant territory for analysing the likelihood of confusion concerns the European Union as a whole and all its Member States.
- 22 The relevant public for the identical or similar goods and services, as compared below, includes mainly the public at large. Part of the goods and service in Classes 3, 16, 41 and 43 may also address specialists and a professional public. The level of attention of the relevant public may vary from average to high.

b) Comparison of the goods and services

- 23 Goods or services are identical when they appear with the same wording in the lists of goods or services compared or when they are included in a more general category designated by the other mark (13/09/2018, T-94/17, Tigha, EU:T:2018:539, § 46).
- 24 In assessing the similarity between the goods or services in question, all the relevant features of the relationship between those goods or services should be taken into account. Those factors include, inter alia, their nature, their intended purpose, their method of use, their end-users and whether they are in competition with each other or are complementary (29/09/1998, C-39/97, Canon, EU:C:1998:442, § 23). Other factors may also be taken into account such as, for example, the distribution channels of the goods and services concerned (11/07/2007, T-443/05, Pirañam, EU:T:2007:219, § 37). The reference point is whether the relevant public would perceive the relevant goods and services as having a common commercial origin (04/11/2003, T-85/02, Castillo, EU:T:2003:288, § 38).
- 25 Complementary goods or services are those between which there is a close connection, in the sense that one is indispensable or important for the use of the other with the result that consumers may think that the same undertaking is responsible for manufacturing those goods or for providing those services (24/04/2018, T-831/16, Zoom, EU:T:2018:218, § 69).

Class 3

- 26 The contested ‘cleaning and fragrancings preparations’ and ‘toiletries’ are included in both lists of goods. The remaining contested ‘perfumery and fragrances’ are included in the earlier ‘toiletries’, which include a variety of preparations for washing or taking care of one’s body (*Collins Dictionary*). Perfumery and fragrances are beauty and personal hygiene products. These products are generally used to take care of the human body and to embellish it by giving it a pleasant smell or appearance. Nowadays, it is even common for these products to have several inseparable functions, relating at the same time to hygiene, aesthetics and tactile or olfactory pleasure (16/11/2006, T-278/04, Yuki, EU:T:2006:351, § 56). Insofar as the term ‘toiletries’ is indeed very broad, the contested goods can be considered to fall under this category. It follows that all the contested goods are identical.

Class 14

- 27 The contested ‘key rings and key chains, and charms therefor’ overlap with the earlier ‘key rings (trinkets or fobs); parts and fittings of all the aforesaid goods, included in this class’. Key chains and charms are certainly parts and fittings of key rings. They are also identical.

Class 16

- 28 The contested ‘printed matter; paper and cardboard; stationery and educational supplies; bags and articles for packaging, wrapping and storage of paper, cardboard or plastics’ are identically included in both lists of goods.

Class 18

- 29 The contested ‘luggage, bags, wallets and other carriers; walking sticks; umbrellas and parasols; umbrellas; parasols’ are identically included in both lists of goods. The contested ‘golf umbrellas’ are included in the earlier broader term ‘umbrellas’, whereas ‘card holders made of leather; card holders made of imitation leather; document cases of leather’ are included in the earlier ‘other carriers’ and are also identical.

Class 24

- 30 The contested ‘textile goods, and substitutes for textile goods’ are identically included in both lists of goods. The remaining contested ‘linens; household textile articles; plastic banners; streamers of textile; banners of textile or plastic; banners of textile; flags and pennants of textile; nylon flags; flags of textile or plastic; plastic flags; handkerchiefs of textile; textile tissues; wash cloths’ are included in the earlier broader category ‘textile goods, and substitutes for textile goods’. Therefore, they are identical.

Class 25

- 31 The contested ‘headgear; footwear; clothing’ are identically included in both lists of goods. The remaining contested ‘hosiery; gloves [clothing]; sports jerseys; golf pants, shirts and skirts; golf trousers; dressing gowns; golf shorts; tee-shirts; golf clothing, other than gloves’ are included in the earlier ‘clothing’. They are identical.

