

Battle of the dachshunds: figurative and word elements of composite marks may be co-dominant

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08 November 2023



EUROPEAN UNION

Legal updates: case law analysis and intelligence

- In the assessment of similarity, the figurative element of a composite mark may be considered to be as distinctive and dominant as the word element
- The General Court does not have the power to declare a trademark registrable, but only to annul or alter previous decisions of the EUIPO Board of Appeal
- The Board of Appeal is not bound by its previous decision-making practice, but only by the applicable law

On 25 October 2023 in [Case T-773/22](#), the General Court ruled in favour of Italian clothing company Harmont & Blaine SpA, upholding the decisions of the Opposition Division and the Board of Appeal of the EUIPO. The case concerned an EU trademark application filed by Contorno Textil SL ('the applicant') for goods in Class 25 ("clothing; footwear; headgear"), as depicted below:



Decision

The General Court confirmed the existence of a likelihood of confusion under Article 8(1) of [Regulation 2017/1001](#) between the trademark applied for and the earlier international trademark of Harmont & Blaine (No 1249733), extended to the European Union and covering the same goods in Class 25, which represented a dachshund:



In particular, the General Court reasoned as follows:

- The dachshund breed is immediately recognisable as the popular 'sausage dog'. Both trademarks represented the dog in profile, in basic monochromatic colours, without using any particular stylisation.
- The word element 'teckel' is the French translation of 'dachshund'.
- Both the figurative element and the second word element of the applicant's trademark referred to the concept of a dachshund and had a co-dominant position in the trademark.
- The average consumer of the goods in questions would rarely have the chance to compare the two marks when making their purchase decisions, and would have an imperfect recollection of the trademarks and their differences.

In light of the above, the General Court found the trademarks to be:

- visually similar to at least a low degree;
- phonetically not comparable, as the earlier mark was purely figurative; and
- conceptually similar to a high degree, considering that the earlier mark was the representation of a dachshund, while the mark applied for represented a dachshund named Gilbert.

In its reasoning, the court also provided an important clarification on the powers of the General Court after the applicant requested the court to hold that the mark applied for could be registered in respect of the goods at issue. The court rejected such claim, specifying that while it can alter the decisions of the Board of Appeal of the EUIPO, that power is intended to ensure that it adopts the decision that the Board of Appeal ought to have taken; the court does not have any power to take cognisance of the possibility to register a trademark.

The applicant also claimed that the Board of Appeal of the EUIPO had infringed the principles of equal treatment and legal certainty by issuing a decision that contrasted with previous decisions of the EUIPO in relation to marks representing animals in their figurative elements. The General Court rejected this plea, stating that the legality of the decisions of the EUIPO must be assessed on the sole basis of Regulation 2017/1001, without regard to the EUIPO's previous decision-making practice, considering that each case has unique factual circumstances.

Comment

This conclusion appears consistent with settled case law. In this regard, a further relevant circumstance shall also be considered: namely, the shift in the EUIPO's practice in the assessment of certain elements of trademarks (one example is the stricter and more rigorous assessment of the distinctiveness of trademarks in recent years), which may contribute, in certain circumstances, to render previous decision-making practice inapplicable.

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