

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

-versus-

JING YANG DING,
Respondent-Applicant.

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} **IPC No. 14-2011-00547**
} Opposition to:
} Appln. Serial No. 4-2011-009851
} Date filed: 18 August 2011
} **TM: "RICHBOSS"**

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2015 - 272 dated December 03, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, December 03, 2015.

For the Director:

Edwin O. Datin
Atty. EDWIN DANILO A. DATIN
Director III
Bureau of Legal Affairs

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Opposition to Trademark
Application No. 4-2011-009851
Date Filed: 18 August 2011
Trademark: "**RICHBOS**"

x ----- x Decision No. 2015- 272

DECISION

Hugo Boss Trademark Management GmbH & Co. Kg.¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2011-009851. The contested application, filed by Jin Yang Ding² ("Respondent-Applicant"), covers the mark "RICHBOS" for use on "*shoes, sandals, jeans, pants, t-shirts, polo shirts, shorts, skirts, blouse*" under Class 25 of the International Classification of Goods³.

The Opposer anchors its opposition on Section 123, paragraphs (d), (e) and (f), of R.A. No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code")⁴. It claims to own several registrations of the trademark "BOSS" for various classes. In the Philippines, it registered the said mark as early as 1994. It avers that it has caused the extensive promotion, advertising, sale and

¹ A corporation organized and existing under the laws of Germany, with principal office at Dieselstrasse 12, 72555 Metzingen, Germany.

² An individual with address at 115 Mauban Street, Brgy. Manresa, Quezon City, Philippines.

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.

⁴123.1. A mark cannot be registered if it: xxx

(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, account shall be taken 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;

(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; xxx.

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marketing of its products bearing the mark. According to the Opposer, the marks "BOSS" and "RICHBOS" are confusingly similar as they cover related goods and for the following reasons:⁵

- a. The last letters B-O-S-S in respondent-applicant's mark are identical and in the same sequence as the letters in opposer's registered an well-known mark BOSS and other marks containing the dominant word BOSS.
- b. Because of the identity of the letters B-O-S-S in respondent-applicant's mark and in opposer's marks, the appearance of the marks are almost the same.
- c. Because of the presence of the word Boss in respondent-applicant's mark and in opposer's marks, the marks have similar sound and pronunciation.
- d. The two (2) marks are therefore practically identical and confusingly similar with each other. The potential confusion is very real.
- e. Respondent-applicant's mark and opposer's marks are pure word marks in plain letterings and not stylized. Neither is in color nor is compounded with a unique device or design. Hence, the similarity between the marks is even more pronounced or enhanced."

In support of its Opposition, the Opposer submitted the following:

1. various advertisements of its marks in Philippine media;
2. sales invoices for products bearing the mark "BOSS";
3. certificates of registrations for the mark "BOSS" issued by the World Intellectual Property Office (WIPO), United States of America (USA), Thailand, Republic of Trinidad and Tobago, Turkey, Taiwan, South Korea, Kingdom of Swaziland, United Arab Emirates (UAE), Egypt, Cyprus, India, Indonesia, Hong Kong, United Kingdom, Ecuador, Estonia, Finland, France, Ghana and Georgia;
4. advertisements of its marks in major media markets around the world;
5. brochures/fashion catalogues of Hugo Boss AG's products;
6. list of countries where Hugo Boss AG's products are exported;
7. decisions of Chinese Trademark Office in Case Nos. 2000 TMO 2467 and 2003 TMOP No. 00700 dated 01 February 2001 and 09 April 2003, respectively;
8. decision of Amsterdam District Court in Netherlands dated 29 October 1998;
9. decision of the Commercial Court of Canton in Bern in Switzerland dated 22 January 1999;
10. decision of the National Bureau of Standards of Ministry of Economic Affairs in Taiwan dated 13 May 1991;
11. Corporate Secretary's Certificate;
12. affidavit-testimony of Volker Herre;

⁵ See Verified Opposition, p. 12.

13. company profile of Hugo Boss for year 2010; and
14. annual report of Hugo Boss for year 2010.⁶

The Respondent-Applicant filed its Answer on 17 April 2012 alleging that the trademarks in their entirety as they appear in their respective labels or hang tags must also be considered in relation to the goods to which they are attached. According to the Respondent-Applicant, its mark is the whole "RICHBOSS", which should be considered as a whole and not piecemeal. It asserts that "RICHBOSS" is a fanciful and arbitrary trademark which has no dictionary meaning and that the distinctive features of the contending marks are sufficient to warn the purchasing public on what its products are as distinguished from the Opposer's. Its evidence consists of a copy of its Declaration of Actual Use (DAU) and pictures of "RICHBOSS" shoes.

