



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

-versus-

BRANDBOSS ADVERTISING  
SERVICE CORPORATION,  
Respondent-Applicant.

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}  
} IPC No. 14-2010-00264  
} Opposition to:  
} Appln. Serial No. 4-2009-002490  
} Date filed: 10 March 2009  
} TM: "BRANDBOSS & DESIGN"  
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### NOTICE OF DECISION

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#### GREETINGS:

Please be informed that Decision No. 2012 - 218 dated October 30, 2012 ( copy enclosed) was promulgated in the above entitled case.

Taguig City, October 30, 2012.

For the Director:

**Atty. PAUSTI U. SAPAK**  
Hearing Officer  
Bureau of Legal Affairs



HUGO BOSS TRADEMARK  
MANAGEMENT GMBH & CO. KG.,  
*Opposer,*

IPC No. 14-2010-00264  
Opposition to:

- versus -

Appln. Serial No. 4-2009-002490  
(Filing Date: 10 March 2009)  
Trademark: "BRANDBOSS & DESIGN"

BRANDBOSS ADVERTISING  
SERVICES CORPORATION,  
*Respondent-Applicant.*

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Decision No. 2012 - 218

## DECISION

HUGO BOSS TRADEMARK MANAGEMENT GMBH & CO. KG. ("Opposer") filed on 05 October 2010 an opposition to Trademark Application Serial No. 4-2009-002490. The application, filed by BRANDBOSS ADVERTISING SERVICES CORPORATION ("Respondent-Applicant"), covers the mark "BRANDBOSS & DESIGN" for use on "advertising services" under class 35 of the International Classification of goods.<sup>3</sup>

The Opposer alleges that the Respondent-Applicant's mark is confusingly similar to its trademarks BOSS and HUGO BOSS and BOSS HUGO BOSS, as well as to its various registered trademarks containing the dominant word BOSS. To support its opposition, the Opposer submitted as evidence the following:

1. advertisements in the Philippine media;
2. sales Invoices for products bearing the mark BOSS, HUGO BOSS, BOSS HUGO BOSS and HUGO HUGO BOSS;
3. certificates of International Registration for the mark BOSS issued by the World Intellectual Property Organization;
4. certificates of registration for the mark BOSS in: U.S. (Reg. Nos. 1,023,305 and 2,429,018), Thailand (Reg. No. Kor108576), Trinidad and Tobago (Reg. No. 25608), Turkey (Reg. No. 099252), Taiwan (Reg. No. 279,546), South Korea (Reg. No. 93547), Kingdom of Swaziland (Reg. No. 501/97), United Arab Emirates (Reg. No. 31072), Egypt (Reg. No. 5928), Cyprus, India (Reg. No. 493925), Indonesia (Reg. No. 449710), Hong Kong (Reg. No. 678 of 1989), U.K. (Reg. Nos. 1198783 and 1198781), Ecuador (Reg. No. 1847), Estonia (Reg. No. 14937), Finland (Reg. No. 86157), France (Reg. No. 1 414 947), Ghana (Reg. No. 28,072), Georgian (Reg. No. 4102);
5. advertisements in major media markets around the world;
6. brochures/fashion catalogues of Hugo Boss AG's products;
7. list of countries worldwide where Hugo Boss AG's products are exported;
8. Decisions of the Chinese Trademark Office in Case No. 2000 TMO 2467 (01 Feb. 2001), Chinese Trademark Office in Case No. 2003 TMOP No. 00700 (09 Apr. 2003), Amsterdam District Court in Netherlands (28 Oct. 1998), Commercial Court of the Canton of Bern in Switzerland (22 Jan. 1999), National Bureau of Standards Ministry of Economic

1 A corporation duly organized and existing under and by virtue of the laws of Germany, with business address at Dieselstrasse 12, 72555 Metzingen, Germany.  
2 With address at Stall #5, Marian Commercial Complex, FTI Complex, Taguig City.  
3 The Nice Classification is a classification of goods and services for the purpose of registering trademark and service marks, based on the multilateral treaty administered by the World Intellectual Property Organization. The treaty is called the Nice Agreement concerning the International Classification of Goods and Services for the purpose of the Registration of Marks concluded in 1957.

