

JUDGMENT OF THE COURT OF FIRST INSTANCE (Fifth Chamber)

14 December 2006 *

In Joined Cases T-81/03, T-82/03 and T-103/03,

Mast-Jägermeister AG, established in Wolfenbüttel (Germany), represented by
C. Drzymalla, lawyer,

applicant,

v

**Office for Harmonization in the Internal Market (Trade Marks and Designs)
(OHIM)**, represented by J. García Murillo, acting as Agent,

defendant,

the other party to the proceedings before the Board of Appeal of OHIM, intervener
before the Court of First Instance, being

* Language of the case: Spanish.

Licorera Zacapaneca SA, established in Santa Cruz (Guatemala), represented by L. Corno Caparrós and B. Uriarte Valiente, lawyers,

THREE ACTIONS brought against the decisions of the First Board of Appeal of OHIM of 19 December 2002 (Case R 412/2002-1 and Case R 382/2002-1) and 14 January 2003 (Case R 407/2002-1), relating to opposition proceedings between Licorera Zacapaneca SA and Mast-Jägermeister AG,

THE COURT OF FIRST INSTANCE
OF THE EUROPEAN COMMUNITIES (Fifth Chamber),

composed of M. Vilaras, President, E. Martins Ribeiro and K. Jürimäe, Judges,

Registrar: K. Andová, Administrator,

having regard to the applications lodged at the Registry of the Court of First Instance on 3 March 2003 (Cases T-81/03 and T-82/03) and 19 March 2003 (Case T-103/03),

having regard to OHIM's responses lodged at the Registry of the Court of First Instance on 14 December 2004 (Cases T-81/03 and T-82/03) and 15 December 2004 (Case T-103/03),

having regard to the intervener's responses lodged at the Registry of the Court of First Instance on 15 December 2004,

having regard to the stays of proceedings decided on on 16 June 2003, 5 December 2003 and 22 April 2004,

having regard to the joinder of the cases decided on on 1 June 2006,

having regard to the oral procedure and further to the hearing on 13 July 2006,

gives the following

Judgment

Background to the dispute

- 1 On 13 November 1998 Licorera Zacapaneca SA filed three applications for registration of Community trade marks at the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) pursuant to Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended.

- 2 The three marks in respect of which registration was sought (collectively, 'the marks applied for') are the figurative signs set out below, for which the colours claimed

were black, gold and white, and, as regards only the marks applied for in Cases T-81/03 and T-103/03, red:



(Case T-81/03)



(Case T-82/03)



(Case T-103/03)

- 3 The goods in respect of which registration of the marks was sought are the same in the three cases and are in Classes 32 and 33 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 July 1957, as revised and amended. More specifically, the list of goods in respect of which registration was sought, as restricted by the intervener on 7 February 2000, contains the following goods:

— Class 32: ‘Mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages’;

— Class 33: ‘Rum, rum liqueurs and aguardientes’.

- 4 The two Community trade mark applications which are the subject of Cases T-81/03 and T-82/03 were published in *Community Trade Marks Bulletin* No 88/99 of 8 November 1999.

- 5 On 24 November 1999 Mast-Jägermeister AG filed two notices of opposition against those applications under Article 42(1) of Regulation No 40/94. The oppositions were based on the applicant's earlier Community figurative mark registered on 16 October 1998 under number 337 337 ('the earlier mark') and set out below:



- 6 The goods in respect of which the earlier mark is registered are in Classes 18, 25, 32 and 33 of the Nice Agreement and correspond to the following description:

- Class 18: 'Umbrellas, parasols';
- Class 25: 'Clothing, footwear, headgear';
- Class 32: 'Non-alcoholic beverages';
- Class 33: 'Wines, sparkling wines, fruit wines, fruit sparkling wines, spirits'.

- 7 The grounds relied on in support of each opposition were the identity of the mark applied for and the earlier mark and the likelihood of confusion between them within the meaning of Article 8(1)(a) and (b) of Regulation No 40/94.
- 8 The intervener's third Community trade mark application, which is the subject of Case T-103/03, was published in *Community Trade Marks Bulletin* No 38/2000 of 15 May 2000.
- 9 On 31 May 2000 the applicant filed a notice of opposition against that application based on the earlier mark, referred to in paragraph 5 above, and on its earlier Community figurative mark, registered on 15 October 1998 under number 135 228 ('the second earlier mark') and set out below:



- 10 The goods in respect of which the second earlier mark is registered are in Class 33 of the Nice Agreement and correspond to the following description: 'alcoholic beverages (except beer)'.

- 11 The grounds relied on in support of the opposition were the identity of the mark applied for and the two earlier marks and the likelihood of confusion between them within the meaning of Article 8(1)(a) and (b) of Regulation No 40/94.
- 12 In its communications on the grounds of its three oppositions submitted on 2 June 2000 (Case T-81/03), 27 April 2000 (Case T-82/03) and 3 November 2000 (Case T-103/03), and by letters of 27 September 2000 (Cases T-81/03 and T-82/03), the applicant relied on the results of two opinion polls carried out in Germany in 1994 and 1999. The 1994 poll found that 88% of the adult population of Germany associated the Jägermeister mark with alcoholic beverages, whilst the 1999 poll found that 70% of Germans were able to connect the name 'Jägermeister' with a black-and-white representation of a deer's head.
- 13 By three decisions of 25 March 2002 (Case T-81/03), 27 February 2002 (Case T-82/03) and 14 March 2002 (Case T-103/03), the Opposition Divisions upheld the oppositions and rejected the three applications for registration in their entirety on the ground that, in view of the similarity of the signs in question and the fact that the goods concerned are in part identical and in part similar, there was a likelihood of confusion in Spain. As regards the two opinion polls submitted by the applicant, the Opposition Divisions took the view that the 1994 poll was irrelevant since it referred to the awareness on the market of the Jägermeister mark and not of the earlier mark. As for the second opinion poll of 1999, the Opposition Divisions found, in their decisions on the oppositions which are the subject of Cases T-81/03 and T-82/03, that the applicant had not provided, within the period prescribed for substantiating its oppositions, the representation of the design shown to the persons surveyed. In its decision on the opposition which is the subject of Case T-103/03, the Opposition Division likewise did not take into consideration that poll, all the elements of which had been submitted in due time, on the grounds, first, that it had not been demonstrated that in relevant countries other than Spain the word element 'venado especial' has an impact identical to that which it has on the Spanish public and, second, that the likelihood of confusion in Spain was sufficient to reject the

contested trade mark application in its entirety. Lastly, in that decision, the Opposition Division concentrated its analysis on the likelihood of confusion between the mark applied for in that case and the earlier mark and did not undertake a comparison of the mark applied for with the second earlier mark.

14 On 25 April 2002 (Case T-82/03) and 10 May 2002 (Cases T-81/03 and T-103/03) the intervener filed three notices of appeal under Articles 57 to 62 of Regulation No 40/94 against the above-cited decisions of the Opposition Divisions.

15 By decisions of 19 December 2002 (Case R 412/2002-1 which is the subject of the action in T-81/03 and Case R 382/2002-1 which is the subject of the action in T-82/03) and 14 January 2003 (Case R 407/2002-1 which is the subject of the action in T-103/03) (collectively, 'the contested decisions'), the First Board of Appeal of OHIM upheld the intervener's appeals and therefore rejected the applicant's oppositions. The contested decisions were notified to the applicant on 2 January 2003 (Cases T-81/03 and T-82/03) and 20 January 2003 (Case T-103/03).

