**O/0825/23**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. UK00003680069**
**IN THE NAME OF XIAMEN JINBEIBI TRADING CO.,LTD.**
**TO REGISTER THE TRADE MARK:**

# Kissboss

**IN CLASSES 7, 11 AND 25**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 431207**
**BY HUGO BOSS TRADE MARK MANAGEMENT GMBH & CO. KG**

## Background and pleadings

1. On 11 August 2021, Xiamen Jinbeibi Trading Co.,Ltd. ("the applicant") applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 19 November 2021 in respect of the following goods:

> **Class 7:** *Electric fruit presses for household use; Blenders, electric, for household purposes; Coffee grinders, other than handoperated; Dishwashers; Whisks, electric, for household purposes; Dust removing installations for cleaning purposes; Electric saws; Electrical hand tools; Air pumps; Blowers [machines]; Vacuum cleaners; Bread cutting machines; Steam mops; Steam cleaners for household purposes; Washing apparatus; 3D printers; Washing machines [laundry]; Mills for household purposes, other than handoperated; Kitchen machines, electric; Ironing machines; Gardening tools (Electric -); Sewing machines; Vacuum packaging machines; Grating machines for vegetables; Vegetable spiralizers, electric.*
>
> **Class 11:** *Lamps; Range hoods for household purposes; Cooking apparatus and installations; Cooking utensils, electric; Lighting lamps; Drying apparatus; Air conditioning installations; Hair driers; Taps [faucets]; Steam facial apparatus [saunas]; Showers; Bath installations; Bath fittings; Disinfectant apparatus; Radiators, electric; LED lamps; Humidifiers; Dehumidifiers; Air fryers; Refrigerators for household purposes; Electric ovens for household purposes; Lights for festive decoration; Water purification units; Water filters; Lighting apparatus and installations.*
>
> **Class 25:** *Clothes; Coats; Skirts; Topcoats; Uniforms; Vests; Trousers; Pyjamas; Sports shirts; Shoes; Hats; Hosiery; Scarfs; Gloves [clothing]; Boots; Underwear; Pants; T-shirts; Bras; Aprons; Dresses; Sports wear; Jackets; Hoodies; Swimsuits.*

2. On 21/02/2022, HUGO BOSS Trade Mark Management GmbH & Co. KG ("the opponent") opposed the application based upon Sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act").

3. The opponent initially relied upon five earlier trade marks and two unregistered signs, however, due to the lack of participation by the applicant – who filed nothing beyond a very bare counterstatement – the opponent decided to narrow its case and focus on the two earlier marks shown below and on its goodwill in the name BOSS:[1]

UK00003618619 ("the first earlier mark")

BOSS

Filing date: 30 March 2021
Registration date: 12 November 2021

Under Section 5(2)(b) the opponent relies on some of the registered goods and services, namely those in classes 21, 25 and 35. Under Section 5(3) the opponent claims reputation in relation to all of the registered goods and services, namely:

**Class 12:** *Golf carts; dollies [hand trucks]; Prams; rickshaws; sleighs; land vehicles and conveyances; strollers; stroller hoods; stroller covers; bags adapted for strollers; handmuffs for strollers.*

**Class 18:** *Leather and imitations of leather, and goods made of these materials (included in class 18) namely small leather goods; trunks and travelling bags; bags; umbrellas and parasols; Luggage, bags, wallets and other carriers.*

[1] On 1 January 2021, the UK left the EU. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing EUTM. As a result, the opponent's second earlier mark was automatically converted into a comparable UK trade mark. Comparable UK marks are now recorded on the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.

**Class 21:** *Household or kitchen utensils and containers; cocktail shakers; brushes; glassware; porcelain; reusable bottles, thermo bottles; hair brushes; boot brushes; shaving brushes; washing brushes; bottle brushes; golf brushes; tooth brush cases; holder for brushes; combs; cases for combs.*

**Class 25:** *Clothing for men, women and children; stockings; headgear; underwear; nightwear; swimwear; bathrobes; belts; shawls; accessories, namely headscarves, neck scarves, shawls, dress handkerchiefs; ties; gloves; shoes; belts of leather.*

**Class 35:** *Business management, sales consultancy; Wholesale and retail services in relation to clothing, footwear, headgear and clocks and watches, spectacles, fashion accessories, cosmetics and perfumery, goods of leather, bags, bed linen, home textiles, household articles, stationery, luggage, sporting articles and smoking articles; Marketing services; Market research and market analysis; Advertising; Sales promotion; Rental of advertising space; Distribution of goods and advertising material for advertising purposes, including via electronic media and via the Internet; presentation of goods, in particular shop and shop window dressing; Organization of Exhibitions for commercial or advertising purposes; Promotion of business relationships by providing of commercial and business contacts; advice and advisory services for consumers; Business consultancy and administration; Business organization consulting; Professional business consulting; Business advisory services in the field of fashion consultancy; organization of fashion shows for commercial, industrial and advertising purposes;. Management of retail stores in relation to clothing, footwear, headgear and clocks and watches, spectacles, fashion accessories, cosmetics and perfumery, goods of leather, bags, bed linen, home textiles, household articles, stationery, luggage, sporting articles and smoking articles; Online wholesale and retail services and online ordering services in relation to clothing, footwear, headgear and clocks and watches, spectacles, fashion accessories, cosmetics and perfumery, goods of leather, bags, bed linen, home textiles, household articles, stationery, luggage, sporting articles and smoking articles; Mail ordering retail services and computerized online ordering services in relation to clothing, footwear, headgear and clocks and watches, spectacles, fashion accessories, cosmetics and perfumery, goods of leather, bags, bed linen, home*

