



HUGO BOSS TRADEMARK MANAGEMENT	}	IPC No. 14-2012-00084
GMBH & CO. KG.,	}	Opposition to:
<i>Opposer,</i>	}	
	}	Appln. Serial No. 4-2011-006782
-versus-	}	Date Filed: 10 June 2011
	}	
EDISON CHENG,	}	TM: BOSSY
<i>Respondent-Applicant.</i>	}	
x-----x		Decision No. 2014- <u>47</u>

DECISION

HUGO BOSS TRADEMARK MANAGEMENT GMBH & CO. KG, ("Opposer")¹ filed an opposition to Trademark Application Serial No. 4-2011-006782. The application, filed by EDISON CHENG ("Respondent-Applicant")², covers the mark "BOSSY" for "spray cologne, hair shampoo, perfume, soaps, splash cologne" under Class 3 of the International Classification of Goods and Services³.

The Opposer anchors its opposition on the ground that the registration of the mark "BOSSY" in favor of the Respondent-Applicant is contrary to the provisions of Sections 123.1 (d), (e) and (f) of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code") which prohibit the registration of a mark that:

- (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;

- (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 applicant for registration, and used for identical or similar goods or services: Provided, That in determining whether a mark is well-known,

¹ Corporation organized under the laws of Germany and having its principal place of business at Dieselstrasse 12, D-72555 Metzingen, Germany.

² With address at 122 Old Samson Road, Balintawak, Quezon City.

³ The Nice Classification is a classification of goods and services for the purpose of registering trademark and services 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.

account shall be taken of the knowledge of the relevant sector of the public at large, including knowledge in the Philippines which has been obtained as a result of the promotion of the mark.

- (f) is identical with, or confusingly similar to, or constitutes a translation of a mark considered well-known in accordance with the preceding paragraph, which is registered in the Philippines with respect to goods or services which are not similar to those with respect to which registration is applied for: Provided, That use of the mark in relation to those goods or services would indicate a connection between those goods or services, and the owner of the registered mark: Provided further, That the interests of the owner of the registered mark are likely to be damaged by such use.

To support its opposition, the Opposer submitted in evidence the following:

1. Exhibit "A" – Original notarized Verified Notice of Opposition;
2. Exhibit "B" – Scanned copy of the Certificate and Special Power of Attorney executed by Mr. Volker Herre regarding the authority of Atty. Laxmi J. Rosell to verify the notice of opposition and execute the certificate of non-forum shopping and the authority of Quisumbing Torres to represent Opposer in these proceedings, the original authenticated copy of which will be submitted immediately upon receipt thereof by undersigned counsel;
3. Exhibits "C" to "C-6" – Scanned copy of the Affidavit executed by Mr. Volker Herre, the original authenticated copy of which will be submitted immediately upon the receipt thereof by undersigned counsel;
4. Exhibit "D" – Trademark Registration No. 4-1996-111064 issued by the Philippine Intellectual Property Office on 08 May 2001 for BOSS in Class 3;
5. Exhibit "E" – Trademark Registration No. 4-1996-111065 issued by the Philippine Intellectual Property Office on 08 May 2001 for BOSS in Class 3;
6. Exhibit "F" – Trademark Registration No. 4-1996-108678 issued by the Philippine Intellectual Property Office on 16 April 2004 for BOSS in Class 3;
7. Exhibit "G" – Trademark Registration No. 4-2002-008306 issued by the Philippine Intellectual Property Office on 01 July 2005 for BOSS IN MOTION in Class 3;
8. Exhibit "H" – Trademark Registration No. 4-2003-004689 issued by the Philippine Intellectual Property Office on 02 October 2006 for BOSS INTENSE in Class 3;
9. Exhibit "I" – Trademark Registration No. 064768 issued by the Philippine Intellectual Property Office on 25 June 1997 for HUGO HUGO BOSS in Class 3;
10. Exhibit "J" – Trademark Registration No. 058538 issued by the Philippine Intellectual Property Office on 23 June 1994 for BOSS in Class 9;
11. Exhibit "K" – Trademark Registration No. 061207 issued by the Philippine Intellectual Property Office on 18 July 1995 for BOSS HUGO BOSS in Class 9;

12. Exhibit "L" – Trademark Registration No. 063703 issued by the Philippine Intellectual Property Office on 24 September 1996 for BOSS HUGO BOSS in Class 14;
13. Exhibit "M" – Trademark Registration No. 057838 issued by the Philippine Intellectual Property Office on 02 May 1994 for BOSS in Class 18;
14. Exhibit "N" – Trademark Registration No. 057530 issued by the Philippine Intellectual Property Office on 24 March 1994 for BOSS in Class 25;
15. Exhibit "O" – Trademark Registration No. 057531 issued by the Philippine Intellectual Property Office on 24 March 1994 for HUGO BOSS in Class 25;
16. Exhibit "P" – Trademark Registration No. 056884 issued by the Philippine Intellectual Property Office on 26 January 1994 for BOSS HUGO BOSS in Class 25; and
17. Exhibit "Q" – Trademark Registration No. 4-2011-002893 issued by the Philippine Intellectual Property Office on 27 October 2011 for BOSS HUGO BOSS in Class 9, 27 and 35.

