

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2052532 BY
MASSA FINANCE B.V. TO
REGISTER A TRADE MARK IN CLASSES 9,
14, 16, 18, 24, 25 AND 26**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER
OPPOSITION No 47361 BY HUGO BOSS AG**

TRADE MARKS ACT 1994

5 **IN THE MATTER OF Application No 2052532**
by **Massa Finance B.V. to register a**
trade mark in **Classes 9, 14, 16, 18, 24, 25 and 26**

and

10 **IN THE MATTER OF Oppositions thereto under**
Opposition No. 47361 by Hugo Boss A.G.

15 **DECISION**

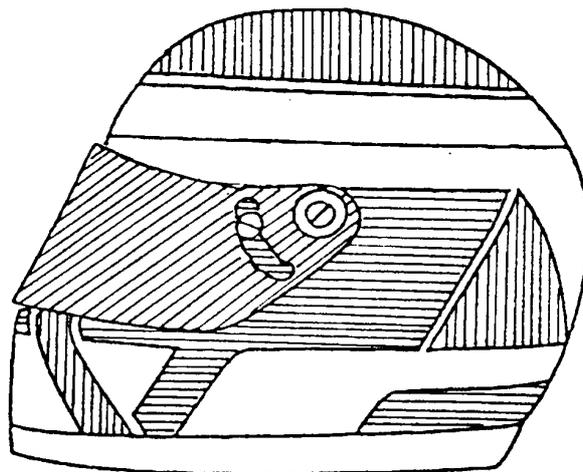
On 20 January 1996 Massa Finance B.V. applied to register the mark **JOS THE BOSS** and **DEVICE** (reproduced below) in respect of goods in Classes 9, 14, 16, 18, 24, 25 and 26 (details are provided at Annex A):-

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JOS THE BOSS

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The advertisement details indicate that “the mark here depicted in heraldic shading is shown on the form of application in the colours red, dark grey and blue, but the mark is not limited to colour”.

45 On 13 August 1997 Hugo Boss AG filed notice of opposition to the application. The grounds of opposition are in summary:-

- (i) the opponents are the proprietors of the trade marks set out at Annex B - all marks consist or incorporate the word BOSS;
- 5 (ii) the opponents have made extensive use of their trade marks in relation to the goods in respect of which the trade marks are registered and have acquired a worldwide reputation. The word BOSS forms a principal distinctive element to the opponents' corporate name;
- 10 (iii) the trade mark the subject of the present application incorporates the whole of the opponents' trade mark and trade name BOSS;
- (iv) under Section 3(6) in that the application was made in bad faith;
- 15 (v) under Section 5(2) because the trade mark is identical or similar to the opponents' earlier trade marks and is for identical or similar goods;
- (vi) under Section 5(3) in that use of the trade mark would take unfair advantage of and be detrimental to the distinctive character or repute of the opponents' trade marks which enjoy a reputation within the United Kingdom;
- 20 (vii) under Section 5(4) in that use of the trade mark is liable to be prevented by rule of law, in particular the law of passing off;
- 25 (viii) registration or use of the mark applied for would obstruct or prejudice the legitimate conduct of the opponents' business and accordingly the name applied for should be refused.

The applicants deny these grounds of opposition. Both sides ask for an award of costs.

30 Both sides filed evidence in these proceedings. Neither side requested a hearing. Acting on behalf of the Registrar and after a careful study of the papers I give this decision.

OPPONENTS' EVIDENCE

35 The opponents filed a statutory declaration dated 2 April 1998 by Gert-Jurgen Frisch who is legal counsel of Hugo Boss AG of Germany. Mr Frisch states that his company is the proprietor of various registered trade marks in the United Kingdom which consist solely of, or incorporate, the word BOSS. A schedule of these registrations is exhibited at "GJF-1".

40 Mr Frisch explains that his company has been selling mens' clothing throughout the United Kingdom continuously since 1972 and, through their licensees, also sells associated products such as fragrances, sunglasses, spectacles, watches, jewellery, cases, bags, smokers' articles and umbrellas. His company's products are primarily sold under its trade marks BOSS and HUGO BOSS. He goes on to say that since 1994 products have also been sold under the
45 trade marks HUGO, HUGO BOSS, BOSS HUGO BOSS and BALDESSARINI HUGO BOSS.

