



INTELLECTUAL PROPERTY  
OFFICE OF THE PHILIPPINES

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

**-versus-**

**SHAWILL CORPORATION,**  
*Respondent-Applicant.*

X-----X

**IPC No. 14-2016-00264**

Opposition to:  
Appln. Ser. No. 4-2015-012449  
Date Filed: 28 October 2015

**TM: ANDREA SECRET BOSSIMI**

**NOTICE OF DECISION**

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**GREETINGS:**

Please be informed that Decision No. 2017 - 352 dated 09 October 2017 (copy enclosed) was promulgated in the above entitled case.

Pursuant to Section 2, Rule 9 of the IPOPHEL 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, 10 October 2017.

**MARILYN F. RETUAL**  
IPRS IV  
Bureau of Legal Affairs



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Trademark: **ANDREA SECRET  
BOSSIMI**

x-----x

Decision No. 2017 - 352

### DECISION

HUGO BOSS TRADEMARK MANAGEMENT GMBH & CO. KG<sup>1</sup> ("Opposer") filed an Opposition to Trademark Application Serial No. 4-2015-012449. The application, filed by SHAWILL CORPORATION<sup>2</sup> ("Respondent-Applicant") covers the mark **ANDREA SECRET BOSSIMI** for use on "*cosmetic products especially perfumes*" under Class 03 of the International Classification of goods<sup>3</sup>.

The Opposer alleges the following:

"6. The Respondent-Applicant's application for the registration of the mark **ANDREA SECRET BOSSIMI** should not be allowed by this Honorable Office since to do so would be contrary to Section 123.1 (d) and Section 123.1 (f) of the Intellectual Property Code, which prohibits the registration of a mark that:

x x x

"7. The act of the Respondent-Applicant in adopting the mark **ANDREA SECRET BOSSIMI** for its products under International Class 3 is clearly an attempt to trade unfairly on the goodwill, reputation and consumer awareness of the Opposer's internationally well-known **BOSS** mark that has been registered in 125 other jurisdictions around the world. Such act of the Respondent-Applicant results in the diminution of the value of the Opposer's well-known **BOSS** mark.

"8. The Opposer's well-known **BOSS** mark is registered under several International Classes of goods, particularly, International Class 3, which is identical to the class to which the Respondent-Applicant seeks registration for its mark **ANDREA SECRET BOSSIMI**. Further, because the Opposer's **BOSS** mark is internationally well-known, the same is likely to be associated with the Respondent-Applicant's mark **ANDREA SECRET BOSSIMI** leading to consumer confusion.

"9. Goods are closely related when they belong to the same class, or have the same descriptive properties, or when they possess the same physical attributes or characteristics, with reference to their form, composition, texture, or quality.

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

<sup>2</sup> A domestic corporation with address at Rm. 1402 Tytana Plaza Building, Tytana St., Binondo, Manila

<sup>3</sup> 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.

"10. The Opposer's mark has been used worldwide for decades. As previously mentioned, the products were first put on the market way back in the early 1970s in Germany, and the products of the Opposer were sold using the trademark **BOSS** since 1977. Such mark has been openly and continuously used since then. Moreover, the certificates of registration that the Opposer has obtained all over the world, included in the Affidavit attached hereto as ANNEX "B", is evidence that the Opposer's **BOSS** mark is internationally well-known and warrants protection by the Opposer.

"11. As one of the means of promoting the Opposer's products, goods bearing the **BOSS** mark have been distributed to department stores all over the world. It has likewise been sold in personal care stores, catering to consumers who wish to purchase fragrances and perfumes. The attempt of the Respondent-Applicant to register the mark **ANDREA SECRET BOSSIMI** will definitely lead to confusion among the Filipino public as it falsely suggests business associations, due to the presence of the Opposer's products in precisely the sphere in which the Respondent-Applicant seeks to operate.

"12. The Opposer's **BOSS** mark and the Respondent-Applicant's mark **ANDREA SECRET BOSSIMI** are identical in the following respects, to wit:

12.1 Both marks contain the four letters "B", "O", "S", "S";

12.2 Both marks are visually and aurally similar inasmuch as the Company's internationally well-known **BOSS** mark and the "**BOSSIMI**" mark puts emphasis on the syllable "BOSS";

12.3 Both marks are phonetically similar, as the internationally well-known **BOSS** mark contains one syllable which is read as /'bɒs/ while the last word of the mark **ANDREA SECRET BOSSIMI** contains three syllables which is read as /'bɒs•si•mi/;

12.4. Both marks are used for similar goods, namely, fragrances and perfumes.

"13. The resemblance of the Opposer's and the Respondent-Applicant's respective marks is most evident upon a mere juxtaposition of the two marks, to wit:

x x x

A mere perusal of the Respondent-Applicant's mark will illustrate a poor attempt at reproducing the Opposer's well-known **BOSS** mark, clearly showing an intent to imitate the word mark "**BOSS**" that is closely associated with the Opposer's products. The dominant portion in Respondent-Applicant's mark is evidently the word "**BOSSIMI**", creating the impression that the two word marks "**ANDREA SECRET**" preceding the word "**BOSSIMI**" was merely used to stretch out the mark so as not to look or sound similar to Opposer's well-known **BOSS** mark. In truth and in fact, there is much emphasis on the word "**BOSSIMI**", thereby creating a confusing similarity to the Opposer's well-known **BOSS** mark.

