



OFFICE OF THE DIRECTOR GENERAL

**BRANDBOSS ADVERTISING SERVICE CORPORATION.,**

*Appellant,*

-versus-

**HUGO BOSS TRADE MARK MANAGEMENT GMBH & CO. KG,**

*Appellee.*

Appeal No. 14-2012-0070

IPC No. 14-2010-00264

Opposition To:  
Application No. 4-2009-002490  
Date Filed: 10 March 2009

Trademark: "BRANDBOSS & Design"

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**DECISION**

**BRANDBOSS ADVERTISING SERVICE CORPORATION** ("Appellant"), appeals Decision No. 2012-218, dated 30 October 2012, issued by the Director of the Bureau of Legal Affairs ("Director"), granting the Notice of Opposition filed by **HUGO BOSS TRADEMARK MANAGEMENT GMBH & CO. KG** ("Appellee") on 5 October 2010 against the application filed by the Appellant for the mark "BRANDBOSS & DESIGN", under Trademark Application No. 4-2009-002490. The said application, filed by the Appellant, covers the mark "BRANDBOSS & DESIGN" for use on "advertising services", under class 35 of the International Classification of Goods and Services.

On 5 October 2010, the Appellee filed a Notice of Opposition over the subject application, essentially alleging that the Appellant's mark is confusingly similar to its trademarks "BOSS", "HUGO BOSS", and "BOSS HUGO BOSS", as well as to its various trademarks containing the word "BOSS".

In its Verified Answer, the Appellant disputed the material allegations of the opposition contending that "BRANDBOSS" is not confusingly similar with the Appellee's marks. They allege that the mark does not cause deception or mistake in the minds of the consumers nor dilute the alleged goodwill of the Appellee in the commercial market.

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After the appropriate proceedings, the Director rendered the subject Decision granting the Appellee's Notice of Opposition. In the Decision, the Director noted that at the time the Appellant filed its trademark application on 10 March 2009, the Appellee already had an existing trademark registration for "BOSS HUGO BOSS" under Trademark Registration No. 062888, issued on 21 May 1996, covering "advertising, business management, and business administration" under Class 35. The Director likewise found that the resemblance between the marks is likely to cause confusion considering that they are used for the same services under class 35. Also, the Director noted that the addition of the word "BRAND" in the Appellant's mark does not diminish the likelihood of confusion, in that the feature of part of both marks which immediately draws the eyes and ears is the word "BOSS". When the marks are pronounced, it is in this particular component that one's attention and first impression is focused on and directed.

Dissatisfied with the Decision, the Appellant appeals the same with this Office. The Appellant, in its Memorandum of Appeal filed on 19 July 2013, essentially alleges that the Director erred in ruling that the trademark "BRANDBOSS" resembles that of "HUGO BOSS", that such resemblance is likely to cause confusion on the part of the buying public, and that the Director seriously erred in ruling that the trademark "BRANDBOSS" is proscribed by Sec. 123.1 (d) of the IP Code.

Proceeding to the main issue of the present appeal, the question to be resolved is whether the Director was correct in granting the Notice of Opposition filed by the Appellee against the Appellant's trademark application over the mark "BRANDBOSS & DESIGN".

The competing marks are illustrated below for comparison:



The Appellee in its Memorandum invokes Section 123.1 (d) of R.A. 8293 to wit;

*Section 123.Registrability – 123.1. A mark cannot be registered if it:*

XXXXXXXXXX

*(d) Is identical with a 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.*

There is no dispute that the Appellee had registered in the Philippines the mark "BOSS HUGO BOSS" prior to the filing of the Appellant's trademark application. Such trademarks were registered for services under Class 35, among others, namely "advertising, business management, business administration". The only issue herein is whether the Appellant's mark being applied for is confusingly similar with the Appellee's registered marks.

Applying the foregoing to the present case, this Office notes that the competing marks involved are exactly the same or identical when pronounced, with respect to the word "BOSS", which is the dominant feature of both marks. This Office agrees with the Director in that since both marks covers services under Class 35, the services therein are related and competing, there is a likelihood of confusion between the two marks that would cause deception to the public.

Likewise, the Director correctly noted that when two marks are confusingly similar, the consumers will have the impression that the goods or services covered by these marks originated from a single source or origin, or assume that one mark is just a variation of the other and there is a connection or association between the two marks and/or between the contending parties themselves, when in fact there is none. The likelihood of confusion therefore, would subsist not only on the purchaser's perception of goods but on the origin thereof as held by the Supreme Court, in *Converse Rubber Corporation v. Universal Rubber Products, Inc. et. al.* (G.R. No. L-27906 8 January 1987).

Finding that the registration of Appellant's trademark is proscribed by Sec. 123.1 (d) of the IP Code, this Office finds no cogent reason to disturb Decision No. 2012-218 rendered by the Director of the Bureau of Legal Affairs.

**WHEREFORE**, premises considered, the appeal is hereby **DISMISSED**. Let a copy of this Decision and the records of this case be furnished and returned to the Director of the Bureau of Legal Affairs for appropriate action. Further, let also the Director of the Bureau of Trademarks and the library of the Documentation, Information and Technology Transfer Bureau be furnished a copy of this Decision for information, guidance, and records purposes.

SO ORDERED.

**DEC 16 2013** Taguig City.

  
**RICARDO R. BLANCAFLOR**  
Director General