- Affairs in Taiwan (13 May 1991);
9. extract from the Commercial Register showing that Mr. Volker Herre as the Managing Director of the Opposer is authorized to sign the Verified Notice of Opposition and Affidavit-Testimony;
  10. duly signed, notarized and legalized Affidavit-Testimony of Volker Herre;
  11. Company Profile of Hugo Boss for the year 2010; and
  12. Annual Report of Hugo Boss for the year 2009.<sup>4</sup>

The Respondent-Applicant filed on 24 May 2011 its Verified Answer disputing the material allegations of the opposition, contending that BRANDBOSS is not confusingly similar with the Opposer's marks. According to the Respondent-Applicant, the mark does not cause deception or mistake in the minds of the consumers nor dilute the alleged goodwill of the Opposer in the commercial market. Its evidence consists of its response to Paper No. 4 issued by the Trademark Examiner, dated 26 March 2010, and the consolidated Director's Certificate and Special Power of Attorney.<sup>5</sup>

Subsequently, the Opposer filed a REPLY on 03 June 2011. Then after, the instant case was referred to mediation pursuant to Office Order No. 154, s. 2010<sup>6</sup>. However, the parties failed to reach an amicable settlement. Accordingly, the preliminary conference was conducted and terminated on 26 January 2012. The parties filed their respective position papers on 06 February 2012.

It is emphasized that the essence of trademark registration is to give protection to the owners of trademarks. The function of a trademark is to point out distinctly the origin or ownership of the goods to which it is affixed; to secure to him who has been instrumental in bringing into the market a superior article of merchandise, the fruit of his industry and skill; to assure the public that they are procuring the genuine article; to prevent fraud and imposition; and to protect the manufacturer against substitution and sale of an inferior and different article as his product.<sup>7</sup> Thus, Sec. 123.1 (d) of the IP Code provides that a mark cannot be registered if its is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of the same goods or services or closely related goods or services or if it nearly resembles such a mark as to be likely to deceive or cause confusion.

Records show that at the time the Respondent-Applicant filed its trademark application on 10 March 2009, the Opposer already has an existing trademark registration for BOSS HUGO BOSS under Reg. No. 062888 issued on 21 May 1996. The Opposer's trademark registration covers "*advertising, business management, business administration*" under class 35. "*Advertising*" under class 35 is also the service indicated in the Respondent-Applicants' trademark application.

The question now is: Are the competing trademarks, as shown below, resemble each other such that confusion, or even deception, is likely to occur?



*Opposer's mark*



*Respondent-Applicant's mark*

<sup>4</sup> Marked as Exhibits "A" to "II", inclusive.

<sup>5</sup> Marked as Annexes "1" and "2", inclusive.

<sup>6</sup> Rules of Procedure for IPO Mediation Proceedings.

<sup>7</sup> *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114508, 19 Nov. 1999.

The resemblance between the marks is likely to cause confusion considering that they are used for the same or similar services (advertising) under class 35. The word "BRAND" in the Respondent-Applicant's mark does not diminish the likelihood of confusion. The feature or part, which is common to the competing marks and which immediately draws the eyes and ears is the word "BOSS". It is the feature that gives these marks the distinctive character of a trademark or services mark. When the marks are pronounced, it is in this particular component that one's attention and first impression is focused on and directed.

It is stressed that the determinative factor in a contest involving trademark registration is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of such mark will likely cause confusion or mistake on the part of the buying public. To constitute an infringement of an existing trademark, patent and warrant a denial of an application for registration, the law does not require that the competing trademarks must be so identical as to produce actual error or mistake; it would be sufficient, for purposes of the law, that the similarity between the two labels is such that there is a possibility or likelihood of the purchaser of the older brand mistaking the newer brand for it.<sup>8</sup>

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.<sup>9</sup>



Callman notes two types of confusion. The first is the confusion of goods in which event the ordinarily prudent purchaser would be induced to purchase one product in the belief that he was purchasing the other. In which case, defendant's goods are then bought as the plaintiff's and the poorer quality of the former reflects adversely on the plaintiff's reputation. The other is the confusion of business. Here, though the goods of the parties are different, the defendant's product is such as might reasonably be assumed to originate with the plaintiff and the public would then be deceived either into that belief or into belief that there is some connection between the plaintiff and defendant which, in fact does not exist.

Accordingly, this Bureau finds and concludes that the Respondent-Applicant's trademark application is proscribed by Sec. 123.1 (d) of the IP Code.

**WHEREFORE**, premises considered, the opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2009-002490 together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 30 October 2012.

  
**ATTY. NATHANIEL S. AREVALO**  
Director IV, Bureau of Legal Affairs  


<sup>8</sup> *American Wire and Cable Co. v. Director of Patents et al.*, (31 SCRA 544) G.R. No. L-26557, 18 Feb. 1970.

<sup>9</sup> *Converse Rubber Corporation v. Universal Rubber Products, Inc. et. al.*, G.R. No. L-27906, 08 Jan. 1987.