

**IN THE MATTER OF THE TRADE MARKS ACT 1994**

**AND IN THE MATTER OF UK TRADE MARK APPLICATION NO. 2590988  
"BOSSERT" IN THE NAME OF USA BOSSERT INTERNATIONAL DEVELOPMENT CO LTD**

**AND IN THE MATTER OF OPPOSITION NO. 102744 THERETO  
BY HUGO BOSS TRADE MARK MANAGEMENT GmbH AND CO KG**

**APPEAL BY THE OPPONENT AGAINST THE DECISION OF  
MR OLIVER MORRIS DATED 14 NOVEMBER 2012**

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**DECISION**

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1. This is an appeal by the Opponent from a decision of Mr Oliver Morris on behalf of the Registrar, by which he rejected an opposition by Hugo Boss Trade Mark Management GmbH and Co KG ("Hugo Boss") to the registration of the mark BOSSERT by USA Bossert International Development Co Ltd ("the Applicant").

**Background**

2. The Applicant applied on 11 August 2011 for a mark consisting of the word or name BOSSERT, used in the particular font shown below:

**BOSSERT**

The specification was for clothing and other goods in Class 25.

3. The opposition was based upon subsections 5(2)(b), 5(4) and 5(3) of the 1994 Act and upon 3 earlier trade marks, all of which included goods in Class 25 and consisted of the word or name BOSS. Two of the earlier marks were not merely word marks but used the name in a particular font:

**BOSS BOSS**

4. All three of Hugo Boss's marks were subject to proof of use, but the Applicant did not put it to proof. Hugo Boss nevertheless filed some evidence in support of the opposition, consisting of a short witness statement by its solicitor, Mr Smith, dealing with the extent of use of the marks,

and the various Hugo Boss sub-brands, with a small number of supporting exhibits. No evidence was filed by the Applicant.

5. A hearing took place before Mr Morris on 19 October 2012. The Applicant took no part in it. Hugo Boss was represented by counsel, Mr Jeremy Heald, who filed a skeleton argument.
6. Mr Morris in his decision dated 14 November 2012 rejected the opposition
  - a. as to s 5(2)(b), he found that there was no likelihood of confusion;
  - b. as to s 5(4), he found this took Hugo Boss no further than the 5(2)(b) argument; and
  - c. as to 5(3) he found that no link would be made between the marks; he also found that if he was wrong on the existence of a link that would not cause any of the relevant types of damage for 5(3) to apply.

#### **Standard of review**

7. Mr Malynicz, who appeared for Hugo Boss on the appeal, accepted that this appeal is by way of a review not a rehearing. *Reef Trade Mark* [2003] RPC 5 (“*Reef*”) and *BUD Trade Mark* [2003] RPC 25 (“*BUD*”) show that neither surprise at a Hearing Officer’s conclusion, nor a belief that he has reached the wrong decision, suffice to justify interference in this sort of appeal. Instead, I need to be satisfied that there is a distinct and material error of principle in the decision in question or that the Hearing Officer was clearly wrong; as Robert Walker LJ (as he then was) said at [28] in *Reef*:

*“...an appellate court should in my view show a real reluctance, but not the very highest degree of reluctance to interfere in the absence of a distinct and material error of principle.”*

8. Those principles have since been affirmed by the House of Lords in *Datec Electronics Holdings Ltd & Ors v. United Parcels Services Ltd* [2007] UKHL 23, [2007] 1 WLR 1325. Mr Daniel Alexander QC sitting as the Appointed Person in case BL O/471/11, *Petmeds*, 14 December 2011, summarised the position:

*“Datec and other cases since REEF and BUD all reinforce the need for caution before overturning a finding of the tribunal below of the kind in issue in this case. Difference of view is plainly not enough and, to that extent, the applicant’s submissions are correct. However, those cases and the practice of appellate tribunals specifically to trade mark registration disputes show that the degree of caution should not be so great as to permit decisions based on genuine errors of approach to go uncorrected.”*

9. In Mr Alexander's decision in *Digipos* [2008] Bus LR 1621 he had said:

“... appellate review of nuanced assessments requires an appellate court to be very cautious in differing from a judge's evaluation. In the context of appeals from the Registrar relating to section 5(2)(b) of the Act, alleged errors that consist of wrongly assessing similarities between marks, attributing too much or too little discernment to the average consumer or giving too much or too little weight to certain factors in the multi-factorial global assessment are not errors of principle warranting interference. I approach this appeal with that in mind.”