16 The Board of Appeal essentially found that, despite the identity of certain goods at issue, in Classes 32 and 33, there was no compelling reason to believe that there would be a likelihood of confusion between the marks applied for and the earlier mark on the part of the general public in any part of the Community. This was on account of the visual and phonetic differences and the absence of any great conceptual similarity between those marks. That finding, based essentially on the Board of Appeal's comparison of the conflicting signs, is corroborated by the frequency of the depiction of a deer or a deer's head to cover a range of beverages, as demonstrated by eight Community trade mark registrations and research in the United Kingdom trade marks register undertaken by the Board of Appeal of its own motion.

17 As regards the two opinion polls submitted by the applicant, the Board of Appeal, in its decisions of 19 December 2002 (Cases T-81/03 and T-82/03), essentially confirmed — and for the same reasons — the positions of the Opposition Divisions. In its decision of 14 January 2003 (Case T-103/03), the Board of Appeal also upheld the finding of the Opposition Division on the lack of relevance of the 1994 opinion poll. The Board of Appeal took the view that the results of the 1999 poll gave no indication of the perception of the German consumer faced with the image of a deer's head different from the image of the deer's head in the applicant's mark and accompanied by the foreign words 'venado especial'. According to the Board of Appeal, it is difficult in that case to believe that consumers will still associate the image in question with a product of the applicant (Mast-Jägermeister). Consequently, even if the Board were to accept that the earlier mark possesses a higher degree of distinctiveness in Germany, that would by no means imply that the German public would confuse the mark applied for with the deer's head characterising the applicant's goods. Lastly, in that decision, the Board of Appeal upheld the reasoning of the Opposition Division consisting in taking into account, when assessing the likelihood of confusion in this case, only the earlier mark, referred to in paragraph 5 above, since that mark is closer to the mark applied for. If there were a likelihood of confusion between the mark applied for and the earlier mark, it would be pointless to assess the second earlier mark. Conversely, if there were no likelihood of confusion between the mark applied for and the earlier mark, any likelihood of confusion between the mark applied for and the second earlier mark would a fortiori be eliminated.

Forms of order sought

18 The applicant claims that the Court should:

- annul the contested decisions;

- order the defendant to pay the costs.

19 OHIM contends that the Court should:

— principally:

— annul the contested decisions;

— order the intervener to pay the costs or order each party to bear its own costs;

— in the alternative:

— dismiss the actions;

— order the applicant to pay the costs.

20 The intervener contends that the Court should:

— dismiss the actions;

— order the applicant to pay the costs.

- 21 At the hearing OHIM withdrew its head of claim that the intervener should be ordered to pay the costs in the event that the action is upheld and stated that, in that case, each party should be ordered to bear its own costs. The Court took formal notice of that amendment in the minutes of the hearing.
- 22 At the hearing the intervener added a head of claim on costs to the effect that OHIM should be ordered to pay the costs of the intervener in the event that the contested decisions are annulled. The intervener justified that head of claim by relying on the fact that OHIM endorsed, by its principal head of claim, the applicant's claim that the contested decisions should be annulled. The intervener contends that it is apparent from Case C-106/03 P *Vedial v OHIM* [2004] ECR I-9573, paragraph 26, that that position of OHIM prejudices the legitimate expectations of the intervener, which expects OHIM to defend the decisions of its own Boards of Appeal before the Court. The Court took formal notice of that amendment in the minutes of the hearing.

The admissibility of OHIM's principal claim

Arguments of the parties

- 23 OHIM submits that its principal claim seeking annulment of the contested decisions is admissible. It relies in this respect on case-law according to which it is not required to defend systematically every decision of a Board of Appeal and can endorse a head of claim of the applicant's or leave the decision to the discretion of the Court (Case T-107/02 *GE Betz v OHIM — Atofina Chemicals (BIOMATE)* [2004] ECR II-1845, paragraphs 34 and 36).

Findings of the Court

- 24 By its principal claim, OHIM requests the Court to annul the contested decisions. In support of that claim, OHIM submits arguments which seek to show that the Board of Appeal erred in finding that there is no likelihood of confusion in the present case.
- 25 In that context it must be recalled that, in proceedings concerning an action brought against a decision of a Board of Appeal adjudicating in opposition proceedings, OHIM does not have power to alter, by the position it adopts before the Court, the terms of the dispute as delimited in the respective claims of the applicant for registration and of the opposing party (*Vedial v OHIM*, paragraph 22 above, paragraph 26; see Joined Cases T-466/04 and T-467/04 *Dami v OHIM — Stilton Cheese Makers (GERONIMO STILTON)* [2006] ECR II-183, paragraph 29, and the case-law cited).
- 26 However, it does not follow from that case-law that OHIM is obliged to contend that an action brought against a decision of one of its Boards of Appeal should be dismissed. While OHIM does not have the requisite capacity to bring an action against a decision of a Board of Appeal, conversely it cannot be required to defend systematically every contested decision of a Board of Appeal or automatically to claim that every action challenging such a decision should be dismissed (*BIOMATE*, paragraph 23 above, paragraph 34, and *GERONIMO STILTON*, paragraph 25 above, paragraph 30).
- 27 Thus, there is nothing to prevent OHIM from endorsing a head of claim of the applicant's or from simply leaving the decision to the discretion of the Court, while putting forward all the arguments that it considers appropriate for giving guidance to the Court (*BIOMATE*, paragraph 23 above, paragraph 36; Case T-379/03 *Peek & Cloppenburg v OHIM (Cloppenburg)* [2005] ECR II-4633, paragraph 22, and *GERONIMO STILTON*, paragraph 25 above, paragraph 31).

28 On the other hand, OHIM may not seek an order annulling or altering the decision of the Board of Appeal on a point not raised in the application or put forward pleas in law not raised in the application (*Vedial v OHIM*, paragraph 22 above, paragraph 34; *Cloppenburg*, paragraph 27 above, paragraph 22, and *GERONIMO STILTON*, paragraph 25 above, paragraph 32).

29 In this case it is clear that, in its principal claim, the only arguments that OHIM has put forward are in support of the applicant's head of claim according to which the Board of Appeal erred in finding that there was no likelihood of confusion between the conflicting marks, at least in Spain. Accordingly, the principal claim put forward by OHIM and the arguments advanced in support thereof are admissible in so far as they do not go beyond the bounds of the claims and pleas in law put forward by the applicant.

Substance

30 In each of the cases, the applicant puts forward two pleas in law alleging infringement of (i) Article 8(1)(b) of Regulation No 40/94 and (ii) Article 73 of that regulation. It is appropriate to start by considering the first plea.

Arguments of the parties

31 Referring to the case-law on the assessment of the likelihood of confusion, the applicant observes that since the earlier mark is a Community trade mark, it is

necessary, when assessing that likelihood, to consider the matter from the perspective of the relevant public in the whole of the European Union. However, as is apparent from Article 8(4) of Regulation No 40/94, it is sufficient that there be a likelihood of confusion at least in a relevant part of the European Union, such as the entire territory of a Member State.

32 The applicant submits that the Board of Appeal was right to find that the goods concerned were identical or similar. By contrast, it criticises the Board of Appeal's comparison of the signs.

