O/1028/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3795018

BY GYM BOSS LTD

TO REGISTER:

AS A TRADE MARK IN CLASS 25

AND

IN THE MATTER OF THE OPPOSITION THERETO

UNDER NO. 436971 BY

HUGO BOSS TRADE MARK MANAGEMENT GMBH & CO. KG

BACKGROUND AND PLEADINGS

1. On 2 June 2022 ("the relevant date"), Gym Boss Ltd ("the applicant") applied to register the trade mark shown on the front cover of this decision in the United Kingdom in respect of the following goods:

Class 25
Sports clothing.

2. On 17 October 2022, the application was opposed by HUGO BOSS Trade Mark Management GmbH & Co. KG ("the opponent"). The opposition was initially based on sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act") and, under sections 5(2)(b) and 5(3), the opponent relied on six earlier marks. However, the section 5(4)(a) ground was subsequently dropped and the opponent narrowed its case to rely on the following two marks and the goods listed below:

UKTM No. 3618619 ("the 619 mark") **BOSS** Filing date: 30 March 2021 Registration date: 12 November 2021 *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.*
UKTM No. 900049221 ("the 221 mark") **BOSS** Filing date: 1 April 1996 Registration date: 29 January 2009

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.*

3. These marks qualify as earlier marks under section 6(1) of the Act by virtue of their earlier filing dates. As the 619 mark completed its registration procedure less than five years before the relevant date, the opponent is not required to show that it has used it and can therefore rely on all the goods listed under it in the above table. The 221 mark was registered more than five years before the relevant date, and the opponent has made a statement that it has used the mark for all the goods relied on.

4. Under section 5(2)(b), the opponent claims that the dominant and distinctive element of the contested 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, which enjoy an enhanced reputation. In addition, it claims that the contested goods are identical, or at least similar, to its own goods, that the marks are highly similar, being visually highly similar and aurally identical, and that the goods covered by the marks are either identical or highly similar. Consequently, it claims that there exists a likelihood of confusion on the part of the public.

5. Under section 5(3), the opponent claims that the earlier marks have a reputation for the goods shown in the table in paragraph 2 and that the opponent is particularly well-known (under its earlier marks) for high quality clothing, footwear and headgear. It asserts that use of the contested mark would create a link in the mind of the public between the contested mark and each of the earlier marks. Damage would occur in one of the following ways:

- The applicant would take unfair advantage of the distinctive character or repute of the earlier marks. The opponent claims that the applicant has intentionally sought to exploit, without paying financial compensation, the efforts undertaken by the opponent to create and maintain the reputation of the earlier marks;

- The distinctiveness of the earlier marks would be eroded and blurred so that they are no longer immediately and exclusively associated with the opponent; and/or
- There would be detriment to the repute of the earlier marks as the opponent would have no control over the applicant's use of the contested mark for the applicant's goods. If those goods were of low quality, or the applicant had an image that was inconsistent with that of the opponent, the public could develop negative associations to the earlier marks.

6. The applicant filed a defence and counterstatement in which it stated that *"Gym Boss Ltd denies the opponents claims"*. In particular, it denies any similarity between the marks and likelihood of confusion on the part of the public. Under section 5(3), it denies that there will be unfair advantage or detriment to repute. The applicant did not put the opponent to proof of use of the 221 mark. The opponent is therefore able to rely on all the goods listed in paragraph 2 above.

7. The matter came to be heard by me by videolink on 6 February 2024. The opponent was represented by Darren Meale of Simmons & Simmons LLP, the opponent's representative. The applicant did not attend the hearing and is unrepresented.

EVIDENCE

8. The opponent's evidence comes from Paul Anthony Daly, Director, Finance and Administration of HUGO BOSS (Schweiz) AG and location manager of the HUGO BOSS companies. He is also an authorised representative of the opponent, HUGO BOSS Trade Mark Management GmbH & Co. KG, which is a company within the HUGO BOSS group, of which HUGO BOSS AG is the parent company. His witness statement is dated 12 May 2023 and goes to the claims of enhanced distinctive character and reputation of the earlier marks.