"14. The personal care products and fragrances bears the Opposer's **BOSS** mark and the Respondent-Applicant's mark **ANDREA SECRET BOSSIMI** are known by the public and are commercially available through the same channels of trade such that an indiscriminating purchaser might believe that the Respondent-Applicant's personal care products, specifically fragrances and perfumes, are affiliated with the widely known and regarded products of the Opposer bearing its internationally well-known **BOSS** mark. Moreover, Filipino purchasers who wish to purchase such fragrances and perfumes might confuse and interchange the products bearing the Respondent-Applicant's mark **ANDREA SECRET BOSSIMI** for goods bearing the Opposer's internationally well-known **BOSS** mark. It is worthwhile to mention that the relevant consumers affected herein are the purchasers of such personal care products. Naturally, consumers would merely rely on recollecting the dominant and distinct wording of the marks. There is a great similarity between the Opposer's **BOSS** mark and the Respondent-Applicant mark **ANDREA SECRET BOSSIMI**. Thus, confusion will likely arise and would necessarily cause the interchanging of one product with the other.

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"15. Considering the fact that the goods involved are related and flow through the same channels of trade, the possibility of confusion is more likely to occur in light of the fact that ordinary consumers may be prone to believe that the goods of the Respondent-Applicant are equivalent to, or are affiliated with, the Opposer's goods.

x x x

"17. The Respondent-Applicant's attempt to register the mark **ANDREA SECRET BOSSIMI** in connection with fragrance and perfumes, will take advantage of the worldwide and nationwide reputation of the Opposer, gained by their years of persistent marketing and advertising as a quality producer of superior quality fragrances all over the world. This is also further reinforced by the enviable reputation built up by the Opposer throughout the years due to its uncompromising attitude towards quality and excellence.

"18. The Respondent-Applicant's mark **ANDREA SECRET BOSSIMI** so closely resembles the Opposer's internationally well-known **BOSS** mark that the Filipino public will undoubtedly confuse one with the other or worse, believe that goods bearing the Respondent-Applicant's mark **ANDREA SECRET BOSSIMI** originate from the Opposer, or, at least, originate from economically linked undertakings.

xxx

"21. By the Respondent-Applicant's attempt to register and use the mark **ANDREA SECRET BOSSIMI** for its goods in International Class 3, it is plain that the Respondent-Applicant seeks to take advantage of the worldwide and nationwide reputation of the internationally well-known **BOSS** mark that the Opposer has gained, by confusing and misleading the trade and the Filipino public in passing off its own products as those of the Opposer and/or suggesting that they are being sold or are approved by the Opposer.

"22. The Respondent-Applicant registration of the mark **ANDREA SECRET BOSSIMI** which is confusingly similar to the Opposer's internationally well-known **BOSS** mark, as to be likely, when applied to the goods of Respondent-Applicant, to cause confusion, mistake or deception on the Filipino public as to the source of goods, and will inevitably falsely suggest a trade connection between the Opposer and the Respondent-Applicant, is simply violative of the Intellectual Property Code of the Philippines.

x x x

"24. Allowing Respondent-Applicant to use the mark **ANDREA SECRET BOSSIMI** on its goods under International Class 3 would not only allow it to take a free ride and reap the advantage of the goodwill and reputation of the Opposer's mark, but it would also confuse the consuming public who would be led to believe that the products sold by the Respondent-Applicant are produced and manufactured by the Opposer, or at the very least, is a "local" variant of the Opposer's goods. This is the same confusion that this Honorable Office seeks to protect the public against.

xxx

"28. Of all the possible combinations of the letters of the alphabet and words, the Respondent-Applicant chose to use the mark **ANDREA SECRET BOSSIMI** to identify its goods in International Class 3, which are in direct competition with the Opposer's goods also in International Class 3. The Respondent-Applicant has also chosen to accentuate the word "**BOSSIMI**" to identify its personal care products and perfumes. Thus, it would be extremely difficult for ordinary consumers to notice the extremely negligible difference between the Opposer's **BOSS** mark and the Respondent-Applicant's mark **ANDREA SECRET BOSSIMI**.

