

**DECISION  
of the First Board of Appeal  
of 20 June 2023**

In Case R 1952/2022-1

**Mast-Jägermeister SE**

Jägermeisterstr. 7-15  
38296 Wolfenbüttel  
Germany

Opponent/Appellant

represented by Gramm, Lins dish Partner Patent-und Rechtsanwälte PartGmbB, Frankfurter  
Straße 3c, 38122 Braunschweig, Germany

v

**Tin Kakuszi**

Rét u.49  
6200 Kiskovrös  
Hungary

Applicant/Respondent

represented by Antal Török, Verseny u. 5, 9023 Gynamr, Hungary

Appeal relating to Opposition Proceedings No B 3 145 834 (European Union trade mark-  
application No 18 404 272)

**THE FIRST BOARD OF APPEAL**

composed of G. Humphreys (Chairperson), E. Fink (Rapporteur) and C. Bartos (Member)

Registrar: H. Dijkema

gives the following

## Decision

### Established Facts

1. By an application filed on 21 February 2021, Zsolt Kakuszi ('the applicant') sought to register the coloured figurative mark



as a European Union trade mark in respect of the following goods:

Class 33: *Bitters [liqueurs]*.

2. On 3 May 2021, Mast-Jägermeister SE ('the opponent') filed a notice of opposition to the registration of the trade mark applied for. It based its opposition on Article 8 (1) (b) EUTMR and Article 8(5) EUTMR and earlier international registration with protection in EU No 1 287 791 for the coloured figurative mark



applied for and registered on 17 November 2015 in respect of the following goods:

Class 33: *Alcoholic beverages, except beers, in particular herbal spirits; pre-mixed alcoholic beverages.*

3. Together with its grounds of opposition, the opponent submitted several UEs as proof of the reputation claimed (Annexes 1-8).
4. By decision of 3 August 2022 ('the contested decision'), the Opposition Division rejected the opposition in its entirety and ordered the opponent to bear the costs.
5. The Opposition Division found the signs under comparison to be dissimilar, so neither the conditions of Article 8(1)(b) EUTMR nor Article 8(5) EUTMR had been met:

- The opposing signs were visually dissimilar, as they produced an entirely similar overall impression. The signs under comparison were complex signs composed of numerous different elements which displayed only immaterial similarities, such as for example the colour, framing or the green background, which, however, represented differently. In view of the significant differences, the aforementioned consciousness was not sufficient for the assumption of a similarity between the signs. The mere fact that both Zei were bottle labels of approximately a similar shape did not substantiate any relevant visual similarity, as this shape was customary in connection with alcoholic gears.
- As all the word components differed from one another, the signs were also aurally dissimilar.
- Consumers in the EU immediately and easily grasp the figurative representation of the stag's head in the earlier sign and the figurative representation of the human head in the contested sign, each of which has a different meaning. The conceptual differences were even clearer for those consumers who would understand the word elements of the signs, e.g. the German-speaking verb.
- Similarity between the signs was a necessary prerequisite for the applicability of Article 8(1)(b) and Article 8(5) EUTMR and could not be offset by the claimed reputation of the earlier trade mark.

### **Submissions and arguments of the parties**

6. The opponent filed a notice of appeal on 5 October 2022 and requested that the contested decision be annulled, the trade mark applied for be refused and the applicant ordered to bear the costs.
7. Summary of the facts 6. By letter of 13 December 2022, the opponent claimed that the signs under comparison displayed at least a certain degree of similarity in terms of their overall impression. In view of the other relevant factors, in particular the identity of the goods and the reputation of the earlier trade mark, this degree of similarity was sufficient to affirm the applicability of Article 8(5) EUTMR and Article 8(1)(b) EUTMR:
  - The contested sign consisted of two parts. The right part contained a barcode and details of the content of the product and of the manufacturer. The entire rear part did not perform any characterising function, which meant that it could be disregarded in the comparison of the signs.
  - The signs under comparison had a considerable degree of similarity. Both signs had a rectangular shape and used the colours green, orange, gold and white. They shared the following dominant elements: I) orange coloured banderole in the middle, (ii) green border, (iii) medallion representation above the banderole, (iv) medallion inside green with a gold border, (v) the head depicted from front, with rays arranged around it and (vi) gold coloured floral elements. The more recent trade mark was quite clearly a 'Look-Alike' of the earlier trade mark.
  - Even a small degree of similarity between the signs could be sufficient for a mental association within the meaning of Article 8(5) EUTMR.
  - The earlier trade mark had been used for around 85 years for one of the most successful spirits in the world. It had an outstanding reputation in the EU, but at least in Germany.

