



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

-versus-

TALLYHOE MANUFACTURING
CO. INC., (now known as PMFTC, INC.),
Respondent-Applicant.

X-----X

IPC No. 14-2011-00075
Opposition to:
Appln. Serial No. 4-2009-500939
Date Filed: 02 December 2009
Trademark: "BOSS"

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2012 – 184 dated September 28, 2012 (copy enclosed) was promulgated in the above entitled case.

Taguig City, September 28, 2012.

For the Director:


Atty. PAUSI U. SAPAK
Hearing Officer
Bureau of Legal Affairs

CERTIFIED TRUE COPY

SHARON S. ALCANTARA
Records Officer II
Bureau of Legal Affairs, IPO



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TM: BOSS

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Decision No. 2012- 184

DECISION

HUGO BOSS TRADEMARK MANAGEMENT GMBH & CO., KG. ("Opposer")¹ filed on 01 March 2011 an opposition to Trademark Application Serial No. 4-2009-500939. The application, filed by TALLYHOE MANUFACTURING CO., INC. ("Respondent-Applicant")², covers the mark "BOSS" for use on "cigarettes" under Class 34 of the international Classification of goods.³

It is alleged in the opposition that the mark applied for by the Respondent-Applicant is identical to the Opposer's registered mark BOSS and is confusingly similar to its various other registered trademarks that contain the dominant word BOSS. According to the Opposer, the registration of the mark BOSS in the name of Respondent-Applicant will violate Sec. 123.1, subparagraphs (d) to (f) of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"). To support its opposition, the Opposer submitted the following:

1. Exh. "A" to "A-31": advertisement in the Philippines media;
2. Exh. "A-32": advertisement in the Philippines media for the year 2008;
3. Exh. "A-33": advertisement in the Philippines media for the year 2009;
4. Exh. "A-34": advertisement in the Philippines media for the year 2010;
5. Exh. "B" to "B-5": sales invoices for BOSS products for the year 2003-2004;
6. Exh. "B-6": sales invoices for products bearing the mark BOSS for the year 2008;
7. Exh. "B7": sales invoices for products bearing the mark BOSS for the year 2009;
8. Exh. "B8": sales invoices for products bearing the mark BOSS for the year 2010;
9. Exh. "C" to "C-3": certificates of international registration for the mark BOSS issued by the World Intellectual Property Organization (WIPO);
10. Exh. "D" to "D-1": certificates of U.S. Trademark ("TM") Reg. Nos. 1,023,305 and 2,429,018;
11. Exh. "E": certificates of Thai TM Reg. No. Kor108576;
12. Exh. "F": certificates of TM Reg. No. 25608 issued by the Rep. of Trinidad and Tobago;
13. Exh. "G": certificates of Turkish TM Reg. No. 099252;
14. Exh. "H": certificates of Taiwanese TM Reg. No. 279,546;

¹ A foreign corporation existing under the law of Germany and with address at Diesels Trasse 12, 72555 Metzingen, Germany.

² A Philippine corporation with address at Lot 3, Phase 1B, First Philippine Industrial Park, Tanauan City Batangas.

³ The Nice Classification is a classification of goods and services for the purpose of registering trademarks and service marks based on a multilateral treaty administered by the World Intellectual Property Organization. The treaty is called the Nice Agreement concerning the International Classification of goods and services to the purpose of the registration of marks concluded in 1957.