On 25 June 2012, the Respondent-Applicant filed his verified answer admitting some of the allegations while denying all the material allegations of the opposition. He alleges that he filed in good faith Trademark Application Serial No. 4-2011-006782. According to him, his trademark application is not proscribed by Section 123.1 (d) of the IP Code and "BOSS" is neither identical nor confusingly similar to the Opposer's BOSS trademarks.

The Respondent-Applicant submitted in evidence the following in support of his trademark application:

1. Exhibit "1" – Copy of Application SN 4-2011-006782 filed on 10 June 2011 for the registration of the mark "BOSS" for use on spray cologne, hair shampoo, perfume, soaps, splash cologne falling under Class 3;
2. Exhibit "2" – Copy of the Registrability Report marked as Paper No. 2 and bearing mailing date of 17 August 2011;
3. Exhibit "3" – Copy of the response dated 17 October 2011 to the Registrability Report;
4. Exhibit "4" – Copy of the Notice of Allowance bearing mailing date of 14 December 2011;
5. Exhibit "5" – Printout of Respondent-Applicant's mark "BOSS" as published in the e-Gazette last 24 January 2012; and
6. Exhibit "6" – Duly notarized affidavit of Respondent-Applicant EDISON CHENG.

Should the Respondent-Applicant's trademark application be allowed?

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 of his product⁴.

⁴ Mirpuri v. Court of Appeals, G.R. No. 114508, 19 November 1999.

Thus, Sec. 123.1 (d) of the IP Code provides that a mark cannot be registered if it 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 clearly 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 his trademark application on 10 June 2011, the Opposer already has existing registrations in the Philippines, to wit: (1) Reg. No. 4-1996-111064 issued on 08 May 2001 for deodorant for personal use under Class 3 of the International Classification of Goods and Services⁵, (2) Certificate of Registration No. 4-1996-11065 issued on 08 May 2001 for cosmetic, hair care products and skin care products namely, eau de toilette, after shave lotion, cream, gels and balm, bath and shower gel, anti-perspirant and deodorant for personal use, moisturizer for the face and body, shampoos, conditioners, hair lotions, hair gels, creams and mousses, soap, dentifrices under Class 3⁶, and (3) Certificate of Registration No. 4-1996-108678 issued on 16 April 2004 for goods falling under Class 3⁷.

But, are the competing marks depicted below, confusingly similar?

BOSS

Opposer's Mark

BOSSY

Respondent-Applicant's Mark

Jurisprudence says that a practical approach to the problem of similarity or dissimilarity is to go into the whole of the two trademarks pictured in their manner of display. Inspection should be undertaken from the viewpoint of the prospective buyer. The trademark complained should be compared and contrasted with the purchaser's memory of the trademark said to be infringed. Some factors such as sound; appearance; form, style, shape, size or format; color, idea connoted by the mark; the meaning, spelling and pronunciation of the words used; and the setting in which the words used, may be considered for indeed, trademark infringement is a form of unfair competition⁸.

Another factor in ascertaining whether or not marks are confusingly similar to each other is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of such mark would likely cause confusion or mistake on the part of the buying public. 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 new brand for it⁹.

In this regard, this Bureau finds that the competing marks are confusingly similar. Four (4) out of five (5) letters in the Respondent-Applicant's mark are identical and/or exactly the same with the Opposer's registered mark BOSS. The only difference between the two is the

⁵ Exhibit "D".

⁶ Exhibit "E".

⁷ Exhibit "F".

⁸ Clarke v. Manila Candy Co. 36 Phil 100, 106, Co Tiong SA v. Director of Patents as Phil. 1, 4.

⁹ Converse Rubber Corporation v. Universal Rubber Products, Inc., G.R. No. L-27906, 08 Jan. 1987.

letter "Y" merely added as the last letter in the Respondent-Applicant's mark. The entire mark of Opposer has been taken or incorporated in the Respondent-Applicant's mark. In this regard, it is stressed that confusion cannot be avoided by merely adding, removing or changing some letters of a registered mark. The slight variance is inconsequential because it did not diminish the likelihood of the occurrence of mistake, confusion or even deception cannot be avoided. Consumers will likely assume that the Respondent-Applicant's mark is just a variation of or related to the Opposer's and/or the goods and services originate from the same source while in fact it is not. The likelihood of confusion would subsist not only on the purchaser's perception of the goods but on the origins thereof.

The field from which a person may select a trademark is practically unlimited. As in all cases of colorable imitation, the unanswered riddle is why, of the millions of terms and combination of letters are available, the Respondent-Applicant had come up with a mark identical or so closely similar to take advantage of the goodwill generated by the other mark¹⁰.


It is stressed that the law on trademarks and tradenames is based on the principle of business integrity and common justice. This law, both in letter and spirit is laid upon the premise that, while it encourages fair trade in energy way and aims to foster, and not to hamper competition, no one especially a trader, is justified in damaging or jeopardizing others business by fraud, deceit, trickery or unfair methods of any sort. This necessarily precludes the trading by one dealer upon the good name and reputation built by another¹¹.

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

WHEREFORE, premises considered the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2011-006782 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 18 February 2014.


Atty. NATHANIEL S. AREVALO
Director IV, Bureau of Legal Affairs

¹⁰ American Wire and Cable Co. v. Director of Patents et.al. SCRA 544, G.R. N. L-26557, 18 Feb. 1970.

¹¹ La Chemise Lacoste v. Judge Oscar C. Fernandez, et.al. G.R. No. L-63796-97, 02 May 1984.