33 In this respect, the applicant submits, first, that the Board of Appeal placed too much importance on the word 'venado' or, in Case T-103/03, on the words 'venado especial'. In the light of the meaning of 'venado' in Spanish (deer), that word merely describes, for the Spanish-speaking consumer, the image in the marks applied for. That image, by virtue of its size alone, dominates the marks applied for. Thus, by its purely descriptive function of the figurative element, the word 'venado' cannot be regarded as striking for the Spanish-speaking public. The word 'especial', which appears only in the mark applied for which is the subject of Case T-103/03, has no meaning other than 'special' and, consequently, is understood by the relevant public as an indication that the product in question is an improved or modified product from the same manufacturer. Such concepts are commonly used and do not have distinctive character.

34 Even for the non-Spanish-speaking public, because of the presence of the 'venado' component in the marks applied for, the similarity between the conflicting signs cannot be denied. In the applicant's submission, where the earlier mark consists solely of a figurative sign, it is the figurative element of a later mark which is complex, that is to say word and figurative, which gives rise to confusion. The word element of that later complex mark could indeed further compound the likelihood of confusion, as in the present case, where that element corresponds conceptually to the figurative element of the marks applied for. On the other hand, the word

element of a later complex sign cannot in any event accentuate the difference between that sign and the earlier mark containing no word element, since a comparison of that word element with the earlier figurative mark is precluded from the outset. According to the applicant, the public will compare the image that it has in mind of the earlier figurative mark with the figurative element of the later mark. Any other assessment of this question would result, purely and simply, in it being possible to reproduce, identically or almost so, the earlier figurative sign in a later sign, provided that some type of word is attached to it, including a word which corresponds to the mere verbal description of the figurative sign.

35 In the applicant's submission, the present case is to be distinguished from that where both the earlier mark and the mark applied for consist of a combination of word and figurative elements. In that case it may sometimes occur that the word element of the earlier mark is so striking that the relevant public keeps that mark in mind only through its word element and that, when that public is faced with a later word and figurative sign, only the word elements in the conflicting signs are decisive for it.

36 It follows that the figurative element of the marks applied for must be taken into account as a decisive factor when comparing the conflicting signs, especially since the goods covered by those marks are in everyday use and mainly bought on sight, which confers particular importance on the figurative element.

37 Second, the applicant asserts that the Board of Appeal wrongly took account in this respect of the arrangement of the colours in the marks applied for. The registration of the earlier black-and-white mark covers any colour arrangement, including the use of gold for the circular border and the outlines of the deer's head. The fact that the mark applied for in Case T-103/03 is framed by black and red lines and could

therefore give the impression of a label is also irrelevant. Since that frame is a basic geometrical figure, the relevant public would not attach any importance to it. Moreover, the second earlier mark also consists of a label, whilst the earlier mark is also frequently reproduced on a label.

38 Third, the applicant submits that the Board of Appeal attached too much importance to the differences in detail between the marks applied for and the earlier mark as against the very great similarities between them. The relevant public keeps in mind only a rough impression of the figurative signs and not their details, such as the fact that, in the earlier mark, the deer's fur is striated and its head is drawn in the style of an etching whilst the marks applied for do not display such features. The same is true as regards the deer's antlers, which are shorn in the marks applied for whereas in the earlier mark they are full-length, and as regards the absence, in the marks applied for, of a cross in a halo which is present in the earlier mark.

39 The applicant observes that the overall impression of the earlier mark is characterised by the representation, in the style of a portrait, of a deer's head, which, from the inside of a circle, directly faces the person observing it. The imaginary line from the forehead over the nose to the muzzle of the deer runs down vertically to the neck of the animal. The ears are at an angle of approximately 45 degrees to that vertical line and the antlers come out from just behind the ears.

40 The marks applied for are also characterised by such an imaginary straight line reaching down to the neck, running from the forehead, over the nose to the muzzle of the deer. Moreover, the ears of the deer are also at an angle of approximately 45 degrees to that vertical line and the antlers also come out from just behind the ears. Lastly, both in the marks applied for and in the earlier mark, the deer's head is cut off at neck level by a circle and the two depictions are characterised by their high level of symmetry and both show a stylised representation of a deer's head, the

degree of abstraction being only slightly higher in the marks applied for. Contrary to the opinion of the Board of Appeal, the circles in which the two deer's heads are placed are not a merely decorative accessory but frame the two images and give them their form. That feature heightens the resemblance between the overall impressions of the conflicting signs. By contrast, the rectangular frame in two of the marks applied for (Cases T-81/03 and T-103/03) is in fact merely a decorative accessory which is not perceptible by the relevant public.

41 It is also striking that the deer's head in the marks applied for appears as an image, brought into slightly closer focus, of the deer's head in the earlier marks. If one were to enlarge the image of the deer's head in the earlier mark by 'zooming' in on the deer's head, the deer's antlers would also disappear behind the circle. That effect compounds the likelihood of confusion between the conflicting signs because of the imperfect image that the relevant public retains of those signs.

42 The applicant also submits that the fact that, in the marks applied for, there is no cross motif surrounded by a halo cannot lead to a finding that the signs are sufficiently different. First, the impression of rays of light is present in the marks applied for, more specifically in the circle which forms part of the figurative element of those marks. Second, the marks applied for could be perceived as modernised versions of the earlier mark. The Board of Appeal was wrong to reject that argument on the ground that the differences between the signs are too marked. In the applicant's submission, in view of the points which it has set out, those differences carry only little weight when compared with the resemblance between the signs. Moreover, the intervener's former marks show that it itself modernised its sign.

43 Furthermore, this case can be distinguished from the one which gave rise to the judgment in Case C-251/95 *SABEL* [1997] ECR I-6191. First, in *SABEL*, the Court had to answer a question referred for a preliminary ruling and did not have to

adjudicate on the likelihood of confusion between the opposing signs. Second, contrary to the position with the word ‘sabèl’ in that case, in the present case the word ‘venado’ is understood in the Spanish-speaking world as meaning ‘deer’ and, consequently, has no independent meaning in a comparison between the marks in question, since it describes the image in the marks applied for. Third, the word ‘sabèl’ is integrated into the figurative element of the mark whereas the word ‘venado’ appears separately from the figurative element in the marks applied for. Fourth, and above all, the similarity of the marks in the present case is not confined to a resemblance between the motifs in question; there is also a very strong similarity in the manner in which those motifs are represented.

44 Further, the fact that three separate Opposition Divisions of OHIM, having different compositions, reached the same conclusion independently of one another that there is a similarity between the marks applied for and the earlier mark shows that the strongest arguments are in support of a likelihood of confusion. In addition, Decision No 3006/2000 of the Third Opposition Division of 12 December 2002 reached a similar conclusion.

45 Lastly, the applicant submits that, in view of the similarity of the conflicting signs, it is not necessary to prove that the earlier mark is highly distinctive.

46 In any event, the applicant observes that whilst it is indeed true that, in Cases T-81/03 and T-82/03, it did not submit, within the period prescribed, the figurative sign which served as a basis for the second opinion poll carried out in 1999, it did however describe it in its observations of 27 September 2000 to the Opposition Divisions, and there is therefore no ambiguity on that issue between the parties. Moreover, the intervener understood perfectly the content and the basis of that poll and did not contest its outcome, merely raising the fact that it is limited to Germany. In Case T-103/03, in which the sign which was the subject of the poll was submitted

within the period prescribed, the applicant submits that the Board of Appeal misapplied the law by refusing to take into consideration the result of that poll on the ground that it does not address the question of the public's reaction to a sign containing the word element 'venado especial'. The applicant observes, lastly, that the sign which served as the basis for the poll, consisting of a deer's head with no cross, is registered in its name as a national mark in Germany and as an international mark.