Class 41

- 32 The contested ‘education and instruction services; entertainment, sporting activities; administration [organisation] of entertainment services; entertainment in the nature of golf tournaments; rental services relating to equipment and facilities for education, entertainment, sports’ overlap with the earlier ‘education, entertainment and sports; rental, hire and leasing in connection with the aforesaid, included in this class; advice, consultancy and information for the aforesaid, included in this class’. They are identical.
- 33 The contested ‘cultural activities; rental services relating to equipment and facilities for culture; organisation of conferences, exhibitions and competitions’ are at least similar to an average degree to the earlier ‘education’ as they may have similar educational purposes. Apart from having the same relevant public, they may be provided by the same educational institutions and be complementary to each other.

- 34 Likewise, the contested ‘hosting [organising] awards’ are similar to an average degree to the earlier ‘education’ and ‘entertainment’. They may have the same educational or entertainment purposes, target the same relevant public and be provided by the same educational or entertainment services providers.

Class 43

- 35 All the contested services in this class, namely ‘rental of furniture, linens, table settings, and equipment for the provision of food and drink; temporary accommodation; providing temporary accommodation; restaurant services; provision of food and drink’ are included in, or overlap with, the earlier ‘temporary accommodation; rental of furniture, linens and table settings; provision of food and drink; rental, hire and leasing in connection with the aforesaid, included in this class; advice, consultancy and information for the aforesaid, included in this class’. They are identical.

c) Comparison of the signs

- 36 The comparison of the conflicting marks shall assess the visual, aural or conceptual similarity of the marks in question, based on the overall impression given by the marks and bearing in mind, in particular, their distinctive and dominant elements (06/10/2005, C-120/04, Thomson Life, EU:C:2005:594, § 28).

- 37 The earlier sign consists of a figurative element representing a stag’s head in black and white, facing forward, surrounded by a circle with black lines emanating from a cross placed between the stag’s antlers.



Earlier sign

- 38 The contested sign consists of a figurative element representing a stag’s head in black and white facing forward and the underlined verbal elements ‘LES BORDES’ written at the bottom in black capital letters.



Contested sign

- 39 Visually, the conflicting signs display a black-and-white representation of the same animal and the same part of it: a stag’s head with antlers and part of the neck facing forward. In both signs the proportions between the elements of the stag’s head, namely head, ears, mouth, antlers and neck, are almost identical. In the earlier sign the stag’s head is surrounded by a circle, a small cross and black lines which rather serve as a background and play a decorative role. There is no evidence on file that the verbal elements ‘LES BORDES’ of the contested sign indicate a geographical origin for the French or any other part of the European Union public, nor are they related to the figurative elements. These verbal elements are distinctive for the relevant European Union public.
- 40 The representations of the stags’ heads clearly dominate both signs on account of their size and eye-catching appearance. This finding is not called in question by the more naturalistic style of the earlier sign, in which more details of the animal’s image can be seen. These constitute elements of secondary importance which the average customer is not likely to identify or remember (25/02/2016,

T-692/14, Device of an unidentifiable animal leaping to the right / Device of an unidentifiable animal leaping to the left, EU:T:2016:99, § 33; 30/01/2018, T-113/16, Device of a panther / Device of a panther, EU:T:2018:43, § 38). The additional figurative elements of the earlier sign and the underlined verbal elements of the contested sign are not in themselves sufficient to eliminate the visual similarities between the signs either.

- 41 Unlike the Opposition Division, the Board finds that the conflicting signs are visually similar to an average degree.
- 42 Since the earlier sign is purely figurative, it will not be pronounced. An aural comparison is not possible (07/02/2012, T-424/10, Eléphants dans un rectangle, EU:T:2012:58, § 46).
- 43 Conceptually, the idea underlying the figurative elements of both signs can be summarised as that of a stag's head with antlers and part of the neck facing forward. The additional, less distinctive, figurative elements of the earlier sign and the word elements 'LES BORDES' of the contested sign do not alter this perception. The signs are conceptually similar to an average degree.

