

O-055-11

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION  
No. 2510944  
BY BRITAIN MOST BOSS LIMITED  
TO REGISTER THE TRADE MARK**




**IN CLASS 25**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER No. 99832 BY  
HUGO BOSS TRADE MARK MANAGEMENT GMBH & CO KG**

## BACKGROUND

1) On 12 March 2009, Britain Most Boss Limited (hereinafter the applicant), applied to register the following trade mark:

Number	Mark	Filing Date	Class	Specification
2510944		12.03.09	25	Athletics shoes; football shoes; gymnastic shoes; leisure shoes; boots; trousers; dresses; hats; underwear; socks; gloves for clothing; scarfs; belts for clothing; tee-shirts; sports wear; cardigans; article of clothing; layettes.

2) The application was examined and accepted, and subsequently published for opposition purposes on 28 August 2009 in Trade Marks Journal No.6800.

3) On 30 November 2009 Hugo Boss Trade Mark Management GmbH & Co. KG (hereinafter the opponent) filed a notice of opposition. The grounds of opposition are in summary:

a) The opponent is the registered proprietor of the following trade marks:

Trade Mark	Number	Date of registration/ Designation	Class	Specification
BOSS	1198781	26.09.88	25	Articles of clothing for men; but not including gloves or any goods of the same description as gloves.
BOSS	M456092	13.05.2000	25	Clothing (including knitted garments and garments of knitted fabrics) for women, men and children; hoses; clothing accessories, particularly shawls, bandannas, foulards, shoulder wraps, stoles and handkerchieves as clothing accessories; neckties, belts, headwear; footwear.
<b>BOSS</b>	M773035	16.08.01	25	Articles of clothing for ladies, gentlemen and children, especially suits, coats, jackets, trousers, shirts, raincoats, outer garments and underwear, socks, stockings, tricots, pullovers, knitted shirts; footwear and head coverings, ties, gloves, belts, braces, bathrobes.

b) The opponent has extensive reputation and goodwill in the UK in its marks. The mark applied for is similar to the registered marks of the opponent and the goods of the two parties are identical or very similar. The mark in suit therefore offends against Sections 5(2)(b), 5(3) & 5(4)(a) of the Trade Marks Act 1994.

4) On 26 January 2010 the applicant filed a counterstatement which denied the opponent's claims. The applicant did not put the opponent to strict proof of use. The applicant also claims that it has used a similar mark in China since 2004.

5) Only the applicant filed evidence, and both seek an award of costs in their favour. Neither side wished to be heard. Only the opponent filed written submissions which I shall refer to as and when required.

### **APPLICANT'S EVIDENCE**

6) The applicant filed a witness statement, dated 20 July 2010, by Mr Steve Lam the Business Develop [sic] Manager of the applicant, a position he has held since January 2010. He states that the evidence he provides is from his personal knowledge and also from the applicant's records. Unfortunately, the whole of his evidence is regarding the applicant's business in China which has no relevance to the instant case.

7) That concludes my summary of the evidence filed, insofar as I consider it necessary.

### **DECISION**

8) The opponent chose not to file any evidence in this case. As such it cannot get past the first hurdle of proving reputation under Section 5(3) or goodwill under Section 5(4) (a). The opposition under these grounds therefore fails. The remaining ground of opposition is under Section 5(2)(b) of the Trade Marks Act 1994 which reads as follows:

“5.-(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.”

9) An “earlier trade mark” is defined in section 6, the relevant part of which states:

“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.”

10) In these proceedings the applicant is relying upon three marks outlined in paragraph 3 above which are clearly earlier marks. The applicant has not requested that the opponent provide proof of use.

11) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998]

RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P* (LIMONCELLO). In the recent case of *La Chemise Lacoste SA v Baker Street Clothing Ltd* [ALLIGATOR O/333/10] Mr Hobbs QC acting as the Appointed Person set out the test shown below which was endorsed by Arnold J. in *Och-Ziff Management Europe Ltd and Oz Management Lp v Och Capital LLP; Union Investment Management Ltd & Ochocki*, [2010] EWCH 2599 (Ch).

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods/ services in question; who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements; nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;
- (e) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element in that mark;
- (f) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa;
- (g) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it;
- (h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient;

(i) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(j) if the association between the marks causes the public to wrongly believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

12) In essence the test under section 5(2)(b) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the judgments mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the goods, the category of goods in question and how they are marketed. Furthermore, I must compare the registered proprietor's mark and the mark relied upon by the applicant on the basis of their inherent characteristics assuming normal and fair use of the marks on the goods in their specifications.

13) The effect of reputation on the global consideration of a likelihood of confusion under Section 5(2)(b) of the Act is a factor which is normally taken onto account. However, as the Opponent has not filed any evidence of use it cannot benefit from enhanced protection as a result of use.