9. The applicant's evidence comes from Muhammad Abdullah, the director of Gym Boss Ltd. His witness statement is dated 14 July 2023 and goes to the use made of the applicant's mark. He also states that there are many companies that use the word "BOSS".

THE PLEADINGS

10. In his skeleton argument, Mr Meale submitted that the way the applicant had pleaded its defence put only certain points in issue. In relation to the opponent's claim under section 5(2)(b), Mr Meale noted that the applicant had not denied that the dominant and/or distinctive element of the contested mark was the word "BOSS", that the goods were identical, or that the earlier marks enjoyed an enhanced degree of distinctive character. In relation to the section 5(3) claim, the applicant had not denied that the earlier marks had a reputation or that, should a link be established, there would be detriment to the distinctive character of the earlier marks; neither had it pleaded that it had due cause to use the marks. Mr Meale submitted that I should therefore treat these claims as not in issue and referred me to the decision of Professor Phillip Johnson, sitting as the Appointed Person, in *SkyClub*, BL O/044/21. At the hearing, Mr Meale encouraged me to apply *SkyClub* strictly and expressed his view that each individual allegation should be admitted or denied:

> "We need to be clear as parties to these proceedings what we are dealing with, what is in issue, what do we need evidence for, and what do we need to prepare to make submissions on. If that means there is a duty on the representatives – and I see this in represented cases as much as I do in those with a litigant in person – to go through the points in the statement of grounds and say, 'we deny this, we admit this, we deny this', as you would in the procedure in the courts, then I do not think that is a bad thing and I do not think that is a problem."[1]

11. In *SkyClub*, which was brought under section 5(2)(b) of the Act, the applicant in its counterstatement denied the similarity of the marks but was silent on the similarity of goods and services. As here, the question was what points had been put in issue by the pleaded defence. Counsel for the applicant had argued that the mere act of filing a Form TM8 (the notice of defence) should be treated as a general denial of all the claims. Professor Johnson said:

> "24. The position in the Civil Procedure Rules (CPR) is clear; namely, a defendant must state which allegations are denied, which allegations a

[1] Transcript, page 5.

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 the 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."

12. The applicant in these present proceedings originally filed its defence on 22 December 2022. The counterstatement contained information about the history of the applicant and its activities, and denied any similarity between the marks and that the public would be confused between them. On 10 January 2023, the Registry wrote to the applicant requesting that it state if it admitted or denied the claims made by the opponent. It referred the applicant to the Tribunal Practice Notice cited by Professor Johnson in *SkyClub* (TPN 4/2000) and advised the applicant that if it chose not to amend the counterstatement the Registry might strike out any parts of the defence which were not adequately particularised.

13. The applicant filed an amended counterstatement on 19 January 2023. This repeated the text in the original version, adding the words *"Gym Boss Ltd denies the opponents claims"* at the end. The Registry wrote to the applicant on 1 February 2023 requesting that further amendments were made, in particular to address the claims to similarity of the goods and (as the opponent's claims had not yet been narrowed) services.

14. On 15 February 2023, the applicant filed a further sheet of paper which denied the similarity of the marks and the likelihood of confusion, and provided the following defence of the section 5(3) claim:[2]

"Gym Boss Ltd denies the opponent's claims under section 5(3). Our proposed trademark is neither identical or similar to our opponents. We know there would be no unfair advantage to us at all or be detrimental to the reputation of the opponent's trademark."

[2] It also contained a similar denial of the claim under section 5(4)(a), but as this claim is no longer being relied on, I have not reproduced it here.

15. The Registry wrote back to the applicant on 2 March 2023 requesting that the counterstatement be contained within the Form TM8. On 9 March 2023, the applicant filed a Form TM8 to which was attached a sheet containing all the text that had so far been filed. This was admitted and served on the opponent on 14 March 2023. Nothing had been struck out.