15. Exh. "I": certificates of South Korean TM Reg. No. 93547;
16. Exh. "J": certificates of Kingdom of Swaziland's TM Reg. No. 501/97;
17. Exh. "K": certificates of United Arab Emirates' TM Reg. No. 31072;
18. Exh. "L": certificates of Egyptian TM Reg. No. 5928;
19. Exh. "M": certificates of Cyprus' TM Registration;
20. Exh. "N": certificates of Indian TM Reg. No. 493925;
21. Exh. "O": certificates of Indonesian TM Reg. No. 449710;
22. Exh. "P": certificates of Hong Kong's TM Reg. No. 678 of 1989;
23. Exh. "Q" to "Q-1": certificates of U.K. TM Reg. Nos. 1198783 and 1198781;
24. Exh. "R": certificates of Ecuadorian TM Reg. No. 1847;
25. Exh. "S": certificates of Estonian TM Reg. No. 14937;
26. Exh. "T": certificates of Finnish TM Reg. No. 86157;
27. Exh. "U": certificates of French TM Reg. No. 1 414 947;
28. Exh. "V": certificates of Ghana's TM Reg. No. 28,072;
29. Exh. "W": certificates of Georgian TM Reg. No. 4102;
30. Exh. "X" to "X-98": advertisements in major media markets around the world;
31. Exh. "Y" to "Y-3": brochures/fashion catalogues of Hugo Boss AG's products;
32. Exh. "Y-4" to "Y-7": photos of merchandising articles such as ashtrays, lighters and cigarette cutter bearing the mark BOSS which are distributed around the world;
34. Exh. "Z": list of countries worldwide where Hugo Boss AG's products are exported;
35. Exh. "AA": decision of the Chinese TM Office in Case No. 2000 TMO 2467 dated 01 Feb. 2001;
36. Exh. "BB": decision of the Chinese TM Office in Case No. 2003 TMOP No. 00700 dated 09 April 2003;
37. Exh. "CC": decision of the Amsterdam District Court in the Netherlands dated 28 Oct. 1998;
38. Exh. "DD": decision of the Commercial Court of the canton of Bern in Switzerland dated 28 Jan. 1999;
39. Exh. "EE": decision of the National Bureau of Standards of Ministry of Economic Affairs in Taiwan dated 13 May 1991;
40. Exh. "FF" to "FF-2": duly signed, notarized and legalized Corporate Secretary' Certificate;
41. Exh. "GG" to "GG-13": duly signed, notarized and legalized Affidavit Testimony of Volker Herre;
42. Exh. "HH" to "HH-37": Company Profile of Hugo Boss for the year 2010, the original of which is on file as Exh. "HH" to "HH-37" of the Verified Notice of Opposition in the case entitled "Hugo Boss Trade mark Management GmbH & Co. KG vs. Brand Boss Advertising Services Corporation" (MNO No. 2010-170); and
43. Exh. "II": Annual Reports of Hugo Boss for the year 2009, the original of which is on file as Exh. "II" of the Verified Notice of Opposition in the case entitled "Hugo Boss Trade mark Management GmbH & Co. KG vs. Brand Boss Advertising Services Corporation" (MNO No. 2010-170).

The Respondent-Applicant filed its Verified Answer on 17 August 2011. It alleges that it has changed its name to PMTC, Inc. on 25 February 2010, and which was duly recorded at the Bureau of Trademarks on 27 October 2010. Denying the material allegations in the opposition, the Respondent-Applicant argues that considering that the parties do not deal in the same goods or business, no confusing similarity exists. To defend its trademark application, the Respondent-Applicant submitted the following:

1. Exh. "I": letter certification issued by the Bureau of Internal Revenue ("BIR") dated 27 Aug.

- 1975 confirming FTC's registration and the permit to manufacture the Boss cigarettes;
2. Exh. "2": certification issued by the BIR dated 10 Nov. 1978 certifying that the BOSS cigarette brand has been registered and may be commercially produced in accordance in accordance with the provisions of Sec. 149 (b) of the Tax code of 1977, as amended by B.P. Blg. 3;
 3. Exh. "3": certification issued by the Bureau of Trademarks certifying that Reg. No. 65291 under the name of Fortune Tobacco Corporation with registration date of 3 Nov. 1997 was cancelled as of 12 Apr. 2006;
 4. Exh. "3-A": Cert. of Reg. No. 65291 for cigarettes indicating 30 June 1976 as the date of first use;
 5. Exh. "4": certification issued by the Bureau of Trademarks certifying that Reg. No. SR-9021 under the name of PMFTC Inc., dated 3 Oct. 1994 is valid and subsisting;
 6. Exh. "4-A": Cert. of Reg. No. SR-9021 for cigarettes indicating 30 June 1976 as the date of first use;
 7. Exh. "5": Joint Affidavit of Antonio Tiu and Vicente B. Co, Area Sales Managers of Fortune Tobacco Corporation;
 8. Exh. "6": actual BOSS cigarette products;
 9. Exh. "7" to "9-K": old posters used in promoting the BOSS cigarette brand;
 10. Exh. "10","11" and "12": actual T-shirts and bags bearing the mark BOSS which are used for promoting and advertising the BOSS cigarettes;
 11. Exh. "13": actual compact disc containing radio commercials for BOSS;
 12. Exh. "14" to "14-NNN": certified true copies of receipts, cash invoices, consignment invoices showing the sale and distribution of BOSS products;
 13. Exh. "15": summary of invoices and receipts with names of outlets/distributors, dates, invoices numbers and amount;
 14. Exh. "16": affidavit of Jan Abigail L. Ponce;
 15. Exh. "17": Corporate Secretary's Certificates issued by Respondent-Applicant in favor of Federis & Associates Law Offices;
 16. Exh. "18": certified true copy of the Deed of Assignment as duly recorded with the Bureau of Trademarks covering the assignment of BOSS (App. No. 4-2009-500939) and BOSS LABEL (Reg. No. SR-9021) from Fortune Tobacco Corp. to Tallyhoe Manufacturing Co. Inc.;
 17. Exh. "19": certified true copy of the Certificate of Filing of the Amended Articles of Incorporation showing the change of name of Tallyhoe Manufacturing Co. Inc. to PMFTC Inc. as recorded with the Bureau of Trademarks concerning BOSS (App. No. 4-2009-500939);
 18. Exh. "20": amended Articles of Incorporation of Respondent-Applicant showing the change of name from Tallyhoe Manufacturing Co., Inc. to PMFTC Inc.;
 19. Exh. "21": certified true copy of the Amended Articles of Incorporation of Respondent-Applicant, PMFTC Inc.; and
 20. Exh. "22": certified true copy of the Articles of Incorporation issued on April 29, 1965 and of Fortune Tobacco Corporation.

