

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2247696
BY NICHOLAS PECORELLI
TO REGISTER THE TRADE MARK:**



IN CLASS 25

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No 52185 BY
HUGO BOSS AG
BASED UPON THE EARLIER RIGHT:
HUGO *inter alia***

TRADE MARKS ACT 1994
IN THE MATTER OF Application No 2247696
by Nicholas Pecorelli
to register the trade mark:



in class 25
and
IN THE MATTER OF Opposition thereto under No 52185
by Hugo Boss AG

Background

1) On 6 October 2000 Nicholas Pecorelli of London applied to register the trade mark:



in respect of the following goods:

“clothing including: T-shirts, sweatshirts, shorts, blouses, trousers, jumpers, shorts, socks, hats, ties, suits, skirts, dresses, vests, boxer shorts, pants, baby clothing, ski pants, salts, shawls, sweatbands, jogging pants, footwear” – class 25

The application was published on 29 November 2000 with the following rubric:

“The applicant claims the colour purple as an element of the mark.”

2) On 22 February 2001 Hugo Boss AG of Metzingen, Germany filed notice of opposition to this application.

3) The opponent states that he is the registered proprietor of the following trade marks encompassing goods in class 25:

- International registration no 604808 of the trade mark **HUGO** with protection in the United Kingdom in respect of the following goods:

“women's, men's and children's clothing; stockings; headwear; belts and leather belts; scarves; accessories, namely scarves, fichus, shawls, pockets; neckties; gloves; shoes”

The registration also encompasses goods in other classes.

- Community trade mark application no 49270 of the trade mark **HUGO** in respect of the following goods:

“clothing for women, men and children; stockings; headgear for wear; belts. collar protectors; accessories, namely head scarves, scarves, shawls, dress handkerchiefs; neckties; gloves; shoes; belts of leather”

The application also encompasses goods in other classes.

- International registration no 720615 of the trade mark:



with protection in the United Kingdom in respect of the following goods:

“men's, women's and children's wear, underclothing, underwear, swimming costumes, bathrobes; stockings; headgear; belts; neckscarves; accessories namely scarves, fichus, shawls, ties; gloves; shoes; leather belts”

The registration also encompasses goods in other classes.

- International registration no 685771 of the trade mark **HUGO WOMAN** with protection in the United Kingdom in respect of the following goods:

“women's, men's and children's clothing; stockings; headwear; belts (clothing); scarves; accessories, namely scarves, headscarves, shawls, pockets; neckties; gloves; shoes; underwear; bed linen; swimsuits; dressing gowns”

The registration also encompasses goods in other classes.

- Community trade mark registration of the trade mark **HUGO WOMAN** which is registered in respect of the following goods:

“clothing for women, men and children; stockings; headgear; belts, belts of leather; scarves; accessories, namely head scarves, neckerchiefs, shawls, dress handkerchiefs; neckties; gloves; shoes”

The registration also encompasses goods in other classes.

- United Kingdom trade mark registration no 1538601 of the trade mark:



which is registered in respect of the following goods:

“articles of clothing; all included in Class 25”

- International registration no 720624 of the trade mark with protection in the United Kingdom:



which is registered in respect of the following goods:

“clothing for women, men and children, underclothing, underwear, swimming costumes, bathrobes; stockings; headgear; belts; scarves; accessories namely scarves, fichus, shawls, pocket handkerchieves; ties; gloves; footwear; leather belts”

The registration also encompasses goods in other classes.

- Community trade mark application no 49288 for the trade mark:



in respect of the following goods:

“clothing for women, men and children; stockings; headgear for wear; belts; collar protectors; underwear; night clothing; swimwear; bath robes; accessories, namely head scarves, scarves, shawls, dress handkerchiefs; neckties; gloves; shoes; belts of leather”

The application also encompasses goods in other classes.

- International registration 682850 of the trade mark:



with protection in the United Kingdom which is registered in respect of the following goods:

“clothing for men, women and children; stockings; headwear; belts; scarfs; accessories, namely headscarfs, fichus, shawls, pocket handkerchiefs; neckties; gloves; shoes; leather belts”

The registration also encompasses goods in other classes.

- Community trade mark registration no 585463 of the trade mark:



which is registered in respect of the following goods:

“clothing for women, men and children; stockings; headgear; belts, belts of leather; scarves; accessories, namely head scarves, neckerchiefs, shawls, dress handkerchiefs; neckties; gloves; shoes”

The registration also encompasses goods in other classes.