### **This appeal**

10. The appeal was lodged on 11 December 2012, in relation only to the objections raised under s 5(2)(b) and 5(3). It sought to challenge the Hearing Officer's analysis of the similarity between the parties' respective marks, visually, aurally and conceptually, claiming that as a result he had erred in assessing the likelihood of confusion.

11. The Grounds of Appeal included a submission that the Hearing Officer had described the Applicant's mark as being presented in “an ‘unremarkable’ script” when in fact the script was “identical to the most well-known and most-used presentation” of Hugo Boss's marks, the ‘Boss Black’ version of the mark (which I describe below). This point was also relied upon to support an appeal on the s 5(3) grounds, both as to the likelihood that a link would be found and as to the likelihood of ‘image transfer’ caused by the similarity of style of the Applicant's mark and the Boss Black form of Hugo Boss's marks.

12. The point about the impact of the Boss Black form of the earlier marks was the central point of the appeal as argued, forming the basis of Hugo Boss's submission that the errors made by the Hearing Officer “went beyond simply multi-factorial assessments.” Hugo Boss submitted that the Hearing Officer went wrong in failing to make the comparison between the Applicant's Mark and Hugo Boss's earlier UK mark number 1198781, the word only mark relied upon, because that mark was “strongly associated with a particular script” as a result of extensive use of the Boss Black style by Hugo Boss. This style of use was said to be a Times-style serif font:

**BOSS**

13. Furthermore, Hugo Boss's position was that the Applicant's mark used a similar font, and so was more likely to take unfair advantage of the renown of Hugo Boss's marks.

14. In my view, that was a somewhat surprising submission for Hugo Boss to make on the appeal, in particular because
- a. no such argument was pleaded in its TM7 and detailed Statement of Grounds, which claimed that the earlier trade marks had an extensive reputation throughout the United Kingdom because of the extensive use made of them, and also claimed (in support of its opposition under s 5 (4)) that Hugo Boss was the owner of extensive and valuable goodwill in the BOSS mark, which it described as consisting of the distinctive word BOSS, with no reference to or reliance upon a particular representation of that word.
  - b. no such claim was made in the witness statement dated 19 April 2012 filed on Hugo Boss's behalf by its solicitor, Mr Smith, nor in the written submissions filed on Hugo Boss's behalf on the same date. Both documents simply referred to the enhanced distinctiveness of the earlier marks, with no reference to or reliance upon any particular form in which the BOSS marks had been used; but
  - c. on the contrary, in his skeleton argument for the hearing before Mr Morris, counsel then instructed on behalf of Hugo Boss had submitted that "There is some stylisation present in the mark applied for and two of the earlier marks. However, the fonts used are not distinctive in themselves. It is therefore the verbal content that is of most significance to the visual comparison (i.e. BOSS v BOSSERT)."
15. Despite the position taken by Hugo Boss at the time of the hearing in front of Mr Morris, it submitted that it would be proper to reconsider this point on the appeal because of an intervening change in the law. Mr Malynicz submitted that the decision of the CJEU in Case C-252/12, *Specsavers International Healthcare Ltd v Asda Stores Ltd*, 18 July 2013, [2014] FSR 4 both explained and justified the argument which he wished to make on behalf of Hugo Boss, which may be summarised thus: the CJEU's decision in *Specsavers* shows that the assessment of the likelihood of confusion, whether for the purposes of an opposition or an infringement action, may take into account the enhanced distinctiveness of any particular form in which the earlier mark has been used. In *Specsavers*, enhanced distinctiveness was claimed for use of the earlier mark when coloured green and in this case, he submitted, enhanced distinctiveness could be claimed for use of the earlier mark in the particular Boss Black form.
16. Hugo Boss filed its opposition on 26 October 2011. The Court of Appeal judgment in *Specsavers*, which made the reference to the CJEU, was dated 31 January 2012 and the CJEU's judgment was dated 18 July 2013. As I have said, the opponent's evidence and written submissions were dated 19 April 2012, the hearing took place before Mr Morris in October 2012 and his decision is dated

14 November 2012. This appeal was filed on 11 December 2012. All of those steps in the IPO proceedings therefore took place between the dates of Court of Appeal judgment and the CJEU judgment.