⁴⁷ OHIM contends that, in the present cases, it was the decisions given by the Opposition Divisions and the decision given by the Third Board of Appeal in Case R 213/2001-3 which interpreted correctly the applicable criteria set out in case-law for determining whether there is or is not a likelihood of confusion between the figurative marks at issue.

⁴⁸ OHIM observes, first, that the relevant public in the present case is the Community consumer, in view of the fact that the earlier mark is registered as a Community trade mark. However, according to the case-law, it is sufficient that there be a likelihood of confusion in a part of the Community in order for the registration of that application to be refused, on account of the principle of the unitary character of the Community trade mark. Consequently, a likelihood of confusion in Spain is a sufficient ground for rejecting in their entirety the disputed applications for registration.

⁴⁹ OHIM undertakes, second, a comparison of the goods covered by the conflicting marks and endorses the position adopted by the applicant during the proceedings before OHIM, according to which the differences in application highlighted by the intervener cannot be taken into consideration, given that the goods covered by the marks applied for in Class 33, namely 'rum, rum liqueurs and aguardientes', are included in the more general heading of 'spirits' in respect of which the earlier mark is registered. Similarly, the 'mineral and aerated waters and other non-alcoholic

drinks; fruit drinks and fruit juices' covered by the marks applied for in Class 32 could be included in the more general category of 'non-alcoholic beverages' covered by the earlier mark. Consequently, identical goods are involved in these cases.

50 As regards 'syrups and other preparations for making beverages', covered by the marks applied for in Class 32, they are very similar to the non-alcoholic beverages covered by the earlier mark, since the two categories have an identical intended purpose and are in direct competition on the market. In this respect, OHIM observes that producers of non-alcoholic beverages can sell their goods in two forms, either as end products ready for consumption, or in powder or liquid form (syrups and preparations for making beverages) to which sparkling or still water must be added. In the second case, the resulting product is a non-alcoholic beverage which, in most cases, is the same as the product sold ready for consumption.

51 OHIM contends that the Board of Appeal was right to find that some of the goods at issue are identical and adds that the other goods which were found not to be identical by the Board are highly similar. It also notes that the goods at issue are everyday consumer items.

52 As regards, third, the comparison of the conflicting signs, OHIM observes that, in visual terms, both the earlier mark and the marks applied for display figurative elements consisting essentially in the representation of a deer's head facing forward in a circle. They differ in terms of the style of the representations, the proportion of the head which is visible, the presence in the earlier mark of a cross surrounded by a halo positioned between the antlers, the addition, in the marks applied for, of a word element, namely 'venado' or 'venado especial' and, in the marks applied for in Cases T-81/03 and T-103/03, the rectangular frame in which the marks applied for are placed.

- 53 OHIM takes the view that, despite the presence of the word element ‘venado’ or ‘venado especial’ in the marks applied for, visually their figurative element is perceived as dominant, on account of its position, its very eye-catching appearance and its size. In addition, to insert the mark in a rectangle in the style of a label, as in the marks applied for in Cases T-81/03 and T-103/03, is standard practice in the beverages industry. As regards the earlier mark, OHIM is of the opinion that although the cross surrounded by a halo is clearly visible, it is not dominant in relation to the representation of the animal’s head.
- 54 OHIM observes that from a phonetic point of view the earlier marks are exclusively figurative. Consequently, any oral reference to those marks would be made by describing the design to the interlocutor, so that that person can identify the sign in question. Thus, it is possible that the Spanish public would allude to those marks by reference to the animal depicted, namely ‘venado’ (deer). The marks applied for, on the other hand, are referred to orally by the words which they contain, namely ‘venado’ and ‘venado especial’ respectively.
- 55 On a conceptual level, OHIM observes that the word ‘venado’ is considered by the Spanish consumer to be the definition of an animal whose features correspond to that represented in the figurative element. In the overall impression of the marks applied for, that word is not perceived by the Spanish public as an element in its own right but is considered to be clearly linked to the figurative element, which plays an important role given that the only word element of the marks applied for defines the animal represented. It follows that the figurative element of the marks applied for assumes decisive importance in terms of the Spanish consumer’s perception of the marks.
- 56 In the light of those considerations, OHIM submits that, in the overall assessment of the likelihood of confusion in the present case, account must be taken of the following elements: first, the figurative element of the marks applied for, which is perceived as an element which attracts the attention of the consumer, since the cross surrounded by a halo in the earlier mark is not a dominant element in the overall

impression projected by that mark; second, the word element ‘venado’ or ‘venado especial’ in the marks applied for, which is perceived by the Spanish public as closely linked to the figurative element of those marks, since it is the term by which the animal represented is identified; third, the fact that the signs at issue share, as a feature attracting the attention of consumers, the idea projected by their figurative elements, namely a deer’s head facing forward in a circle, which, in itself, is ordinarily distinctive; fourth, the fact that the goods at issue are identical or highly similar and that, moreover, since they are everyday consumer goods, the average consumer does not pay particular attention when purchasing them.

57 OHIM submits in conclusion, just like the Opposition Divisions and contrary to the Board of Appeal’s assessment in the contested decisions, that, in the event that the relevant public does not, as regards the figurative element of the marks applied for, ascribe any particular meaning to the word ‘venado’, there is a likelihood of confusion between the signs at issue given that the elements which make up the marks applied for are clearly linked conceptually.

58 It is only in the alternative that OHIM contends that the actions should be dismissed, if the Court were to uphold the Board of Appeal’s reasoning that there is no likelihood of confusion between the signs at issue.

59 Lastly, as regards the taking into account of the two opinion polls submitted by the applicant in order to prove that the earlier marks are well known in Germany, OHIM endorses, in Cases T-81/03 and T-82/03, the position adopted by the Board of Appeal and the Opposition Divisions, which found that the first document was not relevant and that the second was not valid because it was not submitted in full within the period prescribed. By contrast, in Case T-103/03, OHIM takes the view that since the poll conducted in Germany in 1999 (see paragraph 12 above) was submitted in full within the period prescribed, it must be taken into account by the Court if the latter were to find that there is no likelihood of confusion between the conflicting marks in Spain.

- 60 The intervener rejects, first, the applicant's argument that since the earlier marks are purely figurative, the word element of the marks applied for should be disregarded in the comparison. The intervener submits that such an approach, which completely ignores the word elements, fails to have regard to the overall comparison of the marks, taking account of their distinctive and dominant elements, required by the case-law.
- 61 The intervener does not agree that the Board of Appeal placed excessive importance on the words 'venado' or 'venado especial'. First, those words, which cover a third of the marks applied for and appear in capital letters, in bold and, in the marks applied for in Cases T-81/03 and T-103/03, in red, are thus highlighted so as to attract the attention of the consumer in a decisive manner. Second, the distinctive character of the earlier mark is weakened because there are a number of marks containing representations of heads or bodies of deer which are used for beverages. The image of the deer must therefore be regarded as an element in common use, so that it cannot be monopolised by one undertaking alone which, in that manner, would be granted an unusual privilege. Since, for those reasons, that image has reduced significance for the purposes of the comparison, it cannot be regarded as a dominant element of the marks applied for.
- 62 The intervener also denies that there is phonetic identity between the conflicting marks. It claims that the average consumer will still use the words 'venado' or 'venado especial' when ordering its goods, irrespective of the images on the bottles. As regards the applicant's goods, the intervener submits that the German consumer will still ask for them using the name 'Mast-Jägermeister', in view of the fact that the applicant's mark containing a deer's head is well known, as demonstrated by the opinion poll submitted by the applicant to OHIM. The intervener does not know what Spanish consumers will call the applicant's mark but submits that they will probably also use the name 'Mast-Jägermeister' or, if they name it by reference to the design, they will use the expression 'cabeza de ciervo' (stag's head) since, in Spanish, the word 'ciervo' is used more frequently than 'venado'.