| |
|---|
| *textiles, household articles, stationery, luggage, sporting articles and smoking articles.* |
| UK00900049221 (“the second earlier mark”)<br>BOSS<br>Filing date: 01 April 1996: Registration date: 29 January 2009<br><br>Under Section 5(2)(b) the opponent relies on some of the registered goods, namely those in classes 3, 16, 24, 25, 29, 30, 31 and 32. Under Section 5(3) the opponent claims reputation in relation to all of the registered goods and services, namely:<br><br>**Class 3:** *Essential oils, bleaching preparations and other substances for laundry use; fragrant sprays; Perfumery, deodorising preparations for personal use; soaps; cosmetics; hair care preparations including hair lotions; dentifrices; oral hygiene preparations, not for medical purposes.*<br><br>**Class 9:** *Spectacles and parts therefor.*<br><br>**Class 10:** *Condoms.*<br><br>**Class 12:** *Bicycles.*<br><br>**Class 14:** *Precious metals and their alloys and goods of precious metals or coated therewith (included in class 14); jewellery; clocks and watches.*<br><br>**Class 16:** *Paper, cardboard and goods made from these materials (included in class 16); printed matter; containers of plastic, paper or cardboard for packaging; stickers; playing cards.*<br><br>**Class 18:** *Leather and imitations of leather, and goods made of these materials (included in class 18), in particular small leather goods; trunks and travelling bags; bags; umbrellas and parasols.* |

**Class 20:** *Furniture, mirrors, picture frames; clothes hangers; protective covers of plastic for clothing.*

**Class 24:** *Woven fabrics and textile goods, included in class 24, in particular handkerchiefs and hand towels; Bed and table linen, wall hangings of textile.*

**Class 25:** *Clothing for men, women and children; stockings; headgear; underwear; nightwear; swimwear; bathrobes; belts; belts of leather; shawls; accessories, namely headscarves, neck scarves, shawls, dress handkerchiefs; ties; gloves; shoes.*

**Class 27:** *Carpets; non-textile wall hangings.*

**Class 28:** *Gymnastic and sporting articles, namely skis, snow boards, surf boards, golf clubs and tennis rackets.*

**Class 29:** *Jams, fruit sauces; eggs, milk; edible oils and fats.*

**Class 30:** *Coffee, tea, cocoa, sugar, tapioca, sago, artificial coffee; flour, bread, pastry and confectionery; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments), spices, chocolate and chocolate goods, sugar confectionary*.

**Class 31:** *Agricultural, horticultural and forestry products as well as grains (as far as contained in class 31); fresh fruits and vegetables; natural plants and flowers.*

**Class 32:** *Mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.*

**Class 35:** *Advertising, business management, business administration, sales consultancy.*

**Class 42:** *Planning of offices.*

4. The opponent's marks qualify as "earlier trade marks" in accordance with Section 6 of the Act, as their filing dates are earlier than the filing date of the applicant's mark. As the opponent's second earlier mark had completed its registration processes more than five years before the filing date of the applicant's mark, it is subject to the use provisions specified in Section 6A of the Act.

5. Under Section 5(2)(b), the opponent claims that the marks are similar to a high degree, that the goods and services are identical or similar, and that the distinctiveness of the earlier marks has been enhanced through use, resulting in a likelihood of confusion.

6. Under Section 5(3), the opponent claims that *"as one of the world's leading fashion houses, the opponent is particularly well-known (under its earlier marks) for high quality clothing, footwear and headgear, leather goods, bags, accessories and fragrances"* and that use of the applicant's mark will take unfair advantage of the reputation and distinctiveness of the earlier marks and cause detriment to their reputation and distinctiveness.

7. Under Section 5(4)(a), the opponent initially claimed to have used the sign 'BOSS' throughout the UK since 1996 and to have generated goodwill in relation to a variety of goods listed in an Annex accompanying the statement of grounds, however, the opponent subsequently focused on clothing and retail of household articles.[2] The opponent claims that use of the applicant's mark would cause a misrepresentation, leading consumers to believe that the goods marketed by the applicant originate from the opponent or that there is an connection between the applicant and the opponent, causing damage to the opponent's goodwill.