17. Kitchin LJ in the Court of Appeal at [2012] EWCA Civ 24, [2012] E.T.M.R. 17 considered it necessary to make a reference as to the point about the impact of enhanced distinctiveness, but his judgment contains the following passages:

“87 In my judgment the general position is now clear. In assessing the likelihood of confusion arising from the use of a sign the court must consider the matter from the perspective of the average consumer of the goods or services in question and must take into account all the circumstances of that use that are likely to operate in that average consumer’s mind in considering the sign and the impression it is likely to make on him. The sign is not to be considered stripped of its context.

....

96 I have reached the conclusion that the law on this issue is not clear and that its resolution will require a reference to the Court of Justice. I also believe, for reasons I shall explain, that although such a reference is not necessary to decide the appeal in relation to the Word, Shaded logo and Unshaded logo marks, it is necessary for this court to decide the appeal and dispose of the claim based upon the wordless logo mark. In case it may be of assistance, I offer my provisional view. ... A mark registered in black and white is, as this court explained in *Phones 4U* [2007] R.P.C. 5, registered in respect of all colours. The position is therefore markedly different from the cloud images in *L’Oréal* [2009] E.T.M.R. 55 which did not form any part of the mark as registered. Further, the Court of Justice has said in many cases, for example *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* (C-39/97) [1998] E.C.R. I-5507; [1999] E.T.M.R. 1, that the reputation of an earlier mark is to be taken into account when determining the likelihood of confusion. In particular, the more distinctive the earlier mark the greater the risk of confusion, and marks with a highly distinctive character, either per se or because of the reputation they possess in the market, enjoy broader protection than marks with a less distinctive character. Moreover, as the Court of Justice explained in *SABEL BV v Puma AG* (C-251/95) [1997] E.C.R. I-6191; [1998] E.T.M.R. 1, account must be taken of the visual, aural and conceptual similarity of the marks, including the overall impression given by them, and bearing in mind, in particular, their respective distinctive and dominant components. If, therefore, a logo registered in black and white has

acquired, through use, a particular and distinctive character, in, for example, the colour green, that would seem to me to be a matter which ought to be taken into account in the global appreciation analysis.”

18. The CJEU answered the question referred to it on this point as follows:

“32 By its fourth question, the referring court asks whether art.9(1)(b) and (c) of Regulation 207/2009 must be interpreted as meaning that where a Community trade mark is not registered in colour, but the proprietor has used it extensively in a particular colour or combination of colours so that it has become associated in the mind of a significant portion of the public with that colour or combination of colours, the colour or colours which a third party uses in order to represent a sign alleged to infringe that trade mark are relevant in the global assessment of the likelihood of confusion or unfair advantage under those provisions.

...

34 Concerning, in the first place, the assessment of the likelihood of confusion within the meaning of art.9(1)(b) of Regulation 207/2009 , it should be recalled that, according to settled case law, the existence of a likelihood of confusion on the part of the public must be assessed globally, taking into account all factors relevant to the circumstances of the case (see, inter alia, *SABEL BV v Puma AG* (C-251/95) [1997] E.C.R. I-6191; [1998] R.P.C. 199 at [22]; *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* (C-120/04) [2005] E.C.R. I-8551; [2006] E.T.M.R. 13 at [27]; and *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Shaker di L. Laudato & C. Sas.* (C-334/05 P) [2007] E.C.R. I-4529 at [34]).

35 The Court has also held on several occasions that the global assessment of the likelihood of confusion, in relation to the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. The perception of the marks by the average consumer of the goods or services in question plays a decisive role in the global appreciation of that likelihood of confusion. In this regard, the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (see, inter alia, *SABEL* [1998] R.P.C. 199 at [23]; *Medion* [2006] E.T.M.R. 13 at [28]; and *OHIM v Shaker* [2007] E.C.R. I-4529 at [35]).

36 Furthermore, according to the case law of the Court, the more distinctive the trade mark, the greater the likelihood of confusion. Therefore, trade marks with a highly

distinctive character, either per se or because of the reputation they possess on the market, enjoy broader protection than trade marks with a less distinctive character (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* (C-39/97) [1998] E.C.R. I-5507; [1999] E.T.M.R. 1; [1999] R.P.C. 117 at [18]).