16. I have considered Mr Meale's submissions. The circumstances here are slightly different from those of *SkyClub*. The applicant in these proceedings did make a blanket denial of the opponent's claims. I accept that it is preferable for parties to set out precisely which of the specific claims are admitted, which denied, and which require proof. However, I do not read Professor Johnson's decision as saying that blanket denials are not permissible. I shall therefore proceed on the basis that all the opponent's claims are denied. If I am wrong in this, though, for reasons that will become clear, I do not consider that it would put the applicant in any better position if I were to invite it to clarify its pleadings. It would simply lead to further delay and potentially greater costs.

RELEVANCE OF EU LAW

17. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

DECISION

Section 5(2)(b)

18. 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."

19. In considering the opposition under this section, I am guided by the following principles, gleaned from the decisions of the Court of Justice of the European Union ("CJEU") 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 BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (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-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):

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. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but someone who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them they have kept in their 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 greater 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; and

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

20. The words *Sports clothing* do not appear in the specification of either of the earlier marks. However, where goods in the specification of one party are included in a broader term from the other party's specification, those goods are considered to be identical: see *Gérard Meric v OHIM*, Case T-133/05 at [29]. In my view, the contested *Sports clothing* is included in the broader term *Clothing for men, women and children* which is to be found in both of the earlier specifications. Consequently, I find that the goods are identical.

Average consumer and the purchasing process

21. The average consumer is deemed to be reasonably well informed and reasonably circumspect: see *Hearst Holdings Inc & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC

439 (Ch) at [60]. For the purposes of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods and services in question: see *Lloyd Schuhfabrik* at [26].

22. The average consumer of the goods is a member of the general public. The consumer will buy them from a clothing retailer, department store, or, in the case of sports clothing, a specialist sports retailer, either visiting a physical shop or ordering the goods from a website or a printed catalogue. This means that the mark will be seen and so the visual element will be the most significant: see *New Look Limited v OHIM*, Joined cases T-117/03 to T-119/03 and T-171/03, at [50]. However, I do not discount the aural element, as the consumer may in some cases be assisted by a member of staff. The price of the goods varies, and, in many cases, the goods will be frequent purchases. The consumer will pay attention to the size, the materials, the style, colour, and the purpose for which they are acquiring the clothes to ensure that they buy a garment that fits them and meets their needs. For these reasons, I disagree with Mr Meale's submission that the average consumer will be paying a low degree of attention. In my view, the average consumer will be paying a medium degree of attention.

Comparison of marks

23. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. 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: see *SABEL*, at [23]. Artificial dissection of the marks would therefore be wrong, although it is necessary for me to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks: see *Bimbo*, at [34].

24. The respective marks are shown below:

Contested mark	Earlier marks
	The 619 mark: **BOSS** The 221 mark: BOSS

25. The overall impression of the earlier marks lies in the single word "BOSS". In the 619 mark, it appears in capital letters in a bold, standard sans-serif typeface, but the stylisation here is minimal and in my view it is unlikely to make any material contribution to the overall impression of the mark.

26. The opponent had claimed that "BOSS" is the dominant and/or distinctive element of the contested mark. That mark consists of the words "GYM BOSS" in gold capital letters, in a standard sans serif typeface. Mr Meale submitted that the typeface is the same as that used in the 619 mark and that this raises significant questions about how the applicant decided to use that particular typeface.[3] I have already found that this is a standard typeface. To my eyes, there is nothing remarkable about it, and so I dismiss Mr Meale's submissions that I should treat the similarity between the letters used in the 619 and the contested marks as indicative of an intention to adopt the same stylisation as the opponent. Above the letters, there is a large device which I consider is likely to be seen as comprising the letters "G" and "B" in the same typeface as the words below. The mark contains shading which brings to mind the way that light plays on the shiny surface of gold. Given the size of the device in relation to the words, I do not agree with the opponent that "BOSS" is the dominant element of the contested mark. In general, the average consumer more easily refers to the origin of goods by using the words, rather than describing a device: see *Wassen International Ltd v OHIM (SELENIUM-ACE)*, Case T-312/03, at [37]. Balancing this tendency with the size of the device, it is my view, that both the device and the verbal element make roughly equal contributions to the overall impression of the mark. I consider that the verbal element

