



INTELLECTUAL PROPERTY
OFFICE OF THE PHILIPPINES

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

-versus-

WILLIE LAO,
Respondent-Applicant.

X-----X

IPC No. 14-2016-00006

Opposition to:
Appln. Ser. No. 4-2015-009153
Date Filed: 12 August 2015

TM: HUGE!

NOTICE OF DECISION

E.B. ASTUDILLO & ASSOCIATES

Counsel for Opposer
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8741 Paseo de Roxas, Makati City

WILLIE LAO

Respondent-Applicant
Auditing Street, Ext. Project 8
Quezon City

GREETINGS:

Please be informed that Decision No. 2017 - 379 dated 16 November 2017 (copy enclosed) was promulgated in the above entitled case.

Pursuant to Section 2, Rule 9 of the IPOP HL Memorandum Circular No. 16-007 series of 2016, any party may appeal the decision to the Director of the Bureau of Legal Affairs within ten (10) days after receipt of the decision together with the payment of applicable fees.

Taguig City, 21 November 2017.

MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs

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Trademark: HUGE!

Decision No. 2017 - 379

DECISION

HUGO BOSS TRADEMARK MANAGEMENT GMBH & CO. KG¹ ("Opposer") filed an Opposition to Trademark Application Serial No. 4-2015-009153. The application, filed by WILLIE LAO² ("Respondent-Applicant") covers the mark HUGE! for use on "*t-shirt, muscle sando*" under Class 25 of the International Classification of goods³.

The Opposer alleges the following grounds:

"10. The mark HUGE! being applied by respondent-applicant is confusingly similar to opposer's trademark HUGO, as to likely, when applied to or used in connection with the goods of respondent-applicant, cause confusion, mistake and deception on the part of the purchasing public.

"11. The registration of the trademark HUGE! in the name of respondent-applicant will violate Section 123.1 subparagraph (d) of Republic Act No. 8293, otherwise known as the Intellectual Property Code (IP Code), to wit:

x x x

"12. The registration and use by respondent-applicant of the mark HUGE! will diminish the distinctiveness and dilute the goodwill of opposer's mark HUGO.

"13. The registration of the mark HUGE! in the name of respondent-applicant is contrary to the provisions of the IP Code of the Philippines."

Opposer's evidence consists of the following:

1. Philippine Certificate of Registration No. 4-2008-009948 for the mark HUGO;
2. Philippine Certificate of Registration No. 4-1993-089082 for the mark HUGO BOSS;
3. Philippine Certificate of Registration No. 057531 for the mark HUGO BOSS;

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

² A resident of the Philippines with address at Auditing Street Extension, Project 8, Quezon 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.

4. Philippine Certificate of Registration No. 4-2008-009948 for the mark HUGO;
5. Chinese Certificate of Registration No. 1250621 for the mark HUGO BOSS;
6. US Certificate of Registration No. 2,361,234 for the mark HUGO;
7. OHIM Certificate of Registration No. 000049270 for the mark HUGO;
8. CD-ROM containing selected advertisements and promotional paraphernalia displaying the mark HUGO;
9. HUGO BOSS AG's Annual Report 2014;
10. Certificate of Identity of the Legal Representative;
11. Legalized and authenticated Affidavit-Testimony of Paul Anthony Daly; and
12. Printout of company profile of HUGO BOSS for 2010 downloaded from its website.

On 31 March 2016, this Bureau issued a Notice to Answer and personally served it to Respondent-Applicant's representative on 05 May 2016. Despite the receipt of Notice, Respondent-Applicant failed to file the answer. On 12 October 2017, an Order was issued declaring Respondent-Applicant in default. Accordingly, the case is deemed submitted for decision on the basis of the opposition, the affidavits of witnesses, if any, and the documentary evidence submitted by the Opposer.

Should the Respondent-Applicant be allowed to register the mark HUGO! ?

Sec. 123.1 (d) of Republic Act No. 8293, also known as the "Intellectual Property Code of the Philippines (IP Code)", as amended provides:

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

- x x x
- 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;

Explicit from the afore-cited provision of the IP Code that whenever a mark subject of an application for registration resembles another mark which has been registered or has an earlier filing or priority date, or to a well-known mark, said mark cannot be registered.