The Opposer filed a REPLY on 23 Aug. 2011.⁴ Then after, the Hearing Officer issued on 22 August 2011 Order No. 2011 referring the case to mediation pursuant to Office Order No. 154, s. 2010 (Rules of Procedure for IPO Mediation Proceedings) and Office Order No. 197, s. 2010 (Mechanics for IPO Mediation and Settlement Period). The mediation, however, failed. Accordingly, the preliminary conference was conducted and terminated on 14 March 2012. The parties filed their respective position papers on 26 March 2012.

⁴ The Respondent-Applicant filed a REJOINDER on 01 Sept. 2011.

Should the Respondent-Applicant be allowed to register the mark BOSS in its favor ?

The Opposer anchors its case on Sec. 123.1(d) of the IP Code which provides that a mark shall not be registered if 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. It also invokes Sec.123.1, pars. (e) and (f) of the IP Code, to wit:

Sec.123. Registrability. - 123.1 A mark cannot be registered if it:

xxx

(e) Is Identical with, or confusingly similar to, or constitutes a translation of 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;”[Underscoring supplied]

(f) Is Identical with, or confusingly similar to, or constitutes a translation of 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 interest of the owner of the registered mark are likely to be damaged by use;”

In this regard, at the time the Respondent-Applicant filed its trademark application on 02 December 2009, the Opposer has existing trademark registrations for the mark BOSS, particularly,

1. No. 4-1996-111064 and No. 4-1996-111065 issued on 08 May 2001 (Class 03);
2. No. 4-1996-108678 issued on 16 April 2004 (Class 03);
3. No. 058538 issued on 23 June 1994 (Class 09);
4. No. 057838 issued on 02 March 1994 (Class 18); and
5. No. 057530 issued on 24 March 1994 (Class 25).

and for other marks featuring the word BOSS:

1. No. 064768 issued on 25 June 1997 for HUGO HUGO BOSS (Class 03);
2. No. 4-2007-011456 issued on 18 Aug. 2008 for BOSS SKIN (Class 03);
3. No. 4-2004-011944 issued on 17 Dec. 2004 for BOSS SKIN (Class 03);
4. No. 4-1996-116348 issued on 11 Mar. 2004 for BOSS ELEMENTS AQUA (Class 03);
5. No. 4-2002-008306 issued on 01 July 2005 for BOSS IN MOTION (Class 03);
6. No. 4-2003-004689 issued on 02 Oct. 2006 for BOSS INTENSE. (Class 03)
7. No. 4-2004-004047 issued on 09 Oct. 2006 for HUGO HUGO BOSS ENERGISE LABEL. (Class 03)
8. No. 4-2008-005086 issued on 15 Dec. 2008 for HUGO BOSS (Class 09);
9. No. 066152 issued on 28 July 1998 for HUGO HUGO BOSS (Class 09);

10. No. 061207 issued on 18 July 1995 for BOSS HUGO BOSS (Class 09);
11. No. 063703 issued on 24 Sept. 1996 for BOSS HUGO BOSS (Class 14);
12. No. 4-2008-008468 issued on 27 Mar. 2009 for HUGO BOSS (Class 16);
13. No. 057301 issued on 15 Mar. 1994 for HUGO BOSS (Class 18);
14. No. 063036 issued on 21 Mar. 1996 for HUGO HUGO BOSS (Class 18);
15. No. 57531 issued on 24 Mar 1994 for HUGO BOSS (Class 25);
16. No. 56884 issued on 26 Jan. 1994 for BOSS HUGO BOSS (Class 25);
17. No. 4-1993-089082 issued on 20 Nov. 2005 for HUGO HUGO BOSS (Class 25); and
18. No. 062926 issued on 21 Mar. 1996 for BOSS HUGO BOSS (Class 42).