8. The applicant filed a counterstatement in which it put the opponent to proof of use in relation to two of the earlier marks relied upon, namely the first earlier mark and the UK mark no. 3618612. However, neither of these marks is subject to proof of use as they both have a filing date of 30 March 2021. The only denial of the opponent's claims stated by the applicant is as follows:

[2] Opponent's skeleton arguments

1. The defendant denies the opponent's claim, namely, Section 5(2)(b) - Likelihood of confusion.

2. The defendant denies the opponent's claim, namely, Section 5(3) - Detriment and unfair advantage.

3. The defendant denies the opponent's claim, namely, Section 5(4)(a) - Unregistered Rights.

9. The opponent argues that these denials lack specificity, a point to which I will return.

10. Only the opponent filed evidence. Aside from filing the very bare counterstatement which I just mentioned, the applicant did not participate any further in these proceedings.

11. The opponent is represented by Simmons & Simmons LLP and the applicant by Meifang KE.

12. A hearing took place before me on 3 May 2023 by video conference. The opponent was represented by Darren Meale of Simmons & Simmons LLP. The applicant did not attend the hearing and did not file any written submissions in lieu of attendance.

**EU Law**

13. Although the UK has left the EU, Section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

**The evidence**

14. The opponent's evidence consists of a witness statement by Paul Anthony Daly, the Director of Finance and Administration of HUGO BOSS (Schweiz) AG, an authorised representative of the opponent's company. Mr Daly's witness statement is dated 20 September 2022 and is accompanied by 22 exhibits (PAD1-PAD22).

## DECISION

### Proof of use

15. The applicant requested proof of use in relation to two earlier marks, namely the first earlier mark and the UK mark no. 3618612. As the first earlier mark is not subject to proof of use, and the opponent confirmed that it no longer relies upon the UK mark no. 3618612, the applicant's request for proof of use is no longer relevant. I also note that although the second earlier mark is subject to proof of use, the applicant chose not to put the opponent to proof of use in relation to that mark, which means that the opponent can rely on all the goods and services it has identified without having to prove that it has genuinely used the mark.

### Approach to the applicant's counterstatement

16. In his skeleton argument, Mr Meale argued that the applicant's counterstatement failed to engage in any meaningful sense with the opponent's pleaded case. He noted that while the applicant denied the ultimate outcome pleaded by the opponent – namely that it should succeed on each of the three grounds – it did not deny any of the other pleaded facts and arguments, namely:

- the opponent's analysis of the comparison of marks and goods and services (as pleaded at paragraphs 2.2 to 2.8 of the statement of grounds);

- the enhanced reputation of the earlier marks (as pleaded at paragraph 2.11(c) of the statement of grounds);

- the reputation of the opponent's earlier marks (as pleaded at paragraph 3.3 of the statement of grounds);

- the extensive and valuable goodwill of the opponent's earlier mark (as pleaded at paragraph 4.1 of the statement of grounds).

17. According to Mr Meale, *"in the absence of any denial, the absence of any serious opposition to these points, and the absence of any meaningful participation in this opposition by the applicant, the opponent submits that it should be pushing at an open door when seeking to establish these matters at the hearing on the balance of probabilities".*

18. I have considered Mr Meale's submissions. It seems to me that the point of criticism which is being made about the applicant's counterstatement is justified. In BL-O-44/21 Professor Phillip Johnson, sitting as the Appointed Person, considered the approach to be taken in a case where a counterstatement contained no specific denial of the plea that the goods were similar. He stated:

> "19. Accordingly, the issue becomes whether the TM8, as filed, was sufficient to put the issue of the similarity of goods and services in issue. If the TM8 was sufficient then the Hearing Officer was entitled to make the findings he did (subject to the second ground of appeal) but if the TM8 was not sufficient then he would have to treat the goods as similar (this would raise an issue about how similar he must treat them as being).
>
> 20. Before considering the adequacy of the TM8, I will first address Mr Engelman's argument regarding the TM7. He alleges that the TM7 filed in this case was insufficient as it included no separately pleaded Statement of Grounds.
>
> 21. In *WILD CHILD TM* [1998] RPC 455, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, spelt out what was required for an objection under section 5(4)(a):
>
> > The Scope of the Opposition
> > In the interests of justice and fairness it is plainly necessary for an objection to registration under section 5(4) to be framed in terms which: (i) specify whether the objection is raised under subsection (4)(a) or subsection (4)(b); (ii) identify the matters which are said to justify the conclusion that use of the relevant trade mark in the United Kingdom is

> liable to be prevented by virtue of an "earlier right" entitled to recognition and protection under the relevant subsection; and (iii) state whether the objection is raised in relation to all or only some (and, if so, which) of the goods or services specified in the registration or application for registration of the relevant trade mark…

22. In relation to each of these things, as adapted for objections under section 5(2)(b), it is possible to make the objection entirely by completing the boxes on TM7. There is no need to file a separate Statement of Grounds. Of course, where certain things are alleged a Statement of Grounds will be needed, for instance where enhanced distinctiveness is claimed. Nevertheless, an Opponent has a fully pleaded claim based on the completion of the boxes on Form TM7 alone.