- United Kingdom registration no 1276175 of the trade mark **HUGO BOSS** which is registered in respect of the following goods:

“articles of outerclothing; socks; articles of sports clothing; all included in Class 25; all for men”

- International trade mark registration no 430400 with protection in the United Kingdom of the trade mark **Hugo Boss** which is registered in respect of the following goods:

“clothing of all kinds; clothing for men and adolescents, including, coats, jackets, trousers, shirts, raincoats; joggingwear and underwear; hosiery, namely, tights and socks, knitwear, pullovers, knit shirts; linen and underclothing; footwear and headgear; clothing accessories, such as belts, braces, neckties, gloves and hats”

The registration also encompasses goods in other classes.

- Community trade mark application no 49254 for the trade mark **HUGO BOSS** for the following goods:

“clothing for women, men and children; stockings; headgear for wear; underwear;

night clothing; swimwear; bath robes; belts; collar protectors; accessories, namely head scarves, scarves, shawls, dress handkerchiefs; neckties; gloves; shoes; belts of leather”

The application encompasses goods in other classes.

4) The opponent states that he has made extensive use of the trade mark HUGO, trade marks containing the word HUGO and the trade mark HUGO BOSS in the United Kingdom for clothing and has an extensive goodwill and reputation in the aforesaid trade marks. He states that the trade mark HUGO BOSS has been used in the United Kingdom since 1980 and trade mark HUGO/HUGO BOSS has been used in the United Kingdom for clothing since 1993.

5) The opponent states that the application in suit should be refused under the provisions of section 5(2)(b) of the Act. He states that the trade mark in suit is similar to one or more of his earlier trade marks and encompasses goods which are identical and/or similar to the goods encompassed by his earlier registrations. The opponent states that the trade mark in suit is similar to the trade mark HUGO and similar to their earlier trade marks that include the word HUGO. He states that the trade mark in suit consists of the first three letters of the trade mark HUGO. The opponent states that any colour/stylisation in the trade mark in suit is not sufficient to distinguish it from his earlier registrations. The opponent states that the tails of the letters H and G are encircled by a letter O resulting in the complete word HUGO. Furthermore he states that use of, for example, an R in the circle symbol at the end of the trade mark in suit would result in the formation of the word HUGO. The opponent states that the use and extensive reputation in the United Kingdom of the trade marks HUGO and HUGO BOSS should be taken into account.

6) The applicant filed a counterstatement denying that there is a likelihood of confusion. In particular he states that the way in which the word HUG is represented is highly distinctive from the trade marks of the opponent. The applicant states that the trade mark in suit reflects visually the word HUG enclosing the world by the arms going from the large lateral sweep of the “H” and the stem of the “G” enclosing both the empty space and the “U”, similar in a way to the Taoist Ying/Yang symbol. He states that the trade mark in suit is in no way comparable or capable of confusion with the trade marks of the opponent, which he states are static in nature and do not enclose the “U” or any part within their letters (sic). The applicant states that the basic concept is a global concept of a HUG embracing the world. He states that it is not the case that there is an “O” encircling the letters or that this creates conflict with HUGO.

7) Both parties filed evidence in the proceedings.

8) Both parties seek an award of costs.

9) The matter came to be heard on 5 February 2002. The applicant was represented by Ms McFarland of Counsel, instructed by Jacksons Solicitors. The opponent was represented by Mr Hamer of Counsel, instructed by D Young & Co.

Opponent’s evidence

10) The opponent’s evidence consists of two witness statements and an affidavit.

11) I turn first to the witness statement dated 30 August 2001 by Jill Matchett, who is a trade mark attorney. Ms Matchett exhibits various documents to substantiate the earlier rights of the opponent. She refers in particular to international registration no 604808 of the trade mark HUGO. She states that this registration encompasses inter alia women's, men's and children's clothing of all types and that the trade mark is not limited to any particular stylisation.

12) Next, there is an affidavit dated 25 September 2001 by Judith Eckl, who is the legal counsel of the opponent. Ms Eckl states that the opponent has traded internationally since the 1970s. She exhibits at EC 1 a copy of the opponent's annual report for 1999. Ms Eckl states that the trade mark HUGO is one of the three main HUGO BOSS brands. She states that HUGO is used in relation to the opponent's avant-garde range.

13) Ms Eckl states that net sales (in Euros) for the HUGO brand in Great Britain were as follows:

1995	1996	1997	1998	1999	2000
1, 006, 758	833, 053	1, 051, 271	1, 275, 815	1, 805, 267	2, 282, 883

14) Ms Eckl states that the marketing expenses (in Deutschmarks) for the HUGO brand in Great Britain were as follows:

1996	1997	1998	1999
335, 000	390, 000	111, 000	497, 000

15) Ms Eckl states that clothing under the trade mark HUGO is available throughout the United Kingdom and she exhibits at EC 2 a list of the opponent's retail customers for HUGO products. The list comprises 48 names, two of which are in the Channel Islands and so not within the United Kingdom.