- The level of attention of the targeted consumers was low, as they were relatively low-priced everyday products.
  - On account of the overall visual impression, the contested trade mark was capable of calling the earlier trade mark to the mind of the relevant public. There was also a risk of unfair advantage being taken of the distinctive character and repute of the earlier trade mark. The applicant deliberately used the design of his trade mark on the basis of that of the earlier trade mark in order to retain the reputation of the earlier trade mark and thereby promote sales of its products.
  - On account of the identity of the goods and the high degree of distinctive character of the earlier trade mark, as well as the below-average level of attention of the trade circles targeted, there was also a likelihood of confusion despite the low degree of similarity between the signs.
8. The opponent submitted an updated version of Annex 4 (Annex 4a).
  9. By written submission of 3 February 2023, the applicant submitted observations and requested that the Bebe refused.
  10. The Opposition Division had correctly rejected the opposition. Both Zeicould peacefully exist on the market. The sign claimed was not similar to the earlier trade mark, took no account of the distinctive character of the earlier trade mark and was also not detrimental to its repute. Alcoholic beverages may ultimately be purchased by adults. The name of the beverages played a decisive role here. On account of the difference in price alone, no one would purchase an ‘St. Joseph Bitter’ from an error instead of a ‘Jägermeister’. A likelihood of confusion or a conceptual association could not be proven. The consumer would immediately recognise the differences between a deer’s head and the head of a hot man. This applied all the more if consumers of a traditional alcoholic beverage were involved in the premium category, such as ‘Jägermeister’. The overall impression of the two signs was different.

### **Reasons**

11. The appeal is well founded. The Opposition Division incorrectly rejected the opposition based on the grounds for invalidity pursuant to Article 8(1) EUTMR and Article 8(5) EUTMR, owing to a lack of similarity between the signs. The opposing trade marks have a low degree of similarity.
12. Both the likelihood of confusion pursuant to Article 8(1)(b) EUTMR and the exploitation or detriment to the distinctive character or repute of an earlier mark with a reputation presuppose that the contested mark is identical or similar to the earlier mark. The Board therefore begins the examination with that of the opposing signs. As the earlier trade mark was ineligible for protection in the EU, account must be taken of the public in the entire EU for the comparison of the signs.

### *Comparison of signs*

13. The appreciation of the visual, aural and conceptual similarity of the marks must be based on the overall impression created by them, bearing in mind, in particular, their distinctive and dominant components. The perception of marks in the mind of the average consumer of the category of goods or services in question plays a decisive role here. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 25; 11/11/1997, C-

251/95, Sabèl, EU:C:1997:528, § 23; 06/10/2005, C-120/04, Thomson Life, EU:C:2005:594, § 28).

14. In particular, the examination of the similarity between the signs does not mean that only one component of a trade mark composed of several components should be taken into account and compared with another trade mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components. However, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element (12/06/2007, C-334/05 P, Limoncello, EU:C:2007:333, § 41-42; 20/09/2007, C-193/06 P, Quicky, EU:C:2007:539, § 42-43 and the case-law cited therein).
15. The contested figurative mark consists of a rectangular shape which resembles a bottle label. On a dark-green background there is a rectangle in black and white, which is essentially divided into two parts by green lines in a rectangular shape. In the left and central part, which makes up approximately two thirds of the sign, there is a horizontal red banderole in the middle with the text 'ST. Joseph' in black, slightly stylised capital letters. The word 'Bitter' and the indications 'Alk' appear underneath in grey capital letters. '24.5 %' and '50 ML'. Above the red banderole is a green circle edged in white and gold, surrounded by golden-coloured floral elements, in the middle of which the gold-coloured, stylised portrayal of a man surrounded by a circle is depicted. The right-hand part of the sign consists of a bar code and word elements in Hungarian which, on account of their position and presentation, will be understood by consumers as purely promotional, non-distinctive indications, irrespective of whether they understand Hungarian.
16. The element 'Alk. 24.5 %' will be recognised by consumers as a reference to the alcohol content and the element '50 ML' as a reference to the fill quantity, which means that these elements are also devoid of distinctive character owing to their descriptive character. The aforementioned elements therefore play only a limited role in the comparison of the signs.
17. Where signs consist of both verbal and figurative elements, the word component of the sign usually has more impact on the consumer than the figurative element, since the public will more easily refer to the goods or services in question by quoting their name than by describing the figurative element of the mark (14/07/2005, T-312/03, Selenium-Ace, EU:T:2005:289, § 37; 19/12/2011, R 233/2011-4, BEST TONE (fig.)/BETSTONE, § 24; 13/12/2011, R 53/2011-5, JUMBO (fig.)/DEVICE OF AN ELEPHANT (fig.), § 59). The most distinctive and dominant element of the contested trade mark is therefore the word element 'ST. Joseph'. Nonetheless, the graphic design of the sign and in particular the gold-coloured, stylised portrayal of a man with crown on a green circle and the green/white/red colouring of the sign claimed also contributes to the overall impression and must therefore be taken into account when comparing the signs (see the case-law cited in paragraph 14).
18. The earlier figurative mark likewise consists of a rectangular shape which resembles a bottle label. On a dark-green background there is a white rectangle bordered by a green line followed by a white line. There is a horizontal banderole in orange in the middle of the sign, which contains the text 'Jägermeister' in black stylised letters. Underneath it is the word element 'SELECTED 56 BOTANICALS' in considerably smaller lettering together with further details, which are barely legible on account of their even smaller font. Above the orange strip there is a white and golden green circle which is decorated with