23. The same cannot be said for Form TM8. Mr Engelman submits that filing Form TM8 should be treated as a general denial; that is, denying everything alleged by the Opponent that is not specifically addressed in the pleadings. In other words, if a blank Counter-Statement were filed then the similarity of marks, the similarity of goods and services, the likelihood of confusion, and anything else alleged by the Applicant would be in issue.

24. The position in the Civil Procedure Rules (CPR) is clear; namely, a defendant must state which allegations are denied, which allegations a defendant is unable to admit or deny, and which allegations the defendant admits (CPR, 16.5(1)). Where a defendant fails to deal with an allegation it is taken to be admitted (CPR 16.5(5)). This is subject to the rule that where an allegation is not dealt with, but the defence sets out the nature of his case in relation to the issue to which that allegation is relevant, then the allegation must be proved by the Claimant (CPR 16.5(3)). Thus, the filing of a "blank" defence would lead to the whole of the Claimant's case being admitted.

25. The procedure before neither the registrar nor the Appointed Person is governed by the CPR, but there is a Tribunal Practice Notice (TPN 4/2000) which deals with pleadings and provides a similar rule to the CPR:

> 19. A defence should comment on the facts set out in the statement of case and should state which of the grounds are admitted or denied and those which the applicant is unable to admit or deny but which he requires the opponent to prove.
>
> 20. The counter-statement should set out the reasons for denying a particular allegation and if necessary the facts on which they will rely in their defence. For example, if the party filing the counter-statement wishes to refer to prior registrations in support of their application then, as above, full details of those registrations should be provided.

26. In the context of the CPR, the Court of Appeal has emphasised that there is a positive duty on a defendant to admit or deny matters unless the party is unable to do so: *SPI North Ltd v Swiss Post International (UK) Ltd* [2019] EWCA Civ 7 at [48]. As Lord Hoffmann opined in *Barclays Bank Plc v Boulter* [1999] 1 WLR 1919 at 1923:

> The purpose of the pleadings is to define the issues and give the other party fair notice of the case which he has to meet.

27. In that case, their Lordships excused otherwise inadequate pleadings (under the old Rules of the Supreme Court) because the case the defendant would have to meet was made abundantly clear (from concealed and referential allegations) and the pleading point was said to be “technical in the highest degree” (Barclays at 1923). In that case, the defendant’s Counsel had made it clear that he would be able to deal with the point without the trial being adjourned. On the other hand, the plaintiff would merely have to make a formal request to amend. On balance it was concluded that no amendment was necessary.

28. In this case, it is clear from the Hearing Officer’s decision that the amendment would have been allowed if an application had been made and (as in fact occurred) the parties were ready to proceed on the basis that the similarity of goods and services, the global appreciation test and the likelihood

of confusion was in issue. However, in contrast to *Barclays*, in this case there was no concealed or referential allegation. The defence appeared only to address the (now abandoned) section 5(3) ground and nothing (other than experience) would have put the Appellant on notice that the similarity of goods and services or confusion were in issue in relation to s 5(2)(b).

29. The Hearing Officer has the power to request clarifications from a party to proceedings under r 62(1)(a) of the Trade Marks Rules 2008. He also could have invited Mr Engelman to apply to amend his pleadings to put in issue the similarity of goods and services, confusion and so on. Neither of these things happened. Accordingly, the Hearing Officer was wrong to proceed on the basis that the similarity of goods and services, confusion and anything other than similarity of the marks was in issue."

19. Here, the case the applicant had to answer was well set out in opponent's statement of grounds. It was therefore sufficiently clear and could have been certainly answered by the applicant. However, the counterstatement the applicant filed was defective, principally in not denying the opponent's claims about (i) the similarity of the marks, (ii) the identity of similarity of the goods and services, (iii) the enhanced distinctiveness and reputation of the earlier marks, and (iv) passing off. Further, the applicant having failed to engage any further with these proceedings, neither the option of exercising the power to request clarifications, nor that of inviting the applicant to apply to amend its pleadings, were put before me, or could have been exercised.

20. For all of the above reasons, I have resolved to take a strict approach to the matter of how the applicant has pleaded its defence.

21. Whilst I am not saying that the opposition will necessarily succeed simply on the basis that the applicant's counterstatement did not address many of the allegations in the Form TM7 and statement of grounds, the decision in BL-O-44/21 makes clear that it would not be right for me to just ignore the fact that the applicant has failed to engage with the opponent's claims save for the three bare denials that (i) there is no likelihood of confusion, (ii) there is no detriment and unfair advantage and (iii) use of the applicant's mark would not be liable to be prevented by any law protecting

unregistered rights. In the circumstances, the applicant's counterstatement is not sufficient for me to proceed on the basis that all the pleadings alleged were denied. Accordingly, the failure of the applicant to plead against the similarity of the goods and services, the similarity of the marks, the existence of enhanced distinctiveness, the existence of reputation and the existence of at least, misrepresentation and damage, means that these facts and arguments are not in issue. I will, however, engage with the substance of the claims that are denied.