This Bureau, however, noticed that the goods and service covered by the Opposer's registered marks are not similar or closely related to cigarettes (class 34) indicated in the Respondent-Applicant's trademark application. These goods and service are:

1. various cosmetics products including lotions, toiletries, deodorants, and perfumery under class 3;
2. sunglasses, mobile phones, Personal Digital Assistant and headsets under class 9;
3. paper and cardboard-based goods, pens and other office requisites under class 16;
4. leather and leather-based goods under class 18;
5. clothing and accessories under class 25; and
6. planning of business premises, sales advice under class 42.

The stark differences between the Opposer's goods and service on one hand and the Respondent-Applicant's on the other with respect to composition, purpose and the manner by which the goods are accessed or available to the consumers, render confusion, much less deception, unlikely. Thus, this Bureau finds and concludes that the Respondent-Applicant's trademark application is not proscribed by Sec. 123.1, pars. (d) of the IP Code.

Corollarily, because the Respondent-Applicant's goods are not identical or similar to the Opposer's, there is no basis not to allow the Respondent-Applicant's application on the basis of pars. (e) and (f) of Sec. 123.1 of the IP Code. The Respondent-Applicant submitted evidence to establish that the mark BOSS for cigarettes has been in the Philippine market since the latter half of the 1970s. In fact, the Respondent-Applicant was even issued Cert. of Trademark Reg. No. SR-9021 on 3 Oct. 1994 for the "BOSS LABEL" mark and Cert. of Trademark Reg. No. 65291 on 03 Nov. 1997 for the mark "BOSS", both of which cover the goods "cigarettes" and indicate "30 June 1976" as the date of first use.⁵ Having long established its presence in the Philippine market, it is unlikely that those who buy BOSS branded or marked cigarettes will assume that these goods or the mark is connected or associated with the Opposer. This Bureau finds merit in the Respondent-Applicant's argument, to wit:

"37. Even assuming without conceding that the Opposer's trademark is well-known, two additional conditions must be met, namely, a showing that relevant consumer will associate the business of Opposer to the business of the Respondent and, that Opposer will sustain damage if the Respondent is permitted to register the disputed trademark. Section 123.1(f) reads:

x x x

"38. It is clear from the above-quoted section that in order to claim the benefit of Section

5 Exhibit "3-A". Cancelled on 12 April 2006 for non-filing of Declaration of Actual Use.

123.1(f) of the IP Code, the claimant must be able to establish two (2) conditions, namely, (1) a connection between its good and to those of the other party, and (2) damage to the claimant as a result of the other party using the claimant's trademark. Opposer failed to establish both.

"39. In the case of 246 Corporation, doing business under the name and style of Rolex Music Lounge vs. Hon. Reynaldo B. Daway, Montres Rolex S.A. and Rolex Center Phils. Limited, the Supreme Court affirmed the need to prove these conditions when a party litigant invokes Section 123.1(f) of the IP Code.

"40. Given the nature of the Opposer's business and the goods that it deals with, it is inconceivable, under any real or contrived scenario, for any reasonable person to associate the goods of the Opposer (clothing, leather goods and toiletries) to those of the Respondent-Applicant (cigarettes).

"41. And precisely because the parties' goods are totally unrelated and non-competing, Opposer is in no way damaged by Respondent-Applicant's use of BOSS on cigarettes (not least because the Respondent is the prior right-holder)."⁶

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; to protect the manufacturer against sale of inferior and different articles as his products.⁷ The Respondent-Applicant's mark sufficiently serves this function.

WHEREFORE premises considered the opposition is hereby **DISMISSED**. Let the file wrapper of Trademark Application Serial No. 4-2009-500939 be returned, together with a copy of this Decision, to the Bureau of Trademark for information and appropriate action.

SO ORDERED.

Taguig City, 28 September 2012.


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

⁶ See Respondent-Applicant's Verified Answer, pp. 13-14.

⁷ *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114508, 19 Nov. 1999, citing *Etepha v. Director of Patents*, 16 SCRA 485.