37 At the very least where there is a trade mark which is registered not in a particular colour or characteristic, but in black and white, the colour or combination of colours in which the trade mark is later used affects how the average consumer of the goods at issue perceives that trade mark, and it is, therefore, liable to increase the likelihood of confusion or association between the earlier trade mark and the sign alleged to infringe it.

38 In those circumstances, it would not be logical to consider that the fact that a third party, for the representation of a sign which is alleged to infringe an earlier Community trade mark, uses a colour or combination of colours which has become associated, in the mind of a significant portion of the public, with that earlier trade mark by the use which has been made of it by its proprietor in that colour or combination of colours, cannot be taken into consideration in the global assessment for the sole reason that that earlier trade mark was registered in black and white.”

19. Kitchin LJ had thus suggested in January 2012 that a proprietor might rely not simply upon the enhanced distinctiveness of his mark but upon enhanced distinctiveness of a particular form of his mark; the correctness of that view was one subject of the reference to the CJEU outstanding during 2012. Given the pending reference, it is perhaps understandable that no argument was made below on behalf of Hugo Boss that its marks had acquired a particular and distinctive character through use in the Boss Black form which ought to be taken into account in the analysis of the likelihood of confusion. Nevertheless, that argument was raised in the Grounds of Appeal, which were also settled before delivery of the CJEU's judgment.
  
20. Whatever the explanation for the change in Hugo Boss's argument, and whether or not there may be said to have been a change in the law since the Hearing Officer delivered his decision, the very real difficulty which I see with the submissions made on the appeal is that I do not consider them to be supported by the evidence which it filed. It does not seem to me that Hugo Boss has shown that the Boss Black form is the principal form in which the earlier marks were used, still less that the particular form of the word Boss had acquired enhanced distinctiveness in the UK by the relevant date.

21. The witness statement described the extensive use which had been made of Hugo Boss's various brands. Mr Smith exhibited at AS01 a document dated 15 April 2012 showing an overview of its different brands. Boss Black was described as the Hugo Boss core brand, standing for contemporary modern elegance. The small illustration of the brand in that document shows the name BOSS in slightly stylised capital letters, with the name Hugo Boss in very much smaller capital letters beneath it:



22. Although the document in AS01 describes Boss Black as the appellant's core brand, the witness statement did not state what proportion of the appellant's sales or marketing figures related to that brand. Exhibit AS02 gave a thumbnail sketch of the company's brand history, and did show some uses of the Boss Black mark and of just the word BOSS in the same font, but it did not prove when the Boss Black form of mark was first adopted, nor how widely it had been used in that form. Exhibit AS03 showed screenshots from various websites selling Hugo Boss goods, which again used the Boss Black form of the mark; the websites date from 2012. Exhibits AS04 and 05 showed a variety of photographs of uses of Boss marks in relation to the appellant's sponsorship of sporting activities.
23. There are few photographs showing use of the word Boss in the relevant typeface alone, but most show the word Boss used over the name Hugo Boss. The Hearing Officer commented on these examples of use of the Boss Black mark in his review of the evidence. It is not possible to tell from most of the exhibits the date or place of use, and the extent of such use is not proved. Equally, there is nothing in the witness statement to show that use of the Boss Black mark, which includes not just the word Boss but also the name Hugo Boss, had the effect of enhancing the distinctiveness of the word Boss alone, in that form of script,
24. AS10 exhibited a list of Hugo Boss trade marks. These include marks which are in the Boss Black form, the earliest of which was registered in 1986, *inter alia* for goods in Class 25. However, the mere fact of registration of those marks cannot prove the extent to which they have been used or have acquired distinctiveness.
25. There is no statement in the witness statement to the effect that that the principal form in which any of the earlier marks was used was the Boss Black form, or claiming that it had acquired a distinctiveness of its own. Mr Malynicz sought to persuade me that the witness statement and its exhibits, when read together, provided ample evidence to prove that this was the case. I do not

accept that submission. Had Hugo Boss wished to rely upon the enhanced reputation or enhanced distinctiveness of its marks based upon its use of the Boss Black mark, it could and should have pleaded the point and supported it with its evidence. It did not seek to do so.