16) Ms Eckl states that advertisements featuring the HUGO clothing range have appeared regularly in major United Kingdom publications. She exhibits at EC 3 media plans for the trade mark HUGO in the United Kingdom for the years 1994 to 1999 inclusive with copies of various advertisements for the years 1998 and 1999. (I note that all the advertisements use the trade mark HUGO in combination with HUGO BOSS.) She states that advertisements have appeared in publications such as: "Arena", "Marie Claire", "Vogue", "ID Magazine", "The Face", "Wallpaper" and "Dazed and Confused". Finally she exhibits at EC 4 details of the opponent's HUGO spring/summer 2001 range.

17) The final evidence in chief is a witness statement dated 5 October 2001 by Jill Matchett. Ms Matchett exhibits at JM2 copies of the original application forms for international registration no 604808 and community trade mark application no 49270. She states that these support the opponent's contention that the trade marks are not limited to any particular stylisation.

Applicant's evidence

18) The applicant's evidence consists of four affidavits.

19) The first affidavit, dated 31 October 2001, is by Antony Wilson. Mr Wilson is the export manager for Malabar Cotton Company Ltd. He states that he has no interest in either party in the proceedings. In his affidavit Mr Wilson states that he had not known of the use of HUGO simpliciter until the date of his affidavit. Mr Wilson goes on to state that the parties will occupy very different areas of the clothing market. Mr Wilson gives his opinion that there is not a likelihood of confusion between the trade mark in suit and the trade marks of the opponent.

20) The second affidavit, dated 6 November 2001, is by Richard Green who is a director of Ted Baker Ltd. Mr Green states that he has been involved in the clothing industry for more than twenty years. He states that he has no interest in either party in the proceedings. Mr Green comments on the market for the goods of the opponent. He refers to HUGO as a less well known brand. Mr Green states that he would not confuse the trade mark in suit with the trade marks of the opponent.

21) The third affidavit, dated 30 November 2001, is by Nicholas Pecorelli, who is the applicant. Mr Pecorelli goes into his intentions as to how he intends to use the trade mark in suit and the nature of the goods that he intends to produce. He outlines the differences he considers that there will be between his methods of sale and those used by the opponent. For reasons I give in relation to this issue in this decision I do not consider it necessary to go into these matters in further detail. Mr Pecorelli adduces evidence to support a claim that HUGO is used in conjunction with HUGO BOSS. Exhibit NP1 to Mr Pecorelli's declaration can best be characterised as representing submissions rather than evidence of fact. He also refers to state of the register of evidence. The matters raised in exhibit NP1 will be dealt with in my decision, where appropriate and necessary. I, therefore, do not consider it necessary to say any more about the contents of NP1.

22) Mr Pecorelli submitted a further affidavit, dated 30 November 2001, as additional evidence. He exhibits at NP11 an article from "DrapersRecord" dated 17 November 2001 which he states sets out industry views of the HUGO BOSS women's brand.

Opponent's evidence in reply

23) The opponent's evidence in reply consists of two witness statements.

24) The first witness statement, dated 7 January 2002, is by Judith Eckl. Ms Eckl states that it is not correct to state that the opponent's trade mark HUGO is always used in conjunction with the HUGO BOSS trade mark. She states that the trade mark is often referred to as HUGO as shown in evidence already filed and is used as a stand alone trade mark. She exhibits as EC5 a tag. This is a tag which she describes as a type normally attached to trousers sold under the brand in the United Kingdom. This, she states, clearly shows use of the trade mark HUGO alone.

25) Ms Eckl states that it is her view that the opponent's various trade mark registrations are not limited to any particular customer type, material or type of outlet. She also deals with the opponent's claim that different methods of sale will be used in relation to the respective goods.

26) The second witness statement, dated 17 January 2002, is by Jill Matchett. Ms Matchett

deals with the state of the register evidence of Mr Pecorelli.

Decision

27) The ground of opposition pursued by the opponent is under section 5(2)(b) of the Trade Marks Act 1994. The relevant provisions read as follows:

Section 5:

(2) A trade mark shall not be registered if because -

(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 defined in section 6 of the Act 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."

28) Mr Hamer accepted that his best case rested with international registration no 604808. I consider that it is only necessary to consider this registration. This trade mark is for HUGO simpliciter and encompasses most the goods of the application in suit. If the opponent does not succeed in relation to this registration he will not succeed in relation to the other registrations and applications.

29) In determining the question under section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG* [2000] E.T.M.R. 723. It is clear from these cases that:-

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v. Puma AG* page 224;

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG* page 224; 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* page 84, paragraph 27.