63 In respect of countries other than Spain, the intervener submits that the words 'venado' or 'venado especial' will not be understood by the average consumer and will not be associated with the image of the deer. Consequently, the marks applied for will be regarded in those countries as fanciful. In addition, the intervener claims that it registered the word mark VENADO at OHIM and that the applicant did not oppose that registration. Nor did the applicant oppose a number of word and figurative marks, containing the same word and the image of the deer's head, registered by the intervener in Spain, as should have been the case if any likelihood of confusion were limited to that State.

64 From a visual point of view, the intervener submits that there are indisputable differences between the earlier mark and the marks applied for, as observed in the contested decisions. The intervener also contends that, in view of the limited distinctiveness of the representation of the deer's head, the word element of the marks applied for acquires importance for the purposes of the comparison. The word element 'venado' or 'venado especial' is highlighted by means of large coloured letters, so that it is likely to attract the attention of consumers, even more so than the design.

65 In the intervener's submission, it cannot be accepted that consumers consider the marks applied for to be modern versions of the earlier mark since the marks applied for do not contain the cross of St. Hubert, which the applicant regards as a feature clearly emphasised in the earlier mark, but include a new and distinctive feature, namely the words 'venado' or 'venado especial'. The intervener observes that, in general, modernised versions of marks retain their most distinctive features and any new elements are not normally particularly noticeable. Lastly, the fact relied on by the applicant that the intervener itself modernised its marks is irrelevant in assessing the likelihood of confusion between the conflicting marks.

- 66 On a conceptual level, the intervener concurs with the Board of Appeal's view that there is no conceptual identity, given, in particular, that the earlier mark contains an additional feature, namely the cross of St. Hubert, whilst the marks applied for include, on the other hand, the words 'venado' or 'venado especial'.
- 67 The intervener observes that, even if there is some conceptual similarity between the conflicting marks, it is apparent from *SABEL*, paragraph 43 above, that that similarity could give rise to a likelihood of confusion only if the opposing mark were to have a particularly distinctive character, either per se or because of the reputation it enjoys with the public. However, the earlier mark does not possess such character. First, its inherent distinctiveness is limited by the fact that there are other marks relating to the same goods which include representations of cervidae or deer, as the intervener demonstrated to the Board of Appeal without being contradicted by the applicant. Second, the reputation of the earlier mark has not been proven since the opinion polls submitted by the applicant were not admitted as evidence.
- 68 In any event, the intervener recalls that the opinion poll of 1999 was based on the representation of a deer's head without the cross, and not on the earlier mark. It is irrelevant that that representation was also registered as a mark in the applicant's name since that mark, which was not used to form the basis of the applicant's oppositions or relied on before the Board of Appeal, cannot, according to case-law, be relied on for the first time before the Court.
- 69 The intervener concludes that the Board of Appeal was right to find that, in view of the differences between the marks at issue and the absence of particular distinctiveness on the part of the earlier marks, there was no likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 in the present case.

Findings of the Court

- 70 Article 8(1)(b) of Regulation No 40/94 provides that, upon opposition by the proprietor of an earlier trade mark, the trade mark applied for is not to be registered if ‘because of its identity with or similarity to the earlier trade mark and the identity or similarity of 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; the likelihood of confusion includes the likelihood of association with the earlier trade mark’.
- 71 According to settled case-law, the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion (Case T-104/01 *Oberhauser v OHIM — Petit Liberto (Fifties)* [2002] ECR II-4359, paragraph 25; see also, by analogy, Case C-39/97 *Canon* [1998] ECR I-5507, paragraph 29, and Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 17).
- 72 According to the same case-law, the likelihood of confusion on the part of the public must be assessed globally, taking into account all factors relevant to the circumstances of the case (see, by analogy, *SABEL*, paragraph 43 above, paragraph 22; *Canon*, paragraph 71 above, paragraph 16; *Lloyd Schuhfabrik Meyer*, paragraph 71 above, paragraph 18; and *Fifties*, paragraph 71 above, paragraph 26).
- 73 As far as the visual, phonetic or conceptual similarity of the marks in question is concerned, that global assessment must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. It is not impossible, in that respect, that the conceptual similarity resulting from the fact that two marks use images with analogous semantic content

may give rise to a likelihood of confusion where the earlier mark has a particularly distinctive character, either per se or because of the reputation it enjoys with the public (see, by analogy, *SABEL*, paragraph 43 above, paragraphs 23 and 24).

74 In addition, the global assessment implies some interdependence between the factors taken into account, and in particular between the similarity of the trade marks and the similarity of the goods or services concerned. Accordingly, a lesser degree of similarity between those goods or services may be offset by a greater degree of similarity between the marks, and vice versa (see, by analogy, *Canon*, paragraph 71 above, paragraph 17; *Lloyd Schuhfabrik Meyer*, paragraph 71 above, paragraph 19, and *Fifties*, paragraph 71 above, paragraph 27).

75 It should also be observed that the perception of marks in the mind of the average consumer of the goods or services in question plays a decisive role in the global assessment of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Fifties*, paragraph 71 above, paragraph 28, and Case T-355/02 *Mühlens v OHIM — Zirh International (ZIRH)* [2004] ECR II-791, paragraph 41; see, by analogy, *SABEL*, paragraph 43 above, paragraph 23, and *Lloyd Schuhfabrik Meyer*, paragraph 71 above, paragraph 25). For the purposes of that global assessment, the average consumer of the goods concerned is deemed to be reasonably well-informed and reasonably observant and circumspect. Furthermore, account should be taken of the fact that the average consumer only rarely has the chance to make a direct comparison between the different marks but has to rely on the imperfect image of them that he has retained in his mind. It should also be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question (see, by analogy, *Lloyd Schuhfabrik Meyer*, paragraph 71 above, paragraph 26, and *Fifties*, paragraph 71 above, paragraph 28).

76 Moreover, it follows from the unitary character of the Community trade mark laid down in Article 1(2) of Regulation No 40/94 that an earlier Community trade mark is protected in the same way in all Member States. Earlier Community trade marks

may therefore be relied on in opposition to any subsequent application to register a trade mark which infringes their protection, even if it does so only in the perception of the consumers of part of the Community. It follows that the principle laid down in Article 7(2) of Regulation No 40/94, according to which it suffices, in order for registration of a trade mark to be refused, that an absolute ground for refusal exists only in part of the Community, also applies by analogy to a relative ground for refusal under Article 8(1)(b) of Regulation No 40/94 (Case T-6/01 *Matratzen Concord v OHIM — Hukla Germany (MATRATZEN)* [2002] ECR II-4335, paragraph 59; *ZIRH*, paragraph 75 above, paragraphs 35 and 36; Joined Cases T-117/03 to T-119/03 and T-171/03 *New Look v OHIM — Naulover (NLSPOOT, NLJEANS, NLACTIVE and NLCollection)* [2004] ECR II-3471, paragraph 34; and Case T-185/03 *Fusco v OHIM — Fusco International (ENZO FUSCO)* [2005] ECR II-715, paragraph 33).