d) Distinctive character of the earlier trade mark

- 44 The inherent distinctive character of the earlier trade mark as a whole must be considered to be normal given that it is neither descriptive nor evocative as regards the relevant goods and services.
- 45 The appellant claimed that the figurative elements of the earlier trade mark enjoy enhanced recognition and distinctive character, in Germany and the European Union, and submitted rankings, market surveys and sales volumes in relation to alcoholic beverages. Insofar as all these materials, including the market survey filed on appeal and therefore belated, concern the German public's awareness of the stag's head in relation to alcoholic beverages, which are irrelevant for the case at hand, the enhanced degree of distinctive character of the earlier trade mark for the relevant goods and services, either in Germany or elsewhere, has not been proven.

e) Global assessment of the likelihood of confusion

- 46 A likelihood of confusion on the part of the public must be assessed globally. That global assessment implies some interdependence between the factors taken into account and in particular similarity between the marks and between the goods or services covered. Accordingly, a lesser degree of similarity between these goods or services may be offset by a greater degree of similarity between the marks, and vice versa (22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 19; 29/09/1998, C-39/97, Canon, EU:C:1998:442, § 17). The more distinctive the earlier mark, the greater the risk of confusion, and marks with a highly distinctive character, either per se or because of the reputation they

possess on the market, enjoy broader protection than marks with a less distinctive character (29/09/1998, C-39/97, Canon, EU:C:1998:442, § 18).

- 47 For the purpose of that global appreciation, the average consumer of the category of goods concerned is deemed to be reasonably well-informed and reasonably observant and circumspect. The level of attention of the relevant consumer is likely to vary according to the category of goods or services in question and the average consumer only rarely has the chance to make a direct comparison between the different marks but must place his or her trust in the imperfect picture of them that he or she has kept in mind (30/06/2004, T-186/02, Dieselit, EU:T:2004:197, § 38; 22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 26). Even a more attentive public only retains an imperfect image of the trade marks (06/12/2018, T-665/17, CCB, EU:T:2018:879, § 35, 68).
- 48 Given that the average consumer retains only an imperfect image of the mark in his or her mind, it cannot be considered that he or she would be able to recall all figurative details of the signs in question, such as the more or less realistic style of the stag's head or the circular background in which the animal's head in the earlier sign is placed. Both signs contain the partial image of the same animal (a stag) and the same part of that animal is shown, namely the stag's head together with the antlers and the neck facing forward. The visual differences between the signs are further offset by the identity between most of the goods and services concerned, the partial similarity between the services in Class 41, and by the average level of visual and conceptual similarities between the signs (14/12/2006, T-81/03, T-82/03 & T-103/03, Venado, EU:T:2006:397, § 103, 108, 111).
- 49 It follows that the identity or similarity between the goods and services, the average degree of visual and conceptual similarities between the signs and the normal level of inherent distinctiveness of the earlier trade mark are sufficient to result in a likelihood of confusion under Article 8(1)(b) EUTMR, even taking into account the consumer's higher level of attention for part of the relevant goods and services.
- 50 Given that the opposition succeeds in its entirety based on earlier IR No 1 311 081 designating the European Union, there is no need to examine the opposition in respect of the other earlier rights invoked.

Costs

- 51 Pursuant to Article 109(1) EUTMR, the defendant, as the losing party, must bear the costs of the opposition and appeal proceedings.
- 52 Pursuant to Article 18(1)(c)(i) and (iii) EUTMIR, the Board fixes the amount of representation costs to be paid by the defendant to the appellant with respect to the appeal proceedings at EUR 550 and with respect to the opposition proceedings at EUR 300. In addition, the defendant has to bear the opposition fee of EUR 320 and the appeal fee of EUR 720. The total amount is EUR 1 890.

Order

On those grounds,

THE BOARD

hereby:

- 1. Annuls the contested decision;**
- 2. Upholds the opposition and rejects EUTM No 18 082 876 for all the contested goods and services;**
- 3. Orders the defendant to bear the costs of the opposition and appeal proceedings which are fixed at EUR 1 890.**

Signed

D. Schennen

Signed

C. Bartos

Signed

E. Fink

Registrar:

Signed

p.o. P. Nafz

