

HUGO BOSS TRADEMARK MANAGEMENT GMBH & CO. KG. Opposer,  -versus-  OLIVER TAMAYO, Respondent-Applicant x-----x	} } } } } } } } } } } } } }	IPC No. 14-2007-0039 Opposition to:  Serial No. 4-2006-003469 Date filed: 28 March 2006 Trademark: "BOSE"  Decision No. 2009-24
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### DECISION

This pertains to the NOTICE OF OPPOSITION to the registration of the mark "BOSE" bearing Application Serial No. 4-2006-003469 filed on 28 March 2006, covering the goods jeans, slacks, shorts, socks and jogging pants falling under Class 25 of the International Classification of goods, which application was under Class 25 of the Intellectual Classification of goods, which application was published on the OFFICIAL Gazette, released for circulation on 20 July 2007.

The Opposer in the instant opposition is "HUGO BOSS TRADEMARK MANAGEMENT GMBH & CO KG", a corporation duly organized and existing under and by virtue of the laws of Germany, with business address at Dieselstrase 12, 72555 Metzingen, Germany.

Respondent-Applicant on the hands is Oliver Tamayo, with address at 568-A Lakandula Street, Tondo, Manila, Philippines.

The grounds of the opposition are as follows:

"1. The trademark BOSE being applied for by Respondent-Applicant is confusingly similar to Opposer's trademark BOSS, as to be likely, when applied to or used in connection with the goods of Respondent-Applicant, to cause confusion, mistake and deception on the purchasing public."

"2. The registration of the trademark BOSE in the name of Respondent-Applicant will violate Section 123.1, subparagraph (d) and (e) of Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines and section 6bis other provisions of the Paris Convention for the Protection of Industrial Property to which the Philippines and Germany are parties.

"3. The registration and use by Respondent-Applicant of the trademark BOSE will diminish the distinctiveness and dilute the goodwill of Opposer's trademark BOSS."

"4. The registration of the trademark bose in the name of Respondent-Applicant is contrary to other provisions of the Intellectual Property Code of the Philippines."

Opposer relied on the following facts to support its opposition:

1. Opposer is the owner of and/or registrant of and/or applicant in many trademark registrations and/or application of the trademark BOSS as well as other trademark containing the word BOSS namely HUGO BOSS and BOSS HUGO BOSS, around the world under International Class 25, more particularly for "suits, jackets, trousers, polo shirts, t-shirts, skirts, pullovers, coats, jogging suits, shirts, sweatshirts and blouses for men, women and children, sock and stockings, headgear; belts, scarves and shawls, accessories, namely head scarves; neck scarves, shoulder scarves, pocket kerchiefs; gloves, shoes" among other classes and goods.

2. In the Philippines, Opposer is the owner/registrant of the trademark BOSS, as follows:

- |    |                       |   |
|----|-----------------------|---|
| a) | Trademark             | : BOSS  |
|    | Cert. of Reg. No.     | : 57530   |
|    | Date Issued           | : 24 March 1994   |
|    | Registrant            | : Hugo Boss Trademark Management GmbH & Co. KG  |
|    | Goods                 | : suits, jackets, trousers, polo shirt, t-shirt, pullovers, coat, jogging suits, shirts, sweatshirts and blouses for men, women and children; socks and stockings, headgear; belt, scarves and shawls, accessories, namely head scarves; neck scarves, shoulder scarves, pocket kerchiefs; ties, gloves, shoes. |
| b) | Trademark Certificate | : BOSS  |
|    | Date Issued           | : 57838   |
|    | Registrant            | : 2 May 1994  |
|    |                       | : Hugo Boss Trademark Management GmbH & Co. KG  |
|    | Goods                 | : Leather goods, cases and bags, Umbrellas and parasols, belts made of Leather.   |
| c) | Trademark Certificate | : BOSS  |
|    | Date Issued           | : 58538   |
|    | Registrant            | : 23 June 1994  |
|    |                       | : Hugo Boss Trademark Management GmbH & Co. KG  |
|    | Goods                 | : Sun-glasses and parts thereof   |