**Section 5(2)(b)**

22. Section 5(2)(b) of the Act is as follows:

> "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".

23. Section 5A of the Act is as follows:

> "5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only."

24. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG,* Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc,* Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV,* Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia*

*Sales Germany & Austria GmbH,* Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM,* Case C-334/05P and *Bimbo SA v OHIM,* Case C-591/12P.

(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 or 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;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also 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 of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) 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;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

**Comparison of goods**

25. In its statement of grounds, the opponent claims that the applicant's goods in classes 7, 11 and 25 are identical or at least highly similar to the opponent's goods and services in classes Class 03, 09, 16, 21, 24, 25, 29, 30, 31, 32 and/or 35.

26. The failure of the applicant to plead against the similarity of the goods and services means that I must treat all the goods and services as being identical or highly similar. Hence, I find that the applied-for goods in classes 7, 11 and 25 are all identical or highly similar to the goods and services of the first earlier mark (in classes 21, 25 and 35) and second earlier mark (in classes 3, 16, 24, 25, 29, 30, 31 and 32).

**Average consumer**

27. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which the goods and services are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited,*

[2014] EWHC 439 (Ch), Birss J. (as he then was) described the average consumer in these terms:

> "60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

28. The average consumer of the parties' goods and services at issue is a member of the general public or, for some of the applied-for goods in class 11, a tradesman. The purchasing process for these goods and services is likely to be dominated by visual considerations. However, I do not discount aural considerations entirely as it is possible that the purchasing of these goods and services may involve oral discussions with sales representatives or word of mouth recommendations. The degree of attention may vary from medium to slightly above medium (but not high), depending on the cost and frequency of the purchase.

**Comparison of marks**

29. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

> ".....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall

impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion."

30. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

31. As the applicant's mark is a word-only mark, the second earlier mark being also a word-only mark it provides the best case for the opponent. It is therefore on this mark that I will focus. The respective marks are shown below:

| **The applicant's mark** | **The opponent's mark** |
|---|---|
| Kissboss | BOSS |

32. In its statement of grounds, the opponent states:

> "The applicant's mark is similar to the earlier marks […] A distinctive element of the applicant's mark is the word "BOSS", which is visually, aurally and conceptually identical to the sole or the dominant and distinctive element of each of the earlier marks […], namely the word "BOSS". Accordingly, the applicant's mark is similar to each of the earlier marks […] to a high degree"

33. The failure of the applicant to plead against the similarity of the marks means that I must treat the opponent's claim that the marks are similar as having been admitted. That said, in the course of his submissions on the similarity of the marks, Mr Meale, developed the following arguments (which were not pleaded *ab initio*):

- that the applicant's mark, while presented as one mark, is a composite sign consisting of a combination of the two known words "kiss" (meaning a touch or

caress with the lips) and “boss” (meaning a person in charge). The mark as a whole will be understood as indicating “a “*kiss” being done to a “boss””* and the element “boss” is dominant in the sense that it is the element to which the action (the kiss) is being done;

- the “rule of thumb” that the similarities at the beginning of the marks are more important than the similarities at the end does not apply here. In this connection Mr Meale referred to the Court of Appeal judgment in *Combe v Wolf* [2022] EWCA Civ 1562, where Lord Justice Arnold states at paragraph 120 in relation to the comparison between DR WOLFF’s VAGISAN and VAGISIL that:

  “Thirdly, the Defendants complain that the judge failed to take into account the rule of thumb that consumers pay most attention to the beginning of a trade mark: see e.g. Case T-183/02 and T-184/02 *El Corte Inglés SA v Office for Harmonisation of the Internal Market (Trade Marks and Designs)* [2004] ECR II-965 at [81]. It appears that the reason for this is that the judge was not referred to the relevant case law, but it does not matter. The rule of thumb has no relevance to the present case because the composite sign consists of two elements, one of which has no counterpart in the trade mark and the other of which is very similar to the trade mark.”

  Mr Meale submitted that the same reasoning applies here because “Kissboss” is a composite sign consisting of two elements, one which is not present in the earlier mark (i.e. the word ‘Kiss’) and one which is not just similar but identical (i.e. the word ‘boss’);

- There is conceptual similarity because both marks convey the concept of a “boss”. The applicant’s mark merely adds an action done to that “boss”;

- The word ‘boss’ has an independent distinctive role in the applicant’s mark because (a) the opponent’s mark is entirely contained within the applicant’s mark; (b) the applicant’s mark is a composite sign made up of two elements one of which has no counterpart in the opponent’s mark and the other of which

is identical to the opponent's mark; and (c) the word 'boss' plays a dominant role in the applicant's mark. In this connection, Mr Meale referred me to the following passage from Case C-120/04 *Medion AG v Thomson Sales Germany & Austria GmbH*:[3]

> "30 … it is quite possible that in a particular case an earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element.
>
> 31. In such a case the overall impression produced by the composite sign may lead the public to believe that the goods or services at issue derive, at the very least, from companies which are linked economically, in which case the likelihood of confusion must be held to be established."