[3] Skeleton argument, paragraph 36.

has an independent, distinctive role in the mark. The word “BOSS” is more distinctive than “GYM”, as “GYM” is descriptive in the context of the goods for which registration is sought (i.e. *Sports clothing*).

Visual comparison

27. Mr Meale submitted that the marks are visually highly similar, while the applicant claimed that the marks are not similar at all. The device is a clear point of visual difference between the marks. The earlier marks could fairly be used in gold, as they are registered in black (the 619 mark) or as a plain word mark (the 221 mark), although the use of shading in the contested mark is another difference between them. Both marks share the word “BOSS” and the remaining verbal part of the contested mark is descriptive. However, this does not mean that I should ignore it. As Mr Philip Harris, siting as the Appointed Person, said in *The Stockroom (Kent) Ltd v Purity Wellness Group Ltd*, BL O-115-22, at [31], even descriptive elements are not automatically negligible. Taking all these factors into account, I find that there is a medium degree of visual similarity between the marks.

Aural comparison

28. Mr Meale submitted that the marks are aurally highly similar and that the device would not be pronounced, even if the average consumer understood it to refer to the letters “GB”. He referred me to a decision of the General Court (“GC”), *Orsay GmbH v OHIM*, Case T-39/04, in which the GC held that even if the average consumer understood the device in the mark below as the letter “O”, they could see it as just a repetition of the first letter of the word “ORSAY” and so not pronounce it.[4]

29. I agree with Mr Meale that it is unlikely that the device will be articulated, as it will be perceived as a logo created from the initial letters of “GYM BOSS”, rather than two

[4] At [51].

letters that will be spoken. The verbal element of the mark consists of two words, each of one syllable, and they will be given their usual pronunciation. The second of these two words is identical to the only word in the earlier marks. As this is also the more distinctive verbal element, I find that it is aurally similar to the earlier marks to a high degree.

Conceptual comparison

30. The word "BOSS" will bring to the mind of the average consumer a person who is in charge of other people or a business as a whole. I am aware that the word "BOSS" has other meanings (for instance, a protruding round decoration), but I think that these will not come to mind as readily. Mr Meale submitted that the word would have the same meaning in both parties' marks, but acknowledged the additional conceptual message conveyed by the inclusion of "GYM" in the contested mark. I agree. The device will, in my view, have no conceptual content beyond that conveyed by the verbal element, given my finding that the average consumer would see it as indicating the initial letters of "GYM BOSS". I find that the marks are conceptually similar to a high degree.

Distinctive character of the earlier marks

31. Distinctive character is a measure of how strongly a mark distinguishes the goods or services of one undertaking from those of others. The factors that I must take into account in assessing the level of distinctive character were set out by the CJEU in *Lloyd Schuhfabrik*:

> "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)."

32. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, 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 the mark can be enhanced by the use that has been made of it.

33. I shall consider the inherent distinctiveness of the marks first. The 619 mark is registered in a particular stylisation, but I found that this is unlikely to make any material contribution to the overall impression of the mark and I do not consider that it adds to the inherent distinctiveness of the word "BOSS". I have already set out my findings on how the word will be perceived by the average consumer. This is a word in standard English usage that neither describes nor alludes to the goods at issue. I therefore find that the marks are inherently distinctive to a medium degree.