Mr Frisch declares that the approximate annual turnover of goods by Hugo Boss AG under their trade marks in the United Kingdom for the years 1984-1995 has been as follows:-

	Year	Turnover £ Sterling
5	1984	£1,790,000
	1985	£2,238,000
	1986	£3,388,000
	1987	£5,785,000
10	1988	£8,518,000
	1989	£12,025,000
	1990	£14,364,000
	1991	£14,747,000
	1992	£14,027,000
15	1993	£11,597,000
	1994	£14,314,000
	1995	£14,962,000

20 The approximate annual amount spent by Mr Frisch's company in making its trade marks known within the United Kingdom in each of the years 1985-1995 has been as follows:-

	Year	Advertising Expenditure £ Sterling
25	1985	£32,764
	1986	£103,594
	1987	£192,003
	1988	£267,776
	1989	£314,160
30	1990	£344,458
	1991	£445,419
	1992	£440,500
	1993	£496,956
	1994	£614,562
35	1995	£479,805

40 The approximate annual turnover of goods sold by licensees of Mr Frisch's company, under its trade marks, in the United Kingdom for the years 1989-1996 has been as follows:-

Sunglasses

	Year	Volume in Pieces	Turnover £ Sterling
45	1992	3,800	
	1993	7,100	
	1994	8,800	

1995	6,000	£144,000
1996		£90,600

Leather Products

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Year	Turnover £ Sterling
1993	£490

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Bodywear

Year	Turnover £ Sterling
1994	£151,000
1995	£96,000
1996	£270,000

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Shoes

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Year	Turnover £ Sterling
1996	£58,000

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At GJF-2 samples of advertisements are provided, at GJF-3 an article relating to sponsorship activities undertaken by Hugo Boss AG, and at GJF-4 examples of articles on, or referring to, Hugo Boss AG and its activities.

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Mr Frisch declares that his company has built up considerable goodwill in its trade marks in the United Kingdom, in particular in the mark BOSS. In his assertion, use of the mark JOS THE BOSS in relation to the goods applied for would be confusing to the public. He goes on to say that the mark applied for contains the whole of his company's principal trade mark. Bearing in mind the notoriety of the international and national registered trade mark BOSS, Mr Frisch asserts that the mark applied for should be refused registration as being likely to cause confusion, and its registration would adversely prejudice the conduct of his company's business in the United Kingdom.

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APPLICANTS' EVIDENCE

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This consists of a statutory declaration by Huub Rothengatter dated 21 July 1998 who since 1991 has been the manager of Jos Verstappen, the Formula One motor racing driver. He explains that he instructs Massa Finance BV (the applicants) who are the proprietors of trade marks relating to Jos Verstappen.

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Mr Rothengatter accepts that the opponents products have been widely sold and are well known in the United Kingdom. He goes on to state that the mark applied for comprises a device of a racing driver's helmet, and the phrase JOS THE BOSS. JOS being the first name of Jos Verstappen and is well known among members of the public interested in motor racing.

The applicants' mark has not to date been used a great deal in the United Kingdom. Mr Rothengatter declares that the phrase JOS THE BOSS has been used in the Netherlands and in 1993 a fan club was established which has some 11-12000 members, including some who are resident in the United Kingdom. A number of products featuring the phrase JOS THE BOSS are available through the Fan club and photographs of such products are provided at "HR1". Approximately 10,000 t-shirts and 15,000 flags have been sold to members. At "HR2" Mr Rothengatter provides editorial copy from a UK motorsport magazine AUTOSPORT showing some of Jos Verstappen's fans carrying JOS THE BOSS club flags at the 1998 British Grand Prix.

Mr Rothengatter disagrees with the assertion that use of the mark applied for would be confusing to the public. In his view the phrase JOS THE BOSS would inevitably be seen as reference to Jos Verstappen and would not lead to any kind of association of Jos Verstappen related goods with the opponents or their marks. Mr Rothengatter goes on to say that in spite of the well-publicised use of the phrase 'JOS THE BOSS' in the Netherlands where the opponents and their products are well known, so far no-one has ever suggested that there might be a link with the opponents. He declares that the applicant and Jos Verstappen have never at any time had any wish that their goods should ever be associated with the opponents or their trade marks or in any way benefit from the opponents' goodwill.

That completes my review of the evidence.

I will deal firstly with the objection based in Section 5(2)(b).