34. Admittedly, in its statements of grounds, the opponent did not state that the applied-for mark is dominated by the element 'boss'. The fact that the opponent did not plead a legal argument from the outset does not mean that the opponent is prevented from arguing the same point later on in the course of the hearing. However, since the argument that the element 'boss' is the dominant element of the applied-for mark was not put forward in the statement of grounds, it cannot be deemed as having been accepted by the applicant. I will therefore consider the applicant's submissions and make my own mind up on the basis of the relevant case-law.

35. I agree with the opponent that although the applicant's mark 'Kissboss' is presented as one word, the average consumer will separate out the two components of the sign, namely the word 'Kiss' and the word 'boss'. Neither word is visually more prominent than the other; further, neither word is descriptive or allusive of the goods in question. Consequently, I reject the opponent's argument that the word 'boss' is more dominant that the word 'Kiss' and I find that they both contribute equally to the overall impression of the applicant's mark.

[3] Reference was also made to the summary of the relevant principles about signs incorporated in whole or in part (including in a modified form) in later signs, provided by the Appointed Person Dr Brian Whitehead in Genting Skyworlds (BLO/629/22).

36. However, I agree with Mr Meale that the word 'boss' retains an independent distinctive role in the composite sign 'Kissboss' because although the words are conjoined, the meaning of the word 'boss' is not altered by the word 'kiss' and, as such, it maintains a natural distinction.

37. Visually, aurally and conceptually, the marks coincide in the four-letter word 'boss/BOSS'. However, in the applicant's mark the word element 'boss' is preceded by the four-letter word 'Kiss' which has no counterpart in the opponent's mark. Although the applicant's mark is presented in title case, and the opponent's mark is presented in upper-case, the difference in casing is not relevant because both marks are word-only marks and notionally cover use in all possible fonts and typefaces. Conceptually, both marks share the concept of a boss, which will be understood by the average consumer as the person who is in charge of an organisation. The evidence (which is unchallenged) shows that the word 'BOSS' is also used by the opponent as part of the name Hugo Boss to denote a German surname, a fact that, I accept, will be known by the UK average consumer (I will return to this point below). The diverging meaning of the word 'kiss' in the applicant's mark – which refers to a touch or caress with the lips as an act of affection or greeting – does not form a grammatically correct phrase or known expression, and does not alter the meaning of the word 'boss'; consequently, it does not counteract the similarities between the marks with regard to the common verbal element 'BOSS'. There is in my view a good degree of visual, aural and conceptual similarity between the parties' marks.

**Distinctive character of earlier mark**

38. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV,* Case C-342/97, the CJEU stated that:

> "22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-

108/97 and C-109/97 *WindsurfingChiemsee* v *Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

39. Registered trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it.

40. The word 'BOSS' is used by the opponent as a surname, however, it is also a dictionary word which is neither descriptive nor allusive of the goods and services covered by the earlier mark. Considering the position from an inherent perspective, the average consumer, who has never been exposed to the opponent's use of the earlier mark 'BOSS' as a surname, will perceive the earlier mark as consisting of the dictionary word 'boss', which has a medium degree of distinctive character.

41. In its statement of ground the opponent claimed that the earlier mark benefits from enhanced distinctiveness because of its reputation. Applying the approach that I have set out above, the failure of the applicant to plead against the enhanced distinctive character and reputation of the earlier mark means that I must treat these claims as admitted.

42. Nonetheless, I have examined the evidence filed by Mr Daly. The reason why I felt unable to take the matter of reputation fully into account without looking at the evidence, is that the opponent's statement of grounds did not make any specific claims as to how strong the opponent's reputation is in the UK so, applying my approach to the counterstatement, I could not take as admitted facts that were not claimed in the statement of grounds.

43. In any event, having examined the opponent's evidence, I find that it is solid and convincing, reflecting my own experience of the opponent's brand as a famous German luxury fashion house, which is well-known in the UK. The evidence filed establishes that the UK is a very significant market for the opponent's business. Suffice to say that (a) the opponent's brand has a long history dating back to 1924, (b) the opponent has reported worldwide sales which consistently exceed €2billion in the five-year period 2017 – 2021, (c) annual net sales for the same period in the UK range from €255million to €368million, coming to a staggering total of €1,711million; (d) annual UK marketing investment (for just apparel) was between €500,000 and €5.2million in the period 2017-2022; (e) at the relevant date of 11 August 2021, the opponent had 200 physical stores in the UK, 90% of which were branded as 'BOSS'; (f) the opponent's website (which accounts for 20% of the UK sales) received between 9 and 13 million visitors a year between 2017 and 2021. The consumers' awareness of the earlier mark is also shown by copies of reports published by RepTrak, a leading publisher of reports on the global reputation of corporations based on consumer surveys and media coverage. Mr Daly says that Hugo Boss has featured in RepTrak's top 100 brands every year since at least 2014 and was ranked in position 63 in 2022, one above Apple.