34. Mr Meale submits that the applicant has not denied the opponent's claims to enhanced distinctiveness of the earlier marks, and that I should therefore proceed on the basis that this has been admitted. The opponent has pleaded that the earlier marks enjoy *"an enhanced reputation"*.[5] Reputation and distinctiveness are not the same thing. Reputation is a measure of how well-known a mark is, while distinctiveness is, as I have already said, an indication of how strongly a mark distinguishes the goods and services of one undertaking from those of another. However, given that evidence has been filed, I will consider all the relevant factors set out by the CJEU in *Lloyd Schuhfabrik*. I accept that Mr Abdullah has admitted in his witness statement that the earlier marks are those of *"a well known brand"*.[6] However, even if I were to accept that the opponent has (in effect) pleaded that the distinctiveness of the earlier marks has been enhanced, and the applicant has admitted this, there remains a question of degree.

35. He states that Hugo Boss is a luxury fashion company that began to trade in Germany in 1924. Its business was originally in menswear and the BOSS brand was originally launched in the early 1970s. Womenswear was added to the range in 1998, initially sold under the mark HUGO Womenswear, but rebranded as BOSS Womenswear in 2000. From 2009, the marks were licensed for use on children's

[5] Statement of grounds, paragraph 2.10(c).
[6] Page 3, unnumbered paragraph.

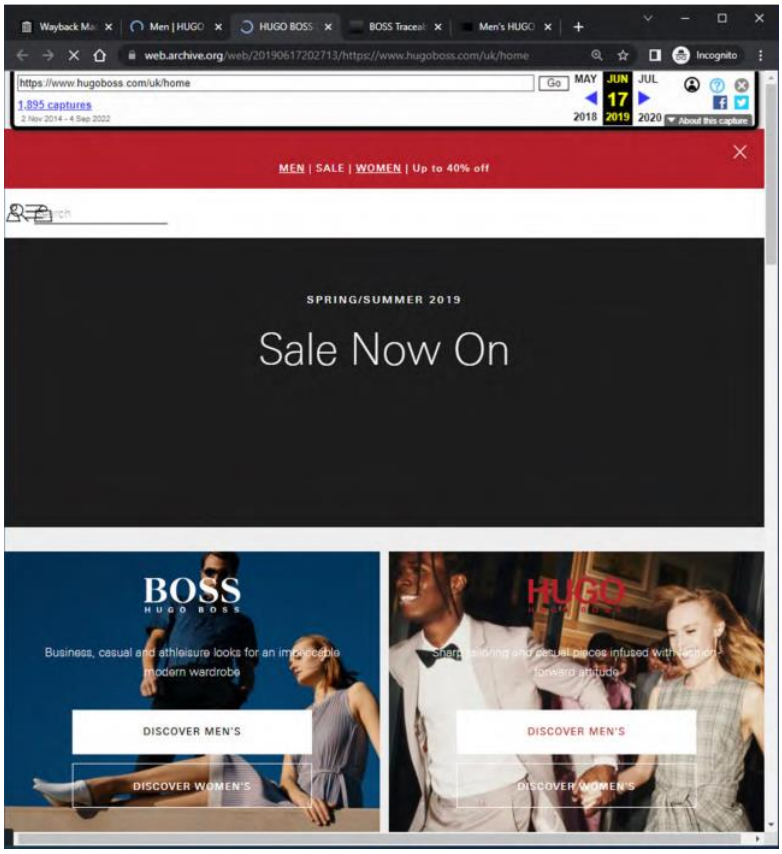
clothing. They have also been used in connection with goods such as fragrances, eyewear, jewellery, accessories and homeware.