This Section reads:

- "5.- (1)
- (2) A trade mark shall not be registered if because -
- (a)
- (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,
- there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

The term "earlier trade mark" is itself defined in Section 6 as follows:

- "6.- (1) In this Act an "earlier trade mark" means -
- (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(b) a Community trade mark which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK), or

5 (c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention as a well known trade mark."

10 The correct approach to the interpretation of the expression "a likelihood of confusion on the part of the public" as used in article 4(1)(b) and section 5(2) was considered by the European Court of Justice in Case C-251/95 *Sabel BV v Puma AG, Rudolf Dassler Sport* [1998] RPC 199. The way in which the presence or absence of a "likelihood of confusion" should be assessed was identified in paragraphs 23 and 24 of the judgment of the court at 223:

15 "..... it is clear from the tenth recital in the preamble to the Directive that the appreciation of the likelihood of confusion depends on numerous elements and, in particular, on the recognition of the trade mark on the market, of the association which can be made with the used or registered sign, of the degree of similarity between the
20 trade mark and the sign and between the goods or services identified'. The likelihood of confusion must therefore be appreciated globally, taking into account all factors relevant to the circumstances of the case.

25 That global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. The wording of Article 4(1)(b) of the Directive - 'there exists a likelihood of confusion on the part of the public

30 appreciation of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.

35 In that perspective, the more distinctive the earlier mark, the greater will be the likelihood of confusion. It is therefore not impossible that the conceptual similarity resulting from the fact that two marks use images with analogous semantic content may give rise to a likelihood of confusion where the earlier mark has a particularly distinctive character, either per se or because of the reputation it enjoys with the public."

40 The opponents rely upon 19 registrations of trade marks and one pending application in their name which consist of or include the word BOSS, which in their view should constitute a barrier to the application in suit. I do not I think have to consider each of the registrations in turn. The BOSS registrations (in Classes 9, 14, 18 and 25) are closest to the mark applied for. If the opponents do not succeed on the basis of these registrations they are unlikely to be in a
45 stronger position in relation to other registrations referred to in their statement of grounds.

The applicants' goods in Classes 16, 24 and 26 bear no similarity to the goods for which the opponents' marks are registered and consequently there is no likelihood of confusion. The opposition under Section 5(2) with regard to these goods therefore fails.

5 The opponents' BOSS registrations in Classes 14, 18 and 25 clearly encompass the applicants' goods in the same classes. Also, the opponents' goods are identical to some of the applicants' goods in Class 9, namely "sun glasses, spectacles and cases thereof". The applicants remaining goods in Class 9 are clearly not similar to any goods for which the opponents' marks are registered and therefore they do not form an obstacle under the provision of Section 5(2).

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In summary, I turn to consider whether, taking into account the fact that all the goods covered by Classes 14, 18 and 25, and some goods in Class 9 (sun glasses, spectacles and cases thereof) are the same or similar to the goods of the opponents, the trade marks themselves are similar, enough to give rise to a likelihood of confusion, bearing in mind any evidence of reputation of the earlier trade marks and any other relevant factors.

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From the sales figures provided and the length of use I think it is beyond dispute that at the material date the opponents had established a reputation under their trade marks which consist of or include the word BOSS. It is clear from the Sabel v Puma case that a strong mark with a reputation deserves more protection than a mark which is less distinctive in the market.

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The applicants' mark contains the whole of the mark BOSS. It is clear that if the opponents are to stand any chance of success then it must rest on establishing that the word BOSS is an essential feature of the mark applied for, and the fact that there is other matter in the applicants' mark does not detract from the finding that BOSS is likely to be seen as one of the essential distinguishing features of the mark.

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In addition to BOSS solus, the opponents are proprietors of the registered trade marks HUGO BOSS, BOSS/HUGO BOSS, and HUGO/HUGO BOSS. As a consequence of use of these registrations, in my view, it seems highly likely that the mark BOSS has acquired a reputation in the marketplace as the trade mark of a person or company called BOSS. In the applicants' mark the presence of the definite article is crucial in that it clearly establishes the meaning of the word BOSS - JOS THE BOSS is the person in charge. Also, in view of the device of a motor racing helmet in the applicants' name, members of the public familiar with Grand Prix motor racing may well recognise the word JOS referring to the well-known racing driver Jos Verstappen. Therefore, I conclude that the respective marks have their own distinct meaning - the opponents by reputation, the applicants by nature.