77 Finally, it must be observed that the legality of decisions of the Boards of Appeal is to be assessed purely by reference to Regulation No 40/94, as interpreted by the Community judicature, and not to any practice by OHIM in its earlier decisions (Case T-130/01 *Sykes Enterprises v OHIM (REAL PEOPLE, REAL SOLUTIONS)* [2002] ECR II-5179, paragraph 31; Case T-129/01 *Alejandro v OHIM — Anheuser-Busch (BUDMEN)* [2003] ECR II-2251, paragraph 61, and Case T-117/02 *Grupo El Prado Cervera v OHIM — Héritiers Debuschewitz (CHUFAPIT)* [2004] ECR II-2073, paragraph 57).

78 Having regard to the above, a comparison should be undertaken, first, between the goods concerned and, second, between the conflicting signs. In this respect, it must be stated that the decisions of the Opposition Division and the Board of Appeal, relied on by the applicant and OHIM (see paragraphs 45 and 47 above respectively) and relating to the likelihood of confusion between other marks applied for by the intervener and the earlier mark, are not relevant to that analysis, since they would show, at the very most, a certain decision-making practice on the part of OHIM which the Court cannot take into account according to the case-law cited in the previous paragraph.

The earlier marks in Case T-103/03

- 79 In support of its opposition in Case T-103/03, the applicant relied on its two Community trade marks referred to in paragraphs 5 and 9 above. It must however be observed that the second earlier mark resembles a label comprising as its main element the same representation of a deer's head as that which appears in the earlier mark. Other features have been added to it, in particular the 'jägermeister' name of the product concerned, the applicant's name and address and instructions, in English, on the consumption of its product ('serve cold — keep on ice').
- 80 In those circumstances, both the Opposition Division and the Board of Appeal were right to concentrate their analysis on the likelihood of confusion between the mark applied for in that case and the earlier mark. If it is found that there exists a likelihood of confusion between the mark applied for in that case and the earlier mark, there will be no need to take account of the second earlier mark. Similarly, if it is found that there is no such likelihood, that finding will apply a fortiori in respect of the second earlier mark, which contains, besides the image of the deer's head which also appears in the earlier mark, the additional features mentioned in the previous paragraph which distinguish it to a greater extent from the mark applied for in that case. In this respect, it should also be observed that in its application in Case T-103/03 the applicant itself focused its analysis on the similarities between the mark applied for and the earlier mark.
- 81 The Court will therefore concentrate its analysis, also as regards the opposing signs in Case T-103/03, on the likelihood of confusion between the mark applied for in that case and the earlier mark.

The relevant public

82 The marks applied for cover beverages, whether alcoholic or not. Such goods are also among the goods covered by the earlier mark. Since beverages, whether alcoholic or not, are everyday consumer items, the contested decisions were right to find that the relevant public consisted of the general public, that is to say the average consumer.

83 Furthermore, since the earlier mark is a Community trade mark, the relevant territory for the purpose of analysing the likelihood of confusion is the whole of the European Union. However, it is common ground that the words ‘venado’ and ‘venado especial’, of which the marks applied for are composed, are Spanish words, the meaning of which will be understood only by the average Spanish-speaking consumer. The assessment of the likelihood of confusion between the marks applied for and the earlier mark in Spain therefore assumes particular importance for these cases. If it transpires that there is no likelihood of confusion between the marks applied for and the earlier mark in Spain, that finding will be all the more valid in respect of average consumers in other Member States, who will not understand the meaning of the abovementioned word elements of the marks applied for. On the other hand, in accordance with the case-law cited in paragraph 76 above, likelihood of confusion between the conflicting marks in Spain would be a sufficient ground for rejecting the applications for registration at issue and there would be no need to consider whether such likelihood also exists in the rest of the European Union.

84 It follows that the analysis of the likelihood of confusion must start with an examination of the Spanish public’s perception of the conflicting marks.

Comparison of the goods

85 The Board of Appeal found, without being contradicted by the parties, that certain goods covered by the conflicting marks are identical. That is the case in respect of

‘mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices’ in Class 32 and covered by the marks applied for, which are non-alcoholic drinks and, therefore, identical to the ‘non-alcoholic beverages’ in the same class covered by the earlier mark. Similarly, ‘rum, rum liqueurs and aguardientes’ in Class 33 and covered by the marks applied for are identical to ‘spirits’ in the same class, covered by the earlier mark (contested decisions in Cases T-81/03 and T-103/03, paragraph 23; contested decision in Case T-82/03, paragraph 20).

⁸⁶ The Board of Appeal did not rule expressly on the comparison of the other goods covered by the marks applied for in Class 32, namely ‘syrops and other preparations for making beverages’, with the goods covered by the earlier mark. The Board of Appeal did not however call in question the assessment of the Opposition Divisions, according to which those goods covered by the marks applied for and the non-alcoholic beverages in Class 32 covered by the earlier mark are similar. The applicant and OHIM agree on the fact that those goods are very similar, whilst the intervener did not express a view on the issue in its response. However, it accepted at the hearing that those goods are similar. It must be held that the goods in question are highly similar since, as OHIM rightly observes, it is sufficient to add sparkling or still water to the goods covered by the marks applied for in order for them to become non-alcoholic beverages ready for consumption, and those goods therefore have an identical intended use and are in direct competition on the market.

⁸⁷ The Court therefore finds that the goods covered by the conflicting marks are to a large extent identical and very similar as to the remainder.

Comparison of the signs

⁸⁸ In the contested decisions, the Board of Appeal found that there was no likelihood of confusion between the marks applied for and the earlier mark in any part of the

Community, despite the identity of certain goods covered by the marks at issue and the existence of 'clear similarities' between them. That finding is based on certain 'manifest and striking' differences between the conflicting figurative signs, such as the absence, in the marks applied for, of the cross of St. Hubert surrounded by a halo which rivals the deer's head itself in terms of prominence and attracts the attention of consumers, the differences in the representation of the respective deer's heads and the presence, in the marks applied for, of a stylised word element in colour ('venado' or 'venado especial'). In the light of those differences, the Board of Appeal found that the conflicting marks had to be regarded as visually distinct (contested decision in Case T-81/03, paragraphs 25, 26, 28 and 34; contested decision in Case T-82/03, paragraphs 22, 23, 25 and 30; contested decision in Case T-103/03, paragraphs 25, 26 and 31).

⁸⁹ Phonetically, the Board found that the marks at issue are also distinct, since only the marks applied for contain a word element. In the contested decisions in Cases T-81/03 and T-82/03, the Board of Appeal moreover found that the Opposition Divisions had been wrong to take the view that the word element of the marks applied for is associated in Spain with the figurative element of the signs. In this respect, the Board of Appeal, relying on an argument that the applicant itself had put forward before the Opposition Divisions, found that it was more likely that the earlier mark would be perceived phonetically as referring to the word and, therefore, to the Jägermeister mark than to a 'deer' or 'VENADO' mark (contested decision in Case T-81/03, paragraphs 28 and 34; contested decision in Case T-82/03, paragraphs 25 and 30; contested decision in Case T-103/03, paragraphs 26 and 31).