36. Mr Daly does not say when the mark began to be used in the UK, but he does state that the first BOSS store in the UK was opened in London in 1996. He says that the HUGO BOSS group has more than 200 physical stores in the UK, with 188 of them branded as BOSS, adding that the vast majority of these were open at the relevant date.[7] Photographs in Exhibit PAD05 show the marks appearing prominently on the signage:[8]

37. Goods are also sold through third party retailers such as Harrod's, Harvey Nichols, House of Fraser, John Lewis and Selfridges and through the group's online store, which was launched in the UK in September 2008. Exhibit PAD09 contains

[7] Paragraph 19.
[8] The first photograph shows the store in Regent Street, London, and was taken in December 2016; the second shows the store in Edinburgh and was taken in August 2021.

screenshots from the group's website, obtained via the Wayback Machine, and dated from 22 June 2012 to 7 April 2022. An example from 17 June 2019 is reproduced below:[9]



38. The table below shows the numbers of UK visitors to the group's website:[10]

UK website visitor numbers (number of sessions)					
2022	**2021**	**2020**	**2019**	**2018**	**2017**
13.2 million	13.3 million	13.7 million	11.6 million	11.5 million	9.5 million

39. Annual sales for the last five years in the UK were as follows:[11]

[9] Page 115.
[10] Paragraph 24.
[11] Paragraph 12.

UK sales (€ million)						
	2022	**2021**	**2020**	**2019**	**2018**	**2017**
Net Sales	491	386	255	385	360	325

40. These include all the group's goods, not just the *Clothing for men, women and children* that is relevant for the present purposes. It will therefore cover HUGO-branded products, as well as those sold under the earlier marks. Exhibit PAD02A breaks down the figures for sales of BOSS-branded products. I have added up the figures for items of clothing and these are as follows: €242,834,369 (2017), €268,095,164 (2018), €284,015,678 (2019), €184,890,282 (2020), €284,538,274 (2021) and €356,826,084 (2022). I have not included the figures for goods described as *Leather* as it is not clear to me whether these refer to clothing or to other goods, such as wallets. These are €5,543,855 (2017), €4,594,747 (2018), €3,818,798 (2019), €1,946,692 (2020), €2,105,995 (2021) and €2,206,018 (2022).

41. The earlier marks can be seen prominently displayed on items of clothing, such as T-shirts, vests, sweatshirts, polo shirts swim shorts, jogging bottoms and hoodies offered for sale on the websites of retailers such as John Lewis and JD Sports and on the opponent's own website. There is only limited evidence of children's clothing (a dungaree set, jogging bottoms and hoodies), with the majority being clothes for men and women.[12]

42. Marketing expenditure for clothing is shown in the table below:[13]

UK marketing spend €					
2022	**2021**	**2020**	**2019**	**2018**	**2017**
5,275,870	863,847	565,541	743,968	533,937	508,512

[12] Exhibit PAD07.
[13] Paragraph 39.

43. Exhibit PAD10 contains samples of advertising material dating from 2016 to 2019, featuring menswear and womenswear. The earlier examples use the word “BOSS” with “HUGO BOSS” underneath it in smaller letters. Those from 2019 adopt the format shown below:[14]

44. The same exhibit also contains coverage of the BOSS ranges from the *Vogue* website, dating from 2002 to 2020. Mr Daly states that the opponent advertises widely in magazines such as *Esquire, GQ, Grazia, Harper’s Bazaar* and *Vogue*, in national broadsheet newspapers, online and on social media. Some examples, including a number advertising eyewear, from 2012, 2018 and 2019 are shown in Exhibit PAD14. The mark on the clothing advertisements is shown as follows:

BOSS
HUGO BOSS

45. The number of UK followers of the opponent’s social media are shown below:[15]

[14] Page 181.
[15] Paragraph 43.

UK social media followers		
Platform	**Brand**	**Approximate number of followers**
Instagram	BOSS	188,000
	HUGO	46,700
Facebook	BOSS	667,000
	HUGO	85,000
TikTok	BOSS	100,000
	HUGO	50,000

46. The opponent has also developed relationships with high-profile brand ambassadors, such as the actor Chris Hemsworth and celebrities Kendall Jenner and Hailey Bieber.[16] It has a long-standing sponsorship of Formula 1, Formula E, golf and sailing.[17] In particular, the opponent has had a 33-year relationship with the McLaren Formula 1 racing team. More recently, it has worked with the boxer Anthony Joshua on a co-branded clothing range, BOSS x AJBXNG, which was launched in September 2020.[18] This received coverage in the *Daily Mail* and on websites (luxurylondon.co.uk and wonderlandmagazine.com).