14) I must now determine the average consumer for the goods of the parties, which are, broadly clothing and shoes. Clearly the average consumer must be the clothes buying general public in the UK. Such items are not purchased without some consideration, as size, material styling etc will be taken into account. Although I must take into account the concept of imperfect recollection.

15) I next turn to consider the goods of the two parties. For ease of reference these are reproduced below.

Applicant's goods	Opponent's goods
Athletics shoes; football shoes; gymnastic shoes; leisure shoes; boots; trousers; dresses; hats; underwear; socks; gloves for clothing; scarfs; belts for clothing; tee-shirts; sports wear; cardigans; article of clothing; layettes.	1198781: Articles of clothing for men; but not including gloves or any goods of the same description as gloves.
	M456092: Clothing (including knitted garments and garments of knitted fabrics) for women, men and children; hoses; clothing accessories, particularly shawls, bandannas, foulards, shoulder wraps, stoles and handkerchieves as clothing accessories; neckties, belts, headwear; footwear.
	M773035: Articles of clothing for ladies, gentlemen and children, especially suits, coats, jackets, trousers, shirts, raincoats, outer garments and underwear, socks, stockings, tricot, pullovers, knitted shirts; footwear and head coverings, ties, gloves, belts, braces, bathrobes.

16) Clearly, “Athletics shoes; football shoes; gymnastic shoes; leisure shoes; boots;” are all items of footwear and this term is included in the opponent’s M456092 and M773035. Similarly, “hats” in the applicant’s specification is identical to “headwear” in M456092 and “head coverings” in M773035. The balance of the applicant’s specification “trousers; dresses; underwear; socks; gloves for clothing; scarfs; belts for clothing; tee-shirts; sports wear; cardigans; article of clothing; layettes.” must be considered to be identical to “Clothing (including knitted garments and garments of knitted fabrics) for women, men and children;” in M456092 and “Articles of clothing for ladies, gentlemen and children”. Overall the opponent’s specifications for M456092 and M773035 must be regarded as identical to the specification of the mark in suit. These two marks therefore provide the opponent with its strongest case.

17) I now turn to consider the marks of the two parties. I will only consider the opponent’s marks M456092 and M773035 for the reasons stated in paragraph 16 above. For ease of reference these are reproduced below:

Applicant’s Trade Mark	Opponent’s Trade Marks
	BOSS
	BOSS

18) Despite the very minor element of stylisation in the second of the opponent’s marks above I regard them as being identical and effectively are simply the word BOSS written in normal typeface. Clearly, the applicant’s mark contains more than one word or element and is, therefore, a composite mark. The *Medion* case acknowledges that the overall impression conveyed to the relevant public by a composite mark may, in certain circumstances, be dominated by one or more of its components. The heraldic devices on either side of the word elements will be seen by the average consumer as simple adornment, and it is accepted that, in general, words carry far more weight than devices, particularly when they are very standard items such as the lions rampant in the applicant’s mark. Of the two words I believe that the word “BOSS” is the dominant. Firstly, it is substantially larger than the other word in the mark, it is underlined and almost highlighted by the linear device running through the word. Also it could be viewed as being the subject of the word “MOST”. The word “most is usually used as a pronoun, and although the phrase “most boss” is grammatically incorrect it could be taken to mean the biggest or best boss. However, I must compare the marks as wholes.

19) There are clearly visual differences between the marks, in that the applicant’s mark contains the word “most”, the word “boss” is underlined and has a linear device running through it and there are also the heraldic devices. However, visually there is a great degree of similarity as the whole of the opponent’s mark is contained within the applicant’s mark and the word “BOSS” is the dominant element of the applicant’s mark.

20) There are obvious aural differences as the applicant’s mark has the word “MOST” in addition to the word “BOSS”.

21) Conceptually, both marks conjure up an image of a leader or manager in the average consumer’s mind.

22) When considering the marks as wholes I take into account the acknowledged fact that such items are purchased primarily by eye [REACT]. I accept that there are differences, visually and phonetically between the marks. However, it is my view that these are far outweighed by the similarities. To my mind the marks are quite similar.

23) I take all of the above into account when considering the marks globally. I also take into account the interdependency principle – a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa. The similarities in the marks are such that when used on identical goods as in the instant case I believe there is a likelihood of consumers being confused into believing that the goods provided by the registered proprietor are those of the applicant or provided by some undertaking linked to them. The opposition action under Section 5(2) (b) therefore succeeds in relation to the whole of the specification.

### **COSTS**

Preparing a statement and considering the other side's statement	£200
Preparing evidence and considering and commenting on the other side's evidence	£200
Preparing for and attending a hearing	£0
Expenses	£200
<b>TOTAL</b>	<b>£600</b>

24) As the opponent has been successful it is entitled to a contribution towards its costs. I order the applicant to pay the opponent the sum of £600. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 17 day of February 2011**

**G W Salthouse  
For the Registrar  
the Comptroller-General**