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG* page 224;

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG* page 224;

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* page 7, paragraph 17;

(f) 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; *Sabel BV v. Puma AG* page 8, paragraph 24;

(g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG* page 224;

(h) further, 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; *Marca Mode CV v. Adidas AG* page 732, paragraph 41;

(i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* page 9 paragraph 29.

30) The goods encompassed by the specification of the earlier registration are:

“women's, men's and children's clothing; stockings; headwear; belts and leather belts; scarves; accessories, namely scarves, fichus, shawls, pockets; neckties; gloves; shoes”

The goods encompassed by the specification of the application in suit are:

“clothing including: T-shirts, sweatshirts, shorts, blouses, trousers, jumpers, shorts, socks, hats, ties, suits, skirts, dresses, vests, boxer shorts, pants, baby clothing, ski pants, salts, shawls, sweatbands, jogging pants, footwear”

Neither party has contended that there is an issue in relation to the respective goods. The bulk of the specification of the application in suit is encompassed by the goods of the earlier registration, and so such goods are identical. Any remaining goods are, at worst, highly similar.

31) The trade marks to be compared are as follows:

Earlier registration:

HUGO

Application in suit:



32) I consider that the trade mark in suit will be seen as the word “hug” in a stylised form. Mr Hamer accepted that if the trade mark in suit is seen as “hug” then there is a conceptual difference between the respective trade marks. The earlier registration is a commonly known forename whilst the trade mark in suit is a commonly known noun and verb relating to the act of embracing. I find, therefore, that the respective trade marks enjoy different conceptual associations and are conceptually different.

33) The “u” in HUGO, as it is a commonly known word, will be pronounced in a completely different fashion to the “u” in the equally known word “hug”. The final vowel in the earlier registration is alien to the trade mark in suit. I find that the respective trade marks are phonetically different.

34) Visually the earlier registration is in standard characters. The trade mark in suit is presented unusually with the long sweep of the top of the “h” and the bottom of the “g” combining to almost form a circle. I find that the respective signs are clearly visually different. (I do not consider that anything turns upon the colour claim of the application in suit.)

35) Consequent upon the above I find that the respective trade marks are not similar. Indeed, I would go further and state that they are highly dissimilar.

Conclusion

36) I have not considered the issue of the claimed reputation of HUGO and I do not think that anything turns upon this matter. Reputation cannot turn dissimilar signs into similar signs. It, especially, can have no effect in the instant case where the signs are so patently dissimilar.

37) I take no cognisance of those parts of the affidavits of Mr Green and Mr Wilson in relation to the similarity of the respective trade marks and the likelihood of confusion. Expert witnesses “are experts in the market, not on confusing similarity” – *European Limited v The Economist Newspaper Ltd* 1998 FSR 283 at 291. It is for me to decide if the signs are similar and if there is a likelihood of confusion.

38) Ms McFarland accepted that the applicant’s evidence in relation to the use of the earlier registration and the proposed use of the trade mark in suit could have no bearing upon my findings. I have to consider normal and fair use of the earlier registration in relation to the

specification for which it is registered and normal and fair use of the trade mark in suit in relation to the goods for which it is applied.

39) The instant case boils down to the simple matter of the clear dissimilarity of the respective trade marks. I cannot envisage how there could be a likelihood of confusion. For a finding of likelihood of confusion the signs have to be similar. This is what the Act states, this is what the Directive states, this is what is stated in *Sabel*:

“it is to be remembered that Article 4(1)(b) of the Directive is designed to apply only if by reason of the identity or similarity both of the marks and of the goods or services which they designate, “there exists a likelihood of confusion on the part of the public”.”

Alleged reputation, identity of goods nor imperfect recollection will affect the outcome in the instant case. Mr Hamer submitted that on first impression the public might associate the earlier registration with the trade mark in suit; believe that the latter was a variant form of the trade mark that they already knew. Owing to the extreme dissimilarity between the signs I cannot see any reason why the public would associate them or, more to the issue, confuse them.

40) I, therefore, find that there is no likelihood of confusion and that the opposition is rejected in its entirety. The application in suit may go forward for registration.

41) At the hearing Ms McFarland indicated that she would like costs off the scale to be considered. Mr Hamer had indicated that he was content with costs on the scale. However, following Ms McFarland’s submission he reserved his position in relation to costs. Owing to Ms McFarland’s submission I allowed the parties two weeks to submit written submissions in relation to the costs. However, after the hearing Ms McFarland indicated to me that the applicant no longer requested costs off the scale and, this being the case, that Mr Hamer was content for the costs to be considered upon the normal scale. Consequently I will award costs according to the scale.

42) The applicant is entitled to a contribution towards his costs and I therefore order the opponent to pay him the sum of £2100. This sum is 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 13TH day of February 2002

**D.W.Landau
For the Registrar
the Comptroller-General**