golden-coloured leaves on its underside. The stylised head of a stag with antlers in a jet-circle is depicted in the green circle. Above and framed by the anchor is a circle in a lighter green with a white Latin cross. For the above reasons, the most distinctive element of the earlier sign is the word element 'Jägermeister'. Nevertheless, the brown targeted will not neglect the graphic design as a whole and in particular the representation of a stag's head on a green circle with a cross and the green and orange colour schema in the overall impression of the earlier trade mark.

19. Despite the differences that exist, in particular the differences in the most distinctive word components 'ST. Joseph' and 'Jägermeister' and in terms of the figurative elements (head of a man in contrast to the head of a deer), the opposing signs have a low degree of visual similarity, as their graphic arrangement is very similar overall. The signs are identical in terms of their colour schema (green, white, gold and orange/red), their basic rectangular shape, their construction and their essential graphic elements and their arrangement to one another (circular green element with a portraitsimilar strip above an orange-coloured/red banderole).
20. Both the earlier sign and the central left-hand part of the sign applied for consist of an inner (dark) white rectangle which is firstly bordered by a green, then a dark-green white line and then a dark green line. Both signs contain a red or orange band positioned in the centre with a black lettering above which a dark-and-white and golden green circle with a gold floral decoration is attached. In the dark green circle, there is in each case a stylised front view of a head (by a man in the contested sign and a stag in the earlier sign), which is surrounded by a jet circle in each case.
21. The signs under comparison therefore have a low degree of visual similarity.
22. The signs are aurally dissimilar, as the most distinctive word elements 'ST. Joseph' of the contested sign and 'Jägermeister' of the earlier sign un are pronounced differently- depending on the different relevant languages.
23. The signs are conceptually dissimilar. Some of the consumers will understand the word element 'ST. Joseph' of the contested sign as a reference to the naked Josef. The word-element 'Jägermeister' of the earlier sign as a whole has no meaning. Nevertheless, the German-speaking consumer in any case immediately recognises therein the fact that the terms 'Jäger' and 'Meister' are combined, and therefore a meaning that differs from 'ST. Joseph'. Furthermore, for all the consumers targeted, the signs differ in the meaning of the respective figurative elements, namely the depiction of a head of a man in the application, in contrast to the depiction of a head of a deer in the earlier trade mark.
24. Overall, the signs under comparison therefore have a low degree of similarity.
25. The Opposition Division considered the signs to be dissimilar and therefore, from their point of view, did not examine the further requirements of the asserted opposition. However, since, as stated above, the signs have a low degree of visual similarity, this must be remedied. It must be borne in mind, in particular, that, depending on the degree of recognition of the earlier trade mark, even a low degree of similarity between the signs may be sufficient for the assumption of a link within the meaning of Article 8(5) EUTMR (-16/01/2018, 398/16, COFFEE ROCKS (fig.)/STARBUCKS COFFEE (fig.) et al., EU:T:2018:4, § 78).
26. As the Opposition Division has not yet examined the further requirements of Article 8(1) EUTMR and Article 8(5) EUTMR, and in particular the claimed reputation of the earlier trade mark, the case must be remitted to the Opposition Division for further examination pursuant to Article 71(1) (2) EUTMR.

**Costs**

27. As, as a result of the appeal proceedings, neither party has been successful and no party is ordered to bear the costs of the appeal proceedings, the Board orders each party to bear its own costs in the appeal proceedings pursuant to Article 109(3) EUTMR. The decision on the costs of the opposition proceedings is reserved for the decision on the substance.

**Order**

On those grounds,

THE BOARD

hereby:

- 1. Annuls the contested decision.**
- 2. Remits the case to the Opposition Division for further examination.**
- 3. Orders each party to bear its own costs in the appeal proceedings.**

Signed

G. Humphreys

Signed

E. Fink

Signed

C. Bartos

Registrar

Signed

P.O. P. Nafz