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"30. It cannot be gainsaid that confusion will arise inasmuch as the marks are identical, and they cater to the same kind of consumers. No conclusion can be drawn surrounding the case other

than the fact that the Respondent–Applicant is knowingly and deliberately attempting to trade on the valuable goodwill and to ride on the notoriety of the Opposer’s internationally well-known **BOSS** mark that have been used throughout the world for more than four decades including in the Philippines.

"31. Clearly, the registration and use of the Respondent–Applicant’s mark **ANDREA SECRET BOSSIMI** is a usurpation of the internationally well-known **BOSS** mark, a mark legally owned by the Opposer, as well as the goodwill associated therewith and/or passing off its own products, as those manufactured by the Opposer.

"32. Thus, the denial of the registration of Trademark Application No. 4-2015-00012449 for the mark **ANDREA SECRET BOSSIMI** by this Honorable Office is authorized and warranted under the provisions of the Intellectual Property Code of the Philippines."

Opposer's evidence consists of the following:

1. Special Power of Attorney
2. Authenticated Affidavit of Paul Anthony Daly;
3. List of registration of **BOSS** marks in various countries;
4. Copies of Certificates of Registration of the mark **BOSS** issued by OHIM, Malaysia, Singapore, South Africa, Taiwan R.O.C. and WIPO under Madrid Protocol; and
5. Copies of samples of promotional materials for the mark **BOSS**, **HUGO BOSS**;

On 04 August 2016, this Bureau issued a Notice to Answer and personally served it to Respondent-Applicant's representative on 22 August 2016. Despite the receipt of Notice, Respondent-Applicant failed to file the answer. On 17 April 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 **ANDREA SECRET BOSSIMI**?

**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, said mark cannot be registered.

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The records will show that at the time the Respondent-Applicant filed its application for the mark ANDREA SECRET BOSSIMI on 28 October 2015, the Opposer already has an existing registration for the trademark BOSS issued on 08 May 2001 and 16 April 2004 both for goods under Class 3. 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. As regards the goods of the parties, Opposer's BOSS mark is used on " *deodorants for personal use*" and " *foundation cosmetics, powder, blusher, eye shadow, eye liner, mascara, eyebrow pencil, lip color, lip gloss, lip base, perfume, cologne, nail color, nail base coat, nail drying preparations, nail top coat, nail saving preparations, skin care cosmetics, moisturizing lotions and creams, astringents and cleansing creams*" under Class 3. On the other hand, Respondent-Applicant's mark ANDREA SECRET BOSSIMI is being applied for use on " *cosmetic products especially perfumes*" under Class 3 also. Thus, it appears that Respondent-Applicant's goods, which cover Opposer's goods and therefore, their goods are similar, closely related and competing.

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

**BOSS**

Opposer's Marks



Respondent-Applicant's Mark

The manifest similarity in the contending marks is the word "BOSS" which is the very mark of Opposer. However, despite the presence of the word "boss" in both marks, this Bureau finds that it is insufficient to establish a finding of confusing similarity to sustain the opposition.

A practical approach to the problem of similarity or dissimilarity is to go into the whole of the two trademark pictured in their manner of display. Inspection should be undertaken from the viewpoint of the prospective buyer. The trademark complained of should be compared and contrasted with the purchaser's memory (not in juxtaposition) of the trademark said to be infringed. Some such factors as "sound; appearance; form, style, shape, size or format; color; ideas connoted by marks; the meaning, spelling and pronunciation, of words used; and the setting in which the words appear" may be considered.<sup>4</sup> Thus, confusion is likely between marks only if their overall presentation as to sound, appearance or meaning would make it possible for consumers to believe that the goods or products, to which the marks are attached, comes from the same source or are connected or associated with each other.

Prescinding from the above ratiocination, the contending marks are not confusingly similar. Opposer's mark is word mark which contain four letters, "B-O-S-S". On the other hand, Respondent-Applicant's mark is a composite mark which consists of the logo "ANDREA SECRET" and below it is the word "BOSSIMI" written in stylized form and rotated at 90 degrees. Opposer's and Respondent-Applicant's marks are also pronounced differently such that they cannot be

<sup>4</sup> *Etepha A.G. v. Director of Patents, G.R. No. L-20635, 31 March 1966.*

confused with each other. Thus, it is very apparent that the parties marks are not only visually different but aurally as well. Thus, the likelihood of confusion, mistake or deception on the part of the purchasing public is very remote.


Aptly, 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.<sup>5</sup> The Respondent-Applicant's mark meet this function.

Accordingly, the registration of the mark ANDREA SECRET BOSSIMI is not contrary to the provision of Sec. 123.1 (d) of the IP Code.

WHEREFORE, premises considered, the instant opposition is hereby *DISMISSED*. Let the filewrapper of Trademark Application Serial No. 4-2015-012449, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 09 OCT 2017

  
MARLITA V. DAGSA  
Adjudication Officer  
Bureau of Legal Affairs

<sup>5</sup>See *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 Nov. 1999.