⁹⁰ The Board of Appeal also found that there was no great conceptual similarity between the conflicting marks. Although the bridging concept between the marks could be described as a deer's head, the presence of other features, such as the cross of St. Hubert in the earlier mark and the word element 'venado' or 'venado especial' in the marks applied for, distinguishes them conceptually (contested decision in Case T-81/03, paragraph 34; contested decision in Case T-82/03, paragraph 30; contested decision in Case T-103/03, paragraph 31).

- 91 In addition to those comparisons, the Board of Appeal found that the distinctive character of the motif of a deer or of a deer's head was weakened given its frequent use for designating a range of beverages, as demonstrated by the eight Community registrations relied on by the intervener and the result of the research undertaken by the Board of Appeal itself in the United Kingdom trade marks register (contested decision in Case T-81/03, paragraphs 27 and 34; contested decision in Case T-82/03, paragraphs 24 and 30; contested decision in Case T-103/03, paragraph 32).
- 92 So far as concerns the visual comparison, the Court observes that both the marks applied for and the earlier mark display figurative elements consisting, in particular, in the representation of a deer's head facing forward in a circle. That shared figurative element dominates the conflicting signs on account of its eye-catching appearance and its size. That finding is not called in question either by the more abstract and coloured style of that figurative element of the marks applied for or by the indented outline of the circle in which that element appears. The word elements of the marks applied for, the insertion of two of them in a rectangular frame and the cross surrounded by a halo in the earlier mark are admittedly visible features which differentiate the conflicting signs visually. However, they are not dominant features, unlike the figurative element common to those signs, namely the representation of a deer's head facing forward in a circle. In the light of all those factors, the Court finds, in contrast to the Board of Appeal, that there is significant visual similarity between the conflicting marks.
- 93 The Board of Appeal's finding that the marks at issue are phonetically distinct even to Spanish consumers is also incorrect.
- 94 The earlier mark is purely figurative. All three of the marks applied for contain the word 'venado', which will doubtless be associated phonetically with the figurative part of those marks by Spanish-speaking consumers. Because of its meaning, that word could also be associated, by the same consumers, with the earlier mark or be

used to identify it, since it does not contain any word element. The Opposition Divisions found, essentially for those same reasons, that there was phonetic identity or similarity between the conflicting signs in Spain.

95 In the contested decisions, the Board of Appeal rejected that finding in the light, in particular, of the absence of an emphatic word element in the earlier mark, which is present in the marks applied for ('venado', 'venado especial'). In the contested decisions in Cases T-81/03 and T-82/03 the Board of Appeal also relied on an argument which the applicant itself had put forward before the Opposition Divisions, to the effect that it is more likely that the earlier mark is perceived, even in Spain, as referring to the Jägermeister mark than to a 'deer or VENADO' mark.

96 Those considerations are unfounded. It must be borne in mind that the word 'jägermeister' does not appear in the earlier mark, but only in the second earlier mark, on which the applicant did not rely in support of its oppositions in Cases T-81/03 and T-82/03. In those circumstances, there is no good reason why Spanish-speaking consumers would associate phonetically the earlier mark with the word 'jägermeister' rather than with the words 'deer' or 'venado', which correspond to the dominant figurative element of the earlier mark. It might be otherwise only if it were established that the earlier mark has a reputation in Spain. The applicant's arguments before the Opposition Divisions, relied on by the Board of Appeal, sought precisely to establish the existence of such a reputation, in particular in Germany and other countries of the European Union, including Spain, and did not seek to establish that the conflicting marks were phonetically distinct, as the Board of Appeal wrongly asserted. It must be stated, first, that the applicant has not put forward any evidence to establish the reputation of the earlier mark in a country of the European Union other than Germany. Next, the Board of Appeal did not

recognise that the earlier mark has a reputation in Spain. Lastly, the applicant itself has in the meantime abandoned that argument, since, in its applications, it pleads that the earlier mark has a reputation only in Germany and, at the hearing, it confirmed that it was not claiming that that mark has a reputation in Spain.

97 In any event, the mere fact that Spanish-speaking consumers are acquainted with the Jägermeister name of the applicant's product cannot prevent them from thinking of that product when they hear about a 'venado' liqueur, a word which they might understand as a reference to the image which appears in the earlier mark rather than to the name of a separate product. That is all the more probable because Spanish speakers have difficulty in pronouncing the word 'jägermeister', which makes it more likely in Spain that the applicant's product will be referred to by the description of the earlier mark.

98 The foregoing cannot be called in question by the intervener's assertion that Spanish consumers, when referring to the animal in the earlier mark, will instead use the word 'ciervo' since that word is allegedly used more frequently in Spanish than the word 'venado'. Even if that is the case, the intervener does not dispute that the Spanish word 'venado' also describes the animal whose image is represented in the earlier mark. Accordingly, that word can also lead the relevant consumer to think of that earlier mark.

99 The addition of the adjective 'especial' to the word 'venado' in the mark applied for in Case T-103/03 cannot lead to a different conclusion in that case. Spanish consumers will undoubtedly consider that qualifier to be a secondary and ancillary feature. First, it appears under the word 'venado' and in much smaller characters. Second, its meaning in Spanish (special) means that consumers will perceive the product bearing the mark VENADO ESPECIAL as a variation, in terms of character or quality, on the product of the VENADO mark.

100 Conceptually, the idea underlying the figurative element of the marks applied for can be summarised as that of a deer's head facing forward in a circle or a medal. The word element of those marks has no effect on that concept for Spanish consumers, who will perceive the term 'venado' or 'venado especial' not independently but as a direct reference to the figurative element. The same concept essentially underlies the earlier mark. Consequently, the conflicting marks must be regarded as conceptually similar.

The overall assessment of the likelihood of confusion

101 As regards the overall assessment of the likelihood of confusion, the Court finds, in contrast to the contested decisions, that, given that the goods concerned are to a large extent identical and very similar as to the remainder, and in view of the visual, phonetic and conceptual similarities between the conflicting marks for average Spanish consumers, the differences between them are not sufficient to eliminate the existence of a likelihood of confusion on the part of that relevant public.

102 In particular, the visual differences between the signs are not in themselves sufficient to eliminate any likelihood of confusion on the part of the relevant public.

103 In the first place, given that the average consumer retains only an imperfect image of the mark in his mind, it cannot be considered that he would be able to recall figurative details of the signs in question, such as the more or less realistic style of the deer's head, the dimensions of the deer's antlers or the simple or indented nature of the circle in which the animal's head is placed.

- 104 The presence of colours in the marks applied for essentially loses any significance for the comparison with the earlier mark because the earlier mark is a black-and-white image. Thus, faced with the marks applied for, the average consumer could reasonably believe that they are merely the colour version of the earlier mark.
- 105 The cross between the deer's antlers in the earlier mark, although clearly visible, will not be perceived, as already observed (see paragraph 92 above), as the dominant feature by the average Spanish-speaking consumer.
- 106 Nor can the rectangular frame of the marks applied for in Cases T-81/03 and T-103/03 be regarded as a sufficiently distinctive feature. As the applicant and OHIM rightly maintained, that frame is a secondary feature which gives to the marks concerned an appearance of a label. In addition, because the drinks are often sold in bottles, the insertion of the mark in a rectangle in the style of a label is a very common practice in the beverages industry.
- 107 Lastly, as observed above, the word elements ('venado', 'venado especial') appearing only in the marks applied for will be understood by the average Spanish-speaking consumer as a direct reference to the figurative part of those marks. Consequently, those elements alone are not sufficient to distinguish the marks applied for from the earlier mark in Spain, since Spanish consumers will also find in the earlier mark the image of the animal which they call 'venado'.
- 108 In the second place and above all, the visual differences between the marks at issue are offset by the identity of many of the goods concerned and the similarity of the other goods concerned and by the phonetic and conceptual similarity of those marks for the relevant Spanish-speaking public.