47. Exhibit PAD22 contains screenshots showing that in 2022 the opponent was ranked 63 in the "Global RepTrak 100" which, Mr Daly explains, measures the reputation of companies based on consumer surveys and media coverage. He says that it has featured in the top 100 every year since at least 2014.

48. On the basis of the evidence summarised above, I accept that the distinctive character of the marks has been enhanced to a high degree for clothing for men and women.

Conclusions on likelihood of confusion

[16] Exhibit PAD17.
[17] Paragraphs 48-51.
[18] Exhibit PAD21.

49. Making an assessment of the likelihood of confusion is a matter of considering the relevant factors from the viewpoint of the average consumer of the goods at issue and determining whether they are likely to be confused. When doing this, I am required to bear in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely on the imperfect picture of them that they have in their mind. This means that the global assessment emulates what happens in the mind of the average consumer on encountering the later mark with an imperfect recollection of the earlier mark in mind. There is no law setting out precisely what weight should be attached to each of the factors or providing a formula that can be applied to any set of circumstances. However, I am required to take account of the interdependency principle, i.e. that a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods or vice versa.

50. Earlier in my decision, I found that:

- The goods are identical;
- The average consumer is a member of the general public who pays a medium degree of attention in what is a largely visual purchasing process;
- The marks are visually similar to a medium degree and aurally and conceptually similar to a high degree;
- The distinctiveness of the earlier marks has been enhanced to a high degree for clothing for men and women; and
- The earlier marks have a medium degree of distinctiveness for clothing for children.

51. In his witness statement, Mr Abdullah claimed that a lot of different companies use the name “BOSS” and that this is shown by a search of government websites. He has not filed the results of this search, but it is likely to be a search of the Register of Companies or the Trade Marks Register, or both. Even if the results of the search had been produced in an exhibit, they would not help the applicant, because they would

not show the extent to which the word was used in the market (as opposed to appearing on statutory registers).

52. Mr Meale submitted that there was a likelihood of confusion that could be either direct or indirect. In *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10, Mr Iain Purvis QC, sitting 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 recognised 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."

53. In my view, the differences between the marks are such that the average consumer is not likely to mistake one mark for the other. I consider that they will remember the additional word "GYM", despite its descriptiveness, and are likely also to recall the device, given it size. I find that there is no likelihood of direct confusion.

54. In *L.A. Sugar*, Mr Purvis gave a number of scenarios in which he considered indirect confusion might occur:

> "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)."

55. In *Liverpool Gin Distillery Limited & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ commented that:

"12. This is a helpful explanation of the concept of indirect confusion, which has frequently been cited subsequently, but as Mr Purvis made clear it was not intended to be an exhaustive definition.

13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/291/16) at [16] 'a finding of likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion'. Mr Mellor went on to say that, if there is no likelihood of direct confusion, 'one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion'. I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion."

56. Mr Meale submitted that the contested mark would be perceived to be a sub-brand or spin-off of the earlier marks. Given the identity of the goods and the highly distinctive character of the earlier marks for men's and women's clothing, I agree that the average consumer is likely to assume that the contested mark indicates the opponent's range of gym clothing, which is a type of sports clothing. I acknowledge that the contested mark contains a device, which has no counterpart in the earlier marks. However, I remind myself that the average consumer tends to find words more distinctive than

devices. In addition, they are accustomed to seeing undertakings using plain word marks, for example in website descriptions of the goods, and figurative marks, for example on the clothing itself. I find that there is a likelihood of indirect confusion and so the opposition is successful under section 5(2)(b).

Section 5(3)

57. Section 5(3) of the Act is as follows:

> "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."