44. In terms of goods, the opponent's product lines include clothing, headwear, jewellery, fragrances, eyewear, footwear, watches, leather goods, accessories and homeware. Sale figures for goods sold by the opponent's licensors are given for each category of goods; they show that fragrances, watches and clothing were the opponent's top sellers. However, given that the opponent pleaded reputation *ab initio* in relation to all of the registered goods and services, and taking into account the applicant's lack of pleadings in relation to the claim to reputation, I am not concerned about making a finding as to the types of goods in relation to which the opponent has

a reputation (or for which the opponent's reputation is stronger). I am therefore satisfied that, at the relevant date, the opponent's mark enjoyed a very high level of distinctiveness due to its reputation in relation to all of the goods and services claimed.

**Likelihood of confusion**

45. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

46. Confusion can be direct or indirect. The difference between these two types of confusion was explained in *L.A. Sugar Trade Mark,* BL O/375/10, where Iain Purvis Q.C. as the Appointed Person explained that:

> "16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: "The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ("26 RED TESCO" would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as "LITE", "EXPRESS", "WORLDWIDE", "MINI" etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ("FAT FACE" to "BRAT FACE" for example)."

47. Earlier in this decision I have found as follows:

- the applicant's goods are either identical or highly similar to the opponent's goods and services;

- The average consumer is a member of the general public or a tradesman. The purchasing process will be predominantly visual, although I do not discount an aural component to the purchase and the average consumer will pay a medium, or slightly above medium (but not high) degree of attention;

- The average consumer will separate out the two components of the sign, namely the word 'Kiss' and the word 'boss'. The word 'boss' is the shared element, it is identical to the opponent's mark, and retains an independent distinctive role within the applicant's mark;

- The marks are visually, aurally and conceptually similar to a good degree;

- The earlier mark is inherently distinctive to a medium degree, however, the extensive use of the mark made by the opponent has enhanced its distinctiveness to a very high degree.

48. The applicant denied that there is a likelihood of confusion. Neither party at the pleading stage elaborated on how confusion would occur, or why it would not occur. I will therefore approach the matter as in a normal case where likelihood of confusion is denied.

49. In my view, the existence of an unusually high level of distinctiveness as a result of the public's recognition of the opponent's mark 'BOSS', tips the balance in favour of the opponent. Whilst I accept that the word 'Kiss' is a distinctive element of the applicant's mark, the element 'boss' (which is identical to the opponent's mark) does not lose its visual, phonetic or conceptual 'individuality' or its 'distinctive character' and retains an independent role.

50. Given the significant reputation of the opponent's mark 'BOSS' and its very high level of distinctiveness, I consider that the average consumer presented with identical or highly similar goods marked 'Kissboss' might well believe that they came from the same or economically linked undertakings. In my view, the average consumer who has become used to seeing the word 'BOSS' as a trade mark denoting the surname of the famous fashion designer Hugo Boss in the particular context of goods which are identical or highly similar to the applicant's goods, might well assume that 'Kissboss' used on identical or highly similar goods is a variant mark used by the opponent. There is a likelihood of indirect confusion.

51. For the sake of completeness, I should say that I consider this case to be a borderline case. The applicant chose not to submit any arguments or evidence and did not seek to persuade me that there is no likelihood of confusion. In the circumstances, it is possible that had the applicant engaged properly with the proceedings, it might have persuaded me to reach a different conclusion (however, I make no such finding, not being necessary).

52. The opposition based upon Section 5(2)(b) is successful.

**Section 5(3)**

53. Section 5(3) states:

> "(3) A trade mark which-
>
> (a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom 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".

54. Section 5(3A) states:

> "(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected".

55. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors,* Case 252/07, *Intel,* Case C-408/01, *Adidas-Salomon,* Case C-487/07, *L'Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *Environmental Manufacturing LLP v OHIM.* The law appears to be as follows.

> (a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24.*
>
> (b) The trade mark for which protection is sought must be known by a significant part of that relevant public; G*eneral Motors, paragraph 26.*

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63.*

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68;* whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79.*

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34.*

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74.*

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure).*

56. The relevant date for the assessment under Section 5(3) is the filing date of the application at issue, being 11 August 2021.

**Reputation**

57. In *General Motors,* Case C-375/97, the CJEU held that:

"25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

58. I have already found that the distinctiveness of the earlier mark had been enhanced through use to a very high degree. For similar reasons to those I have set out above, I also find that the opponent's mark had a qualifying reputation in the UK at the relevant date. The reputation was in relation to all of the registered goods and services and was strong.

**The Link**

59. As I noted above, my assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

The degree of similarity between the conflicting marks. The marks at issue are 'Kissboss' versus 'BOSS'. They are visually, aurally and conceptually similar to a good degree;

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public. The applicant's goods are either identical or highly similar to the goods and services for which the earlier mark is registered and the relevant public is the same.