3. In the Philippines, Opposer is also the owner/registrant of other trademark as follows:

- |    |                   |   |
|----|-------------------|---|
| a) | Trademark         | : HUGO BOSS   |
|    | Cert. of Reg. No. | : 57531   |
|    | Date Issued       | : 24 March 1994   |
|    | Registrant        | : Hugo Boss Trademark Management GmbH & Co. KG  |
|    | Goods             | : suits, jackets, trousers, polo shirt, t-shirt, pullovers, coat, jogging suits, shirts, sweatshirts and blouses for men, women and children; socks and stockings, headgear; belt, scarves and shawls, accessories, namely head scarves; neck scarves, shoulder scarves, pocket kerchiefs; ties, gloves, shoes. |
|    | Class             | : 25  |
| b) | Trademark         | : BOSS HUGO BOSS  |
|    | Cert. of Reg. No. | : 56884   |
|    | Date Issued       | : 24 March 1994   |
|    | Registrant        | : Hugo Boss Trademark Management GmbH & Co. KG  |

Goods	:	suits, jackets, trousers, polo shirt, t-shirt, pullovers, coat, jogging suits, shirts, sweatshirts and blouses for men, women and children; socks and stockings, headgear; belt, scarves and shawls, accessories, namely head scarves; neck scarves, shoulder scarves, pocket kerchiefs; ties, gloves, shoes.
Class	:	25
c) Trademark	:	BOSS HUGO BOSS
Cert. of Reg. No.	:	63703
Date Issued	:	24 September 1996
Registrant	:	Hugo Boss Trademark Management GmbH & Co. KG
Goods	:	Precious metals and their alloys as well as goods made thereof or coated therewith; jewelry; clocks and watches
Class	:	14

4. By virtue of Opposer's prior application and/or registration the trademark BOSS and other variations thereof in the Philippines and its prior application and/or registration and ownership of this trademark around the world, said trademark has therefore become distinctive of Opposer's goods and business.
5. By adopting the confusingly similar BOSE for exactly the same goods, i.e. t-shirts, polo, polo shirts, that Hugo Boss AG is internationally known for, it is obvious that Respondent-Applicant's intention is to "ride-on" the goodwill of Hugo Boss and pass off his goods as those of Hugo Boss AG.
6. A boundless choice of words, phrases and symbols are available to a person who wishes to have a trademark sufficient unto itself to distinguish his product from those Respondent-Applicant to choose the mark BOSE especially to include the word BOSS when the field for his selection was so broad. Respondent-Applicant obviously intends to trade and is trading on Opposer's goodwill.
7. The registration and use of the trademark BOSE by Respondent-Applicant will deceive and/or confuse purchasers into believing that Respondent-Applicant's goods and/or products bearing the trademark BOSE emanate from or are under the sponsorship of Opposer Hugo Boss Trademark Management GmbH & Co. kg, owner/registrant of the trademark BOSS and other variations of the mark containing the dominant word BOSS. This will therefore diminish the distinctiveness and dilute the goodwill of Opposer's trademark.
8. The allowance of Application Serial No. 4-2006-003469 in the name a Respondent-Applicant will be in violation of the treaty obligation of the Philippines under the Paris Convention for the Protection of Industrial Property, to which the Philippines and Germany are member-states.

On 21 August 2007, Opposer filed its Unverified Notice Opposition to the trademark BOSE. In the accordance with the rules of practice, Opposer was required to file the Verified Notice of Opposition within two (2) months from the filing of the Unverified Notice of Opposition, subject to an extension of another 30 days. Hence the deadline to file the same was 20 October 2007, subject to a thirty (30) days extension as long as the period does not exceed one hundred and twenty (20) days from the date of the publication of the mark.

On 19 October 2007, Opposer filed its Motion for Extension of Time to File Verified Notice of Opposition citing as reason that it is a foreign-based corporation and that it takes time to prepare the necessary documents and to have them authenticated and/or legalized. Opposer was granted a final extension of twenty seven (27) days or November 2007 within which to files its Verified Notice of Opposition in compliance with the requirements of Office Order No. 79, series of 2005 (Amendments of the Regulations on Inter Partes Proceedings).

On 14 November 2007, a Notice to Answer was sent to Respondent-Applicant through registered mail to file its Verified Answer within thirty (30) days from receipt thereof.