58. The conditions of section 5(3) are cumulative. First, the marks at issue must be identical or similar. I have already made a finding of similarity under section 5(2)(b). Secondly, the opponent must satisfy me that the earlier mark has achieved a level of knowledge/reputation amongst a significant part of the relevant public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier mark being brought to mind by the application. Fourthly, assuming that the first three conditions have been met, section 5(3) requires that one or more of the three types of damage claimed will occur. It is unnecessary for the purposes of section 5(3) that the goods be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

59. The relevant case law can be found in the following judgments of the CJEU: *General Motors Corp v Yplon SA* (Case C-375/97), *Intel Corporation Inc v CPM United Kingdom Ltd* (Case C-252/07), *Adidas Salomon AG v Fitnessworld Trading Ltd* (Case C-408/01), *L'Oréal SA & Ors v Bellure & Ors* (Case C-487/07), *Interflora Inc & Anor v*

Marks and Spencer plc & Anor (Case C-323/09) and *Environmental Manufacturing LLP v OHIM* (Case C-383/12 P). 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; *General 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 Salomon*, 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 and/or services, the extent of the overlap between the relevant consumers for those goods and/or 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 that 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) The more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that use of the latter will take unfair advantage of, or will be detrimental to, the distinctive character or the repute of the earlier mark; *L'Oréal*, paragraph 44.

g) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods and/or 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 and/or services for which the earlier mark is registered, or a serious risk that this will

happen in the future; *Intel*, paragraphs 76 and 77, and *Environmental Manufacturing*, paragraph 34.

h) 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.

i) 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 on the earlier mark; *L'Oréal*, paragraph 40.

j) 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; *Interflora*, paragraph 74, and the court's answer to question 1 in *L'Oréal.*

Reputation

60. In his witness statement, Mr Abdullah says that the opponent is a well-known brand. I take this to be an admission that the earlier marks have a reputation. However, even if he had not acknowledged this, I would have made such a finding on the basis of the evidence I set out earlier in my decision when I considered the enhanced distinctiveness of the earlier marks. I am satisfied that the earlier marks had a strong reputation for clothing for men and women at the relevant date.

Link

61. I found there to be a likelihood of confusion under section 5(2)(b). In *Intel*, the CJEU said:

> "57. … a link between conflicting marks is necessarily established when there is a likelihood of confusion, that is to say, when the relevant public believes or might believe that the goods or services marketed under the earlier mark and those marketed under the later mark come from the same undertaking or from economically-linked undertakings …"

62. I therefore find a link in the present case.

Damage

63. The opponent had pleaded that damage would occur through unfair advantage, damage to reputation (tarnishment) and/or damage to the distinctive character of the earlier mark (dilution). Unfair advantage means that consumers are more likely to buy the goods and services of the contested mark than they would otherwise have been if they had not been reminded of the earlier marks, and that such an advantage is taken unfairly: see *L'Oréal*, paragraph 50. A likelihood of indirect confusion means that the public are likely to buy the applicant's goods in the belief that there is a connection between the applicant and the opponent, or that the marks belong to the same undertaking, and so the applicant would be able to free-ride on the investment made by the opponent in promoting its mark. Damage is therefore made out and the section 5(3) ground is successful.

OUTCOME

64. The opposition is successful and Application No. 3795018 is refused registration.

COSTS

65. The opponent has been successful in these proceedings and is entitled to a contribution towards its costs in line with the scale set out in Tribunal Practice Notice No. 2/2016. I have calculated the award as follows:

£300 for preparing a statement and considering the other side's statement;

£1000 for preparing evidence and considering and commenting on the other side's evidence;

£800 for preparing for and attending the hearing

£200 for official fee for filing the opposition

£2300 in total

66. I therefore order Gym Boss Ltd to pay HUGO BOSS Trade Mark Management GmbH & Co. KG the sum of £2300. This sum should be paid within twenty-one days of the expiry of the appeal period, or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 30th day of October 2024

Clare Boucher
For the Registrar,
Comptroller-General