109 The finding that there is a likelihood of confusion between the conflicting marks in Spain cannot be called in question by the intervener's argument (see paragraph 63 above) that it registered the word 'venado' as a Community word mark without any opposition from the applicant. Irrespective of the question of the admissibility of that fact, relied on for the first time before the Court, it is sufficient to observe, first, that the mere fact that the applicant did not oppose the registration of a mark does not prevent it from filing an opposition against the registration of another mark. Second and above all, since the phonetic similarity between the conflicting marks is only one of the factors which must be taken into account in an overall assessment of the likelihood of confusion, the likelihood of confusion between the marks applied for and the earlier mark is not precluded even if it is conceded that there is no such likelihood so far as concerns the earlier mark and the word mark VENADO, notwithstanding their phonetic similarity.

110 The intervener's argument, accepted in the contested decisions, to the effect that images of a deer or a deer's head are not very distinctive because such images are frequently used to protect beverages must also be rejected. Irrespective of whether the eight registrations relied on by the intervener and the unprompted research undertaken by the Board of Appeal in the United Kingdom trade marks register are sufficient to reach such a conclusion, it must be held that, in the present case, it is not the more general concept of a deer or a deer's head which acts as a bridging concept between the conflicting marks, but a more specific concept, consisting in a representation, in the form of a medal, of a deer's head facing forward in a circle. Only three of the eight Community registrations relied on by the intervener are akin to that more specific concept, that is the trade marks registered under Nos 86439, 164392 and 163311, the last two being clearly linked because they both designate the same product, namely ANTLER beer. In addition, the trade mark registered under No 86439 appears to be very different from the conflicting signs in the present case, since the circle containing the deer's head is framed by an additional border, which has an irregular and fanciful outline and the trade mark contains a dominant word element, namely the word 'contri', written in characters proportionally much larger and having no semantic link with the figurative part of the mark. In the light of all of

the foregoing and in the absence of a clear semantic link between a deer or a deer's head and alcoholic or non-alcoholic beverages, the Court finds that it is impossible to deny that the concept of a deer's head facing forward in a circle has at least average distinctive character for designating beverages.

- 111 Finally, the intervener's argument, based on *SABEL*, paragraph 43 above, that the image of a deer's head is not particularly distinctive, must be rejected. In *SABEL*, the Court of Justice held that the mere association which the public might make between two trade marks as a result of their analogous semantic content was not in itself a sufficient ground for concluding that there was a likelihood of confusion in the case of two marks one of which consisted in the combination of a word and a picture, whilst the other was composed of a picture and was not especially well known to the public (*SABEL*, paragraphs 11 and 25). The Court stated that there would be such likelihood only if the earlier mark has a particularly distinctive character, either per se or because of the reputation it enjoys with the public (*SABEL*, paragraph 24). It must be stated that in the present case the word element ('venado' and 'venado especial') in the marks applied for constitutes in Spain a direct reference to the image in those marks, whilst in *SABEL*, paragraph 43 above, the word 'sabèl', which formed part of the mark applied for in that case, had no semantic link with the image of a bounding cheetah which it accompanied. Furthermore, in *SABEL*, the semantic analogy between the figurative parts of the two conflicting marks was limited to the fact that the animals in the marks, a cheetah and a puma, both belonged to the feline family and were represented in a bounding movement, a pose which is typical of that type of animal (Opinion of Advocate General Jacobs in *SABEL*, ECR I-6193, paragraphs 3, 4 and 13). By contrast, as observed above, the similarities between the conflicting signs in the present cases are numerous and go beyond mere concordance of elements which are derived from nature and, therefore, not very fanciful. It must be borne in mind, in particular, that the conflicting signs all contain the partial image of the same animal (a deer) and that, in every case, the same part of that animal is shown, namely the head together with the antlers and the neck, facing forward in a circle.

112 It follows from all of the foregoing that the first plea raised by the applicant must be upheld and that, therefore, the contested decisions must be annulled, and there is no need to examine the applicant's other arguments (i) that the relevant public considers the marks applied for to be a modernised version of the earlier mark and (ii) relating to the alleged reputation of that mark in Germany, or the second plea raised by the applicant alleging infringement of Article 73 of Regulation No 40/94.

Costs

113 Under Article 87(2) of the Rules of Procedure, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings. However, under the first subparagraph of Article 87(3), the Court may order that the costs be shared where the circumstances are exceptional.

114 In the present case the intervener has been unsuccessful inasmuch as the contested decisions must be annulled, in accordance with the form of order sought by the applicant. However, the applicant has not applied for costs from the intervener, but for an order that OHIM pay those costs.

115 Even though OHIM has supported the applicant's first head of claim, it should be ordered to pay the costs incurred by the applicant since the contested decisions were made by its Board of Appeal (*BIOMATE*, paragraph 23 above, paragraph 97).

- 116 As regards the intervener's new claim, submitted at the hearing, that in the event that the contested decisions are annulled, OHIM should be ordered to pay the intervener's costs, it must be observed that, according to case-law, it is open to the parties to apply for costs at the hearing, even if they have not previously done so (Case 113/77 *NTN Toyo Bearing and Others v Council* [1979] ECR 1185, and the Opinion of Advocate General Warner delivered in that case, 1212, 1274; Case T-214/04 *Royal County of Berkshire Polo Club v OHIM — Polo/Lauren (ROYAL COUNTY OF BERKSHIRE POLO CLUB)* [2006] ECR II-239, paragraph 54). That claim is therefore admissible.
- 117 The Court finds, however, that the position adopted by OHIM in relation to the decisions of its own Board of Appeal does not constitute exceptional circumstances capable of justifying the sharing of costs under the first subparagraph of Article 87(3) of the Rules of Procedure. As observed in paragraphs 24 to 29 above, OHIM is not required to defend systematically every contested decision of its Boards of Appeal and can endorse a head of claim of the applicant's. Such a position by OHIM is not therefore liable to prejudice the legitimate expectations of the intervener. *Vedial v OHIM*, paragraph 22 above, relied on by the intervener in this connection, is not relevant. In paragraph 36 of that judgment, the Court of Justice merely referred to the expectation of the party which was successful before the Board of Appeal, in so far as the purpose of proceedings before the Court of First Instance is, pursuant to Article 63(2) of Regulation No 40/94, to review the legality of the decision of the Board of Appeal. That legitimate expectation has not been infringed in the present case since the Court has undertaken such a review independently of the position adopted by OHIM. The intervener must therefore be ordered to bear its own costs.

On those grounds,

THE COURT OF FIRST INSTANCE (Fifth Chamber)

hereby:

- 1. Annuls the decisions of the First Board of Appeal of the Office for Harmonization in the Internal Market (Trade Marks and Designs) of 19 December 2002 (Case R 412/2002-1 and Case R 382/2002-1) and of 14 January 2003 (Case R 407/2002-1);**

- 2. Orders the Office for Harmonization in the Internal Market (Trade Marks and Designs) to pay the costs incurred by the applicant;**

- 3. Orders the intervener to bear its own costs.**

Vilaras

Martins Ribeiro

Jürimäe

Delivered in open court in Luxembourg on 14 December 2006.

E. Coulon

M. Vilaras

Registrar

President