26. In my judgment, the absence of such evidence is all the more striking, given Hugo Boss's reliance at first instance upon s 5(4) of the Act, where the form of use of the mark in which goodwill resides might have been relevant, particularly given Hugo Boss's views about the form which the Applicant chose for the BOSSERT trade mark.
27. In the absence of any such statement in the body of the witness statement itself, in my judgment the exhibits are wholly inadequate to prove that the Boss Black mark is the principal mark which had been used by Hugo Boss in the UK prior to the relevant date, still less that the particular capitalised form of the name BOSS had become associated, in the mind of a significant portion of the public in the UK, with the earlier trade marks relied upon, by the relevant date.
28. In the circumstances, I do not accept that if the Hearing Officer had made his decision after the CJEU's decision in *Specsavors*, he would or should have approached the assessment of the similarity of the parties' respective marks on the basis that the Hugo Boss marks enjoyed an enhanced distinctiveness in the particular form in which the word Boss is used in the Boss Black mark. The evidence before him would not, in my judgment, have justified such a finding over and above his finding at paragraph 34 that use of the mark had made it highly distinctive.
29. In addition to the central point discussed above, Hugo Boss made a number of other criticisms of the Hearing Officer's assessment of the similarity between the parties' respective marks. For example, it was suggested that the Hearing Officer had failed to take account of the fact that more importance is generally given to the beginnings of words. I consider that criticism to be misplaced; clearly the Hearing Officer did consider that point in paragraph 29 of the decision. I do not consider that the Hearing Officer's failure to state, as Arnold J did in *Sarmad's trade mark application* [2006] E.T.M.R. 2 at [21], that "human beings have a tendency to see what they expect to see" shows that his assessment of the level of visual similarity between the marks was flawed, let alone 'plainly wrong,' given that he found that the additional letters 'ert' in the junior mark were very noticeable.
30. Hugo Boss also challenged the Hearing Officer's assessment of the level of aural similarity between the marks; it suggested that he had found that both syllables of the Bossert mark were given equal prominence and that this finding was plainly wrong. This does not seem to me to be a fair summary of his findings as to aural similarity in paragraph 30 of judgment, in which he

found that however Bossert was pronounced, it would have two syllables rather than one, leading to only a moderate degree of similarity.

31. Thirdly, Hugo Boss submitted that the Hearing Officer erred in finding that there was a conceptual difference between the marks. The Hearing Officer considered that the Boss mark had a meaning, whether because the word would mean 'boss' as in 'manager' or as a surname, but that the average consumer would not perceive Bossert as a surname nor would it have any meaning for the average consumer. I do not accept that the Hearing Officer erred in this regard. Even if he had concluded that the enhanced distinctiveness of the Boss marks meant that they would be more likely to be seen as a surname, it does not seem to me that this means that his analysis of the conceptual difference between that name and Bossert was wrong. On the contrary, in my view this was a conclusion which it was open to the Hearing Officer to reach and he was, therefore, entitled to find that there was a conceptual difference which had a countering effect on the visual and aural similarity of the marks.
32. I therefore reject the appeal on the section 5(2)(b) grounds.
33. The appeal on the section 5(3) grounds also depended primarily upon Hugo Boss's submissions as to the enhanced distinctiveness of the Boss Black form of the Boss marks. In paragraph 45 of his decision the Hearing Officer found that the marks were not close enough for a member of the relevant public to bring the Boss marks to mind when encountering Bossert. He therefore rejected the ground of opposition under section 5(3) on the basis that there would be no link made between the marks. The principal complaint made of his reasoning was that he had not taken into account the font in which Hugo Boss now says that it has primarily used the Boss marks. For all the reasons given above, I do not accept that the Hearing Officer ought to have taken any such point into account, not only because the point was not argued in that way before him, but because the evidence does not substantiate such a claim.
34. In the circumstances, I do not consider that there is any material error in the Hearing Officer's finding that no link would be made between the marks. In the circumstances, it is not open to me to revisit that point nor would it be right for me to consider whether, if the link were made, the other requirements of section 5(3) would have been satisfied.
35. I therefore also reject the appeal on the section 5(3) grounds.
36. The appeal is dismissed.

37. The applicant has taken no part in the appeal and I will make no order as to the costs of the appeal.

Amanda Michaels  
The Appointed Person  
7 May 2014

Mr Simon Malynicz (instructed by Simmons & Simmons LLP) appeared on behalf of the Appellant.

The Respondent did not appear and was not represented.