The strength of the earlier mark's reputation. The reputation of the opponent's mark is strong.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use. The trade mark 'BOSS' is inherently distinctive to a

medium degree. The use made of the mark in the UK has elevated that degree of distinctiveness to very high.

Whether there is a likelihood of confusion. There is a likelihood of confusion on the part of the general public.

60. Taking all of the above into account, I find that the UK consumers would have made a link between the applicant's mark and the opponent's earlier mark when used in relation to the applied-for goods.

**Damage**

61. I next assess whether unfair advantage will arise, as claimed by the opponent. The applicant merely denied detriment and unfair advantage.

62. I bear in mind that unfair advantage has no effect on the consumers of the goods/services of the earlier mark, but instead the taking of unfair advantage of the reputation and distinctive character of earlier mark means that consumers are more likely to purchase the goods and services of the later mark than they would otherwise have done if they had not been reminded of the earlier mark.

63. As I have said above, I will proceed on the basis that the opponent has a strong reputation in relation to all of the registered goods and services. Given the strength of the opponent's reputation and the identity and high similarity of the goods and services, it is clear that there is the potential for the applicant to gain an unfair commercial advantage, namely that of benefitting from the opponent's reputation without paying any financial compensation.

64. As damage is made out on the basis of unfair advantage, it is not necessary for me to go on and consider the other heads of damage.

65. The opposition under Section 5(3) is therefore successful.

**Section 5(4)(a)**

66. Section 5(4)(a) states:

> "(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-
>
> (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, where the condition in subsection (4A) is met,
> (aa) […]
> (b) […]
> (c)
>
> A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an "earlier right" in relation to the trade mark."

67. Subsection (4A) of Section 5 states:

> "(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application."

68. In *Discount Outlet v Feel Good UK,* [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

> "55. The elements necessary to reach a finding of passing off are the 'classical trinity' of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether *"a substantial number"* of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21)."

**Goodwill**

69. In *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL):

"What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start."

**The relevant date**

70. As the applicant did not claim that it has used the contested mark prior to filing the contested application, the relevant date for the assessment under Section 5(4)(a) is the filing date of the application at issue, being 11 August 2021.[4]

**Assessment**

71. I can deal with this ground briefly. The opponent's position is that although the applicant has denied the ultimate outcome of the Section 5(4)(a) claim, it has not denied the other pleaded facts and arguments, including goodwill. Another reasonable approach is that the applicant has denied the existence of goodwill (because by denying the existence of "unregistered rights" the opponent has effectively denied the existence of unregistered trade mark rights, which in order to be actionable, must be intrinsically related to – and supported by - the goodwill of a business) but has admitted

[4] *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11

the existence of misrepresentation and damage. However, given my findings that the opponent's mark has a strong reputation and that there is a likelihood of confusion, the point is purely academic.

72. I have already found that the opponent's mark 'BOSS' (which is identical to the sign relied upon under Section 5(4)(a)) had a strong reputation in the UK by the relevant date. It follows that the opponent also had a significant goodwill associated with the sign 'BOSS'. I recognise that the test for misrepresentation is different to that for likelihood of confusion because misrepresentation requires *"a substantial number of members of the public are deceived"* rather than considering whether the *"average consumer is confused"*. However, as recognised by Lewinson L.J. in *Marks and Spencer PLC v Interflora,* [2012] EWCA (Civ) 1501, it is doubtful whether the difference between the legal tests will produce different outcomes. I believe that to be the case here. Given my finding that there is a likelihood of confusion between the opponent's mark 'BOSS' and the applicant's mark 'Kissboss', I also find that a substantial number of the opponent's customers will be misled into purchasing the applicant's goods in the belief that they are those of the opponent, for essentially the same reasons that I set out when considering the likelihood of confusion under Section 5(2)(b).

73. The opposition under Section 5(4)(a) succeeds.

**OUTCOME**

74. The opposition succeeds under Section 5(2)(b), 5(3) and 5(4)(a). Subject to any appeal against this decision, the application shall be refused.

**COSTS**

75. As the opponent has been successful, it is entitled to a contribution towards its costs. At the hearing Mr Meale requested costs at the top-end of the scale because the applicant failed to engage beyond the counterstatement. Whilst I agree that the applicant's conduct of the case has not been ideal, I am not convinced that it calls for costs at the top-end of the scale. Based upon the scale in Tribunal Practice Notice

2/2016, I award the opponent the sum of £2,900 as a contribution towards the cost of the proceedings. This sum is calculated as follows:

| | |
|---|---|
| Preparing a Form TM7 and considering the opponent's statement: | £400 |
| Filing evidence: | £1,300 |
| Attending a hearing: | £1,000 |
| Fees: | £200 |
| Total | £2,900 |

76. I therefore order Xiamen Jinbeibi Trading Co.,Ltd. to pay HUGO BOSS Trade Mark Management GmbH & Co. KG the sum of £2,900. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of the proceedings if any appeal against this decision is unsuccessful.

**Dated this 30th day of August 2023**

**Teresa Perks**
**For the Registrar**