On 21 November 2007 Respondent-Applicant received the Notice to Answer and despite receipt of the same, the latter neither filed its Verified Answer nor any motion relative thereto. Thus, considering that no Answer has been filed, and that this case is mandatorily covered by the summary rules, this case is deemed submitted for decision, admitting the following pieces of documentary evidence submitted by the Opposer to wit:

Exhibits	Nature/Description of Document
"A" "A-11"	Affidavit-Testimony of the witness, Volker Herre
"A-11-a"	Signature of Opposer's witness, Volker Herre
"A-11-b"	Notarization and legalization of the Affidavit Testimony of the witness, Volker Herre
"B"	An outline of the history of the Hugo Boss Group
"C"	A copy of the Annual Report of Hugo Boss for the year 2006
"D"	A copy of the Annual Profile of Hugo Boss for the year 2006
"E"	Copy of German Certificate of Registration No. 962816 for the mark BOSS
"F"	Copy of the Certificate of Registration No. 57530 for the mark BOSS issued by the Intellectual Property Office of the Philippines
"G"	Copy of the Certificate of Registration No. 58538 for the mark BOSS issued by the Intellectual Property Office of the Philippines
"H"	Copy of the Certificate of Registration No. 57838 for the mark BOSS issued by the Intellectual Property Office of the Philippines
"I"	Copy of the Certificate of Registration No. 57531 for the mark HUGO BOSS issued by the Intellectual Property Office of the Philippines
"J"	Copy of the Certificate of Registration No. 56884 for the mark BOSS HUGO BOSS issued by the Intellectual Property Office of the Philippines
"K"	Copy of the Certificate of Registration No. 63703 for the mark BOSS HUGO BOSS issued by the Intellectual Property Office of the Philippines

“L”	Copy of the Certificate of Registration from countries around the world for the mark BOSS.
“M”	List of countries where products bearing the well-known mark BOSS are being sold.
“N”	Invoice No. 025024 issued by Hugo Boss AG to its Philippine distributor Igedo Fashions, Inc.
“O”	Copies of decisions rendered in favor of Hugo Boss AG in countries such as CHINA, Peru, Netherlands, Switzerland and Germany

The main issue presented to this Bureau for resolution is:

*Whether or not Respondent-Applicant’s “BOSE” mark is confusingly similar to Opposer’s mark “BOSS”, “HUGO BOSS” and “BOSS HUGO BOSS” in respect of eh classification of goods and of other relevant circumstances hence, not entitled to registration.*

Sec. 123.1 (d) and (e) of Republic Act No. 8293, as amended, provides:

“Sec. 123. Registrability. – 123.1. A mark cannot be registered if it:

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(d) is identical wit ha registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of:

- (i) the same goods or services, or
- (ii) closely related goods or services, or
- (iii) if it nearly resembles such a mark as to be likely to deceive or cause confusion

(e) is identical with, or confusingly similar to, or constitutes a translation of a mark which is considered by the competent authority of the Philippines to be well-known internationally and in the Philippines, whether or not it is registered here, as being already the mark of a person other than the application for registration, and used for identical or similar goods or services: Provided, That in determining whether a mark is well-known, accounts shall betaken of the knowledge of the relevant sector of the public, rather than of the public at large, including knowledge in the Philippines which has been obtained as a result of the promotion of the mark”

In order to arrive at a just and fair conclusion as to whether the contending marks are confusingly similar, both are reproduced below for comparison and scrutiny.

Pursuant to the aforequoted provision, the application for registration of the subject mark can not be allowed. Opposer’s marks “BOSS”, “HUGO BOSS” and “BOSS HUGO BOSS” has as its operative word “BOSS” which confusingly similar to Respondent-Applicant’s mark “BOSE”. Similarity, “BOSE” is applied to goods that are closely related to Respondent-Applicant’s goods under Class 25 to wit: jeans, slacks, shorts, sock and jogging pants. Opposer is the owner and prior use of the unabandoned marks “BOSS”, “HUGO BOSS” and “BOSS HUGO BOSS”, all bearing the distinctive and dominant mark “BOSS”.

In ascertaining whether one trademark is confusingly similar to or is a colorable imitation of another, jurisprudence has developed two kinds of test to wit: the dominance test and the holistic test.