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As the ECJ stated in Sabel v Puma the public normally perceive marks as wholes and do not proceed to analyse the various details. Visually, aurally and conceptually the marks are quite different. I cannot see that there is even a remote danger of confusion arising on any of these accounts and therefore the opposition also fails under Section 5(2)(b) in relation to Classes 14, 18 and 25 and "sun glasses, spectacles and cases thereof" in Class 9.

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Section 5(3) of the Act reads:

"(3) A trade mark which -

- (a) is identical with or similar to an earlier trade mark, and
- (b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

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shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark."

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The provisions of Section 5(3) only come into play when the mark applied for is identical with or similar to an earlier trade mark. In dealing with Section 5(2)(b) I have already found that the marks are not similar such that there exists a likelihood of confusion on the part of the public and I can see no reason to come to a different finding in relation to the marks here. Consequently, the opposition fails under Section 5(3).

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I turn next to the objection based in Section 5(4)(a) which reads as follows:-

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(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

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(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b)

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A summary of the elements of an action for passing off were set out in WILD CHILD trade mark (1998 RPC 455). Briefly, the opponents are required to establish that they have goodwill in an indicium; that there will be an operative misrepresentation and that there will be consequential damage.

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As discussed above the opponents have made a very significant claim to goodwill arising from their trading activities in relation to goods covered by their registrations, although the turnover figures are not broken down by class. However, even assuming that the opponents claim to goodwill is established, they must in my view fail on the second leg of the above test as there can be no misrepresentation in the light of my views on the respective marks. It follows also that there will be no damage arising from the applicants' use of their mark. The opposition therefore fails under Section 5(4)(a).

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Finally, the opponents plead bad faith under Section 3(6) which reads:

"A trade mark shall not be registered if or to the extent that the application is made in bad faith."

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In my view there is an onus on an opponent when basing a ground of opposition on Section 3(6) to demonstrate that the applicants are seeking to register a trade mark which it knows

belongs to another. An allegation that the applicants were aware of the use and worldwide reputation of the opponents' trade marks, is not sufficient to sustain an objection to registration under this head. Even where the applicants have in essence done no more than deny the allegation, there remains an onus on the opponent to demonstrate that the applicants
5 have deliberately sought to register a trade mark to which they were not entitled. That has not been shown so far as I can see in this case and consequently the opposition based on Section 3(6) is dismissed.

As the applicants have been successful they are entitled to a contribution towards their costs.
10 I order the opponents to pay the applicants the sum of £435.

Dated this 18 day of June 1999

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D C MORGAN
For the Registrar
25 **the Comptroller General**

Class 9

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Clothing, footwear, headgear, all for protecting against accident or injury; helmets, gloves, life belts, swimming belts, goggles, all of a protective nature; luminous and mechanical signs; anti-glare screens; sun glasses, spectacles and cases thereof; anti-theft warning apparatus; remote locking apparatus; personal security apparatus; encoded and magnetic cards; batteries;

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communication apparatus; receivers; satellite apparatus; video apparatus and cassettes; audio apparatus and cassettes; compact disc apparatus and discs; digital apparatus and digitising apparatus; books on discs and tapes; film, tapes, discs, computer hardware, computer software all bearing recordings; photographic apparatus; recording apparatus; binoculars; computer apparatus and peripherals; computer discs; parts and fittings for all the aforesaid goods; all

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included in Class 9.

Class 14

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Time pieces and timers; watch bands; jewellery and imitation jewellery; coins; medals; cufflinks; tie clips and pins; medallions; scale motor vehicles and safety helmets, badges, buckles, buttons, studs, lapel badges, figurines, busts, cameos, ashtrays, smokers articles, ornaments, key-rings, coasters, paper knives, paper weights, drinking and eating articles, storage cases, trophies, all of either precious or semi-precious metals or coated with same; parts and fittings for all the aforesaid goods; all included in Class 14.

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Class 16

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Stationery; advertising material of cardboard, paper, plastic; pictures; photographs; posters; stamps; book covers and bindings; portfolios; newspapers; magazines; comics; publications; manuals; catalogues; annuals; business papers; address books; albums; autograph books; diaries; scrap books; writing pads and blocks; binders; calendars; planners; organisers; cards; imitation bank notes; route maps; printing, painting and drawing sets; computer

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documentation; stickers; stencils; transfers; gift wraps and stationery; party streamers, stationery and table linen made of paper; cases, bags, wallets, holders, packaging, badges, mats all of either paper, card or plastic; busts, figurines, ornaments, cameos all of either papier mache or card; labels, parts and fittings for all the aforesaid goods; all included in Class 16.