The records will show that at the time the Respondent-Applicant filed its application for the mark HUGO! on 12 August 2015, the Opposer already has an existing registration for the trademark HUGO issued way back in 03 November 1993. Thereafter, Opposer also registered other variants of is HUGO mark such as HUGO BOSS, HUGO HUGO BOSS and BOSS HUGO BOSS, among others under Class 25. As such, the certificate of registration in its name is a *prima facie evidence* of the validity of the registration, its ownership of the mark and its exclusive right to use it in connection with the goods and/or services and those that are related thereto, pursuant to Section 138 of the IP Code. Thus, the Opposer has the right to oppose the application for registration of a mark which is similar or resembles its HUGO marks, as in this case.

But are the competing marks, as shown below, similar or closely resemble each other such that confusion, mistake or deception is likely to occur?

HUGO

Opposer's Marks

HUGe!

Respondent-Applicant's Mark

A perusal of the composition of the competing trademarks involved in this case show that the competing marks are both word marks. Opposer's mark consists of four letters "H-U-G-O" written in plain upper case letters. On the other hand, Respondent-Applicant's mark consists of four letters "H-U-G-E" written in a stylized manner with an exclamation point at the end. Three of the four letters of Opposer's mark, "H-U-G" are present in Respondent-Applicant's in sequential order. As to the last letter, while it differs from that of Opposer's, the letter "E" in Respondent-Applicant's mark is written in such a way that it looks like a letter "O". The addition of an exclamation point at the end does not effectively makes the mark different. Further, Respondent-Applicant's mark can also be pronounced as "hug-e!", in which case, it is not only visually similar but aurally similar to Opposer's mark as well. As such, the likelihood that the consumers will be confused, mistaken or deceived that the mark of Respondent-Applicant is the same as Opposer, or that the two are associated or affiliated is inevitable. In addition, since the mark of Respondent-Applicant will be used on goods that are already covered by Opposer's goods bearing the HUGO mark, it will further contribute to the likely occurrence of confusion, mistake or deception on the public.

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 purchaser as to cause him to purchase the one supposing it to be the other⁴. Colorable imitation does not mean such similitude as amounts to identify, nor does it require that all details be literally copied. Colorable imitation refers to such similarity in form, context, words, sound, meaning, special arrangement or general appearance of the trademark or trade name with that of the other mark or trade name in their over-all presentation or in their essential, substantive and distinctive parts as would likely to mislead or confuse persons in the ordinary course of purchasing the genuine article⁵.

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.⁶

Indeed, the registration of trademarks involves public interest. Public interest, therefore, require that only marks that would not likely cause deception, mistake or confusion should be registered. The consumers must be protected from deception, mistake or confusion with respect to the goods or services they buy. Trademarks serve to guarantee that the product to which they are affixed comes up to a certain standard quality. Modern trade and commerce demands that

⁴ *Societe Des Produits Nestle, S.A v. Court of Appeals*, G.R. No.112012, 4 Apr. 2001, 356 SCRA 207, 217.

⁵ *Emerald Garment Manufacturing Corp. v. Court of Appeals*. G.R. No. 100098, 29 Dec. 1995.

⁶ *American Wire and Cable Co. v. Director of Patents et al.*, G.R. No. L-26557, 18 Feb. 1970.



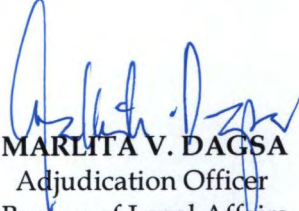
depreations on legitimate trademarks should not be countenanced. The law against such depreations is not only for the protection of the owner but also, more importantly, for the protection of consumers from confusion, mistake, or deception as to the goods they are buying.⁷

Accordingly, this Bureau finds that the Respondent-Applicant's trademark application 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. 4-2015-009153, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 16 NOV 2017


MARLITA V. DAGOSA
Adjudication Officer
Bureau of Legal Affairs

⁷ *Le Chemise Lacoste, S.A. v. Oscar C. Fernandez et. al.*, G.R. Nos. 63796-97 and G.R. No. 65659, 21 May 1984.