



OFFICE OF THE DIRECTOR GENERAL

EDISON CHENG,
Respondent-Appellant,

-versus-

HUGO BOSS TRADEMARK
MANAGEMENT GMBH & CO.
KG.,
Opposer-Appellee.

x-----x

Appeal No. 14-2014-0013

IPC No. 14-2012-00084

Opposition to:

Application No. 4-2011-006782

Date Filed: 10 June 2011

Trademark: BOSSY

DECISION

EDISON CHENG (“Appellant”) appeals the decision¹ of the Director of Bureau of Legal Affairs (“Director”) sustaining the opposition to the registration of the mark “BOSSY”.

On 10 June 2011, the Appellant filed Trademark Application No. 4-2011-006782 for BOSSY for use on spray cologne, hair shampoo, perfume, soaps, and splash cologne. On 24 January 2012, the trademark application was published in the Intellectual Property Office Electronics Gazette for Trademarks. Subsequently, HUGO BOSS TRADEMARK MANAGEMENT GMBH & CO. KG. (“Appellee”) filed a “NOTICE OF OPPOSITION” dated 23 April 2012 alleging that it will be damaged by the registration of BOSSY.

The Appellee claimed that it is the owner of and has exclusive rights over the “BOSS” trademarks registered in the Intellectual Property Office and used on several classes of goods and services including the class of goods covered by BOSSY. The Appellee maintained that BOSSY is confusingly similar to BOSS as to be likely to deceive or cause confusion in the minds of the relevant sector of the purchasing public. According to the Appellee, the Appellant’s use of BOSSY on goods similar and directly competing with its goods will take unfair advantage of, dilute the goodwill, and diminish the distinctive character or reputation of the BOSS trademarks. The Appellee asserted that its BOSS marks are well-known and world-famous which cover an extensive product range consisting of classic-modern business wear, elegant evening and relaxed casual fashion, shoes and leather accessories, licensed fragrances, eyewear, watches, children’s fashion and motorcycle helmets.

On 25 June 2012, the Appellant submitted an “ANSWER” claiming that he filed his trademark application in good faith and that the Bureau of Trademarks has

¹ Decision No. 2014-47 dated 18 February 2014.

determined that his application complies with the requirements for registration of a mark. The Appellant maintained that BOSSY is neither identical nor confusingly similar to the BOSS trademarks and that a side-by-side comparison of the reproduction of these marks will show the visual and aural differences between them. The Appellant averred that these marks have their respective different derivation, meaning, connotation, and commercial impression. The Appellant asserted that "HUGO BOSS" is a proper noun, being the name of the Appellee's founder while BOSSY is a word found in all dictionaries. According to the Appellant, BOSSY as a noun means "cow" or "calf" while as an adjective, BOSSY means inclined to domineer or dictatorial. The Appellant contended that the Appellee failed to submit competent and substantial evidence to show that the BOSS trademarks are well-known internationally and in the Philippines.

On 18 February 2014, the Director issued the decision which sustained the Appellee's opposition to the registration of BOSSY in favor of the Appellant. The Director held that BOSSY is confusingly similar to BOSS as their only difference is the letter "Y". The Director stated that consumers will likely assume that the Appellant's mark is just a variation of the Appellee's mark and that the purchasers of the goods and services covered by these marks may consider them as originating from the same source.

On 08 April 2014, the Appellant filed an "APPEAL MEMORANDUM" contending that his trademark application is not proscribed by the provisions of the Intellectual Property Code of the Philippines ("IP Code"). The Appellant reiterates his arguments that BOSSY is neither identical nor confusingly similar to BOSS and that his mark is capable of distinguishing his goods.

The Appellee filed its comments² on the appeal maintaining that BOSSY is confusingly similar to BOSS and that the Appellant's attempt to register BOSSY is an attempt to usurp the internationally well-known mark BOSS.

On 17 June 2014, this case was referred to the IPOPHL Alternative Dispute Resolution (ADR) Services pursuant to Office Order No. 154, Series of 2010, Rules of Procedure for IPO Mediation Proceedings. Subsequently, on 10 July 2014, this Office received a notice from the IPOPHL ADR Services that that parties refused to undergo the mediation proceedings.

The main issue in this appeal is whether the Director was correct in sustaining the opposition to the registration of the mark BOSSY.

Sec. 123.1(d) of the IP Code, states that a mark cannot be registered if it:

(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

² COMMENTS AND OPPOSITION TO APPEAL dated 28 May 2014.

- (ii) Closely related goods or services, or
- (iii) If it nearly resembles such a mark as to be likely to deceive or cause confusion;

In this case, it is not disputed that the Appellee is the owner of the registered mark BOSS that covers the class of goods similar to those covered by the Appellant's mark such as perfume and cologne. Accordingly, the relevant question in this case is whether BOSSY is confusingly similar to BOSS.

Below are the illustrations of the Appellant's and Appellee's marks:

BOSSY

Appellant's mark

BOSS

Appellee's mark

The similarity of these marks is very obvious. At a glance, one can see that they both contain the term "BOSS". Considering that these marks cover similar class of goods, confusion is very likely. As correctly discussed by the Director in his decision:

Four (4) out of five (5) letters in the Respondent-Applicant's [Appellant] mark are identical and/or exactly the same with the Opposer's [Appellee] registered mark BOSS. The only difference between the two is the 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 form 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 mark.³

Accordingly, to allow the Appellant to register BOSSY would go against the very rationale for trademark registration. 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.⁴

The Appellee has shown its ownership and use of the BOSS trademarks. As the Appellee has no control on the Appellant's use of BOSSY, the registration of this mark creates confusion, negates the right of the Appellee to exclude other persons from using similar marks in related goods and services, and undermines the reputation that the Appellee has achieved in its prior use of BOSS in its business activities.

Wherefore, premises considered, the appeal is hereby dismissed. Let a copy of this Decision be furnished to the Director of Bureau of Legal Affairs and the Director of Bureau of Trademarks for their appropriate action and information. Further, let a copy of this Decision be furnished to the library of the Documentation, Information and Technology Transfer Bureau for records purposes.

SO ORDERED.

NOV 25 2014 , Taguig City.


RICARDO R. BLANCAFLOR
Director General

³ Decision No. 2014-47 dated 18 February 2014, page 5.

⁴ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.