The issue to be resolved in this case is whether the trademark application for "RICHBOSS" may be allowed to be registered in favor of Respondent-Applicant.

Records reveal that at the time Respondent-Applicant sought registration for its mark, "RICHBOSS", the Opposer has a valid and existing registration for its mark "BOSS". As early as 02 March 1994, the mark "BOSS" was registered under Certificate of Registration No. 057838.

To determine whether the marks of Opposer and Respondent-Applicant are confusingly similar, the competing marks are depicted below for comparison:

Opposer's Marks:

BOSS
HUGO BOSS

⁶ Marked as Exhibits "A" to "JJ".

BOSS
HUGO BOSS

Respondent-Applicant's Mark:

RICHBOSS

The word "BOSS" constitutes the marks or the prevalent feature of the Opposer's marks. Scrutinizing the Respondent-Applicant's applied mark, the only notable difference is the addition of the word and/or prefix "RICH". This notwithstanding, the competing marks remain visually and aurally confusingly similar. Confusion cannot be avoided by merely adding, removing or changing some letters of a registered mark. Confusing similarity exists when there is such a close or ingenuous imitation as to be calculated to deceive ordinary persons, or such resemblance to the original as to deceive ordinary purchased as to cause him to purchase the one supposing it to be the other.⁷ In the case of **Del Monte Corporation vs. Court of Appeals**⁸, the Supreme Court held:

"The question is not whether the two articles are distinguishable by their label when set side by side but whether the general confusion made by the article upon the eye of the casual purchaser who is unsuspecting and off his guard, is such as to likely result in his confounding it with the original. As observed in several cases, the general impression of the ordinary purchaser, buying under the normally prevalent conditions in trade and giving the attention such purchasers usually give in buying that class of goods is the touchstone."

Succinctly, since the Respondent-Applicant will use or uses the mark "RICHBOSS" to goods under Class 25, the aforesaid minor differences will not diminish the likelihood of the occurrence of confusion, mistake and/or deception. It is highly probable that the purchasers will be led to believe that Respondent-Applicant's mark is a mere variation or associated with that of Opposer's mark. In **Skechers, USA, Inc. vs. Inter Pacific Industrial Trading Corp.**⁹, the Supreme Court made the following pronouncement:

⁷ Societe des Produits Nestle, S.A. vs. Court of Appeals, GR No. 112012, 04 April 2001.

⁸ G.R. No. L-78325, 25 January 1990.

⁹ Skechers, USA, Inc. vs. Inter Pacific Industrial Trading Corp., G.R. No. 164321, 23 March 2011.

"Modern law recognizes that the protection to which the owner of a trademark is entitled is not limited to guarding his goods or business from actual market competition with identical or similar products of the parties, but extends to all cases in which the use by a junior appropriator of a trade-mark or trade-name is likely to lead to a confusion of source, as where prospective purchasers would be misled into thinking that the complaining party has extended his business into the field (see 148 ALR 56 et seq; 53 Am. Jur. 576) or is in any way connected with the activities of the infringer; or when it forestalls the normal potential expansion of his business (v. 148 ALR 77, 84; 52 Am. Jur. 576, 577). x x x

Indeed, the registered trademark owner may use its mark on the same or similar products, in different segments of the market, and at different price levels depending on variations of the products for specific segments of the market. The purchasing public might be mistaken in thinking that petitioner had ventured into a lower market segment such that it is not inconceivable for the public to think that Strong or Strong Sport Trail might be associated or connected with petitioner's brand, which scenario is plausible especially since both petitioner and respondent manufacture rubber shoes."

Moreover, it is settled that the likelihood of confusion would not extend not only as to the purchaser's perception of the goods but likewise on its origin. 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 the belief that there is some connection between the plaintiff and defendant which, in fact, does not exist."¹⁰

Finally, 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.¹¹ Based on the above discussion, Respondent-Applicant's trademark fell short in meeting this function.

¹⁰ Societe des Produits Nestle, S.A. vs. Dy, G.R. No. 1772276, 08 August 2010.

¹¹ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2011-009851 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 03 December 2015.


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