In the case *Mighty Corporation vs. E.J. Gallo Winery* (G.R. No. 154342, July 14, 2004) the Supreme Court stated that:

"The dominance test focuses on the similarity of the prevalent features of the competing trademarks which might cause confusion or deception, and thus infringement. If the competing trademark contains the main, essential or dominant features of another, and confusion or deception is likely to result, infringement takes place. Duplication or imitation is not necessary; nor is it necessary that the infringing label should suggest an effort to imitate. The question is whether the use of the marks involved is likely to cause confusion or mistake in the mind of the public or deceive purchasers"

It is observed that the dominant feature of the Opposer's marks "BOSS", "HUGO BOSS", and "BOSS HUGO BOSS" is the word "BOSS" which is exactly the same with Respondent-Applicant's mark "BOSE" in appearance despite the substitution of the last letter of "BOSS" from an "S" to "BOSE" with an "E". "BOSE" and "BOSS" are also phonetically similar and because it covers similar goods if not the same goods that follows the same channel of trade, co-existence of the two marks is not possible and would likely cause confusion as to source or origin.

Respondent-Applicant is applying for the registration of the mark "BOSE" to be used for jeans, slacks, shorts, socks and jogging pants, while Opposer's mark "BOSS", "HUGO BOSS", and "BOSS HUGO BOSS" are registered for suits, jackets, trousers, polo shirts, t-shirts, skirts, pullovers, coats, jogging suits, shirts, sweatshirts and blouses for men, women and children; socks and stockings, headgear; belts, scarves and shawls, accessories, namely head scarves; neck scarves, shoulder scarves, pocket kerchiefs; gloves, shoes; which are essentially the same kind of apparel. A reading Opposer's and Respondent-Applicant's respective goods show that they are the same goods and it is clear that: 1) they the same or complementary purpose; and 2) it might be reasonably assumed that they originate from one manufacturer (*ESSO Standard Eastern, inc. v. Court of Appeals, et al.*, G.R. No. L-29971, August 31, 1982). Noteworthy is the fact that both are apparel worn and respondent-applicant is seeking registration for exactly the same kinds of goods, i.e. jeans, slacks, shorts, socks and jogging pants that the Opposer already registered for.

In trademark registration cases, the certificate of registration is prima facie evidence of the validity of the registration, the registrant's ownership of the mark and the exclusive right to use the same in connection with the goods or services and those that are related thereto specified in the certificate (*Levis Strauss & Co., vs. Clinton Apartelle, Inc.*, 470 SCRA, 253-254 (2005)). The records show that Opposer is the registrant of the marks "BOSS" as evidenced by Certificate of Registration No. 57530 issued on 24 March 1994 (Exhibit "F"), "HUGO BOSS", as evidenced by Certificate of Registration No. 57531 (Exhibit "I") issued on 24 March 1994 and "BOSS HUGO BOSS" as evidenced by Certificate of Registration No. 56884 issued on 24 March 1994 (Exhibit "J") all issued by this Office. As such Opposer as owner of the mark is entitled to protection. Respondent-Applicant was given ample opportunity to rebut this prima facie presumption but failed to file a Verified Answer within the period provided for under the rules.

Pursuant to the foregoing discussion, the application for registration of the subject mark cannot be allowed: Respondent-Applicant's mark "BOSE" is confusingly similar to Opposer's registered marks "BOSS", "HUGO BOSS" and "BOSS HUGO BOSS", which are applied to goods that are the same, with the Opposer enjoying prior registration to wit: 24 March 1994 both "HUGO BOSS" and "BOSS HUGO BOSS". To repeat, Opposer has already registered marks which Respondent-Applicant's mark nearly resembles as to likely deceive or cause confusion, and which are applied to goods that are the same.

WHEREFORE, premises considered the Notice of Opposition is, as it is, hereby SUSTAINED. Consequently, Application bearing Serial No. 4-2006-003469 filed by Oliver Tamayo on 28 March 2006, for the registration of the mark "BOSE" covering the goods jeans, slack, shorts, socks and jogging pants is hereby REJECTED.

Let the file wrapper of "BOSE", subject matter of this case together with copy of this Decision be forwarded to the Bureau of Trademarks (BTO) for appropriate action.

SO ORDERED.

Makati City, 09 February 2009.

ESTRELLITA BELTRAN-ABELARDO  
Director, Bureau of Legal Affairs  
Intellectual Property Office