Class 18

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Luggage and cases; back packs; handbags; purses; belt bags; sports bags; school bags; writing set cases; umbrellas; sunshades; portfolios; jewellery boxes, cases, wallets, holders, book covers and key fobs, all of either leather or imitation leather; labels for luggage; parts and fittings for all the aforesaid goods; all included in Class 18.

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Class 24

- 5 Banners; flags; towels; face flannels; bed linen; duvet covers; pyjama cases; sleeping bags, curtains; bean bag covers; linen tableware and napkins; fabric; fabric badges and labels; curtains; blinds; sun screens and shades; kitchen linen; handkerchiefs; friezes; plastic table mats; cloth labels; parts and fittings for all the aforesaid goods; all included in Class 24.

Class 25

- 10 Clothing; swim wear; rainwear; sportswear; night wear; ski wear; underwear; track suits; shell suits; overalls; coats; mantles; suits; jackets; waist coats; bath robes; jumpers; trousers; shorts; shirts; polo shirts; T shirts; sweater shirts; sweat bands; footwear; ski boots, gaiters and cases for same; socks; headgear; peaks; visors; baseball caps; neckwear; scarves; gloves; belts; braces; headbands; parts and fittings for all the aforesaid goods; all included 25.
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Class 26

- 20 Textile badges or patches; embroidered badges and patches; embroidery; name, monogram tabs; lettering; rosettes; ribbons; hat bands; hair grips; parts and fittings for all the aforesaid goods; all included in Class 26.

Annex B

	No	Mark	Class	Specification
5	1298751	BOSS	14	Articles made wholly or principally of precious metals or coated therewith; jewellery; imitation jewellery; clocks and watches; all included in Class 14
10	B946586	BOSS	34	Smokers' articles included in Class 34; and pyrophoric lighters for smokers
15	1298750	BOSS	9	Spectacles, spectacle frames and sunglasses, cases for spectacles and for sunglasses; all included in Class 9
20	1298752	BOSS	18	Articles made wholly or principally of leather or of imitation leather; belts; cases, bags, articles of luggage, umbrellas, parasols; all included in Class 18
25	1198781	BOSS	25	Articles of clothing for men; but not including gloves or any goods of the same description as gloves
30	1198782	BOSS device	25	Articles of clothing for men; but not including gloves or any goods of the same description as gloves
35	1276174	BOSS/ HUGO BOSS LOGO	25	Articles of outerclothing; socks; articles of sports clothing, all included in Class 25; all for men
40	1538615	BOSS/ HUGO BOSS Logo	9	Spectacles, spectacle frames and sunglasses; cases for spectacles and for sunglasses; all included in Class 9
45	1538616	BOSS/ HUGO BOSS Logo	18	Articles made wholly or principally of leather or of imitation leather; belts, cases, bags, articles of luggage, umbrellas, parasols; all included in Class 18

	1538510	Baldessarini HUGO BOSS Logo	25	Articles of clothing for men; all included in Class 25
5	1298756	HUGO BOSS	18	Articles made wholly or principally of leather or of imitation leather; belts, cases, bags, articles of luggage; umbrellas, parasols; all included in Class 18
10	1298754	HUGO BOSS	9	Spectacles, spectacle frames and sunglasses; cases for spectacles and sunglasses; all included in Class 9
15	1276175	HUGO BOSS	25	Articles of outerclothing; socks; articles of sports clothing; all included in Class 25; all for men
20	1298755	HUGO BOSS	14	Articles made wholly or principally of precious metals or coated therewith; jewellery; imitation jewellery; clocks and watches; all included in Class 14
25	1538599	HUGO/ HUGO BOSS Logo	9	Spectacles, spectacle frames and sunglasses; cases for spectacles and for sunglasses; all included in Class 9
30	1538600	HUGO/ HUGO BOSS Logo	18	Leather and imitation leather; articles made wholly or principally of leather or of imitation leather; belts, cases, bags, articles of luggage, umbrellas, parasols; all included in Class 18
35	1538601	HUGO/ HUGO BOSS Logo	25	Articles of clothing; all included in Class 25
40	1538602	HUGO/ HUGO BOSS Logo	28	Games and toys; gymnastics and sporting articles; all included in Class 28
45	1571204	HUGO/ HUGO BOSS Logo	10	Condoms; all goods in Class 10